

*Collegio Italiano dei
Consulenti in Proprietà Industriale*

Deontologia tra Ordine ed epi

4 Novembre 2025

Bologna – Museo del Patrimonio Industriale



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN

Principali argomenti trattati

- ***Cambio di studio del professionista: Pubblicità***
- ***Storno della Clientela***
- ***Storno dei dipendenti***
- ***Potenziali conflitti di interesse***

epi perspective

■ Disciplinary bodies:

- Disciplinary Committee (DC - epi)
- Disciplinary Board (DB - epi+EPO)
- Disciplinary Board of Appeal (DBA - epi+BoA)

complaint → decision

■ Advisory body:

- Professional Conduct Committee (PCC - epi)

enquiry → opinion

epi perspective

epi Code of Conduct, art. 7(c):

(c) A Member has the right to seek through the Secretary General an opinion on the permissibility, under this Code, of any act or omission the Member proposes. Such opinion is not binding on the Disciplinary Bodies.

Cambio di studio del professionista: Pubblicità

CoC Art. 2. Advertisements

- a) Advertising is generally permitted provided that it is true and objective and conforms with basic principles such as integrity and compliance with professional secrecy.
- b) The following are exceptions to permitted advertising:
 - (1) the identification of a Client without the express authorisation of that Client;
 - (2) the mention of the name of another Member or Professional Entity unless there is a written co-operation agreement between the Member and that other Member or Professional Entity;
 - (3) the advertisement, announcement or publishing of offers to buy, sell or negotiate industrial property rights, except upon the instructions of a Client.

Cambio di studio del professionista: Pubblicità

ENQUIRY:

Does a conflict of interest with the Code of Conduct arise if a European Patent Attorney posts a profile on LinkedIn?

What information can be posted?



Cambio di studio del professionista: Pubblicità

OPINION:

Permissible insofar as the information included on the LinkedIn profile is comparable to information given in a CV

Profile information may comprise reporting objective facts, such as earlier work experience and workplaces, education, and personal skills

If the member includes advertisements on LinkedIn, for example regarding services provided by the member, Art. 2 CoC must be followed

A mere mentioning on the LinkedIn profile of the name of another professional entity in the role of a former employer is not advertising and does not fall under Art. 2(b)(2) CoC

Storno della Clientela

CoC Art.5. Relations with other Members

(a) A Member must observe good fellowship towards other Members (...)

(d) Where a Member is instructed by a Client to take over the handling of a case from another Member, the Member so instructed is free to accept such instruction but then must ensure that the other Member is informed. Such other Member must without delay, loan or transfer all documents necessary for the handling of the case or provide copies at reasonable expense to the new representative.



Storno della Clientela

ENQUIRY:

Is it admissible to select companies' field of technique and send letters to the selected companies to offer courses and conferences on IP topics against payment of a fee?



Storno della Clientela

OPINION:

It is in line with art. 2(a) CoC if the advertising is true and objective

When the charged fee for the training courses and conferences is in line with the remuneration that is common for such services in the market, this supports that the advertisement can be regarded as a true and objective offer for training courses and conferences



Storno dei Dipendenti – Concorrenza Sleale

CoC Art.5. Relations with other Members

(a) A Member must observe good fellowship towards other Members (...)



Storno dei Dipendenti – Concorrenza Sleale

ENQUIRY:

Is it in accordance with the CoC to recruit professional patent attorney staff, such as European Patent Attorneys, by contacting directly European Patent Attorneys working at other firms?



Storno dei Dipendenti – Concorrenza Sleale

OPINION:

The Code of Conduct does not regulate specifically this, in particular the recruitment of European Patent Attorneys is not prohibited.

So, it is possible to recruit epi-members directly, provided that good fellowship is respected, art. 5(a).



Potenziali Conflitti di Interesse

CoC Art. 4. Relations with Clients

(d) A Member must decline an order which is in conflict with the Member's own interests. In such a case, if an order cannot be postponed without detriment to the Client, the Member must accept and perform the order only so far as immediately necessary to avoid such detriment; thereafter the Member must resign immediately from the case.

Potenziali Conflitti di Interesse

CoC Art. 4. Relations with Clients

(e) A Member must not acquire a financial interest in any industrial property right in such circumstances as to give rise to a conflict between professional duty and interest. The Member must not charge a fee directly related to the outcome of the services provided by the Member.

Potenziali Conflitti di Interesse

CoC Art. 4. Relations with Clients

(f) A Member must not take any action against a particular matter which is being handled or has been handled by the Member or another person in the Member's professional Entity, unless the Client in the matter agrees to this action or unless the Member has no cognizance of the matter and is no longer in a position to take cognizance of it. The Member is not permitted to make use in the action of information obtained during the time the matter was previously handled, unless the information is public.

Potenziali Conflitti di Interesse

CoC Art. 1. General

(c) The basic task of a Member is to serve as a reliable adviser to persons interested in patent matters. The Member must act as an independent counsellor by serving the interests of their Clients in an unbiased manner without regard to the Member's personal feelings or interests. Each Member is responsible for keeping their professional knowledge up to date.

Potenziali Conflitti di Interesse

ENQUIRY:

Is it allowable for a member or his/her firm to accept equities in a client's business in exchange for the firm waiving their fees until the client receives further funding?

Is it allowed for a member of epi to accept shares in the business of a client as a part-payment towards the provided services by the EPA?



Potenziali Conflitti di Interesse

OPINION:

Payment in company shares involves the risk of jeopardising the independence of the EPA within the meaning of Art 1(c) CoC.

Whether the circumstances give rise to a conflict between professional duty and interest under Art 4(e) CoC depends on the specific facts of the case.

In order to be on the safe side, it is recommended to reject payment in company shares.

Potenziali Conflitti di Interesse

(cont.)

Should such payment nonetheless be considered, it is strongly advised that the member terminates his services as soon as he finds himself in a situation of conflict between his own interests (related to his ownership of the company shares) and those of his client.

It should also be considered whether the company is small or big and whether it is a one-time advice or a continuing service relationship.



Potenziali Conflitti di Interesse

UPC Order in case UPC_CFI_164/2024

The requirement of independence of a lawyer implies that a party cannot properly be represented before the Courts of European Union by a lawyer that is employed or financial dependent by the client or who has, within the represented body, extensive administrative and financial powers.



Potenziali Conflitti di Interesse

UPC Order in case UPC_CFI_164/2024

In the present case, it is undebated that XX is the respondent's managing director and main shareholder and that because of that he enjoys extensive administrative and financial powers within the body he represents.

Therefore, he cannot be considered as independent for the purpose of a valid representation of his client in the current proceedings.

Potenziali Conflitti di Interesse

UPC_ CoA_563/2024

No corporate representative of a legal person or any other natural person who has extensive administrative and financial powers within the legal person, whether as a result of holding a high-level management or administrative position or holding a significant amount of shares in the legal person, may serve as a representative of that legal person, regardless of whether said corporate representative of the legal person or natural person is qualified to act as a UPC representative in accordance with Art. 48(1) or (2) UPCA



Potenziali Conflitti di Interesse

UPC_ CoA_563/2024

One of the objectives of parties being represented by a lawyer is, among other things, to ensure that legal persons are defended by a representative who is sufficiently distant from the legal person which he or she represents.

The independent exercise of the duties of a representative is not undermined by the mere fact that the lawyer or the European patent attorney, qualified as a representative under Art. 48(1) or (2) UPCA, is employed by the party he or she represents.



Potenziali Conflitti di Interesse

UPC_ CoA_563/2024

A representative who is employed by a party must act towards the Court as an independent counsellor by serving the interests of his or her client in an unbiased manner without regard to his or her personal feelings or interests, pursuant to Art. 2.4.1 of the Code of Conduct for Representatives who appear before the Court according to R. 290.2 RoP.

Potenziali Conflitti di Interesse

ENQUIRY:

Is it allowed to challenge patents (e.g. file opposition, third party observations, nullity action) for which a member has previously prepared the application in another firm when the arguments are based on publicly available information and the member has no contact anymore with the previous clients, firm and colleagues?

Potenziali Conflitti di Interesse

OPINION:

In case the subject new application at the old office was prepared personally by the enquiring member himself, the acceptance of an order to act against the same right would collide with the rules of professional conduct.

In case the subject application was prepared by someone else in the enquiring member's old office, the acceptance of an order to act against this right would not collide with the rules of professional conduct.



Potenziali Conflitti di Interesse

ENQUIRY:

Can doing the administrative act of a national validation of an EP patent create any conflict of interest ?



Potenziali Conflitti di Interesse

OPINION:



Grazie per l'attenzione!

epi - Regulation on discipline

<https://patentepi.org/assets/uploads/documents/rules-regulations/4.3.2-250510.pdf>

epi - Code of Conduct

<https://patentepi.org/assets/uploads/documents/rules-regulations/4.2.1-250510.pdf>

UPC - Code of Conduct for Representatives

https://www.unifiedpatentcourt.org/sites/default/files/upc_documents/code-of-conduct-for-representatives.pdf

