

Competency Framework - Patent

The material below sets out the general and technical skill sets which provide a framework within which a trainee patent attorney is expected to work when undertaking IP legal services. It also includes indicative guidance for trainee patent attorneys about the evidence that may be used to demonstrate achievement of those skills, rather than a “must do” list of topics to cover during a supervised training period. There will inevitably be differences in the type of work undertaken, dictated by the particular training environment (private practice vs industry) and the nature of the business, eg serving corporate clients, SMEs or individuals. Thus the areas covered below are not exhaustive but offered as a guide. They are expressed as outcomes, with illustrative examples of the work experience which results in the skills described.

This framework also includes suggestions as to the associated business competencies and relationship skills that IP trainees should aim to develop over time.

The framework is not designed for use in individual performance assessments or any other personnel review processes.

General/ Legal

There are 8 general skill sets designed to provide a framework within which a trainee patent attorney is expected to work when undertaking IP legal services. These are broadly the same as the competency guidelines published by other legal regulators to ensure, wherever possible, a consistent approach to legal training whatever the area of law to be practised

Skill Sets

Each element of the Skill Set is set out in bold below with suggestions how you might evidence that competency

Practical Application of the Law and Legal Practice

Apply the law to a matter

- Identify the applicable law
- Describe how the law applies to the matter you are dealing with
- Explain how the evidence you have supplied demonstrates your application of the law to the matter

Apply the relevant legal procedures to a matter

- Identify the legal procedure
- Describe how the legal procedure applies to the matter you are dealing with
- Explain how you have used the correct legal procedure to deal with the matter and supply supporting evidence

Identify and deal with the issues arising in a matter

- Identify the relevant issues in the matter (the issues may be legal, evidential or factual)
- Explain how you will deal with the issues
- Explain the action you have taken to deal with the matter and provide supporting evidence of the action you have taken

Undertake legal research

- Identify a situation in which you need to undertake legal research
- Identify the sources you need to undertake the research
- Undertake relevant and up-to-date research and provide that research as part of your evidence
- Apply the findings of your research to the matter you are dealing with and provide evidence of your application of the research to the matter

Communication Skills

Use suitable language in communication

- Use clear, concise, accurate and unambiguous language in your communication
- Tailor the style of your communication to suit the needs of the recipient where relevant

Address all issues in communication

- Identify and address all relevant factual, legal or evidential issues arising in a case
- Apply relevant law and procedure in the context of your communication and provide supporting documentation to demonstrate this communication

Represent a client through effective use of communication and other skills

- Identify the information you need to represent the client
- Obtain this information through effective questioning and listening techniques
- Represent the interests of your client through use of your legal and professional skills
- Provide supporting evidence of your representation of the client

Client Relations

Take accurate instructions relating to a legal matter from the client

- Use the appropriate listening and questioning techniques and take accurate instructions from your client
- Confirm with your client that your understanding of their instructions is correct
- Provide evidence of both taking the instructions and confirming the instructions with your client

Provide clear legal advice to the client

- Your advice should include what action you will take to represent your client and outline the available options and next steps
- Provide legal advice to your client on the legal matter in which they have instructed you
- Provide evidence of the advice provided to your client

Evaluate the risks, costs and benefits or alternative courses of action relating to the client

- Identify situations in which it is appropriate to consider any alternative courses of action that might be available to your client dealing with their legal matter
- Evaluate and communicate the options (including the costs, risks and benefits of each option) to the client
- Provide evidence of the identification and evaluation of alternative course/s of action available to your client

Take action to deal with instructions received

- Identify how to act on your client's instructions
- Demonstrate how you took all reasonable steps to take appropriate action (this may include your judgements and decisions in the matter)
- Provide evidence of the action taken to deal with the instructions received

Manage a client's expectations

- Identify the needs, objectives and priorities of your client
- Identify situations in which the objectives of your client may be unrealistic
- Take all reasonable steps to manage your client's expectations
- Provide evidence which demonstrates communication with your client in order to manage their expectations

Management of Workload**Progress matters expeditiously**

- Demonstrate dealing with your workload without causing or allowing any unnecessary delay to the progress of the legal matter
- Demonstrate the progression of a legal matter without delay and provide an example of work progressed quickly to meet a deadline

Plan your workload and deliver a good legal service to the client

- Demonstrate planning and prioritisation of your workload including managing your files/tasks concurrently, making the best use of available resources and seeking support where necessary
- Provide evidence which demonstrates planning your workload including managing a number of tasks concurrently
- Demonstrate exercising judgement and being realistic about how long it will take to achieve tasks to ensure you can provide the legal services you have agreed to provide

Maintain files and records in accordance with procedures

- Demonstrate maintenance of your files and business systems (including databases and accounting records) in accordance with the procedures established where you work
- Demonstrate keeping files up to date and processing financial transactions in accordance with rules and procedures and with due regard to information security
- Evidence could include file reviews, ledgers etc

Business Awareness**Demonstrate an understanding of the business environment of a legal practice or organisation**

- Identify the business and legal environment in which you work
- Identify and explain the aims and objectives of the practice/organisation in which you work
- Explain how you keep the aims and objectives of the practice/organisation in mind throughout your working practices

Evaluate the risks, costs and benefits of alternative courses of action to the business

- Identify alternative courses of action which arise in your work and which may have different impacts on the practice/organisation in which you work
- Explain how and why you have chosen one method of working over another in the context of understanding the business environment
- Provide practical evidence of choosing one option over another

Professional Conduct

Apply the rules of professional conduct appropriately to relevant situations

- Identify the rule of the IPReg Code of Conduct relevant to any matter you are dealing with, including any ethical dilemmas
- Identify how you will act in accordance with the Code
- Apply these rules of professional conduct to your work
- Provide evidence which supports active application of the Code to your work

Understand the need to avoid discrimination and promote equality and diversity

- Demonstrate up-to-date knowledge of current equality legislation
- Demonstrate understanding of equality and diversity issues
- Demonstrate the practical application of your understanding of equality and diversity issues

Self-awareness and Development

Evaluate your professional skills and legal knowledge

- Reflect on your performance
- Identify what your strengths and weaknesses are in the work you undertake
- Identify objectives for the development of your professional skills and legal knowledge
- Plan to address any areas for improvement
- Provide evidence of this reflection on practice

Understand the limitations of your professional skills and knowledge

- Identify where you do not have the skills required to undertake a task
- Provide evidence of the limitation you have identified and the action you took to resolve the situation

Working with Others

Establish effective working relationships with others involved in a legal matter

- Understand the importance of establishing effective working relationships with other professionals involved in the legal matter
- Provide evidence of effective working relationships you have with other professionals involved in legal matters that you are dealing with
- Provide evidence of two-way communication with other professionals

Demonstrate ability to select and provide appropriate information to others as required by the law

- Identify what information may be legally disclosed to others
- Apply the law to ensure you act within the limitations of the law
- Provide evidence of deciding to disclose (or refusing to disclose) information through the application of the law

Technical Competency Framework

The following pages list the range of Technical IP Legal Competencies which applicants would be expected to cover. IPReg recognises, however, that not all firms and not all departments within industry will be able to offer everything listed. As with the previous General Legal Competencies the material is designed to provide indicative guidance rather than a “must do” list.

Technical/Basic Level

At this level trainees would be expected to understand the key conceptual differences between different forms of IP, particularly patents and registered designs, and to advise clients on the protection these confer

Skill Sets

Each element of the Skill Set is set out in bold below with suggestions how you might evidence that competency

Analysis and Advice

- Conduct a basic search/patent family search effectively
- Appropriate awareness of PCT and EP systems
- Basic understanding of novelty and inventive step
- Basic understanding of added matter, enablement, non-patent subject matter, clarity
- Awareness of key sources for case law and preparing argumentation

Drafting

- Ability to analyse prior art and draft a simple main claim
- Ability to prepare bullet points for response to GB or EP official letter

Validity

- Basic understanding of validity concepts

Prosecution

- Awareness of procedural stages in the life of a patent (filing, search, examination, grant)
- Awareness of the basic structure of a patent application

Infringement

- Basic understanding of infringement concepts

**Technical/
Intermediate Level**

At this stage trainees would be expected to develop the basic skills and recognise the business implications for their client in adopting certain strategies

Skill Sets

Each element of the Skill Set is set out in bold below with suggestions how you might evidence that competency

Analysis and Advice

- Understands requirements for patentability (UK/EP) and key case law; awareness of differences in other countries, especially US patentability requirements
- Understands patent life concepts in more detail (priority, PCT filing, national/regional phases, prosecution and grant) and ability to describe to client
- Understands grant procedures and renewal process
- Understands concepts of registered design, unregistered design right and copyright protection
- Knowledge of leading cases (Supreme Court and EP decisions) affecting UK law of patents and designs

Drafting

- Ability to prepare first draft of patent specification with only medium correction
- Adopts appropriate claim structure (order, dependencies, etc)
- Drafts robust claims with appropriate fall-back positions
- Ability to draft a more complex response to a GB or EP official letter with medium correction
- Ability to draft overseas claims (especially US) for EP practice compliance
- Prepares basic draft response for any jurisdiction
- Ability to draft a preliminary Freedom to Operate analysis

Validity

- Awareness of opposition, appeal (EP) and revocation procedures

Prosecution

- Demonstrate intermediate knowledge of all stages of patent life, including EP/PCT systems and deadlines and consequences of non-action
 - Awareness of filing procedures and can prepare an application for UK or Community Design registration under supervision
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Infringement

- Has more detailed understanding of infringement concepts

Technical/ Advanced Level

At this level trainees would be expected to have developed knowledge and experience of complex cases with an ability to analyse risk and make key decisions on their own account. The level of technical knowledge and experience attained should be at the threshold for successful qualification as a registered patent attorney

Skill Sets

Each element of the Skill Set is set out in bold below with suggestions how you might evidence that competency

Analysis and Advice

- Demonstrate detailed understanding of patentability and procedures in US and other overseas jurisdictions
- Ability to liaise successfully with foreign associates handling overseas filings or contentious work and review their opinions critically/request further advice based on own knowledge of local law
- Demonstrate detailed knowledge of leading cases in the UK and US and how to apply them
- Ability to present recent case law and procedural changes coherently to office colleagues at CPD meetings or prepare an article for *CIPA Journal* on these topics
- Ability to give client practical and cost-effective advice on portfolio management

Drafting

Ability to:

- draft a complex patent specification requiring only minor checking
- draft a response to a GB/EP official letter with no/minimal need for supervision
- prepare a draft response for any other jurisdiction requiring only minor checking
- draft a Freedom to Operate analysis requiring only minor correction

Validity

- Demonstrate in-depth understanding of the requirements for patentability and the impact of case law for challenges to the validity of UK/EP filings

Prosecution

- Demonstrate in-depth knowledge of all stages of patent life including EP/PCT systems, opposition and appeal (with deadlines) and consequences of non-action
 - Prepare UK/Community registered design filings and take through to registration with no/minimal supervision
 - Run own Diary and meet procedural deadlines in a timely manner
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Infringement

- Recognise and be able to advise on registered design and unregistered design, design right and copyright infringement in the UK and infringement of Community registered designs
- Demonstrate detailed understanding of infringement concepts, tactics and effect of bringing court actions
- Demonstrate awareness of the effects of legal and IP privilege on infringement advice
- (Post-qualification) – demonstrate ability to take primary responsibility for litigation in the Patents County Court, acting in liaison with Counsel if required