



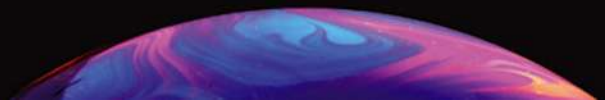
Intellectual Property:
Release its potential

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A Career as a Patent Attorney

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My Career



- 1999-2003 1st Class Degree in Chemistry, Oxford University
- 2003-2006 DPhil in Organic Chemistry, Oxford University
(supervisor: Jeremy Robertson)
- 2006-2007 Post-Doctoral Research Assistant, École
Polytechnique, near Paris (supervisor: Samir Zard)
- 2008-2010 Post-Doctoral Research Fellow, University of York
(supervisor: Paul Clarke)
- 2010-2013 Trainee Patent Attorney, HGF Leeds
- 2013 - today Patent Attorney, HGF Leeds

Qualified as a Chartered Patent Attorney in 2013 and qualified as a European Patent Attorney in 2014



What is a Patent Attorney?



A lawyer with a scientific background who specialises in the field of patents (and other intellectual property)

- entry requirement - at least a 2.1 BSc in a technical or scientific discipline
- most attorneys have no previous legal experience
- private practice or in-house

Lord Hoffmann*:

“...translation of the language of science and technology into the language of law that judges can understand...”

[*at CIPA president’s dinner; 2006]



What is a patent?

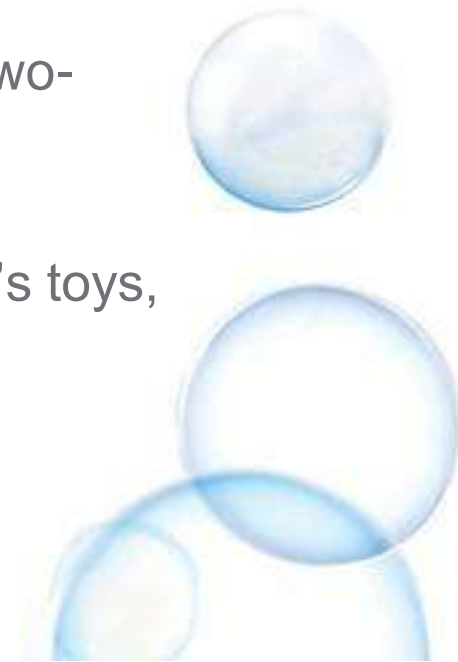


A patent is a monopoly over an invention which is granted by the state for a limited term

The invention and the extent of the monopoly is described in a published document

Patents can be granted for a wide range of technologies:

- I mostly work on: drug molecules, pharmaceutical formulations, synthetic processes, graphene and other two-dimensional materials, green technologies
- but I have also worked on: camping equipment, children's toys, bike locks



What is a patent?



To be granted/enforced a patent must be:

- novel, i.e. never previously disclosed to the public
- inventive, i.e. not obvious in light of what has been previously disclosed to the public



Typical work – Advising a client



We advise clients on:

- how to protect their innovations using patents
- how to use their patents
- how other people's patents affect their business
- what to do about other people's patents
- whether to buy or license other people's patents



Typical work – Advising a client



You must understand:

- the science/technology
- the law
- the commercial situation

and then... find the best solution for the client

Skills and Abilities

- Common sense / empathy
- Problem solving
- Communicate complex ideas both orally and in writing
- Ability to influence



Typical work - Drafting



- Talk to the inventors to understand how their new ideas work
- Define and describe the invention as clearly as possible
- Advise on filing strategy

Skills and Abilities

- Quickly gain understanding of the science behind the invention
- Excellent written communication skills and use of language
- Legal understanding



Typical work – Getting it granted



- Review previous published documents
- Present arguments to patent office examiners – in writing, by telephone and in formal hearings

Skills and Abilities

- Analytical skills/attention to detail
- Oral and written communication skills - advocacy
- Problem solving
- Negotiation



Typical work – Oppositions



- Attack or defend
- Review previous published documents and file histories
- Present arguments to patent office examiners – in writing and in formal adversarial hearings

Skills and Abilities

- Strategic thinking
- Think clearly in high pressure fast moving situations
- Assimilate large volumes of material and identify key issues



Pros of the job



The opportunity to gain new skills, such as legal skills, whilst retaining contact with science

- Every day is different - there is a large variety of work
- Client facing - working with a wide range of people
- Working at the cutting edge of technology
- Financially rewarding
- Intellectually stimulating



Cons of the job



- Lots of exams!

8 final exams to qualify in the UK and Europe plus foundation exams, university courses and pre-qualification.

It takes at least 3.5 years to qualify!

- Deadlines, responsibility for valuable patents
- Entry is competitive – a small profession – around 100-140 entrants each year in the UK



Resources



Chartered Institute of Patent Attorneys (CIPA)

www.cipa.org.uk/pages/home

Institute of Professional Representatives before the European Patent Office (EPI)

<http://www.patentepi.com>

Intellectual Property Regulation Board (IPREG)

<http://ipreg.org.uk/>

UK Intellectual Property Office (UKIPO)

www.ipo.gov.uk/home.htm

HGF Intellectual Property Specialists

www.hgf.com





Any Questions?

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HGF Intellectual Property Specialists

