

CITMA Paralegal Competency Framework

Contents

1 Introduction	2
2 General competences	3
Skill set 1: Communication.	3
Skill set 2: Managing your workload . .	4
Skill set 3: Business awareness.	4
Skill set 4: Conduct and ethics.	5
Skill set 5: Self-awareness and development	5
Skill set 6: Working with others	6
3 Technical skills	7
Skill set 7: Understand trade marks . .	7
Skill set 8: Trade marks – filing and formalities.	7
Skill set 9: Trade marks: renewals	8
Skill set 10: Seniority, conversion, recordals and records	8
Skill set 11: Contentious matters.	9
Skill set 12: Designs and copyright . . .	9
Skill set 13: IP business support	9

1 Introduction

The skill sets below set out the general and technical skill sets which provide a framework in which a CITMA Paralegal is expected to work when supporting Chartered Trade Mark Attorneys and other IP legal professionals.

There will inevitably be differences in the type of work undertaken by CITMA Paralegals in different working environments, notably private practice vs industry, and by the nature of the business they work in, for example, serving corporate clients, SMEs or individuals, or by the organisation of a business whereby a CITMA Paralegal focusses on a particular area, for example, on renewals or in providing support in contentious matters. As such, this Competency Framework is a general illustration of the standards and knowledge that are expected of CITMA Paralegals but they by no means need to “tick off” every element. Nonetheless, more junior CITMA Paralegals may see a path for progression and learning where senior CITMA Paralegals in their organisation are covering some of the tasks they are not yet handling.

It is appreciated that in many workplaces the roles of trainee trade mark attorneys and paralegals can be blurred. Additionally, some CITMA Paralegals will be considering or undertaking training to become a Registered Trade Mark Attorney. The ‘Competency Framework - Trade Marks’ of the Intellectual Property Regulation Board (IPReg) should be referred to, if appropriate.

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

2 General competences

Skill set 1: Communication	
You should be able to:	Knowledge
1.1 Read and process incoming correspondence, including emails, accurately	<p>Standards of written and verbal communication appropriate to a professional environment</p> <p>Organisational procedures and processes</p> <p>Organisation's house style</p>
1.2 Ascertain deadlines for responding to official communications	
1.3 Prepare standard letters and emails in accordance with internal procedures and house style	
1.4 Ensure all elements of a task are understood, checking information when necessary and referring queries to an appropriate person	
1.5 Under appropriate supervision, prepare non-standard letters and emails using appropriate house styles	
1.6 Be courteous in all communication	
1.7 Use clear, concise and accurate language in all communication	
1.8 Adapt communication style and language to suit your audience	
<p>Guidance</p> <p>Communication includes all forms of written and verbal communication.</p> <p>Correspondence includes all forms of written communication including letters, official communications and emails</p>	

Skill set 2: Managing your workload

You should be able to:	Knowledge
2.1 Manage your workload without causing or allowing any unnecessary delay to the progress of a matter	<p>Organisation's procedures and processes including database and accounting systems, if relevant</p> <p>Prioritisation: the importance of differentiating between deadlines that may be imminent and those that are more pressing. For example, some deadlines require fairly simple responses whereas others may require obtaining supporting documentation that may take some time to collate together</p>
2.2 Plan and prioritise workload including managing tasks concurrently, making the best use of available resources and seeking support where necessary	
2.3 Monitor, prioritise and manage upcoming deadlines	
2.4 Maintain organisational files and business systems (including databases and accounting records) in accordance with established procedures	

Skill set 3: Business awareness

You should be able to:	Knowledge
3.1 Describe the business and legal environment in which you work	<p>The company you work for, an understanding of your role and the industry in which you work</p>
3.2 Identify the aims and objectives of the organisation in which you work	
3.3 Describe your own role and other key roles within the organisation where you work	
3.4 Understand the procedures and processes in force and in which you are involved in your role	
3.5 Suggest improvements in your organisation's procedures and processes to your supervisor, as appropriate	
<p>Guidance</p> <p>3.3 Key roles are likely to include your line manager, team members and members of staff who you work closely with or supervise</p>	

Skill set 4: Conduct and ethics

You should be able to:	Knowledge
4.1 Adhere to the accounting, anti-money laundering and data protection regulations that impact your organisation	Relevant requirements of legislation and regulations Organisation policies
4.2 Keep confidential information confidential and secure	
4.3 Work with others (clients, agents, suppliers and colleagues) without discrimination or prejudice	
4.4 Treat others courteously, respectfully and with dignity	
<p>Guidance</p> <p>4.3 and 4.4 include ensuring you do not discriminate on the basis of age, disability, race, religion, gender, sexual orientation or other factors; challenging discriminatory actions and working to ensure inclusion of anybody who could feel excluded.</p>	

Skill set 5: Self-awareness and development

You should be able to:	Knowledge
5.1 Regularly reflect on and review own performance, set achievable objectives and monitor progress against objectives	Organisation's performance management system
5.2 Identify where you do not have the skills required to undertake a task and know what to do when such a situation arises	
5.3 Demonstrate commitment to continued professional development and learning	
<p>Guidance:</p> <p>Reflection and review of own performance should include:</p> <ul style="list-style-type: none"> Identifying strengths and weaknesses in own work Identifying development and training needs 	

Skill set 6: Working with others

You should be able to:	Knowledge
6.1 Understand the importance of establishing effective working relationships with other professionals involved in the trade mark profession	Understand the people you interact with and how you can build a positive relationship with them
6.2 Develop relationships with colleagues at all levels including the senior Attorneys within your organisation	
6.3 Identify tasks that are better managed by others and seek support as necessary	
6.4 Share information, knowledge and experience openly and willingly	
6.5 If appropriate, assist with the training and mentoring of other staff members	
Guidance 6.1 Other professionals are likely to include: Chartered Trade Mark Attorneys, solicitors, colleagues, clients, UK IPO staff, foreign agents and suppliers of IP services	

3 Technical skills

Skill set 7: Understand trade marks	
You should be able to:	You should know:
7.1 Search and classify trade marks	What does not qualify as a trade mark
7.2 Conduct trade mark searches using appropriate online tools	The reasons why a trade mark search is conducted
7.3 Check for approved terms using online tools	The purpose of the International classification system The “typical” lifecycle of a trade mark How to use appropriate online tools
<p>Guidance:</p> <p>7.2 Online tools will normally include tools such as UK IPO tools, TMview, TMclass or commercial databases</p>	

Skill set 8: Trade marks – filing and formalities	
You should be able to:	Knowledge
8.1 Complete a UK trade mark application online unsupervised or with minimal supervision	The process of registering a trade mark in the UK in a smooth case
8.2 Complete an EU trade mark application online unsupervised or with minimal supervision	<p>Official fees due for filing UK trade mark applications often filed by your organisation</p> <p>The process of registering a trade mark in the EU in a smooth case</p> <p>Official fees due for filing EU trade mark applications often filed by your organisation</p> <p>The concept of priority, the deadlines involved and how to claim it</p> <p>The process of registering a trade mark in foreign countries in which your organisation typically files, including how foreign agents are used</p> <p>The circumstances in which certain documents must be notarised and legalised</p> <p>The process of registering a trade mark under the Madrid Protocol, including the role of the Office of origin, the role of WIPO and the roles of the IP Offices of designated states and when agents might play a role</p>

Skill set 9: Trade marks: renewals

You should be able to:	Knowledge
9.1 Complete a UK trade mark renewal online unsupervised or with minimal supervision	The use of foreign agents/suppliers to help the process of renewing and maintaining trade marks in other countries
9.2 Complete an EU trade mark renewal online unsupervised or with minimal supervision	
9.3 Complete an International trade mark renewal online unsupervised or with minimal supervision	
9.4 Describe the process of renewing and maintaining trade marks in foreign countries in which your organisation is typically maintaining	
9.5 Calculate renewal deadlines and grace periods for renewal	

Skill set 10: Seniority, conversion, recordals and records

You should be able to:	Knowledge
10.1 Complete an EU trade mark conversion online unsupervised or with minimal supervision	The concept of seniority and 'triple identity' The concept of conversion
10.2 Follow processes to make applications to record licences, security interests, assignments, mergers, Changes of Name, Changes of Address and Changes of Address for Service in the UK and EU, on the International Register, or in foreign countries, as appropriate to the work of your organisation	The differences between the processes listed
10.3 Complete UK, EU and International trade mark recordal applications unsupervised or with minimal supervision	
10.4 Maintain accurate trade mark and IP records and disputes	
10.5 Undertake data verification of trade mark registrations using online databases	

Skill set 11: Contentious matters

You should be able to:	Knowledge
11.1 Support Chartered Trade Mark Attorneys (and/or IP Solicitors) in the preparation of opposition, invalidation and revocation papers for filing at the UK IPO and EUIPO	The framework process for opposing, invalidating and revocating trade marks in the UK and EU, including relevant deadlines
	The purpose of The Company Names Tribunal and, if appropriate to your work, the framework process for applications made to it, including relevant deadlines

Skill set 12: Designs and copyright

You should be able to:	Knowledge
12.1 Complete a UK registered design application online unsupervised or with minimal supervision	The process of registering a registered design in the UK in a smooth case
12.2 Complete a Registered Community Design application online unsupervised or with minimal supervision	The process of registering a registered design in the EU in a smooth case
12.3 Complete a design application under the Hague Agreement online unsupervised or with minimal supervision	The process of registering a registered design/design patent or copyright in foreign countries in which your organisation is typically filing, including having appropriate contacts with agents to help with any queries
	The types of works protected by copyright

Skill set 13: IP business support

You should be able to:	Knowledge
13.1 Register, renew and manage domain name registrations using online tools	That domain names are not trade marks and that most domains are allocated on a first-come, first-served basis
13.1 Manage deposit accounts held with the UK IPO, EUIPO and WIPO, and accounts held with any subscription services	Basic understanding of the UDRP process with WIPO or Nominet dispute resolution service
13.1 Manage trade mark watches using online tools	Why a trade mark watch is set up