

# From Agent to Attorney: A niche profession and a trajectory for access to specialist justice.

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# Trade Mark Law – a tale of trains and boats and planes...





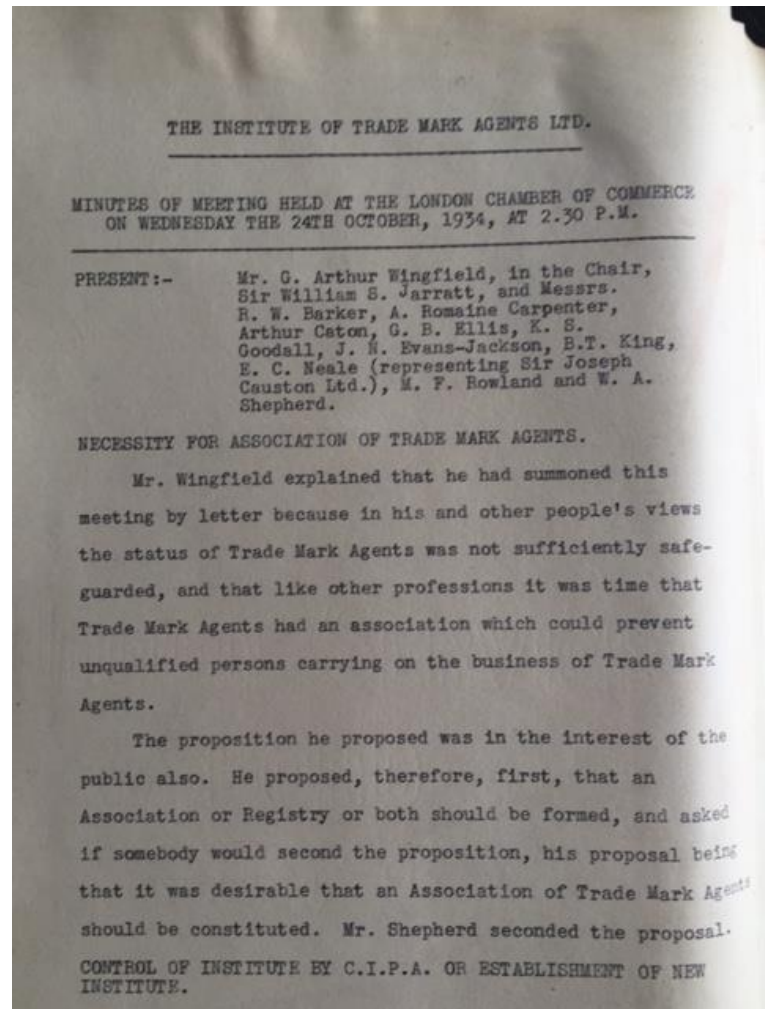
# ITMA Minute Book No 1

## Meeting 23 October 1934

“the status of Trade Mark Agents was not sufficiently safeguarded, and like other professions it was time that Trade Mark Agents has an association which could prevent unqualified persons from carrying out the business of Trade Mark Agents.

The proposition he proposed was in the public interest also”

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# Development of a niche profession

- A relatively small, niche profession
- Pan UK qualification
- Trade mark agents traditionally registered trade marks and managed trade mark portfolios
- Profession gathers pace after the Trade Marks Act 1875 with exponential growth after Trade Marks Act 1938
- Education and training for the professional exams – Joint Examination Board until 2010
  - *"Where Science Meets Law"* (2002) (Sherr/Harding)
- Why was change required?
  - Legislation
  - Economic and social changes

# A bellwether for the legal sector? What is a lawyer?

- Legal professional privilege
  - *Dormeuil Trade Mark* [1983] “it seems odd and perverse, that if a trade mark attorney is entitled to advise a client in relation to legal matters and to conduct certain legal proceedings on his behalf, the same privilege should not apply in a case where advice was being given and the proceedings were being conducted by a solicitor”
  - Trade Marks Act 1994 s87
  - Legal Services Act 190 (litigation privilege)
  - Accepted in *Prudential v Special Commissioner for Tax (Pandolfo)* [2012] UKSC
- Rights to conduct litigation and exercise a right of audience
  - Restricted under the *Courts & Legal Services Act 1990* – grandfathered rights and assessment at , arguably, expertise level
  - Now – basic rights at qualification with additional rights available, up to and including Supreme Court Advocacy
- Impact of s1 Legal Services Act 2007: increase diversity of the professions/competition between the professions.

# Adaptation: shift in the qualification framework from 2010

## **TM Specialisation**

- Registration
- Clearance/searching and reporting
- Portfolio management
- International trade mark knowledge and contacts

## **“solicitor like” work**

- Drafting (licences/assignments)
- Due diligence on IP portfolios
- Litigation/before the courts (not just registry)



# Where next? Optimised for mobile...

