

University of Texas MD Anderson Cancer Center Postdoctoral Association



Career Trajectories: Intellectual Property Law and Practice



Tuesday, August 26, 2008; noon – 1:00 p.m.



INSTITUTE FOR INTELLECTUAL PROPERTY & INFORMATION LAW
University of Houston Law Center
Houston, Texas 77204-6391

Greg R. Vetter

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The Description . . .

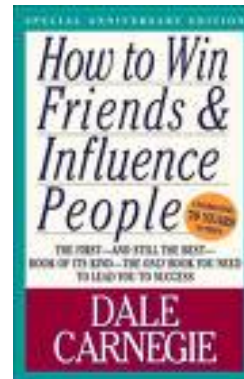
. . . bring[] a diverse perspective about the possibilities law school might provide to the career trajectory of a person with a background in engineering, science or technology (ES&T). With two technical degrees and two non-technical advanced degrees, [Vetter's] presentation draws from his work experience before law school as well as his legal practice before becoming a law professor. Intellectual property law, in particular patent law, provides, on the one hand, unique opportunities among lawyers. But, on the other hand, practicing intellectual property law has characteristics common to other areas of practice. As an educational asset, a law school degree provides broadening opportunities for an ES&T individual, but also provides opportunities, particularly within patent law, to work with technologies from one's core ES&T background or from other technological fields.

Resources . . . for later . . . part two



Resources . . . for later . . . part three

- Baylor Postdoc Career Development Workshop Series
 - <http://www.bcm.edu/pda/career/workshop.html>
 - Particularly the overheads posted by Scott F. Basinger



Lawyering . . . litigation & transactions & . . .

No. 03-038

In the Supreme Court of the United States

DETERMINED MARKETING COMPANY, INC.,
PETITIONER

v.

ASTORIAN EQUIPMENT MANUFACTURING COMPANY

ON PETITION FOR A WRIT OF HABEAS CORPUS
FROM THE SUPREME COURT OF OREGON
FILED FEBRUARY 13, 2007

BRIEF FOR THE UNITED STATES
AS AMICUS CURIAE

STEPHEN B. HUGHES
Attorney General
State of Oregon

ANDREW A. THAYER
Attorney General
State of Washington

ANDREW C. WOODWARD
Attorney General
State of California

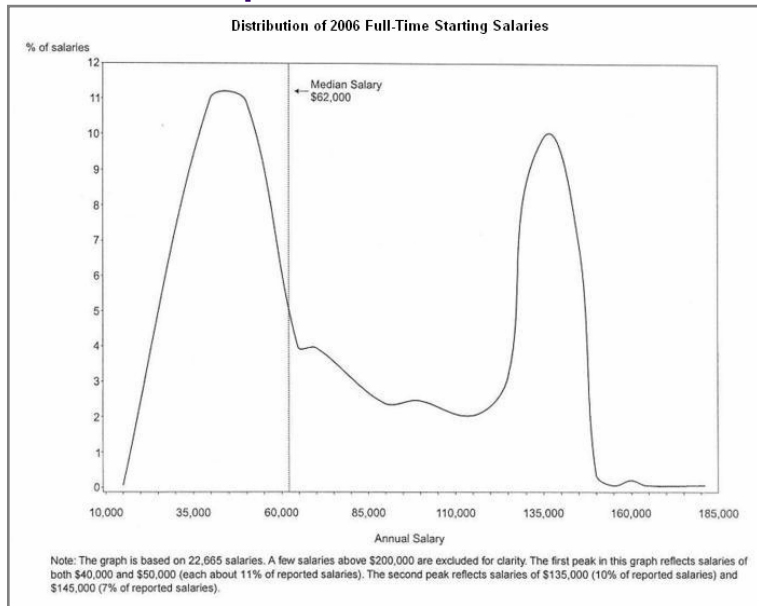
ANDREW J. STEINBERG
Attorney General
State of Montana

Largest US Web 2.0 Deals in 2007
Equity Deals in U.S. Venture-Backed Companies, 2007

Entity Name	Raised USD M
Facebook	\$240.00
Facebook	\$40.00
Ning	\$44.00
Metaweb Technologies	\$42.50
Zillow	\$30.00
Metacafe	\$30.00
i2N Commerce	\$30.00
Veoh Networks	\$25.00
MyStrands	\$25.00
Reunion.com	\$25.00
Fabrik	\$24.90
MyStrands	\$24.25
Eons	\$22.00
iHS Networks	\$20.00
Murphy	\$19.60

Career Trajectories: Intellectual Property Law and Practice, Prof. Greg R. Vetter, Aug. 2008

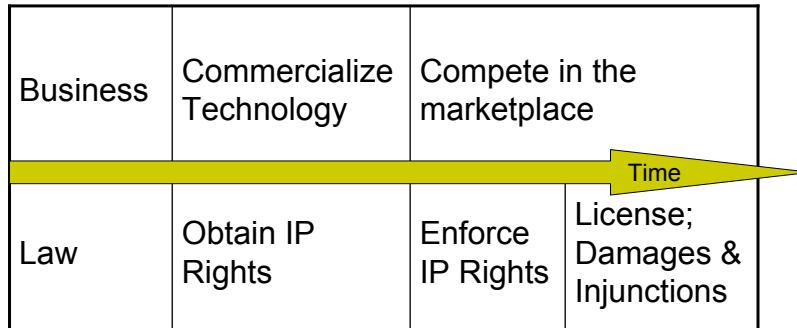
The economic part of the satisfaction mix . . .



http://www.elsblog.org/the_empirical_legal_stud/2007/09/distribution-of.html

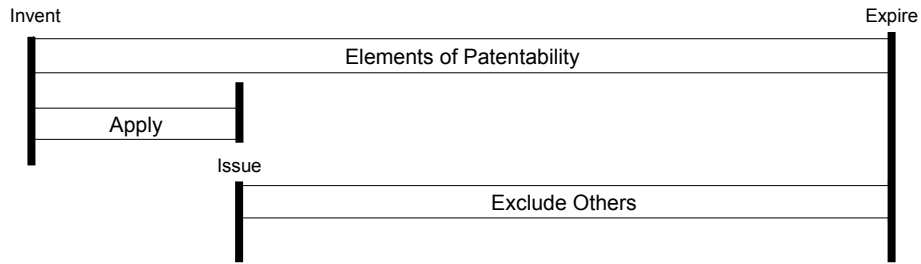


Business / IP Rights Life Cycle



The elements of Patentability

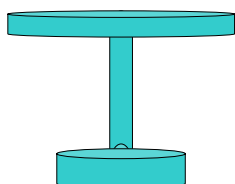
- **Patentable subject matter**, i.e., patent eligibility
- **Useful/utility** (operable and provides a tangible benefit)
- **New** (statutory bar, novelty, anticipation)
- **Nonobvious** (not readily within the ordinary skills of a competent artisan at the time the invention was made)
- **Specification requirements** (enablement, written description, best mode, definiteness)



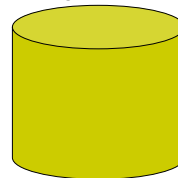
The Seating Marketplace



Competing Product



Existing Product



New Product



Patent – claims



Narrow

Broad

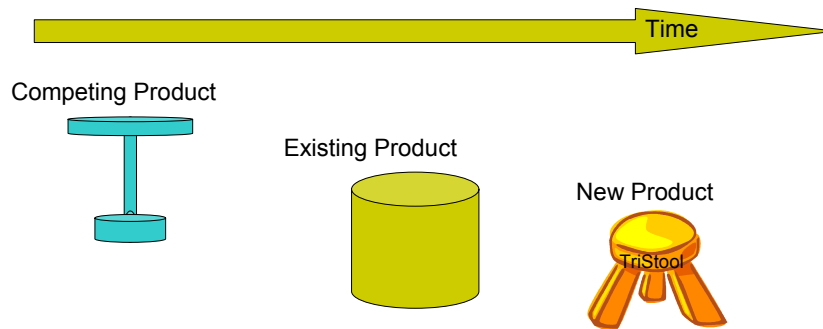
1. A **seating apparatus**, comprising:
 - (a) a horizontal **seat**; and
 - (b) three **legs** each having one end connected to the **bottom** of said horizontal **seat**.

1. A device for supporting objects, comprising:
 - (a) a horizontal support member; and
 - (b) three vertical support members each having one end connected to the same face of said horizontal support member.

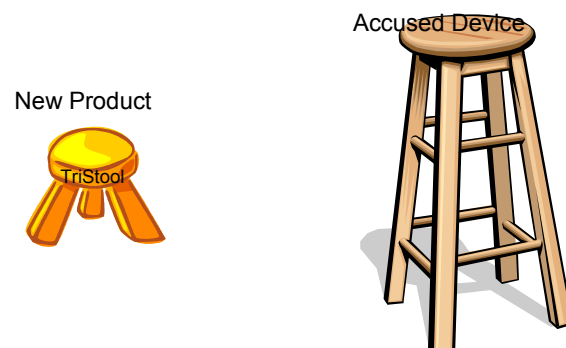
Patent - patentability

- patentable subject matter
- **novelty; utility; non-obviousness**
- specification support



- novelty:



Patent - infringement

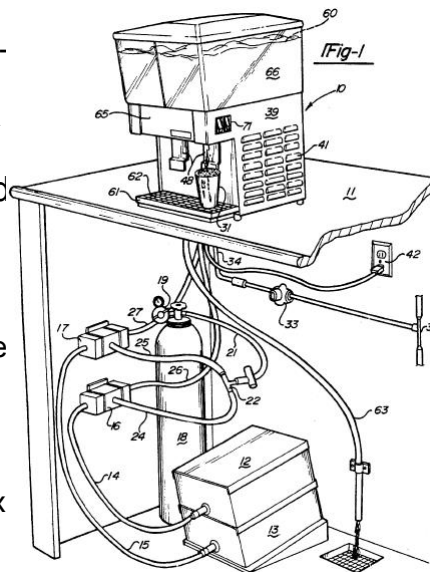


Basis for IP Rights

Option	Problem	→			Benefit	Cost
 No IP	Public good nature of info: -nonrivalrous -nonexcludable	Invest in R&D, create & sell product	Imitations sell at lower cost	May not be able to recover R&D costs	Getting info is "cost free"	Info under produced
 IP	Costs associated with limiting access to info	Invest in R&D, create & sell product	IP rights block imitators to some degree	Recoup R&D with (hopefully) a profit	Info is produced & supplied*	Limits to access of info, ↑ transaction costs

Utility

- Juicy Whip v. Orange Bang
- Juicy Whip's patent is for "post-mix" beverage dispenser that simulates the presentation of a "pre-mix" beverage dispenser
- District court held patent invalid
 - Purpose is to increase sales by deception
 - Other claimed usefulness (eliminating need to clean) is not independent of deceptive purpose and thus insufficient to raise a genuine issue of material fact
 - Improves prior art only by making the product more saleable
 - Is merely an imitation of a pre-mix dispenser
- Appellate Court reversal



Credentialing by area of IPIL practice (excluding Trade Secret)

- ☺ = only a state license is required

	Copyright	Trademark	Patent
Litigation	☺	☺	☺
Licensing	☺	☺	☺
Application*	(there is only a very minor volume of work in registering copyrighted works)	☺	"Patent Bar" exam required

* The process of applying for a patent before the US Patent and Trademark Office (PTO) is called "patent prosecution." This is practice before a Federal Administrative Agency and requires that one be a "Registered Patent Attorney."

- A special license is required to "prosecute patents" - which means that one must take the PTO's "Patent Bar" exam to do this.
- Whether one needs the credential of being a Registered Patent Attorney depends on a variety of factors, including general market conditions and the specific conditions in the area or niche of IP in which a student is interested.
- Sometimes large IP law firms prefer to hire patent bar eligible attorneys because such individuals can be more flexibly applied to service a variety of work.
 - For example, if trademark or licensing work is slow, the attorney could perhaps perform patent prosecution instead.
 - Or, the attorney may be perceived as more valuable in patent litigation due to the patent bar credential (although there are many great patent litigators who are not "Registered Patent Attorneys").
- In other employment situations, however, the patent bar credential carries little or no weight because the mixture of work available is more specialized and/or the patent bar credential is not significant within that employment market or community.

Conclusion

- Questions . . .

and

