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## LEGAL STATUS OF ADVISORS IN THE FIELD OF INTELLECTUAL PROPERTY RIGHT IN THE UNITED KINGDOM

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### Abstract

**Purpose:** to research the legal status of advisors in the field of intellectual property right in the United Kingdom. In this article an author distinguishes and gives a legal description of the types of advisors in the field of intellectual property right in the United Kingdom. The main provisions of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons (2015) are considered. **Methods:** to analyse the legal status of advisors in the field of intellectual property right in the United Kingdom the method of induction, systematic approach, formal legal methods were used. **Results:** this research provides an opportunity to broaden the understanding of the institute of advisors in the field of intellectual property right (in particular patent attorneys and trademark attorneys) in the UK and thus include this knowledge in domestic research on intellectual property right. **Conclusions:** the majority of types of advisors in the field of intellectual property right in the United Kingdom (patent attorneys, chartered patent attorneys, European patent attorneys, registered trademark attorneys and trademark attorneys, European trademark attorneys, etc.) is well-educated professionals in all areas of intellectual property and are able to advise on a wide range of technical and commercial issues in this field. The obtained results will have a positive impact on the reform of the institute of representatives in the field of intellectual property in Ukraine in order to ensure its effectiveness and relevance to the challenges of the present.

**Keywords:** advisor; code of Conduct; intellectual property; patent attorney; trademark attorney.

### 1. Introduction

“Lawyer” is a general term referring to an individual who is professionally qualified to practice as a lawyer. But, in fact, within the legal profession there are a number of different types of lawyers.

The majority of people are familiar with the terms “solicitor” and “barrister” for lawyers in the United Kingdom. Solicitor is a member of that branch of the legal profession whose services consist of advising clients, representing them before the lower courts, and preparing cases for barristers to try in the higher courts. Barrister is a lawyer who is a member of one of the Inns of Court and who has the privilege of pleading in the higher courts. “Attorney” is the term which is used in the United Kingdom for those individuals who are specifically qualified to advice on intellectual property right and subject to external regulation. The protected terms “patent attorney” and “trade mark attorney” distinguish these lawyers from “patent consultants or

patent advisors” and “trade mark consultants” etc., who are unlikely to have any form of professional qualification [1].

### 2. Analysis of the latest research and publications

It should be noted that international experience and national practice of the institute of patent attorneys was considered by such domestic scientists as Borivyk P.A., Kovalenko T.V., Tverezenko O.O. and others, but this issue needs to be researched in further.

### 3. Purpose of a research

In this article an author researches the legal status of advisors encountered in the field of intellectual property right in the United Kingdom, considers the main provisions of the Code of Conduct or the Rules of Professional Conduct for patent attorneys and trade mark attorneys as well-educated professionals in all areas of intellectual property.

#### 4. Presenting main material

Intellectual property is the term applied to a miscellaneous collection of rights which operate to control what may legitimately be copied and what needs permission [2].

Intellectual property is divided into two categories: industrial property includes patents for inventions, trademarks, industrial designs and geographical indications; copyright covers literary works (such as novels, poems and plays), films, music, artistic works (e.g., drawings, paintings, photographs and sculptures) and architectural design [3].

Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and broadcasters in their radio and television programs [4].

But, the key areas of the intellectual property right are patents, trade marks and designs.

The field of intellectual property right has many international aspects and clients can typically range from individual inventors to major multi-national corporations.

In any field the value and trustworthiness of advice depends on the ability of the advisor.

The following describes the types of advisor encountered in the field of intellectual property right in the United Kingdom:

Firstly, *the patent attorney* is an expert in the intellectual property right. Patent attorneys are specially trained, examined and experienced in the drafting patents and in knowledge of intellectual property right [5]. In the United Kingdom the title “patent attorney” is protected by the Copyright, Designs and Patents Act 1988 [6] and can only be used by a fully qualified patent attorney who is entered into the Register of Patent Attorneys and who is regulated by the Intellectual Property Regulation Board (hereafter – the IPReg) or by a fully qualified solicitor with specialist expertise in intellectual property law who is regulated by the Solicitors Regulation Authority. All those who are entered in the Register of Patent Attorneys must comply with the Code of Conduct – the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons (hereafter – the Rules) [7] set out by the IPReg.

The IPReg was set up in 2010 by the Chartered Institute of Patent Attorneys (hereafter – the CIPA) and the Institute of Trade Mark Attorneys (hereafter – the ITMA) to be the independent regulatory body for the patent attorney and trade mark attorney

professions. The CIPA and ITMA are approved regulators under the Legal Service Act 2007 [8], and in 2010 in order to separate their regulatory functions from their representational functions, as the Act requires them to do, they each set up a Regulation Board (the Patent Attorney Regulation Board and the Trade Mark Attorney Regulation Board) which will act and take decisions together as the IPReg.

The IPReg has a Chairman and four Lay Members along with three Patent Attorneys and three Trade Mark Attorneys. The IPReg is responsible for:

- setting the education and training requirements for qualification as a Patent Attorney and a Trade Mark Attorney;

- setting the requirements for the Continuous Professional Development (hereafter – CPD) in order that the knowledge, skills and expertise of Patent Attorneys and Trade Mark Attorneys are maintained at a high level. All registered patent and trade mark attorneys in active practice are required to achieve the minimum of 16 hours CPD in order to remain registered and to self-certify that they have met this requirement when renewing their registration. Compliance may be monitored by requiring detailed support (such as individual CPD records) from a random sample of registrants each year to substantiate the 16 hours figure. Attorneys are required to undertake CPD relevant to their practice. The IPReg do not require specific numbers of hours to be devoted to particular subjects. Instead, attorneys should determine for themselves, bearing in mind their existing skills and the nature of their practice, the most appropriate subjects where they should undertake CPD, taking account of their responsibilities and the expectations placed upon them [9];

- setting and maintaining the Rules for the professions;

- handling complaints of the professional misconduct against patent attorneys and trade mark attorneys and where appropriate taking disciplinary or other action [10].

The patent attorneys qualify by taking appropriate examinations in accordance with the regulations of the IPReg. The examinations for entry on the Register of Patent Attorneys are set by the Patent Examination Board.

Secondly, *the chartered patent attorneys* are fellows of the CIPA who have attained the highest standards of professional practice in intellectual

property law. The CIPA exists to provide its members with support in the early stages of professional training and to offer a comprehensive programme of the post-qualification Continuous Professional Development which guarantees that the chartered patent attorneys have the skills, knowledge and expertise to provide an excellent level of service. The majority of the chartered patent attorneys are also the European patent attorneys and the registered trade mark attorneys.

Thirdly, *the European patent attorneys* who are persons entered on a list of professional representatives at the European Patent Office as being qualified to prosecute patent applications. Entry on to the list is by examination (although when a new country joins existing agents in that country are entitled to be entered on the list). Under the United Kingdom law no one other than a person entered on the list of professional representatives may use the title "European patent attorney".

Fourthly, *the registered trade mark attorneys and trade mark attorneys*. Unlike the position for the patent attorneys, the terms "trade mark attorney" and "trade mark agent" are not protected by law and anyone may use them whether or not they have a qualification in trade marks. However, for the protection of the public, no one in the United Kingdom may use the title "registered trade mark attorney" unless he or she is in the Register of Trade Mark Attorneys. Entry to the Register of Trade Mark Attorneys is by examination and the Register is under the control of the IPReg.

All patent attorneys are examined in trade marks as part of the qualification to become a patent attorney and many of them practise as trade mark attorneys, although they may not have passed all the examinations for entry on the Register of Trade Mark Attorneys, or may have decided not to be on that Register. The Rules for patent attorneys requires them not to practise outside their competence and experience. Thus, when looking for advice on trade marks, it is advisable to check whether the advisor is a registered trade mark attorney or the patent attorney.

Fifthly, *the European trade mark attorneys* who are persons included in the list of professional representatives entitled to practise before the Office for Harmonisation in the Internal Market. There is no examination for entry on such list, but the local Patent Office must certify that the applicant has regularly practised in trade marks nationally.

Sixthly, all patent attorneys have the right both to conduct litigation (i.e. to run cases) and the right of audience in the Patents County Court and on appeal from the Patent Office in the Patents Court, which is part of the High Court. *The patent attorney litigators* can conduct the litigation and instruct a barrister to appear before the Court, without the need to use a solicitor for this work. The purpose of the government in granting this right was to give clients greater freedom of choice in selecting their advisers and to reduce the cost of litigation. The award of Certificates to the patent attorney litigators is governed by the CIPA Higher Court Qualification Regulations.

Seventhly, *the solicitors* are entitled to file and prosecute patent, design and trade mark applications provided that this is within their competence. There are no requirements for a solicitor to take specialist examinations before acting in the field of intellectual property right. Solicitors are subject to regulation by the Law Society.

Eighty, *the barristers* are specialist lawyers who advise clients about litigation issues and act as the advocate for the client if the case gets to court. There is a specialist Patent Bar which deals with intellectual property cases, these barristers generally having a scientific as well as a legal background.

In recent years, there has been some blurring of the boundaries of the work of barristers, solicitors and patent agents, with the latter two professions being able in certain circumstances to act as advocates in Court.

Ninthly, there are some organisations which offer to find manufacturers to exploit an invention for clients called as *the invention promoters or invention brokers*. Such organisations tend to advertise widely on TV or in the press. They are not qualified as patent or trade mark attorneys, and there can be dangers in using such services.

All members of the CIPA and ITMA have agreed to abide by the Rules written to ensure that clients consulting a firm of patent attorneys would receive accurate and impartial advice which puts their interests foremost. The Rules were drafted by the Patent Regulation Board of the CIPA and the Trade Mark Regulation Board of the ITMA working jointly together as the IPReg.

The Rules set out the standards of professional conduct and practice expected of the registered patent attorney, registered trade mark attorney or a body (corporate or unincorporated) registered in the Patent Attorney Register or the Trade Mark Attorney

Register undertaking professional work (hereafter – the Regulated persons).

The Regulated persons are responsible under the Rules not only for their own acts and omissions, but also for those sanctioned, expressly or otherwise, by them.

Individuals, firms and companies registered in the Patent Attorney Register or Trade Mark Attorney Register, their managers and employees are subject to the Rules if they act in the course of a business which undertakes relevant professional work.

The Regulated persons shall carry out their professional work with due skill, care and diligence and with proper regard for the technical standards expected of them. They should only undertake work within his expertise or competence. The interests of the client would be served by the Regulated persons in fulfilment of the client's instructions.

The Regulated persons only undertake litigation and advocacy in matters where the primary issues at stake relate to intellectual property rights. Where a case raises issues which are not within the Regulated persons' competence (e.g. complex issues of employment law in an intellectual property entitlement case), if the Regulated person is to continue to act they must supplement their team with other legal advisers who have relevant specialist knowledge of such matters.

Patent and trade mark attorneys do not have rights of audience in respect of criminal litigation.

The Regulated persons should in all professional activities: a) practise competently, promptly, conscientiously, courteously, honestly and objectively, avoiding unnecessary expense to the client; b) act so as to promote confidence in the intellectual property system; and c) put clients' interests foremost and keep clients' affairs confidential.

The Regulated person should not do anything that might compromise: a) his independence; b) the dignity and good standing of the Regulated person, or of the patent or trade mark professions; or c) the freedom of clients to instruct any person or firm to carry out their work or to change their representation.

The Regulated persons shall carry out their professional work in a timely manner and with proper regard for standards of professional service and client care.

Written terms of business should be given to clients at the outset of a relationship and as often as necessary thereafter. Any variations should be

communicated to clients as soon as they apply to the client. The Regulated persons should ensure that clients receive as often as necessary an explanation, appropriate to the client's reasonably apparent or expected level of understanding, as to the issues in a matter, the progress of the matter and the likely timescale and an update periodically on expenditure incurred or to be incurred. The level of reporting depends on the client relationship and the experience of the client or the person responsible within the client's organisation. For example, lay clients may require more care than in-house counsel. Extra care should be taken when dealing with potentially vulnerable clients such as private individuals and in particular where there may be risk factors related to a person's circumstances (e.g. bereavement, illness or disability, etc.) which increase the likelihood of the client being at a disadvantage or suffering detriment.

Every Regulated person should have a written file retention/destruction policy which should be made available to the client on request.

The Regulated person must not act where his interests conflict with those of a client or of a former client, or where he knows or has reasonable grounds for suspecting that the interests of any partner or Regulated person or staff of his firm, conflict with those of a client or of a former client.

Provided in all the circumstances it is reasonable to do so, the Regulated person may act for two or more clients, or for a client as against a former client, in relation to the same or a related matter in a situation of conflict, or possible conflict but only if all of the parties have given their informed consent in writing.

The Regulated person must not allow any person to perform work under his supervision when the Regulated person knows or has reasonable grounds for suspecting that such a person has a conflict of interest in respect of the work.

A conflict may not arise simply because the Regulated person acts for two or more parties in the same general field of business or technology although on the facts it may do so. More typically a conflict arises by reference to the specific subject matter of a case.

All Regulated persons should undertake a "conflict check" before taking on a new client. This may take whatever form is considered appropriate in all of the circumstances. The minimum expected is a check with all other relevant persons that acceptance

of a named client is not likely to compromise the interests of a client already on the books.

The Regulated persons must keep the affairs of clients and former clients confidential except where disclosure is required and permitted by law or by the client or former client.

Subject to this duty of client confidentiality and any circumstance where disclosure of information is prohibited by law, unless a client expressly agrees that no duty to disclose arises or a different standard of disclosure applies, the Regulated person should disclose all relevant information of which he is aware to a client.

The Regulated persons' fees must be justifiable. Thus, fees charged should be based upon the information provided in any letter of engagement or on the basis of any amendment thereto.

Every Regulated person must ensure that they have in place appropriate controls, procedure and records and also sufficient and appropriately qualified staff and/or other resources to ensure that clients always receive a high standard of service in relation to the management of client money.

In the event that the Regulated person receives money from a client, other than by way of payment of fees or disbursements incurred but including money on account for fees or disbursements paid up front, they should ensure that such money is held on trust for the client in an account which is entirely separate from the Regulated person's or the firm's professional business accounts.

The Regulated persons in private practice must have an established procedure for dealing with complaints. The Regulated persons in private practice must keep records of all complaints received and the outcomes of their complaints procedures in respect of such complaints. In this context a complaint means an oral or written expression of dissatisfaction which alleges that the complainant has suffered (or may suffer) financial loss, distress, inconvenience or other detriment.

The Regulated persons may exercise a lien over client papers and other materials belonging to a client only when and to the extent that the lien is available in law or the lien is an express term of business to which the client has agreed.

The registered patent attorneys and registered trade mark attorneys shall undertake appropriate continuing professional development and, on request, provide details thereof to the appropriate Regulation Board.

Publicity and promotional activity of any kind by the Regulated persons is permitted if it is fair, honest, accurate and is not misleading and is not otherwise in breach of the Rules.

The letterhead, website and e-mails of the Regulated persons must show the words "regulated by the Intellectual Property Regulation Board" or "regulated by the IPReg".

## 5. Conclusions

In the United Kingdom an advisor encountered in the field of intellectual property right is anyone skilled and qualified in intellectual property matters, who acts for others – inventors and companies usually – in securing, enforcing or advising in the intellectual property field. Like in Ukraine, in the United Kingdom the term "patent attorney" is a protected title, and only those who have passed tough qualifying examinations and who have then decided to place their name on the statutory Register of Patent Attorneys are entitled to use the term. All patent attorneys are trained broadly across the field of intellectual property and are expected to be able to advice on a wide range of technical and commercial problems throughout that field. But, unlike in Ukraine, in the United Kingdom there exist several types of advisors in the field of intellectual property right, namely: patent attorneys, chartered patent attorneys, European patent attorneys, registered trademark attorneys and trademark attorneys, European trademark attorneys, etc.). In our opinion, implementing a similar diversity of advisors in the field of intellectual property right of Ukraine will have a positive impact on the reform of the institute of representatives in the field of intellectual property in Ukraine in order to ensure its effectiveness and relevance to the challenges of the present.

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#### **Правовий статус консультантів у сфері права інтелектуальної власності у Великій Британії**

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**Мета:** дослідити правовий статус консультантів у сфері права інтелектуальної власності у Великій Британії. У даній статті автор виокремлює та дає правову характеристику основних видів консультантів у сфері права інтелектуальної власності у Великій Британії. Розглянуто основні положення Правил поведінки для патентних повірених, повірених з торговельних марок та інших осіб (2015). **Методи дослідження:** для аналізу правового статусу консультантів у сфері права інтелектуальної власності у Великій Британії використано метод індукції, системний підхід, формально-юридичний методи. **Результати:** дане дослідження дає можливість розширити уявлення про інститут консультантів у сфері права інтелектуальної власності (зокрема патентних повірених та повірених з торговельних марок) у Великій Британії і, таким чином, включити ці знання до вітчизняних наукових розробок з права інтелектуальної власності. **Висновки:** більшість видів консультантів у сфері права інтелектуальної власності у Великій Британії (патентні повірені, дипломовані патентні повірені, Європейські патентні повірені, зареєстровані повірені з торговельних марок та повірені з торговельних марок, Європейські повірені з торговельних марок тощо) є добре освіченими спеціалістами у всіх сферах інтелектуальної власності та здатні консультивати з широкого кола технічних та комерційних питань у даній галузі. Отримані результати матимуть позитивний вплив на реформування інституту представників у справах інтелектуальної власності в Україні для забезпечення його ефективності та відповідності викликам сьогодення.

**Ключові слова:** інтелектуальна власність; Кодекс Поведінки; консультант; патентний повірений; повірений з торговельних марок.

#### **Х. В. Кмэтык**

#### **Правовой статус консультантов в сфере права интеллектуальной собственности в Великобритании**

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**Цель:** исследовать правовой статус консультантов в сфере права интеллектуальной собственности в Великобритании. В данной статье автор выделяет и дает правовую характеристику основных видов консультантов в сфере права интеллектуальной собственности в Великобритании. Рассмотрены основные положения Правил поведения для патентных поверенных, поверенных по торговым маркам и других лиц. **Методы исследования:** для анализа правового статуса консультантов в сфере права интеллектуальной собственности в Великобритании использован метод индукции, системный подход, формально-юридический методы. **Результаты:** данное исследование дает возможность расширить представление об институте консультантов в сфере права интеллектуальной собственности (в том числе патентных поверенных и поверенных по торговым маркам) в Великобритании и, таким образом, включить эти знания в отечественные научные разработки по праву интеллектуальной собственности. **Выводы:** большинство видов консультантов в сфере права интеллектуальной собственности в Великобритании (патентные поверенные, дипломированные патентные поверенные, Европейские патентные поверенные, зарегистрированные поверенные по торговым маркам и поверенные по торговым маркам, Европейские поверенные по торговым маркам и т.д.) есть хорошо образованными специалистами во всех сферах интеллектуальной собственности и способны консультировать по широкому кругу технических и коммерческих вопросов в данной области. Полученные результаты окажут положительное влияние на реформирование института представителей по делам интеллектуальной собственности в Украине для обеспечения его эффективности и соответствия вызовам современности.

**Ключевые слова:** интеллектуальная собственность; Кодекс поведения; консультант; патентный поверенный; поверенный по торговым маркам.

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