

## **THE ROLE OF THE AGENT IN THE PROTECTION OF TRADE MARKS**

I am here to speak to you about the role of the Agent in the protection of Trade Marks.

In most countries, among them Spain, there are no free professionals trained to deal exclusively with trade marks, but rather to deal with Industrial Property in general. In my country we are called Industrial Property Agents and we are advising our clients on the best way to use the different weapons (patents, trade marks, models) the Industrial Property Law is offering the manufacturers to defend from imitation and unfair competition the results of their efforts to put on the market more efficient, useful and attractive products. In fact providing manufacturers with these weapons in defence of competition, the keystone of a free market economy is the common aim of the different Industrial Property rights; and if competition is the keystone of the free market and industrial development, there is no doubt that Industrial Property Agents perform a key activity in the present world.

The manufacturer directs his endeavours to offer goods presenting technical advantages that may be protected by patents or utility models or attractive external forms that may be protected by industrial models (also called designs) or simply goods produced using a know-how that reduces costs or increases the quality. And once he has developed a product susceptible to compete with success in the market, he has to offer it to the potential clients under a sign, which will allow these clients to clearly identify the product. Therefore patents, models and trade marks are different means of a global strategy aiming to compete with success in the market and to defend this success from the unfair activities of the competitors, and the role of the Industrial Property Agents is to advise the manufacturer about the best way to combine these three means.

Therefore I shall speak to you about the role of the Industrial Property Agent, although I shall specially focus on the portion of his tasks dealing with trade marks.

The basic tasks of an Industrial Property Agent, as a reliable adviser to persons interested in Industrial Property matters, are filing and prosecuting Patent, Trade Mark and Model or Design applications in his own country or before the corresponding international or regional office, if applicable, maintaining in force the registrations so obtained and centralizing the link with the foreign colleagues entrusted with the prosecution of parallel applications in their respective countries.

These are the basic tasks of our profession, but if we look into them more in detail we shall see that they encompass a large field of activities. I shall hereinafter deal with them in the same order they are performed when, in order to give our advise to a client who is planning the marketing policy of a new product, we have to make him aware of all the Industrial Property implications of his plan and to draw up a scheme of protection.

The very first step will be to obtain from the client a full and exhaustive information about the product, so that we are able to determine whether there is novelty and inventive step allowing patent protection, whether the external forms are new and original enough to obtain a design registration, which could be the most suitable kind of trade mark for this particular product and which should be the geographical extent of the protection.

In order to be in a position to give a good advise it is absolutely necessary that the client is disclosing everything without any mental reservation. Therefore the Attorney must endeavour to create an atmosphere of trust and confidence and should be submitted to a code of conduct based on certain principles of professional ethics, as we shall see in the second part of this paper.

Leaving aside the aspects of our activity linked with patent and design protection, I shall now explain what we have to do in connection with trade marks once we have obtained from our client the necessary information.

Usually the client has already an idea of the mark he would like to apply to the new product. But it is our first task to examine this project of trade mark in order to find out whether it is really convenient and likely to be properly protected. In other occasions we have to collaborate in the creation of the trade marks.

The mark may be a word, a device or a combination of words and device; it may be completely fancy, not meaning or representing anything concerning the product, or it may be formed in a way that it suggests to the consumers ideas related to the product itself, to its characteristics or to its use.

Therefore the Industrial Property Agent must enlighten his client on the advantages and disadvantages of everyone of these different kinds of trade marks. A combined trade mark (word + device) may dilute the protection of the word, that is generally the main element, but the registration of the device may also be convenient to avoid confusion through visual perception.

Trade marks comprising descriptive elements are often preferred by the manufacturers, mainly for certain kind of goods such as pharmaceuticals and cosmetics, because they send to the consumers messages related to the product, its use or its characteristics and furthermore they are easier to remember, but they are relatively weak inasmuch as it is not legally possible to avoid that the same descriptive elements appear in new trade marks of the competitors; although in these new trade marks the descriptive parts will have to be combined with different distinctive elements, there is no doubt that the owner of a trade mark of this kind is bounded to tolerate the existence in the market of marks relatively similar thereto, so that counterfeiting may be sometimes difficult to fight. Some trade marks may be so highly descriptive that they risk to be unregistrable because they fall under the absolute prohibitions. The client must also be informed about this risk.

A fancy trade mark can be much easier defended against counterfeiting but on the other hand does not contain any information and may be more difficult to remember, drawbacks that may be compensated by an adequate advertising campaign. A word that is fancy in the clients language may have an unappropriate meaning in the language of one of the countries where the goods will be sold and we have also to inform the client accordingly.

It goes without saying that the client has the last word, but we must make him fully aware of the eventual drawbacks and implications of a particular trade mark so that he can take the decision with full knowledge.

Once a trade mark registrable per se has been chosen the Trade Mark Agent will have to proceed with the appropriate searches to determine whether it is identical with or confusingly similar to any other prior trade mark. If the client intends to export the goods it will be necessary to extend the searches to the countries of destination or at least to the countries where the goods are expected to be sold in the near future.

The Spanish Trade Mark Agent will make the searches in his own country using the data base of the Spanish Patent and Trade Mark Office, to which most Spanish colleagues are connected on line. If this search shows that the mark is likely to be registrable in Spain, he will get in touch with the colleagues of the other countries and/or with one of the several firms specialized in world-wide searches.

It is very convenient to search simultaneously the availability of two or three trade marks because, mainly if the searches have to be carried out in many countries, it is quite improbable that a trade mark appear to be acceptable in all of them.

The Trade Mark Agent must carefully examine the search reports, decide about the availability of the client's mark when compared with the prior rights and decide which is the mark having more chances to be registered and used without problems in all countries or in a fairly good number of them. In the countries where obstacles not likely to be removed appear, it will be necessary to negotiate an agreement with the owners of the prior rights or to think about a different trade mark for this particular country.

Sometimes the client has neglected to register his trade mark on time and comes to our office when it has already been used and become known to such a degree that it would be commercially very harmful to change the mark. In this case there is no other alternative than going ahead with the application and working hard to remove by argumentation or negotiation the eventual obstacles.

The next step will be to decide about the extent of the protection. Needless to say that the mark will have to be protected in connection with the specific goods or services to which it will be applied. But it may be also convenient to extend the protection to areas closely related to said specific goods or services. For example a trade mark used for diet products (international class 5) would be better protected if also

registered in international class 29 and perhaps also in international classes 30 and 32; a good protection of a trade mark used in connection with lady's luxury clothing or shoes would require the registration in international classes 25 (where the specific goods are included), 18 which includes bags and 3, which includes perfumes (as you know perfumes and luxury clothes often carry the same trade mark).

The suitable area of protection may become larger if the owner of the new trade mark intends to undertake a intense and costly advertising campaign likely to make it become well known within a relatively short period of time; this is because identical or very similar trade marks registered or implanted by use for different goods during this period would become later very bothersome and annoying once the client's mark has become a well known brand. Afterwards the registrations covering different goods may not be so necessary since well known marks benefit in most countries from a larger protection, extended to goods or services even quite different from the ones for which the trade mark is registered and used.

On the other hand, in many countries a trade mark registration can be cancelled if the mark is not used within a certain period of time (between 2 and 5 years) from the date of grant. Therefore the Attorney will have to analyse which are the use requirements in the respective countries and the severity of the corresponding provisions, in order to find out where an enlarged protection will be efficient and to advise the client accordingly.

This brings us to the drawing up of the list of countries where the trade mark should be protected. This list should include the countries where the mark will be used in the future. Here again the use requirements will have to be taken into consideration, because a trade mark registration in Spain and in many other countries (among them all EC countries) would become revocable, if use had not commenced 5 years after grant (which means about seven years after the application date), so that filing an application in one of these countries is not advisable if use is not foreseen within the next six-eight years. In some countries, among them the United States and Canada, use has to be started within shorter delays.

It goes without saying that if the interested firm is not our direct client but the client of a foreign colleague, the global advise we are talking about will be given by this colleague and our task will be restricted to make the searches and file the applications in our own country and to enlighten our foreign colleague about aspects of our Law and practice he may not know well.

We have now arrived to the stage where we have to file the applications, first in our own country and in the countries where we cannot claim the priority of the first application, then, within six months, in the countries belonging to the Paris Union, or at the International Bureau in Geneva, if applicable.

Then comes the prosecution of the applications. Each attorney will deal directly with the prosecution in his own country and through the respective foreign colleagues

with the prosecution in the other countries. Our task at this stage depends on the granting procedure of the respective country. In Spain and in other countries (for example in Greece, Denmark, the United Kingdom, Japan or the United States) it includes replying to the objections raised by the examiner and to the oppositions lodged by third parties, as well as filing appeals and replying to the appeals lodged by the opponents.

The prosecution of a trade mark application includes also the negotiation and drafting of agreements with the owners of conflicting prior rights in order to obtain the withdrawal of the opposition or a declaration of consent for the registration of our client's trade mark, if there has not been an opposition but an examiner's citation.

In other countries (for example in France, Germany, Italy or Canada) the examiner is not making any searching, he is only raising objections concerning the inherent registrability of the mark and, in the countries where opposition is provided for, notifying to us the oppositions filed by third parties.

In the countries where the filing of oppositions is possible we have to watch, from the date our client's application has been filed, over the publication of any new application regarding an identical or confusingly similar trade mark, in order to alert our client and to prepare and file the opposition if he is instructing us to do so. Sometimes the watch is entrusted to specialized firms that fulfil this task over the various countries where the watch is advisable. In this case our job will be to advise about the chances of success of an opposition against a new application detected by this specialized firm and to prepare and file the opposition.

Another important task of the Industrial Property Agent is to advise the clients in licensing matters; if the client is the licensor we have to draft the licence agreement or to amend the one prepared by him; if the client is the licensee we have to give our opinion regarding the draft agreement proposed by the licensor, suggesting amendments, if necessary. Often long negotiations have to be carried out before a final agreement is reached.

We have a very important intervention in legal conflicts concerning the infringement of Industrial Property Rights or Unfair Competition. We send warning letters to the infringers and we reply to the ones received by our clients, and we conduct searches to check whether the rights of the claimant are solid or vulnerable. In many cases the negotiations that follow the reception of a warning letter end in an agreement, so avoiding litigation before the Courts of Justice.

Where litigation is unavoidable we generally entrust the case to an external barrister specialized in Industrial Property matters; this is the normal practice even if the Agent is also a lawyer, as it very often happens.

But this does not mean that the intervention of the Agent has finished, because we collaborate closely with the barrister in very various ways, for example carrying out

searches, drawing up technical comparative reports, obtaining certifications regarding the legal status of the rights involved, etc, etc.

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The second part of my intervention will now deal with the qualifications required to become an Industrial Property Agent, and with the associations of these professionals. Regulation of our profession is not uniform throughout the world and the best course is therefore to outline the rules introduced in some of the countries with the most firmly-established traditions in this field, namely Germany, France, the United Kingdom, Italy, the United States, Japan and Spain.

## **GERMANY**

In this country there are two big groups of professionals: on the one hand the so called "Patentassessoren" (Patent Advisers) who can only act as employees of an industrial enterprise, but are not allowed to act as free professionals, and, on the other hand, the "Patentanwälte" (Industrial Property Agents) whose professional functions and duties, as independent advisers and representatives, are to advise their clients and represent them before third parties in matters dealing with the obtaining, maintenance and defence of Patent, Utility Model, Design and Trade Mark rights.

To become a Patent Adviser it is necessary to pass a qualifying examination and, to be a candidate to this examination, the following is required:

Firstly, to hold a Degree issued by a University or a Technical School evidencing to have followed scientific or technical studies (Engineering, Chemistry, Physics, Natural Sciences, etc.) and to have completed a one-year training within the field of these studies.

Secondly, to have undergone an apprenticeship and professional training period of three years in the field of Industrial Property Law, having worked at least for two years with an Industrial Property Agent or in the Industrial Property Department of an industrial enterprise under the supervision of a qualified Patent Adviser, at least four months in the German Patent Office and at least eight months in the Federal Patent Court. Six months out the two year training with a professional can be spent in a lawyer's office.

Any person who complies with these two requisites (a degree and a professional training of three years in the field of Industrial Property Law), can take the relevant examination aimed to prove that he is able to apply the Industrial Property legal

provisions, including the international conventions and treaties, as well as the provisions dealing with unfair competition, and the parts of Civil Law, Commercial Law and Procedural Law which are of relevant significance to carry out advisory activities within the Industrial Property field.

After passing this qualifying examination, the candidate who wishes to establish himself as a free professional has to be included in the list of "Patentanwälte" (Industrial Property Agents) held by the German Patent Office and to become a member of the Industrial Property Agents Association (Patentanwaltskammer). The final decision on such inclusion will be taken by the director of the German Patent Office, subject to the prior report of the Board of the Patentanwaltskammer.

Lawyers may also act as professional representatives before the Patent Office, but they are not allowed to use the title of Patentanwalt.

## **FRANCE**

In this country the regulation of our profession is similar to that in Germany.

The Institut National de la Propriété Industrielle (INPI) holds a list of persons qualified to provide advisory service on Industrial Property matters, who can work either as employees of industrial enterprises or as employees of free professionals, but are not entitled to act on their own behalf, as free practitioners.

For a person qualified in Industrial Property to be able to act as a free professional he should be registered as well on a second list, also held by the INPI. Furthermore he has to become a member of the Compagnie des Conseils en Propriété Industrielle (Industrial Property Advisers Association).

In order to be included in the first list, the one of persons qualified to act as employees, the following is required:

1. To have a legal, scientific or technical degree and a diploma issued by the Centre d'Etudes Internationaux de la Propriété Industrielle (CEIPI) of the University of Strassbourg or equivalent.
2. To evidence a professional training of at least three years under the supervision of a person duly qualified in the field of Industrial Property; this means somebody who is at least included in the first list.
3. To pass a qualifying examination before a board formed by a representative of the Judicature, a Civil Law Professor, a Lawyer and four persons qualified in Industrial Property.

The candidate who complies with such requirements is registered as qualified person in Industrial Property. The registration includes one or several mentions

regarding his specialities (lawyer, engineer, patent, trade mark, or design expert) according to his academic degree and professional training.

A person qualified in Industrial Property has to be included in a second list, the list of Industrial Property Advisers, in case he wishes to act as a free professional. To have access to such list he will have to comply with the following requirements:

- to be a national from any E.C. member state,
- to be domiciled or to have a professional place of business in France,
- to underwrite a professional civil liability insurance policy and to deposit a bond,
- to agree to start his professional practice within a term of three years, and
- to be a member of the Compagnie des Conseils en Propriété Industrielle.

The registration in this second list is decided by the General Director of the INPI, after having heard the advice of the Compagnie des Conseils en Propriété Industrielle.

## **ITALY**

Access to the Registry of qualified Industrial Property Agents or "Consulenti in Proprietà Industriale" held by the Patent Office is restricted to those who pass a qualifying examination, both written and oral, on Public and Private Law, Civil Procedural Law, Chemistry, Mechanics or Electricity, Italian Industrial Property Law, E.C. and International Industrial Property Law, Industrial Property comparative Law and English, German or French.

The Examination Board is formed by the Director of the Central Patent Office, a member of the Chamber of Appeals, two University professors, selected by the Ministry of Industry and Trade and four qualified Industrial Property Agents, appointed by the Board of the Association of Qualified Industrial Property Agents.

Other requirements are to have the nationality of any E.C. country, to be domiciled in Italy, to have a university degree, to undergo a training period of at least two years and to be a member of the Association of Qualified Industrial Property Agents.

## **UNITED KINGDOM**

In this country the titles of Patent Agent and Registered Trade Mark Agent can be only used by those persons who are listed in the relevant Registries and the use of these titles or other confusingly similar expressions by non registered persons is considered as an offence.

Such Registries are under the responsibility of the Chartered Institute of Patent

Agents and the Institute of Registered Trade Mark Agents, respectively, and to be registered it is necessary to pass a qualifying examination and to undergo a training period of four years (only two if carried out under the Supervision of a Patent Agent or a Registered Trade Mark Agent.)

The rules for the examinations are set out by the Chartered Institute of Patent Agents and by the Institute of Registered Trade Mark Agents respectively, under the Supervision of the Director of the Patent office.

In order to be a candidate it is not necessary to have a diploma or academic degree although actually most candidates have a technical, scientific or law degree.

## **UNITED STATES**

Here a distinction should be made between Patent Agents and Patent Attorneys.

The Patent Agents are only entitled to prepare, file and handle patent applications, but they are not authorized neither to give advice on legal aspects such as agreements, licences, infringement of rights, etc, nor to handle trade mark applications or to advise on trade mark matters.

To become a Patent Agent it is necessary to hold a technical or scientific university degree and to pass a qualifying examination lasting a full day and divided into two parts, one regarding Patent legislation and another one consisting of the drafting of a Patent Specification and the relevant claims.

The Patent Attorneys are Lawyers qualified to appear before the Courts who moreover have a technical or scientific background and have passed the qualifying examination established for Patent Agents; otherwise they can only act before the Patent and Trade Mark Office in matters related to trade marks.

The Patent & Trade Mark Office has its own disciplinary rules which all the professional representatives have to comply with. Patent Attorneys are also practising Lawyers and must comply as well with the disciplinary rules of the state before whose courts they are qualified to act as lawyers.

The number of Patent Agents is decreasing and most Industrial Property professionals are Patent Attorneys.

## **JAPAN**

To act as professional representative of a third party before the Japanese Patent

and Trademark Office it is necessary to be registered in the list of professional representatives held by the Japanese Association of Patent Agents.

For this purpose, candidates have to pass a hard examination consisting of a preliminary part (legal, economic and technical subjects and a language to be chosen among English, German or French) and a main part, including one oral and two written tests. Those who hold a university degree or those who have practised at least for a period of five years as examiners in the Japanese Patent Office are exempted from the preliminary part.

Lawyers and former examiners with a practising experience of at least seven years do not need to sit the examination but have to become members of the Association.

## **SPAIN**

In my country the requirements to become an Industrial Property Agent are as follows:

- to be a national from any of the E.C. states domiciled in Spain;
- not to be prosecuted or have been condemned by a Court;
- to deposit a bond and underwrite a civil liability insurance policy;
- to hold any University or Technical School degree; and
- to pass a qualifying examination evidencing that the candidate has the necessary knowledge and skills for the exercise of the professional activity.

The other basic requirement for the adequate performance of the profession, namely the compliance with a code of professional conduct, which is mandatory in all countries under review, is fulfilled through compulsory membership of the Colegio de Agentes de la Propiedad Industrial (Association of Industrial Property Agents).

Therefore we find ourselves within a frame similar to that of most of the countries previously reviewed. Within this frame the Law defines the profession and establishes the requirements to become an Industrial Patent Agent, while the code of professional conduct, defining how to fairly exercise the profession, is under the responsibility of an Association grouping all the Industrial property Agents of the respective country.

A national association exists in almost every country that has a patent system.

The common mission of national associations of industrial property attorneys is to keep a careful watch over the profession and promote every initiative that tends to improve and better it.

Such associations establish rules of professional conduct and supervise the

ethics of that conduct. They impose penalties (or propose to the competent governmental authority to do it so) when a member of the association fails to comply with the rules of the association.

It is furthermore customary for governments to seek the opinion of these associations when legislative reforms are contemplated and representatives of the professional associations are usually appointed as members of the boards of examination set up in the various countries for the qualifying examinations giving access to the profession.

Every member of a national association must comply with the professional rules and regulations and the association is an authority to which third parties can turn in the event of some irregularity committed by one of its members.

The basic rule of the different codes of professional conduct is that the Industrial Property Agent must serve as a reliable adviser to persons interested in Patent and Trade Mark matters, acting as an independent counsellor by serving the interests of his clients in an unbiased manner without regard to his personal feelings or interests.

Moreover, in order to keep his independence, he should not acquire a financial interest in an industrial right in such circumstances as to give rise to a conflict between professional duty and interest, and he should not charge fees directly related to the outcome of the services he provides.

According to another basic rule of professional conduct an Industrial Property Agent shall not take in charge any action that might be in conflict with any other action taken by him or one of his collaborators on behalf of another client, unless this client agrees to such action.