

In-House v Private Practice

After a career spent in-house how does life in private practice match up? Lawyer Monthly talks to Bob Boad, former Head of Trade Marks at BP, to discover what he has made of his first year on ‘the other side of the fence,’ away from the world of the big corporate department.



Bob Boad
former Head of Trade Marks at BP

Presented in your late 50's with an early retirement package from the much-envied BP pension scheme, many of us would reach for our golf clubs and the holiday brochures, but after a few months spent 'getting his breath back,' Bob Boad realised he was not yet ready to retire. He knew he wanted to stay active in the world of brand protection but relished the idea of doing something different after 26 years of looking after the brand properties of the BP group and prior to that, spending almost 13 years in-house at Wellcome, now part of GSK. Bob knew that he did not want to take on a standard private practice role and that he also wanted to find a way to 'give something back' at this stage of his career.

The opportunity to take on a role that was tailored to his desires and experience soon came, in the form

of an offer from Manish Joshi and Duncan Welch who, like Bob, are Registered Trade Mark Attorneys. In 2006 the pair had created their own firm, Joshi & Welch, having decided life in their former firms was too restricting and preventing them from offering the sort of service they aspired to deliver for clients. Bob explains: "I had known Duncan for many years, since he had first joined the TM profession in-house at ICI and I had also known Manish for some years. I had always enjoyed their enterprising and innovative spirit which seemed to be mixed with an understanding that ultimately intellectual property is a business asset and needs to be treated accordingly. They also believed in approaching every project in a way that would solve the client's specific need. This is the approach I followed in-house, so I felt we were all on the same wavelength!"

Bob continues: "Joshi & Welch had already caught my eye by developing some interesting offers such as being willing to commit to creative solutions for charging and their trade mark search product which is very user-friendly and has some novel features. To ensure the latter was as good as it could be they visited us at BP during its development to get an in-house perspective.

"They were also running courses for students taking the ITMA final examinations and achieving remarkable results –it is a rare firm that trains the students working for its competitors but it is another factor that has helped them quickly establish a reputation and distinctiveness in an already crowded and mature marketplace. I have participated in some sessions and was impressed by their focus and the attention to detail. I began to realise this was somewhere that I would fit in, enjoy a new challenge and contribute to the further development of the operation.

"In spring 2010 they kindly invited me to join them on a part-time basis as non-executive Chairman. They had recently incorporated the business as a limited company and it appeared that my senior in-house experience and insight would help with business development and governance

AF aims to raise public awareness of the risks and issues associated with counterfeit products and it is the only organisation that is focused entirely on trying to damp down the ever-increasing demand for fakes.

Bob Boad



issues as well as help strengthen strategic planning and management processes. We have a shared belief in trying to better align the brand building and brand protection activity of a business and this has led us to explore some strategic partnership opportunities that should offer enhanced service levels and additional options for our clients in developing or defending their own brands. We have also analysed our particular strengths and identified some exciting growth opportunities for our business.”

Bob continues: “For me there have been a number of surprises and important lessons. For example, I soon learned that not all companies are as concerned to protect their intellectual property as my former employers had been. I have noticed some quite well-known brands that are not protected with trade mark registrations and have spoken with several companies who choose new marks without even the most basic search for prior rights and potential conflicts. They seem oblivious to the risk

and potential cost of such an approach to managing what are often critical assets for their businesses. It has also been interesting to see the contrast between providing advice in an in-house environment (where generally it is followed, even where the client department has to fund the work) with private practice where even the most self-evident actions, even those involving minimal cost, are less certain to be undertaken.

“It has also been hard to get used to not always being involved in the strategic aspects of some matters such as major litigation cases, big licensing deals such as those involving TNK-BP in Russia and M&A activity, such as the disposal of a service station network in a particular country. However there are compensations, especially the chance to help brand owners across a range of industries, rather than be restricted to supporting a single group of companies, and the ability to react immediately if we like the look of an opportunity.”

Bob has also satisfied his second ambition, having been invited to become President of the not-for-profit organisation The Authenticity Foundation (AF) on a pro bono basis. Bob explains: “This was not something I would have had time for when I was at BP. AF aims to raise public awareness of the risks and issues associated with counterfeit products and it is the only organisation that is focused entirely on trying to damp down the ever-increasing demand for fakes. Historically, other anti-counterfeiting organisations have devoted most of their efforts towards stopping the supply of counterfeits -for example, lobbying for stronger laws with harsher penalties, for better enforcement resources or tougher trade treaty provisions -although now some are starting to recognise the need to balance this with initiatives which also help stem the demand.” **LM**

JOSHI & WELCH

