

**O-490-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE REGISTRAR OF TRADE MARK'S  
PRELIMINARY VIEW TO IMPLEMENT THE  
RECOMMENDATION OF THE INTELLECTUAL PROPERTY  
REGULATION BOARD TO REFUSE TO RECOGNISE  
MANISH JOSHI UNDER  
SECTION 88 OF THE TRADE MARK ACT 1994 AND RULE  
61 OF THE TRADE MARK RULES 2008  
AS AN AGENT IN RESPECT OF ANY BUSINESS**

## Background

1. On 27 February 2020 the Intellectual Property Regulation Board (“IPReg”) Disciplinary Board issued a determination<sup>1</sup> in respect of proceedings it brought against two Registered Trade Mark Attorneys (“RTMAs”). These two RTMAs, Manish Joshi and Duncan Welch, set up the company Joshi & Welch Limited for their joint practice. As directors of the company, the IPReg’s Disciplinary Board, in its determination of 27 February 2020, found that Mr Joshi and Mr Welch were personally responsible for the actions and omissions of the company.

2. The following four allegations were proved against Mr Joshi:

- (i) From 1 June 2015 onwards, Mr Joshi failed to take out or maintain a policy of professional indemnity insurance, commensurate with the risks at large arising from the extent and size of his practise, contrary to the rules of conduct for trademark attorneys, thereby placing clients at risk if they had a valid claim or claims against his company. In doing so, he failed to act with integrity and breached the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons (“Rules of Conduct”);
- (ii) Mr Joshi failed to account to a client for money paid to Joshi & Welch Limited in relation to third party costs. A proportion of this money was paid in respect of the costs of an overseas agent but was retained by Joshi & Welch Limited. This breached the Rules of Conduct;
- (iii) Mr Joshi failed to comply with the decision of the Legal Ombudsman and in so doing, failed to act with integrity in putting clients’ interests foremost. This was in breach of the Rules of Conduct;
- (iv) Mr Joshi failed to cooperate with the Complainant during its investigation by failing to respond properly or at all to correspondence between November 2015 and August 2016.

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<sup>1</sup> <https://ipreg.org.uk/sites/default/files/JDB%20Final%20Determination%20-%20IPReg%20v%20Welch%20Joshi%20270220.pdf>

3. With effect from 17th of January 2020, the Disciplinary Board ordered the following sanctions:

- (i) Pursuant to the IPReg's Disciplinary Procedure Rules (DPR), that Mr Joshi's entry be removed from the Register of Trademark Attorneys for a period of 6 months;
- (ii) Pursuant to the DPR, that notification of this decision be made to the IPO and the EUIPO together with the recommendation that Mr Joshi's recognition or authorisation be withdrawn for a period of 6 months;
- (iii) Pursuant to the DPR, that a recommendation be made to CITMA that Mr Joshi's membership be suspended for a period of 6 months;
- (iv) Pursuant to the DPR that Mr Joshi be disqualified from being an employee and/or manager of a registered person pursuant to the DPR and that such disqualification shall remain in force for 6 months at which time it should be reviewed by the IPReg pursuant to the DPR.

4. The 6 month period of suspension from the Register of Trade Mark Attorneys commenced on 17 January 2020 and ended on 16 July 2020.

5. In line with the second of these sanctions, by letter of 28 January 2020, IPReg informed the IPO of the outcome of its Disciplinary Board proceedings and drawing the attention of the IPO to the sanctions. The decision that follows is in respect of Mr Joshi and the Registrar's proposed implementation of Disciplinary Boards second sanction. Mr Welch is subject to separate proceedings before the IPO.

6. By letter of 30 April 2020, the IPO wrote to Mr Joshi ("the first notification") to inform him that the Registrar intended to make use of his power under Rule 61(b) of the Trade Mark Rules 2008 ("the Rules") and refuse to recognise him as an agent in respect of any business under the Trade Marks Act 1994 ("the Act") for the same 6 month period, namely, from 17 January 2020 to 16 July 2020 ("the original preliminary view"). Mr Joshi was also informed that, as a consequence, he would not be able to act as a representative in any trade mark matter before the IPO and that he would be removed as agent from existing trade marks or applications with the applicants or owners being informed.

7. As a result of the COVID crisis, the IPO entered a period of interrupted days introduced (under Rule 75 of the Rules). This period ended on 29 July 2020 and on the same day, Mr Joshi requested to be heard.

8. A further consequence of the delays resulting from the period of interrupted days is that the proposed 6 month period of suspension expired before the Registrar could take a final decision. This led the Registrar to write to Mr Joshi on 8 July 2020 (“the second notification”) to inform him of his intention to vary the sanction so that the period of suspension would begin from the date of this decision (“the varied sanction”).

9. Mr Joshi filed written submissions and, to the extent that I consider it necessary, I will refer to them in my decision.

10. A telephone hearing was set up for 17 September 2020 where Mr Joshi represented himself. It became apparent at this hearing that Mr Joshi was not aware of the IPO’s second notification containing the varied sanction. The hearing was postponed to 23 September 2020 so that the second notification could be re-sent and for Mr Joshi to consider its content.

## **DECISION**

11. The relevant part of Section 88 of the Act states:

“**88.** - (1) The Secretary of State may make rules authorising the registrar to refuse to recognise as agent in respect of any business under this Act-

(a) ...;

(b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark [attorneys] on the ground of misconduct;

(c) ...;

(d) ...

(2) ...”

12. Rule 61 of the Rules states:

“61. The registrar may refuse to recognise as agent in respect of any business under the Act—

- (a) ...;
- (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents on the ground of misconduct;
- (c) ...;
- (d) ...”

### **Period of proposed ban**

13. Mr Joshi submitted<sup>2</sup> that there is no reason why the IPO suspension should go beyond the end of the 6 month suspension imposed by IPReg, namely, 17 July 2020. He argued that the period of the IPReg sanction has passed and no further restriction should be placed upon him. He also submitted that there is no intention on the part of the Disciplinary Board, or any other reason, why the Registrar’s sanction should go beyond these dates<sup>3</sup>. He suggested that IPReg’s notification to the IPO was intended to dovetail the relevant period of suspension and there can be no ambiguity or misinterpretation of the order of the Disciplinary Board<sup>4</sup>. Mr Joshi also submitted that because no allegation of dishonesty was brought against him<sup>5</sup>, this is a reason why the IPO should not take any additional or extreme position to that recommended by IPReg.

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<sup>2</sup> His written submissions of 14 August 2020, para. 15

<sup>3</sup> Ditto, para 16

<sup>4</sup> Ditto, para 18

<sup>5</sup> Ditto, para 29

14. Mr Joshi also relied upon section 6 of the Human Rights Act 1998 (“the HRA”) because it would be unlawful for a public authority such as the IPO to deprive him of his ability to do his livelihood. I keep this in mind but, for reasons that will become apparent, it is not necessary that I consider the issue specifically within the context of the HRA.

15. The relevant IPReg sanction set out in its Order accompanying the determination of its Joint Disciplinary Board was:

“With effect from 17 day of January 2020 the following action be taken in relation to the Registration of [Mr Joshi]:

...

- Pursuant to Rule 16.1(f) of the Rules that notification of this decision be made to UKIPO [...] with a recommendation that [Mr Joshi’s] recognition or authorisation be withdrawn for a period of 6 months”

16. The order does not explicitly state that the 6 month period for which Mr Joshi is recommended to have his authorisation withdrawn be the same period imposed by IPReg regarding his suspension from the Register of Trade Mark Attorneys, but taken in context with the other sanctions that have effect from 17 January 2020, this is a reasonable assumption. Mr Joshi submitted<sup>6</sup> that IPReg concluded no such sanction should apply beyond the term indicated and even then, only in respect to reserved legal activities. This last point is at odds with IPReg’s Disciplinary Board explicitly stating in its Order that the IPO is notified of its determination together with a recommendation that the IPO withdraw Mr Joshi’s recognition or authorisation for a period of 6 months. Further, a specific power to do this is included in rule 61(b) of the Rules. Therefore, when making the recommendation, IPReg must have had in mind for the IPO to impose a suspension that went wider than just reserved legal activities. I dismiss Mr Joshi’s submission.

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<sup>6</sup> Mr Joshi’s written submissions, para 25

17. The COVID pandemic has created a highly unusual situation where the IPO has been unable to conclude these proceedings in its normal timely manner and has resulted in a decision being taken by the IPO to vary its original preliminary view so that the period of suspension begins from when this decision is issued<sup>7</sup>. The delays have resulted in this decision being issued over two months after the end of the IPReg period of suspension and to confirm the varied sanction now would place restrictions upon Mr Joshi's ability to conduct business before the IPO for a further period of 6 months. This second 6 month period would prolong the effects of the second sanction for over 8 months from the date when the period of suspension from the Register of Trade Mark Attorneys came to an end, i.e. 16 July 2020 and would create an unfairness to Mr Joshi. In my view, this was not likely to be the intention of IPReg when making its recommendation. Therefore, I agree with Mr Joshi's submission that he should not suffer further restrictions to his business activities beyond the period envisaged by the IPReg sanction and recommendation because of a reason (delays in processing the proceeding resulting from the situation created by the COVID pandemic) that was not of his making.

18. In summary, I find that it would not be correct to utilise the provisions of rule 61(b) to impose a period where the IPO refuses to recognise Mr Joshi in trade mark matters which begins from the date of this decision, and I decline to confirm the varied sanction set out in the second notification.

19. Having made this determination, I must decide whether a different sanction would be fair. At the hearing, Mr Joshi clarified that his submissions applied to the varied sanction and he indicated that he accepted that the original preliminary view was appropriate. As he pointed out, this was evidenced by him voluntarily stepping back from actively representing his clients between 17 January to 16 July 2020. I note this and in the circumstances, this is fair and would implement IPReg's recommendation. I conclude that it would be appropriate for the Registrar to refuse to deal with Mr Joshi in all matters under the Trade Marks Act 1994 during the period 17 January 2020 to 16 July 2020.

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<sup>7</sup> As set out in the second notification of 8 July 2020

20. However, because of the highly unusual circumstances created by the COVID pandemic and the resultant delays to concluding these proceedings, to implement this sanction now would potentially be unfair to trade mark owners and applicants represented by Mr Joshi. I recognise that Mr Joshi voluntarily stepped back from actively representing his clients but, in circumstances where he is still recorded as agent, implementation of the sanction would potentially result in any actions taken before the IPO on his behalf, during the sanction period, being nullified. In the circumstances, implementation of the sanction would create unfairness and uncertainty for trade mark owners/applicants regarding these actions and, reluctantly, the Registrar does not require the sanction to be implemented despite believing that it is, in all other respects, a fair and just sanction.

21. The original preliminary view stated that the IPO was also minded to remove Mr Joshi as agent from existing trade marks or applications with the applicants or owners being informed. There is nothing in rule 61 that provides a specific power for the Registrar to do this but in circumstances where the Registrar has refused to deal with an agent it would be incumbent upon the IPO to notify applicants and owners (that list the agent as their representative) in order to allow the owners and applicants to make alternative plans for representation during the sanction period. Therefore, if the Registrar's proposed sanction had been finally determined in good time, such action would have been prudent. However, the sanction has not been finally determined in good time because of the delays that have resulted from the circumstances created by the COVID pandemic. Consequently, the sanction period has ended and it can no longer be the case that the owners/applicants need to be individually informed in order to implement the sanction. This, combined with the absence of a specific power to undertake such actions, leads me to conclude that the Registrar should not now individually inform trade mark owners or applicants that list Mr Joshi as their representative.

## **Suspension of decision pending outcome of IPReg's consideration of Mr Joshi's application for re-admittance to the Register of Attorneys**

22. Mr Joshi has made an application to IPReg to be re-admitted to the register of trade mark attorneys and he sought a suspension of issuing this decision until the outcome of this application is known. He submitted that because:

- (a) the period of suspension recommended by IPReg has passed, and;
- (b) as a result the IPO is no longer required to refuse to deal with him

he should not be penalised for delays in IPReg issuing its decision on his application to be re-admitted.

23. I have found that if this decision had been issued in a timely manner, it would have been appropriate to implement the sanction. This finding has not been affected by the late issuing of this decision. This remains the case despite the subsequent application by Mr Joshi to be re-admitted to the register of attorneys. Therefore, I find that a suspension of issuing this decision will serve no useful purpose and neither does the fact that Mr Joshi has applied to be re-admitted to the register of attorneys have the capability to impact upon my findings in this decision.

24. Taking all of the above into account, I decline to suspend this decision until the outcome of Mr Joshi's re-application for re-admittance is known. This decision is to be issued and published on the IPO website in the normal way.

### **Conclusions**

25. The Registrar finds that the varied sanction is unfair and declines to confirm it. He finds that the IPO's first preliminary view is appropriate and correct in respect of refusing to recognise Mr Joshi as an agent in any business under the Trade Marks Act 1994 for the period 17 January 2020 to 16 July 2020. However, in order to protect the interests of trade mark owners/applicants represented by Mr Joshi, he finds that this should not be retrospectively implemented.

30. The IPO will not individually notify trade mark owners and applicants represented by Mr Joshi.

31. This decision will be posted on the IPO website in the normal way.

**Dated this 5th day of October 2020**

**Mark Bryant**

**For the Registrar**

**The Comptroller-General**