



PACE LAW SCHOOL

P A C E U N I V E R S I T Y

A GUIDE TO CAREERS IN INTELLECTUAL PROPERTY LAW

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I. Introduction

Intellectual property lawyers combine their legal skills with other skills in technology, business, and the arts. Often a company's lifeblood is its ownership of intellectual property. The lawyer who understands the nature of an invention, as well as how it affects the client's business, will be best equipped to assist the client in protecting and managing the client's patent portfolio. Those who practice intellectual property law have a unique opportunity to be exposed to the cutting edge of research and development in many scientific and technical areas.

From the ABA Section on Intellectual Property, found at http://www.americanbar.org/groups/intellectual_property_law.html.

Intellectual property law (or "IP law") is one of the fastest growing areas of legal practice. Opportunities in IP law exist at law firms of all sizes, mid-to-large sized corporations, universities, the government, and public interest organizations. There is a demand for IP lawyers all over the country, including the New York area. However, if you are able to relocate geographically, the Washington, DC area – home of the U.S. Patent & Trademark Office ("USPTO"), the U.S. Copyright Office, and the Court of Appeals for the Federal Circuit – offers many career opportunities in IP law. In addition, areas with high concentrations of technically advanced companies, such as Silicon Valley in California, also tend to have a high demand for IP lawyers.

II. Types of Intellectual Property Law

IP law involves protecting intellectual creations including inventions, discoveries, original creative works such as music, plays, maps, computer programs and books, as well as brand names and other symbols that indicate the source of goods and services. IP includes patent law, copyright law, trademark law, and trade secret law, along with some other areas of law, including licensing and unfair competition. There is also a significant overlap with other practice areas such as computer law and sports and entertainment law.

Some IP lawyers may focus on one or two areas of IP law – particularly those who practice patent law, but many tend to practice these specialties together given the overlap between the various specialties.

A. Patent Law

Patents provide 20 years of protection to inventions that meet certain requirements. Legally, patents provide inventors with the right to exclude others from making, using, selling, offering for sale, or importing an invention.

Many patent lawyers specialize in preparing and obtaining ("prosecuting") patents before the USPTO. In order to prosecute patent applications, one must have a technical background (such as an undergraduate or graduate degree in engineering, biological or physical science) and pass the patent bar examination. After the patent is issued, a patent lawyer may be called upon to

investigate and develop licensing opportunities for the patented product or process, which involves drafting and negotiating license agreements that allow others to produce the invention, in exchange for appropriate compensation. Patent lawyers also protect their clients' property rights against potential infringers or misappropriators of the patented product or process, or defend their clients against accusations of infringement or misappropriation. Other IP lawyers—those without technical backgrounds—may get involved in the litigation of patent infringement cases.

Patent lawyers generally work at either law firms in patent or IP law departments, in-house at corporations, for government agencies such as the USPTO, or at universities.

B. Copyright Law

Copyrights protect original works of authorship, including literary works, paintings, films, and music. Copyright lawyers advise authors, artists, composers, filmmakers, and playwrights on their rights to their works, negotiate contracts protecting their clients' rights, and represent their clients in lawsuits enforcing their rights.

Copyright lawyers generally work at law firms of all sizes, in-house at corporations, for government agencies such as the U.S. Copyright Office, universities and not-for-profit organizations.

C. Trademark Law and Unfair Competition

Trademarks protect words, sounds, colors, or other symbols that are used to identify a source of goods or services. Owners of trademarks have the right to prevent others from using any mark that would cause confusion in the consumer's mind. A trademark owner is protected from trademark infringement.

Trademark lawyers work with clients on choosing a mark, clearing it for use, and registering the mark with the USPTO. Trademark lawyers also survey the marketplace for unauthorized use of the trademark, litigate against potential infringers or misappropriators, or defend their clients against accusations of infringement or misappropriation.

Trademark lawyers generally work at law firms of all sizes, in-house at corporations, for government agencies such as the USPTO, and universities.

D. Trade Secrets

Trade secrets are information that companies keep secret to give them an advantage over their competitors. The most famous trade secret is the recipe for *Coca-Cola*. Owners of trade secrets can protect against unauthorized use of the information by individuals who improperly acquire the information.

IP lawyers working on trade secret cases counsel their clients on how to keep confidential their trade secrets, and litigate when a trade secret has been improperly acquired.

E. Related Field: Computer Law

Computer law addresses the protection of hardware and software developed by a client. Depending on the type of programs, this may involve protection through patents, copyrights, trademarks and trade secrets. Attorneys practicing computer law often prepare and negotiate development agreements, software licensing agreements or hardware purchase agreements, and litigate matters growing out of these relationships.

F. Related Field: Sports & Entertainment Law

Sports and entertainment lawyers often have to deal with IP law issues. For example, sports and entertainment lawyers working on the distribution of a film or an album need to understand copyright and trademark issues that may come up. Sports and entertainment lawyers who represent rock bands, theater companies or orchestras may also need to be familiar with the law and procedure for seizing counterfeit items (such as t-shirts and merchandise) at concerts and performances.

III. Career Opportunities

IP lawyers usually focus on one of two areas of IP law: litigation or prosecution/transactional work. IP litigation does not vastly differ from other types of litigation, but some attorneys are particularly drawn to the subject matter. Prosecution/transactional IP work includes obtaining IP rights (patent, trademark, copyright) through registration with the proper agency such as the USPTO or U.S. Copyright Office; negotiating and drafting IP license agreements; conducting searches to determine if certain IP rights have previously been claimed by others; and determining whether a mark, book, song, Web page, or other publication infringes on another's IP rights.

For experience in both IP litigation and transactional work, consider working at a law firm. If you choose to work in-house at a corporation or join the USPTO as an examiner, your practice may focus on prosecution and transactional work.

A. Private Sector

1. Law Firms

Many law firms throughout the U.S. specialize in intellectual property law. In addition, many large general practice firms have IP law departments. Mid-to-large law firms generally have a wide variety of clients and practice IP law across a wide spectrum of technologies. To accommodate these diverse needs, many law firms with large IP practices hire attorneys with varied technical backgrounds. Law firms tend to handle their client's IP litigation because the litigation expertise and necessary personnel are usually not available within a corporate legal department.

Large law firms are likely to expose associates to a broad range of IP law issues. Depending on how the IP department is organized, many associates at large law firms have the opportunity to handle litigation, prosecution, and transactional work. Large law firms tend to have many and large clients, and a wide range of work.

Lawyers at firms with small IP practices or boutique firms are less likely to have large corporate clients, and more likely to work with artists, writers, filmmakers, and other creative types who may be unable to afford the fees of larger firms. Small law firms tend to handle somewhat different types of IP matters than larger firms, including libel reads, literary contracts, trademark searches, and trademark clearance.

Here is a list of some representative tri-state area firms that specialize in IP law:

Buchanan Ingersoll & Rooney	www.bipc.com
Collen IP	www.collenip.com
Colucci & Umans	www.colucci-umans.com
Fincham Downs	www.finchamdowns.com
Dugan & Dugan P.C.	http://www.duganpatent.com
Fish & Richardson	www.fr.com
Fitzpatrick Cella	http://www.fitzpatrickcella.com
Frommer Lawrence Haug	www.flhlaw.com
Kelleher Patent Law	http://kelleherpatentlaw.com
Kenyon & Kenyon LLP	http://kenyon.com/
Lackenbach Siegel LLP	http://www.lackenbachsiegel.com/
Leason Ellis	http://leasonellis.com
Lerner David	www.ldlkm.com/index.asp
Merchant & Gould	www.merchantgould.com/
Sughrue Mion	www.sughrue.com/

The following resources may be useful to find out about additional law firms with IP practices:

http://law.lclark.edu/student_groups/intellectual_property_student_organization/ip_firm_list.php
<http://www.iptoday.com/issues/2014/03/top-patent-firms.asp> (Top patent firms)
<http://www.iptoday.com/issues/2014/05/top-trademark-firms.asp> (Top trademark firms)
www.martindale.com (Martindale Hubbell)
www.nalpdirectory.com (NALP Directory)
www.vault.com (Vault)
www.lawschool.westlaw.com (Go to “Career Prep”)

To find contact information for attorneys and agents with licenses to practice before the US Patent and Trademark Office, go to:

<https://oedci.uspto.gov/OEDCI/>

2. Corporations

Many corporations hire IP lawyers as in-house counsel. In-house lawyers usually develop an expertise in the corporation's technology, and may be involved in business decisions relating to the protection of the intellectual property. In-house IP lawyers often collaborate with attorneys in law firms on litigation or other matters that are referred out-of-house for purposes of obtaining additional assistance or expertise.

The type and variety of corporate IP work varies greatly by the type and size of the company. Larger high-tech corporations, such as pharmaceutical or computer companies, often have a staff of IP lawyers drafting and prosecuting patent applications. Publishers and record labels often have lawyers on staff who specialize in copyright law. Companies involved in marketing consumer products generally have in-house lawyers who handle trademark matters. Regardless of the type of business, corporate IP work tends to be fairly focused, because the lawyer has only one client, the corporation.

The following resources may be useful to find out about opportunities at corporations:

www.acc.com (Association of Corporate Counsel)

www.aipla.org (American Intellectual Property Law Association)

<http://www.iptoday.com/issues/2012/07/corporate-patent-scorecard.asp> (Corporate patent scorecard)

B. Public Sector

1. Government

The federal government employs numerous IP lawyers within its different agencies. The USPTO, part of the Department of Commerce, is the principal federal government employer of IP lawyers. Although the patent examiners who review patent applications are only required to have technical backgrounds, some have law degrees as well. The trademark examiners employed by the USPTO to review trademark applications are required to have a law degree. IP lawyers are also employed in other administrative areas within the USPTO.

Other departments of the federal government employ IP lawyers as well. The Department of Commerce (www.commerce.gov) employs IP lawyers to assist in matters involving international trade. IP lawyers who work in the Department of Defense (www.defenselink.mil), the Department of the Interior (www.doi.gov), and the Department of Energy (www.energy.gov) may prepare patent applications and be involved in administering and negotiating rights to inventions made pursuant to government contracts. The U.S. Copyright Office (www.copyright.gov) hires IP lawyers in various capacities. The Department of Justice (www.justice.gov) hires IP lawyers to represent the government when IP law matters are litigated on behalf of government agencies.

Opportunities exist in the court system as well. The U.S. Court of Appeals for the Federal Circuit in Washington, DC hears appeals in cases involving patents from federal courts around the country, and from the USPTO.

a. United States Patent & Trademark Office (USPTO)

The USPTO is the only federal agency responsible for granting patents and registering trademarks. Within the USPTO, there are patent and trademark positions. Patent examiners review patent applications to determine if they comply with basic rules and legal requirements. Although a law degree is not required for patent examiners, many examiners have one. The majority of the attorneys who work for the USPTO work within the Trademark Examining Organization (TMEO), which consists of 17 separate law offices, each with approximately 25 attorneys. The Trademark Office, which employs approximately 400 attorneys, offers an opportunity to practice trademark law. The work is challenging and attorneys are afforded schedule flexibility.

For more information on the USPTO, go to: www.uspto.gov

b. Federal Communications Commission (FCC)

The FCC regulates interstate and international communications by radio, television, wire, satellite and cable. The FCC's jurisdiction covers the fifty states, the District of Columbia, and U.S. territories. The Office of General Counsel of the FCC serves as the chief legal advisor to the FCC and to its various bureaus and offices. The General Counsel also represents the FCC in litigation in federal courts, recommends decisions in adjudicatory matters before the FCC, assists the FCC in its decision making capacity and performs a variety of legal functions regarding internal and other administrative matters.

For more information on the FCC, go to: www.fcc.gov

c. Judicial Internships & Clerkships

Law students who are interested in patent law should consider applying for a judicial internship or clerkship at the U.S. Court of Appeals for the Federal Circuit in Washington, DC. The Court hears appeals in cases involving patents from federal courts around the country, and from the USPTO.

Law students interested in judicial internships with the Court of Appeals for the Federal Circuit should write directly to the judges at least six months in advance of the time requested for an internship, and include a resume, transcript, writing sample and letters of recommendation. The cover letter should specify the time period for which the applicant is applying. Some judges are willing to take interns for brief periods of several months. The address of the Court of Appeals for the Federal Circuit is 717 Madison Place NW, Washington, DC 20439.

Law students interested in post-graduate judicial clerkships at the Court of Appeals for the Federal Circuit should apply through OSCAR, <https://oscar.symplicity.com/>.

The competition for federal clerkships is very stiff. Students who are considering applying for federal clerkships should be aware that significant legal writing experience and excellent

academic records are required. Law review or other journal experience is important to most federal judges.

If you are interested in applying for a judicial internship or clerkship, you should make an appointment with the Clerkship Advisor in the CCPD.

2. Colleges & Universities

Many colleges and universities employ IP lawyers, especially those college and universities with large research and development departments. IP lawyers at colleges and universities frequently work with the university's scientists and researchers in identifying inventions that may have commercial potential. While some colleges and universities handle patent prosecution themselves, many others work with outside law firms. The college's or university's IP lawyers will then work with outside counsel in the commercialization of the invention, transferring the patented technology through licensing or assignment.

From time to time, teaching jobs in IP law are available at law schools. A law professor has the opportunity to work with highly qualified and interested law students, as well as the opportunity to research and write articles on IP law issues. These positions are highly desirable and tend to be difficult to obtain. Successful applicants tend to have strong academic credentials, including law review or other journal experience, as well as experience practicing in the IP field.

The following resources may be useful to find out more about opportunities at colleges and universities:

<http://chronicle.com> (The Chronicle of Higher Education - Academic positions)

<http://law.academickeys.com> (AcademicKeys - Academic positions)

<http://www.saltlaw.org/employment/> (Society of American Law Teachers - Academic positions)

www.nacua.org (National Association of College & University Attorneys)

www.aals.org (Association of American Law Schools)

www.nalp.org (Go to "Jobs")

3. Non-Profit Organizations

There are many opportunities for those interested in practicing IP law in a non-profit setting. Although these positions are generally very desirable and competitive to obtain, you may wish to consider working for an arts institution such as a museum, art gallery, or theater company. Some public interest organizations, such as Volunteer Lawyers for the Arts (www.vlany.org), provide *pro bono* and low cost legal services to members of the arts community. Other organizations to look into include The Electronic Frontier Foundation (www.eff.org), The Electronic Privacy Information Center (<http://epic.org/>), and Creative Commons (<http://creativecommons.org/>).

The following resources may be useful to find out more about opportunities and organizations in non-profit settings:

www.psjd.org (PSJD)

www.idealists.org (Idealist; see "Jobs" to search job postings)

www.equaljusticeworks.org (Equal Justice Works)
www.nonprofitcareer.com (Go to “Search Nonprofit Jobs”)
www.opportunityknocks.org/ (Go to “Job Seekers,” then “Search Jobs”)

D. International

If you are interested in pursuing a career in international IP law, you should consider law firms with international IP practices, as well as non-governmental agencies and other international organizations such as:

Chartered Institute for Patent Attorneys (CIPA) www.cipa.org.uk

Institute of Professional Representatives before the European Patent Office (EPI)
www.patentepi.com

Institute of Trademark Attorneys (ITMA) www.itma.org.uk

International Association for the Protection of Intellectual Property (AIPPI) www.aippi.org

International Intellectual Property Institute (IPI) <http://www.iipi.org>

International Trade Centre (ITC) www.intracen.org/

International Trade Administration (ITA) <http://trade.gov/index.asp>

IP @ The National Academy of Sciences (NAS)
[http://sites.nationalacademies.org/PGA/step/IPManagement/ /](http://sites.nationalacademies.org/PGA/step/IPManagement/)

Japan Intellectual Property Association (JIPA) www.jpaa.or.jp/?cat=546

Japan Patent Attorneys Association (JPAA) www.jpaa.or.jp/english/

Office of the United States Trade Representatives (USTR) www.ustr.gov/

Trilateral Cooperation (European Patent Office – Japan Patent Office – USPTO)

www.trilateral.net/

World Intellectual Property Organization (WIPO) www.wipo.int/portal/index.html.en

World Customs Organization (WCO) www.wcoomd.org

World Trade Organization (WTO) www.wto.org

The following resources may be helpful in researching other international IP opportunities:

www.chambersandpartners.com (Search for international law firms by practice area)

www.internationaljobs.org (International Career Employment Weekly)

www.lawgazettejobs.co.uk/content_static/home.asp (Publication of Law Society of Wales & England; features online job searches)

IV. Patent Bar Examination

In order to practice patent law before the USPTO, you must become a registered patent agent. In order to become a registered patent agent, you must take and pass the patent bar examination (officially, the Examination for Registration to Practice in Patent Cases Before the U.S. Patent and Trademark Office).

You are only eligible to sit for the patent bar examination if you have a scientific education background; you do not actually need any legal training to take the exam. When you apply to take the exam, you will need to provide an official transcript showing that you received a Bachelor's degree in one of the following subjects by an accredited United States college or university, or that the equivalent to a Bachelor's degree was awarded by a foreign university in one of the following subjects:

Science Degrees	Engineering Degrees
Biology	Aeronautical Engineering
Biochemistry	Agricultural Engineering
Botany	Biomedical Engineering
Computer Science	Ceramic Engineering
Electronics Technology	Chemical Engineering
Food Technology	Civil Engineering
General Chemistry	Computer Engineering
Marine Technology	Electrical Engineering
Microbiology	Electrochemical Engineering
Molecular Biology	Engineering Physics
Organic Chemistry	General Engineering
Pharmacology	Geological Engineering
Physics	Industrial Engineering
Textile Technology	Mechanical Engineering
	Metallurgical Engineering
	Mining Engineering
	Nuclear Engineering
	Petroleum Engineering

Many students who sit for the patent bar exam take a bar review course. The Practicing Law Institute (New York City), the Patent Resources Group (Washington, DC), and John Marshall School of Law (Chicago) are among those that offer review courses. Another method of

preparing for the patent bar exam is through actual work experience at a patent law firm or the patent law division of a corporation.

For more information on the patent bar examination, see the USPTO's official site:
<http://www.uspto.gov/go/dcom/olia/oed/examregist.htm>

V. **Career Fairs**

Career fairs are a great way to interview with prospective employers and find out about opportunities in IP law.

A. **Loyola University Chicago School of Law Patent Interview Program, Chicago, IL**

Loyola University Chicago School of Law hosts a Patent Law Interview Program every July or August in Chicago, Illinois. This is a nationwide interview program that targets patent law employers, rising 2L and 3L students, and students in Intellectual Property LL.M. programs.

Roughly 100 employers, 180 law schools, and 1,600 law students participate in the program annually. The program is entirely pre-selected, which means that students submit resumes and bid on interviews with the employers they are interested in, and employers then review the resumes of the students who bid on them and select the students they wish to interview at the program. Last year, less than half of the participating students were selected for interviews, but many students were selected for multiple interviews.

Students with undergraduate or graduate degrees in engineering or a technical science should consider registering for the program. You do not need to be patent bar eligible to register, although the vast majority of employers participating in the program are seeking patent bar eligible students. For more information on the program, please refer to the program website at http://www.luc.edu/law/career/patent_students.html.

Online student registration for the Patent Law Interview Program typically opens in mid-February and closes in early March. Our school is listed alphabetically as Pace University School of Law on the registration form's drop down menu of law schools. There is a non-refundable \$35 registration fee which you must pay by credit card to complete your online registration.

B. **San Francisco Intellectual Property Law Association Career Fair, San Francisco, CA**

This Fair is held every July or August in San Francisco, CA. Registration is available in May, and the registration deadline is in June. Membership in the San Francisco Intellectual Property Law Association (SFIPLA) is required; however, you do not need to be a resident of the San Francisco area in order to become a member. For information on membership and the career fair, go to <http://www.sfipla.com/job.html>.

VI. Bar Associations and Other Professional Organizations

If you are considering a career in IP law, you should join organizations like the International Trademark Association (INTA), the Copyright Society of the USA, the American Intellectual Property Law Association (AIPLA), and your local bar association's IP committee. By joining professional organizations, you will demonstrate your interest in and commitment to the IP field, add to your knowledge of IP law, and develop networking opportunities.

www.inta.org/ (International Trademark Association)
www.csusa.org/ (The Copyright Society of the USA)
www.aipla.org (American Intellectual Property Lawyers Association)
www.americanbar.org (American Bar Association)
www.nysba.org (New York State Bar Association)
www.nycbar.org (The Association of the Bar of the City of New York)
www.wcbany.org (Westchester County Bar Association)
www.wwbany.org (Westchester Women's Bar Association)
www.fedbar.org (Federal Bar Association)

You should also consider getting involved with Pace Law School's **Intellectual Property Student Organization** (IPSO).

In addition, you should become familiar with IP trade journals and websites to keep up-to-speed on new issues in IP law.

www.jptos.org (Journal of the Patent and Trademark Office Society)
www.iptoday.com (Intellectual Property Today magazine)
www.iplb.org/ (University of San Francisco Intellectual Property Law Bulletin)
www.intelproplaw.com/ (Intellectual Property Law Server)
www.ipwatchdog.com (IP Watchdog)

Another valuable report to read: <http://www.gao.gov/new.items/d10423.pdf>