



States of Guernsey
Office of the Registrar

Consultation Response Paper On Trade Mark Agents (original consultation issued 24 March 2016).

16 January 2017

1. Executive Summary

The Bailiwick has a suite of modern and dynamic legislation. The Commerce and Employment Department (the **'Department'**) released a consultation paper on 24 March 2016 to seek the views on the proposed terms of a Register of Agents, initially for Trade Mark Agents and then for Intellectual Property Agents.

It was an open/public consultation, for general comment by the public. In addition, the document was sent to the Intellectual Property Commercial Group and individuals (including agents) currently filing with the Intellectual Property Office. It was made available online at www.ipo.guernseyregistry.com.

The consultation closed on 31 May 2016.

This document summarises the responses received and details the Registrar's conclusions.

2. Background

Registers of Agents currently exist for Patents and Image Rights. The current practice of the IPO in relation to all other IP products is to accept applications made by persons authorised by the proprietor.

It was a conclusion of the Consultation that the IPO would undertake to simplify the current system, and to introduce a single register of Agents to apply across all registerable IP products.

Issues around terminology of Patent Agents and Attorneys were identified as part of the Consultation. Introducing a single register of Intellectual Property Agents will also simplify the terminology used for agents and avoid confusion internationally.

Work required to implement of a single Register of Intellectual Property Agents is being progressed in a number of stages:

i) in the first instance, Regulations have been drafted for the introduction of a Register of Trade Mark Agents, which are the subject of this consultation. The Regulations include restrictions on residence and qualifications. Similar Regulations already exist for Image Rights Agents and Patent Agents.

ii) it is intended that, once implemented, the Register of Intellectual Property Agents held by the Registrar will detail all registered Intellectual Property Agents. Appropriate designations will be included next to the Agent's name confirming which products they

are able to file applications in, according to their qualifications and/or level of IP experience.

Further Regulations will be required to enact the single Register of Intellectual Property Agents. The draft Trade Mark Agent Regulations, and feedback provided as a result of the consultation, will be used to draft the provisions required to introduce a single Register of Intellectual Property Agents with regards Trade Marks applications. Similarly, the existing Regulations for Image Rights Agents and Patent Agents will be used to incorporate provisions for Intellectual Property Agents able to file applications for those products.

iii) Amending Ordinances will be required in relation to each of the IP products, to replace existing Registers of Agents and introduce a Register of Intellectual Property Agents. The Ordinances will deal with both restriction on residency and qualifications of Agents.

3. Responses and analysis:

The Registrar would like to thank all those who took the time to contribute to the consultation. A total of three responses were received from intellectual property industry professionals. A list of the respondents can be seen in the annex to this document.

In the interests of preserving anonymity, comments have not been attributed to respondents.

4. Glossary of Terms

IPO	Guernsey Intellectual Property Office
IP	Intellectual Property
IP Agents	Intellectual Property Agents

5. Consultation Questions

1. Do you agree with the proposed fee schedule for Agents? Please provide details if you disagree.

All respondents were broadly in favour. One respondent did suggest that the fee for the Image Rights Agent Training should be increased to £100 to bring it in line with other courses and dissuade individuals who might not be committed to Image Rights. Another respondent pointed out the significant increase for individuals currently working across multiple IP filings, but agreed with the rationale and acknowledged that the total, despite the increase, was not a significant amount.

Registrar's response:

The Registrar will recommend the fee schedule to the Committee for Economic Development, including the increased training fee.

2. Do you agree with the required qualifications for Trade Mark Agent, as provided for in the draft Trade Marks Agents Regulations? Please provide reasons for your answer, or alternative suggestions.

All respondents agreed with the approach and in particular that individuals, rather than firms, should be the agents. One respondent suggested that this could possibly include those on the list of Professional Representatives before the EU IPO (OHIM).

Registrar's response:

The draft regulations will be amended to reflect that it is a director, manager or other similar officer of a corporate services provider, who is appropriately qualified, that can be an agent. The List of Professional Representatives before the EU IPO will be included as a criterion.

3. Do you agree with the proposal for similar provisions regarding Agent qualifications to be made in relation to Agents able to file Design Right Registration applications? Please provide reasons for your answer.

All respondents agreed. One respondent suggested that whilst there is no UK equivalent to the UK Register of TM Agents, the EU IPO list may still apply.

Registrar's response:

The Registrar will recommend similar provisions to be made in relation to Agents able to file Design Right Registration Applications.

4. Please provide any additional comments or suggestions you consider necessary, both in relation to the draft Trade Marks Agents Regulations and the terms of the proposed Register of Intellectual Property Agents.

One respondent highlighted the need to ensure that if a register of IP agents is to be effective, it needs to be composed of those individuals who are, at the very least, able to demonstrate that they have filed a reasonable number of applications for third party clients over the years. Without this, it is difficult to determine the ability of those on the register and this could undermine the state of the register going forward. It is important that Guernsey has a credible list of agents which demonstrates that they have knowledge in this area.

Registrar's response:

The importance of maintaining a credible Register is noted and the provisions for erasure, suspension and refusal to recognise an agent will be importance facets in the appropriate maintenance of the Register.

Conclusion

The Registrar is pleased to recommend to the Committee for Economic Development the introduction of a Register of Trade Mark Agents.

Next Steps

Having considered the responses, The Registrar will recommend regulations to the Committee for Economic Development, having duly consulted with Alderney and Sark representatives.

Appendix 1 – List of Respondents

Responses to this consultation were received from the following:

- David Evans, Collas Crill IP
- David Stanley, Stanleys Ltd
- Elaine Gray, Carey Olsen