POSITION DESCRIPTION

POSITION TITLE: Patent Attorney

HOURS OF WORK: Permanent, Full-Time

REPORTS TO: Special Counsel Patent Attorney

DIVISION: Patent Prosecution

1. Position Objective

1.1 Reporting to the Special Counsel, Patent Attorney, the Patent Attorney is responsible for providing patent legal services and advice to Pearce IP's clients across the life sciences industries with a particular focus on 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 and a low incidence of reminders;

2.3 Advising clients in relation to patent prosecution before the Australian and New Zealand Patent Offices;

2.4 Global Freedom to Operate 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 online systems 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 assist 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.

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 advice;

3.4 Experience in pre-litigation dispute resolution and patent office procedures;

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.

4 Qualifications and Experience

4.1 Science Degree (life sciences)

4.2 Qualified Patent Attorney – AU, Trans-Tasman, EU, US