



Sloan Career Cornerstone Center

Profiles of Chemical Engineers



James Monroe

Associate Attorney
Finnegan, Henderson, Farabow, Garrett & Dunner
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Education:

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

Job Description:

Associate Attorney

Advice to Students:

"A lot of people, and I was one of them, blindly go to college and pursue a certain degree because they had to pick something when they were in high school. They don't stop and question themselves every year and say, 'Is this really what I want to be doing?'"

Video Transcript:

"I spend most of my day on projects to help enforce patents for clients. I step into the picture once a client has obtained a patent. I get involved in policing the market to make sure people aren't infringing their patent, and if there is a company or an individual infringing their patent then I assist the client in going to court and seeking some type of compensation or injunction from the court to prevent the infringement, or I help the client work with the alleged infringer and work out a settlement of some type, a cross licensing agreement. The other side is helping accused infringers explain why they're not infringing someone's patent. You also spend a lot of time reviewing documents and not from the standpoint of reading, but from the standpoint of analyzing strategy of your opponent and what their company was doing over the years from a business standpoint, so it's pretty analytical."

Interview:

Monroe: My name is James Monroe, and I'm a patent litigator here at Finnegan Henderson. I have a degree in chemical engineering and a law degree from George Washington University.

Q: What does a patent litigator do?

Monroe: I spend most of my day on projects to help enforce patents for clients. I step into the picture once a client has obtained a patent. I get involved in policing the market to make sure

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people aren't infringing their patent. If there is a company or an individual infringing their patent, then I assist the client in going to court and seeking some type of compensation or injunction from the court to prevent the infringement. I also help the client work with the alleged infringer to work out a settlement, such as a cross-licensing agreement. That's one aspect of what I do from the day-to-day as a patent litigator. The other side is helping accused infringers explain why they're not infringing someone's patent, going to court and representing them, and trying to convince the courts that what they're doing is completely legal and should not be punished or stopped.

Q: Are the cases that you work on all related to the chemical or engineering field?

Monroe: I have been involved in cases from semiconductor devices, to pharmaceuticals, to conventional chemical engineering processes. In all of those cases though, there was a prevailing use of my technological background. I use my education in chemistry in almost all of the cases I've been involved in. I think the most common use of my background is chemistry, because no matter what I've been involved in, from semiconductor devices to pharmaceuticals, it has had some chemical slant to it.

Q: What would you say the parallels are between chemical engineering and being a lawyer?

Monroe: I think they're very similar, and from my personal experience, the engineers who were going into patent law were some of the better students and had it much easier in law school than the non-engineers. The reason is, you learn as a chemical engineer to be a problem-solver, think through things, and look for answers. In law school, that's basically all you do. You look at a set of variables and try to figure out how it all fits together and come up with an answer. My experience from law school was that chemical engineers, and other engineers in general, have a better grasp of the problem-solving concept.

Q: What route have you taken on your career path to this point?

Monroe: I think that if you talk to most patent attorneys, they will say that they never planned to become one. It was happenstance. People don't think, when they're in high school, that they're going to become a patent attorney, because they don't know about it. Only children of patent attorneys think about it. I was studying chemical engineering at Washington University in St. Louis and realized about halfway through my junior year that I really didn't want to be a conventional engineer. I wanted to go into something more business- or marketing-related, something besides just conventional engineering. So I did research, and it was hard to find out about alternative career paths. At the time, I just happened to be doing part-time work for a dean at the law school. One day she mentioned patent law. It stuck in my mind, so I started writing to people. I used the Martindale-Hubbell, which is the directory for all attorneys, and found those who had graduated from my school and had become patent attorneys in Washington, D.C. I wrote to some of them and said who I was, what I was thinking of doing, and asked for advice. It was remarkable that about 80% of the people wrote back to me and gave me real advice, which really shocked me, but I think it reflects the patent community, which is small. Almost all of them said if you can do it, come to Washington, D.C., where the patent office is located, and try to get a job there, and then go to one of the schools there. So I took their advice and came here, attended George Washington University, got a job at the

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Patent Office, discovered what patents were really all about, and that I had found something I like. I then came here to the firm I'm at now and started doing patent prosecution. About two years after I became an attorney, I left the firm to clerk at the U.S. Court of Appeals for the Federal Circuit, which is the patent appeals court in Washington, D.C. I took a sabbatical and went there for two years and clerked for a judge who was one of the authors of today's patent laws. I then came back to the firm and began litigating. Since I returned, I do primarily litigation. I also do some opinion work, just counseling clients on what they're doing, whether or not they're infringing anyone's patents. I also do a small amount of patent prosecution for the Patent Office.

Q: What advice would you offer to someone interested in becoming a patent lawyer?

Monroe: If students are interested in being involved in patent law and wanted to test the waters to see if this was something they wanted to do for a career, I would suggest that they contact a patent attorney and see about doing a summer internship, or getting a part-time job while they're an undergraduate. I think students should feel confident enough to contact patent attorneys by looking them up in the Martindale-Hubbell. They should feel confident to contact the attorneys and ask them directly for help, because it's a very small and helpful community. As far as coursework, I think it's very important that engineering students, and students in the sciences in general, not overlook writing skills. Too often, engineering programs let you get by with taking one English course and then one technical-writing course. I think it's very important, especially if students want to go into patent law eventually, to focus on their writing skills and take as many writing courses as they can so they can become persuasive writers. I think that applies regardless of whether they intend to go into patent law. I have friends who are engineers who discovered, when they got out of college and began to be practicing engineers, that there was a lot of report-writing and summarizing of what they did on a day-to-day basis.

Q: Tell us about a case you've had that might illustrate how your chemical engineering has come into play?

Monroe: I was asked to work on an opinion for a client, to determine whether or not we thought someone in the marketplace was infringing their patent. Their patent happened to involve chemical vapor deposition, and that was something that I had studied in my undergraduate program. We drafted an opinion to the client, outlining why we thought the company was infringing on their patent, and then I began getting involved in a law suit. I drafted the complaint for filing in court against the infringing company, and from there it became a huge machine of filing motions with the court, and taking depositions of employees from the infringing company. We had what we call a discovery process, where we quiz the other side about their chemical engineering process, and they quizzed us about our patent and how we developed our invention. We prepared for trial, and ultimately settled the day before trial. But throughout that, and it took a year to get to that point, I spent a year of my life knee-deep in chemical vapor deposition. Throughout the year, I was constantly drawing on what I learned in college. Plus, I had to, of course, build upon that. One thing that you discover as a patent attorney is that you're constantly being exposed to new technology and things that you haven't studied before. So you quickly learn to adapt and educate yourself in certain areas.

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Q: Do all patent attorneys have engineering backgrounds?

Monroe: I would say today about 75% of all patent attorneys have an engineering background, though I think that number is going down. It used to be about 95% had an engineering background. To become a patent attorney, and to be officially registered before the U.S. Patent and Trademark Office, you have to have a degree in engineering or the hard sciences. If you have an engineering degree, you're automatically eligible to be registered, but you have to take an exam first. If you don't have an engineering degree and you have some other type of scientific degree, you then have to prove yourself by submitting certain evidence of abilities. Because of the biotech field, we have Ph.D.s in biochemistry who don't have engineering degrees. So as biochemistry has become more important, the number of engineers has gone down and the number of Ph.D.s has filled that void. You don't have that many patent attorneys who don't have any type of engineering or science degree.

Q: What are some of the behind-the-scene things that attorneys do?

Monroe: As you probably expect, television doesn't reflect the real practice of law. People are sometimes disappointed to learn how boring the practice of law can be, and then pleasantly surprised about how exciting it can be. Behind-the-scenes there is a lot of reading and writing. It's not all appearing in court or taking and defending depositions. A lot of it is simply reading and writing so, if you don't like that, then patent law is probably not your field. You also spend a lot of time reviewing documents, not from the standpoint of reading, but from the standpoint of analyzing strategy of your opponent and what their company was doing over the years, from a business standpoint. I think that's why a lot of engineers like it, because they get to use that kind of thought process. If you do litigation, there is a lot of deposition practice where you get experience asking questions and defending your witness during a deposition. I think what surprises people who get into patent law is they expect it to be more contentious than it is. From TV, you always see attorneys yelling at each other and being real argumentative, but for the most part, it's not like that. Especially in the patent field, everyone is very cordial and it's a really nice community. You see the same people, your opponents, on a social basis, at national meetings. It's a very relaxed, but tense atmosphere.

Q: What is a typical day like for you?

Monroe: I'll use yesterday as an example. I got in about 8 o'clock in the morning, and I had to spend about an hour tying up some loose ends from a just-settled litigation that I spent basically a year on. I had to call some of our witnesses who were planning to come to trial in a couple of weeks and let them know they didn't have to, and I had to prepare a stipulation to file with the court, notifying the court that we had settled and that we were withdrawing our complaint and both sides were in agreement. Then I spent a couple of hours talking to a client for whom I'd been counseling on what they should do with their technology. Should they seek patent protection? Should they keep what they're doing as a trade secret? Should they be policing the market more to see what others are doing? Should they be seeking international patent protection, or just protection here in the United States? In the afternoon, I drafted a patent application for a client whom I've worked with for several years. So I worked on that for the first part of the afternoon. Due to timing, I spent the rest of the afternoon preparing for a patent litigation course that I teach. But you never know from day-to-day what's going to happen. There are times when you're working from 8 o'clock in the morning till 10 o'clock at night.

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Q: Do you work typical hours?

Monroe: There are times when the heat is on and you are working from 8 a.m. till 10 p.m. or later, depending on the motions your opponent is filing. Other days, your day is very relaxed and very short and you come in at 9 and leave at 5, knowing that tomorrow is going to be a bad day and you're going to be in all day.

Q: What advice would you offer to someone interested in becoming a patent attorney?

Monroe: My primary advice would be to really look closely at what they're doing. A lot of people, and I was one of them, blindly go to college and pursue a certain degree because they had to pick something when they were in high school. They don't stop and question themselves every year and say, 'Is this really what I want to be doing?' I knew a lot of engineers who did that-they didn't stop and think about it-and fortunately some of those had preceded me by a couple of years, and that's what led me to think about what I was doing. A lot of times, with engineering programs, you do your first two years studying basic science and you're not even doing anything with respect to your ultimate degree in chemical engineering. I studied physics, chemistry, and basic courses in electrical engineering. It wasn't until my junior year that I really hit the chemical engineering courses. It's unfortunate that a lot of students get in that situation and then they don't think they have an option. My second piece of advice, though, is that it's never too late. If you do get in that situation-you graduate, you get into a job, and are your working in a plant or doing some type of conventional chemical engineering work-it's never too late to go into patent law. The average age of entering patent attorneys is pretty high. Most patent attorneys do not go straight from undergraduate school to law school. They take a couple of years off and work in industry or do something different. Especially in the biotech area, a lot of patent attorneys started going to law school when they were 40 years old, so it's never too late. I hope people don't feel stuck to do exactly what they got into when they first got out of college.

Q: How do you deal with stress?

Monroe: People have the impression that the practice of law is very stressful. It can be, but the most important thing for you to do is sit back and evaluate your life and prioritize what's important. The practice of law can be extremely rewarding. With patent law, you're working with clients and you're helping them get a patent on their product, and that's a good feeling. When that happens, you should really take a moment and appreciate it. Think about what you have done-you have helped somebody. It's not just a corporation, it's not just money, it's actually somebody who has spent his or her life working on a project. You helped them get protection for their product. I think it's important to stop and smell the roses and think about what you've done-that makes you feel better about your life. You have to prioritize and take control and say 'I want to do this and I want to be successful in my career.' But you also need to have a personal life and enjoy what you're doing. For the most part, a lot of the stress of being a lawyer comes from interacting with opposing counsel. If you take a friendly, professional attitude toward opposing counsel, they'll put it right back at you, and then suddenly you're really enjoying working with them. Even though you're on opposite sides and you write motions and letters back and forth about how much you disagree with each other and how much each of you is wrong, you still like each other. And then you enjoy what you're doing, and you don't allow yourself to fall into the contentious, angry atmosphere that you see on television.

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