

Pre-registration Employment Requirements for Patent Attorney Registration

1. BACKGROUND

For registration as a patent attorney, a person must have been employed in a position, or positions, that provide experience in the following skills¹:

- (i) searching patent records;
- (ii) preparing filing, and prosecuting patent applications in Australia;
- (iii) preparing, filing, and prosecuting patent applications in other countries and organisations, particularly countries and organisations that are regarded as major trading partners with Australia;
- (iv) drafting patent specifications;
- (v) providing advice on the interpretation, validity and infringement of patents.

Further, the person must have been employed in the position, or positions, of that kind for at least:

- (i) 2 continuous years; or
- (ii) a total of 2 years within 5 continuous years.

The experience is intended to ensure that the person has an appropriate foundation for practice as a patent attorney.

These guidelines are intended to provide an explanation of the required experience and the process by which it is assessed.

The Board does not register patent attorneys; that function is the responsibility of the Designated Manager under the provisions of Section 200A of the *Patents Act 1990*. The Designated Manager is appointed by the Secretary of the Department of Innovation, Industry, Science and research. Currently, the Designated Manager is the Director General, IP Australia.

The broad process is that a person seeking registration obtains a **statement of skill** and provides it to the Designated Manager as part of the evidence required for registration.² The Designated Manager must be satisfied that the experience gained by

¹ Reg. 20.10 *Patents Regulations 1991*

² Reg. 20.3 (1) *ibid*

the person concerned during the period of employment provides the level of experience required by the Designated Manager.

The **statement of skill** is a statement by a registered patent attorney who has been registered for a period for at least 5 years that, in the opinion of the registered patent attorney, the person concerned has the required experience.

The focus of the process is on the attainment of the relevant experience in each of the prescribed skills. The Designated Manager is ultimately responsible for deciding whether a person has acquired the level of experience required in order to be registered. This decision involves considerations of protecting the public interest by not registering a person who is not yet suitably experienced in all of the required capacities. The decision of the Designated Manager is reviewable by the Administrative Appeals Tribunal under section 224(1)(b) of the *Patents Act 1990*.

2. EMPLOYMENT EXPERIENCE

A person must have been employed in a position, or positions, that provide experience in the following skills:

- (i) searching of patent records;
- (ii) preparing, filing, and prosecuting of patent applications in Australia;
- (iii) preparing, filing, and prosecuting of patent applications in other countries and organisations, particularly countries and organisations that are regarded as major trading partners with Australia;
- (iv) drafting patent specifications; and
- (v) providing advice on the interpretation, validity and infringement of patents.

It is expected that the experience would also include exposure to, or involvement in, opposition procedures, as well as a general understanding of the management of an IP portfolio and the management of a patent attorney practice.

2.1 Patent searching

Patent attorney work includes searching patent office databases and other intellectual property information services for various purposes, including ascertaining status information on patent cases, obtaining an indication whether an invention is novel, or identifying whether the use of a product or process (for example) is infringing some other patent right.

A person seeking registration as a patent attorney must have skills in searching databases for bibliographic data on patent cases, conducting novelty searches and infringement searches, and analysing and advising on the outcomes of such searches.

It is expected that a person seeking registration as a patent attorney would have had direct experience in performing such activities, preferably under the supervision of a patent attorney.

2.2 Preparing, filing, and prosecuting applications

Preparing, filing and prosecuting patent applications in Australia and in other countries and organisations, particularly countries and organisations that are regarded as major trading parties with Australia, demands a high level of professional competence which can only be acquired through exposure to such activities under the supervision of a patent attorney. This is particularly so in relation to prosecution of patent applications, which requires an in-depth knowledge of the practices and procedures of the relevant jurisdiction.

It is expected that a person seeking registration as a patent attorney would have had direct experience in performing patent attorney work involving:

- preparing and filing provisional and complete applications in Australia;
- preparing and filing international applications under the Patent Cooperation Treaty;
- instructing agents with respect to the filing of patent applications in other jurisdictions (including in particular Europe, Japan and the USA); and
- attending to the filing of patent applications in New Zealand, either by filing there directly or by instructing agents in New Zealand.

Further, it is expected that a person seeking registration as a patent attorney would have had direct experience in performing patent attorney work involving:

- prosecuting complete patent applications in Australia;
- instructing agents in respect of prosecution of patent applications in other jurisdictions;
- prosecuting international applications under the Patent Cooperation Treaty through the international phase; and
- interpreting and amending the claims of a patent specification according to the laws and practices of Australia and other jurisdictions

2.3 Experience in drafting patent specifications

gives A patent attorney an exclusive right to prepare patent specifications and amendments to patent specifications³.

Drafting patent specifications is a skill that requires informed technical communication with inventors or their representatives, and an in-depth knowledge of requirements in the relevant jurisdiction. As such, drafting patent specifications is a skill which requires development under the supervision of a patent attorney in an environment where there is exposure to inventors or their representatives and also the demands of real-time drafting.

It is expected that a person seeking registration as a patent attorney would have had direct experience in performing patent attorney work involving:

- conferring with clients in relation to inventions for which patent specifications are to be drafted (including taking instructions in relation to details of the inventions and any known prior art);
- drafting provisional and complete specifications for Australia and New Zealand with a scope and set of claims that satisfactorily protects a client's interests in the invention described in the patent specification; and
- drafting specifications for international applications under the Patent Cooperation Treaty, and for patent applications in other jurisdictions, with a scope and set of claims that satisfactorily protects a client's interests in the invention described in the patent specification.

2.4 Advising on the interpretation, validity and infringement of patents

Giving advice about the validity, or infringement, of patents is a highly skilled role that demands informed communication between a client (or other party requiring advice) and the patent attorney in order to prepare and provide legal opinions. As such, provision of such advice requires experience in an environment where there is exposure to clients (or other parties requiring advice) and their needs.

A person seeking registration as a patent attorney must have experience in advising on the interpretation, validity and infringement of Australian patents acquired through exposure to such activities under the supervision of a patent attorney.

³ Sub-sections 201 (1), 201 (7)(b), section 202 *Patents Act 1990*,

It is expected that a person seeking registration as a patent attorney would have had direct experience in performing patent attorney work involving:

- considering Australian patents and prior art material deemed to be relevant to the patents, and providing opinions as to the validity or otherwise of the patents; and
- considering Australian patents and alleged or potential infringements thereof, and providing opinions in relation to the issue of infringement.

The opinions need to have exhibited a sound understanding of the principles of claim interpretation, construction and validity under Australian law.

3. ACQUISITION OF THE EXPERIENCE

It is expected that the experience would be at a level corresponding to that which would ordinarily be acquired through the performance of patent attorney work in Australia for a period of at least two years under the supervision of a patent attorney registered in Australia.

In some circumstances, experience may be acquired through patent attorney work in other jurisdictions; for example, through performance of patent attorney work under the supervision of a patent attorney registered in another jurisdiction.

The experience may, in certain circumstances, be achieved, either wholly or in part, through relevant work in other areas within the field of intellectual property. For example, a person may acquire some experience through work as a patent examiner, involving patent searching and interpretation of patent specifications. Further, a person may acquire some experience, either wholly or in part, through patent attorney work in jurisdictions other than Australia, or possibly whilst working in a corporate environment.

4. STATEMENT OF SKILL

A **statement of skill** is a statement by a registered patent attorney who has been registered for at least 5 years that, in the opinion of that registered patent attorney, the person concerned has experience in one or more of the necessary skills. There may be several statements of skill issued by different registered patent attorneys which together cover all of the prescribed skills.

The statement of skill must:

- (a) contain details of the basis of the opinion that the person concerned has the required experience; and
- (b) include details of the evidence on which the opinion is based;

The statement of skill must refer to the specific skills covered by the statement and also the period of employment.

The statement must be on a form approved by the Board and executed as a statutory declaration.

If the person concerned is unable to obtain a statement of skill from a patent attorney, the Board may, upon request, prepare a statement of skill in relation to the person concerned.

4.1 Statement of Skill by a Registered Patent Attorney

It is anticipated that this would be the procedure more commonly followed by persons seeking registration as a patent attorney. Indeed, it is necessary for a person seeking registration to follow this procedure unless there are circumstances precluding its use.

The statement must be made by a patent attorney who has been registered in Australia for at least 5 years and who is in a position to comment on the person's skills.

It should be noted that "registered patent attorney" is a term defined in the *Patents Act 1990*. As such, the term "registered patent attorney" means a person registered as a patent attorney in Australia.

The assessment should comprise a statement from the registered patent attorney:

- (a) explaining the duration and the nature of the employment;
- (b) describing the type of work performed in order to acquire the required experience;
- (c) explaining how the registered patent attorney making the statement came to the decision that the person possesses the required experience; and
- (d) explaining why the registered patent attorney making the statement is in a position to comment on the experience of the person concerned.

Typically, the statement would be made by a registered patent attorney who has supervised the work of the person concerned during the relevant period of employment. Where the supervision has been provided by two or more registered patent attorneys over the relevant period of employment, any one of the registered patent attorneys may provide the statement of skill, provided that he or she is in a position to do so. Alternatively, there may be several statements of skill, each provided by a different registered patent attorney and directed to different aspects of the experience.

Where the registered patent attorney providing the statement of skill has not supervised the person concerned to an extent to be able to comment on all aspects of the experience, that registered patent attorney may consult with another patent attorney who has provided the necessary supervision, in order to be in a position to comment on the experience overall. Alternatively, or additionally, the registered patent attorney providing the statement of skill may inspect examples of work produced by the person seeking registration in order to be in a position to comment on the experience.

A statement of skill from a registered patent attorney who merely knows the person will not be suitable; **the statement of skill must be by a registered patent attorney who has either supervised the work being assessed or is otherwise in a position to provide the statement.**

The Designated Manager must be satisfied that a registered patent attorney providing the statement of skill is in a position to comment on the experience of the person concerned.

Several examples involving consideration of requests for registration supported by statements of skill from registered patent attorneys are provided in Appendix A.

4.2 Statement of Skill prepared by the Board

There may be circumstances where a person is unable to meet the requirement for a statement of skill by a registered patent attorney who has been registered for at least 5 years but nevertheless has acquired the required experience.

In such circumstances, the person may apply to the Board for a statement of skill. In applying for the statement of skill, the person must provide a statement (in the form of a statutory declaration) which:

- (i) explains why the person is unable to meet the requirement for a statement of skill by a registered patent attorney who has been registered for at least 5 years;
- (ii) identifies the duration and nature of the experience;

(iii) describes activities undertaken involving practical application of the various aspects of the required experience; and demonstrates that the experience is sufficient to provide the required level of experience.

In relation to item (iii), it is expected that the statutory declaration would be accompanied by material supporting the assertion that the required experience has been acquired. The supporting material may, for instance, comprise a portfolio of work performed, subject of course to confidentiality and privilege constraints.

Additionally, the person may be required to confer with one or more members of the Board to demonstrate to the satisfaction of the Board that the required experience has been acquired.

If the Board is satisfied that the level of experience is sufficient, it may issue a statement of skill in relation to the person concerned..

Several examples involving consideration of requests for statements of skill prepared by the Board are provided in Appendix B.

Contact Details:

For further information please refer to the PSB web-site or contact the Secretary, PSB at

Tele: (02) 6283 2345,

Email: mail.psb@ipaaustralia.gov.au

P O Box 200

WODEN ACT 2606

APPENDIX A

Statement of Skill by a Registered Patent Attorney

This procedure requires an assessment of the experience of the person seeking registration by a patent attorney who has been a registered patent attorney for at least 5 years and who is in a position to comment on the person's experience.

It is expected that the required experience would ordinarily be acquired through the performance of patent attorney work in Australia under the supervision of a registered patent attorney for a period of at least two years.

However, the focus of the process is on acquisition of the required experience rather than the time served. Accordingly, in some instances, a person may take longer than two years to acquire the prescribed skills. This is for the registered patent attorney to assess, based on the performance of the person concerned.

Experience as a Patent Examiner

One example of relevant work in another area within the field of intellectual property may be work as a patent examiner, through which experience in patent searching and interpretation of patent specifications may have been acquired, possibly over a period of less than two years. In such a case, the person concerned may acquire the remaining experience through employment involving performance of patent attorney work under the supervision of a registered patent attorney. That period of employment again need not necessarily have been two years. However, the cumulative experience must equate to at least 2 continuous years or a total of 2 years within 5 continuous years.

Experience Outside of Australia

A further example of relevant work in another area within the field of intellectual property may be through patent attorney work in another jurisdiction. A person who is a patent attorney in another jurisdiction (particularly a common law jurisdiction) may have certain aspects of the required experience. In such a case, the person concerned may be able to demonstrate the required level of experience during employment under the supervision of an Australian registered patent attorney. This is for the supervising registered patent attorney to assess, based on the performance of the person concerned.

Combination of Employment Experiences

A somewhat related example involving work experience in a jurisdiction other than Australia may involve a person who has acquired some, but not all, of the aspects of the required experience through work as a patent attorney or trainee patent attorney in that jurisdiction. In such a case, the person concerned may acquire the remaining aspects of the required experience in Australia through a period of employment involving performance of patent attorney work under the supervision of a registered patent attorney.

Experience in a Corporate Environment

Some Australian organisations employ staff for the specific purpose of liaising with the organisation's external patent attorneys. Sometimes this requires those employees to conduct patent attorney work, often under direct or indirect supervision by those external patent attorneys. In conducting patent attorney work in this situation, the employee may accrue experience in at least some of the aspects, and the external patent attorney may feel able to attest to the employee having that experience.

In each case, the registered patent attorney making the assessment will need to explain how the person has acquired the required experience. The registered patent attorney will also need to explain how it is that he or she knows this.

Statement of Skill prepared by the Board

This procedure is available only in circumstances where a person is unable to meet the requirement for a statement of skill by a registered patent attorney who has been registered for at least 5 years but nevertheless has acquired the necessary experience required for practice as a patent attorney.

One such circumstance might be where a person has acquired the required experience through patent attorney work under the supervision of a registered patent attorney, but without exposure to a registered patent attorney who has been registered for more than 5 years and who is in a position to comment on the experience of the person concerned. The person may, for instance, have acquired the experience through patent attorney work under the supervision of a patent attorney who is registered but not for the prescribed period of 5 years.

Another circumstance might be where a person considers that he or she has acquired the required experience but the supervising patent attorney declines (for any reason) to provide a statement of skill

Still another circumstance might be where a person is a patent attorney in another jurisdiction and believes that they have acquired the required experience in that jurisdiction.

In any such circumstance, the person may seek a statement of skill from the Board.

As mentioned above, a request for a statement of skill from the Board must be accompanied by a Statutory Declaration that explains why the person is unable to meet the requirement for a statement of skill by a registered patent attorney who has been registered for at least 5 years.