



JOB PROFILE OF A PATENT PROFESSIONAL

In India, there are two types of patent professionals who can file and prosecute patents before the Indian Patent Office (IPO). The first, a "patent agent," registered with the IPO. The second, a "patent lawyer" or "patent attorney", has, in addition, earned a law degree and passed a bar exam, which allows him / her to represent clients in the courts. To become a patent agent you must possess a science / technical degree and pass the patent agent exam conducted by the IPO. In the event, that you possess a science / technical degree and have not passed the patent agent exam, you still can opt for a career in patent law and perform key tasks such as, searching, drafting of patent applications, drafting response to office actions, etc. You will be able to file and prosecute patents either after you clear the patent agent exam and / or earn a law degree from a recognized university.

As a patent professional your job is to meet clients to learn about their inventions and to clearly describe in writing how to make and use an invention, laying down claims for what makes it "novel" and "inventive" as set out in the Patent Act of the jurisdiction where you propose to file the patent application. This is not an easy task and requires a thorough understanding of science, the relevant patent laws and good writing and communication skills.

Before you begin to draft a patent application, you may be asked to assess the patentability of the subject invention, which involves identifying the relevant prior art by researching the patent literature, technical (patents owned by other companies) and scientific literature (published papers, articles, etc.). Based on this information retrieved, you will advise the client on whether the subject invention is useful, novel and nonobvious in light of the relevant prior art. The relevant prior art is also used while drafting the patent claims, i.e., by defining the scope of the invention in light of what is already known in the field. In addition to patent drafting, patent agent / associate are also involved in "prosecuting" pending patent applications

Prosecuting patent applications involves drafting response to several examination reports issued by the Patent Office rejecting the patent application. The drafting of response may involve narrowing the patent claims in order to distinguish the subject invention from the prior art identified by the Patent Examiner or provide arguments to emphasize and illustrate the patentability of the subject invention. The objective is to convince the Patent Examiner (at the Patent Office) that the subject invention is patentable. Here too, the knowledge of relevant sciences, patent law and good writing skills are essential.

Similar to patent agents, a patent attorney prepares, file and prosecute patent applications. In addition, a patent attorney / lawyer deals in enforcement of issued patents through litigation. For example, during the development of a new drug, the patent attorney may be involved to study the patents owned by other parties and advises the client regarding the scope and validity of these patents so that the client's drug development work avoids infringing on valid patents of all other parties. Patent attorneys, in addition to the law degree, must have the technical background to understand the inventions they are supporting.



As a patent professional you can find job opportunities in many settings, not just at law firms. Patent professionals work in corporate, knowledge process outsourcing companies, IP law firms, state and central governments (including Indian Patent Office), private institutes, and research organizations.

Working with a company, you are likely to specialize, as most companies are focused on a narrow area of science (i.e., therapeutic monoclonal antibodies). The objective to work with a company is to protect and expand the intellectual property assets of the company by filing new patent applications and protecting the existing ones.

As a patent professional working at a K/LPO, you will be involved in services related to searching, mining, analyzing, and managing patents and patent-related information for corporations and attorney firms around the world. Patent related off-shoring services to India have increased in recent years and companies are always looking to hire professionals with strong technical and patent skills.

IP Law Firms are an attractive option for both fresh and experienced technical professionals. People having advanced degrees in their core technical areas are often picked up by the Law Firms and offered lucrative jobs. These Law firms use a mix of lawyers and technical people to handle contentious and non-contentious cases before the Indian Patent Office and tribunals such as the Intellectual Property Appellate Board (IPAB). Cracking the Indian Patent Agent Exam is a must for only a Registered Patent Agent can appear before the Patent Office. Students who take professional help in equipping themselves with knowledge in Indian Patent Law as well as the Patent Cooperation Treaty definitely stand a better chance of qualifying the exam. Patent professionals without law degrees often assist patent lawyers in preparing a case, but only patent lawyers can represent a client in court.

On the other hand, as an Examiner at the Patent Office, you are involved in examining patent applications, understanding the technology described in the applications, and assess the state of the art (i.e., the science) to determine whether the proposed invention is new and nonobvious. As a Patent Examiner, you may be involved in evaluating a wide range of technology / patent application, but you will still have a specialty.

You can find jobs with institutions, such as a university or a research organization (say, CSIR). Here, you may get to work with a wider range of technologies, with patentable ideas emerging from disciplines as far apart as, say, mechanical and biotechnology. You may also get to evaluate the potential of research outcome and help identify companies that might be interested in licensing the technology.

The patent law field has numerous opportunities, and people with specific expertise have opportunities to move up. Future trends in field of patent law will require skills to monetize patents and help clients in buying, selling, licensing, cross licensing of patents. This is a common method for revenue generation from a patent portfolio that companies are pursuing at a growing rate. In such situations, patent professionals will be involved in negotiation of the terms and drafting of agreements.



Most scientists who become patent professionals are attracted by the prospect of staying close to cutting-edge science without being tied to the bench or to one particular project. Making the decision to switch to a career in patent law requires weighing and balancing many factors. But if you have the appropriate skills and enjoy analyzing and communicating about scientific innovations, patent law could be your ideal career.

If you wish to discuss how to launch your career in field of patents, write to us today at info@giipinfo.com or call us on +91-9310255571. We are here to happy to help you get a head start as a patent professional!