

1990 No. 1458

TRADE MARKS

The Register of Trade Mark Agents Rules 1990

<i>Made</i> - - - -	<i>18th July 1990</i>
<i>Laid before Parliament</i>	<i>23rd July 1990</i>
<i>Coming into force</i> -	<i>1st October 1990</i>

The Secretary of State, in exercise of the powers conferred upon him by section 282 of the Copyright, Designs and Patents Act 1988(a) and after consultation with the Council on Tribunals in accordance with section 10(1) of the Tribunals and Inquiries Act 1971(b), hereby makes the following Rules:-

Citation and commencement

1. These Rules may be cited as the Register of Trade Mark Agents Rules 1990 and shall come into force on 1st October 1990.

Interpretation

2. In these Rules, unless the context otherwise requires-

“the Comptroller” means the Comptroller-General of Patents, Designs and Trade Marks;

“the Institute” means the Institute of Trade Mark Agents;

“the register” means the register of trade mark agents required to be kept under these Rules, and “registered trade mark agent” means a trade mark agent whose name is entered in the register;

“the Registrar” means the person appointed in accordance with rule 7 below to maintain the register;

“trade mark agency work” means work done in the course of carrying on the business of acting as agent for others for the purpose of applying for or obtaining the registration of trade marks in the United Kingdom or of conducting proceedings before the Comptroller relating to applications for or otherwise in connection with the registration of trade marks;

“the United Kingdom” includes the Isle of Man.

The register

3. There shall be kept by the Institute a register, to be known as the register of trade mark agents, in which shall be entered the name of each person who is entitled to be registered pursuant to rule 10 below, together with his business address, the date of his registration, his qualifications, and such other particulars as the Registrar may, at the request of that person, think fit to include.

(a) 1988 c.48.

(b) 1971 c.62.

Special record

4. There shall also be kept by the Institute a special record and the Registrar shall transfer thereto the name and particulars of any person whose name has been erased under rule 12 or 13 or pursuant to a direction under rule 14 below and he shall enter therein, against such name, the reason for the erasure.

Inspection of register and special record

5. The register and the special record or, if they are kept otherwise than in documentary form, entries therein made available in documentary form, shall be open to public inspection at such times and in such manner as the Registrar may, subject to any general directions of the Comptroller under rule 21 below, direct.

Publication of list of registered trade mark agents

6. Not later than 1st April in each year the Institute shall cause to be printed, published and placed on sale a copy of the entries in the register (with the names arranged alphabetically) as at the end of the preceding calendar year.

The Registrar

7.—(1) There shall be a Registrar who shall be charged with the duty of maintaining the register and the special record in accordance with these Rules and who shall, subject thereto and to any general directions of the Comptroller under rule 21 below, be under the directions of the Institute.

(2) The Registrar shall be appointed by the Institute for a period of one year and shall on ceasing to hold office be eligible for reappointment. He shall hold and vacate his office in accordance with such terms and conditions as the Institute may, after consultation with the Comptroller, determine.

Qualifying examinations

8.—(1) The Institute may, by regulations made by it after consultation with the Chartered Institute of Patent Agents and with the approval of the Comptroller, make provision for such educational qualifications, training and qualifying examinations (which examinations shall be offered at least once in every year) as it considers appropriate for the registration of persons under these Rules and shall, subject to any such regulations and any general directions of the Comptroller under rule 21 below, have the entire management and control of such examinations.

(2) Any such regulations may make transitional provision for candidates who have, before the coming into force of the regulations, entered for any examinations held or to be held by the Institute for the purpose of admission to ordinary membership of the Institute to complete or take the same or part or parts thereof or such other examinations in lieu thereof within such time and subject to such conditions as may be specified.

Qualifications for registration

9.—(1) Subject to paragraph (2) below, each of the following persons shall qualify for registration under these Rules—

- (a) a person who has passed the qualifying examinations of the Institute and who has completed—
 - (i) not less than two years' full-time practice in the field of intellectual property, including substantial experience in trade mark agency work, under the supervision of either a registered trade mark agent or of a barrister, solicitor or, in Scotland or the Isle of Man, an advocate, being a registered Patent Agent, barrister, solicitor or advocate who is engaged in or has substantial experience of trade mark agency work in the United Kingdom, or
 - (ii) not less than four years' full-time practice in the field of intellectual property, including substantial experience in trade mark agency work in the United Kingdom;
- (b) a Fellow or an ordinary member of the Institute;

- (c) a person, being a registered patent agent, or barrister, solicitor, or in Scotland or the Isle of Man, an advocate, who has in the period of eight years immediately preceding the date he seeks to have his name entered in the register under rule 10 below completed a total of three years' practice in trade mark agency work;
- (d) a person who has in the period of eleven years immediately preceding the date he seeks to have his name entered in the register under rule 10 below completed a total of eight years of full-time practice in trade mark agency work; and
- (e) a person who passed in March 1990 the examination paper, entitled "Advanced Trade Marks Practice (T3)", set by the Chartered Institute of Patents Agents, and-
 - (i) becomes a registered patent agent before 31 December 1992, or
 - (ii) passes before 31 December 1991 a special advanced trade mark examination paper set by the Institute pursuant to any regulations made by it under rule 8 above.

(2) A person mentioned in sub-paragraph (b), (c) or (d) above shall not be entitled, by virtue of his qualification for registration thereunder, to have his name entered in the register under rule 10 below after the expiration of-

- (a) in the case of the person mentioned in sub-paragraph (b) above, the period of three years commencing from the operative date;
- (b) in the case of the person mentioned in sub-paragraph (c) above, the period of four years commencing from the operative date; and
- (c) in the case of the person mentioned in sub-paragraph (d) above, the period of two years commencing from the operative date.

(3) In this rule-

"the operative date" means the date of the coming into force of this rule; and

"registered patent agent" means a person whose name is entered in the register kept under rules made under section 275 of the Copyright, Designs and Patents Act 1988(a).

Entitlement to registration

10.—(1) Unless a direction under paragraph (3) below in relation to him is in force, a person who qualifies for registration under rule 9 above shall be entitled to have his name entered in the register on production to the Registrar of evidence that he qualifies for registration under that rule and on the payment of the fee prescribed by regulations under rule 20 below.

(2) The Registrar may, for the purpose of satisfying himself that a person has completed the requisite number of years of practice, require that person to submit to him a statutory declaration attesting to that fact and may require such further particulars of that practice as he may consider necessary.

(3) The Secretary of State may, upon being satisfied after due inquiry in accordance with rule 15 below that a person (who would otherwise be entitled to be registered) has been guilty of misconduct, direct that the name of that person shall not be registered, and upon such direction the Registrar shall not, except with the prior consent of the Secretary of State, register the name of that person.

Amendment of the register

11. A registered trade mark agent shall give notice to the Registrar of any change in the particulars relating to him entered in the register and the Registrar shall, on payment of the fee (if any) prescribed by regulations made under rule 20 below, amend the register accordingly.

Erasure of registration for failure to pay fee

12.—(1) If any registered trade mark agent fails to pay any annual practice fee that may be prescribed by regulations made under rule 20 below within one month from the day on which it becomes payable, the Registrar shall send to him at his business address

(a) 1988 c.48; see the Register of Patent Agents Rules 1990 (S.I. 1990/1457).

(as shown in the register) a notice requiring him to pay the fee on or before a day specified in the notice, and if that person fails to pay the fee on or before that date the Registrar may erase his name from the register.

(2) The name of a person erased from the register under this rule may be restored to it by direction of the Institute on payment by him of the fee or fees due from him, together with such further sum not exceeding the amount prescribed for the annual practice fee as the Institute may in each particular case direct.

Correction of entries in register

13.—(1) The Registrar may, upon being satisfied in accordance with paragraph (2) below that any entry in the register has been made in error or that any entry is incorrect, erase or correct the same.

(2) No erasure or correction of any entry in the Register shall be made under paragraph (1) above unless the Registrar has first served notice of the proposed erasure or correction on the person appearing to him to be affected, has afforded that person the opportunity to make written representations regarding the same and has taken into account any such representations.

Erasure of registration after due inquiry into misconduct

14. Where the Secretary of State is satisfied, after due inquiry in accordance with rule 15 below, that a person has been guilty of misconduct, that is to say, conduct discreditable to a registered trade mark agent, he may at his discretion, having regard to the circumstances of the misconduct, direct that the name of that person be erased from the register, and he may further direct that the name shall remain erased during such period as he may specify; and upon a direction under this rule the Registrar shall erase the name and particulars of that person from the register accordingly.

Inquiry by Secretary of State

15.—(1) Where it appears to the Secretary of State under rule 10(3) or rule 14 above that a person may have been guilty of misconduct he shall serve on that person (hereinafter referred to as the person affected) a notice—

- (a) informing him of the grounds on which it so appears to the Secretary of State and the substance of any allegations of misconduct made against him, and
- (b) inviting him to submit to the Secretary of State, within such period (being not less than 21 days) as may be specified in the notice, his representations in writing and requiring him to serve notice, if he wishes, of his intention to make oral representations.

(2) A copy of the notice served on the person affected under paragraph (1) above and a copy of any written representations submitted by him to the Secretary of State shall be served by the Secretary of State on the Institute.

(3) Where the person affected has served notice under paragraph (1)(b) above of his intentions to make oral representations, the Secretary of State shall give him not less than 21 days notice, or such shorter notice as the person affected may request or consent to accept, of the date, time and place at which his representations will be heard.

(4) If the Secretary of State considers that he should proceed with his inquiry but for a reason which differs or on grounds which differ from those set out in the notice served under paragraph (1) above he shall give a further notice under that paragraph.

Hearing of representations

16.—(1) At the hearing of oral representations held pursuant to rule 15(3) above the Secretary of State shall, at the request of the person affected, permit any other person (in addition to the person affected) to make representations on his behalf or to give evidence or to introduce documents for him.

(2) The Secretary of State shall not refuse to admit evidence solely on the grounds that it would not be admissible in a court of law.

(3) The hearing may be adjourned at the discretion of the Secretary of State and if

adjourned he shall give the person affected reasonable notice of the date, time and place at which the hearing is to be resumed.

(4) The Secretary of State shall inform the Institute of the date, time and place appointed for any hearing and the Institute shall be entitled to be represented at the hearing and to make submissions touching on the matters in issue.

Decision

17. The Secretary of State shall, in deciding whether to issue a direction, take into account any written or oral representations made in accordance with rules 15 and 16 above and shall—

- (a) if he decides not to issue a direction, give notice of that decision to the person affected, the Institute and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person (if known), but nothing in this rule shall require the Secretary of State to state the reasons for that decision;
- (b) if he decides to issue a direction, give notice of his decision, the terms thereof and his reasons for the decision to the person affected, the Institute and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person (if known).

Restoration of name to register

18.—(1) On an application made to him by a person whose name has been erased from the register under rule 14 above, the Secretary of State may, if he thinks fit, direct that the name of that person shall be restored to the register, and he may further direct that such restoration shall be made either without fee or on payment of such fee as he may fix not exceeding the fee prescribed by regulations made under rule 20 below for the registration of a name.

(2) The Registrar shall, upon a direction for the restoration of the name of a person under this rule, restore the name and particulars of that person to the register and shall, in the case of a person whose name has been erased for a specified period and in respect of whom no direction has been issued under this rule, restore his name and particulars upon the expiration of that period and upon payment of the fee prescribed by regulations made under rule 20 below for the registration of a name.

Appeal to Comptroller from decision of the Institute or Registrar

19.—(1) a person aggrieved by any decision of the Institute or the Registrar under these Rules may appeal to the Comptroller by serving on the Comptroller, within one month from the date of the decision, a notice of appeal, stating the grounds of appeal with a statement of his case in support thereof. A copy of the notice with a copy of the statement of case shall, at the same time, be served by that person (the appellant) on the Institute or the Registrar, as appropriate.

(2) The Comptroller shall, on receipt of the notice of appeal, give such directions as he thinks fit for the purpose of hearing the appeal and shall give the appellant and the Institute or the Registrar, as the case may be, not less than 14 days notice, or such shorter notice as the appellant and the Institute or Registrar may consent to accept, of the date, time and place appointed for the hearing of the appeal.

(3) At the hearing the Comptroller shall, at the request of any party, permit any other person (in addition to that party) to appear on his behalf.

(4) The Comptroller shall give his decision on the appeal in writing with a statement of his reasons and shall serve a copy thereof on the appellant and the Institute or Registrar.

(5) The Comptroller's decision on the appeal shall be final and for the purposes of giving effect to it he may give such directions to the Institute or Registrar as he thinks fit.

Fees

20.—(1) The Institute may, by regulations made by it with the approval of the Comptroller, prescribe the fees to be paid by—

- (a) every candidate for any examinations (or part or parts thereof) held in accordance with regulations made under rule 8 above,
- (b) every person for the registration of his name,
- (c) every registered trade mark agent as an annual practice fee,
- (d) a registered trade mark agent requesting an amendment of the register under rule 11 above,

and any such regulations may provide for the remission or refund of any fees in such circumstances as may be prescribed thereunder.

(2) When prescribing any fees for the purposes of paragraph (1)(a) above the Institute shall, as far as practicable, secure that the income therefrom does not exceed the expenditure properly incurred in administering any examinations, taking one year with another.

Directions by Comptroller

21. The Comptroller may from time to time give general directions to the Institute as to any matters relating to the register and in respect of such matters as in his opinion will be conducive to the better regulation of any examinations held by the Institute.

Report of the Institute

22. The Institute shall before 30th April in each year send to the Comptroller a report stating—

- (a) the number of applications for registration which were made in the preceding year and the number of registrations effected in that year;
- (b) the examinations which were held in that year and the results thereof;
- (c) the amount of the fees received by the Institute in that year; and
- (d) that rule 20(2) above has been complied with and showing, by reference to income and expenditure, its compliance with that rule;

and shall include in the report a statement on such other matters in relation to the provisions of these Rules (including any regulations made by the Institute pursuant thereto) as the Comptroller may from time to time require.

18th July 1990

Douglas Hogg
Minister of State,
Department of Trade and Industry

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules regulate the registration of persons who act as agents for others for the purpose of applying for or obtaining the registration of trade marks.

Rules 8, 9 and 10 make provision for qualifying examinations and qualifications for, and entitlement to, registration. Rule 8 empowers the Institute of Trade Mark Agents to make regulations for the qualifying examinations appropriate for registration and to have the entire management and control of such examinations.

Rules 14 to 17 relate to proceedings by the Secretary of State when inquiring into the misconduct of a person applying for registration or of a registered trade mark agent and

for the erasure from the register of the name of a person on the ground of misconduct. A person whose name has been erased from the register may apply to the Secretary of State for its restoration (rule 18), and a person aggrieved by a decision of the Institute or the Registrar under these Rules may appeal to the Comptroller (rule 19).

Rule 20 confers on the Institute power to make regulations with respect to the payment of examination, registration and annual practice fees. The Institute is required to secure, as far as practicable, that the income from examinations fees does not exceed the expenditure incurred in administering the examinations, taking one year with another (rule 20(2)).