

PRACTICE NOTE
From the Designated Manager
No 1. 2010

To all registered patent attorneys and those applicants seeking registration as patent attorneys:

Statements of Skill

The Designated Manager is responsible for registering patent (and trade marks) attorneys. The Designated Manager is currently the Director General of IP Australia, Mr Philip Noonan.

The Designated Manager must enter a person's name on the Register of Patent Attorneys if that person satisfies the requirements of section 198 of the *Patents Act 1990*.

One of the conditions relates to employment. Regulation 20.10 of the *Patents Regulations 1990* provides that an applicant must have been employed in a position or positions that provide experience in certain skills. There are a number of skill sets required, including skills such as searching patent records and drafting patent specifications. Regulation 20.10(1) (a) prescribes the particular skills required.

An Applicant for registration as a patent attorney must include with their application one or more statements of skill in support of their application. This is a relatively new requirement and there has been some inconsistency in the statements of skill which have been put forward in support of recent applications. Some statements do not provide enough evidence on which the Designated Manager can be satisfied that the applicant has the required skills.

This Practice Note seeks to provide some guidance on what is required in a statement of skill.

Required skills (see. Reg 20.10 (1) (a))

- (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.

The applicant must also have been employed in a position, or positions, of a kind that provided the applicant with experience in these skills for at least two continuous years or a total of two years within five continuous years (see Reg. 20 10 (1)(b)).

Regulation 20.10 also provides examples of major trading partners for sub-paragraph (a) (iii).

Sometimes, no one registered patent attorney will be able to testify as to all five sets of the skills. In this case, the applicant will have to bring forward more than one statement of skill from appropriate registered attorneys (see regulation 20.10(2)).

Levels of details required

Regulation 20.11(2) is crucial in considering the level of detail which should be in the statement of skill. It provides that the statement of skill must:

- (a) contain details of the basis of the opinion that the applicant has the required experience and
- (b) include details of the evidence on which the opinion is based, described by reference to:
- (c) the skills mentioned in paragraph 20.10 (1) , and
- (d) the employment requirements mentioned in paragraph 20.10 (1) (b).

It can be seen that what a statement of skill must do is not just assert the possession of the relevant skills but also contain details of the basis of that opinion and details of the evidence on which the opinion is based.

Accordingly, statements of skill which are expressed in very general terms about the types of experience the applicant has acquired will not usually suffice. Some detail is required.

It is not possible to specify any particular type of information which would always be necessary and sufficient. However, some points of guidance can be provided:

- Evidence of the number of matters can be significant. Statements of skill about providing advice on interpretation, for instance, would be more impressive if they referred to a large number of matters which had involved the provision of such advice. A statement of skill that could be read as referring to one or two instances of providing advice, over a two year period, will not easily satisfy the Designated Manager that the requisite level of skill has been attained.
- One important factor which can be useful in some cases is the size of practice. If an attorney has primary responsibility for a large number of files within the office, and these files relate to a broad range of applications that the attorney has responsibility for prosecuting, this would go a long way towards demonstrating that the requisite level of skills in that area was present.
- Some statements of skill have made effective use of anecdotes by describing particular matters that were complex or difficult or where the applicant took a strong lead in a manner that would indicate strong skills as a registered patent attorney. These can add flavour to the statement of skill and contribute to an overall impression of an applicant who is ready to be admitted to the profession.
- The statement of skill is perhaps best thought of as a submission to the Designated Manager, which is intended to convince the Designated Manager that the particular application is worthy (in a skills sense) of admission to the profession.

Because it is not possible in a guidance note such as this to deal with every possible situation, applicants may choose to discuss the matter with the Secretary to the Professional Standards Board for Patent and Trade Marks Attorneys before submitting their application. The responsibility to satisfy the Designated Manager as to the statutory requirements is on the applicant and the Secretary will be unable to offer more than general advice about how particular issues might be approached in the statement of skill. Nevertheless, some applicants might find this helpful in avoiding unnecessary reworking of their application to bring it into line with the statutory requirements.

Philip Noonan
Designated Manager

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