



Sloan Career Cornerstone Center

Profiles of Chemical Engineers



Michael McGurk

**Associate
Finnegan, Henderson, Farabow, Garrett & Dunner
Washington, DC**

Education:

B.S. - Chemical Engineering, University of Delaware
J.D. - George Washington University

Job Description:

Patent Attorney

Advice to Students:

"I think science and law are very similar in that you have a networking of facts and other variables, and you have to learn how to work through and come out with the answer you want."

Video Transcript:

"Some of what you will end up doing, I think, is unpredictable. You'll look back 10 years from now and say I would never have guessed. So I certainly can say the same thing for myself. I never dreamed of being a patent attorney. I think engineers, quite a few, go on to medical school. Some go into business. I think it's a great background to have. I think you can go almost anywhere you want with it. I think the options for engineers are much more significant than they are for maybe somebody in another major."

Interview:

McGurk: My name is Mike McGurk. I'm a patent attorney here at Finnegan Henderson. I've been here since 1987. In 1988, I became an attorney, graduated from law school, and I've been an attorney here ever since.

Q: In terms of your educational background, how did you go from your undergraduate days to where you are now?

McGurk: I got my bachelor's in chemical engineering in 1983. My sophomore year at college, I worked at a chemical plant as a student chemical engineer. It was at that time I decided that I didn't want to stay in the practice of hard-core engineering. I started to evaluate some of my alternatives, and one of those I had considered previously was going to law school. So, I studied for the LSAT, took it, and then upon graduation, what I had wanted to do before I went

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to law school was work a couple of years. As it turns out, I got a job with the US Patent and Trademark Office in Washington. I worked for two years, started law school my second year, and then left there and went into a private practice firm down in Alexandria, Virginia, while I was still in school. I then came to Finnegan my last year in school.

Q: How has your chemical engineering degree helped you as a patent attorney?

McGurk: It's actually very helpful, in fact, most people in patent law have to have some sort of a technical degree, whether it's engineering, chemistry, biochemistry, biotechnology, computer science, or electrical engineering. In order to become a patent attorney and pass the patent bar exam-which is a separate bar exam-you have to have a technical background. I get to use a lot of what I learned in engineering in my day-to-day practice because of the technologies that are involved. The chemical technologies require some basic understanding of chemistry or whatever particular field you're in. So what I enjoy most about what I do is the fact that I'm able to get involved in the law, but, at the same time, I'm using some of the scientific background that I have.

Q: Would you illustrate how your chemical engineering has come into play?

McGurk: Recently, I worked on a process called cryogenic distillation. That's basically a low-temperature air separation process. When I got involved in the project, I immediately recalled some of the things that I did in my chemical engineering days in school. I didn't remember all the theory and the mathematical equations and how you get from A to B, but there was enough of what I recalled involved that I was not only able to assist the client, but also have a level of understanding so he was not spending an inordinate amount of time trying to educate me. I was able to go in and say, 'Yeah, I remember a lot of this stuff. You're going to have to help me out a little bit, but for the most part, I can help you out.' My principal purpose is to apply the law as I understand it or as it exists, to the technical facts that I'm given.

Q: What are some of your specific job responsibilities?

McGurk: There is a wide spectrum of things that a patent attorney can do, like getting a patent for an inventor. Somebody comes to you and says, 'I have an idea, I want to get it patented. Here's my idea. What do I need to do?' So you're basically advising him or her on the process of obtaining a patent. A patent is obtained through the U.S. Patent and Trademark Office. It's a very formal process that requires a detailed application, and prior literature-searching to see if anyone else has done what they say they've done. So the inventor would come to the patent attorney with their idea. I would help the inventor prepare the application, we'd file it, and I'd see him or her again through the patent office until they actually get a patent. The patent, basically, is a legal document that gives them the right to exclude others from making, using, or selling their invention. Once you have a patent, then the question becomes, what do I do with this patent? Either that person manufactures that product himself or herself, or wants to license it. The second big issue is enforcing the patent. You get the patent from the Patent Office, then you have to enforce it. When you enforce it, you basically go to a federal district court, and you're alleging that, at some point, somebody infringed on your patent rights. The whole aspect of enforcement is really what we call litigation, getting into the courts, taking depositions, getting in front of a judge, arguing to a jury, and preparing your filing motions in the court. Besides all that, there are a variety of things, such as opinions, that we offer. A client

"Profiles of Chemical Engineers"

will come to you and want to know whether their patent is enforceable or valid before they get sued, or if they've already been sued. So we'll undertake that analysis. We'll advise them whether they should fold their tent and move to another city, or whether they have a good chance of winning if they fight it. Some clients who own the patent want to know whether the patent will stand up in court, so they have you analyze it. Many times, the Patent Office will issue a patent that, on its face, may not appear valid. It got through the Patent Office somehow and a lot of people have doubts about it, so we'll study that in more detail. We'll advise the client how best to prepare for a law suit, and what preliminary steps can be taken to make sure all our ducks are in a row before we sue.

Q: What aspects of your job do you like the most and what don't you like quite as much?

McGurk: The part I like the most is working with clients, going to meet them, and trying to help them out of a jam or get them on their way to getting a patent. Or if they've already gotten it, making sure that we can enforce it, and making sure that people aren't infringing on their patent. I enjoy the scientific part of it, too-using the law with my technological background. The part I don't like is that you're asked to do a lot of things in short order. Somebody picks up the phone and says, 'I need this tomorrow.' Suddenly, your fun evening with your wife or kids is no longer an evening and you're spending the night here. So you have to be ready for that. Litigation is another part that can be very troublesome or tiring because you're at the mercy of the court, the other side, and sometimes your clients. You're asked to pick up on short notice and fly to a city far away and spend a couple of days taking depositions. So on the one hand, it's getting to work with the clients and using my background. On the other hand, it's the sudden and unpredictable nature of being a patent attorney.

Q: How do chemical engineering and law overlap in terms of the education and thought process it takes to be a successful lawyer?

McGurk: When I was applying to law school, I was trying to convince them that they should let me in. One of the answers I gave was that I thought engineers, because of their analytical skills and ability to go through a process, math equation, or chemical reaction, were also able to succeed in law because there are a lot of analytical requirements in the legal profession. I think science and law are very similar in that you have a networking of facts and other variables, and you have to learn how to work through and come out with the answer you want. In law, that means getting a case, reading it, finding the facts of the case, determining how the court applied the law to the facts, and what the outcome was.

Q: How did you find this job?

McGurk: I got out of the Patent Office and was working in a private firm doing patent work, and then I spent a summer in Chicago. While in Chicago, I knew somebody that was working here at Finnegan. We talked, and there was a need for somebody with my background and skills. So I called a partner up at the firm and told him I was in Chicago for the summer. I told him I was coming back to Washington to finish up my last year in school, and asked if they would be interested in hiring me. Ultimately, the answer was yes. I got the job pretty much over the telephone, although that won't happen today, unfortunately. The typical process is, you send your resume in and they'll bring you in for a series of interviews.

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Q: Do you only handle cases that are associated with chemical engineering?

McGurk: There's not really an easy way to classify whether something's chemical engineering or not. There's usually a mixed issue of whether it's mechanical or chemical. I do things that aren't necessarily chemical engineering or chemistry. I've done mechanical things. I have a client who manufactures darts and dart boards. That type of work will get funneled towards the person who is qualified, and qualifications vary. If it's litigation, it might go to somebody who's got more litigation experience, and they would seek out the assistance of somebody with the technical background to help them understand the technology.

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