



# TRADE MARKS

A CAREER IN TRADE MARKS



The Institute of  
Trade Mark  
Attorneys

Letters:



A Personal Name:



A Slogan:

*"It's the Real Thing"*  
**Coca Cola**

A Word:

**Mars**

A Jingle:

*Air on a G-string*  
**Hamlet Cigars**

A Colour:



A Number:

A Sound:



A Form of Packaging:



A Smell:



A Logo:



A dog barking – Dulux

Darts smelling of beer – Unicorn Products Ltd



## What is a trade mark?

**A trade mark is essentially a way of identifying goods or services; differentiating between the goods and services of one trader and another.**

**It can take a variety of forms including, for example, a word, a slogan, a logo, a jingle, a colour, a smell, a shape, a sound, letters, a number, a form of packaging or a personal name.**

## Why do businesses need trade marks?

Businesses put a lot of time and money into developing and marketing a product or service. By giving the product or service a trade mark, the public can readily identify that it has come from a particular source.

A trade mark gives brand recognition. It helps guarantee the origin, quality and consistency of the goods or services and allows for brand extension.

Having a trade mark avoids confusion with others in the same line of business. It also enables action to be taken against anyone counterfeiting or copying a registered trade mark for similar goods or services.

Increasingly in today's technological age, trade marks mirror domain names and vice-versa. The advice from **ITMA – the Institute of Trade Mark Attorneys** – is that companies should, where permissible, register their domain names as trade marks as soon as possible and that it is also useful to register their trade marks as domain names to avoid cybersquatters getting there first.

For many of today's major companies a trade mark is a precious asset and can be worth millions of pounds. Like any asset, it must always be carefully looked after, using expert professional help where necessary.

## What does a trade mark attorney do?

Trade mark attorneys are professional advisers on a wide range of trade mark issues. They also advise on designs and copyright

Trade mark attorneys will be involved at an early stage in advising on the legal aspects of the marketing of new goods or services and their introduction into the market place. They will be responsible for advising a client on:

- a) whether their selected trade mark can be registered, i.e. whether it meets the criteria laid down by the relevant trade mark authorities. In the case of the UK this is the Trade Marks Registry of the UK Intellectual Property Office. This may involve working with the client on the creation of new trade marks;
- b) establishing that the trade mark is free to use – by conducting searches of the relevant Registers and searching for similar trade marks in the same or similar classes of goods or services;
- c) filing the application at the relevant Registry; paying appropriate fees; handling examination by the relevant Registry and dealing with any questions raised, either in writing or by attending Hearings; mounting defences to opposition proceedings should these arise; and seeing the application through to registration;
- d) handling renewals – in the UK this is every 10 years but it varies in different jurisdictions;

- e) using trade marks correctly in such areas as advertising and product literature and advising the client on portfolio management including expansion of protection, transfers of ownership, licensing and other developments affecting the client's trade marks; and perhaps most importantly;
- f) taking action on trade mark infringement and passing off;
- g) advising on designs and copyright issues.

## What does a trade mark attorney do about infringement?

Infringement can be a two way street with a client taking action against an infringer or the client itself being accused of infringement. In both cases the trade mark attorney has an important role to play. Potential conflicts are frequently resolved by means of letters of consent, co-existence agreements, undertakings as to future activities and other compromise solutions.

Trade mark attorneys will be involved in negotiating such settlements, and drawing up appropriate contractual papers. Trade mark attorneys will be expected to provide constructive and commercially sensible advice in this area. Litigation is always viewed as a last resort. However, if it comes to that, the trade mark attorney will be expected to provide back-up to solicitors and barristers conducting the case.

## Where do trade mark attorneys work?

### Private practice

The majority of trade mark attorneys work in private practice whether they are solely trade mark practices or, more often, combined patent and trade mark practices. In addition, firms of solicitors are increasingly developing trade mark departments. A full list of firms in the UK in which ITMA members work appears on the website [www.itma.org.uk](http://www.itma.org.uk)

### In-House trade mark work

Increasingly, large companies are developing specialist in-house trade mark departments to handle their own trade mark affairs.

There is scope for movement between private practice and industry and experience of both is positively welcomed.

In the UK most trade mark attorneys work in the London area, although many large firms have regional offices while some firms have established themselves as regional bases only.

### Career Path

Trade Mark Attorneys enter the profession as trainees within a firm; either in private practice or in a company. There are two sets of professional examination to take; Foundation level and Advanced level. These are discussed in more detail later.

Once qualified, and in order to remain a member of ITMA, trade mark attorneys have to undertake continuing professional development whereby they will be expected to attend a certain number of educational events/conferences etc to maintain their professional knowledge and excellence.

There is no grade structure to the career (other than trainee and qualified) and the ultimate achievement is probably to become a partner in a firm, if not the owner.

## What qualifications are needed to enter the profession?

### Minimum requirements

The minimum educational requirements to enter the profession are GCSE A, B or C grade, or equivalent, in five approved subjects; and GCE 'A' Level, or their equivalent, in two approved subjects, of which one shall be English Language.

### Graduate entry

Candidates with certain degrees, such as Law, may be eligible for exemption from some of the Foundation Papers of the qualifying examinations. However, a degree in any subject is acceptable, and, indeed, desirable.

### Personal qualities

A trade mark attorney must be able to communicate effectively, both on paper and in person with clients and other advisers such as solicitors, barristers, marketing executives and others acting for third parties such as Government Officials and foreign associates. They, therefore need to be personable, able to work with others and be able to pay attention to detail as mistakes can be very costly. A knowledge of foreign languages is often desirable.

## How do you join a firm?

There is no central admissions procedure to the profession and prospective trade mark attorneys need to keep their eyes and ears open for opportunities.

These may appear as adverts in the national or local press or on the ITMA website. Many new entrants come into the profession by recommendation/word of mouth or quite often by having sent a CV to employers in areas they choose to work.

There are no set salaries for trade mark attorneys; each firm determines its own. However, remuneration is at least equal to that of other leading professions.

## What training is given to trainee trade mark attorneys?

### Courses

The Institute of Trade Mark Attorneys runs a series of one-day lectures covering all the Foundation level papers. At the Advanced level there is a two-year day

release programme run in conjunction with Queen Mary, University of London. Annual residential revision courses for both Foundation and Advanced level papers are also available.

### In-House training

Most firms will provide on-the-job training, often supplemented with courses provided by the Institute.

## What professional examinations are needed to qualify?

### Foundation

There are five Foundation papers that a trade mark attorney must pass:

- **Basic UK Trade Mark Law**
- **Basic UK Trade Mark Practice**
- **Basic Overseas Trade Mark Law and Practice**
- **UK Designs and Copyright Law**
- **Basic English Law**

### Exemptions

Students who have a GCE in Law, a Law Degree, a Law Society Final Examination or Bar Final Examination are exempt from the Foundation Level Basic English Law paper.

Students who have a Law Degree (with IP Option) are also exempt from the Basic UK Trade Mark Law paper and the UK Designs & Copyright Law paper.

Students who have the QMW certificate in IP; the Manchester University IP Certificate; the Bournemouth University Certificate/Diploma/LLM in IP or the Brunel University Certificate in IP Law are exempt from all Foundation papers. They must all, however, pass the Advanced papers.

For a complete run-down of the examinations, please refer to the Examination Regulations on the Institute's website: [www.itma.org.uk](http://www.itma.org.uk)

### Advanced

There are three Advanced papers that have to be passed:

- **Advanced Community and International (Protocol) Trade Mark Law and Practice**
- **Trade Mark Searching**
- **Advanced UK Trade Mark Law and Practice.**

## **What is the Institute of Trade Mark Attorneys – ITMA?**

The Institute of Trade Mark Attorneys (ITMA) is the UK body dedicated to the promotion and protection of trade marks. It was established in 1934 and now has over 1,500 members throughout the world in various categories of membership. It is one of the few professional bodies of practitioners concerned primarily with trade mark matters.

Fellows and Ordinary Members of ITMA have all qualified to be entered on the Official Register of Trade Mark Agents. They are well qualified to practice in this field and are subject to stringent requirements for continuing professional development guaranteeing up to date knowledge of the subject matter.

## **What is the Register of Trade Mark Agents?**

The Register of Trade Mark Agents was established under The Copyright, Designs & Patents Act 1988 and is administered by the Institute of Trade Mark Attorneys. All of those who are successful in the examinations detailed above can be entered on the list, providing they have completed a minimum of two years practising as a trade mark attorney.

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