

WORLD focus

Celebrating ITMA 70

A special publication to mark the 70th anniversary of the Institute of Trade Mark Attorneys

OCTOBER | 2004



Onwards and upwards

Trade Mark Attorneys climb to new heights

Satisfying result

1994 lobbying victory

Litigation rights

Major hurdle cleared

Changing times

Trade marks in 2014

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Celebrating ITMA

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We wish to congratulate ITMA on its 70th Anniversary

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From the president

The great German-born physicist Albert Einstein once commented, "I never think of the future. It comes soon enough". Given that attitude, it is probably just as well that *Trademark World* has asked the writer, rather than the famous exponent of relativity, to offer his vision for the development of the Institute of Trade Mark Attorneys (ITMA) on the occasion of its 70th birthday.

Such a milestone is obviously a cause for celebration and a time to reflect on past deeds and on the great strides that ITMA has made during the three score years and ten since its humble beginnings. However, such reflection – on the past – should not dominate our thoughts. Any organisation that wishes to continue to flourish must also look to its future and to where it should be when that future arrives. Here are my thoughts on the matter.

First and foremost, I want to make the UK trade mark profession the most widely respected trade mark practitioner group in the world. As part of this process, I intend to raise the profile of UK trade mark attorneys and their professional institute – ITMA – still further amongst the world's trade mark professionals and trade mark opinion formers. In order to achieve this, we will need to harness the freshness and energy of youth. I shall therefore encourage gifted young attorneys to come forward as speakers, writers, educators and representatives of the UK profession. I also want such people to serve on the ITMA Council and its various committees. A body that distrusts young people and thereby refuses to introduce new blood to its leadership is doomed eventually to fail.

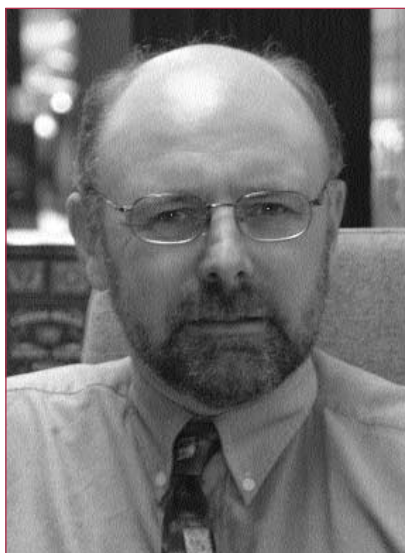
One of the main roles of a professional body is to try to identify, at an early stage, the way in which its members work is likely to develop in the medium to long term and then to provide the appropriate education and training, to ensure that the membership is well placed to exploit the new work practices.

It seems clear to me that the nature of trade mark work will change fundamentally over the next few years and that it will be based far less on the areas of filing and prosecution and far more on the areas of opposition, cancellation and infringement. It is therefore imperative that the ITMA membership becomes well acquainted with, and experienced in, the proper drafting of grounds, arguments and evidence. I also expect more members to obtain – and use – advocacy skills. Finally, in this context, the need for ITMA members to obtain litigators' rights, in order to be able to compete on a level playing field with other trade mark service providers, becomes clear. That is why the Institute will be pursuing those (litigators') rights with great vigour over the next few months.

At the end of this year, Sir David Clementi and his team will produce a report making recommendations about the future provision of legal services in this country, as well as the future regulation of legal service providers. The precise nature of those recommendations is, at the time of writing, unknown. As a matter of general principle, however, ITMA takes the issue of regulation extremely seriously and accepts that any profession that wishes to be held in high regard must ensure that its members are properly regulated and that they offer a consistently high level of service to their clients.

The Institute already has a self-regulatory system that it believes to be consistent with good practice for a profession of our size and character. However, it is also willing to modify its procedures still further in order to satisfy any possible public concerns. We trust that the Clementi Review – and, subsequently, the government legislators – will ensure that any alternative regulatory system that is introduced for the legal industry will be proportionate, efficient and cost-effective.

ITMA is a small – though beautifully formed – professional body. It is dwarfed by the International Trade Mark Association (INTA). As a result, its (ITMA's) influence on the world's trade mark bodies and trade mark legislators is considerably less than INTA's. In my view, there should be a strong, separate European voice on trade mark matters that is expressed through a channel other than INTA. ITMA cannot do this alone.



Editor's view

Trademark World is, of course, very glad to offer its congratulations to ITMA on the impressive milestone that is its 70th anniversary. But in compiling this landmark publication to chronicle the Institute's past, it became obvious that congratulations cannot be limited to the simple feat of endurance: instead, we chose to celebrate a record of constant achievement, matched by a commitment to ever-increasing levels of service to the profession.

Past and future achievements alike draw upon a long history of involvement and activism, with many hours of dedicated service delivered by already busy professionals. At a time when ITMA's membership is expanding beyond its base in the UK, and its conferences attract professionals from around the world, the Institute is well positioned to become a leading voice for trade mark attorneys. The key word, however, is voice: without yours, and those of your peers, ITMA – and other membership organisations – can do nothing.

Jacqueline Nunan

Editor: Trademark World

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ITMA Council

Continued from page 5

I would therefore like to see stronger links being formed between ITMA and its sister trade mark organisations in the European Union, as well as between ITMA and the European Communities Trade Mark Association (ECTA). If Europe could speak as one on trade mark issues and in a manner that was not dictated by self-interest, it would have a greater chance of influencing the future development of trade mark law and practice around the world. It is my aim to produce such a strong, European voice that clearly reflects the views and interests of Europe in this legal area.

Finally, for many years, trade mark professionals were the Cinderellas of the intellectual property world: largely ignored, sometimes mistreated by their perceived betters. As the range and complexity of trade mark law and practice has grown, this situation has changed radically. Not only have the Cinderellas gone to the ball, they have often organised and even paid for it.

UK trade mark attorneys are now confident in their ability and sure of their position in the IP world. This has led to a position where UK patent and trade mark professionals see each other and treat each other as equals. They often also work closely together on a day-to-day basis. Given this new reality, it is apparent to me that the two IP professional bodies in the UK, namely ITMA and the Chartered Institute of Patent Agents (CIPA), should also work closely together in areas of mutual interest. We already do this in respect of education, regulation and business development. I intend to continue with this ever closer collaboration. Whenever the interests of the two bodies coincide, then I intend to work with CIPA to improve the position of all our members.

In the Paul Simon song "Old Friends", the writer reflects upon the human condition with the poetic line "How terribly strange to be 70". I have always taken this to mean that no one expects to be or feels, in an intellectual sense, 70. Of course, many people do live to be 70, however strange it may be, they all must come to terms with the ageing process and the inevitability of their own mortality.

This may be inevitable for human beings, but it is by no means inevitable for an organisation such as ITMA. By passing the baton in a timely fashion from generation to generation, ITMA can remain young and vibrant, both in an intellectual and in a physical sense. It is the responsibility of each older generation to ensure that this transfer takes place. I am confident that under my Presidency, as well as under that of those who follow me, this renewal will happen and that ITMA will continue to go from strength to strength.

So happy birthday ITMA, and here's to the next 70 years.

Stephen James
President, ITMA
Partner, RGC Jenkins

Ode to ITMA

or The Cheque's in the Post

By Barry Cryer

Once more unto the speech, dear friends, once more
And sing in praise of ITMA
There is so much that one can say
Of them – they have letters after their name to identify them
CTM, OHIM
My brain reels at the lyrical logistics
I am stunned by the staggering statistics
You have only to diligently scan 'em
A contribution of trade mark practice to the UK balance of trade of some
£25m per annum

I can only marvel here today
At the thought of 2 million trade marks registered in the UK
Permit me, incidentally, if I say quite grandly
That "ITMA" reminds me of Tommy Handley
ITMA was a World War Two radio show
That only the oldest here will know
Sadly I only remember it because
I also remember when Jimmy Young was
And I may confess tonight
I remember when Judith Chalmers was white
But enough of nostalgia! I must be oblivious
Of the past – I'm old – it's patently obvious
For many years have I plied my trade
Mark my words – I am not afraid
To admit I was registered in 1935
For one year more, has the Institute been alive
Ever since have I tried to make my mark
Spelled with a "K" or "Q" – it's all a lark
My own agent and my own attorney
In my private practice I have travelled my journey
Possessor of my own brand name
"Cryer" is my copyright, my aim
But to survive whate'er may befall
Totally unaware of Madrid Protocol
Hoping my name would become generic
Trying not to be too hysteric
Something very much my own
Like linoleum or gramophone
Would I be an originator
Like Aspirin, Hoover or accelerator?
My dream – to be a living logo
And not find myself in an area no-go
But tonight we relax mid bunting and frolic
A phrase I dread after too much alcoholic
Intake – and so, as each Institute member their loins gladly girds
Their message is spelled out in these few brief words:
"Our aims are to ensure that all those admitted to
Practising membership of the Institute possess the
Specialised knowledge and experience necessary in
Trade Mark matters and thereby afford protection
To those who employ members of the Institute and to
The Public and to consider proposed legislation affecting
Trade Marks."
These few brief words separate fact from myth
I merely gave the gist and took the pith
That is the end of the muse – I must desist
And salute all here who came to get well acquainted
My poetic patent doth now expire
I greet you, toast you, thank you, Barry Cryer.

Changing times

Trade marks in 2014

Ian Buchan takes a trip into the future and speculates on how a trade mark attorney will fill their working day ten years from now

I have been asked, by the miracles of time travel and poetic licence, on the occasion of your 70th anniversary to tell you about the world of trade marks in 2014. I will be delighted to meet you, over a drink of course, when you join me in ten years time, to discuss the changes that have taken place over the past ten years.

Firstly may I congratulate ITMA on having prospered for 70 years and let me reassure you that ITMA still has a major, and indeed enhanced, role to play in trade marks in 2014.

I thought that I could illustrate this article best by describing a typical day in the life of a modern UK Trade Mark Attorney.

The Office, where we all used to work together, is a thing of the past. I work mainly from the comfort of a study in my house accessing my firms centralised records, as needed, using these new fangled Wireless Headset Online (WHO), in a choice of colours (all subject to trade mark registrations naturally), that allow me to speak to, and see,

clients, look at records, documents and information on a head-up display. It also, of course, allows me to dictate, by voice-recognition technology, all my correspondence, official documents etc. No more repetitive strain injuries for my wrists!

I speak to a client who wishes to register his mark, which I searched last week on the Worldwide Online Access Database (WOAD). How you did searches when you had to search country by country is beyond me! Anyway he now wants to file in 70 countries around the world.

No more worrying about particular requirements for each country, legalised Powers of Attorney, or odd classification systems. I can file electronically, using my WHO, a UK home application and an International Registration designating the CTM (now 35 countries of course) and the remaining countries including of course an Andean Registration covering most of South America. Nothing could be easier. Application numbers

are of course allocated today and reported by my WHO automatically to the client. My invoice is automatically paid by my client's bank today using the standard Worldwide Holistic Instant Payment (WHIP) system!

Within two weeks of filing I expect to start getting the examination reports, via my WHO of course, from those countries designated who have the temerity to object to the carefully researched application that I filed. Actually I do not expect to receive many. Of course the Madrid system now only allows countries six months to examine and object to any application, so much better than in the bad old days!

I will not need to use a local attorney to deal with the objections. I can do it directly in the language of the application. Why employ a local attorney to do what you can do just as well! What an archaic concept. I am so glad that we dispensed, on a global basis, with the local address for service requirements in 2009.



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The cost of obtaining registrations, because of efficiencies flowing from modern electronic systems, is probably less now than in 2004, despite inflation since then of at least 5% a year. Gordon Brown please note that your "Golden Rule" was breached in 2005.

Consequently our income from trade mark filings (which of course are much reduced now that one application can cover so many countries) and prosecution are probably no more than 10% of our total income and they occupy less than 10% of our time.

Our time now is taken up with opposition work (about 30% of our time), before the UK Office, who now try and resolve oppositions within six months of filing and before OHIM who at last allow oral hearings, using my WHO of course; no need to sample the delights (?) of Alicante. Unfortunately OHIM still take years to deal with oppositions, plus le change as they say in Peckham; at least they did on some old 1980's TV programme I watched last night. But I digress.

Of course we are now able to handle directly all trade mark matters including litigation for clients before the UK Courts, The Patent County Court and before the Community Lower Intellectual Property Tribunal (CLIPT) which replaced the Court of First

Instance in 2011 for all Intellectual Property Matters. That takes about 30% of my time.

The prescient and observant amongst you will have noticed that I have only accounted for 70% of my time. Of course in 2004 it was perfectly acceptable to only charge for 70% of your time, not so now. The remaining time is spent carrying out and reporting on trade mark searches (Paper T4 is still an important

thought 14 hours were too much), using presentations and information provided by ITMA which I can access whenever I want using my WHO.

A typical trade mark attorney these days has a Law Degree, is ITMA qualified, has UK and European Litigators rights (gained by examination of course), is qualified as an ADR Counsellor and will be fluent in English, French, Spanish and probably German. By the way they are also over 30 years old at least; it takes some time to acquire all these skills!

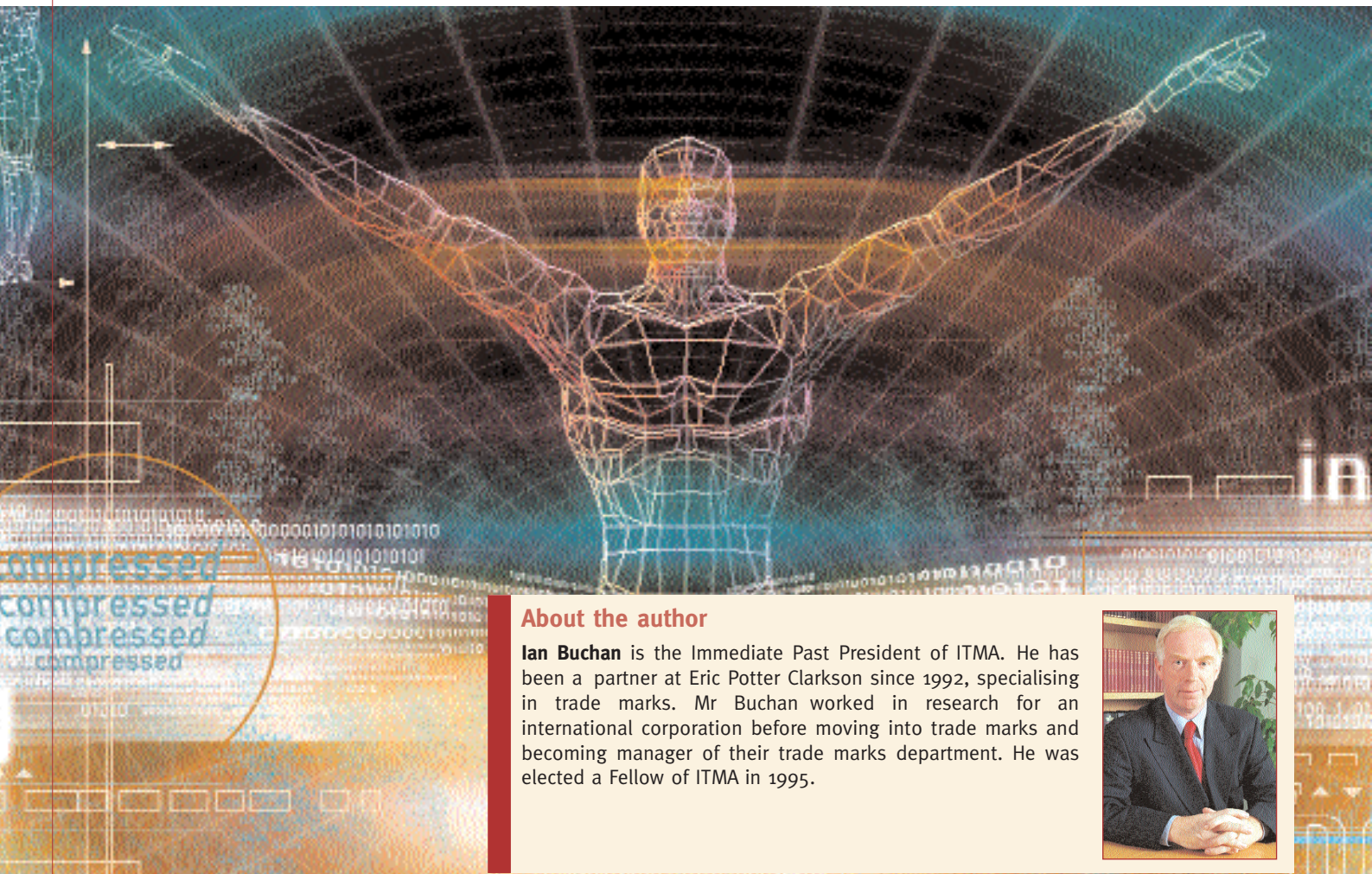
I must close now. I hope that this insight into the future is of interest to all of you and particularly those of you who will still be working in ten years time. You will notice that things have changed, but that many facets of the profession are still the same as they were in your time. That includes of course the proliferation of acronyms and alphabet soup, see above, which is a great comfort to us (it is our own secret language), and helps to impress our clients!

I look forward to seeing you all in ten years time and enjoy your 70th Anniversary. 🍷

Kind Regards
A Time Traveller

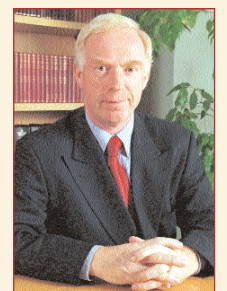
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exam, although the pass rate has improved), drafting licences and agreements, and using my Alternative Dispute Resolution (ADR) skills to resolve disputes. I also spend at least 5% of my time on CPD (we have to do 50 hours a year! I cannot understand why you



About the author

Ian Buchan is the Immediate Past President of ITMA. He has been a partner at Eric Potter Clarkson since 1992, specialising in trade marks. Mr Buchan worked in research for an international corporation before moving into trade marks and becoming manager of their trade marks department. He was elected a Fellow of ITMA in 1995.



Strength in numbers

The value of belonging for inhouse attorneys

An ITMA member for 19 years, **Katrina Burchell** explains how inhouse practitioners benefit from joining

In today's competitive world, any organisation surviving for 70 years is a testament to its value, strength and to the affection and level of respect it is held in by its members, users or customers. No organisation can survive for the long term if it does not adapt and improve to meet the demands of the world as it changes. It is a great tribute to ITMA to be in a position to reflect on how it has continued to grow in terms of membership size and reputation, particularly over the last ten – 15 years.

In the 70 years since ITMA has been in existence, the world of trade marks has changed considerably. Even in my own relatively short time as a member of this profession I have seen the role we perform, the laws on which we base our arguments and the nature of the work we do, as well as the amount of time we have to do it in, change considerably.

ITMA has been instrumental in improving the practical implications of many of the changes we have seen, including the introduction of the UK Trade Marks Act 1994, the UK joining the Madrid Protocol and the opening and developing of the function of the European Community Trade Mark Office. Further, the domain name boom and the cybersquatting of trade marks as domain names have also been addressed in various ways by ITMA and its members.

One thing that has not changed over this period, however, is the value of belonging to an organisation which represents the interests of the profession in a fair and professional way, not only for the private practitioner but for those acting as an inhouse attorney or agent.

I have been a member of ITMA for 19 years, as Student, Ordinary and Fellow member and for the last ten years I've had the honour, elected by the membership, to serve on the Council. At each stage of membership the value of an organisation like ITMA can not be underestimated. As a student, particularly one working "inhouse" rather than in a firm of attorneys or solicitors, it is often the case that you have little opportunity to be involved in the finer intricacies of UK or OHIM day to day practice. Usually this is because an inhouse role involves management of files on a global scale and the UK is seen as just one (albeit an important one) country amongst many.

The value therefore of seminars and lectures, tutorials and revision courses, where an inhouse

practitioner, who may be alone within a company at that stage of training, can learn from others with hands-on experience and share information with counterparts both in other organisations or firms, is unquantifiable. Many of these contacts and friendships made at this stage in a career are long lasting and contribute to the smooth solution of many problems for clients in the ensuing years.

As an Ordinary Member, the inhouse practitioner benefits from the many lobbying activities that the Council and members of the Institute freely give up their time to pursue. Litigators' rights; the Registry Working Practice Group; UDRP and the .uk (Nominet) dispute resolution policies, as well as the legions of education material, seminars and conferences organised on a wide variety of topics, are all examples of how companies and businesses directly benefit from ITMA's contribution to the trade mark profession which advises them.


It is a fact that there are less inhouse people than private practitioners who serve on the Council of ITMA. There are obvious reasons for this, not least that there are statistically less inhouse people, as well as possibly less time or budget and less support from management to contribute staff time in this way. I personally found my term on Council a very useful and valuable experience. Much of the work of ITMA is done by the unsung heroes who give up their time to lobby on a wide range of issues which impact on businesses in the UK and by those members of the Institute who contribute ideas, enthusiasm and passion to many of the hot topics of the day.

In today's world all businesses are concerned with costs; not necessarily on getting everything at the cheapest price, but on getting value for money and certainty with regard to a successful or unchallenged launch or product in the market place. Therefore the inhouse trade mark advisor

is generally concerned with two key issues: freedom to use and ability to protect the brand. Freedom to use requires clarity on the law on similarity, confusion, and accuracy of registers. Ability to protect requires effective laws and procedures enabling action against infringers and counterfeiters or the appropriate defence.

Without the efforts of ITMA and other like minded organisations around the globe trade mark law would not be as harmonised as it is today, nor would there be so many well-informed members of the profession. My dealings with other areas of the law which affect the launch and marketing of a product (such as packaging, labelling and promotions) lead me to the belief that part of the reason for the lack of harmonisation in these areas is the absence of organisations dedicated to representing companies' and practitioners' interests in these fields.

Having strong trade mark registrations, with clarity on what they mean and what can be done with them, enables them to be used as effective weapons in the fight against infringers and counterfeiters and in the closely competitive world that we find ourselves in today. ITMA has worked hard over many years to secure improvements in both procedural elements of trade mark registration and the effective use of those rights. There is more to do in this area, especially in the area of counterfeiting, a problem which is growing substantially and impacting considerably on all businesses whatever products they make.

The skills of ITMA's members and the activities of its Council over the last 70 years has not only raised significantly the profile of this important profession and the value of trade marks in the business world, but has contributed directly to raise awareness amongst consumers, businesses and governments of the importance of valuable IP assets. Long may ITMA's activities in this vein continue. 

About the author

Katrina Burchell LLB (Hons), FITMA is General Trade Mark Counsel – Home & Personal Care Unilever and Chairman of the UK's Anti-Counterfeiting lobbying and awareness organisation, ACG.



Across the pond

Why one member from across the sea loves ITMA

George Moore defines what ITMA means to him, as an overseas member

The Institute of Trade Mark Attorneys (ITMA), based in Croydon and essentially British, is not to be confused with INTA, the International Trademark Association, the behemoth based in New York. With its many faces, membership of ITMA is (or could be) a welcome attribute in any IP practitioner's portfolio, however distant from the UK.

What jumps out is irrelevant – its many fantastic venues. These add immeasurably to the substance-rich professional programmes. No one could forget Sterling Castle, Castle Howard, the Writers of the Signet Hall in Edinburgh, Brugge in Belgium and, soon, Barcelona. Nor late nights in such places as Dublin after Abbey Road. But, for an Overseas Member, simply travelling to London (number one on many lists) could be reason enough.

Content: This, of course, is what it's all about. ITMA delivers content: its newsletter is top flight, perhaps the best in the world, every issue full of interesting articles and cases, including overseas coverage (and it shines through that the UK's IP officials and professionals are helping to define world standards).

Seminars: ITMA's seminars attract tiptop officials and private sector speakers, both domestic and overseas, and the presenters tend to be freely available during the after-work socialising (the only drawback being the rather unimaginative hors d'oeuvres which everyone but the British seems to notice).

Website: ITMA has a fine website, right where you might expect it to be, at www.itma.org.uk. For an Overseas Member, this gives instant worldwide access to a whole bank of IP information, including video replays of important presentations and programmes. This proves handy to some of us in the hinterland, outside the M25. Plus, the other links lead to a whole array of other resources including travel information for those making their way to the UK.

Numbers: The numbers are right! Not too big, not too small, ITMA is just right for providing a chance to bump into someone you may be looking for (in comparison to INTA's annual meeting, where you would have to be lucky).

With some 200 to 250 attendees, ITMA's numbers seem just about perfect. And there is always a healthy mix of Anglos, Continentals, Africans, Asians, Latinos, and others. Altogether, there are some 350 Overseas Members.

Socialising/networking: The socialising (networking) is good and takes us to convivial places (while ITMA always makes sure that you have every opportunity to buy drinks for your colleagues, as there is always a cash bar!).

Wine & song: Plenty of the latter, as the Spring and Fall Friday night galas always turn into a bash with plenty of animated dancing (although others are driven out into the corridors by the sometimes loud blasting, amidst grumblings that there should be an ancillary room without lip-reading of shouting).

Timing: Happily, ITMA meets every spring in close proximity (usually preceding or immediately following) PTMG (the pharmaceuticals group whose inimitable master planner also pulls off magnificent venues), so this fortuitous combination of back-to-back events gives many of the Overseas Members an opportunity to score twice on a single trip. On the other hand, both organisations miss an opportunity to attract greater attendance by staging their meetings while Europe is still gripped by cold, contrasted with the allure of spring which usually dawns just two or so weeks later. That would be too close to INTA, which meets in May, they say.

Humour: The newsletter has not only excellent content but great humour (another rarity amongst professional publications). Wit often emanates from the podium as well (many recall how Brian March's banquet recital of

'good evening' in some forty different languages nearly brought down the roof).

Directory: The ITMA Directory contains the members' contact information, even though you might have to search in different sections, in the right category of membership, although it is not apparent to some users that there is more than one section. For Overseas Members, there is of course the Overseas Members section, while for the Brits there are Fellows, Honorary, Affiliate, Associate and Ordinary members. Altogether, Overseas Members hail from nearly 90 countries.

Access: Being an Overseas Member gives me some privileges but lack of access to certain others, such as being listed and made available to the public under 'Attorney Search' on the organisation's website. Only other ITMA members have online access to information about ITMA's Overseas Members, and the public has no access to them – a threshold that warrants attention.

Leadership: No organisation can thrive without dynamic leadership and ITMA has been blessed with the charm and outstanding qualities of its leaders. While we now have the leadership of Stephen James, it must also be said that we dearly miss Nick Wilson who would have been President now but for his untimely death. We all wish his family and friends the very best.

ITMA's leadership, an Overseas Member cannot fail to notice, is one hundred percent British.

Staff: Here, again, ITMA is tops. Those fine ladies have become endearing and the roses they receive from time to time do not begin to say how much their care and attention mean to ITMA's members. 🌹

About the author

George C. J. Moore (barrister@barrister-law.com) is a Barrister and Attorney. A graduate of Cambridge with degrees in English and international law, he is admitted to the bar in England, Florida and eight Commonwealth Caribbean countries. A Board Certified Specialist in International Law, he is Chairman of the International Law Certification Board of the Florida Bar. Based in West Palm Beach, Florida and at 11 King's Bench Walk, Temple, London, Moore is the principal of Caribbean Trademark Services, which handles trade mark matters in the 18 jurisdictions of the Commonwealth Caribbean.





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The right

🌀 *Certifying the role of support staff and administrators*



One of the students on the initial Formalities Course, **Roy Scott**, describes the thinking behind the course and its subsequent development

The trade mark Formalities Course started in October 1997 and was the brain-child of Janet Cox. The aim of the course is to provide structured training for trade mark administrators and to certify their level of competence through qualification by examination. The course is designed to test knowledge and provide the necessary tools, so that any student, on completion of the course, will have a sound understanding of trade mark formalities and official procedures.

Prior to its inception, the only relevant course and examination/ qualification available to trade mark administrators was the ITMA foundation level examinations. However, these papers are geared towards qualification as a trade mark attorney rather than testing the knowledge of trade mark administrators.

The Formalities Course covers a wide range of topics, including the role of administrators; life history of a trade mark application/ registration; searching and clearance; filing and prosecution; legalisation; licensing and assignments; Community Trade Marks; and the Madrid Protocol.

The initial intake of students back in 1997 was a collection of administrators, who, on average, had at least six years of experience. In its inaugural year, the Formalities Committee had two main objectives. Firstly, to consider what the students and employers wanted from the course and secondly, to determine what level at which to pitch the course.

Being fortunate enough to get a place on the first course, I found that the lectures varied: from being perfectly pitched, to a few that were too basic or too advanced. It was very important that the Formalities Committee received feedback from the students. This took place in the form of an informal gathering where the students met with the Committee and exchanged their views on how the course was progressing. Also, the

Formalities Committee had the foresight to arrange for feedback sheets to be handed out at the end of each lecture for completion by the students.

As a result of the efforts of the original Formalities Committee, the course today is slightly different from the course of 1997. For example, we now organise a visit to the Patent Office. The first visit took place in 1999, with the itinerary for the day organised by Roger Evans (Senior Manager of Registration Administration) and his team. The programme of events is specifically designed for the Formalities Course students who are given a tour of the Central Enquiries, Document Reception, and New Applications Units in addition to a general tour of the Patent Office. The aim of the visit is to help consolidate the students' knowledge and to also acknowledge the role of the Patent Office in general.

Certain topics still remain and will continue to do so as they are considered to be the backbone of the course and the bread and butter of a trademark administrator's daily duties.

In addition, since 2003 we have run a Northern Formalities Course in Leeds, which was set up with the help of David Potter and Patrick Tucker of Harrison Goddard Foote. There has also been a change in the type of students now attending the course. The latest intake of students contains a variety of administrators ranging from those with experience (including junior lawyers) to those who have worked in the field for only a short period of time.

The Formalities Course runs from January to June, with students attending lectures fortnightly and culminates in a three hour written examination. Examination day is obviously a nerve-racking time, with many of the students not having sat an exam for several years.

The students want the day to be over as quickly as possible and head for the nearest watering hole; either to celebrate or to drown their sorrows. Of course, it will be another three months before they get their examination results. Following the examination, I receive the usual round of telephone calls from students asking the same questions that are asked each year: "When will the results be issued?", "Did I ask for my results to be sent to my home address?", "Can I retake the exam if I fail?"

For the majority of students, all the worry is unnecessary. The pass mark is set at 60%. Over the last four years, 95% of the students taking the examination passed, with a high percentage gaining marks of 75% or more.

To conclude, it is my personal opinion that the course has been a great success. Each year the course is oversubscribed and the exam success rate has been in excess of 90%. I would like to thank ITMA, and in particular Janet Cox, for having the foresight to identify the requirements for a formalities course and qualification. I would also like to take this opportunity to thank all those involved in the running of the course, including the past and present Formalities Committee members, because without you there would not be a course. 🌀

About the author

Roy Scott is the IP Support Manager at David Keltie Associates. Mr Scott has more than 17 years of IP experience and has been a member of the ITMA Formalities Committee since 1999.





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From a distance

🌀 Earn CLE points without leaving the office

Alice Mastrovito explains an ITMA project to develop e-learning for Corporate members

E-learning is one of those troublesome children of the internet which we all agree is a good idea in theory but can be rather difficult, not to say expensive, in practice. It is one of the projects ITMA has been busy with in the last three years and which is now coming of age.

ITMA introduced a Continuing Legal Education (CLE) scheme for Corporate members in 2000 (ITMA uses the acronym CPD (Continuous Professional Development)) and there are many other names but for the purposes of this article I will refer to CLE). Then in 2002, ITMA increased the number of free meetings available to members to keep up with developments in the law and practice of trade marks and designs.

Half of ITMA's membership is based in London and ten free meetings a year are held in London and on a regular basis in Birmingham, Bristol, Glasgow, Leeds and Manchester. Speakers are invited to share their knowledge on new case law of the UK and European Courts, as well as on developments in practice of the UK and Community Trademarks and Designs Offices, Nominet, dispute resolution and related matters. Each of the London meetings is filmed and the recordings are available to members not able to attend in person.

ITMA selected Semple Piggott Rochez (www.spr-legal.com), a firm which has done pioneering work on e-learning in the legal field. According to Mike Semple Piggott, chief executive of SPR: "ITMA is the first major professional body in the UK to use webstreaming technology for distributing CLE material to members."

He explains that, "E-learning technology and use is developing rapidly with leading companies, law firms, banks, accountants and other professionals using web television and online training courses to develop their staff and as a means of reaching clients.

"Now, busy executives and professionals are able to do high level training at their desks at a time of their choosing. Organisations using online technology are able to reduce training costs and have good and positive feedback from their staff and members".

In charge of filming is Aidan Hobbs of Rolling Ball (www.rollingball.net). He has

taught us how to get the best out of the technology and introduces our speakers to the demands of the camera. His patience and the patience of our speakers in the early days were praiseworthy.

Filming is from a single camera positioned in the audience so that it is as unobtrusive as possible. The sound is recorded from the speaker's microphone which entails a certain amount of adjusting of dress where there are two or more speakers sharing a mic, but the audience at home is spared the rustling of papers and background noise of the live event. We don't do make-up sessions or artistic direction but speakers are encouraged not to wear loud checks or to pace the stage!

There were teething troubles with access to the recordings when they were first put on the web. A link was set up from Semple Piggott Rochez's site to ITMA's but sometimes our people didn't understand their people's computerspeak and it took a while to perfect the system. I have learned more about firewalls than is strictly necessary for the practice of trademarks.

The sheer size of video files meant that in the early days some members did not have the capacity to access them from the internet, so initially only the soundtrack and text of the talks was available online and members could buy a video recording at cost. If the ITMA Secretariat felt that their office was growing to resemble a film library, they were very tactful about it.

This year, thanks to a new technology called Impatica, we are able to offer online and free of charge a moving picture of the speaker complete with soundtrack, PowerPoint slides and text which is much more satisfactory to access (see picture). Apparently the files are also smaller than conventional video files but



Impatica recording of Emily Taylor, Company Secretary, Nominet, speaking

perhaps by now we all have bigger, faster computer systems.

To earn CLE points, ITMA Corporate members must watch the recording of a presentation and then hold a discussion on the topic with one or more colleagues. By this means, ITMA ensures that all Corporate members can earn their annual CLE quota by watching a given number of presentations, wherever their location in the UK.

The recordings are a valuable source of information on recent case law and practice developments, even for those with a surfeit of credits or for whom there is no obligation to comply with the scheme. You can access examples of recent talks on the ITMA web site or using the link <http://www.spr-consilio.com/itmamaster.html>.

Our current project is to invite Continuing Legal Education bodies outside the UK to accredit our recordings so that their members can share the benefits. If you would like ITMA to contact your CLE, CPD or related organisation to establish whether accreditation is feasible, please let us know. Likewise, if you are aware of other e-learning schemes in the field which our members could benefit from, please send details to ITMA so that we can consider accreditation. If the material is in English there should be a ready market. In the UK we are notoriously deficient in foreign language skills but who knows, we may have members who are just waiting to brush up their knowledge of your language as well as your law! 🌀

About the author

Alice Mastrovito is senior partner of the UK trademark and design practice Mastrovito & Associates, which specialise in practice before the UK and European Community Offices as well as portfolio management. Ms Mastrovito is a member of the Council of ITMA and Chair of the CPD Committee. She read Classics at Kings College London and qualified as a trade mark attorney in 1988, winning the Elizabeth Bennett Memorial Prize.





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Definitely; maybe

ITMA's battle for litigation rights

Trade mark attorneys will gain parity with patent agents when litigation rights are finally granted more than seven years after ITMA first applied, as **Philip Harris**, Gill Jennings & Every, reports

The law", someone once said to me, "is all about 'definitely, maybe'". I didn't understand his drift, not seeing what relevance an album by the band Oasis could have to the less than "rock & roll" world of the law. "Look" he explained patiently, "definitely is the word clients most want to hear, but which lawyers most definitely do not want to say; maybe is the word lawyers definitely want to say, but which clients most definitely do not want to hear".

During the last couple of years at ITMA, the phrase "definitely, maybe" has echoed in my mind as we have tussled with what has been the main professional challenge before us – the grant of litigation rights.

We first applied for these rights more than seven years ago. Time and again I've wanted to be able to tell our members that progress has definitely been made in these areas; all too often I have had nothing but "maybe" to offer them. "Maybe next year... maybe if the terms are changed... probably; but we can't be certain".

At last, however, I can definitely offer some positive news.

First, for the benefit of readers who are not familiar with the workings of the UK litigation system, I should explain the background. There are two principal forums for IP matters in the UK court system, the traditional High Court venue, and the more recent (and theoretically cheaper) Patents County Court (PCC). The High Court has jurisdiction over all IP matters. The PCC has jurisdiction to hear patent cases.

Put very simply, the basic rule in the UK is that only Barristers and Solicitor Advocates can appear in open court in the High and Appeal Courts; only Barristers, Solicitors and Patent Agents can appear in the PCC. Furthermore, in IP cases Barristers can only be instructed to appear in court via Solicitors and qualified Patent Agents.

No prizes for spotting that the words "trade marks attorneys" are conspicuous by their absence. Until now, members of our Institute could not instruct a Barrister directly to appear in Court proceedings, meaning that the duplicative and costly services of a solicitor had to be secured. Furthermore, although it was tailor-made to resolve trade mark disputes, the

PCC lacked jurisdiction to hear trade mark cases. This has meant that whereas patent cases can be handled in the appropriate venue using skilled patent professionals, trade mark cases have been marooned in the High Court, under rules that exclude trade mark professionals from direct involvement. As a result, trade mark cases in the UK have suffered in terms of their relative cost-effectiveness.

Changing this architecture has been a frustrating, difficult task. First, shortly after we applied for rights the entire application system was revised and our application had to be re-submitted. Then, various technical issues were raised that needed attention, with the Institute strenuously lobbying to ensure that it was not subject to any more stringent regulation than patent agents. At times it seemed as though those reviewing our application simply couldn't see that patent agents and trade mark attorneys not only practice together, sometimes they can be one and the same person – so having significantly different rules of practice is just not an option.

In 2002 we were confident that we would have rights in 2003, and embarked on a series of lectures to spread the word. At the end of 2003 we were told the Government had run out of staff to handle the application; gloom ensued until suddenly a new department head took pity on us and gave our application priority. We instigated a litigation training programme with our fingers firmly crossed, not knowing whether the students would ever have the opportunity to get into court at all.


So where are we now? Well, praise the Lord (Chancellor, that is) and pass the Civil Procedure Rules, we heard just before I began writing this article that the last major hurdle had been cleared and our application for litigation rights had been approved by the

Government Minister responsible. By the time you read this article, the enabling legislation should have been drafted and be ready to go to Parliament for enactment. All being well, ITMA should be in a position to issue litigator certificates from Spring 2005. Definitely? Well, barring unforeseen disasters (so I shall be touching wood on a regular basis until Her Majesty signs the paperwork)...

And what of the Patents County Court? We know that His Honour Judge Fysh, who presides over the PCC, has been actively seeking the extension of the jurisdiction of his court to Trade Marks. In early 2003, we were asked by the Government if we would support such a move and give it our blessing, to which we agreed.

At the time of writing this article, there are strong rumours that the Government is ready to put this jurisdictional extension to Parliament. It will not be definite until the Autumn, but I can predict that maybe, just maybe, the PCC will be opening its doors to trade mark cases from October 2004.

These changes mark the start of a new phase for ITMA, finally recognising our equality of status with our patent colleagues and giving us the chance to become the profession of choice for UK trade mark litigation. No matter what happens, it will definitely change the profession beyond recognition in the long-term. No more maybes.

None of this could have been possible without the dedication of those at ITMA who have worked ceaselessly, despite the endless frustrations, to achieve this goal. They know who they are, but I for one would like to give special thanks to the tireless efforts made by Nick Wilson before his untimely death. Future generations of ITMA's Trade Mark & Design Litigators will owe Nick in great measure, for these valuable rights. 

About the author

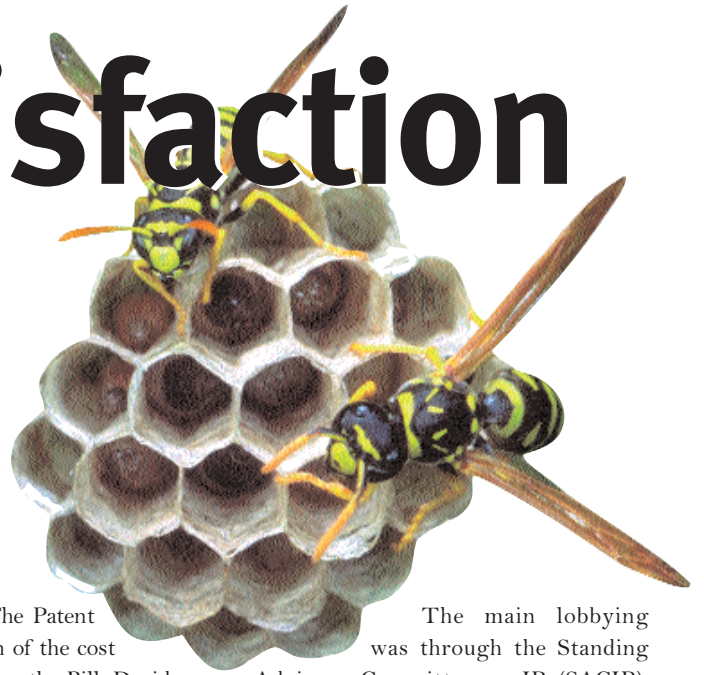
Philip Harris has been a partner at Gill Jennings & Every since 1996. He has been an active member of ITMA's Council since 1999, and is currently Senior Vice-President. A registered trade mark agent and solicitor, he specialises in dealing with aspects of choosing, registering and protecting trade marks around the world. He has represented clients in fields including toys and games, pharmaceuticals and fashion retailing.



Sweet satisfaction

🌿 Lobbying for the Trade Marks Act 1994

From November 1993 to July 1994 the Institute was working hard to influence a new Bill, as **Richard Abnett** recalls



In the two-year period leading up to March 1994 I was in the fortunate position of being President of the Institute, and the last months of my tenure were almost entirely devoted to work on the Trade Marks Bill. The real hard work was coordinated by John Groom, then Chairman of the Laws & Practice Committee. Many others in the Institute were involved and to give a complete list would leave little room for any other comment; suffice it to say it was a combined operation involving many people both on and off Council in contributing to the eventual, and successful, result.

Trade marks is not a highly emotive political issue in 2004, and was even less so in 1994. Engaging the interest of members of both the Commons and the Lords was not easy. We were fortunate in having the active and helpful support of Iain Mills in the Commons, but in the Lords, following the sad death of Lord Lloyd of Kilgerran a year or two earlier, there was no one with trade mark experience who was willing to represent the Institute's views.

What made up for this was the very real help and cooperation we received from the Trade Marks Registry, who took all our comments on board, considered them carefully, and put them up to the Department of Trade and Industry (DTI) and Parliamentary Draughtsmen.

And we certainly had comments to make. The Trade Marks Bill broke the record for the number of amendments put forward during its passage through Parliament. For a Bill that was supposed to be implementing a European Directive, and thus where there ought to have been relatively few policy decisions to be made, this is astonishing, and reflects the difficulty that the Parliamentary Draughtsman, with little experience of intellectual property, had in understanding, interpreting and applying the principles enshrined in the Directive.

The first obstacle was to persuade the Conservative Government to put the Bill into

the Queen's speech at all. The Patent Office asked for an indication of the cost savings that might result from the Bill. David Tatham and I worked on this and between us produced estimates as to the cost saving to British industry; a major element of which was the reduction in costs which would result from simplification of the assignment provisions. We were asked to produce these figures in a very short time period of a small number of days, and David and I generated a succession of estimates, each larger than the one before. The more we thought about it, the bigger the figures seemed to grow. Eventually they found their way into the explanatory memorandum for the Bill in the form of a sentence "Savings for UK businesses generally are likely to be in the region of £55 million in the first year after commencement, and £30 million per annum thereafter". Thankfully, we shall never know how accurate our estimates were.

Once the Bill *was* in the Queen's speech, panic ensued. The Government decided that because of its relatively non-controversial nature, it would start in the Lords, and it would start straightaway. So, whilst it was mentioned in the debate on the Queen's speech on the 24 November 1993, and the Bill was published that day, the second reading took place in the House of Lords on 6 December 1993 and the detailed discussion of amendments began on 13 January 1994. We had to get our views in place extremely quickly and this was done by convening a small committee based on the Laws & Practice Committee, coordinating with others with a similar interest, including: the Chartered Institute of Patent Agents, a number of solicitors, Christopher Morcom QC of Counsel, and, from industry, Alan Cox, Robin Hadfield and our own David Tatham, then at ICI. I still have the notes of a meeting on 9 December 1993 where a common approach was hammered out between these parties and detailed amendments prepared on a clause-by-clause basis.

The main lobbying was through the Standing Advisory Committee on IP (SACIP). Sadly, this committee was disbanded a couple of years ago, but at that time it provided the main consultation route for the Patent Office and it was very active in the period January to March 1994, having several meetings at which detailed wording was discussed and hammered out. These meetings were generally chaired by Alison Brimelow, Head of the Trade Marks Registry at that time, ably assisted by others including, in particular, the perpetually-cheerful Mike Knight. They cannot be thanked enough for the help that they gave ITMA at that time.

But the amount of work that was done by ITMA is not to be underestimated. A detailed clause-by-clause study of the Bill during December 1993 and January 1994 culminated in a paper prepared by John Groom for the Institute and circulated to all members on 31 January 1994, explaining the issues that the Institute intended to move forward with, and asking for comments both on those and on any possible omissions.

We were gratified that the membership did not come up with much that the committee had not already thought of. While we discarded the idea of using professional lobbyists to press forward our amendments, the exercise would have been immensely more difficult without the assistance of The Russell Partnership, Government and Public Affairs Advisors, who provided us on a daily basis with Hansard extracts and oral and written answers from both the Commons and the Lords throughout the proceedings. Thus, we were never more than a day behind what was happening in Parliament. This was all before the internet and email, and just obtaining basic material of this nature was, at that time, virtually impossible without professional assistance.

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The route the Bill took was unusual. Having gone through the House of Lords Scrutiny Committee, it then went to a Public Bill Committee. This consisted of sixteen Lords who went through the Bill clause-by-clause taking amendments over a total of four sittings, on 13, 18, 19 and 20 January 1994. It is rare for a Bill to be hived off to a committee like this, but it certainly proved to be a very effective way of examining the Bill in this case, as the sixteen Lords involved put their backs into getting an understanding of what the Bill was all about. Those most involved were Lord Strathclyde, steering the Bill on behalf of the Government, and Lord Peston for the Labour opposition (he was the speaker at our Dinner Dance that year). Others took an active and helpful interest, notably Baroness Hamwee, Lord Cawley, Lord Reay and the Earl of Harrowby, though picking those out is perhaps unfair to all the others who made their contribution. Notably one of the

members of the Committee was Viscount Goschen, whose father (or was it grandfather?) was the author of the Report which led to the 1938 Trade Marks Act.

With the Committee stage already completed, the panic was getting serious. Report stage in the Lords took place on 24 February 1994, and at this point the amendments that the Institute had formulated in the 31 January 1994 paper started to be taken on board. The third reading followed not long after on 14 March 1994. Then it went to the Commons, the second reading taking place on 18 April 1994, after which it went to Standing Committee, which dealt with it in a single sitting on 17 May 1994, and whence it returned for third reading on 20 June 1994. Finally, it went back to the Lords for the Commons' amendments to be considered on 15 July 1994, and these being agreed with, we then had an Act.

We recognised early on that the real work of amendment was being done in the Lords and if we did not get it right before it left the Lords, the chances of putting it right thereafter would be slim. A lot of work took place in February and early March so that this could be achieved. The main points where ITMA felt the Bill had it wrong were these:

- Honest concurrent user – there were no provisions in the original Bill and they are

now in the Act.

- Comparative advertising – now the subject of Section 12(6) of the Act, with much improved wording.
- Groundless threats – again the wording was improved from that originally proposed.
- Grounds for cancellation – whether they could only be brought by a person aggrieved.
- Disclaimers – we argued that a compulsory disclaimer as a condition of registration for a non-distinctive element of a trade mark was beneficial for all.

We were not successful on all of these, and in particular on the person aggrieved point and on disclaimers we failed. We still felt disclaimers to be important and made more than one attempt to include this in the Bill. Perhaps the full story of that failure can now be told.

After second reading in the Commons, we were left with two amendments that we felt were sufficiently important to be pursued further. One of these was the disclaimers issue, but the second was a topic which had been deliberately omitted from the Institute's memorandum of 31 January 1994. It may not seem an issue now, but at that time there was considerable

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controversy surrounding the proposed use of the expression "Trade Mark Attorney", and we wanted to have it accepted as a proper description of our business.

Thus, we sought to add what is now Section 86 to the Act, making it clear that Registered Trade Mark Agents could use the term "Registered Trade Mark Attorney". We knew this would be contentious, and the submissions on this point were not put to the Patent Office at the same time as the other substantive points. When the Bill came to the Commons in April 1994, the Office made it clear to us that we could only hope to get *one* further substantive amendment incorporated. On the table we still had two: disclaimers, and Trade Mark Attorney. While regretting how British industry would suffer as a result, we went for Trade Mark Attorney.

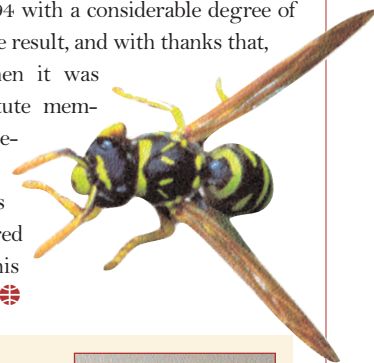
All proposed amendments had to go out to SACIP members for consultation, and this one went out on a Monday with a return date for comments on the Thursday. With this short timetable, it had to be turned round very quickly, and the person receiving it in the Law Society had no time to refer back for instructions, and replied simply stating that the term "Attorney" has no status in British law, and that the Law Society has no power to control it. It was certainly

the view of a number of solicitors that they were opposed to anyone not having general legal qualifications being able to use the term "Attorney", but the overwhelming majority of SACIP members thought that there was no valid reason why Registered Trade Mark Agents should not be able to use the term "Trade Mark Attorney". The amendment was approved by the Commons without a vote.

Overall, the Bill was vastly improved during its progress through Parliament, and the Institute should take a large proportion of the credit for achieving that. Jeremy Pennant in August 1994 produced a summary memorandum of the main changes from the first print of the Bill to the Act, where the Institute's work had made a material difference. In the case of many of these, what we had succeeded in doing was maintaining the wording of the

Bill based on the Directive in the face of attempts at amendment from members of Parliament or indeed the Parliamentary Draughtsman.

We are unlikely ever in trade mark law to have another statute as fundamental as the 1994 Act, given that law-making in this area has effectively been taken over by Brussels. We, and I hope future generations, can look back at the work of the Institute over the months from November 1993 to July 1994 with a considerable degree of satisfaction at the result, and with thanks that, at the time when it was necessary, Institute members were prepared to put in all the resources that were required to achieve this happy outcome. 🍷



About the author

Richard Abnett is a Registered Trade Mark Attorney and a Fellow of ITMA, having been its President for 1993-1994. He has just retired from 20 years continuous service on ITMA Council. Richard Abnett started his professional career with Reddie & Grose, London, in 1966, and qualified initially as a Patent Agent, becoming a Trade Mark Agent in 1980. He has remained with Reddie & Grose throughout, and is now Senior Partner.



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Red-letter days

🌀 Highlights of a trade mark career

The trade mark world is a great one to be part of according to **Keith Havelock**. Here he remembers a few personal high points of his professional life time in trade mark practice

In the course of a professional lifetime in trade mark practice, roughly coinciding with the last four decades of the Institute's existence, there have been many red letter days. Some of mine will correspond to those of fellow practitioners, but some will be more personal.

No doubt we all cherish that all-important moment which heads my list: the day on which we learn we have passed the examination. At last one can, to a certain extent, relax, probably for the first time after years of education and other examinations, and begin to build up that essential experience vital to the creation of a successful professional career.

Next, one may take part in a first Institute event, whether as a lecturer, speaker or panel member. Mine was a debate when, together with three other younger members, we put forward the pros and cons of a European trade mark system.

Then there is the time when you see one of the proposals – such as the one we debated, the Community Trade Mark – actually coming into effect and taking part in its development. Its effect upon your day-to-day activity may be salutary. Trade mark practice has, however, always had the advantage of being a dynamic activity. Something is always happening; not always good, but at least nothing ever stands still.

You may have the satisfaction, as we did in the period leading up to the 1994 Act, of seeing your labours in the preparation for important new legislation bear fruit in the shape of clauses being included in the legislation for which you have fought. The

day on which such an Act actually comes into being is one to remember. Similar considerations apply to influencing new official practices or statutory instruments, such as those relating to mixed professional partnership.

Joining the Institute Council may also be something which appeals and if it does, the day on which you are elected to that august body is a highlight. You may even aspire to become President, and if that is your intention then good luck to you. Whichever way you look at it, there will be many worthwhile jobs to do as a Council or committee member.

Then there are anniversaries and parties, the golden jubilee of the Institute at the Guildhall, for example. Trade mark attorneys are friendly people who enjoy each others' company, preferably in pleasant places with plenty of good food and drink!

Trade mark practice is such an international business too. This calls inevitably for occasional trips to other parts of the world – sometimes quite remote ones – to attend conferences, presentations, meetings or other events involving our clients or companies. There is usually time to look

about, to broaden your outlook. I'm sure we all have our favourite destination. Sometimes it's almost like being on holiday (I did say almost), for example when INTA was held in New Orleans, my particular favourite destination.

Another pleasure may be seeing a fellow practitioner's or colleague's efforts recognised by way of an accolade or formal honour, such as Elwyn Roberts' MBE some years ago or, more recently, the similar award to Margaret Tyler.

Of the original objectives of the Institute when it was formed 70 years ago, many have been achieved: the Register, professional privilege, continuing professional development. Much dedicated work has been put in by many people with vision.

Our trade mark world is a great one to be part of. Don't take the distinction of being part of it lightly, but equally don't let the daily stresses of work become too much of a burden. It is only part of life, albeit a most important part.

As you pursue your trade mark career, *the* distinctive professional career, I think you will also find that there will be plenty of red letter days. 🌀

About the author

Keith Havelock was formerly senior partner of D Young & Co, European Patent and Trade Mark Attorneys of London and Southampton and is a Past President and Chairman of the Laws and Practice Committee of ITMA. He is currently Secretary General of the European Communities Trade Mark Association.

