Importance of the Role Patent & Trademark Agents for the well functioning of the Intellectual property System

Regional Workshop on Human Resources Development of Patent/Trademark Agents in ARIPO Members and Observer States

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Presentation overview

- What is a patent Agent or Attorney, or Trademark Agent or a Corporate Patent/Trademark Agent;
- Main Functions of a Patent/Trademark Agent;
- The Need for Agents to Create & Join Associations;
- Importance of Client – Attorney Privilege for Agents;
- Role of Patent Agents in the National, Regional and International Framework;
- Support by Patent Agents in addressing challenges ARIPO & its Member States face;
- Discussions on the Need for ARIPO to begin Accrediting Agents
Patent Agents

- In most Jurisdictions, a patent agent must have a degree in engineering or sciences but must not have a degree in Law;
- Must be well versed with the Patent Rules & laws in the National, Regional & International Framework;
- In most Jurisdictions, Patent Agents take very difficult examinations to admitted to what’s called the “patent bar”;
- A patent agent –
  - is permitted legally to represent applicants in preparing and filing patent applications and then prosecuting them through the examination process with the patent’s office to obtain an IP title.
What is a patent Attorney

• A Patent Attorney:
  – Has the same qualifications as a Patent Agent but must also have a degree in Law;
  – In most Jurisdictions Patent Attorneys must also pass an examination before being permitted to represent applicants at a Patent Office;
  – ARIPO Patent Agents/Attorneys are the Agents Registered by Member States’ National Offices;
  – Most are lawyers with no science background;
  – This could soon change as ARIPO will soon introduce a registration process for agents/attorneys.
Main Roles of Patent Agents

• They must know the Business, Technical & Legal processing of applications at the National, Regional & International level;

• Must support their clients in all matters of IP including:
  – Completing the necessary forms;
  – Drafting the specifications;
  – Undertaking initial searches to verify the validity of the applications;
  – contact the patent office & lodge in applications;
  – Follow up on any issues that might arise while the application is being processed, etc.
A Trademark Agent

• Must be a lawyer who is qualified to act in matters involving trademarks and provide legal advice accordingly and must:
  – Defend the clients in the fight against counterfeits;
  – Monitor Infringements; etc.
  – They also work as patent agents in the ARIPO Region;
General Functions of a Patent/Trademark Agent

• A patent Agent gives Council to the following:
  – Individual inventors;
  – Industry;
  – Research & Development Institutions
  – Governments,
  – Local & Foreign Clients; etc.
Specific Functions of a Patent/Trademark Agent

• Advise on how to use, protect and apply for IP Rights;
• Provide all the necessary support in the acquisition of the IP rights;
• Represent clients & advise them on:
  – How to maintain the IP Right;
  – How to Work the IP Right;
  – Defend IP Rights against possible conflicts which may arise in connection with the Procurement and/or protecting the Rights;
  – Licensing/Assigning IP Right;
  – Marketing of the IP Right, etc.
Corporate Patent/Trademark Agents

• Large Companies with IP Departments have Services of Corporate Patent Agents whose main Functions Include:
  – Filing & Processing of Applications;
  – Undertaking Searches & Monitoring;
  – Prior art Documentation;
  – Coordination with Research & Development Division,
  – Identifying Infringements & Undertaking Litigations,
  – Licensing, etc.
Associations of Patents & trademark Agents

• To Protect their Profession and IP at large, Agents need form Associations like:
  – International Association for the Protection of Industrial Property (AIPPI)
  – International Trademark Association (INTA);
• There should also be Regional and National Associations;
• There is need to create an ARIPO Regional Agents Association;
The “Client –Attorney Privilege” for Patent Agents

• Client –Attorney Privilege protects communications between the attorney and client made for purpose of furnishing or obtaining professional legal advice or assistance.”

• To gain trust of Inventors, Investors & Researchers, Agents should make sure that the Client- Attorney Privilege is implemented nationally, Regionally and Internationally;

• Most Common Law countries have the “Client-Attorney Privilege” in their Legislations
Role of Patent Agents in the National, Regional & International Framework

- Harmonization of IP Laws accordance to National, Regional & International Treaties;
- Support in the adoption of appropriate National IP Laws and Strategies according to international Treaties;
- Support in Building Effective IP Systems which can attract applicants and investors;
- Support in the Protection & Exploitation of IP Rights; Nationally, Regionally & Internationally to enhance National & Regional exports to International markets;
- Marketing the Services of National & Regional IP Offices, for the Promotion of Trade for Social & Economic development; etc.
The role of patent Agents in promoting innovation and supporting the Dissemination of Technical Information

• Agents should provide Legal & Technical advice & Services to clients including Inventors & Researchers including:

• Services Provided Normally include:
  – Search Services;
  – IP Profiling;
  – Statistics, etc.
Patent Agents and the Public

• Patent agents should support Awareness drives in all matters relating to IP and undertake the following:
  – Advise Governments in the Drafting of appropriate National IP Laws and Strategies;
  – Advise Governments before they join Regional or International Treaties;
  – Demystification of IP Nationally & Regionally
  – Advocate for the Inclusion of IP in the School curricula;
  – Promote the use of IP for the National & Regional Social & Economic Development; etc.
Support by Patent Agents in Addressing some Challenges to ARIPO & Its Member States

- **Limited Resources** to undertake all the Objectives & Programs of the Organization;
- **Limited Capacity** particularly in the National Offices to undertake & adopt relevant Policies in IP;
- **Lack Harmonization** of IP Laws among member states;
- **Lack of Domestication** of ARIPO & other IP Treaties into the National Laws;
- **Limited knowledge & Information** relating to IP among the citizens of the Member States;
- **Limited Infrastructure** e.g. Communication, in the Region;
- Reduction of Perceptions that IP is too cumbersome and is therefore for the Rich, Developed Countries, etc.
Discussions
• Proposal for Accreditation of ARIPO Patent/Trademark Agents:
  – Why there is need for an Accreditation Process;
    • Too many mistakes in Applications & in the Prosecution of IP Rights at ARIPO: This causes a lot of delays;
    • Some Agents just act as Postboxes without adding value to applications;
    • Members of staff of ARIPO support Agents to a certain level but some raise Questions which are Obvious; - Time wasted!
  – How should it be undertaken?
    • Through an Examination Process? Or
    • Just a Registration Process;
    • What would be the most appropriate credentials?
  – Should Patent Agents at ARIPO also be both Lawyers & Engineers or scientists?
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