

The Patent Information Professional: The AIDB Proposal for a European Certification

1. INTRODUCTION

1.1 Aim of the document

1.1.1 This document presents a project that has been developed by the Italian Patent Information Users Group (AIDB – Associazione Italiana Documentalisti Brevettuali) for the implementation of a European Certification for Patent Information Professionals (the Certification from now on).

1.2 Background

1.2.1 An internal AIDB survey was performed in early 2004, asking what the most relevant aims for the association would be. One of the main issues indicated by respondents was the non-official status of their profession. This situation is considered a major disadvantage in their work place and in the work market in general.

1.2.2 Following this survey, a discussion was started, using the AIDB mailing list, on how to make this job title more recognisable and acknowledged. A general agreement was found on the proposal for establishing a professional Certification, which would be sponsored and/or managed by the AIDB. An official granting procedure would allow:

- the setting of standard skills and knowledge requirements and
- the obtaining of better visibility for their role in companies, patent attorneys firms, patent offices, or any other institutions dedicated to or involving patent information.

1.2.3 A Working Group was created within the AIDB and a first draft of the document, describing the features of this Certification, was prepared, distributed and discussed in autumn-winter 2004. Given that similar initiatives are being discussed in other countries, the initial project was modified into a proposal for a supra-national programme, making this Certification a title that would be recognised on a European level.

1.2.4 The proposal for the Certification was developed by the AIDB Working Group, integrating features from various documents (CERTIDoc and COPS working papers, the WON programme, Motivaction EPO study, etc.). It is a “work-in-progress” and, as such, it is open to contributions from anyone working in this field (patent information professionals, patent attorneys, R&D and IP managers, patent information providers, patent offices, etc.) who is willing to contribute to the establishment and implementation of a professional Certification.

2. STRUCTURING THE CERTIFICATION

2.1 Profiling the profession

2.1.1 A step that is preliminary to the establishment of the Certification development is a general definition of the skills and knowledge that should distinguish a patent information professional, consequently generating a profile of the competences to be evaluated.

2.1.2 These skills and knowledge are summarised in the following four points:

- a) Search and retrieval of scientific and technological information identified in patents, journals or any other source of information in the public domain;
- b) Reporting and analysing the retrieved information, in accordance with the needs and the requests of the different possible counterparts (e.g. patent attorneys, scientists, R&D \ IP \ technology transfer managers);
- c) Management of cost-effective information retrieval, archiving and delivery systems;
- d) Basic knowledge of patent law and related proceedings.

2.2 Basic Certification Elements

2.2.1 On the basis of the profile described above, three main areas of competence have been identified, in which candidates for the Certification (the Candidates, from now on) should be trained and the knowledge of which should be evaluated, in order for them to gain access to the profession:

- A. The Patent System & Patent Information;
- B. Searching Patent and Technology Information;
- C. Analysis, Management and Delivery of the Retrieved Information.

2.2.2 The examination for the Certification (the Examination, from now on) should therefore be modelled on this structure, divided into three modules, each of them associated with a series of skills and knowledge, which should be functionally defined and, once agreed upon, categorised with codes (e.g. A01, A02, etc.).

2.3 Module A: Basic features

2.3.1 This module focuses on the knowledge of:

1. Basic elements of the patent system;
2. Patent information available in the public domain.

A list of basic skills and knowledge for these two categories is provided in Annex I.

2.3.2 This module will neither be addressing the technology-related aspects of the search (treated in Module B, §2.4) nor the detailed technical issues of patent law (e.g. how to draft patent applications or perform actions before patent offices). Within the framework of this module,

the Candidates are required to know how a patent document is structured, the basics of patent systems, what the main events and actions during patent prosecution are and how to search patent databases using non-technical, bibliographical data (inventors' names, filing dates, etc.) in order to identify the relevant patent information and get the patent copies, file histories and related documentation, including non-patent literature documentation.

2.3.3 The Candidates should develop specific skills for answering effectively to the requesting party, but they should clearly understand the limits of their own roles and where the competences of an officially acknowledged legal professional (such as a European or a National Patent Attorney) are needed. If, for example, the Candidates are required to provide a review of some technology or of the activities of a company, they should be able to identify the relevant patent and technical information, but always indicating that legally relevant questions should be addressed to legal professionals only.

2.4 Module B: Basic features

2.4.1 This module focuses on the knowledge of the “core” searching skills:

1. Understanding and categorising the search objective;
2. Developing and executing an effective search strategy.

A list of basic skills and knowledge for these two categories is provided in Annex II.

2.4.2 This module will address more detailed technical issues in searching patent and technology information, starting from the identification of the aim and extent of the different types of searches and then explaining how to perform them in practice.

2.4.3 The Candidates are provided with a series of examples, covering the main search topics developed by experts, in the field of either chemistry/life sciences or mechanics/electronics (see also §3.4).

2.4.4 The Candidates should not be obliged to achieve a level of scientific knowledge such that they can satisfy a search request in any kind of technology. The aim of this module is to give the Candidates basic guidelines on how to translate scientific / technical problems into searchable concepts and how to streamline the entire search process, in view of the expectations of the requesting party (in terms of completeness, cost-benefit and time considerations), as well as the available information and searching technology. The Candidates should be capable of developing standard procedures for searching activities, based on guidelines indicated during the training period, but they should also be flexible enough to identify alternative options and working methods, based on their knowledge of database content and structure.

2.5 Module C: Basic features

2.5.1 This module focuses on the knowledge of:

1. Management and analysis of the retrieved information;
2. Reporting and delivering the information to the requesting party.

A list of basic skills and knowledge for these two categories is indicated in Annex III

2.5.2 This module addresses issues related to the organisation of the work for delivering the appropriate information to the requesting party, this being a patent attorney, a scientist, an R&D manager, etc.

2.5.3 The Candidates should be capable of providing the search results in an effective manner, by performing a quantitative and qualitative analysis of the retrieved documentation and understanding which documents and features must be considered relevant in view of the request. Then, the Candidates should be able to choose the most appropriate way of making the relevant information available and usable: a bibliography, a sequence \ chemical structure database, a comparative table, a reasoned review (with any technical, but not legal, recommendations), a regular report for a patent and/or technological survey, a presentation, etc.

2.5.4 In order to achieve sufficient competence in these knowledge\content management skills, some computer skills are of course required, however they should not exceed those required in a normal office environment for generating reporting documents or presentations using standard office applications.

3. IMPLEMENTING THE CERTIFICATION

3.1 The Certification Issuing Authority

3.1.1 A supra-national entity (existing or to be set up for this purpose) would become the Certification Issuing Authority, in charge of all the aspects related to the implementation of the Certification, in particular:

1. The development of the Certification criteria;
2. The training programmes;
3. The evaluation process.

3.1.2 The Issuing Authority forms specific commissions that are responsible for the different aspects of the implementation. National or International entities (such as professional associations, universities or state patent offices) can be appointed by the Issuing Authority for collaborating in these specific projects. In particular, the commissions are responsible for developing the detailed list of skills and knowledge, the training/educational materials and the criteria for each single module. The documents and recommendations provided by the commissions are then approved by the Issuing Authority.

3.1.3 The commission members are chosen by the Issuing Authority, based on their professional competence. These professionals can be directly co-opted by the Issuing Authority, or selected from applications made by single professionals or official candidatures, carried out by international or national entities (including the EPO, EPI, national patent offices, professional associations or commercial providers).

3.1.4 If required by the complexity of the module, sub-commissions can be formed to address specific aspects (e.g. this would be the case for module B, where detailed technical issues are covered). The sub-commissions may eventually co-opt professionals that were not initially appointed by the Issuing Authority in the commission, to collaborate with their activities. The documents and recommendations provided by the sub-commissions will then be submitted to the commission for final approval.

3.1.5 The Issuing Authority promotes the constitution of national or transnational commissions intended to evaluate, train candidates or carry out any other specific tasks in languages other than English.

3.2 Certification Language and Teaching

3.2.1 Given that English is the language that is common to the vast majority of search platforms and technical documentation, the Certification should be established so that the Candidate

evaluation and basic teaching materials are in English, unless a different language is used under the provisions of §3.4.7.

3.2.2 Certification Training Programmes will be acknowledged by the Issuing Authority and provided by private or public institutions. National entities may integrate these programmes by providing documentation and teaching in a different language.

3.3 Certification Eligibility

3.3.1 Similarly to the European Qualifying Examination for patent attorneys, the Candidates should have a secondary school qualification or degree in a technical subject (chemistry, life sciences, physics, engineering, etc.) and specific work experience in the patent department of a company, patent law firm or any other organisation that regularly uses, generates, searches for and/or evaluates information. The latter can be formulated as:

- At least three years' work experience; or
- At least two years' work experience and attendance of a Certification Training Programme.

3.3.2 Professionals working in this field prior to the institution of the Certification and willing to become certified, can apply for the Certification without passing the Examination by providing:

- Proof of at least five years' activity in this field, before the institution of the Certification, and
- The submission of articles or presentations where they demonstrate their knowledge using some (e.g. two-four) case studies, developed on the guidelines given by the Issuing Authority, and possibly made available to the public, in a publication or on a website. These case studies can be presented in the form of an article published in a journal, a presentation, a web page, or any other document made available to the public (or not) in the past. The documents can be provided in English or in a national language accepted by the (supra-)national entity responsible for this evaluation.

3.4 Certification Examination, Delivery and Renewal

3.4.1 The Examination should be developed and carried out in English, directly by the Certification Issuing Authority or by any private or public institution acknowledged by this Authority.

3.4.2 Setting up the Examination is a complex task, given the logistic aspects of organising a test requiring, at least in theory:

- IT support for evaluating searching and computer skills, and
- the availability of full-text documents for evaluating analytical skills

3.4.3. One possibility would be to simply ask Candidates to submit some case studies to the Issuing Authority (see §3.3.2), but this approach may pose a problem in terms of evaluation uniformity and consequently, of credibility. Another possibility would be to avoid the actual analysis of

real full-text documents, that may be too long to read and difficult to retrieve during the Examination (e.g. scientific articles only available as paper documents in libraries). As an alternative, the Examination could be organised in two parts:

- Developing a search strategy based on a request, accompanied by a report and two / three short full-text documents, and generating a list of relevant documents, which are identified by the abstract and indexing information available from Internet free databases and/or commercial providers, to be searched during the Examination.
- Developing a presentation or report based on a request and a limited number of full documents identified by an (imaginary) search.

3.4.4 This Examination should be performed using a computer platform, including basic data \ word processing software and access to pre-selected, Internet-available resources. Certification candidates will be given the option of carrying out the Examination in a technical field of their choice, to be selected from a group comprising at least the following subjects: electronics, mechanics, chemistry, biology.

3.4.5 The Examination should be carried out on a regular basis (e.g. once a year), possibly in a single or few locations where the IT structure can be centralised, and should lead to a pass/fail evaluation and the delivery of a Certificate by the Issuing Authority.

3.4.6 No specific mechanisms of renewal or upgrading need to be put into place. The renewal can be automatically obtained with the enrolment in a European/National professional association acknowledged by the Issuing Authority.

3.4.7 Notwithstanding the provisions of §3.2.1, §3.2.2 and §3.4.1, evaluation, training or other tasks may be carried out in languages other than English if, under request of a national or transnational non-English speaking community, specific commissions using languages other than English are organized. These non-English speaking commissions enjoy the same status of the correspondent, English-speaking international commissions. However, even in case the examination is carried out through non-English speaking commissions, candidates will have to demonstrate a sound working command of the written English language.

4. CONCLUSIONS

- 4.1 This document does not intend to provide an answer to all the complex legal and technical issues associated with the creation of the Certification. The AIDB Working Group expects to receive sufficient support and proposals from non-Italian/Italian patent information professionals, as well as selected institutions, which will be informed or contacted directly over the coming months, in order to improve and continue this project.
- 4.2 If the feed-back on this proposal from non-Italian entities is not sufficient to reach a consensus for the institution of the Certification on a European level, the AIDB is willing to consider the possibility of establishing a similar certification programme on a national level, with the hope that this initiative may facilitate the process of developing similar certification programmes on a supra-national level, when there will be enough international interest and support.

ANNEX I

Module A (the Patent System & Patent Information): Basic Skills and Knowledge

A.1 Basic Elements of the Patent System:

- The rights conferred by the different categories of Intellectual Property (patent, trademark, utility models...).
- The criteria for patentability.
- The structure of a patent document.
- The structure and categories of claims.
- The concepts of patent family and status.
- The basics of PCT, US and EP patent systems (first-to-file Vs first-to-invent, opposition/interference, international/national phases, importance of priority/ publication/fee deadlines, granting proceedings, divisional\CIP applications, etc.).

A.2 Patent Information Available in the Public Domain:

- Structure of institutional databases (USPTO, WIPO, EPO, European national databases) and commercial databases (INPADOC, DERWENT, full-text databases) dedicated to patent information.
- Searching these databases using bibliographic data.
- Retrieval of patent copies, file histories and related documentation, non-patent literature documentation.
- Retrieval of information on post-filing actions related to a patent (prosecution, fee payment, maintenance, nationalisation, opposition, etc.).

ANNEX II

Module B (Searching Patent and Technology Information): Basic Skills and Knowledge

B.1 Understanding and Categorising the Search Objective:

- Identification of the aim of the search and information already available to the requesting party by “challenging” with appropriate questions.
- Types of searches related to patent prosecution (novelty, validity, infringement, state-of-the-art, freedom-to-operate, patent litigation, patent status, etc.).
- Types of searches related to Competitive Intelligence objectives (competitors’ activities, market competition, technology profiling /alerting, regulatory data, official submission to authorities, etc.).
- Types of approaches for a search strategy (keywords, structure, sequence, “cascade” searching through references, patent classification, chronological, etc.).
- Use and importance of patent classification systems (IPC, ECLA, etc.) and of other indexing systems.

B.2 Developing and Executing an Effective Search Strategy:

- Examples of search strategies, competitive intelligence and data mining techniques in the field of chemistry, life sciences, mechanics, and electronics (indicating relevant non-patent/patent databases and online/internet resources and explaining their use).
- Search methods for competitors \ market \ business intelligence (product development, licensing activities, etc.).

ANNEX III

Module C (Analysis, Management, and Delivery of the Retrieved Information): Basic Skills and Knowledge

C.1 Management and Analysis of the Retrieved Information:

- Locating the identified patent and non-patent documentation using libraries, publishers, Internet sites, commercial providers, etc.
- Organising a physical \ digital archive for the retrieved documents (for example, using reference management software).
- Indexing and categorising the documents, based on their importance for the search objective and extracting the relevant information.
- Conducting the quantitative and qualitative analysis of the retrieved patent and technological information, in order to select the elements to be reported to the requesting party.

C.2 Reporting and Delivering the Information to the Requesting Party:

- Structure and preparation of consolidated documents in line with the request e.g. (presentation, tables, search report, databases, mapping of the relevant patents in a technological field, state-of-the-art analysis, regular surveys, etc.).
- Examples of reports and follow-up activities (e.g. development of standard procedures for searching and communicating the results, alerting/watching systems, budgetary aspects, technical recommendations).