Dear Patent Information Professionals,

We would like to thank everyone who has provided feedback so far, and we welcome any further comments which will also be reviewed. Please note that these are proposals for which **constructive** feedback is sought. Nothing has been made final or has been fully decided yet.

We would like to clarify the following points below which seem to raise some questions amongst those who responded during the public consultation period.

Who is the ISBQPIP?

The International Standards Board for Qualified Patent Information Professional (ISBQPIP, pronounced as I-S-B-Q-PIP) is the envisioned name of the organization that will be running the examination, certification and registration of QPIPs. **The organization does not exist yet**. Once the Articles have been formalized and it has been decided who will form the first Supervisory Council, the organization can officially be registered and founded. Until then the only organization that exists is the group of volunteers consisting of a coordinators team and several committees which report to the coordinators team. This group has been working on the certification project since 2008 and consists of volunteers from the CEPIUG, PDG and PIUG. The activities and progress have been regularly presented and discussed in these fora and at a number of conferences. There have been regular requests for volunteers, so any organisation, who wished to appoint one or more representatives, has had ample opportunity to do so and certainly there are a number of representatives from most organisations. If anyone would like to volunteer, please send us an [email](mailto:) or contact one of the coordinator team members below.

Current certification scope

The current proposal for examination and certification is aimed at the patent information professional capable of doing all kind of patent related searches and analyses independently. The exam consists of 2 papers:

1) Search paper *(Rule 8):*

    i.   prior art search such as opposition, validity or novelty search to be conducted

    ii.   patent infringement risk search to be conducted

In both Part i and ii, <u>the candidate will select</u> from a choice of different technical areas to suit his or her technical competence.

2) Analysis paper *(Rule 8)*:

    i.   Short answer questions on patent law of IP5 relevant to a patent information professional

    ii.   Two technology neutral cases in which the candidate will be asked to categorize provided documents as being of interest or not

Possibly, a tiered system will be set up in the future to address different type of searches other than those proposed for the certification exam, but it was decided to concentrate initially on the highest level which recognizes the all-round patent information professional who should at least be capable of prior art searching and patent infringement risk searching. Patent landscaping could be a part of this level in the future, however, at the moment there are no generally accepted norms for this type of search and it is difficult to determine how best to examine and assess them. Therefore it was decided to exclude patent landscaping from the certification scheme, at least for the moment. Anyone who has ideas on this is welcome to set up a team to look at how these may be examined.

Enrolment requirements for examination

The scientific, engineering or technical education requirements to enrol for the exams are in general comparable to what is required to become a patent attorney. Although the technical education requirement

may be similar, the QPIP certification will be a standalone qualification independent of any patent attorney or patent agent qualifications. For example, the requirements necessary for passing the USPTO bar in order to represent clients before the USPTO as a patent agent focuses on the Manual of Patent Examination Procedure (MPEP) and does not focus on the methodology of patent searching. A similar situation exists for the European patent attorney exams as well as patent attorney qualifications in other jurisdictions. For this reason, a patent attorney/agent qualification cannot be considered equivalent to the QPIP certification. Although there are patent searchers in the US who are registered US patent agents, this is not because the preparation to become a US agent emphasizes patent searching skills, but rather appears to have arisen because the patent information profession does not have its own registration process and employers/clients prefer to see some formal qualification.

Although it is apparent that some believe the requirement of three years searching experience has been set too high especially for new entrants, it's important to keep in mind that a patent searcher's competence is largely dependent on experience. Setting it at three years enables the candidate sufficient time in which to conduct the required number of searches (where 1 search is understood to mean 1 complete search project on a given topic that includes all iterations in devising the search and the time spent reviewing the (combined) results and reporting). Although the aim is to have more courses available to help acquire the required knowledge and skills, experience is considered a crucial factor in being able to search efficiently and effectively and deliver at least reasonable results in a very short time frame as is required by the examination. For these reasons, the requirement of three years searching experience has been proposed in order to sit the exams.

Regarding the technical degree requirement, if someone does not have a Bachelor Degree, it is advised to check the website of the Netherlands Organisation for International Cooperation in Higher Education to see whether the person's education is regarded equivalent to a (Dutch) Bachelor degree (see evaluation charts per country). For people who have not completed tertiary education, but who have been working with patent and other technical information for quite some time already, the alternative option to qualify with 10 years of work experience in lieu of education has been added (see Rule 4.4c). This should allow most people who are likely to be able to pass the exams, to apply. If somebody does not meet any of these requirements, but is convinced that (s)he should be allowed to participate in the exam, Rule 24 provides the option to appeal and request the Supervisory Council to assess the provided evidence that enrolment should be allowed. Similar provisions have also been added in the case of applications for prior experience recognition-PER (see Rules 18.6b and 20).

The complaints about the administrative burden concerning the proposed application procedure to either sit the exam or to be granted PER status have already led to the decision to review the procedures, but no concrete alternatives have been developed as of yet. A proposal to have an application form is however being seriously considered. The comments regarding the financial burden of notarising documents have also been reviewed and it is unlikely that this will be a requirement for the exam enrolment. For assessing PER applications, however, there needs to be some means by which to authenticate the applicant's information as an in-person interview procedure is not being currently proposed. Again, alternative options are under consideration and any further suggestions are welcome.

Legal knowledge requirements

Some have commented that the legal knowledge requirements have been set to a relatively high level. With the information overload a patent searcher's client faces, there is an increasing need for the patent searcher to filter and/or select documents to facilitate the client's review. It is understood that in some countries, a client may instruct a patent searcher not to review the search results at all. A QPIP needs to be in a position to cater to all current and future clients' needs that may necessitate such review and selection. For this reason, it is appropriate to include legal knowledge aspects in the certification process. It is not however the intention to require the same level of legal knowledge as for patent attorneys. The patent information professional should at least have thorough knowledge on interpretation of priority dates, be able to assess if a patent is in force or pending and know how to read claims, even if this is not required in their current role. This certification aims to prepare the candidates for whatever the future may throw at them due to circumstances such as a change in job or modified company policies or requirements. Like with any degree/diploma/certification, it is possible or

even likely that it covers more subject matter that may need to be applied later in practice, but at least the registered QPIP will be prepared when such requirements arise.

It should also be emphasized that there is no requirement to do the exams or become a registered QPIP. Patent information professionals who, for example, are not conducting patent infringement risk searches and who do not aim to become an all-round patent information professional can of course decide against participating in the certification.

Prior Experience Recognition PER

One of the requirements for the Prior Experience Recognition (PER) is the willingness to participate in future training and examination. This does not necessarily mean that everybody will have to participate, but it provides a pool of sufficiently experienced people to draw upon to train others, develop and mark exams or otherwise participate in the ISBQPIP organisation. This also explains why the requirements for PER are set relatively high, because the quality of future generations of qualified patent information professionals will depend on them.

Originally the PER was not considered, but to give the organisation an initial critical mass from which to draw upon to establish the committees was perceived as a way of giving the organisation more credibility. Again an application form for PER is being considered to decrease the administrative burden.

Continued Professional Development CPD

The requirements for continued professional development (CPD) seem to raise a lot of questions and discussion. Continuous development requirements have been adopted by many professions as a basic requirement to remain up to date and it appears highly appropriate for a fast developing profession like ours. In many countries such as UK, Australia and the United States it is already mandatory for patent attorneys to complete annual CPD requirements. Many others are looking into introducing such requirements including the European Patent Institute (epi).

Unfortunately, a perception has formed that one needs to spend considerable money and travel in order to satisfy the CPD requirements. This is simply not true. In the examples provided below it is shown how 10+ points can be obtained at low or no costs, i.e. without attending a conference.

Examples:

Searcher working for a company without travel allotments	CPD 12 pts	Independent searcher	CPD 11 pts
Attending remotely or in person an internal training course or meeting relating to patent information or scientific, engineering or technical training lasting ½ day or longer.	2	Attending a half-day web workshop on new release version and best use of a search tool provider.	2
Attending remotely or in person an internal presentation on patent information developments lasting up to ½ day.	2	Reading an article on search strategies in a journal.	1
Evaluation and preparing a report or presentation of new patent information tools for retrieval or analysis.	2	Reading a blog post on patent information analysis	1
Attending remotely or in person a patent information vendor webinar.	1	Participating (or remotely reviewing) in a national patent user group meeting one day seminar focusing on FTO search considerations.	3

Searcher working for a company without travel allotments	CPD 12 pts	Independent searcher	CPD 11 pts
Attending remotely or in person a half day internal meeting with vendors.	1	Following and reviewing the EPO "East Meets West" seminar via the e-learning web program on how to access and search Asian patent information.	2
Internal peer review of patent related search reports.	1	Attending a vendor webinar on a visualization tool.	1
Reading 3 books, journal articles, conference papers, conference proceedings or online forums such as law blogs relating to patent law, patent information retrieval or patent information analysis.	3	Reading and reviewing presentations from EPOPIC on outsourcing routines within companies.	1

As Margaret Rainey (GSK) pointed out in her presentation at IPI-ConfEx 2015 in which she shared the experiences of implementing CPD in her team, before implementation the "perceived time needed to *do* CPD" was a concern, however, in practice "most people did not find this to be an issue". Some quotes from the GSK team upon evaluation of the CPD scheme were as follows:

"I don't think it was time-consuming or onerous. It's a good way of keeping track of things we've done which otherwise we tend to forget."

"Overall, I felt it was a good thing to do as it focused one's mind on what you had achieved and where the gaps were."

"To be honest, I think this initiative breathes fresh-life into the concept of CPD and really helps to give a valuable framework for planning and recording professional development activities. An issue I have seen many times in the past is how to prioritise CPD activities (and how, more fundamentally, to define what may constitute CPD). From what I have seen this new process helps to do both of these things and I'm sure will be a big benefit to us all."

Final remarks

It has been encouraging to see so many people respond to the request for comments which will hopefully result in a recognized qualification that will benefit the community as a whole. The work is not over and the comments will be reviewed over the coming months after which a next draft will be released for a second round of public consultation.

With kind regards,

The Certification Initiative Coordinator Team

Bettina De Jong
Susanne Hantos
Susan Helliwell
Bart van Wezenbeek
Bernd Wolter
Linus Wretblad