

Podcast: an interview with Joel Smith and David Wilson, IP partners

Joel Smith I'm Joel Smith. I'm a partner in the IP group here at Herbert Smith. I've been here now for 15 years at Herbert Smith doing intellectual property law.

David Wilson Hello I'm David Wilson. I'm another partner in the intellectual property group at Herbert Smith. I joined the firm two years ago. Before that I was an IP specialist at another firm in the city. Before that I was a chemist.

Les Waters So one of you has a scientific background and one of you has a law background?

Joel Smith That's correct I had a law background although I always had an interest in plant biotechnology outside of my legal studies. David's different.

David Wilson My first degree was in chemistry and I spent a couple of years working in industry more on the life science side of things and then I decided to requalify as a lawyer. I qualified as a barrister and then switched to being a solicitor back in 1990 something or other. I specialise more on the patent side of things which sometimes you'll hear people refer to as hard IP and that's in no way meant to indicate that it's more difficult than the other areas of IP. Having said that there is a lot of what we do that is common whether you do trademarks or copyrights or patents you can be involved in what's known as contentious and non-contentious work so that would include on the non-contentious side dealing with IP exploiting it putting in place agreements relating to potential licences or sale of IP what have you and then on the contentious side which is more about enforcement and protection of IP you could be dealing with litigation or arbitration or other forms of dispute resolution and opinion providing on that so we tend to both specialise on the contentious side of things although we do have a non-contentious practice. Main areas of work are working with the clients to see whether or not there is a way to solve an issue that they are having with their IP be it someone else is potentially infringing it or they are worried about someone else's IP potentially blocking their right to do things so it's mainly assisting with those kind of issues.

Les Waters One of the things that I am having a bit of difficulty understanding is how the different IP professionals work together and how these roles fit together and I'm thinking here about not just a solicitor working in IP but the patent attorney role, patent examiner, trademark attorney. Our students are probably more familiar with the last three than necessarily with the work of an IP solicitor but how does it all fit together?

David Wilson There is a degree of overlap between certainly some of those professions but the traditional view if you like is that the trademark attorney and the patent attorney are more concerned with the creation of intellectual property so in the example of a patent attorney they will liaise with the client who thinks that they have an invention or an idea worth protecting. They will talk to them to get an understanding of what that idea is, how it works, where it best fits in which industry sectors and then will draft the patent application and then look after the patent application's progress through its prosecution procedure through to grant. The person that they will interact with when doing that will be the patent examiner who is the person who works at the relevant patent office and is responsible for making sure that the patent application satisfies all the

requirements of a patent and then essentially grants it. So a patent examiner will be a civil servant where as a patent attorney will be in private practice working with the client to secure patent protection. The same is true for a trademark attorney. They are responsible for the obtaining of trademarks by liaising with the relevant trademark registries and both patent and trademark attorneys will work with their clients to provide advice as to portfolio management to make sure that the IP that they are creating fits with what they've got already and that there is no unintentional overlap that might cause issues later on and that they have proper coverage for what their business needs are. Where the solicitor becomes involved is that the overlap is that we also are involved in what I call portfolio management giving advice on whether there's an exposure or risk there and also we tend to get involved when once the IP has been created through its exploitations so is it going to be licensed, is it going to be sold and if there's a sale of IP, maybe a discreet IP sale someone might be selling a portfolio of patents or a trademark or some copyrighted works or licensing them or that could form part of a bigger corporate transaction so for companies buying another we would advise on what happens to the IP during that transaction to make sure that no issues arise. We then move to the enforcement and protection of IP which is where again that's our role working if it gets to High Court proceedings with a barrister and that is advising on the chance of success in either defending a claim or enforcing claim, doing the preliminary background work and then if litigation is necessary because we'll try and resolve the dispute if possible in other ways if litigation is necessary then handling that, working with the clients, gathering the evidence, if there's any technical evidence that's needed we will work with the technical experts and that's particularly relevant in patent work and then having day to day conduct at the litigation through trial and any appeals etc. So that in a rather long nutshell is how the roles fit together.

Les Waters Having gone through the overall role can you give me some idea of the day to day tasks that are involved in your work.

David Wilson Well a good example is this week if you like. From Monday of this week through to yesterday, which was Wednesday, I was in Germany working with clients and the technical experts preparing for a hearing in relation to we were challenging a patent that had been granted in relation to titanium alloy. We were opposing the grant of that patent. The hearing was yesterday morning in Munich and I was doing the advocacy and the hearing lasted until lunchtime. Due the fact that the client was very happy with the result we went out for lunch in Munich. I then travelled back during the afternoon. This morning by contrast I was advising a client on their potential exposure for the costs of proceedings that had taken place and have already finished in a trademark matter and then I've also been reviewing a pitch document that we've been asked to submit to a large pharmaceutical company who is interested in retaining our services. So the one thing that's constant about our work is the variety.

Joel Smith I would endorse that. Variety is constant in what we do. Again, this morning I was speaking to one of my clients who is involved in one of the plant breeding industry answering some very esoteric questions about the growing of certain crops in the UK and collecting royalties from those crops from farmers. I then had a call out of the blue from a US media company wanting to schedule a conference call this evening on a new matter. Again, that's to do with DVD's, different area of technology. And in the middle of this got issues about mentoring our own

associates to ensure they get the right variety of work. So it's a completely changing picture of work and other things we do on a professional day to day level.

What would be the particular qualifications and skills that are needed to become a solicitor working in IP. Do you favour particular disciplines or are there particular disciplines from which you would encourage applications and I'm assuming here that you would welcome those with sort of science technology, engineering backgrounds but is it possible for those from other disciplines to get in to IP or is that a really difficult thing to achieve.

David Wilson Absolutely. I mean in terms of the qualifications that you need these are if you like set out by our governing body and I won't go through now the specific exams that you have to pass to be a solicitor but in terms of your non-legal qualification, if you like, anything could potentially be relevant on the science and technology. We are dealing with cases that involve heavy engineering. I am dealing with a client that makes construction vehicles and it's all to do with hydraulic systems right through to I've got matters where I am advising on DNA technology. So we really do have in our group a very wide spectrum of technical backgrounds and non-technical. I think the way that I would characterise it is and the fact that Joel and I are sitting here one of us with a technical background and one of us with a legal background is proof to that. Where a technical background probably has an advantage is in a patent case you may well be dealing with obviously people who are at the cutting edge of the technology that they are interested in. Quite often we will work with experts, independent expert witnesses who will have Nobel prize awards in their sector and it's being able to get up to speed quickly. I mean we will never know as much about their subject matter as they will but at least being able to talk the language and understand the basics of how it fits but having said that there is an awful lot of what I call general engineering scientific training in the way that you are taught to think which comes in useful as a lawyer. The analytical side of your brain is very much used in how you manage your facts ready for litigation and mastering the material so I would say that there is no specific discipline that as an IP lawyer is an advantage to you. We have engineers, we have lawyers, we have historians, we have language graduates but the scientific graduates tend to gravitate more towards the patent side of things because that is the area where you will more likely use your scientific training in your job as an IP solicitor.

Les Waters We've touched on different disciplines but what about those coming into the profession with a PhD infill or some sort of further degree.

David Wilson We don't actively seek people with those qualifications and nor do we actively think they're too long in the tooth if you like to change tracks. We've got both in our group. We've got people with doctorates and we've got people who maybe did a first degree in engineering or science or people who didn't at all. I wouldn't say that it doesn't really cut either way in terms of career advantages but of course if you've spent the extra time researching in that field or are interested in that field and there is an opening for that field to be exploited if you like in the law then obviously that would be useful but it's not a problem either way is the way I describe it.

Les Waters Can you just give me a flavour of the way that the training works for somebody

coming into the profession from a non law background.

David Wilson Sure. The first thing you have to do is bring yourself up to the legal equivalent of someone who has a law degree and that is by studying on a course called the Common Professional Examination or the CPE which is a one year course which is what I did. So that's cramming into quite an intensive twelve months a legal academic training. Once you've done that and passed your exam hopefully you rejoin if you like the qualification process for a lawyer with the law graduates so having a non law degree adds a year to your training and you then go through the normal training course that anyone who wants to be a solicitor has to do.

Les Waters Can you tell me a bit more about the selection process? I'm thinking here about somebody with a science or engineering background who is particularly interested in IP law. If they are full on interested in that subject do you welcome that or do you look for a certain element of flexibility for somebody who is going to be potentially interested in other seats that they go through as part of their training.

David Wilson I think it's really important that people are passionate about what they want to do. If someone upfront knows they want to do intellectual property then they should make it known from the word go. I mean it's something I did from the word go. That's not to say I didn't want to look at other areas of law, test my resolve, see what else a firm might have to offer but at the end of the day if somebody is really keen to do something I think they should make that known and certainly I think it's important that people then are happy to explain why they are interested in intellectual property convey what they've done in the past which may be part of their science, engineering or electronics degree, be able to explain to people well I spent x number of months researching this or doing a dissertation on this particular point and be able to explain to someone who may well be interviewing them and may well be a non science sort of background person be able to convey their passion in the science engineering electronics and why they want to take that forward but in a legal career rather than continuing in science or engineering itself.

Les Waters And if somebody expressed that interest and was really keen on IP what degree of assurance would there be that they would actually be able to get a seat in IP as part of their training.

David Wilson Well, whilst we can't guarantee that everybody will come to IP I think certainly if anyone expresses a strong interest in IP whether they've got a science, engineering or IT background or whether it's because it's something for some other reason they want to do we would definitely try and get them into our group for a seat and a seat is six months so every year we've got effectively two regimes of people coming through. So we've got a number of slots for people to come and try out IP so we can see their talents, they can see what we do and the type of work we do so I would hope that everyone who wants to do IP gets an opportunity.

Les Waters And having had an opportunity to go through a seat what sort of chance is there that after finishing the training one might be able to work in that field. Are there similar numbers of opportunities to seats.

- David Wilson Well IP it's a specialist area so we have what is actually one of the largest teams in the city but it is not as large as a mainstream corporate group so there is a degree of selection and we pride ourselves on getting the very best graduates to come and work with us in the team so not everyone can unfortunately join us but having said that we've grown as a team year on year over the last five years. We're continuing to grow. IP and technologies is a growing sector so there are more and more opportunities. So again for those who are really able and enthusiastic we would hope there is space for them to join us.
- Les Waters And what would be a typical career path for an IP lawyer after training.
- David Wilson Well one of the things we think is very important when someone qualifies and joins us in the IP group is to broaden their knowledge about IP. It may well be that they've gained a certain amount of knowledge as a trainee in one particular area but we send everyone who comes and joins us on an IP diploma course so they go to Oxford university and they do a course on IP which is two weeks residential and then leading up to some exams in the Summer and basically all their peers at other firms would be on that course. It's an opportunity to form relationships but more importantly to learn and get a basic grounding in IP law. So once they join us they've got that under their belt they start as junior associates so they're working in a team with others and they get the opportunity to see various stages of a dispute or a deal and gradually their level of responsibility will increase as they get more qualified over the years and then move up into a sort of middle ranking associate and finally as they become more of a senior associate they'll be running cases and deals more or less on their own but with some input and supervision from the partner on strategy but they'll have a lot of client interface and so its that progression of responsibility, feeling confidence in what you're doing and being able to gain from working on the job.
- Les Waters If somebody from a scientific or technical background is interested in the firm are there any other seats, career paths within your firm that are particularly appropriate or attractive to people with a more technical scientific background?
- David Wilson There are because aside from a specific intellectual property group we also have a technology media and telecom group which sits in our corporate area and although they do mainly non-contentious work they're involved in deals, transactions which quite often have a heavy layer of technology. It may be IT related in the sense of outsourcing arrangements. It may be specific telecom regulatory aspects. It may be more of the esoteric media regulation. Again, having a technology background can be useful there. And the other area which I think interfaces very well with IP is it's a slight different move really from perhaps your science engineering background but into competition increasingly there's a heavy overlap between IP and competition or anti-trust law and again having a real awareness of technology and perhaps the market which technology fits in is really important for some of our corporate clients who have issues with regulators about doing deals combining businesses where it's very important to be able to know what market, what products we're talking about, how the technology works.
- Les Waters Okay so there's some other really interesting areas as well then but just thinking about a scientist wanting to use their science it seems to me that if you go into some of the other professions around patent work you can be assured that you are going to use your science. If you are attracted to becoming a solicitor there is

more of an element of chance about whether you end up actually practising in IP so what would be the pitch that you would make to attract people to become a solicitor rather than these other perhaps slightly more obvious paths.

Joel Smith In terms of my practice and how it's been since I started I think it was in 1993 I've continually used my technical background in almost everything that I do. That's not to say that in my pharma project and my chemistry degree things that I studied during that need to be at my finger tips and overlap exactly with what I do but day on day we are dealing with people who have problems in the technology sector or issues that they'd like to resolve or questions, legal questions, in that sector and I'm just trying to think where I don't use it. I think the difference is, and I ought to say that on the patent side we tend to work very much hand in glove with patent attorneys, I can't really speak much of what a patent examiners role is because if you like they are on the other side of the fence. They're the people that grant patents or refuse them and it's our job as a patent attorney to either persuade them that it should be as how our client would like it to be or not. But I think the aspects of our role that differentiate it perhaps from the patent attorney is whereas the patent attorney probably has more direct contact with those doing the science or the technology in order to extract the essence of the invention to distil it into a patent we tend to be more on the detective side of things. If we're attacking a patent that we think has been improperly granted we will do the research into what the prior art was and whether the claims of the patent stand up to scrutiny and if we are defending a patent then we will have to sit down with the inventor and work out exactly what was done when and to make sure that it all stacks up so there's a forensic side of things is what differentiates us from the patent attorney. So that would be one of the reasons why if you like I came to this side of things because although I don't think I would be a lawyer if IP law didn't exist because I really was a scientist by training and by background it is the contentious side of things that attracted me to it and getting involved in the problems and the solutions that can arise during that. The other thing I really like about what we do is everything that we do be it a short piece of advice or a lengthy piece of litigation is you see immediately the value that you're adding to your client's business or it can be even a person on occasion. You see an impact of what you do fairly immediately and that's very rewarding.

David Wilson I think the other thing which really appeals to me which perhaps from my expertise is less present those other careers is that we get a sight of the bigger picture quite often. How the client is running its business, why the grant or the protection of this particular trademark or patent whatever fits with the business why it's really important to that business and quite heavily involved in strategic advice which may not just be in one particular country or in one particular business unit. It may have facets right across the world so that really appeals to me and the other thing I think is actually meeting people. We spend a lot of our time whether it's meeting in the sense of actually going to visit them or emailing or talking to them but basically interfacing with our clients finding out how they tick, what's important to their business, what's important to them in their personal life and I think that degree of personal contact is really important for me.

Les Waters How typical is your firm in relation to IP work compared with others. Is there a marked variation between firms and how IP fits into their business.

David Wilson Well the obvious answer to that is we'd say that ours is unique but it does vary

because if you look on most firms websites they will list intellectual property as an area in which they do practice but to what degree they practice it and to what interest it is to them as a firm does vary widely. A lot of firms who haven't decided to focus on IP offer it as a support service if you like so providing support to maybe the corporate department when there's a commercial transaction just making sure that the IP follows where the money is going if you like whereas other firms like Herbert Smith and others have selected IP as a core area as an area which they wish to specialise in and add value to their clients by providing the top quality service across all of the issues of IP so I'd say our day to day practice is typical for someone who is in a firm which specialises in IP and has identified IP as an important practice area for that firm.

Les Waters So for the average student considering different firms how do they get a feel for whether or not IP is central to the firm's offering and what advice would you give somebody in trying to choose a firm.

David Wilson Well, the internet is always a good place to start for a core screen. As I say most firms will say that they do practice intellectual property but even a brief skim through a firms website will give an indication about whether that's really serious or not and you can check out the firm's credentials and see whether they've been active in some of the big cases that have been going on to see whether or not they say they do it or whether they actually do it but the most important thing I would say is you cannot replace personal experience of a firm because what really matters is that you are going to enjoy working in a firm for, you hope,- the rest of your professional career and our firm as well as others offer vacation placement programmes where students at any time in their degree or even before they've started at university can come and spend days or weeks with the firm during the vacation periods to find out what it really is like and also it gives you an idea of the culture of the firm and whether they think they will fit in. I have to say our vacation placement programmes are heavily over subscribed. They are very popular so get those applications in early but that would be my best advice because there's no replacement for actually being in the firm, seeing how it ticks, how the people interact with each other and although we can give you a brief flavour now as to what we do on a day to day basis actually seeing it unfold I think is extremely valuable.

Les Waters You mention the word culture. What can you tell me about the culture and working conditions that go with working in IP?

David Wilson I think IP is a great place to work, not just in Herbert Smith but in any of the firms that really specialise in IP because it is relatively small community so everyone gets to know each other over a period of time you might be in litigation against another firm and get to know that person. You may be working on the same side or something. So I think it's very collegiate in the sense of getting to know people. The internal team I think is friendly. People get on well. Everyone here is here because they're academically bright. They have a strong interest in IP and technology whether it's specialised in the sense they've got an interest in Pharma or engineering or telecom media whatever. And they're all here really to strive to give our clients the very best service that they can and so that means that people pull together because there is really only a single objective which is to do your job well and to serve our clients to the very best of your ability but it's also a fun place. It's important to say that it's an area in which people all want to become

work to even if they've never done IP before they perceive us as being a really great team of people who get on well. Working hours generally good. I mean they obviously get longer at times when you're in the thick of coming up for a trial or you've got a major transaction they may be longer but they're reasonable perhaps compared with some areas of practice a more constant level of work really no sort of peaks and troughs. So I think it's an exciting place to be. The gannet of IP is constantly expanding. It's become a major issue for every company, every university, every inventor so I mean there are just so many opportunities.

Les Waters What about the impact of the recession on IP law.

Well obviously the recession has had an impact generally on business and companies and people are thinking very hard, probably rightly so, about how they spend their money and their resources but IP has remained pretty buoyant because people have got a longer eye on what's going to go on in the future. A bigger picture of where their business and their technology is going and they recognise that IP is central to growing their business and so I think to a degree whilst it's not been immune it has weathered the recession well and is picking up greatly and so again I think we are going to be in growth mode again over the next few years.

Les Waters Are there any other key points about the IP profession which we haven't covered?

David Wilson I suppose the only thing I would add is that if you become a solicitor practising in IP it doesn't preclude you from being members and dealing with lots of other bodies which are in IP whether you are a member of CIPA which is the Chartered Institute of Patent Attorneys or ITMA for the trademark attorneys or many other industry bodies. So if you have particular interests many of us are members of different bodies across the scientific and technology community and the IP community so it's another way of sort of networking with people in different areas. And the other thing I would probably mention is certainly at Herbert Smith we pride ourselves on solicitor advocacy so another option for those who come in qualified as a solicitor is to qualify as a solicitor advocate so you can appear in court a bit like a barrister. Whilst most of us don't spend all of our time doing that because we have a sort of different role to a barrister it does mean that from time to time certainly I and others in the group will appear in court. You can have the experience and the adrenalin rush of standing up on your feet so that's fun as well.

Les Waters Finally then, what would be your overall mention to undergraduates reading science, technology or engineering?

David Wilson Well bearing in mind that I'm obviously very biased the bottom line would be do it. It's tremendous fun. I've been doing it now for some 18 years. I tend to get bored very very easily and I'm not bored yet. It really is immensely interesting work for a former whether I'm a lapsed scientist, or whatever you want to call me, every new case that comes in the initial opening up of the papers what is the technology that's an issue here. It's obviously going to be different from yesterday but you're really going to have to understand fully the technology and the subject matter that the client is having an issue with and you're then going to have to liaise with them and really get under the surface and find out what makes them tick and what makes the technology tick. By definition if you like with patent law you're going to be dealing with the leading edge technologies and it really is incredibly interesting and fun. You also get the opportunity to meet and get to

know the client's business as Joel has mentioned and go and visit them wherever they might be in the world. I've also been lucky enough to act as an advocate in proceedings as far afield as Beijing in the patent office there and I've travelled and taken part in trials in Melbourne in Australia and all across Europe so it really is the variety and the ability to still to some extents have to but certainly if you want to use your training and your interest in science and technology so again to repeat I would heartily recommend it as a career path.

Les Waters Dave, Joel thank you very much indeed.

David Wilson Thank you.

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