

Competency Framework - Trade Marks

The material below sets out the general and technical skill sets which provide a framework within which a trainee trade mark attorney is expected to work when undertaking IP legal services. It also includes indicative guidance for trainee trade mark 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 “evidencing competency” exemplars listed 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 trade mark 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 in 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 clients

- 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 (such as file reviews, ledgers etc) up to date and processing financial transactions in accordance with rules and procedures and with due regard to information security

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 a trade mark and other IP rights in order, under supervision, to advise clients on the protection these confer and to undertake basic and simple prosecution work. *Trainees who have a degree in IP or have completed IP modules within their degree are likely to be able to move straight to the Intermediate Level*

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

- Identify and explain basic features of a trade mark by comparison to other IP rights such as patents, design and copyright; can identify and describe different types of trade mark (eg words, devices, logos, slogans)
- Identify key features of other trade mark registration systems in Europe, ie the CTM and Madrid Protocol and explain these in outline
- Analyse client's instructions and give outline advice as to suitable trade mark protection options
- Analyse a simple trade mark clearance search report and pick out serious obstacles
- Explain why trade mark clearance searches are required and know how to conduct identical knock-out searches on-line
- Navigate the UK IPO and OHIM websites competently
- Analyse a basic UK or OHIM examination report and suggest points for response
- Read a simple case report and note key points covered; be aware of key sources of IP case law
- Describe salient features of national trade mark registration systems in the US and other major overseas jurisdictions

Drafting

- Prepare a suggested specification of goods and/or services as required for a trade mark filing in the UK or at OHIM
- Draft a basic reporting letter to client following receipt of the first examination report and advise on next steps, including preparation of draft response

Validity

- Awareness of the bases on which trade mark rights can be challenged, eg non-use, or conflict with earlier rights and the times when this comes into play
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Prosecution

- Describe in outline how to apply for a trade mark registration in the UK or at OHIM and the usual prosecution stages through to registration
 - Collate material needed to support a response to official letters querying specification wording or other preliminary queries such as applicant details
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Infringement

- Awareness of key legal provisions defining trade mark infringement and defences in UK and at CTM level; has outline knowledge of the elements of “passing-off” and leading cases

**Technical/
Intermediate Level**

At this level 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

- Prepare a coherent note of a client meeting correctly describing the advice given by the professional advisor and what was agreed by the client
- Review a complex clearance search report and list conflicts in order of importance; can give overall guidance on likely availability of a client's mark in a letter or advice note
- Explain to client the various materials required to support a claim to acquired distinctiveness of a trade mark
- Identify and explain basic features of UK/CTM opposition procedures to a client in an advice letter
- Explain to client basic formal requirements for trade mark assignments in the UK and at OHIM including describing procedures for recordal

Drafting

- Draft a complex set of written arguments in reply to official objections to a trade mark filing received from the UK IPO or OHIM based on lack of distinctiveness and cite relevant case law
- Draft a witness statement setting out materials relied on to support a claim to acquired distinctiveness before the UK IPO and /or OHIM in coherent form
- Draft a basic UK or CTM assignment document

Validity

- Analyse potential bases for attacking a conflicting earlier trade mark right owned by a third party and advise client if a challenge received from a third party to their mark can be defended

Prosecution

- Prepare a notice of opposition to a UK mark or a CTM and observe key deadlines

- Handle basic filing procedures for UK or a Community Design filing
 - Prepare a basic non-use challenge to a registered UK mark or a CTM
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Infringement

- Identify a situation where trade mark infringement and/or passing-off is an issue and advise client on next steps, including potential legal action
- Describe Nominet domain name dispute procedure and know how to object to a conflicting domain name

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 trade mark 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

- Advise client on options for a complex worldwide trade mark and design filing programme
- Provide tactical advice to client in a conflict situation based on risk analysis; can outline litigation and ADR/mediation options; is aware of effect of legal and IP privilege on advice given
- Provide strategic advice to client re management and exploitation of their trade mark portfolio including licensing opportunities and perils of non-use; can advise in detail on correct uses of trade marks
- Liaise with client and other side's representative to negotiate a settlement of a contentious matter or to negotiate the acquisition of conflicting rights
- Handle all types of contentious work before the UK IPO or OHIM (opposition, cancellation and invalidity proceedings) largely unsupervised and keep client fully advised on their progress and next steps
- Keep up to date with recent case law and procedural changes and can present these coherently to clients or colleagues at CPD meetings

Drafting

- Draft a detailed report to client re outcome of a complex clearance search, clearly listing conflicts in order of importance
- Draft supporting material for a formal Notice of Opposition, or a Counterstatement concerning a UK mark or a CTM filing or for taking Invalidity or Cancellation actions against such marks once registered
- Draft detailed supporting evidence (in affidavit or witness statement format) for opposition, cancellation and invalidity proceedings involving UK or CTM marks
- Draft a set of complex trade mark assignments
- Draft a domain name or registered design transfer
- Draft a straightforward trade mark licence with quality control provisions (but no general commercial terms)
- Draft a settlement agreement or a co-existence agreement

- Draft an article on recent case law/procedural changes for the *ITMA Review*
 - Draft Instructions to Counsel identifying key points requiring Counsel's advice and collate relevant enclosures
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Validity

- Analyse and advise in depth on availability of UK/CTM revocation/cancellation or invalidation procedures against conflicting UK or CTM marks including relevant case law
 - Advise clients on likely defences to such actions involving their own marks
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Prosecution

- Responsible for running own Diary and meeting procedural deadlines in a timely manner
 - Handle all stages of a complex UK/CTM case filing through to registration in a timely and efficient manner, observing all deadlines and keeping client informed
 - Oversee foreign trade mark matters handled by overseas associates by reviewing their opinions critically and requesting further advice where needed before taking client's instructions
 - Prepare a complex Madrid Protocol filing programme with correct designations and supporting documents
 - Prepare a Community Design filing and take it through to registration
 - Handle complex contentious matters before the UK IPO/OHIM including filing of all key documents and supporting materials in a timely and efficient manner
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Infringement

- Advise client on complex issues involving potential UK/CTM infringement or passing-off claims including preparation of a suitable letter before action; is aware of risks posed by threats actions
- Prepare and file a formal objection in a domain name dispute
- Recognise and advise on likely Design or copyright infringements in the UK or under the CRD system
- (Post-qualification) demonstrate ability to take primary responsibility for infringement litigation involving trademarks, designs and associated passing-off claims in the PCC, acting in liaison with Counsel if required