

## Tech specs help IP lawyers navigate complex issues

**BY CRAIG M. DOUGLAS**  
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Judith Stone-Hulslander didn't much relish the idea of spending the rest of her working career in a laboratory.

So, about five years ago, the molecular biologist with a doctorate from the University of Massachusetts Medical School decided to change streams. She joined a law firm.

Stone-Hulslander was recently promoted to associate at Banner & Witcoff after working as a technology specialist at the intellectual property firm based in Boston. She now specializes in securing patents for the products and research flowing out of Banner & Witcoff's biotechnology clients.

"I was struggling with science as a career," said Stone-Hulslander during a recent interview. She is now awaiting the results from her Massachusetts bar exam, having recently graduated from Suffolk University's part-time law school.

As intellectual property grows more and more complex, patent attorneys have come to rely on a growing

class of in-house service providers with the ability to synthesize and interpret the technologies driving their clients' products.

Enter the technology specialist, commonly referred to as "tech specs" by those who employ and work with these industry gurus.

Steeped in the latest academia has to offer, tech specs are often veterans of the life sciences or information technology sectors. These lawyers-in-the-making generally hold doctorates, tend to be a bit older than the average legal associate and can spin some major yarn when it comes to their subjects of expertise.

Demand for these specialists has become particularly acute within the life sciences sector, as drug companies and medical device makers consistently ruffle their competitors' feathers by developing new versions of existing therapies.

"It can be very difficult to understand if you don't have a science background," said Stone-Hulslander, who joined Banner & Witcoff shortly after making her career transition to tech specialist.

A technology specialist's base pay at a law firm generally ranges between \$50,000 and \$110,000. Compensation often includes tuition to the tech

spec's law school of choice. It's a total price tag that can range between \$200,000 and \$500,000 over a three-to-five-year period, depending on the academic institution and the tech spec's course load.

In return, a law office has a bona fide expert on its hands, someone who can cut through the jargon, hype and question marks surrounding a given technology. Most importantly, tech specs have the expertise to determine whether a product or technology is unique, or whether it infringes on the patent-protected ideas of others.

John Lanza, a partner and intellectual property specialist with Choate, Hall & Stewart in Boston, said the added bonus of using a tech spec is that they perform hours of research and consulting services at a lower billable rate. Their affordability and ability to talk shop within a specific field often proves a winning combination when recruiting and retaining clients, he said.

That said, Lanza believes it is key that firms be selective when recruiting tech specs who can "go deep" when it comes to a specific industry or technology. "A firm is not going to have 50 or 60 of these people in house. It needs to be the right fit," he said.

At last count, Choate had six tech specs on salary. Lanza said they are all on the firm's biotechnology practice.

John Kendall, 41, was a chemist with drug giant Wyeth for five years before his career ambitions started to change. In 2001, he quit his job after stumbling over a story about tech specs in an American Chemical Society journal.

"It was really by happenstance," said Kendall, who has a doctorate in organic chemistry from Dartmouth College. Today he works as a tech spec with Fish & Richardson PC's intellectual property practice in Boston.

Kendall is one of 16 tech specs in Fish & Richardson's local practice. Most of those individuals are on the life sciences side of the firm.

"I've seen (the roll of tech specs) change at the firm," said Frank Occhiuti, a Fish & Richardson partner and one-time electrical engineer. He joined Fish & Richardson after working as a patent agent for defense contractor Raytheon Co. in Waltham.

"My sense is there's a greater appreciation for tech specs, and I think the firm is perfectly happy with tech specs" who opt to stay in that position indefinitely, rather than going on to law school, Occhiuti said.

He said a more structured day, something along the lines of a 9-to-5 schedule, and reasonable pay have made the tech spec position an attractive career choice for many life sciences and IT veterans.

At Banner & Witcoff, six tech specs are on the firm's payroll. Five of those in-house experts have a life sciences background, according to B&W partner Ernie Linek.

Linek said that having an experienced stock of in-house tech specs is an excellent recruiting tool when it comes to luring more of these experts to the firm. "It definitely gives us a leg up on the competition," he said.

The firm encourages its tech specs to become patent agents and eventually attorneys, similar to the path that Stone-Hulslander took after scrapping her plans to be a molecular biologist.

"At that point, their responsibilities are multiplied," Linek said.

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