



The Intellectual Property Profession – An International Comparison

An update of previous FICPI reviews by Peter Kirby (1987) and
Malcolm Royal (1994 and 2001) concerning registration
requirements, responsibilities and benefits afforded to
intellectual property practitioners

Contents

Executive Summary	3
Introduction	4
Countries Surveyed	5
CHAPTER 1: THE PATENT PROFESSION.....	6
Regulation of the Patent Profession	6
Qualifications Required	7
Legal Practitioners practising as Patent Attorneys / Patent Agents.....	10
Who can draft and amend patent specifications?	11
Who can represent patent applicants?.....	12
Requirements for Domestic Representation	13
Representation of a patentee in legal proceedings.....	15
Continuing Professional Development Requirements	16
Protection of communications between a patent attorney / agent and a client against forcible disclosure.....	17
Protection of communications between a Foreign patent attorney / agent and a client against forcible disclosure	19
CHAPTER 2: THE TRADE MARKS PROFESSION	20
Regulation of the Trade Marks Profession.....	20
Legal Practitioners practising as Trade Marks Attorneys	22
Who can represent Trade Mark Applicants?	23
Requirements for Domestic Representation	24
Representation of a Registered Trade Mark Owner in legal proceedings	26
CPD Requirements for Trade Mark Attorneys.....	27
Protection of communications between a Trade Mark Attorney / Agent and a Client against forcible disclosure.....	28
Protection of communications between a foreign trade mark attorney and a client against forcible disclosure.....	30
CHAPTER 3: THE DESIGNS PROFESSION.....	31
Regulation of the Designs Profession.....	31
Legal Practitioners practicing as Designs Attorneys/Agents	33
Who can represent Design Applicants?	34
Requirements for Domestic Representation	35
Representation of a Registered Design Owner in legal proceedings	37
Continuing Professional Development Requirements	38

Protection of communications between a Designs Attorney / Agent and a Client against forcible disclosure.....	39
Protection of communications between a Foreign Designs Attorney / Agent and a client against forcible disclosure	41
CHAPTER 4: THE ROLE OF IP OFFICES.....	42
Services Provided	42
Consultation with the Profession.....	43
Assistance to Unrepresented Applicants	44
Suggestions for IP Office Assistance to the Profession	45
Acknowledgement	46
Appendix A – Questionnaire Sample.....	47
Appendix B – Kirby Report 1987, Royal Report 1994, Royal Report 2001	48

Executive Summary

Professional intellectual property advisers are, in general, highly qualified and, in most countries, enjoy the right to practice under a protected title – usually Patent Attorney or Patent Agent. In some countries there are separate Trade Mark Attorney and Design Attorney designations for those IP practitioners that specialise in these fields. In order to practice as a patent attorney or patent agent, many countries require practitioners to hold a tertiary technical qualification, to complete a set of special examinations and to serve out a period of apprenticeship.

Despite continuing efforts to harmonise intellectual property laws there has been little progress in harmonising intellectual property practitioner registration requirements in the last 25 years. The objectives expressed in the FICPI Kirby Report of 1987 remain as pertinent today as they were at that time. In particular there are still several important industrialised countries which do not have a regulated profession and there are a number of different routes to registration in those countries that do regulate the profession. Continuing professional development is mandatory in some countries but it is far from the norm. Whilst communications between clients and professional IP advisers are protected against forcible disclosure in most countries when the IP adviser is locally based, such protection is still unavailable in many countries when the communication is with a foreign adviser.

It remains the case that in those countries that have the highest patenting activity the requirements to practice are the most stringent.

Introduction

The private (or free) profession of intellectual property practitioners has been regulated in most industrialised countries for more than a century. The qualifications required for a person to be registered as a patent attorney or patent agent differ from country to country and have, in general, become more stringent over time.

In 1888, the parliament in the UK enacted laws prohibiting unqualified persons from holding themselves out as patent agents with a view to “avoid the abuse of ill-qualified persons” providing intellectual property services to members of the public¹. Whilst this sentiment has been broadly supported in most countries of the world there continues to be significant variation in national requirements to practice as an intellectual property practitioner – some countries require no qualifications nor registration whilst others impose strict regimes of technical and legal qualifications for registration.

FICPI has for several years supported international harmonisation of the qualifications and regulations pertaining to intellectual property practitioners (recommendation I of the Kirby Report 1987) and has urged that these qualifications include technical, legal and practice based skills (recommendations III, IV and V of the Kirby Report). As succinctly stated by Thomas Blanco White in his authoritative work on English patent law in 1950 – “the drafting of specifications is no job for an amateur”.

FICPI investigated the intellectual property profession in twenty-eight countries in 1987 under the group led by Peter Kirby. This work was supplemented and updated on two separate occasions by Malcolm Royal, first in 1994 (extending the initial work to several South East Asian countries) and again in 2001, when 42 countries were surveyed.

For this report, a survey was sent to representatives of each country or region having a FICPI member (89). Responses were received from 61 countries and regions.

The data from this report is intended to assist in the formulation of FICPI policy. In particular it is intended to be used as part of a broader analysis of the importance and role of the private profession, being conducted by a group led by John Orange (Project Orange).

¹Patent Law and Practice, Vol 2, Frost, 1906

Countries Surveyed

The survey found in Appendix A was sent to FICPI representatives in 89 countries and regions.

58 representatives responded in time for the following countries and regions to be included in this report:

Territory	Response Received	Territory	Response Received
Algeria		Luxembourg	✓
Argentina	✓	Macau	✓
Australia	✓	Macedonia	✓
Austria	✓	Malaysia	✓
Bangladesh		Mexico	✓
Belarus, Republic of	✓	Monaco	✓
Belgium	✓	Morocco	
Brazil	✓	Myanmar	
Bulgaria	✓	Netherlands	
Cameroon		New Zealand	✓
Canada	✓	Nigeria	
Czech Republic	✓	Norway	✓
Chile	✓	Oman	
China	✓	Pakistan	
Chinese Taipei		Panama	
Columbia	✓	Paraguay	✓
Cyprus	✓	Peru	✓
Denmark	✓	Philippines	✓
Dominican Republic	✓	Poland	✓
Ecuador		Portugal	✓
Egypt		Qatar	
Estonia	✓	Romania	✓
EPO	✓	Russian Federation	
Finland	✓	Saudi Arabia	
France	✓	Serbia	✓
Germany	✓	Singapore	
Great Britain	✓	Slovakia	✓
Greece	✓	South Africa	✓
Haiti		South Korea	
Hong Kong	✓	Spain	✓
Hungary	✓	Sri Lanka	
Iceland	✓	Sweden	✓
India	✓	Switzerland	✓
Indonesia		Syria	✓
Iran	✓	Taiwan	✓
Ireland		Thailand	
Israel	✓	Tunisia	
Italy	✓	Turkey	✓
Japan	✓	Ukraine	✓
Jersey		United Arab Emirates	
Jordan	✓	United States of America	✓
Kenya		Uruguay	
Latvia		Venezuela	✓
Lebanon		Vietnam	
Lithuania	✓		

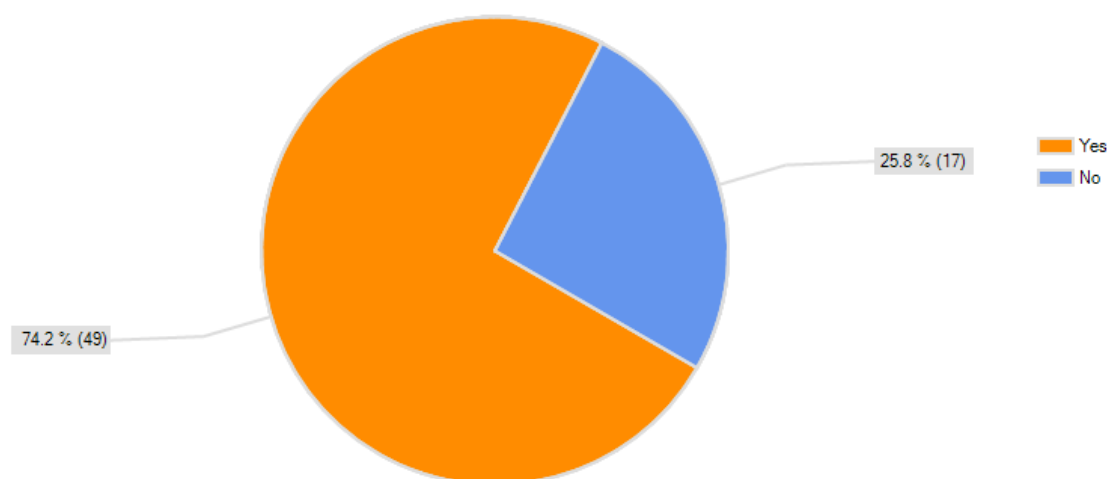
For those countries where no response was received, prior information from the reports of Peter Kirby and Malcolm Royal was used where available and applicable.

CHAPTER 1: THE PATENT PROFESSION

Regulation of the Patent Profession

In 49 of the countries surveyed the intellectual property profession is regulated by the government or a professional association.

Does the government or a professional association regulate the intellectual property profession in your country to determine who can use the title of "patent attorney" (or other relevant title in your jurisdiction)?



Response	Response Count
Yes	49
No	17

Countries with government or professional association regulation: Argentina, Australia, Austria, Republic of Belarus, Belgium, Brazil, Bulgaria, Canada, China, Czech Republic, Cyprus, Estonia, EPO, Finland, France, Germany, Great Britain, Hungary, India, Indonesia*, Ireland*, Israel, Italy, Japan, Lithuania, Luxembourg, Macedonia, Malaysia, the Netherlands*, New Zealand, Pakistan*, Poland, Portugal, Romania, Serbia, Singapore*, Slovakia, South Africa, South Korea*, Spain, Sweden, Switzerland, Taiwan, Thailand*, Turkey, Ukraine, United States of America, Venezuela and Vietnam.

* Data not confirmed by current survey – acquired from previous surveys.

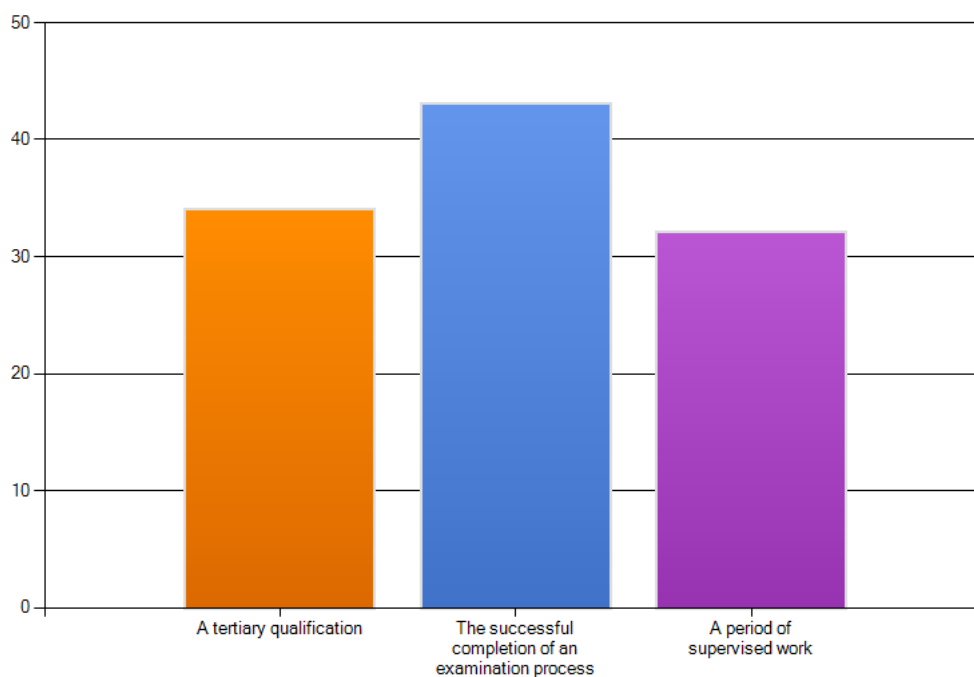
A notable addition to this list is Switzerland which introduced a protected title for Patent Attorneys under a regulated system on 1 July 2011. Prior to that time the profession in Switzerland had been unregulated.

Countries without government or professional association regulation: Chile, Columbia, Denmark, Dominican Republic, Greece, Hong Kong, Iceland, Iran, Jordan, Macau, Mexico, Monaco, Norway, Paraguay, Peru, Philippines and Syria.

Qualifications Required

Of the 52 countries and regions surveyed that have a regulated intellectual property profession 49 of these require some form of skill demonstration (either through a tertiary qualification, the completion of an examination process or the completion of a period of supervised work) before being permitted to use a protected title such as patent attorney. Of these 52 countries or regions, 23 require skills demonstration in each of the three categories.

What qualifications are required to use the title of patent attorney (or other relevant term in your jurisdiction)? Please tick more than one, if appropriate.



Response	Response Count
Tertiary qualification	34
Examination process	43
Supervised work	32

Summary of qualifications required in countries where the patent profession is regulated:

Answer Options	A tertiary qualification	The successful completion of an examination process	A period of supervised work
Argentina		✓	
Australia	✓	✓	✓
Austria	✓	✓	✓
Belarus, Republic of	✓	✓	✓
Belgium		✓	
Brazil		✓	
Bulgaria	✓	✓	✓

Canada		✓	✓
China	✓	✓	✓
Cyprus	✓		
Czech Republic		✓	
Estonia	✓	✓	✓
EPO	✓	✓	✓
Finland	✓		✓
France	✓	✓	✓
Germany	✓	✓	✓
Great Britain	✓	✓	✓
Hungary	✓	✓	✓
India	✓	✓	
Indonesia*	✓		✓
Ireland*		✓	✓
Israel	✓	✓	✓
Italy	✓	✓	✓
Japan		✓	
Lithuania	✓	✓	✓
Luxembourg		✓	✓
Macedonia	✓		
Malaysia	✓	✓	
Netherlands*	✓	✓	✓
New Zealand		✓	✓
Pakistan*	✓		✓
Poland	✓	✓	✓
Portugal	✓	✓	
Romania		✓	
Serbia	✓	✓	✓
Singapore*	✓	✓	✓
Slovakia		✓	
South Africa	✓	✓	✓
South Korea*		✓	✓
Spain		✓	
Sweden	✓	✓	
Switzerland	✓	✓	✓
Taiwan		✓	✓
Thailand*	✓	✓	✓
Turkey		✓	
Ukraine	✓	✓	✓
United States of America	✓	✓	
Venezuela	✓		
Vietnam*	✓	✓	✓

* Data not confirmed by current survey – acquired from previous surveys.

Type of tertiary qualification required by country:

Any tertiary degree: Czech Republic, Estonia.

Technical degree only: Australia, Austria, Republic of Belarus, Belgium, China, EPO, Finland, Germany, Great Britain, Hungary, India, Italy, Israel, Netherlands, Switzerland, Sweden, United States of America (patent agent).

Technical or legal degree: Lithuania, Malaysia.

Law degree only: Cyprus, Indonesia, Philippines.

Intellectual property degree: Ukraine.

Technical and law degree: France, South Africa, United States of America (patent attorney).

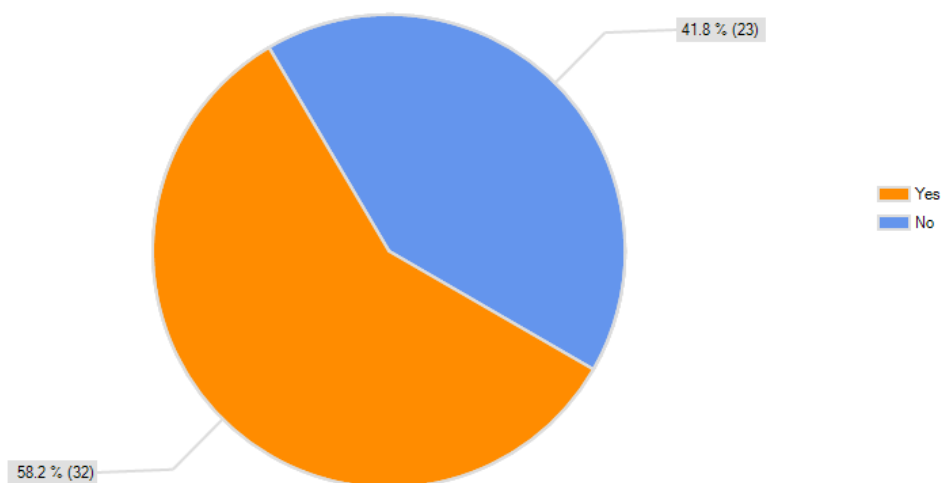
Law or economics degree: Venezuela.

Engineering, law or economics degree: Portugal.

Legal Practitioners practising as Patent Attorneys / Patent Agents

Of the countries surveyed 32 permit qualified legal practitioners to practice as patent practitioners without obtaining further qualifications.

Can a lawyer also practice as a patent attorney without obtaining the qualifications set out in the previous question?



Response	Response Count
Yes	32
No	23

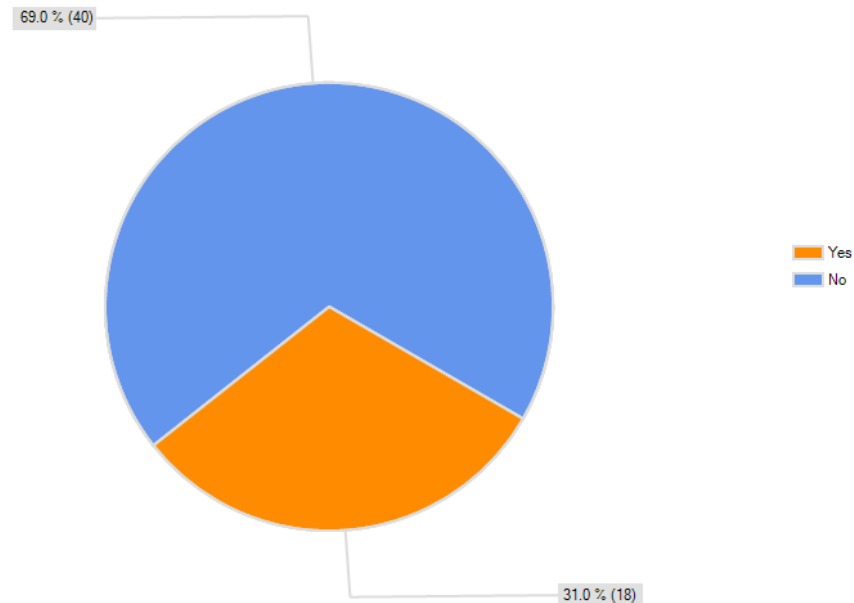
Countries where a lawyer can practice as a patent attorney without obtaining further qualifications: Austria, Belgium, Bulgaria, Czech Republic, Chile, Columbia, Cyprus, Denmark, France, Germany, Great Britain, Hong Kong, India, Iran, Israel, Italy, Jordan, Luxembourg, Macau, Mexico, Monaco, Norway, Peru, Portugal, Serbia, Slovakia, Spain, Sweden, Switzerland, Syria, Taiwan, Venezuela.

Countries where a lawyer cannot practice as a patent attorney without obtaining further qualifications: Argentina, Australia, Republic of Belarus, Brazil, Canada, China, Dominican Republic, EPO, Estonia, Finland, Greece, Hungary, Japan, Macedonia, Malaysia, New Zealand, Paraguay, Poland, Romania, South Africa, Turkey, Ukraine, United States of America.

Who can draft and amend patent specifications?

Of the countries surveyed 18 place restrictions on who (apart from the applicant) can draft or amend a patent specification.

Are there restrictions on who can draft a patent specification or amend a patent specification in your country?



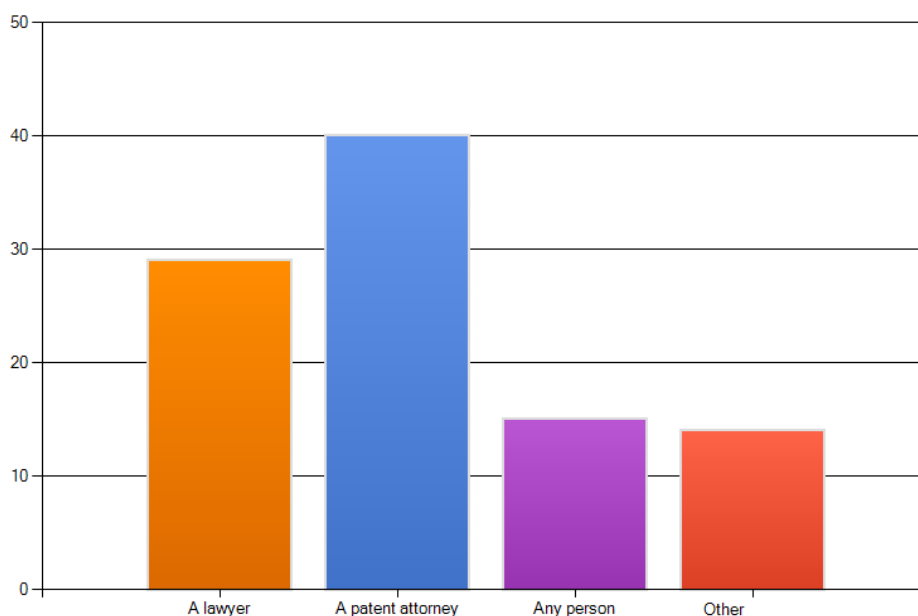
Response	Response Count
Yes	18
No	40

Those countries which place restrictions on who may draft or amend a patent specification: Australia, Austria, Belgium, Brazil, Canada, Cyprus, EPO, France, Germany, Great Britain, India, Israel, Lithuania, Luxembourg, New Zealand, South Africa, Ukraine, United States of America.

Who can represent patent applicants?

Leaving aside applicant self representation, of those countries surveyed there were 18 that limited patent applicant representation to patent attorneys or patent agents. There were 4 countries that required legal representation and 15 countries that required either legal or patent attorney/agent representation

Who is permitted to represent a patent applicant before the Patent Office in your country? Please tick more than one, if appropriate.



Representation of Patent Applicants

Response	Response Count
A lawyer	29
A patent attorney	40
Any person	15
Other	14

Patent Attorneys / Patent Agents Only: Australia, Belgium, Brazil, Canada, China, Finland, Japan, Lithuania, Macedonia, Malaysia, New Zealand, Paraguay, Poland, Romania, South Africa, Spain, Turkey, Ukraine

Patent Attorneys or Lawyers: Bulgaria, Czech Republic, France, Germany, Great Britain, Hungary, India, Israel, Italy, Jordan, Luxembourg, Portugal, Serbia, Slovakia, Taiwan

Any person: Argentina, Republic of Belarus, Chile, Cyprus, Denmark, Dominican Republic, Estonia, Hong Kong, Iceland, Iran, Macau, Mexico, Monaco, Norway, Sweden, Switzerland

Lawyers only: Columbia, Greece, Philippines, Syria

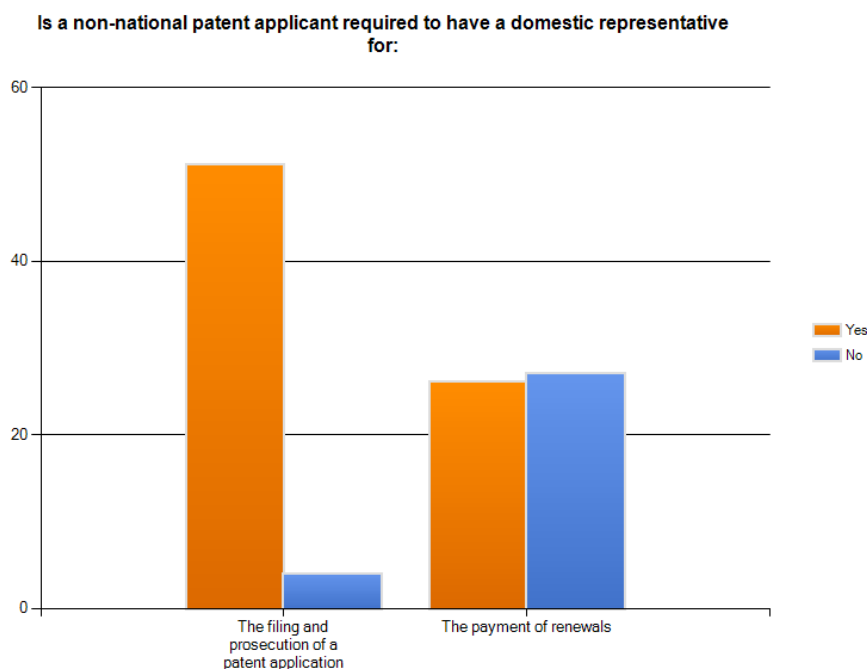
Lawyers or Economists: Venezuela

Patent Attorneys / Agents, Lawyers or Notaries: Austria

Patent Attorneys or Patent Agents only: United States of America (where patent attorneys are also lawyers whereas patent agents are not).

Requirements for Domestic Representation

Of the countries surveyed 51 require a non-national patent applicant to have a domestic representative for the filing and prosecution of a patent application. 27 require a non-national patent applicant to have a domestic representative for the payment of renewals.



Domestic Representation

Question	Yes	No
The filing and prosecution of a patent application	51	4
The payment of renewals	26	27

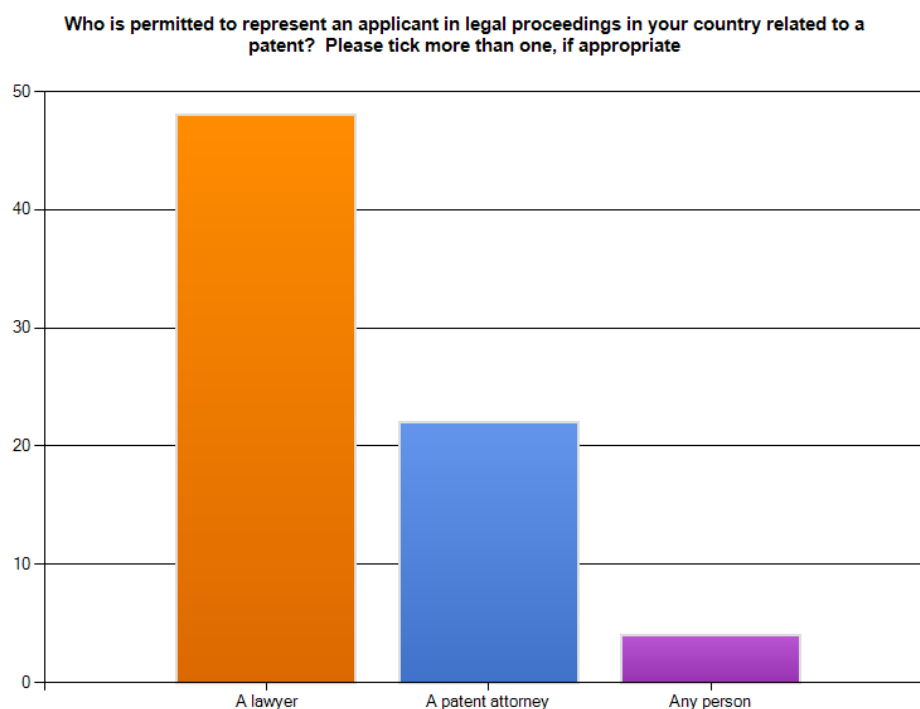
Domestic representation requirements by country:

	Filing and Prosecuting		Payment of Renewals	
	Yes	No	Yes	No
Argentina	✓		✓	
Australia	✓			✓
Austria	✓			
Belarus, Republic of	✓		✓	
Belgium	✓			✓
Brazil	✓			✓
Bulgaria	✓		✓	
Canada	✓		✓	
Chile	✓		✓	

China	✓		✓	
Czech Republic	✓			✓
Columbia	✓		✓	
Cyprus	✓		✓	
Denmark		✓		✓
Dominican Republic	✓		✓	
Estonia	✓		✓	✓
Finland	✓	✓		✓
France	✓			✓
Germany	✓			✓
Great Britain	✓			✓
Greece	✓			✓
Hong Kong	✓			✓
Hungary	✓			✓
Iceland	✓			✓
India	✓		✓	
Iran	✓			
Israel	✓		✓	
Italy	✓			✓
Japan	✓			✓
Jordan	✓		✓	
Lithuania	✓			✓
Luxembourg	✓			✓
Macau	✓		✓	✓
Macedonia	✓		✓	
Malaysia	✓		✓	
Mexico	✓		✓	
Monaco	✓			✓
New Zealand	✓			✓
Norway		✓		✓
Paraguay	✓		✓	
Philippines	✓		✓	
Poland	✓		✓	
Romania	✓			✓
Serbia		✓		✓
Slovakia	✓			✓
South Africa	✓		✓	
Spain	✓		✓	
Sweden	✓			✓
Switzerland		✓		✓
Syria	✓		✓	
Taiwan	✓		✓	
Turkey	✓		✓	
Ukraine	✓		✓	
United States of America	✓			✓
Venezuela	✓		✓	

Representation of a patentee in legal proceedings

Of the countries surveyed 21 permit patent attorneys (who are not also lawyers) to appear on behalf of a patentee in legal proceedings related to a patent. Those countries are Austria, Belarus, Czech Republic, China, Estonia, Germany, Great Britain, Hong Kong, Hungary, Israel, Japan, Luxembourg, Macedonia, Paraguay, Poland, Romania, Serbia, Slovakia, South Africa, Taiwan and the Ukraine. In the United States of America a patent attorney can appear on behalf of a patentee in legal proceedings relating to a patent. Patent Attorneys in the United States of America are also lawyers. Further details concerning legal proceedings representation is set out below:

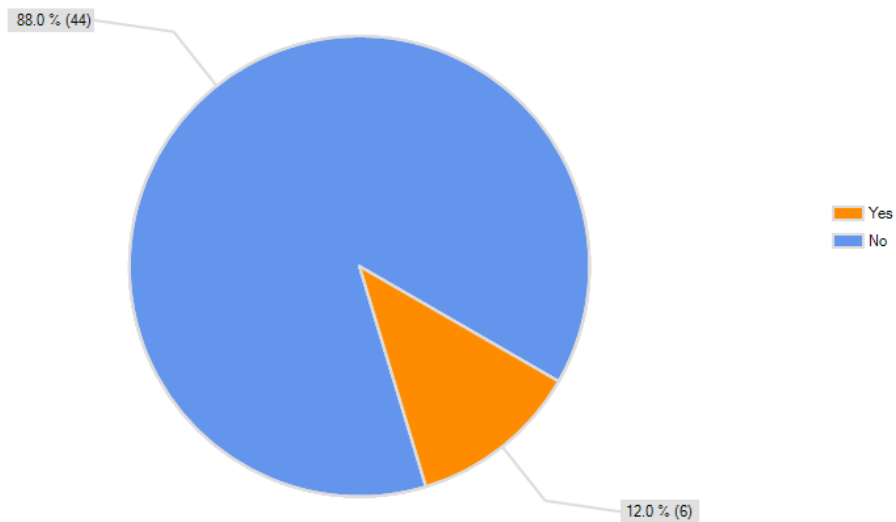


Response	Response Count
A lawyer	48
A patent attorney	22
Any person	4

Continuing Professional Development Requirements

Of the countries surveyed, 6 require continuing professional development for maintaining registration as a patent attorney or patent agent.

Once registered as a patent attorney, are there any continuing professional requirements for maintaining the registration?



Continuing Professional Development Requirements

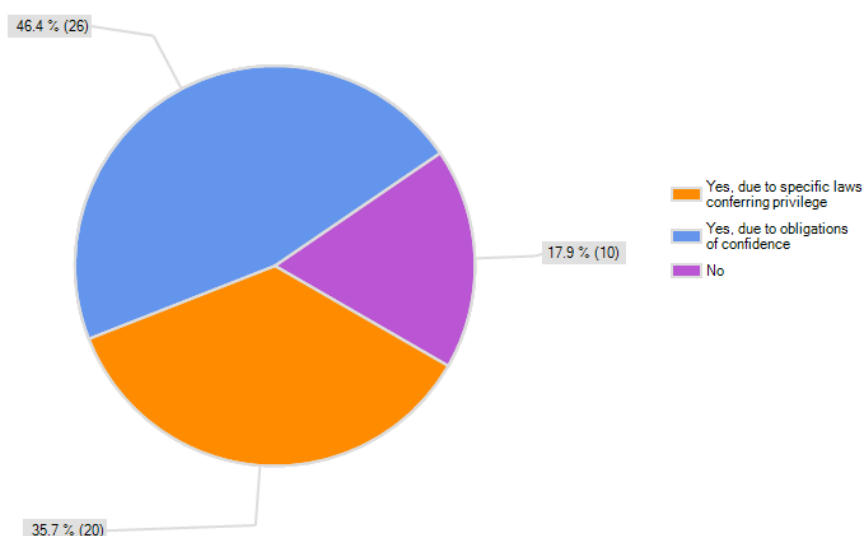
Response	Response Count
Yes	6
No	44

The 6 countries identified as imposing CPD requirements were: Australia, Austria, China, Japan, Paraguay and Poland.

Protection of communications between a patent attorney / agent and a client against forcible disclosure

Of the countries surveyed, there were 46 in which communications between a patent attorney or patent agent of the country and a client are protected against forcible disclosure in the patent attorney or patent agent's country.

Are communications between a patent attorney of your country and a client the subject of privilege or protected against forcible disclosure?



Protection of Client Communications

Response	Response Count
Yes, due to specific laws conferring privilege	20
Yes, due to obligations of confidence	26
No	10

Summary of Results by Country:

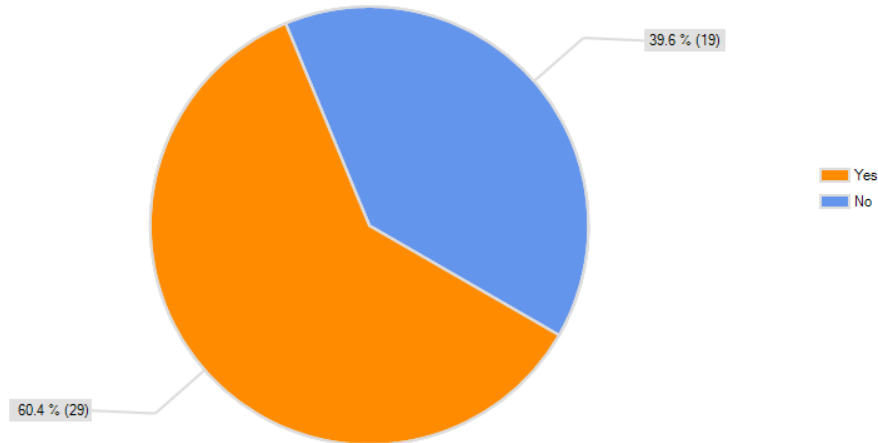
Answer Options	Yes, due to specific laws conferring privilege	Yes, due to obligations of confidence	No
Argentina		✓	
Australia	✓		
Austria		✓	
Belarus, Republic of		✓	
Belgium		✓	
Brazil			✓
Bulgaria	✓		
Canada			✓
Chile		✓	

China			✓
Colombia		✓	
Czech Republic		✓	
Cyprus	✓		
Denmark			✓
Dominican Republic		✓	
Estonia		✓	
Finland			✓
France	✓		
Germany	✓		
Great Britain	✓		
Greece		✓	
Hong Kong		✓	
Hungary	✓		
Iceland			✓
India	✓		
Iran			✓
Israel		✓	
Italy		✓	
Japan	✓		
Jordan		✓	
Lithuania			✓
Luxembourg	✓		
Macau	✓		
Macedonia		✓	
Malaysia		✓	
Mexico			✓
Monaco		✓	
New Zealand	✓		
Norway			✓
Paraguay		✓	
Philippines		✓	
Poland		✓	
Portugal		✓	
Romania		✓	
Serbia		✓	
Slovakia	✓		
South Africa	✓		
Spain		✓	
Sweden	✓		
Switzerland	✓		
Syria	✓		
Taiwan	✓		
Turkey		✓	
Ukraine		✓	
United States of America	✓		
Venezuela	✓		

Protection of communications between a Foreign patent attorney / agent and a client against forcible disclosure

Of the countries surveyed there were 29 in which communications between a patent attorney of another country and a client were protected against forcible disclosure.

Are communications between a patent attorney in another country and a client privileged or protected against forcible disclosure in your country?



Protection of Client Communications (Non-National Patent Attorney/Agent)

Response	Response Count
Yes	29
No	19

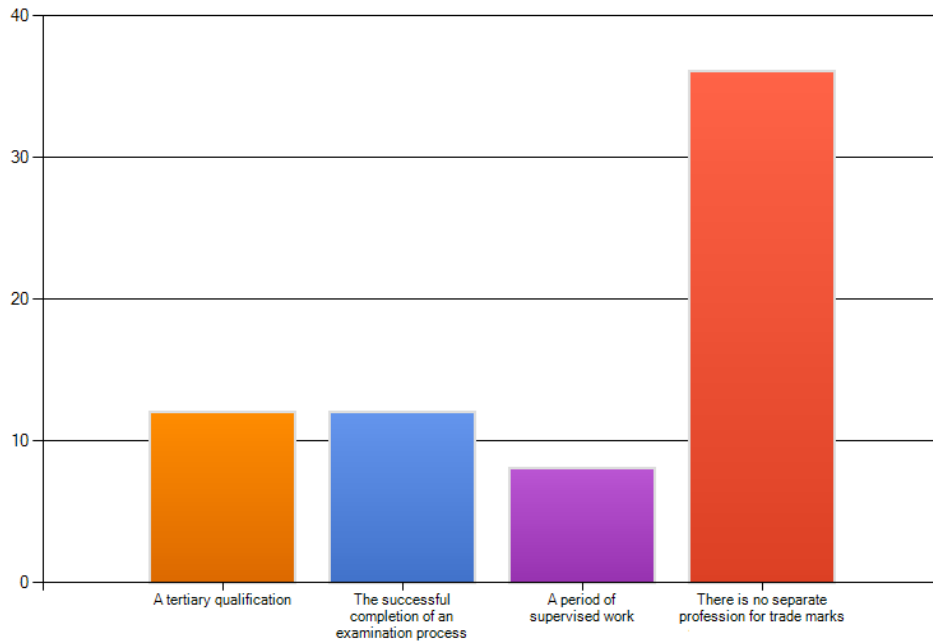
Countries in which communications between a client and a patent attorney (or a patent agent) of a different country are not protected against forcible disclosure: Argentina, Australia (soon to change), Brazil, Chile, China, Denmark, Finland, Iceland, India, Iran, Lithuania, Malaysia, Mexico, Norway, Paraguay, Poland, Portugal, Slovakia, Switzerland, United States of America (variable).

CHAPTER 2: THE TRADE MARKS PROFESSION

Regulation of the Trade Marks Profession

Of the countries surveyed 17 countries recognise a separate profession for trade mark practitioners. These countries are Australia, Belgium, Bulgaria, Canada, the Czech Republic, Cyprus, Estonia, France, Italy, Macedonia, Malaysia, Paraguay, Romania, Serbia, South Africa, Turkey and Venezuela.

If there is a separate profession for trade marks, what qualifications are required to use the title of trade mark attorney / agent? Please tick more than one, if appropriate.



Response	Response Count
Tertiary qualification	12
Examination process	12
Supervised work	8
No Separate Profession	36

Summary of results by country:

Answer Options	A tertiary qualification	The successful completion of an examination process	A period of supervised work	There is no separate profession for trade marks
Argentina				✓
Australia	✓	✓		
Austria				✓
Belarus, Republic of				✓
Belgium	✓		✓	
Brazil				✓
Bulgaria	✓	✓	✓	
Canada		✓		
Chile				✓
China				✓

Cyprus	✓			
Czech Republic		✓		
Denmark				✓
Dominican Republic				✓
Estonia	✓	✓	✓	
Finland				✓
France	✓	✓	✓	
Germany				✓
Greece				✓
Hong Kong				✓
Hungary				✓
Iceland				✓
India				✓
Iran				✓
Israel				✓
Italy	✓	✓	✓	
Japan				✓
Jordan				✓
Lithuania				✓
Luxembourg				✓
Macau				✓
Macedonia		✓		
Malaysia	✓		✓	
Mexico				✓
Monaco				✓
New Zealand				✓
Norway				✓
Paraguay	✓			
Philippines				✓
Poland				✓
Portugal				✓
Romania		✓		
Serbia	✓	✓	✓	
Slovakia				✓
South Africa	✓	✓	✓	
Spain				✓
Switzerland				✓
Syria				✓
Taiwan				✓
Turkey		✓		
Ukraine				✓
United States of America				✓
Venezuela	✓			

Type of tertiary qualification to register as a Trade Marks Attorney by country:

Any tertiary degree: Italy (or equivalent diploma), Australia, Belgium, Bulgaria, Malaysia, Estonia, France, Paraguay, Serbia

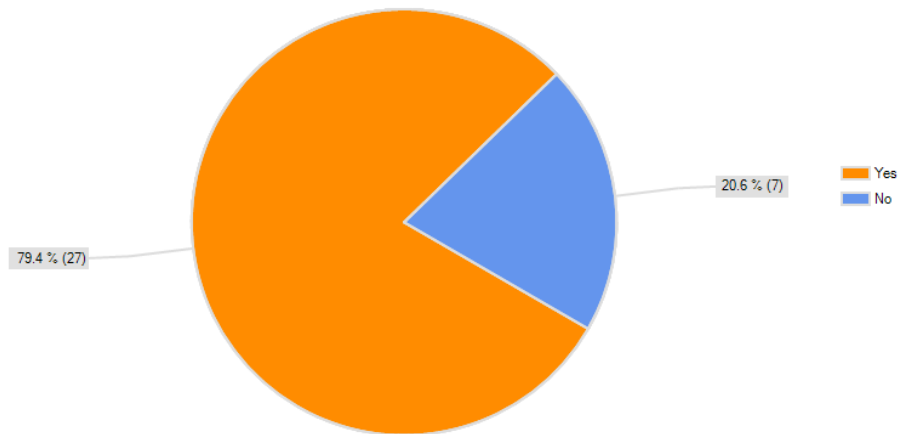
Law degree only: South Africa

Law or Economics: Venezuela

Legal Practitioners practising as Trade Marks Attorneys

Of the countries surveyed 27 were identified in which a lawyer is entitled to practice as a trade marks practitioner without obtaining additional qualifications.

Can a lawyer also practice as a trade mark attorney without obtaining the qualifications set out in the previous question?



Response	Response Count
Yes	27
No	7

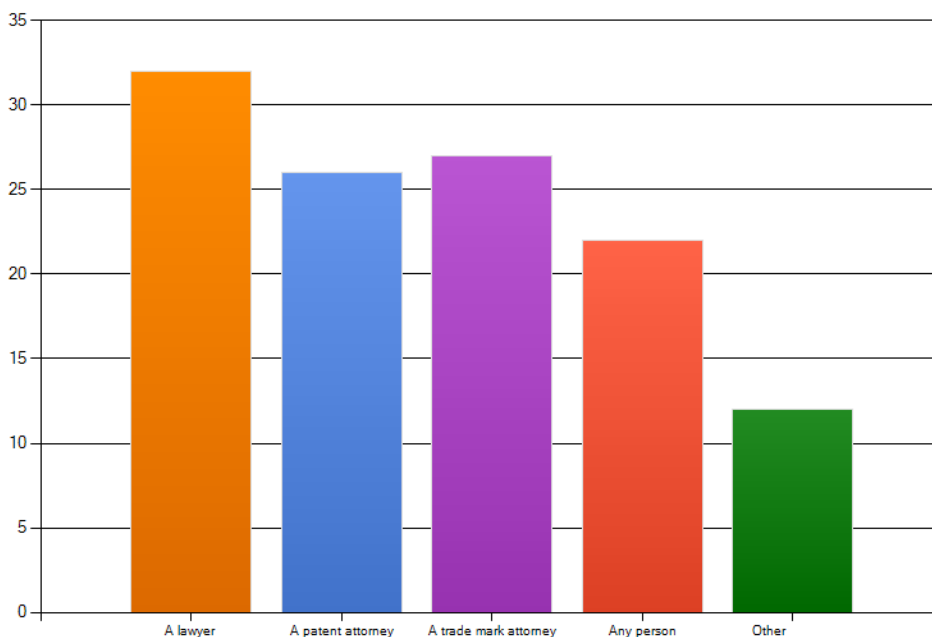
Countries where a lawyer can practice as a trade marks attorney without obtaining further qualifications: Australia, Austria, Belgium, Bulgaria, Canada, Czech Republic, China, Columbia, Cyprus, France, Germany, Great Britain, Hong Kong, Hungary, Iran, Israel, Italy, Malaysia, Mexico, Norway, Philippines, Serbia, South Africa, Sweden, Switzerland, Taiwan, Venezuela.

Countries where a lawyer cannot practice as a trade marks attorney without obtaining further qualifications: Estonia, Macedonia, Paraguay, Poland, Romania, Turkey, Ukraine.

Who can represent Trade Mark Applicants?

Leaving aside applicant self representation, of those countries surveyed there were 9 that limited representation to patent and trade mark attorneys. There were 6 countries that required legal representation and 15 that required either legal or patent or trade mark attorney representation.

Who is permitted to represent a trade mark applicant before the Trade Marks Office in your country? Please tick more than one, if appropriate.



Response	Response Count
A lawyer	32
A patent attorney	26
A trade mark attorney	27
Any person	22

Patent Attorneys / Agents or Trade Mark Attorneys only: Brazil, Japan, Macedonia, Malaysia, Paraguay, Poland, Romania, Turkey, Ukraine

Patent Attorneys / Agents or Trade Mark Attorneys or Lawyers only: Bulgaria, Canada, Czech Republic, Estonia, France, Germany, Hungary, Israel, Italy, Jordan, Serbia, Slovakia, South Africa, Spain, Syria

Any Person: Argentina, Australia, Republic of Belarus, Belgium, Chile, China, Denmark, Dominican Republic, Finland, Hong Kong, Iceland, Iran, Luxembourg, Macau, Mexico, Monaco, New Zealand, Norway, Portugal, Sweden, Switzerland, Taiwan

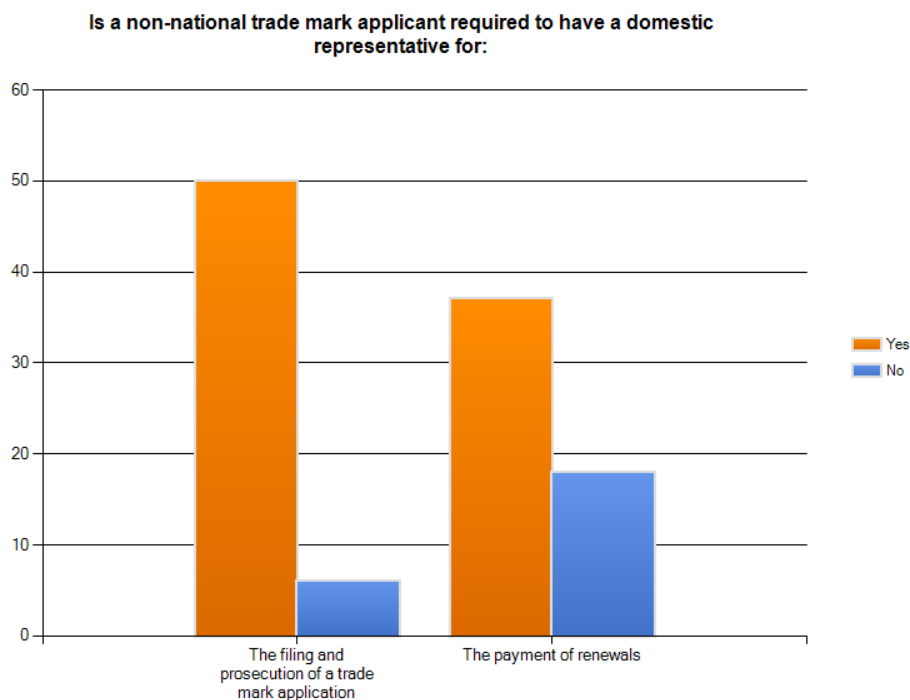
Lawyers only: Columbia, Greece, India, Cyprus, Philippines, United States of America (where all patent attorneys are lawyers)

Lawyers or Economists (registered as IP agent): Venezuela

Patent Attorneys / Agents, Lawyers or Notaries: Austria

Requirements for Domestic Representation

Of those countries surveyed 50 require a non-national trade mark applicant to have a domestic representative for the filing and prosecution of a trade mark application and 37 require a non-national trade mark applicant to have a domestic representative for the payment of renewals.



Domestic Representation

Question	Yes	No
The filing and prosecution of a trade mark application	50	6
The payment of renewals	37	18

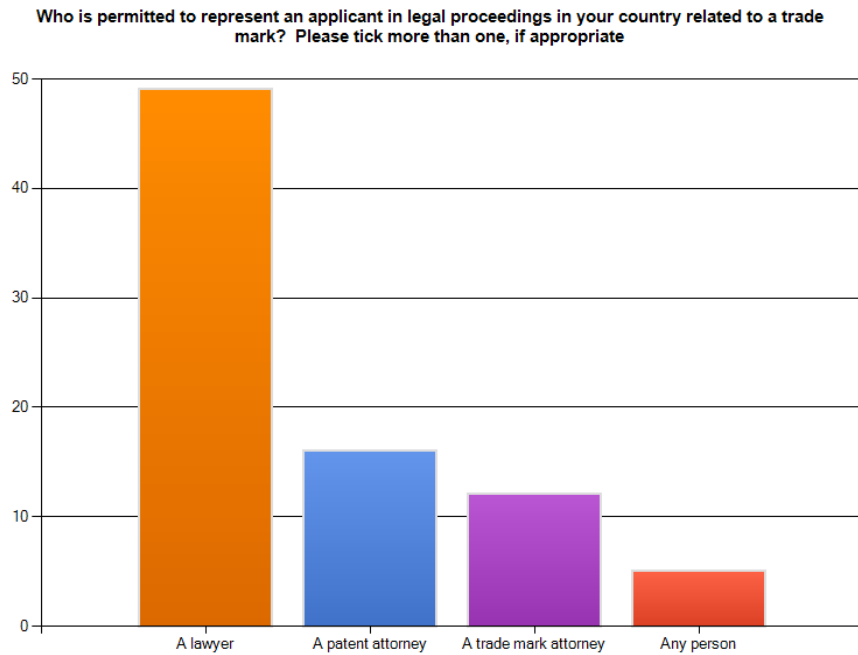
Domestic representation requirements by country:

	Filing and Prosecuting		Payment of Renewals	
	Yes	No	Yes	No
Argentina	✓		✓	
Australia		✓		✓
Austria	✓			✓
Belarus, Republic of	✓		✓	
Belgium		✓		✓
Brazil	✓		✓	
Bulgaria	✓		✓	

Canada	✓		✓	
Chile	✓		✓	
China	✓		✓	
Czech Republic	✓			✓
Columbia	✓		✓	
Cyprus	✓		✓	
Denmark		✓		✓
Dominican Republic	✓		✓	
Estonia	✓		✓	
Finland	✓			✓
France	✓			✓
Germany	✓			✓
Great Britain	✓			✓
Greece		✓		✓
Hong Kong	✓		✓	
Hungary	✓			✓
Iceland	✓		✓	
India	✓		✓	
Iran	✓		✓	
Israel	✓		✓	
Italy	✓		✓	
Japan	✓			✓
Jordan	✓		✓	
Lithuania	✓		✓	
Luxembourg	✓			
Macau	✓		✓	
Macedonia	✓		✓	
Malaysia	✓		✓	
Mexico	✓		✓	
Monaco	✓		✓	
New Zealand	✓			✓
Norway		✓		✓
Paraguay	✓		✓	
Philippines	✓		✓	
Poland	✓		✓	
Portugal		✓		✓
Romania	✓		✓	
Serbia	✓		✓	
Slovakia	✓		✓	
South Africa	✓		✓	
Spain	✓		✓	
Sweden	✓			✓
Switzerland	✓			✓
Syria	✓		✓	
Taiwan	✓		✓	
Turkey	✓		✓	
Ukraine	✓		✓	
United States of America	✓			✓
Venezuela	✓		✓	

Representation of a Registered Trade Mark Owner in legal proceedings

Of the countries surveyed 20 countries allow either patent attorneys / agents or trade mark attorneys who are not lawyers to represent trade mark owners in legal proceedings related to a trade mark. These are Austria, the Republic of Belarus, the Czech Republic, China, Estonia, Germany, Great Britain, Hungary, Iran, Japan, Macedonia, Paraguay, Poland, Romania, Serbia, Slovakia, South Africa, Spain, Taiwan and Ukraine.

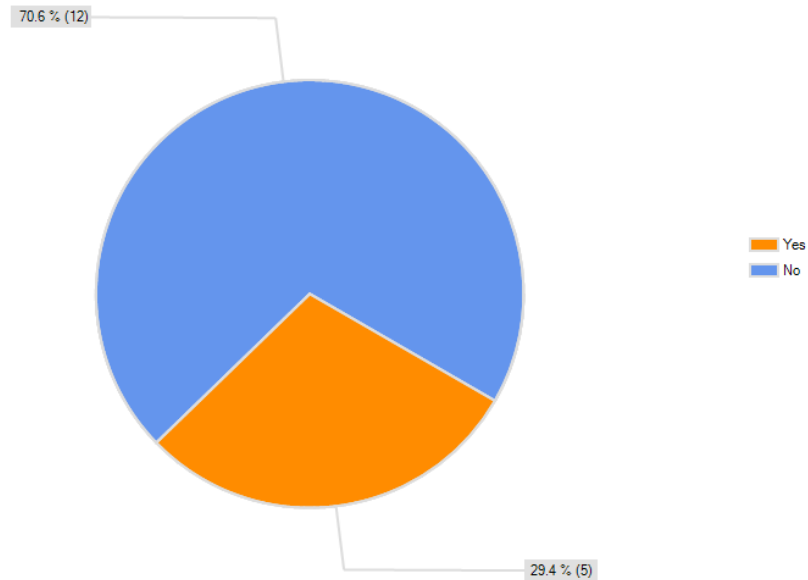


Response	Response Count
A lawyer	49
A patent attorney	16
A trade mark attorney	12
Any person	5

CPD Requirements for Trade Mark Attorneys

Of the countries surveyed, only 5 required practitioners to complete continuing professional development for maintaining registration as a trade mark practitioner.

Once registered as a trade mark attorney, are there any continuing professional requirements for maintaining the registration?



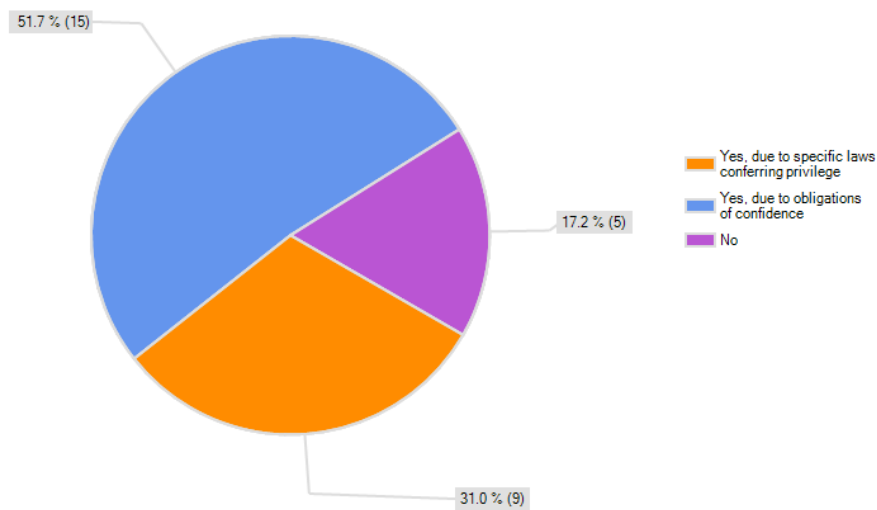
Response	Response Count
Yes	5
No	12

Continuing education requirements for trade mark attorneys: Australia, Bulgaria, Italy, Malaysia, Paraguay.

Protection of communications between a Trade Mark Attorney / Agent and a Client against forcible disclosure

Of the countries surveyed, there were 24 in which communications between a trade mark attorney of the country and a client are protected against forcible disclosure in the trade mark attorney's country.

Are communications between a trade mark attorney of your country and a client the subject of privilege or protected against forcible disclosure?



Response	Response Count
Yes, due to specific laws conferring privilege	9
Yes, due to obligations of confidence	15
No	5

Summary of Results by Country:

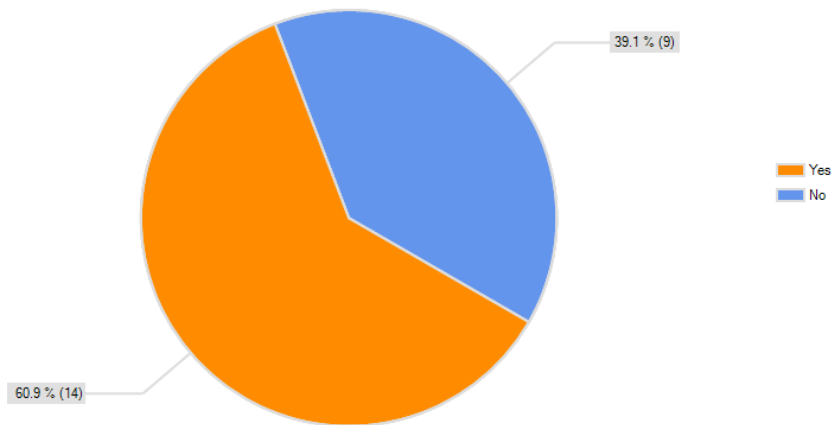
Answer Options	Yes, due to specific laws conferring privilege	Yes, due to obligations of confidence	No
Australia	✓		
Belgium		✓	
Bulgaria	✓		
Canada			✓
China			✓
Columbia		✓	
Czech Republic		✓	
Cyprus	✓		
Estonia		✓	
France	✓		

Hong Kong		✓	
Hungary	✓		
Iran			✓
Israel		✓	
Italy		✓	
Macedonia		✓	
Malaysia		✓	
Norway			✓
Paraguay		✓	
Philippines	✓		
Romania		✓	
Serbia		✓	
South Africa	✓		
Sweden			✓
Switzerland	✓		
Taiwan		✓	
Turkey		✓	
Ukraine		✓	
Venezuela	✓		

Protection of communications between a foreign trade mark attorney and a client against forcible disclosure

Of the countries surveyed there were 14 in which communications between a trade mark attorney of another country and a client were protected against forcible disclosure

Are communications between a trade mark attorney in another country and a client privileged or protected against forcible disclosure in your country?



Response	Response Count
Yes	14
No	9

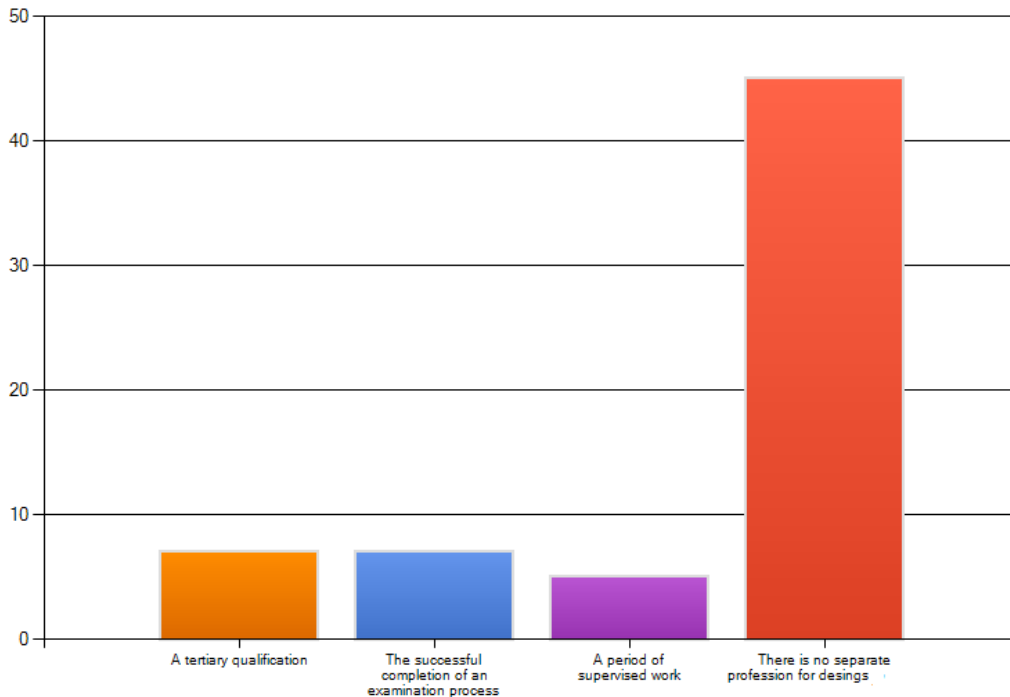
Countries in which communications between a client and a trade mark attorney of a different country are not protected against forcible disclosure: Australia (soon to change), China, Iran, Malaysia, Norway, Paraguay, Romania, Sweden, Switzerland.

CHAPTER 3: THE DESIGNS PROFESSION

Regulation of the Designs Profession

Of the countries surveyed only 10 recognise a separate designs profession. These are Bulgaria, China, Estonia, France, Macedonia, Malaysia, Paraguay, Romania, Serbia and Venezuela.

If there is a separate profession for designs, what qualifications are required to use the title of a designs attorney / agent? Please tick more than one, if appropriate.



Response	Response Count
Tertiary qualification	7
Examination process	7
Supervised work	5
No separate profession for designs	45

Summary of answers by country

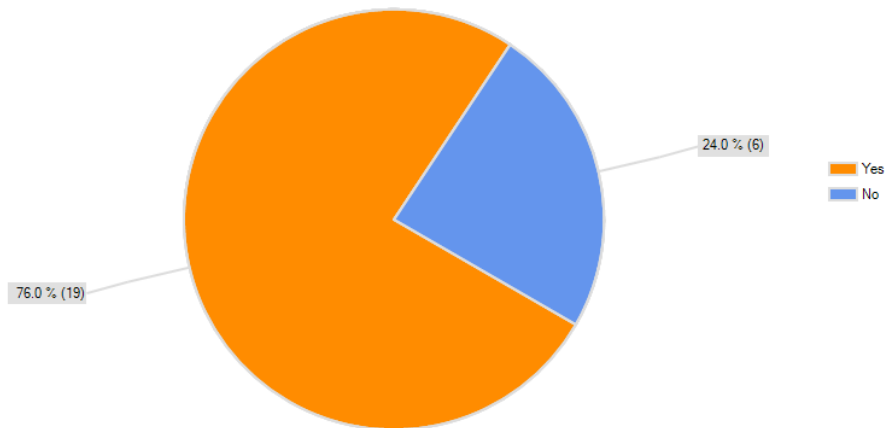
Answer Options	A tertiary qualification	The successful completion of an examination process	A period of supervised work	There is no separate profession for designs
Argentina				✓
Australia				✓
Austria				✓
Belarus, Republic of				✓
Belgium				✓

Brazil				✓
Bulgaria	✓	✓	✓	
Canada				✓
Chile				✓
China		✓		
Czech Republic				✓
Columbia				✓
Denmark				✓
Dominican Republic				✓
Estonia	✓	✓	✓	
Finland				✓
France	✓	✓	✓	
Germany				✓
Great Britain				✓
Greece				✓
Hong Kong				✓
Hungary				✓
Iceland				✓
India				✓
Israel				✓
Iran				✓
Italy				✓
Japan				✓
Jordan				✓
Lithuania				✓
Luxembourg				✓
Macau				✓
Macedonia		✓		
Malaysia	✓		✓	
Mexico				✓
Monaco				✓
New Zealand				✓
Norway				✓
Paraguay	✓			
Philippines				✓
Poland				✓
Portugal				✓
Romania		✓		
Serbia	✓	✓	✓	
Slovakia				✓
South Africa				✓
Spain				✓
Sweden				✓
Switzerland				✓
Syria				✓
Taiwan				✓
Turkey				✓
Ukraine				✓
United States of America				✓
Venezuela	✓			

Legal Practitioners practicing as Designs Attorneys/Agents

Of the countries surveyed 19 allow a lawyer to practice as a designs attorney without obtaining additional qualifications.

Can a lawyer also practice as a designs attorney without obtaining the qualifications set out in the previous question?



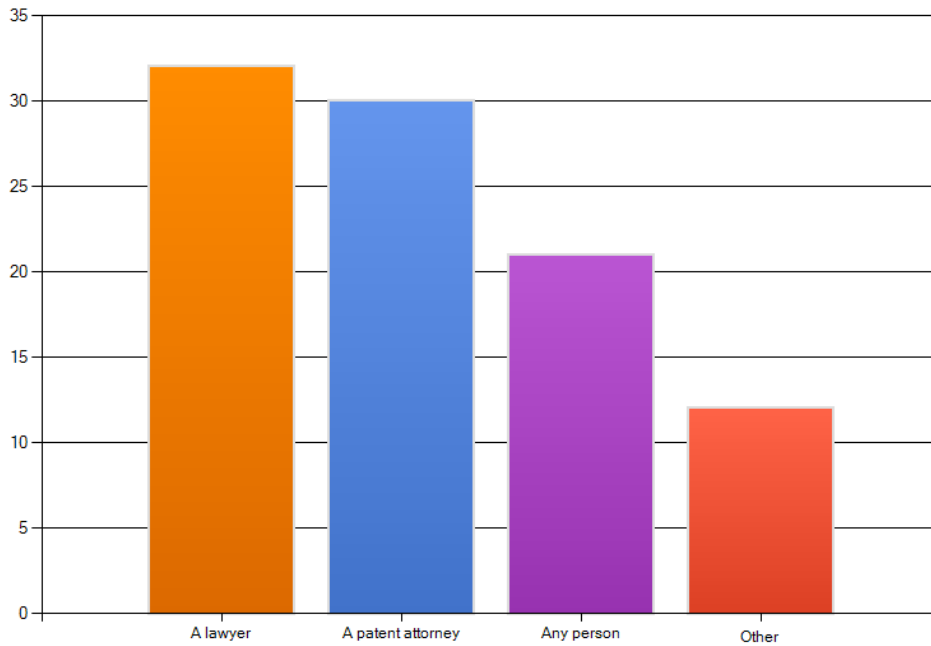
Response	Response Count
Yes	19
No	6

Countries where a lawyer can practice as a designs attorney without obtaining additional qualifications: Australia, Bulgaria, Canada, Columbia, Cyprus, Denmark, France, Germany, Great Britain, Hungary, Iran, Israel, Malaysia, Mexico, Monaco, Norway, Serbia, Taiwan, Venezuela.

Who can represent Design Applicants?

Of the countries surveyed only 8 countries restricted designs work to Patent or Designs Attorneys. Commonly, lawyers are also permitted to do this work. In 21 of the countries surveyed there was no restriction on who could represent a design applicant.

Who is permitted to represent a design applicant before the Designs Office in your country?
Please tick more than one, if appropriate.



Response	Response Count
A Lawyer	32
A Patent Attorney	30
Any Person	21
Other	12

Patent or Designs Attorneys Only: China, Estonia, Japan, Macedonia, Malaysia, Poland, Romania, Turkey

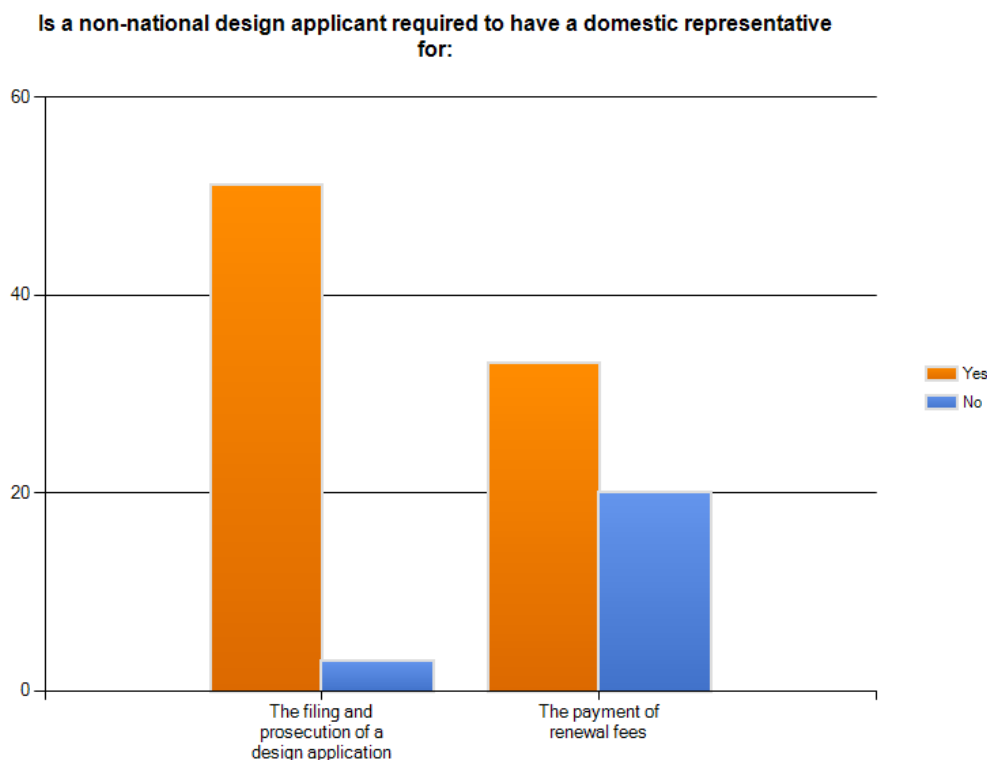
Patent or Designs Attorneys or Lawyers Only: Bulgaria, Czech Republic, France, Germany, Hungary, Italy, Jordan, Philippines, Serbia, Slovakia, Spain, Syria, Taiwan, Ukraine, United States of America

Lawyers Only: Columbia, India, Lithuania, Cyprus, Venezuela

Any Person: Argentina, Australia, Republic of Belarus, Canada, Chile, Denmark, Dominican Republic, Finland, Great Britain, Hong Kong, Iceland, Iran, Luxembourg, Macau, Mexico, Monaco, New Zealand, Norway, Portugal, Sweden, Switzerland

Requirements for Domestic Representation

Of those countries surveyed 51 require a non-national trade mark applicant to have a domestic representative for the filing and prosecution of a trade mark application and 33 require a non-national trade mark applicant to have a domestic representative for the payment of renewals.



Domestic Representation

Question	Yes	No
The filing and prosecution of a trade mark application	51	3
The payment of renewals	33	20

Domestic representation requirements by country:

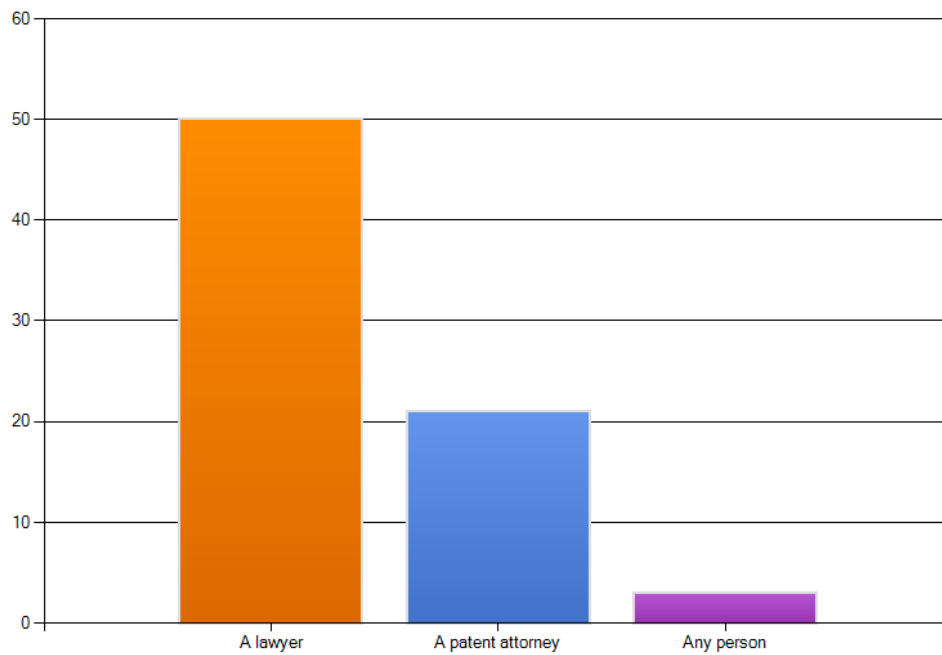
	Filing and Prosecuting		Payment of Renewals	
	Yes	No	Yes	No
Argentina	✓		✓	
Australia	✓			✓
Austria	✓			✓
Belarus, Republic of	✓		✓	
Brazil	✓		✓	
Bulgaria	✓		✓	
Canada	✓		✓	
Chile	✓		✓	

China	✓	✓	
Czech Republic	✓		✓
Columbia	✓		✓
Denmark		✓	✓
Dominican Republic	✓	✓	
Estonia	✓	✓	
Finland	✓		✓
France	✓		✓
Germany	✓		✓
Great Britain	✓		✓
Greece		✓	✓
Hong Kong	✓	✓	
Hungary	✓		
Iceland	✓		✓
India	✓	✓	
Israel	✓	✓	
Iran	✓		✓
Italy	✓		✓
Japan	✓		✓
Jordan	✓	✓	
Lithuania	✓	✓	
Luxembourg	✓		✓
Macau	✓	✓	
Macedonia	✓	✓	
Malaysia	✓	✓	
Mexico	✓	✓	
Monaco	✓	✓	
New Zealand	✓		✓
Norway		✓	✓
Paraguay	✓	✓	
Peru	✓	✓	
Philippines	✓	✓	
Poland	✓	✓	
Romania	✓	✓	
Serbia	✓	✓	
Slovakia	✓	✓	
South Africa	✓	✓	
Spain	✓	✓	
Sweden	✓		✓
Switzerland	✓		✓
Syria	✓	✓	
Taiwan	✓	✓	
Turkey	✓	✓	
Ukraine	✓	✓	
United States of America	✓		✓
Venezuela	✓	✓	

Representation of a Registered Design Owner in legal proceedings

Of the countries surveyed 21 countries allow either patent attorneys / agents that are not lawyers to represent design owners in legal proceedings related to a design registration. These are Austria, the Republic of Belarus, the Czech Republic, China, Estonia, Germany, Great Britain, Hungary, Iran, Israel, Japan, Macedonia, Poland, Romania, Serbia, Slovakia, South Africa, Spain, Taiwan, Ukraine and United States of America.

Who is permitted to represent an applicant in legal proceedings in your country related to a design? Please tick more than one, if appropriate.

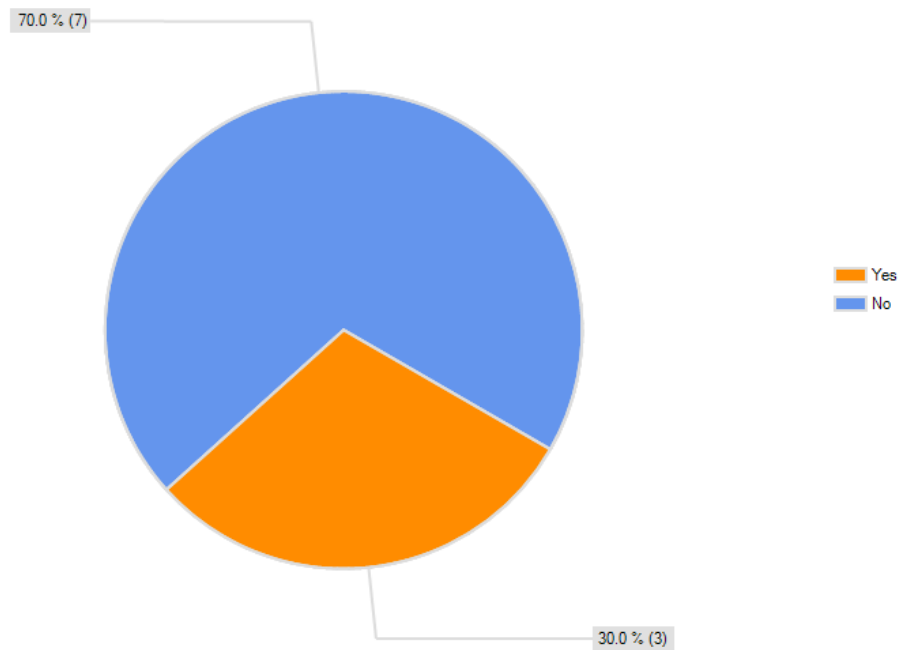


Response	Response Count
A lawyer	50
A patent attorney	21
Any person	3

Continuing Professional Development Requirements

Of the countries having a separate designs profession only 3 have continuing professional requirements for maintaining registration. These are China, Malaysia and Paraguay.

Once registered as a designs attorney, are there any continuing professional requirements for maintaining the registration?

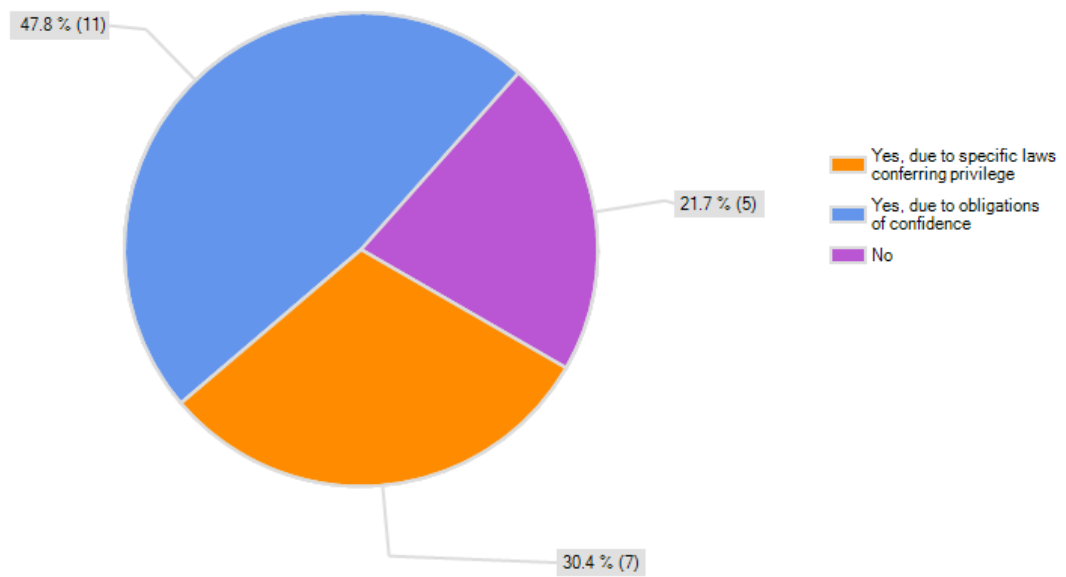


Response	Response Count
Yes	3
No	7

Protection of communications between a Designs Attorney / Agent and a Client against forcible disclosure

Of the countries surveyed communications between a designs attorney of the country and a client were protected against forcible disclosure in 18 countries.

Are communications between a designs attorney of your country and a client the subject of privilege or protected against forcible disclosure?



Protection of Client Communications

Response	Response Count
Yes, due to specific laws conferring privilege	7
Yes, due to obligations of confidence	11
No	5

Summary of Results by Country:

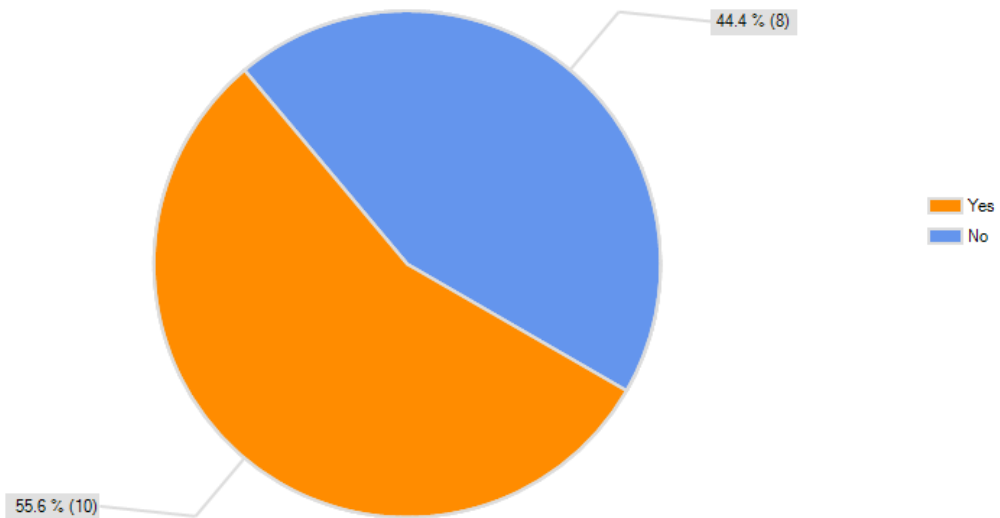
Answer Options	Yes, due to specific laws conferring privilege	Yes, due to obligations of confidence	No
Australia	✓		
Bulgaria	✓		
Canada			✓
China			✓
Columbia		✓	
Cyprus	✓		

Denmark			✓
Estonia		✓	
France	✓		
Great Britain	✓		
Hungary	✓		
Iran			✓
Israel		✓	
Macedonia		✓	
Malaysia		✓	
Monaco		✓	
Norway			✓
Paraguay		✓	
Romania		✓	
Serbia		✓	
Taiwan		✓	
Ukraine		✓	
Venezuela	✓		

Protection of communications between a Foreign Designs Attorney / Agent and a client against forcible disclosure

Of the countries surveyed communications between a designs attorney in another country and a client were protected against forcible disclosure in 10 countries.

Are communications between a designs attorney in another country and a client privileged or protected against forcible disclosure in your country?



Protection of Client Communications with Foreign Design Attorney

Response	Response Count
Yes	10
No	8

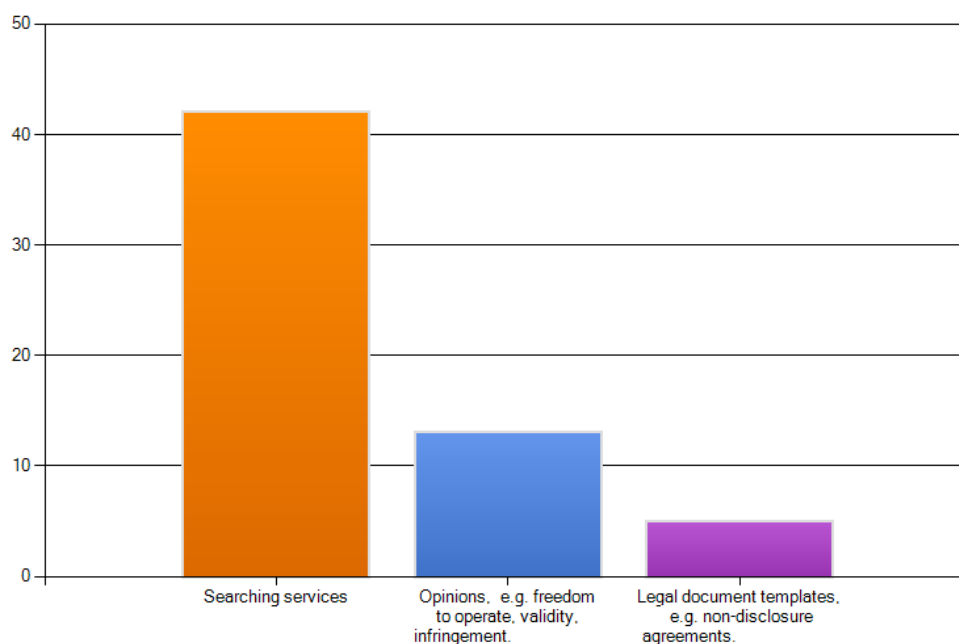
Countries in which communications between a client and Foreign Designs Attorney are protected against forcible disclosure: Bulgaria, Columbia, Estonia, Great Britain, Hungary, Macedonia, Monaco, Serbia, Taiwan, Venezuela.

CHAPTER 4: THE ROLE OF IP OFFICES

Services Provided

All members surveyed were asked whether their local IP Office offers any services traditionally provided by patent attorneys, trade mark attorneys, design attorneys and/or IP lawyers. It appears that several IP offices are now providing a broader offering than examination and grant.

Does your local IP Office offer any of the following services that have been traditionally provided by patent attorneys, trade mark attorneys, design attorneys and/or IP lawyers? Please tick more than one, if appropriate.



Those IP Offices which provide legal opinions: Austria, Belgium, Czech Republic, China, Estonia, France, Hong Kong, Hungary, Israel, Japan, Malaysia, Norway, Switzerland

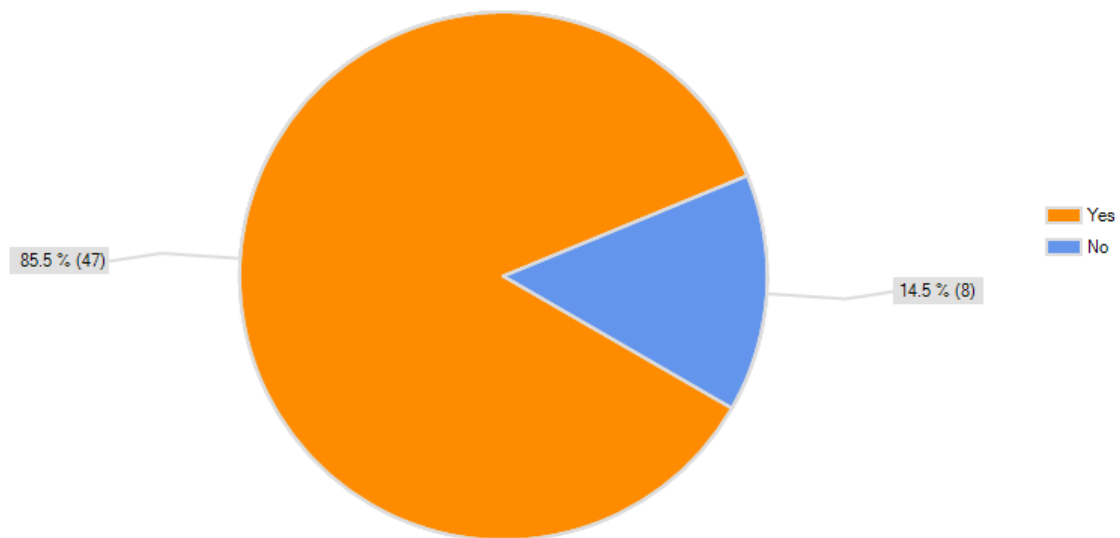
Other services specified included:

Country/Region	Comment
Australia	Non disclosure agreement template; trade mark search preliminary to filing.
EPO	EPO does searches if you ask them and pay.
Estonia	IP Office provides an assistance to the applicants if they require.
Finland	To some extent opinions and legal document templates.
Hong Kong	Trademark registrability.
Hungary	Opinions: only patentability.
India	The Office of the Controller General of Patents, Designs & Trademarks does not provide any of the above services. However, the government has setup the Rajiv Gandhi National Institute of Intellectual Property Management, whose Office of Patent Information Services provides searching services for a fixed fee.
Malaysia	The MYIPO offers searching services (whether there are marks on record which resemble the subject mark) and also Preliminary advice on whether the subject mark is registrable (inherently adapted or capable of distinguishing).
New Zealand	Searching and advice re trade marks only.
Norway	Freedom to operate.
Switzerland	"Opinions" primarily focus on searching for patents that may be infringed. Office does not provide a detailed opinion.

Consultation with the Profession

All members surveyed were asked whether their local IP Office engaged with the patent attorney and trade mark attorney profession when considering changes in law or practice. Pleasingly, the vast majority of local IP Offices do consult with the profession when considering changes in law or practice.

Does your local IP Office engage with the patent attorney and trade mark attorney profession in your country when considering changes in law or practice?



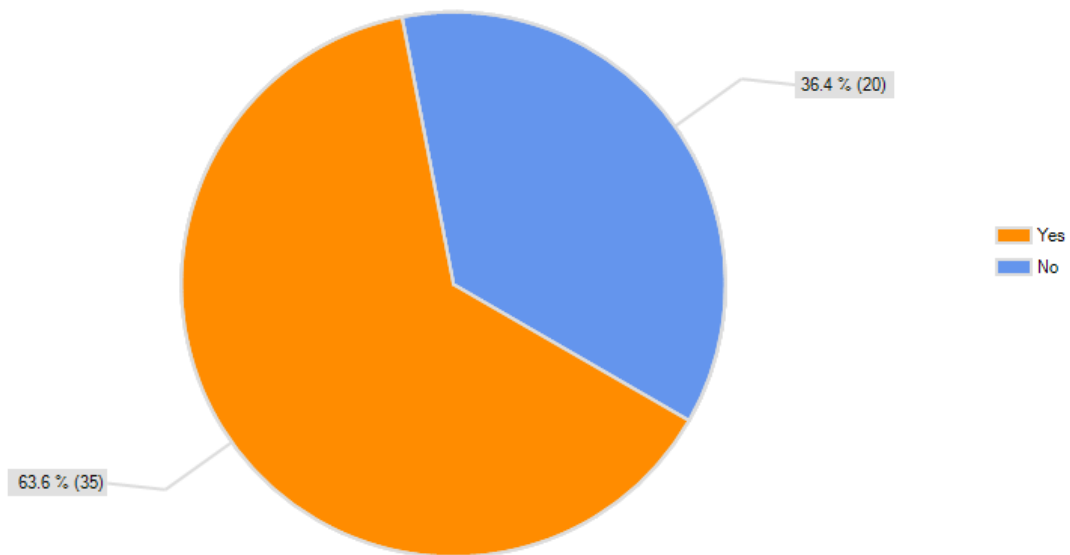
Response	Response Count
Yes	47
No	8

Countries which do not consult with the local profession when considering changes in law and practice: Belgium, Cyprus, Greece, India, Mexico, Monaco, Paraguay and Venezuela.

Assistance to Unrepresented Applicants

Several IP Offices provide assistance to unrepresented applicants.

Does your local IP Office provide assistance to unrepresented applicants?



Response	Response Count
Yes	35
No	20

Countries which do not provide assistance to unrepresented applicants: .Brazil, Bulgaria, Czech Republic, Cyprus, Germany, India, Israel, Jordan, Lithuania, Macau, Macedonia, Paraguay, Portugal, Romania, Serbia, South Africa, Spain, Sweden, Taiwan and Ukraine.

Suggestions for IP Office Assistance to the Profession

All of those surveyed were asked to indicate whether there was anything that IP Offices, law makers or other government bodies could do to foster the patent attorney and/or trade mark attorney professions. Comments were received from 35 countries.

Comments by country are listed below.

Country	Comment
Argentina	In Argentine the most convenient thing the PTO could do for the patent agents would be to consult the local association before issuing rules and regulations.
Australia	Consider the impact of changes in legislation on the domestic profession. View quality examination as their core activity. Discontinue offerings that compete with the profession.
Austria	Co-operation.
Belarus, Republic of	To introduce laws and practices to make it easier to take part in international IP studies, courses, conferences and other IP events.
Belgium	Official recognition and respect of the profession of Patent and Trademark Attorneys.
Bulgaria	I would like to see IP Offices, law makers or other government bodies to work correct and honestly.
Canada	Maintain exam requirement, add CLE requirements, better educate public as to role of patent and trade mark attorneys and IP in general.
Chile	To have a special degree enabling patent attorneys to represent applicants.
China	Communication effectively with attorney profession.
Columbia	Not letting individuals or companies to act directly without representation. Require qualifications to act before it.
Dominican Republic	Restrict certain subject matter to the exclusive handling of IP attorneys.
Estonia	It depends of the economy of the concrete country and from the number on people.
Finland	Engage the patent and trade mark attorney professions in the legislation procedures in an earlier stage and let professions contribute to the IP field based on their expertise and the client knowledge.
France	1st: maintain a regulated title and no obstruct to initiatives to promote continuous education for professionals 2nd: encourage involvement of patent and trademark attorneys in representation for legal proceedings (such as co-pleading or co-representation with attorneys-at-law).
Greece	More co-operation and participation in bringing about changes in the law and the profession.
Hong Kong	First HK needs a substantive examination; primarily to help inventors who wish to file in their home country first; so a corollary would be the development of a proper patent profession to help inventors.
Hungary	Attempts and means to promote and support innovations.
Iceland	Assist in maintaining the profession, support education, training and building qualification programs. (The Icelandic Office does indeed do this to certain extent.)
India	In view of the Indian scenario, the following may be considered: 1. Engage and invite feedback from professional organizations such as FICPI, AIPPI and/or APAA, that represent intellectual property lawyers/practitioners before amending laws and implementing policies. 2. Give special emphasis to the public offices of the

	Controller General of Patents, Designs & Trademarks and the Chairman of the Intellectual Property Appellate Board keeping in mind the specialized nature of the duties assigned to them.
Israel	Support legislation providing for attorneys confidentiality and privilege protection with clients, as the case with regular lawyers.
Jordan	More coordination and publishing their data online.
Macau	To restrict the practice of acts before the IP Offices to licensed patent and trademark attorneys.
Malaysia	Greater funding and incentives to industry to invest in IP protection and acquisition.
New Zealand	Seek more guidance from attorneys as to what changes are needed to improve the process of filing and prosecuting applications to achieve better patents.
Norway	Provide privilege for patent attorneys.
Monaco	That Monaco Law limit the exercise of activities in IP matters to firms established in Monaco, and not accept interventions from IP agents from other countries.
Peru	These bodies should be in contact with the IP professionals and consult them.
Philippines	Support the creation or institutionalizing the patent attorney profession.
Romania	The Patent Office should promote the revision of the Patent Attorney law, in the sense to exclude other professional background than technical and scientific, to attend the qualification examination for patent attorney.
Slovakia	Creating of a patent court.
South Africa	Convert to an examining office.
Spain	To enforce the use of the IP professionals as the only ones who can represent clients at the IP Offices.
Switzerland	Client-attorney privilege Regulations defining the right to carry the title cooperating of Offices with patent and trade mark attorney associations to improve the system and to ease the daily job of the patent and trade mark attorney.
Turkey	Passing a legislation regulating the profession.
Venezuela	Exams for qualifying for Patent Agent/Attorney Exams for qualifying for Trade Mark Agent/Attorney Effective sanctions against misrepresentation.

Acknowledgement

The assistance of Magda Bramante of Phillips Ormonde Fitzpatrick, Melbourne in undertaking the survey, analysing the results and assisting in preparing this report is gratefully acknowledged.

Greg Chambers
January, 2013

Appendix A – Questionnaire Sample

Appendix B – Kirby Report 1987, Royal Report 1994, Royal Report 2001