
**IPOS' EXPLANATORY NOTES
TO THE CODE OF CONDUCT IN
THE PATENTS (PATENT
AGENT) RULES**

Patents (Patent Agents)
(Amendment) Rules 2009

IPOS' Explanatory Notes to the Code

What is in these Explanatory Notes?

The Code of Conduct in the Fifth Schedule of the Patents (Patent Agents) Rules came into operation on 15th December 2009 via the Patents (Patent Agents) (Amendment) Rules 2009.

As this is the first time that such a Code has been introduced in Singapore, these Explanatory Notes have been prepared to provide some background and guide to the Code so that users can better understand how it is to be applied. The illustrations contained in the Notes are not exhaustive and do not restrict the application of the Code.

Feedback if any

These Notes are prepared by the Patent Agent Unit (PAU).

If you have any suggestions or feedback in relation to this Guide, please drop us an e-mail (ipos_enquiry@ipos.gov.sg) and attention it to this Unit.

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1. Introduction

Background

- S105(1) 1.1 In Singapore, section 105 (1) of the Patents Act provides that an individual shall not carry on a business, practice or act as a patent agent unless he is a registered patent agent, or an advocate and solicitor, who has in force a practicing certificate.
- S105(4) 1.2 Section 105(4) goes on to elaborate that for the purposes of this section, a person is taken to carry on a business, practice or act as a patent agent if, and only if, the person does, or undertakes to do, on behalf of someone else, any of the following in Singapore for gain:
- (a) applying for or obtaining patents in Singapore or anywhere else;
 - (b) preparing specifications or other documents for the purposes of this Act or the patent law of another country; or
 - (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.
- 1.3 It is clear in the Act that section 105(4) permits a registered patent agent, or an advocate and solicitor with a practicing certificate to do any of the 3 limbs in section 105(4).
- S105(5) 1.4 However, when it comes to describing oneself as a patent agent, this is reserved to registered patent agents with practicing certificates as section 105(5) states that “An individual shall not —
- (a) carry on a business under any name or other description which contains the words “patent agent”; or
 - (b) in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a “patent agent”,
- unless he is a registered patent agent who has in force a practicing certificate.
- R23,R24 & R25 1.5 The Patents (Patent Agents) Rules introduced in Jan 2002 together with

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the changes in the Patents Act set in place the patent agent regime and transitional provisions which allowed certain individuals to be “grandfathered” and be registered as patent agents if they met the requirements specified.

- 1.6 The following table captures in essence who can practice patent agent work and who can describe themselves as patent agents in Singapore. Individuals registered under the transitional provisions under the Patents (Patent Agents) Rules are registered patent agents and if they hold a valid practicing certificate, they can practice patent agent work and describe themselves as patent agents.

	Carry on a business, practise or act as a patent agent	Describe himself, hold himself out or permit himself to be described or held out as a “patent agent”
Singapore Registered patent agent with a valid patent agent practicing certificate	Yes	Yes
Individuals registered under the transitional provisions with a valid patent agent practicing certificate	Yes	Yes
Singapore advocate and solicitor with a valid practicing certificate	Yes	No

- S105(15) 1.7 Section 105(15) of the Patents Act explains that the phrase “practising certificate” means —

- (a) in relation to a registered patent agent, a practising certificate issued to him under rules made under section 104; or
- (b) in relation to an advocate and solicitor, a practising certificate issued to him under section 25 of the Legal Profession Act.

- S104 1.8 Section 104 of the Patents Act allows the Minister to prescribe for the registration of individuals as patent agents and the Patents (Patent Agents) Rules provides for the Registrar of Patents to keep and maintain

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a register of patent agents. Applications to be registered as patent agents and applications to obtain practicing certificates are made to the Registrar.

- 1.9 Advocates and solicitors on the other hand obtain their practising certificates under section 25 of the Legal Profession Act and they are governed by the Legal Profession Act and its corresponding subsidiary legislation e.g. Legal Profession (Professional Conduct) Rules.

Disciplinary proceedings

- Part III 1.10 Disciplinary proceedings are also in place for registered patent agents under Part III of the Patents (Patent Agents) Rules. Any person may make a complaint or provide information to the Disciplinary Committee on a registered patent agent. Given the growth of the patent agent profession since 2002, it was timely to introduce a Code of Conduct that would apply to registered patent agents with practising certificates.

Code of conduct

- R15A 1.11 Rule 15A was introduced on 15th December 2009 via the Patents (Patent Agents) (Amendment) Rules 2009. It says:
- (1) Every registered patent agent who has in force a practising certificate shall comply with the Code of Conduct set out in the Fifth Schedule.
 - (2) Disciplinary proceedings may be taken against any registered patent agent referred to in paragraph (1) who contravenes any provision of the Code of Conduct.
- 1.12 The Code was so introduced to provide a framework for fair and equitable dealing between practicing registered patent agent and their clients. The Code aims to set a standard of acceptable conduct that can be used in the settling of disputes and to assist clients of practicing registered patent agents and others dealing with the profession to understand the obligations of practicing registered patent agents to their clients.

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- 1.13 The Code can thus be said to focus on the professional relationship between the practicing registered patent agent and his client by making it transparent, while the provisions (section 105) in the Patents Act details the extent of what a registered patent agent with a valid practicing certificate is permitted to do.

- 1.14 The Code should be read in this light and should not be seen as curtailing the scope of work (section 105(4)) permitted under the Act.

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2. Details

Getting Started

2.1 You are advised to have the following documents before you proceed to read the rest of this section in these Notes:-

- Patents Act
- Patents (Patent Agents) Rules
- Patents (Patent Agents) (Amendment) Rules 2009.

Basic Concepts

2.2 The Code does not attempt to cover each and every aspect of the professional relationship between practicing registered patent agents and their clients but it identifies some common expectations required of professionals and reflects them accordingly.

2.3 The Code does not diminish a practicing registered patent agent's responsibility to act according to law. In addition, it does not in any way diminish a client's rights.

Clause 1 of the Code: Application

Clause 1 2.4 Clause 1 makes clear that the Code of Conduct only applies to a registered patent agent who has in force a practising certificate. It does not apply to advocates and solicitors who are not registered patent agents and it also does not apply to in-house registered patent agents if they do not have in force, the required practising certificates.

Clause 2 of the Code: Qualification to undertake work

Clause 2 2.5 Clause 2 is self explanatory and it aims to make it clear that a registered patent agent should not undertake any work which he is not able to undertake. Clause 2 also relates to the registered patent agent's general duty to disclose when he does not have the expertise to undertake certain work on behalf of the client.

To illustrate, if a client has an invention that deals with nucleotide listings and gene sequences and he needs help in drafting the patent specification, if the registered patent agent is unable to provide such work, he should not undertake the work.

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- 2.6 If the registered patent agent is unable to provide such work personally but is able to delegate the work to his colleague or to contract the work to someone else who is able to do the work, and he remains in either case, solely responsible to his client, he should inform his client of the work arrangement planned and if his client agrees, he can undertake that work.
- 2.7 The object of this clause is to protect the interest of the client. It cannot be expected of each and every patent agent to be qualified in or possess expertise in every aspect of emerging technologies. If the registered patent agent can make alternative arrangements in the best interest of his client, either by way of delegation or contracting out, so long as the registered patent agent remains solely accountable to his client for the work done and his client is agreeable to the work arrangement proposed by the registered patent agent, the object of this clause is achieved.

Clause 3 of the Code: Responsibility for work, act or omission of other person

- Clause 3 2.8 Clause 3 reinforces the intent in Clause 2. It holds the registered patent agent solely accountable to his client for the work undertaken and the term “employee” refers broadly to also include any other person (not being a registered patent agent) who is assisting the registered patent agent in the course of his work.

Clause 4 of the Code: Referral to other person

- Clause 4 2.9 Clause 4 is also intended to protect the interest of the client. The registered patent agent must ensure when engaging another person to act on behalf of the client, that such other person is able to undertake the work in question.
- 2.10 The phrase “requisite expertise (including technical expertise)” refers to the carrying out of his professional work with due skill, care & diligence.

Clause 5 of the Code: Maintenance of professional standards

- Clause 5 2.11 Clause 5 sets out key elements as to what is expected from the patent agent profession.

For example, the registered patent agent is expected to understand, and

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be aware of the applicable legislative provisions and processes including any changes to the Patents Act (Cap. 221) and all subsidiary legislation made under that Act as well as the practices of the Registry and the Office.

Another example relates to costs, where registered patent agent shall not overcharge his client. A registered patent agent shall ensure that his client is made aware of the implications, in terms of procedures, costs and timing, of any course of action recommended by him. Also, at the request of a client, the registered patent agent must provide a reasonably foreseeable estimate of the cost of acting for the client in a particular matter.

Clause 6 of the Code: Touting

- Clause 6 2.12 Clause 6 addresses the act of touting which is not condoned by many professional bodies. One common understanding of the word “tout” includes a sense of “solicit” and when read in the context of the Act and Rules, the registered patent agents should not do anything unbecoming a member of his profession.

Clause 7 of the Code: Referral by other person

- Clause 7 2.13 Clause 7 is again intended to protect the interest of the client. It relates to the duty of the registered patent agent to act in the client’s interest, free of any interference or influence, and serves to ensure that the client’s interests are not prejudiced as a result of such a referral.

Clause 8 of the Code: Clients’ moneys

- Clause 8 2.14 This clause emphasizes the need for the registered patent agent to handle his client’s moneys with proper accounting standards and the need for the registered patent agent to maintain the confidence arising from the professional relationship with his clients.
- 2.15 If there are any relevant accounting standards made or formulated by the Accounting Standards Council under the Accounting Standards Act (Cap. 2B), they would apply accordingly.

Clause 9 of the Code: Acting in client’s interests

- Clause 9 2.16 Clause 9 encapsulates what is expected of a registered patent agent the moment he undertakes to do the work for his clients. The registered

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patent agent shall at all times, act in accordance with the law and in the interests of his client. A registered patent agent shall carry out his professional work in a timely manner and with proper regard for standards of professional service and client care.

Clause 10 of the Code: Confidentiality

- Clause 10 2.17 Clause 10 preserves the need for the registered patent agent to maintain confidentiality at all times, except in a specific situation before the Disciplinary Committee where the information is required to be revealed.

Clause 11 of the Code: Conflict of interests

- Clause 11 2.18 Clause 11 is intended to protect the interest of the client. The registered patent agent must take all reasonable steps to avoid situations of conflict between the interests of the client and the interests of the registered patent agent or those of another client. If a conflict of interests (actual or potential) occurs, this is to be resolved immediately and without compromising the interests of the client.

Clause 12 of the Code: Misleading or deceptive conduct or practice

- Clause 12 2.19 Clause 12 highlights conduct that can be seen as unbecoming a member of his profession. He should not mislead or deceive, in his dealings with the Registrar, the Registry, the Office or any other person.

3. Conclusion

In perspective

- 3.1 It is worth repeating that the Code was so introduced to provide a framework for fair and equitable dealing between practicing registered patent agents and their clients. The Code aims to set a standard of acceptable conduct that can be used in the settling of disputes and to assist clients of practicing registered patent agents and others dealing with the profession to understand the obligations of practicing registered patent agents to their clients.
- 3.2 The Code does not attempt to cover each and every aspect of the professional relationship between practicing registered patent agents and their clients but it identifies some common expectations required of professionals and reflects them accordingly.
- 3.3 The Code does not diminish a practicing registered patent agent's responsibility to act according to law. In addition, it does not in any way diminish a client's rights.

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