

New Qualification Requirements for a UK Registered Trade Mark Attorney

A. Introduction

We believe we have worked out the final structure of the new qualification system. There are still some finer details to work out not least because IPReg is now responsible for the qualification system and we need to organise transfer of that responsibility to IPReg.

B. Recent Changes

1. Delay to introduction of the new qualification system

As has been discussed at various meetings the starting date for the new system will now be September 2010. The delay has been primarily due to the economic turndown and the historically low levels of students entering the profession over the last 12 months (with no change imminent).

2. Extension of membership requirements

Due to the fact that IPREG will take over the running of the qualification system it is necessary to have consistency with other bodies who are also regulated by the Legal Services Board. In this context it means in the future students are likely only to have to be members of one body (ITMA, CIPA or the Law Society). You will still however have to go through the qualification system.

C. Format of the Qualification system

Most of this has been set out in previous documents but to pull everything together into one place we have set out below an overview of the new system. The detail of the system is set out in the attachments.

1. Law Course

This course will be run by Queen Mary (QM) and the syllabus is not significantly different from the present syllabus. The difference will be that the course will be taught and examined by QM which should bring more consistency and accountability. The course will be externally moderated and audited. In summary the course will comprise 4 modules comprising roughly 7.5 days teaching each (30 days total):

- Foundations of Law for Trade Mark Practice
- Trade Mark Law A (Basic)
- Designs & Copyright Law
- Trade Mark Law B (Advanced)

The format of the course will be a two weeks intensive course focusing on the first two modules followed by four days teaching per month for five months.

The detail of the syllabi and content of the course is attached at Annex A.

The courses that currently give an exemption from the Foundation papers will be assessed (overseen by IPREG) to see what exemptions will be given from this new QM course.

2. Practice Course

This course will be run by Nottingham Law School (NLS) and will combine the teaching of new skills with testing of the practical skills required to be a Trade Mark Attorney. NLS are writing a bespoke course for ITMA which will concentrate on the practical application of the knowledge and the skill. Again the course will be externally moderated and audited. In summary the course will comprise 3 modules:

- Introduction to trade mark practice and client relationships skills (including interviewing)
- Litigation and tribunal practice and procedure and advocacy
- Professional and self-management

The format of the course will consist of 23 days attendance, divided into four 4-day weekends, two 2 day assessment blocks and one 3-day block. The course will be spread over a period of 12-18 months.

The detail of the syllabi and content of the course is attached at Annex B.

3. Experience Requirement

There is already an Experience Requirement to qualify as a trade mark attorney and the only change will be to bring a light touch assessment. Students will be required to keep a training diary which must demonstrate that they have covered the major areas of Trade Mark Practice in the course of their training. It is likely that a minimum of 20 hours per year will be needed to be spent in each of the core areas of trade mark attorney practice - Prosecution work (CTM or UK), Oppositions/Cancellations (again CTM or UK), Maintenance (eg renewals, assignments, Changes of Name), Searching, International Filing through the Madrid Protocol, Portfolio Management outside UK.

Most students will be required to keep a diary for 2 years, the main exceptions to this will be some transitioning students and solicitors.

4. Timing

The timing of the new courses has been put back to September 2010. Subject to demand there will be transitional measures in place to allow students to move from the existing qualification system to the new one.

The existing JEB trade mark examinations will stop in 2010 for T1, T2 and T5 Foundation Papers and in 2011 for Advanced Trade Mark Papers. There will be retakes for the Advanced Papers in 2012 but for a maximum of two Advanced Papers, students will not be allowed to retake all three papers. Please also note that by their very nature these retakes will only be available to those who have taken the papers before.

5. Transitional provisions and Exemptions

Feedback all along the process is that it would be good if students could move to the new course if they wanted to. This transition process needs to:

- balance the need for maintaining the current standards without making the process too difficult and lengthy
- try and avoid students being tested on material on which they have already passed an exam but balance that with the fact that the new system does not map directly onto the new system;
- not be unduly expensive

These transitional provisions will only apply to current students (being student members of CIPA or ITMA). New entrants to the profession will now only be able to qualify under the new system with any appropriate exemptions.

To summarise the exemptions:

- For students who have passed one or more foundation papers there are some exemptions from the modules of the QM course.
- For students who have passed all the foundations papers (but no finals) or have taken a course which has been granted an exemption from the foundation papers it will be necessary to take and pass the Trade Mark Law B (Advanced) and the NLS course. If there is sufficient demand the QM Module 4 may be taught in May this year to assist students in this position.
- For students who have passed all the foundation papers and either T3 or T6 it will be necessary to pass a shortened version of the NLS course. This course will focus on the Trade Mark Practice elements of the NLS course and only teach two or three of the general legal skills that will be taught on the full NLS course. The rationale for this is to test Trade Mark Practice to the same level as the existing system and to add on some skills but not to impose on relatively mature students all the new skills requirements of the new course.

- For solicitors or barristers who also seek to qualify as trade mark attorneys it will be necessary to pass three modules of the QM course together with the shortened version of the NLS course described above. The rationale here is that solicitors will have been through the general legal skills as part of their training and so to avoid duplication only the IP focussed aspects are taught and tested.

To encourage more experienced IP solicitors to dual qualify a further exemption may be available from the QM course meaning that someone who has practised soft IP for at least 2 years will only have to take the Trade Marks B module at QM and the shortened NLS course. We are awaiting feedback from IPREG on this point.

A table setting out the exemptions and a timeline document showing how students at various stages of the process will qualify is shown at Annex C.

It is intended (numbers permitting) to run the shortened NLS course from September to December 2010. This shortened course will only be available to transitioning students who have passed T3 or T6 or solicitors/barristers. Other transitioning students will have to take the full NLS course.

Transitioning students that have been in the profession for at least 2 years by January 2010 would only be required to keep a training diary for one year as opposed to the two years required for other students.

6. Exemptions for new starters

For new students to the profession or those who chose to transition to the new system without passing any of the current exams, exemptions will be available to solicitors, experienced solicitors and to those who have passed appropriate courses.

7. Miscellaneous

1. Regulation by IPREG

As highlighted earlier how to qualify to be a trade mark attorney will come under the remit of IPREG, the regulator appointed by the Legal Services Board to regulate the IP profession. The roles of ITMA, CIPA and JEB in this area will be absorbed into IPREG.

IPREG has reviewed and approved these proposals and indeed some of the more recent changes are as a direct result of their requirements. Regulations setting out the new route to qualification and the closure of the current system will be published over the coming months and come into formal effect later this year. For this reason ITMA, CIPA and JEB are proposing minimal changes to the current constitution and regulations as there will be wholesale changes soon.

IPREG also regulates qualified attorneys and firms within the IP profession and will take over responsibility for the Register of Trade Mark Attorneys and Chartered

Patent Attorneys from the IPO. With the interests of the consumer at heart IPREG has announced its clear intention that all registered trade mark attorneys will have to be a member of a body that is regulated under the Legal Services Act. In practice this is likely to mean that all attorneys will have to be a member of CIPA, ITMA, Law Society or the Bar Council. In the future it will not be possible to be a registered trade mark attorney unless you are regulated by one of these organisations.

This is relevant to students as in the past it was possible to apply to JEB without being a member of ITMA or CIPA and still pass the exams and go onto the Register. IPREG will change this anomaly and we understand that whether under the current system or under the new system students will only be permitted to take exams after 2009 if they are members of a regulated body.

2. Educational Qualification

Students who pass the whole QM or NLS course will also obtain an educational award as well (either a Certificate or a Diploma). It should be possible to study further at one of these institutions and attain an LLM if so desired. Please note though that if a student is exempt more than a certain amount of each course then an educational qualification will not be awarded.

Annex A

TRADE MARK LAW A

Registered Trade Marks in the UK

Trade Marks in Europe – National Registrations
The 'Harmonisation' Directive
The role of the ECJ
Who may apply – Basis of application
Absolute grounds
The relevance of the 'specification'
The 'sign' requirement
Graphical representation
The concept of distinctiveness
Distinctiveness acquired through use
Deceptive signs
Functionality
Relative grounds
The concept of global appreciation
Identical signs and goods or services
Confusion
Marks with a reputation
Trade names – company names
Other rights
The role of UKIPO
Application procedure
Oppositions
Appeals
The Appointed Person and the Courts
Exploiting a trade mark registration
Assignments
Licensing
Franchising
Security interests
Due diligence exercise

The Community Trade Mark System

Trade Marks in Europe – Community Trade Mark Registrations
The CTM Regulation
The architecture of coexistence
Conversion
Seniority
Who may apply – Basis of application
Absolute grounds
The 'sign' requirement
Graphical representation
The concept of distinctiveness
Distinctiveness acquired through use
Deceptive signs
Functionality
Relative grounds
The concept of global appreciation
Identical signs and goods or services

Confusion
Marks with a reputation
Other national rights
The role of OHIM
Application procedure
Oppositions
Appeals
Boards of Appeal
The role of the CFI and the ECJ
CTM Transactions

FOUNDATIONS OF ENGLISH LAW FOR TRADE MARK ATTORNEYS

Foundations of Law – General Principles

Classifications of law
Court structure
Sources of law
Precedent
Statutory interpretation
The European Union
Contract
Property – real and personal
Tort
Equity
Introduction to civil procedure
Introduction to evidence law

Foundations of Law – Intellectual Property

Introduction to intellectual property
Patents and related IPR
Confidentiality
Overlap between intellectual property rights
Remedies and enforcement
Geographical indications
Olympic symbols
Intellectual property transactions
IP taxation

Foundations of Trade Mark Law

Basic principles of trade mark law
Systems of protection – registered and unregistered trade marks
Systems of registration (including an introduction to the Community Trade Mark), An
introduction to unfair competition
International agreements (including introduction to the Madrid System)

TRADE MARK LAW B

Registered Trade Marks in the UK

Maintaining a registered trade mark
Challenging a trade mark registration
Revocation
Invalidity
Evidence of use
Renewals
Scope of protection
Infringement
Defences
Enforcement
Comparative advertising and other special topics
Mock trial exercise

The Community Trade Mark System

Maintaining a CTM
Challenging a CTM registration
Revocation
Invalidity
Evidence of use
Renewals
Scope of protection
Infringement
Defences
Enforcement (see also EU enforcement under Foundations above)

International Agreements

The 'umbrella' of Paris
The Madrid System
The Relationship between the Agreement and the Protocol
The Agreement
Who may apply – Basis of application
A 'bundle' of national rights
Application and registration process
Central attack
Renewals
The Protocol
Who may apply – Basis of application
A 'bundle' of national rights
Application and registration process
Central attack
Renewals

Protection against 'unfair trading'

Passing off, injurious falsehood, other torts
The European dimension
Consumer protection
Geographical indications
Human rights

Comparative Trade Marks and Unfair Competition

Overview of the law of registered trade marks in the U.S.A., Japan, Brazil, Russia, India, China, South Africa, and other jurisdictions

Overview of protection against unfair competition in the U.S.A., Germany, France, Australia, and other jurisdictions

DESIGNS & COPYRIGHT

Introduction to designs & copyright

Forms of design and property protection
Basic principles of design law
Basic principles of copyright law
Introduction to international agreements in design and copyright law

Community designs

Registrable designs
Proceedings for registration
Scope of protection – infringement and defences
Cancellation and invalidity of registration
Ownership of designs
Transactions in designs
Proceedings in relation to designs
International registrations
Unregistered Community designs

United Kingdom registered designs

Registrable designs
Proceedings for registration
Scope of protection – infringement and defences
Cancellation and invalidity of registration
Ownership of designs
Transactions in designs
Proceedings in relation to designs

Design right under the CDPA 1988

Subsistence of design right
Ownership of design right
Infringement of design right

Copyright law

Subsistence of copyright

Authorship and ownership

Infringement of copyright

Defences to copyright infringement

Moral rights

The relationship between copyright and designs law

Annex B

Trade Mark Practice Course

Module 1

Introduction to trade mark practice and client relationships skills (including interviewing)

Unit 1

Introduction to reflection and research skills

Introduction to client relationships skills

Introduction to intellectual property and title

Proper use of trade marks

UK trade mark searching, evidence, UK/OHIM procedure, filing strategies

Further client relationships skills

Ethics and professional conduct, drafting trade marks applications.

Unit 2

European trade marks

Client relationships skills (letters)

Agreement drafting, non-EU foreign trademarks and trade mark searching, evidence

Design rights and copyright

Preparation for interviewing skills assessment and filing/searching assessment

Module 2

Litigation and tribunal practice and procedure and advocacy

Unit 3

Interviewing skills assessment

Introduction to litigation practice and procedure, case analysis, litigation management

Introduction to tribunal advocacy, practice and procedure

Case management, budgeting and project management

High Court litigation practice and procedure, procedure, expert evidence, drafting, disclosure, case management directions.

Unit 4

Practical filing skills/searching assessment

Further litigation and tribunal procedure

Ethics and conduct in courts and tribunals

Injunctions

Advocacy skills

Preparation for the advocacy skills assessment

Assessments block

Unit 5

Advocacy and ethics skills assessment

Revision day for written examinations

Unit 6

Intellectual Property written examination

Litigation and tribunal procedure and evidence written examination

Module 3 Professional and self-management

Reflective learning and reflective practice

Professional management

Negotiation

Methods of Assessment

Module 1

Interviewing skills assessment

Practical filing skills/searching assessment

Intellectual Property written examination

Module 2

Advocacy and ethics skills assessment

Litigation and tribunal procedure and evidence written examination

Module 3

Reflective report

Annex C

QM Law course Modules	Solicitor/barrister exemptions	Exempt if student has passed:
Foundations of Law for Trade Mark Practice	exempt	Basic UK Law or has a Law degree with IP component (or equivalent) or has passed appropriate University Course*
Trade Mark Law A	Experience exemption	T1 or has passed appropriate University Course*
Copyright & Designs	Experience exemption	Existing C&D paper or has passed appropriate University Course*
Trade Mark Law B	None applicable	T3 or T6

Annex D – Theoretical Qualification Route

	Jan 2010	June 2010	Sept 2010	Sept 2011	Sept 2012
New student	Start training diary	-	Start QM course	Start NLS course	Finish NLS course (apart from reflective report) and qualify in January 2013.
New student who is a solicitor	Start training diary		Start QM course (exempt 1 module)	Start shortened NLS course and qualify in January 2012	
Transitional student with T1, UK Law and C&D	Start training diary	Take QM "transition" course Trade Mark B	Start NLS course	Qualify *	
Transitional student with T1, UK Law and C&D plus T3 or T6	Start training diary		Take NLS "transition" course and qualify* in January 2011		

Illustrative timetable:

* assuming the student has at least 2 years of relevant experience prior to Jan 2010 (self certification)