

## **Compliance with CPD Regulations - Guidance Notes (Jan 2010)**

### **1 About these Guidance Notes**

All practising patent and trade mark attorneys have a professional obligation to ensure that they maintain their skills and knowledge at the necessary level to be able to provide a proper service to existing and potential clients. The principle of Continuing Professional Development (CPD) is well established in most other professions (e.g. solicitors since 1985) and some IP attorneys have undertaken CPD activities for many years either on a voluntary basis or as part of the schemes administered by ITMA and CIPA.

IPReg is charged with ensuring that the public can be confident when they consult an individual registered patent or trade mark attorney that he or she is up-to-date and aware of recent changes in law and practice in what is often a highly technical area. IPReg provides the necessary external regulation to ensure that individual CPD activities are properly undertaken and reflect the varied nature of professional practice. Regulation 6 of the Patent Attorney and Trade Mark Attorney Qualification and Registration Regulations provides the basis for the CPD requirements which are detailed in the Continuing Professional Development Regulations and administered by the IPReg Education & Qualifications Committee.

These Guidance Notes are intended to help all registered patent and trade mark attorneys who are in active practice comply with the CPD requirements recognising that initially there is not a uniform experience of compulsory CPD. Our objective is to see CPD embraced by all registered attorneys as a natural part of their professional activities rather than as a tedious bureaucratic interference. What follows are guidelines rather than absolute requirements.

### **2 What is CPD?**

CPD is work undertaken over and above the normal work and professional commitments of practitioners with a view to such work developing their skills, knowledge and professional standards in areas relevant to their area of practice as registered patent and trade mark attorneys, and in order to keep themselves up to date and to maintain the highest standards of professional practice. Examples of activities which will normally qualify as CPD are given below.

### **3 General CPD Requirements**

All registered patent and trade mark attorneys in active practice are required to achieve the minimum of 16 hours CPD in order to remain registered and to self-certify that they have met this requirement when renewing their registration. Compliance will be monitored by requiring detailed support (such as individual CPD records) from a random sample of registrants each year to substantiate the 16 hours figure.

To count towards the overall requirements, the CPD activity should be at an appropriate level and contribute to an attorney's general professional skill and knowledge, and not merely advance a particular fee-earning matter. Individuals are encouraged to plan their annual programme of CPD activities based on an objective assessment of their training and development needs in relation to the nature of their business practice. It will not be possible to carry over time spent in CPD from one calendar year to the next.

CPD which counts towards the CPD requirements of other bodies regulated by the Legal Services Board (such as the Law Society or Bar Council) may also be counted towards the total required by IPReg, provided it is relevant to practice as a Patent or Trade Mark Attorney.

Patent and trade mark attorneys who are not in active practice (i.e. who are not providing any patent or trade mark services directly or indirectly to any client or employer) but who nevertheless wish to remain on the Register(s) may do so but they will be recorded on the Register(s) as "not

in active practice” and will not be required to undertake any CPD. However, should their circumstances change and they request removal of their “inactive” status from the Register(s), they then will become subject to the annual CPD minimum requirement, normally on a *pro rata* basis for the remainder of that registration year.

#### **4 Activities which will normally count as CPD**

This is not an exhaustive list but is given to illustrate the IP related activities which will **normally** qualify as CPD:

1. Attending or speaking at a CPD event (such as a seminar, lecture or study course) organised by CIPA, ITMA or by another body regulated by the Legal Services Board (such as the Law Society, Bar Council etc.), or at a CPD event organised by another organisation itself accredited for CPD purposes by a body regulated by the LSB – note: these CPD events are entitled to the number of CPD hours assigned by the organising or accrediting body
2. Participating in a formally organised “in-house”, educational meeting or discussion<sup>++</sup>
3. Participating at a CPD event referred to in 1 or 2 by indirect means such as a teleconference, videoconference, webinar or the like
4. Preparing a lecture, seminar, book, article or law report where legal research is involved of the standard and extent required for publication in an established legal publication
5. Speaking and preparing for a client seminar\*
6. Providing a tutorial for trainees and examination candidates\*
7. Giving and preparing for a lecture on careers in IP\*
8. Personal study towards professional qualifications\*
9. Examining for UK (or European) qualifying examinations\*
10. Activities that relate to relevant European and/or foreign law\*
11. Keeping up to date on developments in a specific specialist technological field\*
12. Personal training in practice management\*
13. Personal study of books, articles, law reports, conference papers, recordings and the like\*
14. Serving on a committee of ITMA or CIPA expressly concerned with IP law and practice or on an IP related committee of a body such as the IP Federation, LES or FICPI\*
15. Marking papers for UK (or European) qualifying exams\*

#### **Notes:**

<sup>++</sup> *in-house educational seminars and discussions on developing IP law and practice which meet certain requirements (see separate Guidance in Appendix 1) will automatically be considered as suitable for CPD purposes and do not need to be approved in advance..*

\* *IP related activities such as those set out in 5-15 above may not normally comprise more than 25% of annual CPD hours when taken alone or together and may need to be substantiated in more detail than other CPD activities e.g. with written aims, objectives and outcomes.*

#### **5 Activities which will NOT normally count as CPD**

1. Giving and preparing for lectures and seminars for clients on basic IP matters where the primary purpose is to obtain or retain client business

2. Day to day training of assistants and trainees
3. Personal study of cases and other material in the ordinary course of business where the purpose is to advise clients generally
4. Membership of ITMA or CIPA Councils, or committees of ITMA, CIPA or other IP professional bodies not primarily concerned with developing IP law and practice

## **6 Special CPD requirements: including part-time workers, extended leave, overseas-based registrants, dual-registrants and authorised litigators**

Registered attorneys practising on a part-time basis are required to complete the same minimum number of CPD hours as those in full-time practice. However, registered attorneys who can substantiate that they have not been in active practice for a significant period during a year (for example as a result of illness, maternity, paternity, sabbatical leave or career break) may be entitled to a reduction in the required CPD minimum on application to the IPReg Education and Qualifications Committee. If the inactive period has been prolonged, then the Committee may require that a programme of CPD activities is started immediately on return to active practice.

Newly qualified individuals are not required to undertake CPD during the registration year in which they qualify but only from their next full year of registration.

Practising attorneys registered on both the patent attorney and trade mark attorney Registers are normally only required to achieve the minimum of 16 hours CPD required for a single Register (and not for both Registers) provided the number of hours involved on patent and trade mark activities broadly reflects the split of patent and trade mark business carried out. However, IPReg may wish to examine CPD returns from such dual registered attorneys to ensure that sufficient CPD activities are being carried out relevant to both trade mark and patent practice to support remaining on both Registers.

Registered attorneys practising abroad are still subject to the IPReg CPD requirements but may include relevant activities carried out abroad or to satisfy overseas CPD requirements.

Authorised Litigators are required to carry out a minimum of 6 hours CPD relevant to litigation, 3 hours of which can be included in the 16 hours CPD required to remain on the Register as a practising attorney with the remaining 13 hours primarily devoted to other than litigation topics. Advice about CPD relevant to litigation may be obtained on request from the IPReg CPD Sub-Committee.

## **7 Annual return**

At the end of every year, each person on a Register when applying for continuing registration must make an annual return certifying their compliance with the current CPD requirements and their willingness to supply details to substantiate the CPD if required or indicate that. This annual self-certification of compliance will be taken at face value but IPReg, usually through its Education and Qualifications Committee, will ask a random sample of registrants to provide more detailed information to substantiate their individual CPD certification.

## **8 Return Form**

The standard CPD compliance return form is attached in Appendix 2. This provides individuals with the opportunity to indicate that they are exempt explain the reasons for any non-compliance including a declaration that they are not in active practice i.e. they are not available to conduct any patent and/or trade mark work for a client or employer. This may be for reasons such as ill health, maternity/paternity leave, sabbatical or career break or retirement from active practice.

## **9 Suitability of seminars, courses, etc to count as CPD**

Specific training and development activities do not need to be validated or otherwise judged as suitable by IPReg in advance in order to qualify as CPD and IPReg does not have the resources

or competence to do so. However, as indicated in 4 above, IPReg will recognise the accreditation of IP related CPD activities by LSB regulated organisations such as CIPA, ITMA, the Law Society and the Bar Council, and the CPD hours apportioned to them. It remains the responsibility of individual registrants to decide whether particular activities are meaningful CPD when completing their annual return and to be prepared to justify that decision should they be required to do so as part of the random sampling procedure.

## **10 Record Keeping**

Keeping detailed records of CPD activities is strongly recommended since proof of CPD compliance will need to be provided if requested by IPReg (or its Education and Qualifications Committee). However, adequate details (such as the aim, learning objective and outcome of the activity) must be recorded for qualifying personal study CPD activities such as reading books, law articles, judgements etc. so that they can be properly substantiated for independent verification if required - see attached sample Personal CPD Record in Appendix 3 for an example of the sort of details which will be required. These Personal CPD Records may need to be produced on request for up to 6 years.

## Appendix 1

### CPD and in-house educational meetings

#### 1 General

Continuing Professional Development (CPD) is the process whereby a practising IP attorney takes steps to keep up-to-date with developments in their practice area, ensuring that they can deliver appropriate advice and high level services to their client. Attorneys can help meet their CPD requirements by attending appropriate IP related educational events organised by professional bodies such as CIPA, ITMA, Law Society or the Bar Council which are already recognised for CPD purposes.

In addition, sharing knowledge at suitable in-house educational meetings of IP attorneys in private and industrial practice can also be an efficient and established way of meeting the CPD requirements. In this context, "in-house" also includes regular IP educational events involving small groups of sole practitioner attorneys meeting together.

Such in-house meetings should typically involve one or more of the following objectives and learning outcomes.

- Fostering awareness of recent case law in a relevant IP field (patents, trade marks, copyright, designs or associated areas e.g. confidential information, licensing, competition law).
- Updating knowledge of practice changes and new procedures promulgated by the UK IPO, EPO, OHIM, WIPO and foreign IP offices.
- Enabling participants to keep abreast of new legislation (primary and secondary) in the IP field and contingent areas in the UK and other major jurisdictions.
- Sharing knowledge of best practice in day to day conduct/handling of individual IP cases, e.g. tips for overcoming official objections, opposition tactics, drafting and amendment points, etc.
- Sharing knowledge of the regulatory obligations of attorneys under the IPReg Code.
- Sharing knowledge of best practice in general practice management especially dealing with clients (the care and conduct of a client account).
- Sharing knowledge of technical developments in a specialist field relevant to the attorney's practice.
- Assisting participants at meetings to share this knowledge with other members of the team/trainees/assistants within the grouping, if not present at meeting.

#### 2 Acceptability of in-house educational meetings for CPD purposes

In the light of its recent consultation, IPReg has decided that in-house educational meetings which satisfy these criteria will automatically be considered as suitable for CPD purposes and in that respect be treated in the same way as CIPA and ITMA CPD events and IP related CPD events organised by other professional bodies. As a result such in-house educational meetings are not to be subject to the 4 hour maximum cap.

A meeting may be partly educational and partly general, for example about workloads within the relevant group; in this case only part of the meeting will "count". It will be for the person leading the meeting to determine the extent to which each meeting will count.

However, individuals and organisations must be prepared to substantiate the matters listed above e.g. attendance, content of meeting and relevant criteria, if required to do so by IPReg as part of its monitoring of CPD responses from individual attorneys.

### **3 Format, content and conduct of in-house educational meetings for CPD purposes**

Inevitably “in-house” educational meetings will vary enormously across private and corporate practice and so a single model cannot satisfy every situation. However, it is recommended that the following aspects should normally be included.

#### **a Formal structure**

Whenever possible a formal agenda or written summary of the topics to be covered should be issued in advance. This may usefully include more detailed listings of the case law/official materials/other sources which are to be reviewed.

#### **b Preparation**

It is suggested that an individual is designated as the compiler for the materials to be discussed. They will have responsibility for reviewing relevant outside knowledge sources (IP websites, case law reports and alerts received from external advisers) and collating these materials following a defined structure, e.g. an indexed bundle.

#### **c Frequency and duration**

While appreciating that such meetings have to fit around other work commitments, it is suggested that these should be held on a regular basis, for example bi-monthly or, as a minimum, quarterly. The suggested duration should be no more than 2 hours.

#### **d Individual participation**

Individuals attending the meeting should be required to comment verbally on at least some of the materials e.g. provide a critique of a recent case or a brief summary of a practice change and how it will affect future case handling.

#### **e Record Keeping**

It is important that a designated individual should keep a record of the dates of meetings, participants and copies of the agendas/listings of topics discussed so that these can be produced if requested by IPReg as part of the monitoring process of CPD compliance. Also, individual attorneys can then refer to these records when maintaining their own personal CPD records.

## Appendix 2

### Intellectual Property Regulation Board

#### CONTINUING PROFESSIONAL DEVELOPMENT - COMPLIANCE FORM

**Name:**

**Firm/Company:**

**Address:**

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**1 Declaration:** (please tick the appropriate box)

I have met the requirements for continuing professional development<sup>1</sup> by carrying out CPD activities totalling sixteen hours or more during the period 1<sup>st</sup> January to 31<sup>st</sup> December \_\_\_\_ and will, on request, provide details of these activities for this or previous years.

**or**

I have not met the requirements for continuing professional development<sup>1</sup> during the period 1<sup>st</sup> January to 31<sup>st</sup> December \_\_\_\_ for the reasons or special circumstances set out in 3 below which IPReg should take into account in connection with this non-compliance.

**or (for a newly qualified attorney)**

I hereby declare that I qualified during the period 1<sup>st</sup> January to 31<sup>st</sup> December \_\_\_\_

**or (for an attorney no longer in active practice)**

I am not in active practice as a patent attorney or trade mark attorney and understand that this fact will be recorded in the relevant Register

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**2 Additional Declaration by an Authorised Litigator:**

**Declaration:** (please tick the appropriate box)

I have met the requirements for six hours of CPD activities relevant to litigation<sup>1</sup> and that no more than three hours of such activities have been included in the CPD activities declared in item 1 above.

**or**

I hereby declare that the CPD activities declared above do NOT include at least 6 hours relating to litigation and I have set out in part 3 below the reasons and special circumstances which IPReg should take into account in connection with this non-compliance.

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**3 Reasons/Special Circumstances for non-compliance**

The reasons or special circumstances for my non-compliance are: (please continue on a separate sheet as necessary)

**Signed:**

**Date:**

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<sup>1</sup> IPReg Continuing Professional Development Regulations - 2009

Appendix 3

**PERSONAL CPD RECORD [Sample]**

<b>Name:</b>		<b>For year ended</b>	
<b>Address:</b>		<b>Email (if available)</b>	
<b>(In full)</b>		<b>Telephone no.</b>	

<b>DATE</b>	<b>DETAILS OF CPD ACTIVITY UNDERTAKEN AND OF THE ORGANISERS OF THE ACTIVITY</b>	<b>NUMBER OF HOURS (accredited/non-accredited)</b>	<b>COMMENTS SUPPORTING RELEVANCE OF THIS ACTIVITY</b>
17/2/2009	Attended ITMA Lecture	One hour (accredited)	Discussion of OHIM decisions
27/2/2009	Read ITMA review	One hour	Carefully studied the case reports and discussed the Budvar decision with colleagues; looked at the effect of this decision both in the context of previous Budvar decisions and existing case law, and discussed how it would affect the advice that I gave clients; in this case I decided that it did not affect that advice
26/3/2009	Attended ITMA International Meeting	Three hours 20 mins	Listened to talks on UK IPO update, OHIM update, oppositions and invalidity
25/2/2009	Attended Lecture at KPMG on Management of Professional Firms	Two hours	The lecture was specifically directed at management of patent and trade mark firms
28/4/2009	Attending Butterworths Conference on IP strategies in the Economic Downturn	45 mins (accredited)	IP Litigation & ADR in a recession*

\* Litigation relevant