Science and Engineering Careers in Patent Law

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What’s the difference between an extroverted and introverted patent attorney?

A: The extroverted patent attorney stairs at YOUR shoes!
Intellectual Property

- Patents ➔ functional aspects
- Copyrights ➔ works of art
- Trademarks ➔ I.D. of goods in commerce
- Trade secrets ➔ secret sauce
Characteristics of a patent

- Right of Exclusion ➞ “Negative Right”
- Limited Term
  - 20 years for utility – from filing
  - 14 years for design – from issue
- Transferrable
- Actionable
Basis for patent rights

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries

- Article I, Section 8, Clause 8, U.S. Constitution
Justification for patents

- Avoid Tragedy of the Commons
- Coasian bargaining enables value extraction for society
- Spurs investment leading to more innovation
- Innovation stimulation is justification under U.S. Law
- Positive correlation between patent grants and GDP
  - different tech sectors are more responsive to IP rights than others
- Rewarding inventor is NOT justification under U.S. Law (not the case in most other countries)
Requirements for Patent

- Useful and Statutory Subject Matter ➞ § 101
- Novel ➞ § 102
- Non-obvious ➞ § 103
- Adequate Claims and Description ➞ § 112

* see section 35 of United States Code
Patent Law in Flux

• American Invents Act (AIA)
• Subject Matter Eligibility Continually Debated
  ➢ Driven by Judiciary (i.e., court decisions)
  ➢ e.g., business methods, gene sequences, software
• Patentability Standards (i.e., “obviousness”)
• Non-practicing entities (i.e., Patent Trolls)
Career Choices in Patent Law

- Patent Attorney
- Patent Agent
- Technology Advisor
- USPTO Patent Examiner
Required Characteristics

- Technical Ability ➔ specific and diverse
- Reasoning Skills
- Writing/Communication Skills
- Ability to Work in “Service” Field
Technical Background

- 99% hold bachelors
- 29% hold masters
- 15% hold Ph.D.
Registered Attorneys/Agents
Attorneys vs. Agents

Percent of Registered US Patent Practitioners that are listed as Attorneys, Grouped by Registration Year

Year of Registration

1989 1991 1993 1995 1997 1999 2001 2003 2005 2007 2009

0% 10% 20% 30% 40% 50% 60% 70% 80% 90% 100%
Patent Attorney Requirements

- Qualifying undergraduate degree (or equivalent)
  - These degrees are listed by USPTO
- Law degree
- Pass State Bar Exam
- Pass Patent Bar Exam
  - Can take patent bar exam at anytime after undergrad
Patent Agent Requirements

- Qualifying undergraduate degree (or equivalent)
- Law degree
- Pass State Bar Exam
- Pass Patent Bar Exam
Tech Advisor Requirements

- Valuable degree
- Law degree
- Pass State Bar Exam
- Pass Patent Bar Exam
Examiner Requirements

- Lobby Congress to allow PTO to keep fees
- Get hired
Practice Settings

- “Big Law” Firms
- Boutique Law Firms
- In-house
- Technology Transfer Office
- USPTO (D.C. more coming soon...maybe)
What do Patent Attorneys Do?

- Interface with inventors and company executives
- Analyze broad array of subject matter
  - nanotechnology, nuclear reactors, avionics systems
- Acquire patent rights – U.S. and foreign
  - Write application
  - Prosecute (USPTO → PTAB → CAFC → SCOTUS)
- Rights and Portfolio management
- Litigation
Law School

- Application of Legal Concepts to Factual Setting
- Logic and reasoning skills
- Legal writing
- Science and Engineering skills transfer well
- Clerkship following 1st year – very important!!
Law School - uncensored

- 3 years of your life
- During 1st year...just say goodbye to family
- 1-3% of classmates will have technical background
- Enjoy the Socratic method
Path to Patent Attorney

- Take LSAT exam (approximately 1 year before law school)
- Law school entrance is almost entirely based on undergrad GPA and LSAT score
- Apply to multiple law schools
- Focus on the best law school in region you want to practice
  - After you get first law job school choice is not as important
- Reach out to local patent firms before going to law school
Path to Patent Agent

• Seek out local firms and companies (while finishing technical degree)
• Look for internship opportunities
  ➢ Local law firms, companies with IP department, university tech transfer offices
• Sign up and take patent bar
  ➢ Firm/company may pay for it
• While in school hone writing skills
  ➢ Technical writing courses
* Recall slide 12, which shows number of practitioners registered each year going down
Positive Outlook

- U.S. Patent filings continue to trend upward
- Asia emphasis on IP
  - China has goal of 2,000,000/year by 2015
- U.S. Law is in state of rapid change
  - Changes in law are good for lawyer job security
- Law school enrollment has dropped universally
- Number of Patent Attorneys/Agents continues to drop
The End

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