

# ALTERNATIVE CAREER OPPORTUNITIES IN INTELLECTUAL PROPERTY LAW

Cheryl H. Agris, Ph.D., J.D.

Attorney at Law

Pelham, N.Y.

(914) 712-0093

[c.agris.patlaw@pobox.com](mailto:c.agris.patlaw@pobox.com)

- How I spend my day
- Opportunities in the IP Field
- Is Patent Law For You?

# How I Spend My Day

- Prepare and Prosecute U.S. Patent Applications
- Direct Prosecution of Foreign Patent Applications
- Provide Patentability, Freedom of Operation and Invalidity Opinions-conduct literature and patent searches
- Draft and Review Agreements-confidentiality, licensing, consulting and sponsored research agreements
- Counseling clients

# Prepare and Prosecute Patent Applications

- Prepare Application
  - Review Material from inventor
  - Review Related Literature and Patents
  - Draft Application
- Prosecute Application-respond to communications from the patent office mostly in writing and sometimes orally

# Opportunities in the IP Field

- Patent Examiner-U.S. Government
- Technology Transfer-University
- Intellectual Property Specialist-Corporation
- Searcher-Corporation, Search Firm
- Patent Agent-Corporation and Law Firm
- Patent Attorney-Corporation and Law Firm

# Patent Examiner

- Reviews patent applications in a particular technology; conducts literature and patent searches to determine if subject matter is novel, nonobvious, useful, etc.
- Law Degree Not Required
- Location-Washington D.C. area
- Opportunities-supervisory, policymaking positions based on seniority and merit

# Technology Transfer Specialist

- Evaluates invention disclosures for patentability and/or commercial value
- Acts as a liaison between the patent attorney and inventor
- Markets technology to potential licensees
- Participates in negotiating various agreements, licensing, collaboration, etc.

# Intellectual Property Strategist

- Sometimes requires business experience
- Law degree not required
- Helping to formulate IP strategies with respect to particular technologies
- Monitoring competitor activities
- Interactions with business people and legal department in corporation



# Searcher

- Does patentability and/or freedom of operation searches in patent and literature databases
- May work for a search firm such as Dialog or Derwent
- Have corporate in-house position as part of library or IP department
- Set up own search firm

# Patent Agent v. Patent Attorney

Patent Agent

Law Degree Not  
Required

Must Pass Patent Bar-  
Examination that tests  
knowledge regarding  
patent practice

Can draft and prosecute  
U.S. patent applications  
and direct prosecution of  
foreign patent  
applications

Cannot render legal  
opinions or draft  
agreements or represent  
client in court  
proceedings

Patent Attorney

Law Degree Required

Must Pass Patent Bar  
Examination

Can draft and prosecute  
U.S. patent applications  
and direct prosecution of  
foreign patent  
applications

Can render legal opinions  
or draft agreements or  
represent client in court  
proceedings

# Corporate v. Private Practice

## Corporate

May be restricted to a particular set of technologies

May oversee litigation

Opportunities for interaction with business people and to get big picture of a project

Opportunities for stock options and bonuses

Opportunities to participate in drafting and negotiating agreements

Reasonable working hours- may be some travel

## Private

Opportunity for exposure to a variety of technologies

Opportunity to participate in litigation

Only exposed to specific portions of a client's business

Higher base salaries- opportunity for partnership

Limited opportunities to participate in drafting agreements

Longer working hours

# Is Patent Law For You?

- Do you like to do library work?
- Do you like to write?
- Can you write fast?
- Can you deal with deadlines?
- Can you prioritize work that needs to be done?