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How Do You Start an IP Practice?

I'm a recent law school grad. I've been working for a small firm the past 7 months doing mostly real estate litigation and some construction defect litigation. This past week I gave my firm 3-weeks notice of my resignation. They've been very supportive of my decision to go solo, and have even offered to give me some contract work after I leave. Of course I'm grateful for any work I can get in the beginning, but my real interest lies in IP law.

Other than taking Copyright in law school and writing a paper on the DMCA for a course in Legislation, I have zero experience in this area of practice. Is IP too specialized of a practice area for someone with my limited experience? How can I get some "easy" IP work to get my feet wet?

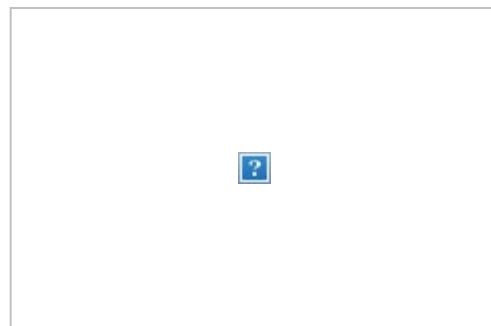
I should also point out that I do not have the technical or engineering background that most patent lawyers seem to have, so patent law is probably not something I would focus on. I really do enjoy studying copyright, trademark, and trade secret law as well as technology licensing issues.

I realize that my questions probably sound absurd to the experienced IP attorneys on this list. If that's the case, please don't hold back your comments. I'd much rather learn the hard truth sooner than later.

Anonymous

Congrats on making the decision to start your own practice. I don't know much about IP practice, but I think the real question isn't how do you start but rather, is there a market for your practice? Are there people in Phoenix who need to hire an IP lawyer? I don't know the answer. My gut tells me yes, but you can't make business decisions based on my gut. Please contact your nearest Small Business Development Center (<http://www.sba.gov>). SBDC's offer free business consultations to businesses, including law practices. They can help you conduct market research and help you market to your target. They will help you make decisions based on numbers and sound logic. And did I mention that they are free (paid for by our federal taxes)? I wish you luck. Sharmil McKee, Philadelphia, Pennsylvania

For a good overview forum, go to www.intelproplaw.com. You are correct that all patent attorneys have a technical (engineering, science) degree of some sort; it's a requirement to sit for the patent bar. But, that just means you can't draft and prosecute patent applications. You can still litigate patent cases, but I wouldn't recommend it as a new solo. You could, however, associate with co-counsel. Patent litigation runs into the seven figures rather quickly so it requires a great deal of time and resources. In addition, it helps to have someone with a technical background and a patent bar license to understand the interface at the patent process. I don't



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know if there's any "easy" IP work. I suppose TM or CR registration might be a good place to start. Especially with TM, you may be soon thrown into the area of office rejections and have to make arguments to the PTO. Do-able, though. Suggest several references. Chisum on Patents (if you're interested); Nimmer on CR; McCarthy on TM. Most major law school libraries have copies. There are also numerous books on IP for the general attorney that may be helpful. A good periodical is Intellectual Property Today, but it deals mostly with patent matters. Suggest you button-hole an experienced IP lawyer for lunch. It will be worth the price of admission.  Finally, IP malpractice insurance can be very expensive. If you're not doing patent work, it might not be so bad, though.

William B. Richards, New Albany, Ohio

I echo a previous post that patent law is probably not your focus. However, I think copyright, trademark and "trade secrets" are fully open to you. You don't need to be a member of any special bar to do that kind of work. One of my best friends/colleagues does this exact practice. (Note: "trade secrets" is really more business law/litigation and is typically based on state statutes.)


Your leads can come from writers, musicians, artists, and any business that wants to trademark a slogan, logo, or image. Copyright is mostly about enforcement (although, registering a copyright is good - mostly forms work available from the US Copyright Office part of the Library of Congress <http://www.copyright.gov/> - copyrights exist the moment someone puts an idea to paper regardless of if or when they register it). Trademark work is handled by the US Patent and Trademark Office <http://www.uspto.gov/>.

My colleague has a LLM in non-patent IP, but you don't necessarily need that. My suggestion is to go to the two websites I mention above, read everything you can, AND attend a seminar(s) on both topics.

Starting a practice in any area is about feeling confident and competent in the work you want to do. The business flows from there.

TJ Thurston, Huntley, Illinois

I echo the other colleague who said, "make sure there's a market first." You should be good in a large metropolitan area. The good news is, if you establish a good initial reputation, these clients will find you and come to you, because they need your specialty. You will get a lot of work by word of mouth alone. There is indeed "easy" IP work but it does not pay

anything  To build this type of practice it might be a good strategy to find some lawyers in this area with an existing practice who might have overflow contract work and would be able to semi-mentor you. I know this is not what you are looking for, going solo, but some kind of mentoring is pretty highly advised.


IP practice separates into four types of lawyers: those who do patents and those who do not, and those who litigate and those who do not. Patent lawyers do copyright, trademark, trade secret law as well as patent law, so

they will be competing with you for the IP clients, even the ones who don't need patent work. "Soft IP" lawyers (ie, non-patent IP lawyers) mostly do trademark and copyright, and then everything and anything associated business areas like literary property, licensing, merchandising, franchising. In other words, this is a "kitchen sink" business law transactions practice, which deals with the special asset-driven issues of that particular type of business. If you decide to do soft IP, it is an extremely wise move to do IT as well as IP: in other words, know how to handle all the IP areas associated with computers: software development, data sales, online publishing, web design and e-commerce. (To become this type of lawyer, you need to either have a background in computers, programming, and technology, or be really really interested in it and do constant reading in it in your free time. Geeks, you know who you are.)



Because more and more of the types of IP that are traditionally protected by copyright, trademark and trade secret are increasingly covered by the over-slosh of patent protection, you will need to have a very good referral relationship with a number of patent attorneys. You will need to be able to refer out mechanical invention work, design patent work, and "business method" patent work (the one that is becoming so large you can drive a Mack truck through). In order to be able to triage these clients, you will need to know enough about patents to know when something is potentially patentable, and to steer that client to a referral who will do a search and advise them. If you didn't take the patent law survey course in school, you need to take that now. In many cases where you could do copyright or trade secret work, you do a disservice to a PC NOT to refer them out for patent work--venture capitalists love patents and the client will frequently only get funding to commercialize his or her product, if a patent can be obtained.

Trademark transactional work can be quite lucrative. Getting the client to pony up for the going rate can be a difficult sell job (they are expecting to pay only several hundreds for the whole shebang--federal trademark search, clearance letter and federal application workup--and the reality is the typical cost is 4 to 10 times that). If you decide to do trademark you will have to learn all the ins and outs of domain name protection and dispute resolution, and how that jibes with trademark. Unfortunately, due to the whole domain name/trademark interplay thing, small artist and music clients are pushed toward the federal trademark arena, because their logical commercialization method is to have a website presence and they need to protect a domain name. They are 100% completely unprepared for how much all this legal work will cost, and unfortunately it's a necessary up-front item to protect their identity (if you do it later I guarantee you the name will not be available), and it's not in their budget. So, lots of NEED for that work, but not lots of PCs who are prepared to pay for their NEED. You educate them and they go away and some of them come back and sign up for the work. I talk to about 10 potentials for every one who actually goes through with it. Business clients who have a marketing or sales background are the ones who "get it" and they are the easy sells on trademark work. If you did not take trademark in school, extremely good idea to read a treatise like McCarthy on Trademarks and Unfair

Competition cover to cover  You should probably partner up with an

experienced trademark lawyer the first couple of times out on this type of work, it's easy to do these the wrong way and really screw them up.

Copyright registrations--I practically give those away. First of all, the form is as short and uncomplicated as a 1040EZ. The great majority of people who want to see you to register a copyright are non-commercial hobbyists who just want to register a collection of songs, or some pictures. The online materials at the Copyright Office are pretty self-explanatory for these people. With web site designs, computer software, databases, non-fiction publications, periodicals, 3D artwork, toys, games etc...ie, the commercially valuable stuff--at that point it gets complicated and they really do need a consultation with a lawyer and it becomes very important how the registration gets done. But you're still talking about a transaction that should cost the client about an hour of your time and a relatively small preparation fee. So overall, not much transactional money here.

In conjunction with copyright, you will need to know a lot about right of privacy and right of publicity, because every time someone brings you an image with a person in it for copyright purposes, those rights are also implicated and need to be addressed and/or released.


The best transactional money in soft IP practice, is in preparing agreements and setting up structures to protect and commercialize the creation of IP, and handling acquisitions or sales of IP and or companies that hold rights to it. In other words, it's business law work. It means knowing how to do company formation to hold IP assets that are going to be commercially exploited, and doing lots and lots of agreements between business parties trading in IP--licensing, commercialization, non-disclosure, custom development, commissioned artwork, consulting, recording agreements. Get your hands on as many of these as you can and study multiple versions of them and learn how they are done. Go to seminars on contracting in entertainment, cyber law, and computer law. You will need to know a little bit about the tax treatment of IP assets (to know when you have to refer questions to a tax professional). You will need to know the whole employee/independent contractor IRS/DOL area of regulation and compliance like the back of your hand, at both the state and federal levels, and the IP side of that: when does a worker own IP he creates and when does the company own what a worker creates. Was someone "hired to invent". Does a so-called "work for hire" agreement actually target work-for-hire as defined in the copyright code or is it just a valiant try by an non-IP attorney. These are the kinds of questions businesses will bring in, and they usually have the ability to pay whatever you quote and you can get nice hourly billables from these types of transactions.

Of course, litigation is where the real money is. Copyright litigation for the right plaintiff is great, because if you win you get your attorneys' fees paid by the other side--they are statutory in many cases. Trademark litigation is highly fact intensive and generates great billables. Ask Eric Grimm on this list about that--he specializes in domain name and trademark litigation. Patent litigation is lucrative but you won't be doing that since you're not eligible to become a patent lawyer (I have yet to see a patent litigator who is successful who is NOT a member of the patent

bar). There is no such thing as "easy" copyright or trademark litigation where you can "get your feet wet"--you'll have to collaborate with a more experienced attorney (recommended) or go it on your own.

Others have covered the scary malpractice insurance issue.

So, net net, it's a great and interesting area of law, but you have to be an "expert" from day one. Other attorneys, as well as clients, are going to turn to you as the "answer man" on esoteric stuff they know nothing about. The good news is you can charge a premium hourly rate for it.

Your best bet to get up to speed on what you did not take in school is to cover all these subject matter areas in CLE and by reading, ASAP. Also a good idea to join lots of legal IP and IP-business-related groups: Association for Computing Machinery, AIPLA, your bar's sections on IP, organizations of professional photographers, designers, writers, journalists, artists. In terms of mailing lists, you should join cni-copyright and INTA's list on trademarks and domain names, and there are about a hundred blogs you can start reading in your spare time 

Carol Ruth Shepherd, Ann Arbor, Michigan

Unless you do not need financial support, you will have to take a look at the business side of starting an IP practice. While you are generating IP clients, you may have to consider other areas in which clients have a need just to generate needed cash flow. Unless you have a stable of clients needing IP work, it's hard to get going by just holding yourself out as an IP specialist. In other words, your horizons may, by necessity, have to be broader in the early going.

Craig McLaughlin, Irvine, California

In fact, driving a Mack truck through the patent office could result in a very interesting business method. It would certainly have a useful, concrete and tangible result.

Mark Lyon

If you are considering starting "an IP practice" at all, don't. Before you even dream of starting an "intellectual property" practice, take a moment to think of what you really mean. "Intellectual property" is a very sloppy broad umbrella catch-all that is overused and should probably be removed from legal lexicon. For a lot of big firms and boutiques, "IP" means "we do patent work, and have a couple of associates handling copyright and trademarks on the side." Most copyright lawyers and trademark specialists would not call themselves IP lawyers because they would not want to invite all the patent work. Most employment lawyers and transactional lawyers probably handle trade secrets on a daily basis, but even if they are quite good at protecting trade secrets they might never consider themselves to be "IP lawyers."

So, decide which of the types of "IP" you really want to handle, and describe your work by that name or those names.

John Mitchell

Thanks to everyone who replied. I really appreciate all the responses. I've thought a lot about what everyone has said and came to the conclusion that it's copyright litigation that I'm really interested in.

My plan now is to open my shop and practice in the areas I have some experience with (real estate and construction defect), but to also continue to learn more about copyright and try to find contract work in that area.

Thanks again.

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