BEST KEPT CAREER SECRET FOR SCIENTISTS AND ENGINEERS: PATENT LAW
In technological and scientific endeavors, the top prizes go to the pioneers. Engineers, scientists, and programmers burn the midnight oil to find path-breaking approaches to technical challenges. Executives strive to be first to market with products that dominate the competition. Protecting the insights that result from these efforts requires a forward-thinking patent prosecution legal team, including highly skilled and motivated scientific analysts, patent agents, and patent attorneys.

Patent prosecutors always begin their professional careers as scientists and engineers. It is the rare patent prosecutor who began his/her scientific training with an eye toward the law. They are individuals who yearn to be on the cutting edge of technology, and want to constantly learn about and influence new innovations. The pursuit of a career in patent prosecution as a scientific analyst or patent agent requires a strong scientific and technical background. Notably, it does not require a law degree. Most often, and depending upon the technologies involved, these positions require training at the Ph.D. level. In other situations, an M.S. or B.S. and significant scientific or legal experience will suffice.
Examples of scientific and technical backgrounds of patent prosecutors (scientific analysts, patent agents, patent attorneys):

- Agricultural Technology
- Biochemistry
- Bioinformatics
- Biophysics
- Chemistry
- Computer Engineering
- Computer Science
- Electrical Engineering
- Genomics
- Immunology
- Inorganic Chemistry
- Materials Science
- Medicinal Chemistry
- Medicine
- Molecular and Cell Biology
- Nanotechnology
- Organic Chemistry
- Pharmaceuticals
- Physics
- Polymer Chemistry
- Proteomics
- Semiconductor Design
- Semiconductors
- Stem Cell Technology
As a scientific analyst or patent agent, you will be part of a larger team of scientific analysts, paralegals, patent agents, patent attorneys, patent litigators, and attorneys from other practice groups within the firm. In addition, scientific analysts and patent agents work directly with clients, particularly inventors. You will also work with technical experts, in-house scientists, technology transfer administrators, in-house patent practitioners, and the attorneys of client companies.

A collaborative personality and the desire to work as part of a team are essential.
Successful scientific analysts and patent agents possess the following skills and traits:

- Acute attention to detail
- Highly analytical and organized thinking
- Proactive/self-starter capabilities
- Strong oral and written communication skills
- Desire to work as part of a team
- Collaborative personality
- Problem-solving abilities
- Proactive/self-starter capabilities
Scientific analysts and patent agents work with patent attorneys to provide technical and legal research and analysis with respect to matters pending before the U.S. Patent and Trademark Office. They also provide technical support for patent interference and litigation proceedings, as well as assistance in planning strategies for clients’ patent portfolios.

**Additional job functions may include:**

- Participating in domestic and foreign patent prosecution
- Planning, completing, and interpreting literature searches using online databases and other search techniques
- Reviewing and analyzing technical documents such as prior art, laboratory notebooks, technical memoranda, deposition transcripts, and file histories
- Locating and interviewing technical experts, consultants, and expert witnesses
- Advising and educating firm litigators in the relevant areas of science and technology
If you are interested in a career in patent prosecution, you should take the following steps:

1. Complete your degree in your chosen scientific/technical area

2. Attend on-campus informational seminars given by patent attorneys and patent agents

3. Request informational interviews with patent attorneys, patent agents, and scientific analysts

4. Audit a patent law course at a law school

5. Become a registered patent agent with the USPTO

Please contact your career center or Morrison & Foerster LLP if you would like to learn more about a career in patent prosecution.

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