

# Careers in Patent Law

Mitchell Jones

Partner

Medlen & Carroll, LLP

# Career Path

- PhD from ERP Program, Neal First's lab
- In early 1990's R&D positions at biotech companies were unstable
- Academic positions required long post-docs and there were many applicants for each position
- Patent law seemed like a good alternative

# Intellectual Property

- Patents
- Trademarks
- Copyright
- Trade secrets

# Patent Basics

- New, useful and non-obvious
- Granted by the government
- Valid for 20 years
- Technical documents that explain how to make and use an invention
- The claims of the patent define the metes and bounds of the invention

# Patent Subject Matter

- Compositions – genes, proteins, drugs
- Methods – Treatments, synthesis, screening
- Research tools – Vectors, reporter genes, kits
- Systems – Image analysis, FACS

# Patent Rights

- Right to exclude others from practicing the invention
- Pharmaceuticals take years to develop at very high expense
- Patents are crucial to protecting market position
- Patents are primary asset of early stage companies

# Need for Patents

- Companies devote substantial resources to patent protection
- Investors require sophisticated patent programs

# Patent Litigation

- Biotech companies are aggressive in protecting patents
- Verdicts have ranged up to \$500 M



# What Makes a Good Patent Attorney

- Diverse scientific background
- Ability to understand technology outside immediate area of expertise
- Excellent communication skills
- Excellent writing skills
- Strong work ethic
- Ability to understand legal concepts
- Calmness under pressure - deadlines

# Success In Law School

- Law is based on ability to apply legal concepts to factual situations
- Must be able to address all sides of an argument – advocate for both sides of an issue
- Must be able to read, analyze and apply legal decisions
- Must be able to see all issues presented in a given factual situation

# Scientific Training is Good Preparation for a Legal Career

- Learn how to solve problems
- Learn how to critically analyze data/facts and recognize shortcoming
- Learn how to defend your interpretation of data
- Learn how to write technical documents

# Use of Scientific Training

- Interaction with scientists/inventors
- Design experiments to support patent
- Expanding invention
- Analysis of notebooks during litigation
- Questioning of scientific witnesses during litigation

# Comparison with Academic Careers

- Get to work with wide variety of technology and clients
- Service based job
- Don't have to do bench work
- Large amount of writing
- Don't have to manage grad students
- Pay is better

# Job Prospects

- Outlook is good as long as biotech industry continues to expand
- Can work in a law firm or directly for a company
- Jobs primarily confined to biotech centers