

# A day in the life of a Patent Attorney



Steve Cuss is a trainee patent attorney in Chemical and Life Sciences. He graduated from the University of Oxford with a Master's degree in Molecular and Cellular Biochemistry. Steve completed a PhD in Infection and Immunity at the University of Cambridge, followed by a period as a visiting researcher at the University of York. After this, he worked for the US National Institutes of Health researching cancer-targeted immunotherapeutics.

## How did you get into your current job?

I was a postdoc in the US and I decided I would like to be a Patent Attorney. Not many jobs were being advertised in the UK for people with a biotech background, but I applied to all that I could find. I then fired off a speculative covering letter and CV to every other patent firm for which I could find the details. The job I eventually accepted resulted from one of the speculative applications. So a fairly traditional application process.

## Can you describe a typical day?

Basically Patent Attorneys handle every aspect of the patenting process, for instance: talking to an inventor with an idea, drafting patent applications, going back-and-forth with patent offices around the world (via our foreign associates for other jurisdictions) in order to get the patent application into a place where the patent office is willing to grant it (called prosecution), and opposing other people's patents if we think that they should not have been granted.

Prosecution makes up a bigger chunk of the day than people normally expect. A typical day might involve receiving an examination report about a patent application that we have already filed. These reports normally contain objections from the examiner; for instance, the examiner might not have fully understood the true nature of the invention and so might refuse to grant the patent on the basis that the invention seems obvious. In which case I would have to make sure that I understand the invention properly myself and why it would not be obvious over anything that has gone before, and then write a letter trying to convince the examiner to change their mind. Often we need to compromise, and so we can narrow the scope of what the patent is seeking to protect. That makes it easier to argue that the invention is not obvious, as you can narrow to only claim the invention in a form where it will be working really well, but still make sure the patent



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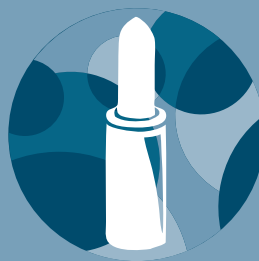
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would fairly protect the client's invention. It's important not to go too narrow, as then a competitor might make a product that maybe isn't quite as good as our client's, but which steals the inventive concept and could compete). Thinking about the best way to strike this balance is a big part of the job. In all of this, of course, you have to involve the client and make sure they're happy with everything. The extent to which the client gets involved varies widely, some like to participate closely, others just want us to handle matters for them.

I'm still a trainee and so I assist a qualified attorney rather than do things alone. To qualify you need to pass exams which require you to know the law (so the typical day involves some studying if I can fit it in) and to be able to demonstrate the necessary skills (which should be possible to pick up while doing the day job).

### What type of skills are needed in your job?

You need to be able to think very carefully and logically, and to be able to formulate arguments in a fairly specific manner. It's also very important to be able to read and understand quite dense technical literature, and so a scientific background is an absolute requirement. You have to be able to interact with the clients, inventors, patent examiners, and so good communication skills would be a big advantage.

### What do most people not realize about your job?

I think most people don't really know what a Patent Attorney is! So I guess my answer would be "that the job exists".

### What is the most useful advice you've been given in your career?

I've been lucky enough to receive a fair bit of career advice. I think the best advice was probably to be proactive, prepare fully, and actively seek opportunities. ■

**'A day in the life of a Patent Attorney' is the first in a new series of articles exploring career paths in biochemistry and molecular biology. Check out the next issue for the next article in this series.**

### Job Profile – Patent attorney

A Patent Attorney is a professional who investigates if inventions are new and suitable to be patented. An expert in intellectual property law, he/she analyzes technical documents and drafts detailed descriptions of novel inventions to file a patent application.

### Responsibilities

Responsibilities include consulting inventors to discuss their ideas, examining scientific documents, drafting and applying for patents, conducting litigations and defending or enforcing existing patents.

### Qualifications

A degree in science or another technical subject is essential and most Patent Attorneys have postgraduate qualifications, such as PhDs. After being hired as a trainee, it is necessary to complete on-the-job training and pass professional examinations to be included in the Register of Patent Attorneys.

### Career development

Patent Attorneys can become partners in the firm in which they work, progress to managerial positions, carry out freelancing work and even set up their own patent agency.



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