



A week in the life (of an in-house patent attorney)

With apologies to Samuel Pepys and Helen Fielding, the extract below is fictional and intended to capture the variety and challenge of life working as part of an in-house IP department.

Monday

Early start today – I'm meeting with a project team to discuss their latest developments. We filed a priority patent application last year and are now reviewing recently generated data to determine claim scope before foreign filing. We spend a fascinating couple of hours digging into the results and technology, it's a highly competitive area so I think there may be filings from third parties, we need to be careful to maintain priority and I draw some timelines for the project team to try to explain why that matters. The project team also has some creative thoughts around names for the technology.

Spend the afternoon drafting my new claim set and sending to the project team as well as setting up a call for next week between them and our trade mark attorney to discuss the naming. I start thinking about a presentation I'm doing for the tech department next week on "IP basics", this morning's discussion really helped set out where there may be gaps in understanding the nuances of patent law and why it's relevant to their work.

Unusually for a Monday I'm out this evening at a local IP networking event. We don't have as many events as London based firms, so it's important to make local connections wherever possible. We often get in external speakers who are specialist in a particular area of law to help upskill our internal attorneys and this is a great way to meet them.

Tuesday

I bump into Bob in the coffee queue – he's super excited about a presentation he's giving later this week. He looks a bit sheepish when I ask if he's cleared it with a patent attorney – I promise to look at it today if he sends to me asap. Spend the rest of the morning reviewing the slide deck and prepping a quick draft to put on file before Thursday. Speak to Bob about scope and we discuss what he can (and can't!) say in the Q&A section. He's travelling to the conference tomorrow, so we agree to meet up next week to review the work in more detail and file a follow up priority case and discuss terms for a watching search.

Departmental meeting this afternoon on case law developments in our area – great discussion on how a recent UK court of appeal judgement could impact the way we prosecute our cases. We discuss data that we could ask the scientists to generate to help. My boss is going to talk to the head of R&D about adding extra arms to some of their standard experiments – the additional results will really add support to our claims. We have a great relationship with the technical side of the company, it's important to understand the business direction and objectives when developing IP strategy. This works both ways too – we spend time educating our senior leaders about IP and why it's relevant.

Wednesday

A prosecution day today! One of my key cases recently entered national phase and it's handled externally so I've got office action draft responses from outside counsel to review for about ten different countries. It's interesting to see how similar law can be applied so differently between for example China, India, Brazil and Europe. I have an overall strategy for the case but need to really tailor my claims for local requirements, making sure I don't lose sight of the critical scope we need in each country. Luckily our outside counsel uses local agents who are super knowledgeable and there's also a lot of experience in various jurisdictions within the department that I can draw on.

Thursday

I have an opposition hearing in a month or so where I am leading the advocacy and I get in to find that we just received some auxiliary requests from the patentee. Spend the morning working through the file and my notes with my opposition buddy, thinking about the amendments and how we can address them. Then this afternoon we both sat down with our internal technical expert to talk about how the amendments (if granted) could be relevant the work that we want to do on a key product. Had to remind her that it's a first instance hearing so we're some time away from a final result, but we're hopeful we'll be successful. (Note to self – remember to contact communications ahead of time to prepare a Q&A in case the media picks up on the hearing.)

Friday

Catch up day today – the corporate and departmental things have been building up a little. I take a couple of compulsory learning modules on “conflicts of interest” and “bribery and corruption” then I review progress against my performance and development objectives as next week is my monthly check in with my manager. It's also my turn to present at the case-law meeting next week so I take a tour through the IP blogs and the recent CIPA journal for interesting cases. Finally, I review my watches for third party publications and grants relevant to the projects I support – spot one that I mark for a potential opposition and set up a discussion with that project team next week.

Off to the pub!

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