

# **IPReg PRACTICE FEE REGULATION 2009**

## **QUESTIONS AND ANSWERS**

### **INDIVIDUAL FEES**

#### **A) In-house attorneys**

- Q. I am a patent attorney/trade mark attorney working in-house. I only undertake work for my employer, third parties related to my employer or where my employer has a “common interest” that with a third party that the work should be undertaken. The work I undertake is therefore restricted to the definition of “corporate work” as defined in regulation 1. How much do I pay?
- A. £125 if you are qualified only as a patent attorney or a trade mark attorney or £200 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers.
- Q. I am a patent attorney/trade mark attorney working in an industrial department. My department would like to provide services to unrelated companies for a fee. Would this affect the registration fees I have to pay to IPReg?
- A. Yes, if you provide services to third parties which are not related to your employer and where your employer does not have a “common interest” in having the work undertaken, your practice would cease to fall within the definition of “corporate work” as set out in the fee regulation. If you wish to undertake such work for third parties you would therefore have to pay the fees appropriate for a sole practitioner attorney set out in section D below.

#### **B) Attorneys in private practice**

- Q. I am a patent attorney/trade mark attorney working in a firm of patent and trademark attorneys registered with IPReg. How much do I pay?
- A. £150 if you are qualified only as a patent attorney or a trade mark attorney or £250 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers.
- Q. I am a patent attorney/trade mark attorney and work as a consultant for a firm of patent and trademark attorneys registered with IPReg. All the work I undertake for clients is prosecuted via that firm. How much do I pay?
- A. £150 if you are qualified only as a patent attorney or a trade mark attorney or £250 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers.

However, if your circumstance were to change and you began to undertake work on behalf of other clients which was not undertaken via the firm or undertake work via

multiple firms, you would become a sole trader attorney for the purposes of the fee regulation would therefore have to pay the fees appropriate for a sole practitioner attorney set out in section D below.

Q. I am a patent attorney/trade mark attorney working in solicitors firm regulated by the SRA. How much do I pay?

A. £150 if you are qualified only as a patent attorney or a trade mark attorney or £250 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers.

Q. I am a patent attorney/trade mark attorney working abroad for a foreign firm of patent and trade mark attorneys. How much do I pay?

A. £150 if you are qualified only as a patent attorney or a trade mark attorney or £250 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers.

Q. I am a patent attorney/trade mark attorney working in a firm based in the UK. However, my firm has chosen not to be registered with IPReg and is not regulated by another legal services regulator. How much do I pay?

A. As your firm is not regulated by IPReg or by another legal services regulator you do not fall within the definition of being in private practice for the purposes of the fee regulation. You would therefore have to pay the fees appropriate for a sole practitioner attorney set out in section D below.

### C) Inactive attorneys

Q. I am a patent attorney/ trade mark attorney currently between jobs/on maternity leave/taking a career break and currently do not undertake any work as a patent attorney/ trade mark attorney. I would, however, like to remain on the register of patent attorneys/ trade mark attorneys. How much do I pay?

A. £125 if you are qualified only as a patent attorney or a trade mark attorney or £200 if you are qualified as both a patent attorney and a trade mark attorney and wish to be or remain on both registers.

### D) Sole practitioner attorneys

Q. I am a sole practitioner patent attorney/trade mark attorney. I do not employ any professional staff. How much do I pay?

A. £250 if you are qualified only as a patent attorney or a trade mark attorney or £350 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers.

Q. I am a sole practitioner patent attorney/trade mark attorney. I do not employ any professional staff. I am considering incorporating my business and would like to register the new company in the appropriate register(s). How would this effect the amount I pay?

A. Changing the manner in which you practise and registering the new company with IPReg would have no effect on the amount you would have to pay. A £100 fee would be chargeable to register the new company with IPReg. However, once registered, providing legal services via the company would fall within the definition of “private practice” for the purposes of the fee regulation. This would mean that the individual fees you would have to pay to remain on the register would fall by £100. Hence overall the change would be cost neutral.

Q. I am a sole practitioner patent attorney/trade mark attorney. As part of my business I employ a number of other attorneys and other professional staff. How much do I pay?

A. The fee you have to pay to remain on the register(s) is made up of two parts. There is a base fee of £250 if you are qualified only as a patent attorney or a trade mark attorney or £350 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers. In addition to this base fee you are also required to pay £50 for each registered patent attorney and registered trade mark attorney you employ and of £200 for each other qualified professional staff that you employ.

For the purposes of determining the amount you have to pay, the following constitute other qualified professional staff:

Anyone who:

- i) is not a registered patent attorney or a registered trademark attorney;
- ii) is based in the UK; and
- iii) is qualified as a:
  - a) European patent attorney;
  - b) European trademark attorney;
  - c) barrister;
  - d) solicitor; or
  - e) is qualified to be a registered patent attorney or a registered trademark attorney but is not registered as such.

Thus for example in the case of a sole practitioner attorney qualified solely as a patent attorney and employing a registered patent attorney, a registered trade mark attorney, and a European patent attorney, the charge for registration in the would be:

£250 (base fee for entry in a single register) + £50 \* 2 (in respect of the registered patent attorney and the registered trade mark attorney) + £200 \*1 (in respect of the European patent attorney) = £550

#### **E) Attorneys who are qualified as lawyers**

Q. I am a barrister. I am also qualified as a patent attorney/trade mark attorney. I currently practise at the independent bar and all my work is therefore regulated by the Bar Standards Board. How much do I pay?

A. Under the Bar Code of conduct, barristers in independent practice may not simultaneously practise as a barrister and as a lawyer regulated by another legal services regulator. If you are practicing as a barrister you cannot therefore undertake work as a patent attorney/trademark attorney and hence are inactive for the purposes of the fee regulation. In order to remain on the register of patent attorneys or the register of trademark attorneys you are required to pay £125 if you are qualified only as a patent attorney or a trade mark attorney or £200 if are qualified as both a patent attorney and a trade mark attorney and wish to be or remain on both registers.

If you were to cease to be in independent practice, you would then become a non-practising barrister and would then be permitted to act as a lawyer regulated by another legal services regulator. You would then have to pay the same fee as any other patent attorney/trade mark attorney to remain on the register dependent upon your circumstance.

Q. I am a solicitor. I am also qualified as a patent attorney/trade mark attorney. I work in a firm of solicitors regulated by the SRA. How much do I pay?

A. Unlike, the case of barristers in independent practice, there are no restrictions on solicitors simultaneously acting as solicitors and as lawyers regulated by other legal services regulator. The amount you are required to pay is the same as any other patent attorney or trade mark attorney to remain on the register dependent on your circumstance.

A patent attorney/ trade mark attorney working in a firm of solicitors regulated by the SRA falls within the definition of working in private practice. You are therefore required to pay £150 if you are qualified only as a patent attorney or a trade mark attorney or £250 if you are qualified as both a patent attorney and a trade mark attorney and wish to be entered into or remain on both registers.

#### **ENTITY FEES**

Q. How much does it cost to register a partnership/company/ LLP in the register of patent attorneys or the register of trade mark attorneys?

- A. If the entity is a company through which a single attorney and no other professionals are to practise, then the fee is £100.

In all other cases there is a base fee of £250 and a fee dependent upon the number of professionals practicing through the entity. The professional dependent fee is charged at the rate of £50 in respect of each registered patent attorney or registered trade mark attorney £50 practicing via the firm plus £200 in respect of each other qualified professional staff.

For the purposes of determining the amount an entity is required to pay to enter or remain on either or both registers, the following constitute other qualified professional staff:

Anyone who:

- i) is not a registered patent attorney or a registered trademark attorney;
- ii) is based in the UK; and
- iii) is qualified as a:
  - a) European patent attorney;
  - b) European trademark attorney;
  - c) barrister;
  - d) solicitor; or
  - e) is qualified to be a registered patent attorney or a registered trademark attorney but is not registered as such.

Thus for example in the case of a firm consisting of 3 registered patent attorneys, 2 registered trade mark attorneys, a European patent attorney and a solicitor, the total charge for registering the firm would be:

$$\text{£250 (base fee) + £50 * 5 (in respect of the 3 registered patent attorneys and 2 registered trade mark attorneys) + £200 * 2 (in respect of the European patent attorney and the solicitor) = £900}$$

- Q. My firm employs a number of attorneys on a consultancy basis. How does this effect the entity fee my firm has to pay?

- A. No charges would be incurred if the attorneys in question are registered as sole practitioner attorneys with IPReg. If the attorneys in question only provide services via your firm and are registered with IPReg as attorneys in private practice your firm will be required to pay £50 in respect of each attorney. If the attorneys are not registered with IPReg your firm will be required to pay £200 in respect of each attorney who falls within the definition of "other professional" for the purposes of the fee regulation.

Q. My firm employs a number of registered patent attorneys who are also qualified as European patent attorneys. What would the cost implications be if we chose to register the firm but not to register the individual attorneys?

A. The cost to the firm would be the same regardless whether you choose to pay the individual attorney fees or not.

Each individual attorney is required to pay £150 in order to be entered into or remain on the register. In addition the firm is required to pay £50 in respect of each registered attorney. If the registered attorneys were to come off the register, no individual fees would have to be paid. However, the fee payable by the firm would be increased by £150 for each unregistered attorney working for the firm cancelling out any savings.

Q. My firm has an office based in Germany where a number of German attorneys practise. Many of these attorneys are qualified as European patent attorneys. Does this mean my firm is required to pay £200 in respect of each of these attorneys?

A. No. The charges in respect of European patent attorneys are only in respect of European patent attorneys based in the UK. No charges will be incurred with respect to the European patent attorneys based on your German office.

Q. My firm has a number of offices worldwide. Some UK registered patent attorneys/ trade mark attorneys practise from offices outside of the UK. Do these attorneys have to be included when determining the cost for registering the firm?

A. Yes, unlike the definition of "other professional", there is no requirement that a registered attorney is based in the UK in order for that attorney to be relevant for assessing the fee for registering an entity.

### **General**

Q. What does the Practice fee cover?

A. The costs of regulation. These are the running costs of IPReg and the contribution that ITMA and CIPA have to make each year towards the running costs of the Legal Services Board.

Q. What is the LSB Levy?

A. The Levy is the annual contribution referred to above. In the year 09/10, the contribution that the Institutes have to pay includes start up costs as well as running costs.

Q. When will IPReg be sending out invoices?

A. Practice fees will be collected on behalf of IPReg by the two Institutes in November and December.