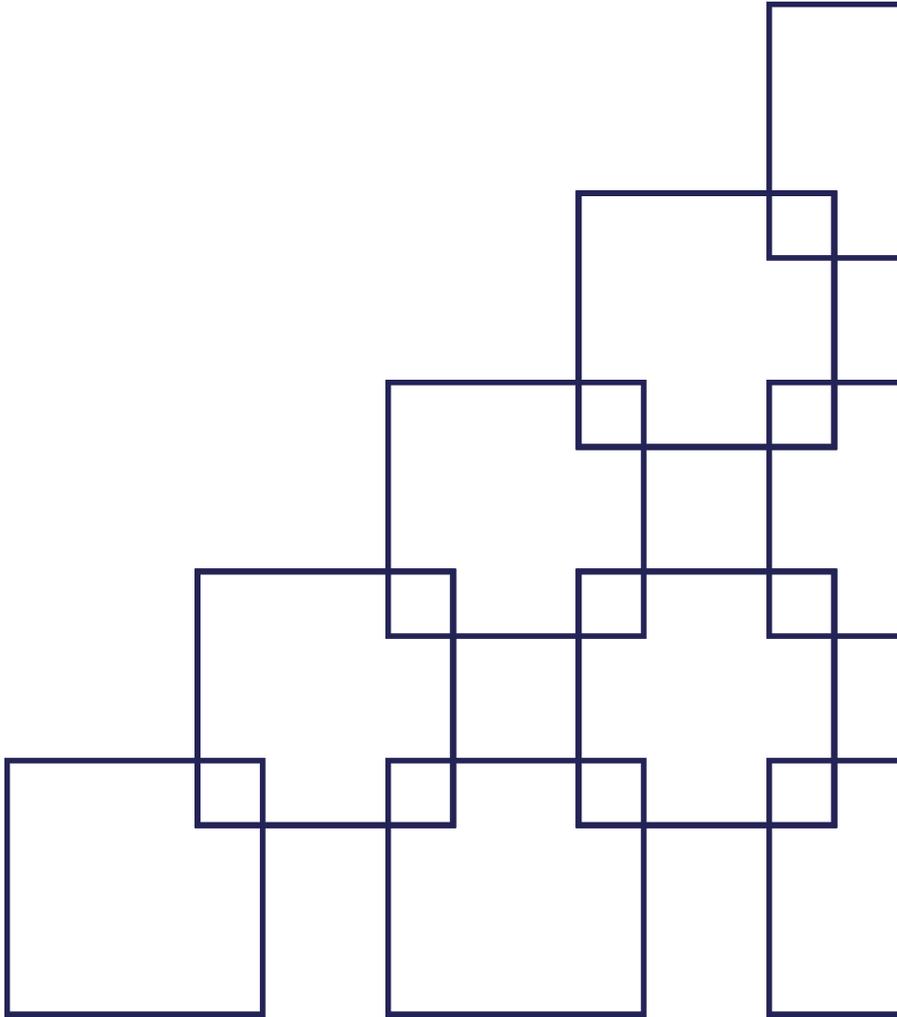


Advanced Competency Framework for Chartered Trade Mark Attorneys



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1. Introduction

Welcome to our Advanced Competency Framework, which outlines the key skill sets of an experienced Chartered Trade Mark Attorney.

The framework includes technical skills, related to understanding of legislation and management of trade marks and designs, and general skills such as communication, conduct and ethics, self-awareness and development.

We intend for this framework to be used by all Chartered Trade Mark Attorneys as a guide to areas for learning, training and development. However, it will be most relevant to those with more than five years' post-qualification experience.

We have designed the framework so it follows on from the Intellectual Property Regulation Board's (IPReg) competency framework for trainee trade mark attorneys. It can be used to demonstrate progression from being a newly qualified Chartered Trade Mark Attorney.

Chartered Trade Mark Attorneys as well as line managers, senior/department managers, trainers and HR departments within firms can use this framework to identify key competences and help identify skills gaps.

Not all Chartered Trade Mark Attorneys will necessarily undertake all the areas set out in this framework - we do not intend this to be an overly prescriptive list.

The framework is intended to provide a general illustration of the standards and knowledge expected of Chartered Trade Mark Attorneys and is by no means a set of compulsory elements.

We acknowledge that there will be differences in the type of work undertaken by Chartered Trade Mark Attorneys in different working environments.

This will be most notable between those working in private practice and those in industry. There will also be distinctions because of the nature of the business you work in whether that is serving corporate clients, SMEs or individuals; as well as by the organisation particularly if there is a strong focus on a particular area.

2. Technical competences

Skill set 1: IP Prosecution and validity

You should be able to:	Knowledge and understanding
<p>1.1 Objections</p> <p>Handle the full range of objections to registrability before the UKIPO and EUIPO with confidence</p> <p>Handle the prosecution of certification and collective marks (as appropriate)</p> <p>Advise clients appropriately as to the strength of their position on both a prima facie basis and on the basis of evidence which they provide to you relating to a used mark</p> <p>Prepare and present evidence of distinctiveness in a logical, persuasive and credible manner</p> <p>Write persuasive submissions on the prima facie registrability of marks</p> <p>Prepare for and conduct ex parte hearings before the UK IPO with confidence</p> <p>Advise clients on appeals to the Appointed Person (as appropriate)</p> <p>Advise clients on the options available for Judicial Review for the purposes of referring work to a Judicial Review specialist (as appropriate)</p>	<p>Relevant law, including recent UK and European decisions</p> <p>Madrid System</p>

<p>1.2 Adversarial proceedings</p> <p>Manage and, where appropriate, conduct adversarial proceedings before the UK IPO and EUIPO</p> <p>Select appropriate grounds of opposition and conduct proceedings in such a way as to best advance the client's position</p> <p>Make appropriate decisions as whether the case should be handled in-house or externally</p> <p>Prepare evidence</p> <p>Identify, select and handle witnesses and prepare draft statements</p> <p>Draft pleadings to best progress the case towards the client's desired outcomes and with regard to the client's objectives</p> <p>Draft skeleton arguments</p> <p>Prepare for and conduct oral hearings before the UK IPO, including advising clients as to the procedure</p>	<p>Law and practice of evidence, including the appropriateness of different kinds of evidence</p> <p>Registry and EUIPO practice as to the conduct of proceedings, including the types of evidence preferred by those tribunals</p> <p>The role of the advocate</p> <p>Conduct and ethics, including regulatory requirements (IPReg Code) questions of whether the case is within the competency of the team involved or whether it requires external assistance</p> <p>Submissions (written and oral) before the UK IPO and EUIPO (as appropriate) and the requirements for a compliant defence in UK IPO proceedings</p> <p>How to manage and conduct appeals</p>
<p>1.3 Domain names</p> <p>Advise clients at a strategic and day-to-day level with regard to domain name issues, including ownership, maintenance and disputes</p> <p>Advise clients on domain name recovery procedures, including the use of formal proceedings before the Courts</p> <p>Conduct dispute procedures</p>	<p>Ownership strategies, including the restrictions on ownership of certain domain names</p> <p>Use of the Trademark Clearinghouse</p>

<p>1.4 Design rights</p> <p>Give strategic advice on the protection of designs alongside trade marks and other rights of the client to maximise their portfolio according to their needs and objectives</p> <p>Give clear, accurate advice on the registration of registered designs before the UK IPO and EUIPO, including filing strategies, and prosecute such registrations.</p> <p>Advise on disputes relating to unregistered and registered UK and Community designs</p> <p>Understand and be able to prosecute actions before the UK IPO and EUIPO relating to the cancellation of registered designs.</p> <p>Advise on the acquisition of designs and alternative rights in other jurisdictions</p>	<p>The full range of issues relating to registered and unregistered design rights before the UK IPO and EUIPO</p> <p>The existence of registered designs and alternative rights in other countries and the implications for client strategies</p>
<p>1.5 Copyright, database and software rights</p> <p>Advise clients regarding the exploitation and enforcement of copyright, and the appropriateness and availability of registration of copyright in other countries (where applicable)</p> <p>Draft documents to fulfil the client's IP objectives</p> <p>Advise on, and undertake pre-litigation correspondence, in relation to allegations of copyright infringement</p>	<p>UK copyright law, including ownership of copyright in a variety of commercial situations</p> <p>Have a basic understanding of what a database right is for the purpose of directing work to a lawyer specialising in this area</p> <p>Have a basic understanding of what a software right is for the purpose of directing work to a lawyer specialising in this area</p>
<p>1.6 Alternative IP rights</p> <p>Identify potential opportunities for the client to obtain other intellectual property or connected rights</p> <p>Make appropriate decisions as to whether to undertake such work personally or to refer such work to appropriately-trained colleagues and fellow professionals</p>	<p>Geographical indications</p> <p>Confidential information, including trade secrets</p> <p>Have a basic understanding of what a patent is for the purpose of directing work to a Patent Attorney</p> <p>Have an understanding of disclosure for IP rights and be able to advise on and draft Non-Disclosure Agreements for the purposes of directing work to a lawyer specialising in this area (where appropriate)</p>

Skill set 2: IP litigation and enforcement

You should be able to:	Knowledge and understanding
<p>2.1 Civil litigation - strategy</p> <p>Provide clients with appropriate advice as to their options</p> <p>Draft and manage pre-action correspondence to promote the client's case in line with the client's objectives</p> <p>Identify the potential for alternative or complementary legal claims to further your client's case that may involve the use of other legal professionals</p> <p>Assess your capability to advise on all aspects of any proposed civil litigation, and the capability of your firm and its professionals to handle the demands of civil litigation, and make decisions, where appropriate, as to external assistance and alternative firms</p>	<p>The place of civil litigation and the process of litigation, including how it fits alongside questions of prosecution and validity, issues of cost and risk</p> <p>Sources of law and rules and their appropriate application</p> <p>The advantages and disadvantages of the various available Courts, including implications as to procedures, costs and cases which may be brought</p> <p>Understand the requirements for appropriately drafted pre-action correspondence</p> <p>Unjustified threats</p>
<p>2.2 Civil litigation pleadings</p> <p>Advise on, and draft, pleadings which clear, concise and comply with the Civil Procedure Rules and which further the client's objectives,</p> <p>Exercise discretion in the drafting of the pleadings in accordance with the needs of the case</p> <p>Advise a client appropriately about the claims made and give advice as to the form and content of the defence</p> <p>Draft a defence which complies with all appropriate rules and which furthers the interests of your client</p> <p>Advise on, and reply to, pleadings received from third parties against your client</p>	<p>The different requirements of the various Courts (in contrast with the UK IPO) with regard to the level of detail</p> <p>The requirements for a compliant defence and the appropriate use of Part 18 requests and pre-action requests for further information.</p>

<p>2.3 Civil litigation prosecution</p> <p>Conduct appropriate proceedings before the Intellectual Property Enterprise Court, including advising on the use of third parties to assist where necessary and using good judgment in the choice of such third parties</p> <p>Advise clients regarding the procedure before the appropriate courts and prepare appropriate documents for the Courts</p> <p>Advise clients as to their obligations before the court</p> <p>Advise clients on forms of alternative dispute resolution and their appropriateness and the cost sanctions applicable for unreasonable refusal of alternative dispute resolution</p> <p>Advise clients as to the financial implications of proposed courses of action, and any cost caps that may apply, including the inclusion of certain arguments and applications proposed to be made or defended</p> <p>Work alongside other professionals to improve your client's position</p>	<p>The purposes of, and availability of, various types of application, to progress your client's position and, where appropriate, draft and appear in such applications</p> <p>Disclosure, preservation of documents and the privilege attaching to documents, including circumstances where disclosure may be reasonably withheld, and awareness of the cost benefit test applied to disclosure</p> <p>The law relating to Part 36 offers and other offers to settle, and the appropriateness of Alternative Dispute Resolution</p> <p>The requirements of counsel and other firms</p> <p>Applications for Default Judgment in the Intellectual Property Enterprise Court</p> <p>The requirements for preparation and attendance at Case Management Conferences in IPEC, including the preparation of a draft Order</p>
<p>2.4 Evidence law and practice</p> <p>Apply knowledge of evidence law, practice and concepts confidently and effectively in dispute cases</p>	<p>Relevant law relating to the admissibility of evidence</p> <p>Concepts of credibility of witnesses, challenging evidence, and similar fact evidence</p>
<p>2.5 Civil litigation cross-examination intensive</p> <p>Advise clients as to what to expect from the experience of cross-examination</p> <p>Recognise the consequences for a case of the outcome of cross-examination, and take appropriate steps in a case as a result</p>	<p>What allegations need to be put to a witness</p>
<p>2.6 Customs procedures</p> <p>Work with customs agencies, law enforcement agencies and others to protect and enforce the client's IP rights</p>	<p>Application for Action</p> <p>Seizures</p> <p>Release/destruction of seized goods</p>

<p>2.7 Anti-counterfeiting</p> <p>Advise the client on strategies to protect their IP rights against counterfeiting</p> <p>Ability to explain the options available to prosecute under criminal law, and the remedies available thereto, for the purpose of directing work to a criminal lawyer</p>	<p>Appropriate strategies</p> <p>Prevention /anti-counterfeiting technologies</p> <p>Working with Trading Standards services</p> <p>Section 9 Witness Statements</p>
<p>2.8 Online monitoring and enforcement</p> <p>Advise clients on the requirements for takedowns on social media and marketplaces and the options available to resolve their commercial concerns</p> <p>Advise clients on the practical issues arising from certain approaches including the potential for non-legal consequences</p> <p>Devise a suitable strategy for the client to handle online issues</p>	<p>Online monitoring and enforcement (social media and marketplaces): watch systems, take-down procedures across differing platforms, and further escalation</p>
<p>2.9 Negotiation, mediation and alternative dispute resolution (ADR)</p> <p>Explain the importance of ADR, the various forms of ADR to parties and the financial implications of unreasonably refusing ADR (where applicable)</p> <p>Advise clients on whether ADR would be appropriate to their issues and identify the form which would be most appropriate</p> <p>Confidently defend a decision not to adopt ADR and give supported, relevant reasons for not using it</p>	<p>Forms of ADR</p>
<p>2.10 Working knowledge</p> <p>Explain the basic principles of parallel imports, customs procedures outside of the UK and the EU, competition law and malicious falsehood to clients for the purposes of directing work to a specialist in these areas</p>	<p>Parallel Imports and exhaustion</p> <p>Basic understanding of customs procedures in territories outside of the UK and the EU for the purposes of directing work to an appropriate person in this territory (where appropriate)</p> <p>Competition law</p> <p>Malicious falsehood</p>

Skill set 3: Commercial legal skills

You should be able to:	Knowledge and understanding
<p>3.1 Company and partnership law</p> <p>Provide accurate, appropriate advice on company and partnership law to meet the client's needs</p>	<p>Corporate structures</p> <p>Liquidation</p> <p>Personal liability of directors/joint tortfeasorship and several liability</p>
<p>3.2 Property law and practice in the IP field</p> <p>Provide accurate, appropriate advice on property law and practice including equitable rights</p> <p>Identify the potential for other legal principles to have an effect on a client's matters</p> <p>Identify and instruct appropriate third parties to deal with ancillary legal matters, and work as part of a team alongside them to resolve the client's matters</p>	<p>Basic property law and equitable principles</p>
<p>3.3 Contract law</p> <p>Interpret and draft IP clauses</p>	<p>Co-existence agreements</p> <p>Settlement agreements</p> <p>Licensing agreements</p> <p>Mergers and acquisitions</p> <p>Assignments</p> <p>Non disclosure agreements</p>
<p>3.4 Company names tribunal</p> <p>Advise clients when it would be appropriate to make use of the Company Names Tribunal to resolve their needs</p>	<p>The cases which would, or would not, be appropriate to commence in the Company Names Tribunal</p>

<p>3.5 Securitisation/due diligence</p> <p>Explain to a client about the difference forms of securitisation which may apply to their IP portfolio and how this may affect them</p> <p>Undertake and manage due diligence programmes in relation to the intellectual property of clients</p>	<p>Principles of securitisation</p>
<p>3.6 Tax</p> <p>Provide accurate and appropriate advice on matters relating to tax to meet the client's needs</p>	<p>IP ownership structures</p> <p>Basic principles of taxation</p> <p>The potential tax implications of commercial proposals and the need to seek formal tax advice</p>
<p>3.7 Advertising¹</p> <p>Identify potential issues in advertising or promotional material shown by clients</p>	<p>The role of the ASA and its extent</p> <p>ASA (CAP Codes)/comparative advertising in practice</p> <p>The general principles within the CAP Code</p>
<p>3.8 Insolvency and Bona Vacantia</p> <p>Advise clients on matters relating to insolvency and IP rights</p> <p>Advise clients in relation to transactions with the Bona Vacantia Division and liquidators</p>	<p>The basic law relating to insolvency and the effects of insolvency on the IP assets of a company</p> <p>The place of the Bona Vacantia unit</p>

1. Refer to section 2.8 Online monitoring and enforcement

3. Management competences

Skill set 4: Practice management	
You should be able to:	Knowledge and understanding
<p>4.1 Finance</p> <p>Analyse financial data and draw conclusions</p> <p>Use financial data to inform strategic planning and decision-making</p> <p>Generate ideas to improve financial performance, including improving staff productivity</p>	<p>Balance Sheet</p> <p>Income and Expenditure Account (or Profit and Loss Account)</p> <p>Management accounts</p> <p>Forecasting and budgeting</p> <p>Action planning</p> <p>Money laundering</p>
<p>4.2 People management</p> <p>Identify current, future and anticipated human resource requirements</p> <p>Manage staff selection, recruitment and induction processes</p> <p>Contribute to the development of performance management strategies</p> <p>Manage the performance of others</p> <p>Manage grievance, disciplinary and employment termination processes</p> <p>Assess the impact of current legal requirements, work-life balance issues and changing work patterns on the organisation's human resource planning</p>	<p>Recruitment and selection</p> <p>Delegation, mentoring and coaching</p> <p>Employee engagement</p> <p>Rewards and benefits</p> <p>Talent management</p> <p>Employee performance management systems and tools</p> <p>Managing grievance and disciplinary processes</p> <p>Termination of employment, including redundancy and dismissal</p> <p>Organisation's policies</p> <p>Employment law for managers</p>

<p>4.3 Leadership</p> <p>Assess the impact of the organisation's culture and values on strategic leadership</p> <p>Contribute to the development of the organisation's strategic objectives</p> <p>Evaluate own leadership style and impact on organisational strategy and decision-making</p> <p>Use influencing and persuading skills in personal interactions, taking account of the impact of individual dynamics and organisational politics</p> <p>Identify situational variables that could cause a change in leadership strategy</p> <p>Explain how ethical leadership impacts on organisational practice</p>	<p>The concept of managers as effective leaders</p> <p>Traits and behaviours of leaders</p> <p>How to motivate, influence and persuade others</p> <p>Storytelling, communicating and emotional intelligence</p> <p>Organisational, legal and regulatory requirements that impact on strategic leadership</p> <p>Ethics in leadership</p>
<p>4.4 Project management</p> <p>Analyse how the proposed project will contribute to strategic objectives</p> <p>Identify project sponsor and project stakeholders</p> <p>Appoint project manager and project team members</p> <p>Scope project, prepare specification and develop the project plan</p> <p>Obtain approval for project</p> <p>Identify methods for securing stakeholder support</p> <p>Establish methods and frequency of communication with stakeholders and other parties</p> <p>Carry out project review</p>	<p>Phases of the project plan:</p> <ul style="list-style-type: none"> ● initiation of start-up: set terms of reference, set objectives, agree budget, appoint team members; ● planning and organisation: identify task, define governance process and agree reporting requirements; ● implementation and monitoring: carry out and control project activities; ● completion and post-implementation review <p>Resourcing the plan</p> <p>Project communication</p> <p>Building the team</p> <p>Monitoring and controlling projects</p> <p>Project closure and learning review</p>