

## **ROLES AND FUNCTIONS OF PATENT AGENTS**

The roles and functions of Patent Agents are determined by the domestic legislation of the territories and countries in which Patent Agents are registered to practice. Such legislation prescribes the qualifications, registration and functions of Patent Agents.

### ***Qualifications for registration as a Patent Agent***

In developed countries, qualification and registration as a Patent Agent is frequently reserved for persons (lawyers and non-lawyers) who hold scientific and technical qualifications have undergone the prescribed period of articles to a registered Patent Agent and passed the prescribed qualifying examinations in the law and practice of patents.

In developing countries, national legislation may, in addition to allowing persons who are non-lawyers to qualify and register as Patent Agents, grant lawyers registered to practise in their jurisdiction the privilege of practicing as Patent Agents.

Despite differing qualifications and functions, the practice of Patent Agents is strictly regulated in most jurisdictions.

In Zimbabwe the Patent Act [Chapter 26:03] provides that any person who is ordinarily resident in Zimbabwe may apply for registration as a Patent Agent provided he or she

*"(a) has served such period of articles as may be prescribed and has passed the prescribed qualifying examinations; or*

*(b) has passed the prescribed qualifying examinations and produces proof that he is a member in good standing of The Chartered Institute of Patent Agents incorporated by Royal Charter on the 11th August, 1891; or*

*(c) produces proof that he holds a qualification recognized by the Minister as being equivalent to the qualifications required for the purposes of paragraph (a) or (b)"*

Where a person meets the requirements for registration in Zimbabwe as a Patent Agent, the Registrar of Patents will, on submission of the prescribed application and fee, register such person as a Patent Agent provided such person is of good moral character and reputation.

In common with regulations governing the practice of Patent Agents the world over, a person who meets the necessary legal and technical qualifications may still be refused recognition and registration as a Patent Agent if, amongst other things he or she

- ❖ has been adjudged insolvent under any enactment in force in Zimbabwe or has made an assignment to or composition with his creditors; or

- ❖ has, after being convicted in Zimbabwe or elsewhere of the crime of theft, fraud, forgery or uttering a forged document or perjury, been sentenced to serve a term of imprisonment without the option of a fine, whether such sentence is suspended or not, and has not received a free pardon; or
- ❖ has been guilty of conduct discreditable to a patent agent; or
- ❖ has been guilty of a breach of any regulations prescribing the conduct of patent agents.

In Zimbabwe legal practitioners who are not registered Patent Agents are entitled to practice as Patent Agents.

Section 66 of the Patents Act provides

*"Every person entitled to practise as a legal practitioner in Zimbabwe may practise as a patent agent and perform the functions set out in section sixty-three without being registered as a patent agent, but no such person shall be entitled to be so registered except under the provisions of section 64."*

It is a criminal offence for person who is not a legal practitioner or registered as a Patent Agent to describe himself or herself as, or hold himself or herself out to be, a Patent Agent or use any term implying such a meaning nor shall such a person permit himself or herself to be so described or held out.

Similarly, a registered Patent Agent may not practice under a name or title which includes the name of any person who is not or was not in his lifetime ordinarily resident in Zimbabwe or registered as a Patent Agent under the Patents Act.

The Patent Act prohibits a Patent Agent from practicing with any person who is not a registered Patent Agent.

The Patents Act also provides that employees who are not registered Patent Agents or legal practitioners entitled to practice as Patent Agents, may not apply for patents in the name or for the benefit of their employer without the authority of the Controller.

The Patent Agents Regulations in Zimbabwe provide for patent qualifying examinations to be conducted annually by a Board of Examiners composed of 6 members of whom—

- ❖ 1 shall be the Chairman of the Board; and
- ❖ 2 shall be drawn from the University of Zimbabwe and shall have expertise in the legal and scientific content of the examinations; and
- ❖ 1 shall be drawn from the Zimbabwe Scientific Association with reference to the technological content of the examinations; and
- ❖ 1 shall be drawn from the Zimbabwe Institution of Engineers

Unlike most developed countries, the Zimbabwe Patent Agents Regulations [RGN 950 of 1972] do not require a person wishing to embark on training as a Patent

Agent to hold a scientific and technical education in areas such as biology, biochemistry, computer science, molecular biology, physics, textile technology, agricultural engineering, general engineering, biomedical engineering, geological engineering, engineering physics, mechanical engineering or electrical engineering.

The only requirement is that such person show that he or she meets the entrance requirements for admission to a university in Zimbabwe, South Africa, Great Britain, Canada, Australia or New Zealand; or that he holds the equivalent of such qualification for admission to a university described above, and that such person intends to undergo articles to a registered patent agent who has continuously practised as a Patent Agent in Zimbabwe for a period of at least 2 years.

The above Board is however defunct owing to the lack of registered Patent Agents within the country who can offer articles to aspiring Patent Agents.

### ***Roles and functions of Patent Agents***

The primary role of a Patent Agent is to help a client secure legal protection for his or her invention by filing a patent application and prosecuting the same to registration. Such registration may be in the client's country of residence or principal place of business or abroad.

Patent Agents act as legal representative on behalf of a client in connection with any matter or proceeding before national or regional Patent Offices and may draw and sign all documents and make all communications between a client and the Patent Office and may represent a client at all attendances before the Patent Office.

In order to represent his or her client in a competent manner, a Patent Agent must have the ability to understand a client's invention and its technical aspects. Expertise in the field of the client's invention is an added advantage in that it assists a Patent Agent better understand the invention and draft a technically sound patent application.

In order to fully understand the invention, the Patent Agent may require multiple attendances on the client.

The first stage is for the Patent Agent to take instructions concerning the nature and field of the invention and ensure that he or she understands the invention as portrayed in any sketches or technical drawings provided by the client.

The Patent Agent must also establish

- ❖ what the client believes is new about his or her invention
- ❖ how the invention differs from prior art
- ❖ what advantage the invention has
- ❖ what problems the invention is intended to address

- ❖ who are the originators of the invention
- ❖ the legal basis of the client's entitlement to a patent for the invention

The next stage is to determine whether the invention meets the criteria of patentability and if so whether it is something for which legal protection can be obtained in the territory in which the client wishes to secure legal protection.

Unless the client is very knowledgeable about the field of his or her invention, it may be necessary to carry out patent searches to determine the novelty of the invention.

In Zimbabwe section 2A of the Patents Act excludes the grant of patent protection for inventions of the following:

*"(a) diagnostic, therapeutic or surgical methods for the treatment of human beings or animals; or*

*(b) plants and animals, other than micro-organisms; or*

*(c) essentially biological processes for the production of plants or animals, other than microbiological processes."*

An invention may by virtue of section 13 of the Patents Act be refused registration if

*"(a) it is frivolous on the ground that it claims as an invention anything obviously contrary to well-established natural laws; or*

*(b) the use of the invention in respect of which the application is made would be generally expected—*

*(i) to endanger public order or public safety; or*

*(ii) to encourage offensive, immoral or anti-social behaviour; or*

*(iii) to endanger human, animal or plant life or health; or*

*(iv) to promote serious prejudice to the environment; or*

*(c) it claims as an invention a substance capable of being used as food or medicine which is a mixture of known ingredients possessing only the aggregate of the known properties of the ingredients or that it claims as an invention a process producing such a substance by mere admixture "*

The Patent Agent must then identify the essential idea or concept that the patent application should seek to protect and reduce the essential features of the invention to writing in a legal document called a Specification with one or more claims.

Claims define in technical terms the extent of the legal protection conferred by a patent and their object is to provide the owner of the patent with a legal right to

exclude others from making, using, selling or offering for sale the subject matter of the patent in the territory in which the patent is registered.

The Patent Agent is required therefore to write the patent application and especially the claims in a clear and concise manner that can withstand

- ❖ objections that may be raised by the Patent Office during examination
- ❖ opposition that may be filed by third parties against the patent application during the prosecution process
- ❖ legal action that may be filed for revocation of the patent or for compensation for infringement of third party rights.

The Patent Agent must possess sufficient legal, scientific and technical skill to be able to review and advise client of the merit of any objections raised by the Patent Office, submit oral or written responses to the Patent Office that overcome the objections or amend the patent application so as to allow the application to proceed to grant.

A Patent Agent is especially required to prosecute his or her client's patent application with due diligence as a lackadaisical approach may prejudice the client and may even result in the loss of priority rights or the lapsing of the patent application.

Section 67 of the Patents Act prohibits a person who is not a legal practitioner, whether or not he is registered as a Patent Agent, from describing himself or herself as, or holding himself or herself out to be, a patent attorney or attorney for patents or use any term containing the word "attorney", nor shall such a person permit himself or herself to be so described or held.

The function of a Patent Agent who is not registered to practice law in Zimbabwe is limited therefore to the representation of clients in matters and proceedings relating to the preparation, drafting and prosecution of patent applications in the Patent Office.

A Patent Agent who is registered to practice as a legal practitioner in Zimbabwe is able to represent his or her clients in all matters and procedures relating to patent law and practice as well as provide legal services in all fields of law including advising clients on

- ❖ licensing of intellectual property rights (IPRs)
- ❖ assignment and transfer of IPRs
- ❖ hypothecation of IPRs, inheritance of IPRs
- ❖ ownership of employee inventions
- ❖ rights of co-owners of IPRs
- ❖ customs remedies for infringement of IPRs
- ❖ criminal remedies for infringement of IPRs
- ❖ civil actions for infringement and enforcement of IPRs.

In conclusion, competence in patent drafting requires that Patent Agents

- ❖ as far as possible, have scientific and technical training
- ❖ undergo a prescribed period of articles to a registered Patent Agent
- ❖ undergo mentorship by Patent Agents who are skilled and experienced within their areas of speciality
- ❖ keep abreast of advances in their field of technology
- ❖ keep abreast of legal issues in patent law
- ❖ undergo advanced patent practice courses

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