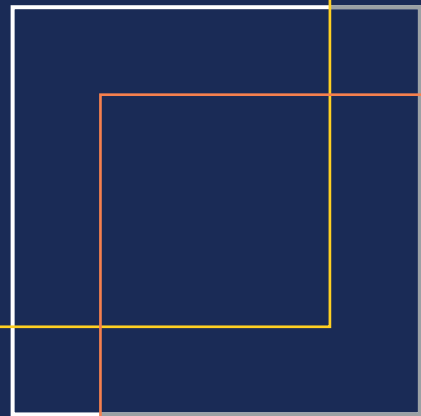
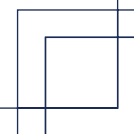


CITMA Paralegal Competency Framework

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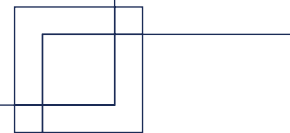


Contents



Introduction	3
<hr/>	
Technical skills	
<hr/>	
Skill set 1: Trade marks - searching	4
Skill set 2: Trade marks – filing and formalities	5
Skill set 3: Trade marks – renewals and maintenance	6
Skill set 4: Seniority, conversion, recordals and records	7
Skill set 5: Contentious matters	7
Skill set 6: Watching services	8
Skill set 7: Designs and copyright	8
Skill set 8: Domain names and online infringements	9
<hr/>	
General skills	
<hr/>	
Skill set 9: Communication	10
Skill set 10: Managing your workload	11
Skill set 11: Conduct and ethics	12
Skill set 12: Business awareness	13
Skill set 13: Learning and development	14
<hr/>	
Advanced skills	
<hr/>	
Skill set 14: Business development and building your network	15
Skill set 15: Leadership and management	16

Introduction



Welcome to our Paralegal Competency Framework, which outlines the key skill sets of a CITMA Paralegal.

This framework includes technical skills, relating to understanding the management of trade marks and designs, and general skills such as communication, professional development and ethics.

We intend for this framework to be used by all CITMA Paralegals as a guide to areas for learning, training and development.

The advanced competences will be most relevant to those with more than five years' experience after passing the CITMA Paralegal Course. Please note that some skill sets also have advanced knowledge and understanding that sit along side the competences, these are highlighted in yellow for ease of reference.

CITMA Paralegals as well as managers, senior-department managers, trainers and HR departments within firms can use this framework to help identify key competences and skill gaps.

Not all CITMA Paralegals will necessarily undertake all the areas set out in this framework and we do not intend this to be an overly prescriptive list.

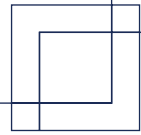
The framework is intended to provide a general illustration of the standards and knowledge expected of CITMA Paralegals and is by no means a set of compulsory elements.

We acknowledge that there will be differences in the type of work undertaken by CITMA Paralegals 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 especially if there is a strong focus on a particular area.

Please note that skill sets 1 to 13 relate to standard and advanced competences, skill sets 14 and 15 are advanced competences only.

Technical skills



Skill set 1: Trade marks - searching

Standard competences:

- 1.1**
Classify trade marks and use online tools to check for approved terms.

- 1.2**
Conduct identical trade mark searches using appropriate online tools.

- 1.3**
Instruct a third-party provider or an overseas agent to conduct a search.

Advanced competences:

- 1.4**
Search, compile, review and traffic light search results before handing over to a Chartered Trade Mark Attorney.

Knowledge and understanding:

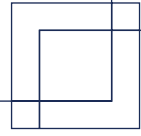
- Why a trade mark search is conducted.
- Purpose of the international classification system.
- Using appropriate online tools.

Advanced knowledge and understanding:

- How the assessments of similarities of trade marks and of goods and services are made.



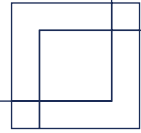
Technical skills



Skill set 2: Trade marks – filing and formalities

Standard competences:	Advanced competences:	Knowledge and understanding:
2.1 Complete a UK trade mark application online.	2.4 Review draft trade mark applications.	Process of registering a trade mark in the UK.
2.2 Complete an EU trade mark application online.	2.5 Review dates that are entered by colleagues and check for accuracy.	Process of registering a trade mark in the EU.
2.3 Have a complete understanding of relevant formalities, milestones.	2.6 Complete an international trade mark application online.	Official fees due for filing UK and EU trade mark applications. Concept of priority, the deadlines involved and how to claim it.
	2.7 Calculate WIPO fees.	Advanced knowledge and understanding: Process of registering a trade mark in overseas countries, including when using overseas agent referral networks.
	2.8 Instruct overseas applications and see through from formalities to registration.	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.
	2.9 Handle classification and formalities examination reports.	Identify circumstances in which certain documents must be notarised and legalised and make arrangements therefor.
	2.10 Awareness of additional documents required in main territories.	
	2.11 Know remedies for extending deadlines and missed deadlines.	

Technical skills



Skill set 3: Trade marks – renewals and maintenance

Standard competences:

- 3.1**
Complete a UK trade mark renewal online.

- 3.2**
Complete an EU trade mark renewal online.

- 3.3**
Calculate renewal deadlines and grace periods for renewal.

- 3.4**
Send confirmation to clients and the Chartered Trade Mark Attorney that renewals have been filed.

Advanced competences:

- 3.5**
Handle U.S. declaration of use deadlines and declarations of use for other jurisdictions where necessary.

- 3.6**
Preliminary review of specimens of use in conjunction with renewals.

- 3.7**
Review client website and collate evidence, liaising as required with client concerning collecting further evidence.

- 3.8**
Complete an international trade mark renewal online.

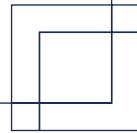
- 3.9**
Describe the process of renewing and maintaining trade marks in overseas countries.

Knowledge and understanding:

Process for renewing and maintaining trade marks and when renewals are due. This includes grace periods and provisions for restoration domestically, and more widely across the world.

Role of overseas agents /suppliers in renewing and maintaining trade marks in other countries.

Technical skills



Skill set 4: Seniority, conversion, recordals and records

Standard competences:

4.1

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 elsewhere.

4.2

Undertake data verification of trade marks using online databases and ensure accurate IP records.

4.3

Accurate record-keeping in relation to various recordals.

Advanced competences:

4.4

Implement strategies around recordals, for example when/ why to record a licence or assignment.

4.5

Oversee and manage recordal programmes, including cost estimates, their budgets and documentary requirements.

4.6

Undertake due diligence projects.

4.7

Follow processes to make an application to record replacement in the UK and elsewhere.

Knowledge and understanding:

Concepts of 'triple identity' in relation to seniority and replacement.

Principles of conversion.

Differences between the processes listed above.

Importance of making recordals and the possible implications of not doing so.

Skill set 5: Contentious matters

Standard competences:

5.1

Draft and prepare TM7As.

Advanced competences:

5.2

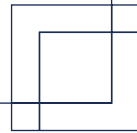
Support Chartered Trade Mark Attorneys (and/or IP solicitors) in the preparation of opposition, invalidation, revocation and The Company Names Tribunal papers and finalising evidence (i.e. pagination, cover sheets) for filings.

Knowledge and understanding:

Process for opposing, invalidating and revoking trade marks in the UK, including relevant deadlines and evidential requirements, formats and requirements for different types of evidence and evidence page limits at different stages of the UK IPO and overseas proceedings.

Purpose of The Company Names Tribunal and the process for applications made to it, including relevant deadlines.

Technical skills



Skill set 6: Watching services

Standard competences:

6.1
Manage trade mark watches using online tools.

6.2
Set up, amend and cancel a watch accurately.

Advanced competences:

6.3
Initial review of the rights that might be held.

6.4
High level review and filtering out of irrelevant results.

Knowledge and understanding:

Why a trade mark watch is set up.

Advanced knowledge and understanding:

How the assessments of similarities of trade marks and of goods and services are made.



Skill set 7: Designs and copyright

Standard competences:

7.1
Complete a UK registered design application online.

7.2
Complete an EU registered design application online.

Advanced competences:

7.3
Review draft registered design applications.

7.4
Review dates that are entered and checking for accuracy.

7.5
Complete a design application under the Hague Agreement online.

7.6
Instruct overseas applications for designs and copyright and see through from formalities to registration.

Knowledge and understanding:

Process of registering a registered design in the UK and EU.

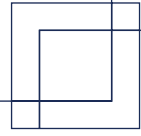
Process of registering a registered design/design patent or copyright in overseas countries.

Deferment of publications.

Grace periods for disclosure of a design before applying.

Types of works protected by copyright.

Technical skills



Skill set 8: Domain names and online infringements

Standard competences:

8.1

Register, renew and manage domain name registrations using online tools.

8.2

Handle social media and online marketplace takedown notices and recording rights within these platforms.

8.3

Conduct domain availability searches and watches, including monitoring of infringing content.

Advanced competences:

8.4

Prepare and file UDRP, URS and Nominet dispute resolution proceedings for review by a Chartered Trade Mark Attorney.

8.5

Understand domain name availability and sunrise periods for registering a domain.

8.6

Enrolment with online brand registries e.g. Amazon.

Knowledge and understanding:

Understand that most domain names are allocated on a first-come, first-served basis.

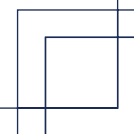
The UDRP and URS processes with WIPO or Nominet dispute resolution service.

Differences between registries, registrars and registrants.

Different types of TLD.

The commercial landscape of domain names.

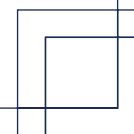
General skills



Skill set 9: Communication

Standard competences:	Advanced competences:	Knowledge and understanding:
9.1 Read and process incoming correspondence, including emails, accurately.	9.7 Prepare non-standard letters/emails and free form correspondence.	Standards of written and verbal communication appropriate to a professional environment. Organisational procedures and processes, including your organisation's house style.
9.2 Ascertain deadlines for responding to official communications.	9.8 Direct correspondence on more complex portfolio matters to the appropriate person.	
9.3 Prepare schedules, reports, standard letters and emails in accordance with internal procedures and house style.	9.9 Prepare complex schedules, reports and interpret details as necessary.	
9.4 Ensure all elements of a task are understood, checking information where necessary and referring queries to an appropriate person.	9.10 An enhanced understanding of clients' portfolios.	
9.5 Under appropriate supervision, prepare non-standard letters and emails using house styles.	9.11 Answer client calls and understand the needs of clients.	
9.6 Be comfortable in verbally communicating with both internal and external stakeholders.	9.12 Confident in presenting information and communicating knowledge.	
	9.13 Review standard text and suggest proposed changes as needed (e.g. when there are changes to house style or to law and practice).	

General skills



Skill set 10: Managing your workload

Standard competences:

10.1

Manage your workload without causing or allowing any unnecessary delay to the progress of a matter and flag when any issues arise.

10.2

Monitor, prioritise and manage upcoming deadlines.

10.3

Maintain organisational files and business systems (including databases and accounting records) in accordance with established procedures.

10.4

Be comfortable in raising issues that may arise with a senior member of staff.

Advanced competences:

10.5

Plan and prioritise workload including managing tasks concurrently, making the best use of available resources and seeking support where necessary.

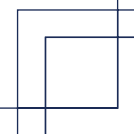
10.6

Differentiate between deadlines that may be imminent and those that are more pressing.

Knowledge and understanding:

Organisation's procedures and processes including database and account systems, if relevant.

General skills



Skill set 11: Conduct and ethics

Standard competences:

11.1
Adhere to the accounting, anti-money laundering and data protection regulations that impact your organisation.

11.2
Keep information confidential and secure.

11.3
Work with others (clients, agents, suppliers and colleagues) without discrimination or prejudice.

11.4
Treat others courteously, respectfully and with dignity.

11.5
Be transparent when mistakes are identified.

Advanced competences:

11.6
Sensitively deal with delicate situations and know when to refer to HR/Head of Department.

11.7
Understand the impact of potential conflicts of interest when taking on a new client.

11.8
Adhere to rules around client monies.

11.9
Awareness of IPReg Code of Conduct.

Knowledge and understanding:

Relevant requirements of legislation and regulations in this area.

Organisational policies.

How and when conflicts of interest may arise and identifying them.

Your organisation's policies around mental health and wellbeing.

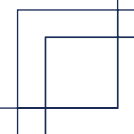
Awareness of professional and personal boundaries.

Advanced knowledge and understanding:

Compliance framework, professional indemnity insurance and when an early claims notification may need to be raised.



General skills



Skill set 12: Business awareness

Standard competences:

12.1

Have a basic understanding of the business and legal environment in which you work.

12.2

Have a basic understanding of the aims and objectives of the organisation in which you work.

12.3

Describe your own role and other key roles within the organisation in which you work.

12.4

Understand the procedures and processes in place and in which you are involved in your role.

12.5

Suggest improvements to your organisation's procedures to your supervisor, as appropriate.

Advanced competences:

12.6

Explain the business and legal environment to internal and external stakeholders.

12.7

Explain the aims and objectives of the organisation to new starters and other staff members.

12.8

Explain own role and other key roles in the organisation to new starters and other staff members.

12.9

Explain procedures and processes in place to new starters and other staff members.

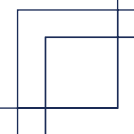
12.10

Suggest improvements to procedures/processes and create action plans for implementation of such improvements along with business cases as to how the proposed changes will positively impact the organisation.

Knowledge and understanding:

The company you work for, an understanding of your role and the industry in which you work.

General skills



Skill set 13: Learning and development

Standard competences:

13.1

Regularly reflect on and review own performance, set achievable objectives and monitor progress against objectives.

13.2

Identify where you do not have the skills required to undertake a task and know what to do when such a situation arises.

13.3

Identify development and training needs and demonstrate commitment to continued professional development and learning.

13.4

Identify strengths and weaknesses in own work.

Advanced competences:

13.5

Create and monitor training plans for colleagues.

13.6

Encourage colleagues in identifying areas for development and assisting them in obtaining the relevant skills.

13.7

Train colleagues and provide guidance as to where to find external training resources (e.g. CITMA webinars) and encouraging their professional development.

13.8

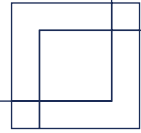
Continue with your own learning and development and set an example for colleagues.

Knowledge and understanding:

Organisation's performance management system.

Be part of the CITMA network and know where learning opportunities can be found.

Advanced skills



Skill set 14: Business development and building your network

Advanced competences:

14.1

Support business development.

14.2

Have a commercial mindset and awareness.

14.3

Build and manage relationships with clients and be comfortable in making suggestions.

14.4

Identify potential opportunities for clients and raise these with colleagues.

14.5

Identify opportunities to promote your organisation and business by contributing to industry associations i.e. joining a working group, content creation, speaking at an event.

14.6

Put together a pitch or slide deck.

Knowledge and understanding:

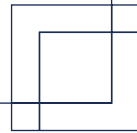
Your target audience, the needs of your clients and where your services would fit.

Industry trends, not just the IP industry but also in your clients' markets.

Awareness of why business development is important.

Awareness of the global legal landscape.

Advanced skills



Skill set 15: Leadership and management

Advanced competences:

15.1

Provide in-house training to colleagues.

15.2

Check and supervise colleagues' work as appropriate.

15.3

Teach, mentor and influence colleagues.

15.4

Identify work which needs to be prioritised and explaining the reasonings behind this to colleagues.

15.5

Know how to direct colleagues to the correct internal procedures and information.

Knowledge and understanding:

The value of upskilling yourself and members of the team.

How to prioritise and manage your workload effectively and support colleagues in this too.

How to identify learning needs for colleagues.

How to talk to people about performance and being able to evaluate and identify any issues in a timely manner.

Openness to learn and gain knowledge from colleagues across the wider profession.



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