

A PATENTLY SATISFYING CAREER

Scientists-turned-lawyers offer tips on navigating a career in **INTELLECTUAL PROPERTY LAW**

LINDA WANG, C&EN WASHINGTON

IN 1995, PAUL E. DIETZE, then an associate professor of chemistry at the University of Maryland, Baltimore County, made a life-changing decision: He left academics and went to law school.

Today, Dietze is a patent attorney with the intellectual property firm Kenyon & Kenyon LLP in Washington, D.C. "In retrospect, not being tenured was the best thing that probably could have happened to me. I really enjoy what I do now."

Most people don't arrive at the decision to practice patent law the way Dietze did, but most people also don't intend early on to become patent lawyers. "I can't think of too many people who started out as undergraduates thinking that what they wanted to do was patent law," Dietze says.

But people who are trained as scientists are perhaps best equipped for this type of work. Patents in the life sciences can involve highly sophisticated inventions, and people with scientific backgrounds have an advantage when it comes to understanding the material. In fact, to qualify for the patent bar exam, candidates either need to have a bachelor's degree in natural sciences, technology, or engineering or must have completed a certain number of semester hours in science or engineering.

At Summa, Allan & Additon P.A., an intellectual property firm in Charlotte, N.C., all but one of the 11 patent attorneys have science degrees. At Myers, Bigel, Sibley & Sajovec P.A., an intellectual property firm in Raleigh, N.C., all 30 patent attorneys have science degrees.

Kenneth D. Sibley, a founding partner of Myers Bigel, says his firm is particularly interested in hiring people with advanced degrees in biology or life sciences. Sibley has a B.A. in biology and psychology and an M.A. in neurobiology.

The demand for such specialized talent is growing. "We're seeing an explosion of innovation and activity in the life sciences area, and I think the demand is continuing quite strongly for the services of people who can provide intellectual property protection," says Lee Carl Bromberg, a partner at Bromberg & Sunstein LLP, a Boston law firm specializing in intellectual property and business litigation.

Patent law is divided into prosecution and litigation. Prosecutors write and process patent applications to be submitted to the Patent & Trademark Office (PTO); litigators go to court to defend or attack the validity of an existing patent.

Edmund J. Sease, who has a bachelor's

DEMANDS
Patent law involves a lot of research.

degree in chemistry and is a partner at McKee, Voorhees & Sease PLC, an intellectual property firm in Des Moines, de-

scribes the two types of lawyers this way: "There are patent lawyers who are more fascinated with the science. They tend to be more interested in prosecution. And then there are patent lawyers who are more interested in the legal side of patent law. They tend more often to be litigators. You have to look within yourself to figure out which discipline suits you best."

Regardless of which type of law one practices, a patent lawyer first needs to be a good lawyer, says Philip Summa, who has a B.A. and an M.S. in chemistry and is a shareholder and founding partner of Summa, Allan & Additon. He offers this practical advice: "Go to the best college you can get accepted into, and get the best grades you can get. Then go to the best law school you can get accepted into, and get the best grades you can get. Those are the two things we really look for."

Having a Ph.D. helps, says Dietze, who has a Ph.D. in organic chemistry. "It's another feather in your hat when you apply for jobs." Bromberg says his firm frequently hires top-notch Ph.D.s and sends them to law school.

But both Bromberg and Dietze are quick to point out that a Ph.D. is not a requirement for practicing law. In fact, they say, many patent lawyers do not have advanced science degrees. Bromberg does predict, however, that 10 or 20 years from now the people in the most senior positions will likely have Ph.D.s, particularly in the biotech and pharma areas.

FOR PEOPLE without advanced degrees, in particular those who want to go into litigation, one way to get a leg up is to clerk for the Court of Appeals for the Federal Circuit. "For us, the opportunity to hire a young lawyer who has worked as a clerk for a federal judge is probably every bit as valuable as hiring someone who has a Ph.D.," says Summa, noting that two of their lawyers are former federal court clerks. "Young people who train there come out with an outstanding level of experience in the law."

Summa says his ideal candidate would be a Ph.D. biochemist who has spent two years as a clerk for the Court of Appeals for the Federal Circuit. "That person could probably name their price," he says.

Meanwhile, people interested in the

prosecution side of things could gain an edge by working as a patent examiner for PTO. Patent examiners review patent applications to determine if they comply with basic rules and legal requirements.

Steven Griffin, a supervisory patent examiner at PTO, says working for the government agency has many advantages, including telework opportunities, a flexible work schedule, paid holidays, a 401(k) plan, job security, and health benefits. In fact, *Business Week* recently named PTO one of the top places to work.

Griffin adds that a person who has worked as a patent examiner for four years may be exempt from taking the registration exam, which is required to be registered to practice before PTO in patent cases. He says job opportunities abound at PTO, and he encourages job seekers to check for openings on its website, usptocareers.gov.

Some people may find that working for a life sciences company is the best fit for them. In-house lawyers have a more nine-to-five schedule and become more intimately familiar with one area of technology. They also see how that technology fits into the company's business plan. At some companies, a scientist can transition from a bench researcher position to a patent liaison position and eventually to a patent agent position.

For some people, being a patent agent is the ultimate career goal. Patent agents do not have law degrees but have passed the patent bar exam and are licensed to prepare and process patents.

Whatever their calling, many people in this field consider it to be the perfect marriage of science and law. "I get to sit down on a monthly, weekly, or sometimes daily basis with some of the smartest people in their individual fields of endeavor, and they get to teach me interesting things about what they do. And that's fascinating," Summa says. Others say doing intellectual property law is just a different way of applying their scientific expertise.

People with science degrees can also consider going into environmental law, corporate law, forensics, criminal law,

and toxic tort law. "In virtually every area of law, scientific issues will arise, and naturally, someone who has a scientific background will be better capable of understanding and addressing those issues," says Justin Hasford, program chair for the American Chemical Society Division of Chemistry & the Law (CHAL) and a patent litigation attorney with Finnegan,

LINDA WANG/GBEN



Henderson, Farabow, Garrett & Dunner LLP, a large intellectual property law firm in Washington, D.C. Hasford has a B.S. in chemistry and molecular biology.

"People need to consider their strengths and weaknesses carefully and think whether they're targeting the right area of law," Sibley says. "You're going to interact with different types of people and in a different environment and climate. It's what's the best fit for your personality and the skill sets that you've acquired."

Law is a lucrative career. Dietze says his

starting salary as a lawyer was considerably better than what he was making as an associate professor. Many law firms even offer higher pay to people with Ph.D.s. Summa says starting salaries for top-notch attorneys coming out of law school are in the \$120,000 to \$130,000 range.

Summa says in many ways, it's easier to find a job as a patent lawyer in a law firm

SECOND CAREER Dietze is a chemistry professor-turned-patent attorney.

than it is to find a job as a chemistry professor at a college or university. He points out that overall professorship positions are fewer than positions for patent lawyers.

Summa's firm has hired five new lawyers since July 2005. Although the firm is not currently hiring, he says it will consider candidates who have outstanding résumés. "It's like sports. If the best person wants to come play for you, you find a place for them." He encourages young lawyers to be proactive and to send in their résumés even if they know a firm is not hiring.

IN THE U.K., demand for patent attorneys is also strong, and filling positions is a problem, says Andrea Brewster, who has a B.A. in natural sciences and is a chartered U.K. patent attorney and European patent attorney at Greaves Brewster LLP. "The system for training is limiting things," she explains. "You have to be trained by an existing patent attorney, who is likely to be overworked, and that's producing a bottleneck in the system."

She explains that patent attorneys in the U.K. do not need law degrees; most of their experience comes from on-the-job training. For a small boutique firm like hers, she says, it can be difficult to find the time to hire and train a new recruit. She recommends that job seekers consider larger firms that have the resources to train new lawyers. "But everybody is recruiting less than they could or perhaps ought to," she says.

To help alleviate this problem, the University of Manchester offers a degree program called Chemistry with Patent

In many ways, it's easier to find a job as a patent lawyer in a law firm than it is to find a job as a chemistry professor at a college or university.

Law. During the four-year program, students take classes in chemistry as well as intellectual property law and European law. In the fourth year, students are paired with a patent professional in industry or private practice. Students who complete the program receive a master's degree in chemistry. David Collison, director of the program, says students graduating from the program have had a good record of finding jobs in patent law.

For women, patent law can be a tough but rewarding career choice. "You're trying to break into a field that's almost as hard to break into as chemistry, but yet when you get there, you're a pretty nice commodity for a firm to have," says Sandra Thompson, a partner with Buchalter Nemer and secretary and chair-elect of CHAL.

Thompson, who has a Ph.D. in analytical chemistry, says having an advanced degree has helped break down some of the barriers between her and the inventors. "When I go in and I give them my card, and they see that

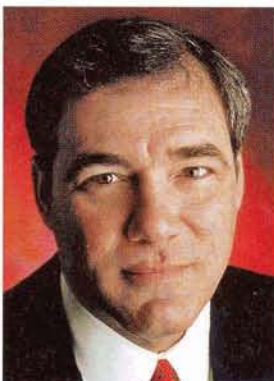


KURT VICKERY

Brewster

she says. She describes herself to inventors as a scientist who is also an attorney, but she's a scientist first.

"If you go in with an inventor and don't get as excited about their work as they are, they're immediately going to shut down on you," she says. "You really have to go in and tell them, 'This is really neat, I really see it,



SUMMA, ALLEN & ADDITON

Summa

she says. "If you're willing to work some unconventional hours, you can really develop a life for yourself where you have ultimate flexibility. I truly love what I do for a living, and I would not change a thing."

Brewster offers this perspective from the U.K.: "When I joined the profession, there were not so many women around.

OPENING DOORS
Working for the Patent & Trademark Office can give young patent attorneys an edge.

It was traditionally a man's job. But I think that's very different now. There are a lot of women around—women holding important positions, women who are partners in firms and representing top-notch corporate clients."

Collison notes that more than half of the students enrolled in the Chemistry with Patent Law program this year are women.

Job seekers can learn more about careers in patent law next March during the ACS spring national meeting in Chicago. CHAL will be cosponsoring a symposium titled "Beyond the Bench: Nontraditional Careers in Chemistry." A patent litigator, a patent office examiner, and a law student will offer their perspectives on careers in patent law. Carl Lippenberger, who has a B.S. in chemical engineering and is chair of CHAL, says that young lawyers or any ACS member seeking advice are welcome to contact any of CHAL's executive committee members, who are listed on CHAL's website.

Dietze admits that he sometimes does miss teaching. But he also says he can't imagine having a more fulfilling job than he does now. "If I had to do it all over again, I would do it in a heartbeat," he says.

Sease agrees. "For almost everyone who finally ends up in patent law, they have that epiphany day where they say, 'Yes, this is what I was meant to do.'" ■



FINNEGAN HENDERSON

Hasford



I have a Ph.D., it's almost as though we're colleagues at that point." She offers this advice to a young woman trying to enter the field: "I would definitely tell her that if she's in a Ph.D. program, finish it. Finish your Ph.D., put your first two years in, and it will get better."

Another tip she offers is to stay grounded. She says she never wears a suit into the lab and doesn't try to stand out. "Inventors really appreciate it when you can sit down and talk about something in real terms,"

I get it.' That is what it takes to really get them to open up, and you have to be confident more in your science, I think, than in your ability to be a good attorney."

She says she loves the flexibility her job gives her. Because a large percentage of her job involves writing, she says she can work from home if she wants to. Although she works many weekends, there are other times she can take off. "You need to stop thinking about a traditional workweek,"