

the barrister

The power of branding

As competitive pressures push sets to consider all avenues available to them to enhance their position, it seems inevitable that the issues of branding and intellectual property attaching to Chambers will become more relevant to the everyday operations of Chambers.

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Intellectual property and branding considerations present a particular issue for barristers. In the wider corporate world, businesses go to great lengths to build and protect their brands, which are often seen as core to the value of their operations.

As competition within the Bar increases (as well as competition with other providers of legal services), so does the need for individual Chambers to build a competitive advantage. One way of doing this is to establish a collective Chambers brand, separate from the personal goodwill attaching to individual lawyers. This can be particularly important for those offering services via the direct access route.

A collective brand identity can jar, however, with the traditional perception and operation of Chambers as an unincorporated association of individuals sharing communal facilities, rather than a group of individuals collectively pursuing a common business. This article considers some key issues arising for sets who are

looking at their options in this area.

Registered v unregistered trade marks

A common step towards protecting a brand is to apply for a registered trade mark. Although rights exist in unregistered names, a registered trade mark makes it easier to bring

itself, lead to issues. Various potential drawbacks and hurdles are touched on below.

Criteria for registration

One of the first things to analyse when considering a trade mark application is exactly what that mark is going to

be. Generally, in order to become registered, a mark needs to be distinctive and capable of being used in such a way as to distinguish goods and services of one party from those of another.

This can be particularly difficult for Chambers whose identity is based around a geographical area or address which may be shared with other

sets. It is probably no coincidence that many Chambers have moved away from purely descriptive address-based names as part of their branding initiatives, even if the brand name is still, for example, an acronym of the address.

Ownership of the mark

In whose name should the trade mark be registered? It is a reasonable starting point to assume that, for most Chambers, the brand is beneficially



infringement proceedings and can also act as a defence to third party claims against the use of that name. Passing off claims (i.e. claims on the basis of unregistered marks) are more difficult to establish than infringement claims based on registered marks.

However, obtaining a registered trade mark is not always straightforward. Indeed, formalising the position with regard to a Chambers mark can, in

owned by the members of Chambers from time to time. Ownership changes as the composition of Chambers changes, but with no individual member having an individual proprietary interest in the brand. Whilst intellectual property rights remain unregistered, this will generally be unproblematic.

However, although we have seen numbers of trade marks for chambers registered generically in the name of a particular set of Chambers, our view is that this is probably an oversight by the IPO and that the registered owner should be an identifiable legal person.

For those Chambers who operate with a service or management company, that is relatively straightforward. For others, the natural choice would be the Head of Chambers. That may create its own issues, both substantive in terms of potentially giving control of a valuable asset to one individual, but also practical in terms of, for example, ensuring the ownership of the mark is transferred as and when there is a change in Head of Chambers.

Services protected?

If it elects to make an application, Chambers will need to prepare a specification of those goods and services that it wants protected through the trade mark. Many Chambers may be comfortable to simply focus on covering the provision of legal advice.

However, some sets with a particular specialism may want to go further if they feel there is scope for a third party to brand itself in a way that is likely to cause confusion. For example, a tax Chambers may want to guard against accountants or other financial advisors branding themselves in a similar fashion.

Recognisable or unique?

Many Chambers have generic names, often based on geographical factors. Often this name will, in itself, reflect the intended Chambers brand – it may be desirable for Chambers to be associated with historic buildings and grand-sounding addresses.

This approach does, however, make it more difficult for Chambers to position themselves as a unique brand that stands out from competitors. In some cases, it can lead to different Chambers having confusingly similar names, and so the issues are more specific than generic. Overall, however, brand recognition and distinctive character become more difficult to establish or develop.

Chambers will therefore need to

consider an appropriate balance to strike between a unique, perhaps more modern, name against the inherent value that can attach to an identity that gives the impression of a long established set (as well as any possible confusion with existing contacts that a rebranding exercise can create).

Individual names

Another potentially thorny issue is for Chambers whose names are associated with the names of particular individuals.

Inevitably, this can give rise to the question of who owns the goodwill attaching to the brand, and whether the relevant person has an individual personal interest.

This is one area where holding a



registered trade mark through a limited company could add significant clarity to the situation and head off potential disputes in the event of the individual(s) concerned retiring or moving on, or even Chambers dissolving.

Equally, the individual concerned might well have entirely legitimate reservations about losing control over the use of their own name.

Valuing the brand

Ordinarily, Chambers will not account for the value of an intangible asset such as a trade mark (whether registered or unregistered), or indeed goodwill attaching to the Chambers.

But what happens when an exceptional event such as a dissolution or merger takes place? In many cases those events may occur in a context where valuing the brand is of academic interest only. For example, if a smaller set merges with a larger set and operates under the larger set's name, it is difficult to argue that the larger set has acquired the benefit of a brand.

And what if some barristers set up a new set using the name and reputation of a Chambers which has dissolved on an insolvent basis where it is seeking additional sums from members to satisfy creditors? Should those benefitting from the brand going forward therefore pay for this benefit, for example? What if the matter is not addressed formally and several competing Chambers then spring up, all trading under very similar names?

Conclusion

As competitive pressures push sets to consider all avenues available to them

to enhance their position, it seems inevitable that the issues of branding and intellectual property attaching to Chambers will become more relevant to the everyday operations of Chambers. What is a relatively fluid and developing area of law and practice is likely to develop even further as barristers continue to practice through new vehicles.



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