

# 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  
ARIPO Headquarters, Harare, Zimbabwe,  
October 27 and 28, 2014

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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 of 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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