



RUTGERS



## **Advice on how to prepare for careers in patent law with a biology PhD**

Description of jobs in patent law/intellectual property:

**Patent Attorney** – Someone who has a JD degree from a law school and has passed at least one state bar exam as well as the Patent Bar. After a student earns a PhD, a postdoc is not necessary to pursue this career path. However, it is important to get real world corporate experience. For example, one may enter a start up biotech company, allowing one to gain exposure to all aspects of the company (business, management, legal, etc.) before applying to law school. There are 3 types of patent attorneys and depending on your personality, one might fit you better than another:

1. Application drafter typically sits in an office and generates applications all day.
2. Business analyst/strategist partners with pharma companies / start-ups to help them plan their patents.
3. Litigator goes to court and argues cases.

**Patent Agent** – Someone who can provide many of the same services as a Patent Attorney, but cannot sign off on applications and cannot become a partner in the firm. The patent agent also cannot provide advice outside of patents, thus cannot work on trademark matters, copyright matters, etc.

This person usually has a PhD and a postdoc could be helpful. The specific field of study is what makes you desirable for a job (e.g. stem cells and Neuroscience are very hot right now). You provide the law firm expertise on the science and you could eventually get hired by a client of the law firm to help them “in house”. Some patent agents eventually go to law school but the firm typically does not pay for tuition. You would enroll as an evening student and continue working at the company or firm during the day.

You must pass the patent bar exam offered by the US Trademark Office. In 2013, those who took the patent bar had a 46.8% pass rate. To prepare for the patent exam, there are several courses one may take.

A popular course is offered by the Practising Law Institute:

<http://www.pli.edu/>.

**Intellectual Property Paralegal** – Someone who assists the patent attorney. This person should be very detail oriented and not mind doing mundane tasks. You do not draft applications. However, you do gain a great deal of experience learning all of the actions in connection with a global portfolio.

**Biomedical Consultant** – Someone who works for a company and advises on which applications to file. This person has a deep knowledge of the science and the future direction of the company. This person steers the company's IP.

**Licensing Manager** – Someone who is a liaison between the inventor and the patent office, as well as between the institution and other companies. Usually they work in a tech transfer office such as at a university or a company. You do not have to have a JD for this. Often after the PhD and some industry experience, an MBA can help you get a job. There is in-licensing (obtaining licenses from other companies) and out-licensing (granting licenses to other companies). For example, if you have a left over reagent such as an antibody, you could out-license the antibody to a company which would then sell the antibody directly to consumers.

**Patent Examiner** – Someone who works for the patent office in Virginia and reviews patents. You have to be a US Citizen. There are lots of these jobs available (6000 total examiners). The need for people with PhD in life science is high. It is a very informal work atmosphere and you can set your own hours.

### **General Advice**

Prepare and practice a 30 second “elevator pitch” in which you tell your audience what you do that is exciting and relevant. The pitch should be tailored to the person you are speaking to.

Build your networks to make contacts at Rutgers, your undergrad institution, acquaintances and LinkedIn.

Make simple business cards to hand out.

Join the various patent law associations:

- American Intellectual Property Law Association (AIPLA)
- New Jersey Intellectual Property Law Association (NJIPLA)
- Licensing Executive Society (LES)
- American Chemical Society (ACS)
- United States Patent and Trademark Office (USPTO)

Seminars and Roadshows

- Rutgers Office of Technology Commercialization

Follow patent law blogs:

- <http://www.law360.com/ip>
- <http://www.ipwatchdog.com/>
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- <http://www.scotusblog.com/>
- [http://www.intellogist.com/wiki/Directory\\_of\\_IP\\_Blogs](http://www.intellogist.com/wiki/Directory_of_IP_Blogs)

Read the NY Times Corner Office articles online:  
<http://projects.nytimes.com/corner-office>

Biotech Incubators are where a lot of the intellectual property is coming from. It is great to get a job in a start up company to learn all aspects of the business before applying for Intellectual Property related jobs.

Remember that what you do in grad school is very important to helping you get a job so your CV looks impressive (i.e. you need to publish and write your own grants). The “soft skills” (e.g., good communicator, confident speaker, disciplined listener) can be just as important as your “hard skills” (e.g., your understanding of the science and how it relates to the business).

Also, the skills you learn in grad school (writing, speaking, networking, thinking broadly, being able to change your perspective, problem solving, critical thinking) will help you in patent law careers so highlight those skills to market yourself to employers.

A typical path could be: PhD – biotech employee or patent examiner – patent agent – law school – patent attorney.

Notably, there are many ways to move vertically while at the USPTO if you choose to be an examiner, so, for example, if you are interested in policy discussions, this may be a place to stay long term.

Importantly, being honest with yourself and knowing what you are good at will help you go far.

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