

## POSITION DESCRIPTION

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**POSITION TITLE:** Senior Associate Patent Attorney

**HOURS OF WORK:** Permanent, Full-Time

**REPORTS TO:** Executive, Patent Team

**DIVISION:** Patent Prosecution

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### 1. Position Objective

- 1.1 Reporting to the Executive, Patent Team, the Patent Attorney/Lawyer is responsible for providing patent legal services and advice to Pearce IP's clients across the life sciences industries with a particular focus on Global Freedom to Operate (FTO) review and advice, patent prosecution and advice, patent strategy and litigation support.

### 2. Key Responsibilities

- 2.1 Providing legally sound, independent and practically appropriate patent attorney services to Pearce IP's clients taking account of alternative approaches and solutions;
- 2.2 Timely provision of services, as measured by response within client deadlines, or in managing client's expectations;
- 2.3 Advising clients in relation to patent prosecution, particularly before the Australian and New Zealand Patent Offices, but also in relation to foreign prosecution;
- 2.4 Providing sound and considered Global FTO patent review and advice;
- 2.5 Providing external in-house counsel legal/patent services for clients as required;
- 2.6 Proactively identifying patent and legal risks and opportunities for clients, and suggesting solutions;
- 2.7 Identifying times when it may be necessary to refer matters to other legal advisors, or where Pearce IP may sub-contract matters to other advisors, on the basis of lack of capacity, expertise or jurisdictional qualifications;
- 2.8 Contribute to the development of systems and processes to manage the Pearce IP practice;
- 2.9 Identify potential clients and suggest and implement strategies for targeting clients and enhancing Pearce IP's public-facing communications (such as Pearce IP's website);
- 2.10 Assist with generating new business for Pearce IP by identifying and assisting with marketing to potential new clients in Australia and overseas;
- 2.11 Identify, report and manage risks across all areas of responsibility including the identification of emergent risks as they become apparent;

- 2.12 Establish and foster solid working relationships with members of the Patent Prosecution and Executive team;
- 2.13 Attend and actively participate in team, client and company meetings as required;
- 2.14 Adhere to the Staff Code of Conduct and Values, ensuring professional conduct and confidentiality is always maintained;
- 2.15 Ensure compliance with Pearce IP's Policies, Procedures, Systems and Processes;
- 2.16 Participate in, and promote a team environment based on supportiveness, development, sharing and effective communication;
- 2.17 Convey a positive and professional image of Pearce IP and its services;
- 2.18 Actively participate in the performance planning and development program, including the development of personal training and career development plans;
- 2.19 Provide a highly professional, responsive and customer oriented approach at all times;
- 2.20 Produce reports, documents and statistics in accordance with established standards and systems, as required and directed;
- 2.21 Undertake other relevant duties as directed, consistent with the employee's skill, competence and training.

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### **3 Key Selection Criteria**

- 3.1 Experience in prosecuting patents before the Australian and New Zealand Patent Offices;
- 3.2 Experience in advising clients in relation to patent prosecution before the patent offices of foreign jurisdictions, such as the United States Patent and Trademark Office and the European Patent Office;
- 3.3 Experience in providing commercially focused patent advice, including strategic and FTO advice;
- 3.4 Experience with patent invalidation procedures such as opposition, re-examination and revocation, and preferably experience with pre-litigation dispute resolution;
- 3.5 Well developed analytical, problem solving and decision-making abilities;
- 3.6 Proficiency in Office 365;
- 3.7 Confidence in direct client communications and ability to present and 'pitch' to potential clients;
- 3.8 Experience in building and executing patent search strategies, including building FTO search strategies, interpreting FTO reports, searching patent office databases, and patent landscape analyses.

### **4 Qualifications and Experience**

- 4.1 Science Degree/PhD (life sciences)
- 4.2 Qualified Patent Attorney – Trans-Tasman
- 4.3 Qualified Lawyer preferred