

Can Experience as a Patent Prosecutor Benefit a New Attorney?

By Harrison Barnes from Los Angeles Office Managing Director

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Before entering law school next fall, I will have a year of high-tech patent prosecution experience as a patent engineer. How much will this experience benefit me when seeking an IP/Patent associate position with the big firms? Can it make up for not being at the top of my law school class or not being from a top 25 law school?

Your experience as a high-tech patent prosecutor will certainly strengthen your application and should compensate for the fact that you have not graduated from a top 25 law school or at the top of your law school class. [Patent prosecution attorneys are typically in high demand](#), and the pool of attorneys with the appropriate technical background is small. Your background will likely make you eligible to sit for and increase your chances of successfully completing the Patent Bar.

Attorneys with scientific undergraduate or graduate degrees are highly in demand in the Intellectual Property arena. Moreover, attorneys with technical expertise in certain scientific fields are far more likely to obtain employment as a patent attorney than those without such expertise. As a result, the pool of potential candidates for patent positions is particularly small. To top that off, your technical experience as a patent engineer will provide you with the technical know-how to understand the technical intricacies of patent prosecution, infringement and negotiating and drafting tech-related licensing agreements and briefs. This puts you at an advantage over many of your law school classmates.

While there are certainly differences that could be pointed out, for the most part the expertise of [patent attorneys](#) falls into the following categories: (1) the life sciences, (2) chemistry & pharmaceutical, (3) material science, (4) electrical engineering, (5) physics, (6) mechanical engineering, (7) medical devices, (8) computer science. [In terms of demand, the greatest demand is for attorneys with backgrounds in electrical engineering or computer science. There is also a strong demand for attorneys with biotechnology, biochemistry or organic chemistry backgrounds.](#) The lesser demand is for those with mechanical or chemical backgrounds.

The fact that you appear to have both a technical degree and a patent prosecution background, when coupled with a law degree, makes you a unique and highly desirable candidate for law firms. While there are certainly many people who graduate each year with technical and science degrees, very few of these people may have any interest in attending law school because there is usually a good market available for these individuals, even without a law degree. Therefore, you will be a fairly unusual commodity with a law degree. Additionally, the demand for patent attorneys is compounded by the fact that the need for patents has continually increased dramatically. For example, a recent article in the *Legal Times* stated that the number of patents issued each year has increased 30-40% since 1990. During the same period of time, the number of software patents increased by approximately 200%.

It is important to mention, one of the reasons your background is valuable is that it makes you eligible to sit for the Patent Bar. In order to even sit for [the Patent Bar](#), an applicant needs prior scientific or technical level training at the Bachelor's degree level in a science or engineering field (or significant college credits in one of these fields). Assuming you have the requisite training to qualify to take the Patent Bar, you must also pass it, and the pass rate for the [patent bar exam](#) is much lower than for most bar exams - [it typically ranges from 28% to 40%.](#) [In the 1996 exam, for example, 968 people passed, and 1794 failed.](#) Your engineering

background and prior patent prosecution background will certainly help your chances of completing the exam successfully. Once you [pass the Patent Bar](#), you will have all the elements in place to have a successful law firm career.

I did notice that your question assumes that you will not be at the top of your class in law school, even though you haven't started. Although you will likely be a marketable attorney, graduating at or near the top of your class will dramatically improve your opportunities with top-tier firms. I strongly encourage you to focus on your performance in law school. Although you may still be quite successful without stellar grades, graduating at the bottom of your class may be a significant hurdle for your success, especially with respect to opportunities early on.

In conclusion, it seems as though you have all the pieces you need to begin law school and do well throughout your career. I recommend that you focus on your grades, and pay careful attention to the firms that have an Intellectual Property practice, especially those that offer summer associate internships. One of the best ways to make inroads with a firm is to take a summer associate position, so that you will be in the pool of law students from which they choose full-time associates. We wish you the best of luck!