

THE INSTITUTE OF TRADE MARK ATTORNEYS



**Consultation on changes to the education,
training, and qualification arrangements
relating to Registered Trade Mark Attorneys and
Membership of ITMA**

June 2008

Introduction

This Consultation Paper seeks views on proposals for significant changes to the way in which the Institute deals with the education, training, and qualification of new entrants to the profession.

With the establishment of a central regulation system for Trade Mark Attorneys and other providers of legal services under the Legal Services Board, pursuant to the Legal Services Act 2007, the Institute will have to demonstrate that it has training, education and qualification arrangements that are fit for purpose and compare with the arrangements in place for other professions which provide legal services.

Having reviewed the arrangements, ITMA Council has determined that they are not delivering all that they should for students and employers alike. As described below, it is believed this largely due to systemic issues. ITMA proposes to address this by introducing a structured, professionally taught and examined package of courses, this to be accomplished before responsibility for the regulation of the profession (and responsibility for laying down standards of education and standards for qualification) are handed over to the joint CIPA/ITMA Intellectual Property Regulation Board (IPREG) under the supervision of the Legal Services Board.

Set out below are the findings of the review together with outline proposals on which the Institute would welcome the views of stakeholders before taking matters further.

The findings of the review

The evidence showed that recruits to the profession are on a par in terms of education and skills with those recruited to other legal professions. There is no evidence that trainees are other than diligent, competent and fully committed to the qualification process. There is no evidence that the subject matter is any more or less complex than other areas of the law. However, as is well known, the pass rates for the examinations for qualification as a Trade Mark Attorney are consistently significantly lower than those for qualification in other comparable, legal professions, and candidate ability not infrequently fails to be a guide in actual performance, for no obvious reason. If one accepts, as we do, that as a profession we are recruiting able candidates who could normally be expected to achieve reasonable passes in other similar professions, then it follows that the system itself must be at least a contributory element in the performance problem.

Furthermore, the evidence suggests the examinations no longer reflect the professional roles an Attorney should be expected to fulfill. It is clear that the

training and qualification processes are historically narrowly focused on the law and on the minutiae of technical procedure and practice in the UK, Europe and in relation to the International registration system. This reflects the fact that in the past Attorneys acted primarily as registration agents. The role of Attorneys today is more wide ranging, yet the qualification process contains no requirement for students to train or be examined in skills many of us now use every day, such as evidence, client care, advocacy, ethics, negotiation skills and agreement drafting, all of which are competencies and skills required by a typical Trade Mark Attorney in today's market place.

The Review suggested that there are a variety reasons for the current situation, the principal ones being:

A lack of training/experience in firms;

A lack of structured or focused academic or practical education that develops with the needs of the profession;

In question setting, an emphasis on technical difficulty and exceptional scenarios rather than on testing essential competencies;

The absence of external monitoring;

A lack of training for Examiners in how to set and mark examinations;

A lack of coordination between the trainers and those who set examinations.

Change is also driven by the practical difficulties we face in continuing to resource a "do-it-ourselves" system. The teaching of the subject matter and the setting, running and marking of examinations is time-intense and places enormous burdens on JEB Members, Examiners and tutors alike, at a time when the pressure to work longer professional hours is increasing. The number of volunteers available to teach, set and mark examinations is correspondingly diminishing.

There are, of course, some advantages to the current system, but these are outweighed, in the view of ITMA Council, by the disadvantages, The principal advantages and disadvantages we identified are listed at Annex A.

Overall, Council does not believe that the current system of training and educating trainees is one which would withstand scrutiny by the regulatory authorities, going forward.

Question 1: *is the analysis flawed: has anything been overlooked, such as factual data, advantages or disadvantages which would cast doubt on the views reached?*

Recent Developments

The Report by Professor Sherr some years ago on the training and education of the IP professions, and the subsequent discussion groups, considered the qualification routes, but no practical or coherent proposals emerged. The forthcoming regulation regime and the transfer of responsibility for the subject to IPREG (and, ultimately, the Legal Services Board) mean that the time for theoretical thinking has passed and we must take immediate and pragmatic steps to address the issues and produce practical and comprehensive proposals before direct control and influence passes elsewhere.

Other professions have developed training/education and examination models which are based on professionally taught and examined packages of courses. Under these models, good, capable candidates can reasonably expect to pass on a first or second attempt despite the subject matter and training requirements being every bit as demanding as those in our field, if not more so. It is these models that the regulatory authorities are likely to look at as the “norm” and the benchmark against which others are judged.

Question 2: *do you agree that the time has come for the Institute to put in place a revised system for training, educating and examining trainees, before one is imposed?*

Proposals for change

A 2-stage external course

First of all, given the problem of the diminishing number of volunteers and the disadvantages in the current system, the proposal is that ITMA (and subsequently IPREG) should move from being a self-examining body to one which is a validating body for externally taught and examined courses. Given the role of a Trade Mark Attorney in industry and commerce today there should not only be an academic stage in the qualification route, which will ensure the application of knowledge and experience of “black letter” Trade Mark law and practice, but also a vocational stage which enables the trainee to develop and show the practical competencies (such as advocacy, evidence management, case theory, search skills, negotiation, agreement drafting) required of a Trade Mark Attorney today. It is expected that of necessity professionals will continue to play a major role in imparting knowledge to students.

Question 3: *do you agree that the trainee should in future be expected to show not only the academic/intellectual ability required to serve a range of clients, but the technical and inter-personal skills and competencies to handle a wide range of commercial and legal situations? If not what should be taught and tested?*

Course content

The academic stage would be a Trade Mark & Design Law course covering the areas set out in Annex B; this would be taken as the first step in qualification (being broadly equivalent in effect to the academic stage of training in other legal professions). This would result in the award of a Certificate in Trade Mark Law. QMW and other providers could be validated to provide such a course.

The vocational stage would be a Trade Mark & Design Professional Practice Course covering areas such as those set out in Annex C. It would include some Litigation skills, so that all new entrants to the profession would have at least basic “conduct” rights on registration. This would put Registered Trade Mark Attorneys in a similar position, at qualification, to CIPA members who have automatic PCC “conduct” rights (evidence suggests that there is little appetite for PCC “audience” rights to be taught at this stage, notwithstanding CIPA Members have such rights).

Question 4: *are you content with the general content of these two stages? Are there any items (such as advocacy) which should be omitted or added? Why?*

Mandatory courses; experience in practice; exemptions

It is proposed that these courses should be compulsory. This is partly to ensure viability – once the courses are run successfully and pass rates increase as expected, the current examinee numbers (swelled by repeat candidates) will fall. Thereafter, we estimate a demand for 35 students each year.

Mandatory training is a common feature of the other professions and it is believed most trainees will be more than familiar with the commitment and funding obligations that will put on them. It is also important that the course is compulsory to ensure that training and candidate consistency can be maintained, bearing in mind the obligations on ITMA (and, in the future, IPREG as a regulator to ensure consumers’ interests are protected by properly established and implemented training standards.

It is suggested that both courses could be taken before or after a trainee enters practice but that entry onto the Register would be on the successful completion of both courses, **plus a minimum period of two years’ relevant practice experience under supervision**, to be evidenced by a training log kept by the trainee and countersigned by the supervisor. Guidelines will set out the types of experience that will be taken into account and the supervisory requirements.

There may be limited exemptions from the Law papers for those with other legal qualifications (eg a basic Law Degree). Because of “regulatory standards” issues in other areas, ITMA has decided in principle that a degree will be required for

entry to the profession in future but is investigating whether that is in fact necessary or appropriate.

Question 5: *do you agree that a compulsory training, education and examination programme leading to qualification is the way forward? Is a period in practice before entry to the Register of benefit? In either case, if not, how should the profession manage entry into the profession and demonstrate consistent, transparent and measurable standards? To what extent are exemptions appropriate?.*

Transitional arrangements; course delivery options

Transitional provisions for existing trainees will need to be put in place, for example it might be possible to offer them the choice of continuing to sit the existing exams for a set number of years or to transfer to the new scheme (possibly just to the Practice Course for those who have passed the Foundation papers)

Delivery modes, testing and course timetables need to be determined but the Certificate course in Trade Mark Law is unlikely to be of less than 3 months' full time teaching (alternatively spread over a longer period of time, and to include distance learning, to allow candidates to work alongside study). The Certificate will be awarded after examination. The Practice course can include a mix of assessment arrangements.

Question 6: *do you agree that there should be transitional provisions of the kind outlined? Should the delivery methods be sufficiently flexible to cover a range of situations and pockets?*

The starting date for the new scheme

Currently, we hope that the start date for the Academic stage will be September 2009, although that depends on progress over the next few months.. We believe the Practice course should be introduced simultaneously to allow existing students to transition, if they so wish, the course being treated in effect as the Finals.

Conclusion

It is clear from our analysis that change to the education system of some kind is necessary if ITMA is to meet the challenges ahead. ITMA believes the proposals outlined above can meet those challenges. We hope that as many stakeholders as possible will help us to shape the future of our training and qualification arrangements by giving us their constructive views.

Your contribution: responding to the consultation.

The views of members of the Institute, Registered Trade Mark Attorneys and other stakeholders are welcome.

The closing date for this consultation is Friday 1 August 2008.

Answers to the questions, and other views and comments, should be sent to:

The Secretary

The Institute of Trade Mark Attorneys

Canterbury House,

2-6 Sydenham Rd,

Croydon, Surrey,

CRO 9XE

Responses may also be submitted by email sent to tm@itma.org.uk.

All responses should be headed "Education Reform"

What happens next?

Although we cannot enter into correspondence with respondents, we shall take responses into account as we develop our proposals for change.

We may publish a summary of responses and we may both list Respondents and quote from their submissions. If you wish your response to be treated confidentially please make that clear in your response.

Once this consultation is concluded we expect to have discussions with various stakeholder groups to identify particular issues that need to be taken into account.

Annex A

Advantages of the current system

It is perceived that because the examinations are hard to pass, even by the most able candidates, they can be relied on as a rigorous test of skill;

Most candidates that do pass undoubtedly possess significant expert knowledge;

The lack of compulsory or formal training relieves firms of the burden of education

Disadvantages of the current system

The high failure rate causes reputational damage to ITMA.

Candidates do not have faith in the system (many are often mystified by their results, both passes and fails);

The lack of any external monitoring means the examinations lack a guarantee of fairness, quality or consistency as a true test of ability;

The practitioners who do the training have no 'training' qualifications or experience;

Candidates who pass may have detailed knowledge of certain areas, but the exams may not have equipped them to be well-rounded attorneys;

Vital skills, such as evidence preparation and contentious skills, are in effect not taught at all;

Repeated failure and the absence of any link between teaching and examinations leads to widespread disillusionment and low student morale;

Good candidates leave the profession, are deterred from joining or qualify as solicitors/barristers instead;

Firms experience long delays in getting candidates to "professional" level;

The lack of a proper training scheme means candidates' "time to revenue" for firms is significantly delayed.

Annex B

Certificate in Trade Mark Law

FOUNDATION LAW FOR TRADE MARK ATTORNEYS

Introduction to Legal Concepts

Sources of Law
Basic Principles
The European Union
Statutory Interpretation

General Law

Contract
Property
Tort
Law of Evidence (basics)

Intellectual Property Law

Introduction to Intellectual Property
Intellectual Property Transactions
IP Taxation
Patents
Confidentiality
Geographical Indications
Olympic Symbols
Overlap between Intellectual Property Rights
Comparative Advertising
Enforcement in the European Union
Intellectual Property Transactions – the concepts of transfer, licensing, franchising, delimitation/coexistence agreements.

TRADE MARKS & DESIGNS

Trade Marks

Law concerning the registration of Trade Marks

The definition of a trade mark in EU/domestic law

The UK system

The CTM system

The Madrid System

International conventions and agreements

International comparisons: US, Japan, a “deposit” country

The UK and OHIM Approaches

Application of the ECJ’s Principles

Absolute grounds for refusal

Relative Grounds for refusal

“confusing similarity”

Cancellation: non-use and invalidity;

Acquiescence

Enforcing registered trade marks

Infringement/defences

Threats

Counterfeiting

Criminal offences

Unregistered trade marks: the law of passing off in the UK

Theory

Causes of action

Defences

Relationship to infringement/unfair competition

Comparative law:

France/Germany

United States

EU/UK Competition law and trade marks; unfair competition

Internet issues

Domain names etc

Trade/business/Company names

Designs & Copyright

Introduction (including Basic Principles of Copyright Law)

International Agreements

Community Design Rights/UCD

UK Registered Design Rights

UK Unregistered Design Rights

Relationship of designs to copyright

Infringement/enforcement

Defences

Annex C

Trade Mark and Design Professional Practice Course

Trade Mark Searching/comparison
Client skills
Case management and preparation
Letter and advice skills
Evidence
Basic Advocacy (written and oral)
UK/OHIM procedures/key practice points
Negotiation/agreement drafting
Proper use of TMs
filing strategies
Professional ethics/conduct
Tribunal and litigation skills
IP property/title issues
IP taxation
Relevant business law and practice
Comparative international practice (limited to eg US, Japan, Germany)