

## POSITION DESCRIPTION

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<b>POSITION TITLE:</b>	Senior Associate / Special Counsel Trade Mark Attorney/Lawyer
<b>HOURS OF WORK:</b>	Permanent, Part-Time (3 days per week), Work From Anywhere
<b>REPORTS TO:</b>	Chief Executive Officer
<b>DIVISION:</b>	Trade Marks

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### 1. Position Objective

- 1.1 Reporting to the Chief Executive Officer, the Special Counsel Trade Mark Attorney/Lawyer is responsible for leading the trade marks team, providing Pearce IP clients with strategic and effective branding strategies, drafting and prosecuting trade mark applications, and managing contentious disputes.
- 1.2 The role is a leadership role, where you will grow the Trade Marks business and team, with the support of Pearce IP executives.

### 2. Key Responsibilities

- 2.1 Provide legally sound, independent, and commercially appropriate trade mark services to Pearce IP's clients;
- 2.2 Timely provision of services, as measured by response within client deadlines, or in managing client's expectations;
- 2.3 Represent Pearce IP's clients before the trade marks office of IP Australia and IPONZ, and work with agents overseas to build and implement effective branding strategies for Pearce IP's clients.
- 2.4 Advise on infringement of registered and unregistered trade marks and the Australian Consumer Law;
- 2.5 Manage trade mark office actions in Australia and New Zealand, including all aspects of contentious office actions;
- 2.6 Manage, or assist with the management of trade mark enforcement/infringement proceedings;
- 2.7 Assist with the commercialisation of trade marks across multiple jurisdictions, including advising in relation to commercial terms, and drafting licenses and assignments;

- 2.8 Proactively identify risks and opportunities for Pearce IP trade mark clients, suggest and implement solutions;
- 2.9 Identify potential clients and suggest and implement strategies for targeting them;
- 2.10 Assist with generating new business for Pearce IP by finding new leads, and implementing effective business development activities to turn those leads into clients.
- 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 Legal teams and members of the Pearce IP Executive;
- 2.13 Attend and actively participate in team, client and company meetings as required;
- 2.14 Adhere to the Staff Code of Conduct and Vision/Mission/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 at all times;
- 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.

### **3. Key Selection Criteria**

- 3.1 Hard working and self driven senior trade mark attorney (ideally, who is also a lawyer) with the desire to grow a team and a practice focussed on advice, prosecution, and enforcement.
- 3.2 Experience in building and implementing trade mark common law and register searches around the world;
- 3.3 Experience in brand protection and enforcement strategies for ANZ;
- 3.4 Experience in advising clients in relation to obtaining trade marks protection in ANZ and in key overseas jurisdictions, including pursuant to the Madrid Protocol;
- 3.5 Experience in providing commercially focused trade mark advice, including strategic advice;

- 3.4 Experience with trade mark invalidation procedures, and preferably experience with pre-litigation advice and litigation;
- 3.5 Well developed analytical, problem solving and decision-making abilities;
- 3.6 Confidence in direct client communications and ability to present and 'pitch' to potential new clients;
- 3.8 Proficiency in Office 365.

#### **4. Qualifications and Experience**

- 4.1 Registered Trade Mark Attorney (and preferably, also a Lawyer) with 8+ years post registration experience.
- 4.2 Qualifications in law
- 4.3 Qualifications to practice as a Solicitor in Australia;