

Patently different

By: Bernadette Starzee April 15, 2015

While many lawyers have struggled to find a job in recent years, the road has been a little easier for patent attorneys.

These specialists – who assist clients in applying for patents and represent them in patent litigation – must have at least an undergraduate degree in a science, such as engineering, biology, chemistry, physics or computer science, in addition to their law degree, and they must pass the patent bar exam in addition to the bar exam that all lawyers take.

“It is a specialty, and it does require a certain background and training that a general practitioner doesn’t have,” said **Peter Bernstein**, a partner and executive committee member at Garden City intellectual property law firm **Scully, Scott, Murphy & Presser**. “It provides a layer of insulation in terms of marketability.”

Long Island law firms must compete for patent and other attorneys with their New York City counterparts, which typically offer higher salaries and a lifestyle that is more attractive to many young lawyers.

It’s most challenging for firms to find associate patent attorneys with three to five years of experience, according to Frank Sardone, the partner in charge of hiring at Melville IP law firm Carter, DeLuca, Farrell & Schmidt.

“By that point, they’ve already gone through a couple of years learning the business and understanding the process, and they’re ready to run,” he said. “But then everyone is looking for them.”

Still, intellectual property law firms like Hoffmann & Baron in Syosset have found it easier to recruit top talent in the patent field since the onset of the recession.

“We have had no difficulty finding attorneys in the last five or six years,” said Founding Partner Ronald Baron.

But hiring patent attorneys with certain areas of expertise is always challenging, said **Bernstein**, whose firm has found it difficult to secure attorneys with backgrounds in materials and life sciences.

Carter DeLuca is always on the hunt for attorneys with degrees in the “hard sciences or engineering,” Sardone said.

“Our clients are heavily into researching and developing competitive products to market, and they’re looking to interface with attorneys that have a solid understanding of engineering,” Sardone said.

On Long Island, manufacturing has taken a hit in recent years, with many regional firms shifting to fill niches, such as making high-end component products including those involving electronics and circuits. That has created a need for patent attorneys with electrical and other engineering backgrounds, said Frederick Dorchak, who leads Collard & Roe, an IP law firm in Roslyn.

But there is less call for patent attorneys with expertise in computer software.

“While several years back, there were a lot of patents filed for software and technology inventions, the U.S. Supreme Court has made it more difficult for inventors to get patent protection in this area,” said Baron, pointing to a landmark decision in *Alice Corp. v. CLS Bank International* in 2014 in which the high court ruled a software patent was invalid because the claims were tied to an abstract idea, and that implementing those claims on a computer were not enough to transform the idea into a patentable invention.

With chances of getting software patents reduced, there is generally less work for IP lawyers in that category. But while Carter DeLuca is filing fewer applications on behalf of software clients, it has seen increased work in advising firms in this category on modifications they can make to software-related inventions to improve their chances of getting a patent issued in light of recent decisions.

Other Supreme Court decisions have narrowed what is patentable in some areas of biotechnology, but a boon in biotech inventions and discovery work has led to increased assignments for patent lawyers in this area.

“Just about every biotech patent gets litigated, particularly in the drug field,” Dorchak said, noting that researching and developing drugs is very expensive.

“Pharmaceutical companies may investigate thousands of products for every drug that gets developed,” Dorchak said. “They then charge high prices for the drug to try to recoup the R&D costs. It’s in the generic houses’ interest to avoid paying the development costs by putting out a copy of a product and attacking the patent on grounds of validity.”

In addition to hiring patent attorneys, many IP law firms hire or consult with technical advisers or consultants with advanced science degrees.

Going forward, which patent area specialties will be in vogue is hard to predict.

“The changing tides of patent decisions and the investment that pharmaceutical and other firms make in R&D and new discoveries will dictate how the market evolves in the future,” **Bernstein** said. “The prospect for legislation to change the course of Supreme Court decisions is out there, and it frequently happens.”