

Advice about the patent bar for current and prospective law students

Students: You should consider this document as a jumping-off point for doing your own research and asking your own questions. It's a synthesis of views, opinions, and advice of many different people. And things change. Accuracy is not guaranteed. (Document created 3/17/21.)

Most important points:

- **You don't need to be admitted to the patent bar to do most things involving intellectual property law.** For practice concerning copyrights, trademarks, trade secrets, and publicity rights, the patent bar is irrelevant. Even litigating patent infringement in federal court does not require the patent bar.
- The patent bar is necessary for those who prepare patent applications and those who represent clients before the U.S. Patent and Trademark Office (USPTO) on patent matters.
- You don't have to be a licensed attorney to be admitted to patent practice before the USPTO. But you do need to meet certain pre-requisites (such as having an engineering degree, a certain kind of hard science degree, or some alternative qualification spelled out by the USPTO). And you have to pass an exam and meet the moral character requirements.
- If you're a non-lawyer and are admitted after passing the exam and meeting the moral character requirements, then you're a "patent agent" (just not a "patent lawyer"). In so far as that goes, "patent bar" is a somewhat inaccurate nickname for admission to practice before the USPTO in patent matters.
- The USPTO's main source of information for becoming registered as a patent agent/lawyer (including requirements to be eligible to register for the exam) is here: <https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/becoming-patent-practitioner>. Note that it may take quite a while for the USPTO to process your paperwork to register for the exam. So plan ahead.

Prep options for the exam:

- Practising Law Institute (PLI) Patent Office Exam Course:
<https://www.pli.edu/poec/home>
This seems to be the most popular and well-known prep course. It is said to be thorough but pricey. They may offer a student discount, for which you might need an e-mail address with .edu.
- Patent Education Series (PES) patent bar review course:
<https://www.patenteducationseries.com>
This is said to be good in particular with helping students learn how to search the Manual of Patent Examining Procedure. It is known to be less pricey than PLI.

- (The Patent Resources Group course www.patentresources.com got a good review, but the website says the course has been retired.)
- There are self-study books, apparently. But they didn't seem to be a very popular option with those in the know. A self-study book might be more plausible in combination with a law school course focused on patent prosecution practice, if one is offered. (But note that is not the same thing as the more commonly offered law school course labelled "Patent Law" or "Patents," which is much more general in coverage.) At any rate, the self-study option is probably best for those who don't mind the prospect of taking the exam a second time if necessary. If you're a one-and-done type, the prep-course option is probably your best bet.

Tips for studying that various people offered:

- Expect to spend a minimum of one month of focused study, or maybe more like 2-3 months. It's a tough test; only about half pass (<https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/registration-exam-results-and-statistics>).
- Consider taking both the PLI and PES courses, if you can afford it.
- Knowing 35 U.S.C. § 102 under the America Invents Act seems particularly important.
- Complete as many practice questions as possible.
- Taking a regular patent law course in law school generally does little to prepare you for the patent bar exam, although it may help provide a broad framework and may increase your interest in the subject. (And vice-versa: Having passed the patent bar exam is not that much of a leg up on a general patent law class.)

Career thoughts that various people offered:

- The patent bar requires intensive study. And there is wide agreement that it is a bad idea to be distracted during your 1L year by any other time commitments. Thus, received wisdom strongly counsels against studying for the patent bar while simultaneously taking 1L classes. Even studying during 2L or 3L year is potentially troubling. (In other words, don't sacrifice grades for the patent bar.)
- A number of people agreed that getting the patent bar out of the way before law school or during a summer of law school can be a great idea.
 - A registration to practice before the USPTO can distinguish your résumé from the multitude of others that firms may receive.
 - Résumés of law students who are registered patent agents are much more likely to receive consideration for patent-prosecution-related summer clerkships/jobs/internships and permanent positions.

- It can be particularly advantageous to have your patent-registration number in hand before going to the Loyola Patent Law Interview Program <https://www.luc.edu/law/currentstudents/careerservices/patentprogram/>.
- And some expressed the sense that having a patent registration number could open up opportunities for jobs at smaller firms where the work would embrace a variety of IP matters, including copyright and trademark.
- There were reports that some patent litigation firms want their patent litigators to pass the patent bar. This is despite the fact that infringement litigation in federal court only requires being a licensed attorney, not being licensed to practice before the USPTO. On the other hand, there are litigation-like patent proceedings that take place before the USPTO (inter partes review and post grant review). These have been increasing in volume, and in many firms, these are handled by the patent litigation group.
- But a number of people perceived downsides of hurrying toward the patent bar.
 - Before law school, it's hard to know what kind of work you'll eventually end up wanting to do. Law school is a time of being exposed to many things – some of which may surprise you as a great fit for you. And patent prosecution is far from the only lawyer work where a science/engineering background is helpful.
 - Along these lines, there was a concern that having a patent agent registration number may unhelpfully pigeon-hole a student as being a patent-prosecution-only person. Even within some IP firms, there was a sense that a patent-registration number might limit a junior lawyer's exposure to other types of IP-related work.
 - On the other hand, pigeon-holing is a generic concern for any stand-out line on a résumé that is associated with a particular field. So it's a concern, but you can't spend your lifetime running from achievement out of a desire to keep your options open.
 - If you find yourself pigeon-holed, you may just have to push harder to get the opportunities you want in order to become more well-rounded. That could be within the firm. Or it might mean leaving the firm. There were stories of lawyers lateraling from their first job to a firm where they could have a broader practice – or leaving to start their own, very fulfilling, practice.
 - Even for a person committed to patent prosecution as a career, there may be a mentoring advantage in waiting to take the exam until after law school. If one feels confident about being able to get a patent-prosecution job without the registration number in hand (perhaps because of having sought-after engineering credentials or an advanced degree), then that person is likely to get very helpful mentoring in the initial phase of their career. This is because a supervising attorney will closely evaluate the new associate's work when it's being done under the supervising attorney's

name and number. On the other hand, once the associate has their own registration, they may be left to get the work done on their own.

- And if you get the job first, your employer may pay for your prep course.
- Make sure you consider the possibility of pursuing a career with the USPTO itself. Being a patent examiner can mean the opportunity for valuable on-the-job training, and it can make you very marketable for private-sector jobs later on. Plus, the federal government tends to be a good employer – with good benefits and lots of stability. And USPTO jobs are no longer just in the D.C. area.
- Because of the availability of online research tools, some patent prosecutors are heading for the hills – working remotely so they can live near hiking, skiing, etc. Having a remote practice likely takes experience, a stable client base or cooperating employer, and some intrepidity. But it can make for a great life.
- Patent prosecution work isn't for everyone, but for those who love it, it can lead to very happy law careers. In at least one person's opinion, admittedly anecdotal in basis, patent prosecutors seem to have some of the highest career satisfaction in the legal profession.

*This document is a synthesis of the wisdom, opinions, and views of others – mostly fellow intellectual property professors who were kind enough to respond to a listserv question I posed – plus a bit of my own advice sprinkled in.
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