

Inventing whole new careers, one patent at a time

IP firms turning to laboratories in talent search

By
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Byeongju – a.k.a. B.J. Park – knows how to shepherd an invention through the patent process.

In fact, he knew how to do

it before he became a patent agent at Garden City's Scully, Scott, Murphy & Presser, having undergone the drill more than a dozen times as an inventor. Park worked in research and development at IBM for more than a decade – obtaining 16 patents, with another dozen pending – before leaving in September to join Scully Scott.

"I know exactly what's in the mind of the inventor," he said. "The inventor comes up with this great idea. In a lot of cases, there's self-doubt: 'I invented something. Is this really usable?' You hope it becomes usable."

Now Park knows what's in the mind of the patent agent, too. Not exactly lawyers (patent agents can't argue in front of a judge), patent agents can file with the patent office, the steam-engine core of patent law.

Although law school is the most common path leading to this legal arena, patent law firms these days are finding representative as often in the laboratory as the law library.

"We really don't recruit, like a lot of firms do, by going to law schools, because we are such a specialty," said Scully Scott partner Paul Esatto. "There are generally very few students in each law school class that are interested in intellectual property or have the right background for it."

As IP law heats up, IP firms such as Scully Scott – which plans to bring on two more experts early this year – are finding tech law talent wherever they can. John

Vodopia, an electrical and computer engineer, joined the firm as an associate in 2006 after working for Philips Electronics.

"It's a combination of people out of other firms, people out of law school and ... engineers or scientists who have been working in those fields," Esatto said.

Scientists sometimes make the leap to law, as Park did, after watching the process develop around their own work. "Maybe they're named as an inventor on work

office, although you can't practice law in the courts.

Their previous professional life, whatever it was, often helps new patent agents find quick success. "I get a whole lot of cases from IBM," said Park.

Other researchers have gone back to law school to become licensed attorneys. Xiaochun Zhu, a biochemistry and molecular biology specialist, last year was named a partner at Scully Scott; she joined the firm in 1997 after serving as a postdoctoral fellow at the Dana Farber Cancer Institute, Harvard Medical School.

Zhu obtained the Chinese equivalent of a bachelor's degree in bioscience from Tsinghua University in China, then earned her doctorate in biochemistry from Brandeis University and her J.D., magna cum laude, from St. John's University School of Law.

"I like it, because I like writing," said Zhu. "This profession is a good combination of science and law."

Park decided to become a lawyer as a "a career decision," and stressed that "everybody should try to work on what he's actually best at."

"The reason any engineer or scientist goes into patent law is the same," said Esatto. "They

decide they want something a little more challenging intellectually than what they're doing in their present job."

But there's another good reason to jump from one career to the other: money.

"There is definitely a financial side about it, too," Park said. "The pay for the patent agent is a little higher than for the average engineer."

And then there's the issue of "the long-term job prospects," he added. "The useful lifetime of an engineer is not that long. New Ph.D.s come out with the most up-to-date information." ■

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SPECIAL AGENT: Former inventor B.J. Park has crafted a new career as a patent agent with Garden City's Scully, Scott, Murphy & Presser.

they're doing," Esatto said. "They come in contact with patent lawyers at the company. They decide they'd like to go on and do that and make a change."

There are many reasons scientists switch, but one key reason is the relative ease of transition: They don't need to pass the bar to launch a career in patent law, although some do take that route.

To become a patent attorney, you must pass at least one state bar. But to become a patent agent, like Park, you must only pass the United States Patent and Trademark Office exam. As an agent, you can apply for a patent or challenge patents before the patent