



## From Lab to Law

What comes after the laboratory work, the experiment design and re-design, and months and years of bench work? For many inventions, the completion of work in the laboratory marks the beginning of another stage in development: patent protection and possible commercialization.

A patent is a written document that gives legal rights to an invention. It is valuable because it allows the patent-holder to exclude others from making, using, selling, offering for sale, or importing the patented invention for a period of twenty years from the date the patent is filed. In many cases, the value of a particular product, or even an entire company, is defined primarily by the strength of the patents covering the product or owned by the company. Some patents, such as those protecting blockbuster pharmaceuticals, are valued in the billions of dollars.

Because patents, especially those in chemistry and biotechnology, can cover complicated scientific discoveries and principles, a patent practitioner may need specialized skills, and sometimes hold a masters or doctorate in the field of their practice. In addition to lawyers with a specialized background, many law firms, corporations, universities, and the government employ scientists with chemical and biotechnological experience to work on patent matters as technical advisors and patent examiners. Both lawyers and non-lawyers are eligible to take the patent bar exam for admission to practice before the United States Patent and Trademark Office (the “PTO”).

A patent practitioner can provide services including identifying patentable inventions and preparing and obtaining the patents, providing

legal advice, and litigating issues related to patents. In order to prosecute a patent application, a scientist or lawyer needs only to pass the patent bar exam and be admitted to practice before the PTO. On the other hand,

only attorneys licensed to practice law may provide legal advice and litigate patent issues; non-lawyers can assist attorneys in these areas.

The bedrock of patent law is the drafting and procurement of patents, termed “patent prosecution.” Many patent attorneys prosecute patents, as do most, if not all, technical advisors. Patent prosecution involves learning about

the invention and the related technology, usually from the inventor, and writing the patent application, which may be 50 pages or more. Patent applications usually include detailed explanations of the relevant science and specific experimental protocols and data

and an explanation of how the invention is novel and unobvious compared to prior inventions and publications in the field. After the application is prepared and filed with the PTO, the patent attorney or technical advisor negotiates with the PTO, ideally to obtain a patent that covers the intended invention. Patent prosecutors learn and write about cutting-edge science in a variety of areas, often long before public disclosure or publication, and they reap the rewards of working with

inventors and companies to see ideas transformed into valuable assets.

Patent attorneys also provide legal advice related to patents. This advice can include analysis of a patent to determine if it covers a certain product, if the patent is likely to be upheld if challenged in a lawsuit, and/or

**In many cases, the value of a particular product, or even an entire company, is defined primarily by the strength of the patents covering the product or owned by the company.**

**Patent applications usually include detailed explanations of the relevant science and specific experimental protocols and data and an explanation of how the invention is novel and unobvious compared to prior inventions and publications in the field.**

whether or not a particular product or method can be used without infringing on patents held by a third party. Patent attorneys work with clients to develop a strategy for protecting new and existing products, to evaluate publications and patent filings in a certain area of science, to prevent accidental loss of rights, such as where details of an invention are inadvertently presented or published prior to the filing of a patent application, and to develop internal procedures for memorializing inventive data and documents in case of future patent challenges. When a company or invention is bought or sold, or an invention is licensed, patent attorneys research and analyze the strength of existing patents or pending patent applications. Patent attorneys can also be instrumental in preparing and negotiating license agreements.

Patent attorneys often work on litigation concerning patent issues. Examples of such litigation may include a patent holder suing

an alleged infringer who is unlawfully making, using, or selling the patented invention, a dispute between two scientists who both believe they are inventors of a particular invention, or a controversy over alleged theft of an idea. In

addition to courtroom-related activities, litigation work often involves analyzing documents and working with scientists and other witnesses to piece together the history of an invention or idea.

Thus, once an invention is defined by scientists in the laboratory, the invention can enter the legal

arena, beginning with the filing of a patent application and potentially involving licensing, commercialization and even litigation. ■

—Amanda T. Barry  
*Mayer, Brown, Rowe & Mau, LLP*

**Patent attorneys work with clients to develop a strategy for protecting new and existing products, to evaluate publications and patent filings in a certain area of science, and to prevent accidental loss of rights.**

#### Resources

[www.ipcounsel.com](http://www.ipcounsel.com)  
[www.mayerbrownrowe.com/biotech/](http://www.mayerbrownrowe.com/biotech/)  
[www.uspto.gov](http://www.uspto.gov)

# Simple soft blowout!

## **accu-jet**<sup>®</sup> motorized pipette controller

- Provides smooth, intuitive meniscus control for cell culture applications.
- Integral check valve and filter protect instrument from aspirated liquids; exhaust port vents vapors.
- Lightweight and comfortable; 8-hour charge life at full speed.
- Dual mode switch permits both powered and gravity dispensing – simple soft blowout!

The accu-jet<sup>®</sup> pipette controller features continuously variable pipetting speed and precise meniscus control for 0.1-100mL pipettes. Pressure-sensitive triggers control pipetting speed, and prevent meniscus "jumping", even with low-volume pipettes. Now available in blue (#2026510), yellow (#2026511), mint (#2026512) or gray (#2026506).



**Lab Rats Love  
BrandTech!**

**BRANDTECH**  
SCIENTIFIC, INC.

Tel: (860) 767-2562  
Fax: (860) 767-2563  
Toll Free (888) 522-2726  
[www.brandtech.com](http://www.brandtech.com)