



## STAFFING AN IP PRACTICE

### A PRACTICE PERSPECTIVE FROM EUROPE

Under the present topic – staffing an IP practice – we will deal with questions of appropriate staffing levels and skills, maintenance and control of our mountain of paper, the role of paralegals, how many secretaries are needed for a professional, help of new technologies and other aspects.

My presentation will focus on a practice perspective from a European viewpoint, concentrating on the assistants' day to day business but also including more general reflections.

During this exercise you will easily recognize the benefits of this overview for your own work and office tasks, whilst ample time for discussion afterwards will give you the opportunity to additionally formulate specific questions flowing herefrom.

First of all, it should be paid attention to the fact that the job description of a secretary has dramatically changed in recent years, not only in our profession but also generally. Where the secretary in former times was the right hand to her – mostly one and only – boss, she rarely would have worked autonomously but depended on concrete directives and instructions of her boss, regularly as a mere typist.

Today, your right hand will probably be an assistant with her own and independent responsibilities – so as to be able to keep as much as possible of your valuable working time free for your special field of business.

Nowadays, your assistant's work can be summarized inter alia under terms like multi tasking, teamwork, whilst another difference could be that she may not have one boss but is working for two or three or more.

Accordingly, flexibility, organizational skills, capacity and commitment are requirements besides her perfection in traditional secretary work, like typing, handling of files, keeping archives, administration and so forth – sufficient computer knowledge is taken for granted. Additionally, in the international business of patent attorneys, she will need at least English as a second language if not also a third one besides her mother tongue.

In our field of IP, this assistant is likely to be what could be called a semi–paralegal: knowledgeable at least in the basics of the files her boss is dealing with, be it patents, trademarks, other protective rights or court proceedings, but in any case administratively capable on the specialized field of the partner or partners she works for – in addition to her skills as mentioned before. Likewise, time management and a certain amount of travel management will form part of her day to day work.

Furthermore, you will most probably have paralegals in your offices; for them, a good qualification such as an university degree in law/business management/language often is a basic requirement. Usually, they work autonomously on files of a certain field or range of IP, with only little or no guidance from the attorney, and generally excluding secretarial tasks. Especially on the trademarks and design field you will find well trained independently working paralegals. However, commonly paralegals are supervised in the sense that the patent attorneys only sign correspondence, petitions and the like, due to liability and/or insurance prerequisites. Exceptions therefrom may be standardized automatic confirmation letters or short forwarding messages.

Additionally to paralegals in that principle sense, there exists in Germany the profession of the patent attorney's assistant. It comprises a three-years-training, an apprenticeship, with a German patent attorney's office before being admitted to pass the corresponding qualification examination at the German Chamber of Patent Attorneys. Whilst it is an administrative profession contrary to e.g. a technical paralegal skilled for example in mechanics or chemics and trained for corresponding work in patent files, this profession often includes high responsibilities up to leading certain departments. On the homepage of the German Chamber of Patent Attorneys you will find more detailed information in this connection ([www.patentanwalt.de](http://www.patentanwalt.de)).

As far as I could investigate, there does not exist a similar qualified assistant's profession in other European countries but only training on the job. However, news from Sweden are that the Swedish FICPI group and its sister organization SIPF, organizing the industrial agents, have just recently formed the Swedish IP Academy. One of its tasks is to create a paralegal programme for assistants both on the patent and the trademark field besides of course training for patent as well as trademark attorneys. Nevertheless, official recognition from the government is envisaged to take years.

However, in most of the European countries, especially for example UK, France, Spain or Italy, there are regular seminars or training sessions of the patent attorney's chambers or similar organizations or at the Patent Offices, which aim to supplement the training on the job. Additionally, there are private seminar organizers especially in the UK and Germany with a variety of courses in the field of IP, some of them being particularly created for paralegals or assistants. It is important that these facilities are used to give these assistants and paralegals a broader overview than it is possible within the confines of one specific office.

To the aforesaid group of employees – secretaries, assistants, paralegals – you may add another group, namely typists, who are nowadays often concentrated in a writing pool either in the office or also external and working from home. Furthermore, there may be inhouse or outhouse translators.

Of course, depending on the size of a patent attorney's office, you will find these different categories compared to a mixture in a few persons only, as well as separate departments. Naturally, the bigger an office is, the more departments you will have, and the need for qualified and trained employees.

A curious fact can be reported from the experience of a greater number of patent attorney's offices in Europe: in our profession, you will find a majority of employees who passionately enjoy their work. Quite understandable given the tremendous variety of the IP field, which makes it incredibly interesting and challenging. Interestingly too: this dedication usually happens already in the trial time; if not, these employees on trial would mostly leave.

Resulting therefrom, we can speak of a relatively high percentage of interested and committed employees, and in the average – compared to other branches – a rather high amount of long-term and loyal employees with less fluctuation. However, we may envisage a change in the latter fact in the future: generally, people in Europe become more and more mobile. Accordingly, there may be less long-term employees, but on the other hand we may benefit from more already trained professionals with broader experience by having worked in more than one European country.

It seems evident that the better trained your employees are, the easier it will be not only to maintain and control of the mountain of paper, but also to assist in the successful and smooth running of your office – even in your absence for business travels –, and thus you will be able to increase the amount of work your office can handle – of course not forgetting that the IP profession is characterized by meeting with all kinds of deadlines and terms and the necessity of high security standards in order to avoid the worst-case-scenario: the loss of a valuable protective right of a client.

It is quite clear that the corresponding organization and administration depends on the size and the structure, but also on the philosophies of a patent attorneys office and its partners. Whilst there exists a variety of solutions, of course, it is interesting that in my research discussions I found a majority of similarities confirmed, at least as long as the size did not differ too much. Consequently, certain settings seem to become obvious according to our practice.

For example, in an office with about 5 – 10 patent attorneys (regularly all partners), there would be an average number of 25 to 50 or 60 employees. There will be a term supervision department – high security measures strictly observed. Also, you would find a filing department, which could be split into subgroups for national and foreign filings. Annuity payments will probably also be handled in a separate division. Maybe, there is a separate trademarks department, which then often comprises the handling of designs. Not to forget about the writing pool and also inhouse or outhouse translators. Except for the usually separate accounting and IT personnel, the aforesaid departments are lead by one or two well trained paralegals or assistants and being supervised by one of the partners. As for them, we can say that the more partners there are, the more specialized they will be besides of their technical fields. Depending on their portfolio, they will additionally have an assistant or a secretary.

In larger offices, the situation and necessary structures change of course. A common main difference for example often is that there would be a more or less fixed number of partners, whilst additionally there will be a certain number of employed patent and/or trademark attorneys plus a lot more staff members. Likewise, there would either be more different departments or naturally departments of bigger size, maybe with more special subdivisions.

To safeguard and guarantee the well functioning of an office like in the example above, we face to apply general internal directives and clear instructions, be it for the use of our tariffs, the handling of files, or competences and charges of the different members of the firm – for efficiency and security reasons.

Additionally, it seems essential if not necessary – in larger offices for sure – to reserve a certain amount of time for internal communication, be it via e-mail for information purposes, or regular meetings of the partners or internal general meetings and discussions, dealing for example with necessary adaptations in working processes resulting from changes in the different IP laws or computer technology.

Furthermore, we have to put effort and time into training for reaching appropriate staffing levels and skills – not to forget recognition of your employees' talents, e.g. languages or figures, being good in organization or management. From a number of respective feedbacks and by experience, I would say that the most efficient and best type of training possible in the IP practice is learning from the files we work on and from the different persons we work with. Supplementing training courses inhouse or outside for your paralegals and assistants should be envisaged and granted at least from time to time.

Doubtlessly, we are touching here the question of time and money. Lets say the training of a paralegal for example on trademarks takes around a year until she will be able to work independently or a considerable amount of time for a so-called semi-paralegal until sufficiently knowledge on your specializ-ed files is gained – that is already a vital form of investment. Clearly, the more one invests, the more one is interested to keep these qualified employees. Naturally both sides know thereabout, but neither one wishes to be pressed in any uncomfortable way.

From my personal practice as well as from views I collected from some col-leagues in different offices in Europe, I believe that one good possibility is to fix clear competences, to assign different fields of responsibilities within one department to different paralegals, and/or – if possible, also here depending on the size of the portfolio – to apportion clients to specific persons. With that, you may enhance the feeling of being accepted and to perform a valuable contribution with ones work, which is an important aspect for most of us.

A self-evident guarantee for a fruitful and long-standing employment or partnership is a good working atmosphere, considerable respect, reasonable conditions and appropriate equipment as well as transparency of the working processes resulting in understanding in your teams. The advantage of a majority of employees passionately enjoying their work could well be their real attraction for their job – consequently accepting even a bit more inconveniences than on another assignment. However, certainly there exist limits. In some European countries, another advantage can be seen in the relatively little number of patent attorneys, where one would not easily change from office to office.

Additionally, I believe that there is one further factor for a really successful and long-standing working relationship namely chemics in the sense of sympathy. Within a group of several FICPI assistants colleagues, this is said to be “the best boss of the world syndrome”. Naturally, we don't agree here, since each of us found her best one.

As a recent survey shows, carried out amongst 380 secretaries and assistants in Germany, Austria and Switzerland, the impressive figure of 82 % would not leave their dream boss just because of the money or due to prolonged daily travelling time; 6 % said yes, and 10 % were ambivalent – but both groups referring to past experiences where the management was changed; the rest remained without answer.

You can see that motivation and engagement and loyalty is not a result of monetary considerations only.

Consequently, a recommendable measure is to put well effort and time into : job applications in order to find matching employees, either for a two–persons–team or a department with several members, and also into building and keeping these relationships. It may take a while and even several trials, but standing from the crowd in this sense the more successful you will be.

Naturally this has a certain impact on our daily business: the more we like what we do and with whom we work, the more motivated we are, and will much easier cope with our duties including a higher “volume” than usual.

However, imperative needs are clear profiles, defined expectations and responsibilities (for both sides), quite importantly: constant exchange of information (vice versa), functioning equipment, transparent working processes and an agreement on priorities.

In all that, new technologies help us. We benefit from say standardized and possibly computerized routine steps in our file work, we use database information for more efficient handling of our files, we may use speech recognition tools, electronic filing is (or will be) a matter of course, e–mail keeps us in more direct contact with our clients, eventually there was no life before Google, and laptop with mobile phone allow us to work even on the beach, guaranteeing also a much easier, say lighter, travelling and for example direct working for meetings like FICPI helds. You may directly access documents, like employees may work from home under such a system; however, due to a more limited flow of information compared to being in the office, such remote work would be an option for e.g. translators, typists or accountants but probably not for your right hand. Of course, this list can be continued. Advantageous achievements on the one hand.

On the other hand, however, we face a significant increase in the pressure of our day–to–day work. Especially e–mail communication and correspondence with electronic files tempt its users to wait until the very last minute. Consequently, we are often so flooded or under such time constraints that we can't avoid the last–minute–run – a result of part of these new technologies combined with a profession characterized by meeting all kinds of deadlines and terms.

Accordingly, time management becomes more and more important. It seems essential to create a general structure of your working day, especially with sufficient buffer time allowing you to remain flexible for changing priorities and meet with your clients' expectations, which is – as I think – our daily practice.

Also, there should be at least one or two fixed time windows for communication and exchange of information with your assistant – and keep these appointments. For being able to relieve your obligations, she should be fully informed of your working schedule and tasks, especially any changes, so as to be able to plan and adapt and monitor your calendar. Meanwhile the necessary document management of electronic files as well as providing the respective files for you should be put in her charge without saying.

From all that it becomes quite obvious how complex the interaction in a patent attorney's office is, dealing with procedures and paperwork under high security standards and time pressure – qualification and training of your employees being imperative such as lifelong learning is generally for our working lives.

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