

HOW CAN THE CHEMIST HELP THE PATENT LAWYER: THE CORPORATE CHEMIST HELPS THE PATENT LAWYER*

By BRUCE L. FAYERWEATHER

Patent Department, The Dow Chemical Company, Midland, Mich.

The title of this paper lends itself to a number of interpretations. The most obvious of these concerns itself with (1) the never-ending struggle of the chemist to invent and obtain patents without becoming enmeshed in the time-consuming operation of defining the limits of his discoveries and (2) the well intentioned efforts of the patent counsel to obtain sufficient of detail properly to present that same invention in such scope as to give the maximum of protection to his client.

I have had experience on both sides of this question, first as a corporate research chemist and for the past 25 years as a representative of The Dow Chemical Company in patent matters.

As a corporate chemist I have known the joys and sorrows of meeting the demands of inordinately thorough patent counsel. As patent counsel, I have experienced the exasperating reluctance of the chemist inventor to cooperate in the completion of insufficient disclosures. To take sides in this continuing friendly controversy would be to court disaster. Accordingly, I will drop the subject completely and proceed to the relatively safer ground of an interpretation originally intended by our moderator.

This second interpretation contemplates the careful and considered use of the qualified corporate chemist in the performance of a portion of the functions of the patent lawyer.

To each of you who has carried or shared the administration of a corporate patent department, with its problems of recruiting, maintaining and expanding a force of competent patent counsel, I extend my condolences. At no time in the past 25 years has there been a sufficient available supply of patent talent. Why the great possibilities in this field have not been recognized by both the legal and chemical professions is hard to understand. In spite of provisions in the statutes and rules of practice for technically trained men to qualify as patent agents or solicitors, the possibility of such activity seldom seems to occur to the chemist. Similarly with the young lawyer of scientific bent. In our continued searching of the law schools and universities it is a rare thing to find a man who has planned for a patent career.

With such a scarcity of "ready-made" qualified personnel, corporate administration is most often faced with little choice other than to out-bid the competition. This is a losing game and certainly establishes a poor precedent for counsel already on the payroll. However, there is not much alternative for the administrator who would maintain a shop consisting only of graduate patent lawyers.

Thirty-five years ago, The Dow Chemical Company selected as the nucleus of a captive patent group a man who had been chief engineer of the company, and two organic chemists, variously engaged in research and technical sales. Perhaps for this reason, the department of which I am a representative has operated since that time as a mixed group of patent lawyers and patent agents, each performing an appropriate function, and further relies very heavily on corporate chemists as liaison men in its relationships with research and development personnel. Of the individuals who presently are in active captive patent practice with our company, thirteen are patent lawyers, eighteen are patent agents, four are trainees, and one is a foreign patent specialist. In addition, we are assisted by twenty-one patent liaison men, two of whom are patent lawyers and nineteen are corporate chemists or engineers. I might add that each of these liaison men is carried on the payroll of the department or group he particularly serves and not on the patent department payroll. Men are designated to this work most frequently by research or development administration and are representative of the finest technical talent employed by the company.

All patent liaison people and the great preponderance of our patent agents are locally trained. While there is nothing particularly astonishing or original about Dow's operations in this regard, it has been suggested that I mention some of the qualifications we look for in a corporate chemist or engineer, something concerning our utilization of the corporate chemist and the functions of the latter in the several aspects of our patent program. This information is presented in outline form.

A. Preferred Qualifications of the Technical Person for Participation in Patent Functions

1. From 3 to 5 years experience with the company.
2. Either a master or doctor degree in science or engineering.
3. An extroverted personality.
4. A willingness to work and the ability to survive constructive criticism.
5. The ability to get along with people.
6. A professional outlook.
7. Young enough in age to justify the required years of instruction and training by experienced counsel.
8. The ability to think and write.

*Presented before the Division of Chemical Literature, ACS National Meeting, New York, N.Y., September 12, 1960.

**B. The Corporate Chemist In Patent Liaison,
Dow's Approach to Utilization**

1. Maintains at least one patent liaison man in each major research group and at each location concerned with research and development.
2. Organizes and carries out schools of instruction for all patent liaison men. In these, the more experienced lawyers and agents conduct seminars on the various aspects of the corporate patent operation.
3. Backs up the liaison operation by regular visits of patent counsel to each of the areas served by liaison personnel.
4. Encourages the individuals concerned in studying patent law and also in obtaining the general law degree by attendance at night school, when available, or otherwise.

Functions Performed by the Patent Liaison Chemist.

1. Maintains personal and friendly contact with the individual chemists and engineers in one or several research groups.
2. Works at uncovering previously unappreciated inventions as made by research and development personnel.
3. Influences research personnel to reduce their inventions to writing in the form of proper disclosures and transmits these to patent counsel.
4. Counsels inventors with respect to additional work required in defining the limits of inventions.
5. Influences the maintenance of a proper record keeping system in the research groups served.

**C. The Corporate Chemist or Engineer as
Patent Agent or Solicitor.
Dow's Approach to Utilization**

1. Selects and attracts from existing research and patent liaison personnel, the best qualified technical people available.

2. Continuously maintains a group of "on the job trainees" in preparation for the United States Patent Office Examinations for agent, solicitor or patent lawyer.
3. Maintains a balance in its corporate patent department between patent agents and patent lawyers.
4. Encourages the individual trainee independently to study patent law and write national examinations, as well as to obtain general law degree by night school, when available, or otherwise.

Functions Performed by the Patent Agent

1. Maintains familiarity with literature and developments in one or several technical areas of prime interest to the company.
2. Works with patent lawyers and research liaison personnel to uncover inventions and encourage sufficient disclosure of them.
3. Drafts, files and prosecutes domestic patent applications.
4. Counsels research personnel and aids in planning research.
5. Cooperates with and assists foreign patent counsel.
6. Works with patent lawyers in inter-corporation negotiations and in the determination of the terms of licenses and agreements.
7. Carries responsibility for the review and approval of company technical publications.
8. Cooperates with general legal department in patent and technical matters.
9. Cooperates with outside counsel as liaison in litigation involving patents.

In conclusion, it is the considered observation of our people that corporate chemists and engineers have made critical contributions in the past operation of our corporate patent section. Working side by side with patent lawyers, technical personnel can and will continue both as patent liaison chemists and as patent agents to enhance their own professional status and further the objectives of the patent department of The Dow Chemical Company.