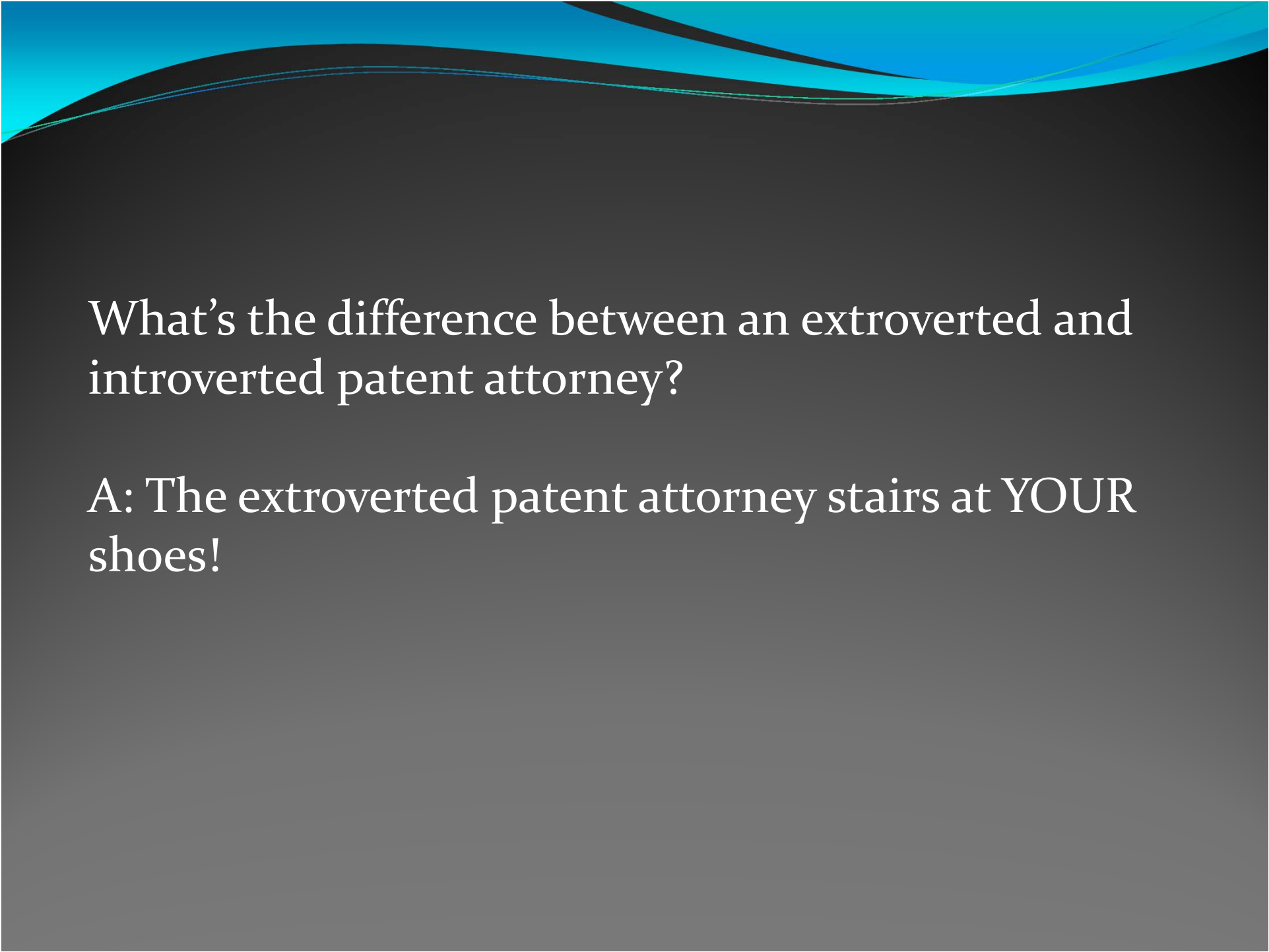




# Science and Engineering Careers in Patent Law

Matt Poulsen  
Patent Attorney  
Suiter-Swantz pc llo



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

A: The extroverted patent attorney stares 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

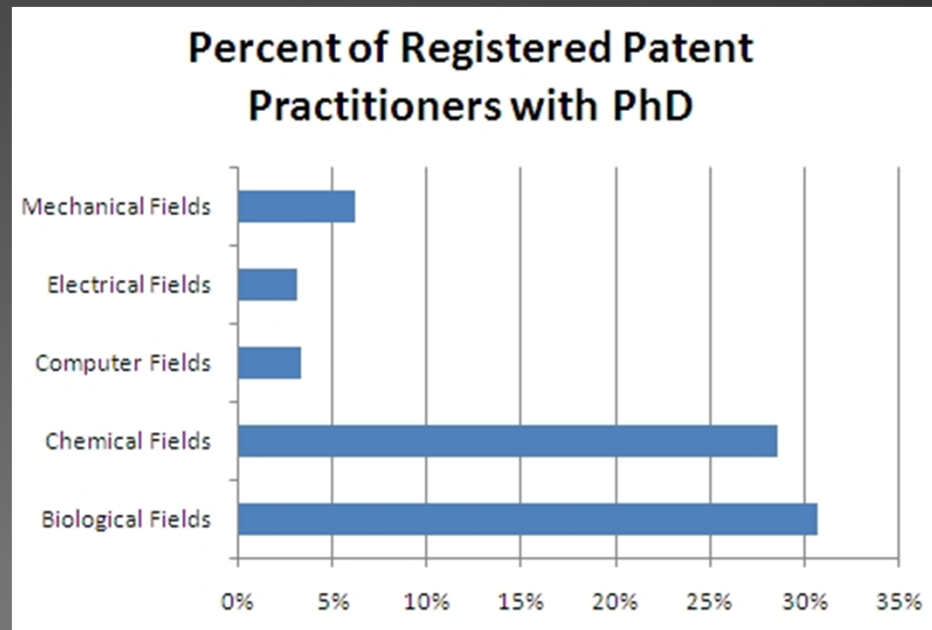
- Patent Attorney
- Patent Agent
- Technology Advisor
- USPTO Patent Examiner

# Required Characteristics

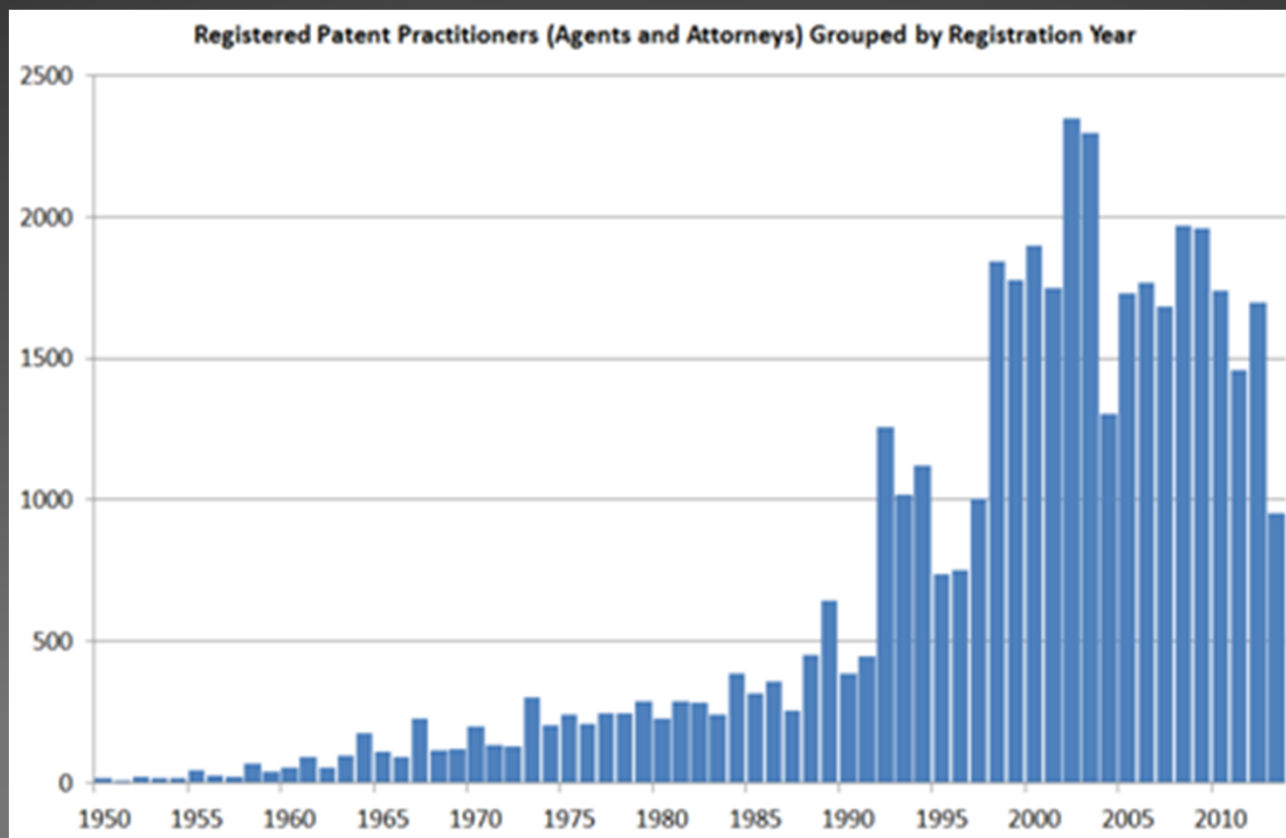
- Technical Ability → specific and diverse
- Reasoning Skills
- Writing/Communication Skills
- Ability to Work in “Service” Field

# Technical Background

- 99% hold bachelors
- 29% hold masters
- 15% hold Ph.D.

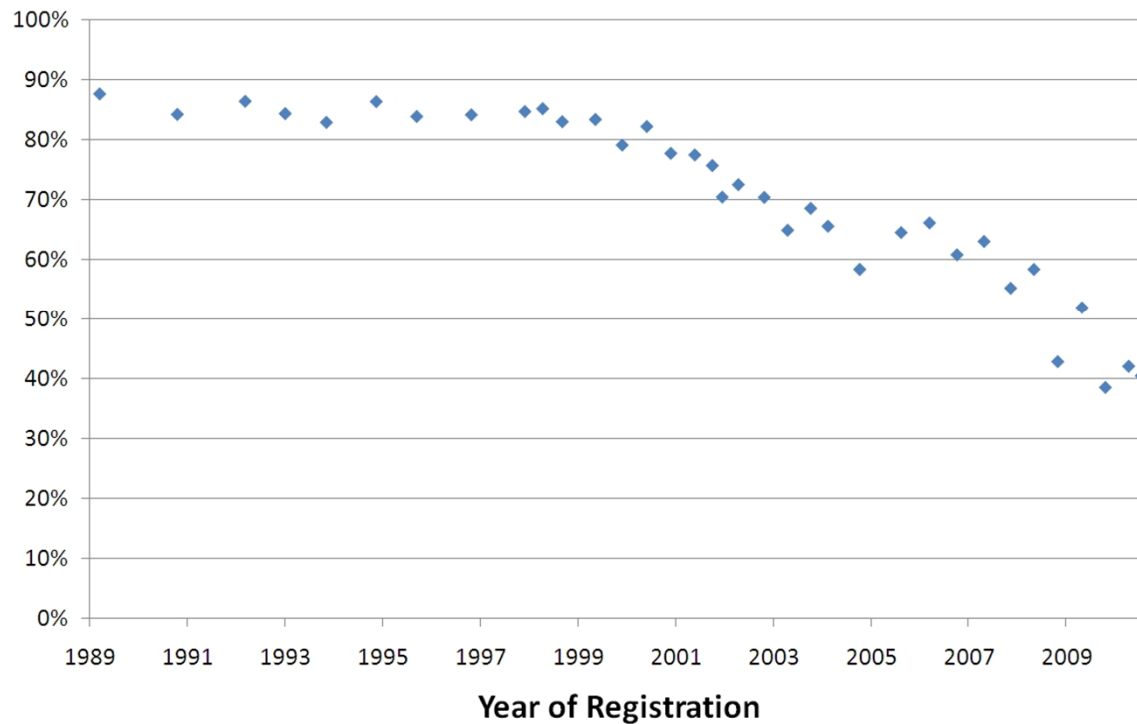


# Registered Attorneys/Agents



# Attorneys vs. Agents

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



# 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
- <http://careers.uspto.gov/Pages/PEPositions/Jobs.aspx>

# 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 1<sup>st</sup> 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

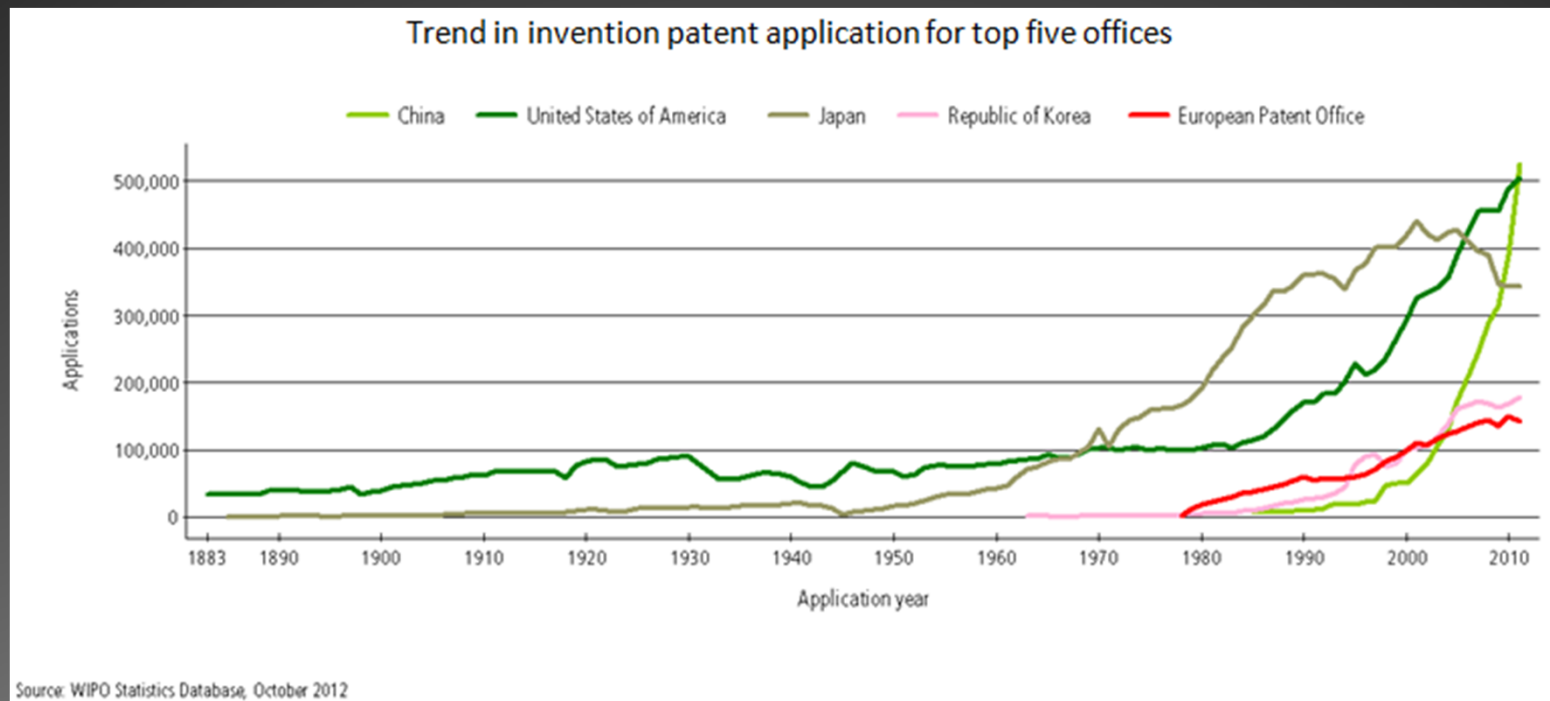
# Path to Patent Attorney

- 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
  - Exception: elite top 10-15 law schools. Those degrees translate anywhere.
  - 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

# Patent Filings



\* 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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