

Inside the life of a patent prosecution boss

Carla Ji-Eun Kim, chair of Sterne Kessler's patent prosecution practice in Washington DC, reveals the perks and challenges of her job – and where she gets her coffee

By Rani Mehta

Carla Ji-Eun Kim, 50, has worked for Sterne Kessler since 2006, shortly after she graduated from the University of Minnesota Law School. She has been a director at the firm since 2014 and currently serves as chair of the firm's patent prosecution practice in Washington DC.

In a Q&A, she tells *Managing IP* about her work life and some of the challenges she has faced – including those related to the emergence of complex technologies in the biotech industry.

She also sets out what she loves about her job and talks about her passion for hiking.

What are your biggest challenges?

There is a lot of demand for patent attorneys nowadays, especially in the biotech sector, so there's a lot of work.

I love the work, but it can be challenging to handle the different technologies and clients.

A lot of it involves the combination of computer science and biotech, and not many people understand that those technologies are merging in new ways.

People who have computer science backgrounds are often wired completely differently from those with biology or biotech backgrounds.



Additionally, patent law is constantly changing, not only in the US but in foreign countries as well.

I tend to file in 40 or 50 countries for the important applications, and I really need to know in advance what the laws are and how they have changed for double patenting and obviousness.

We really have to be on top of the changes, which is why we have so much training and hold so many roundtables – but that can be challenging.

What’s your favourite part of your job?

Interacting with the clients is one of my favourite parts.

A lot of clients are very appreciative of the work that I and the firm as a whole do.

I also like to learn new technologies. When I was young, I wanted to be a scientist. I’m not a scientist anymore, but I get to learn new science from the clients.

Where do you get your coffee in the morning?

I make my own coffee.

I make Bulletproof coffee, which means that I add butter and oil in the coffee, and I blend it. It sounds crazy – adding butter into coffee – but that’s what I start my day with.

What do you do in a typical day?

I start my day at around 7am or 8am and read my emails.

I get a lot of them because I’m a prosecutor and receive messages from all over the world about office actions or client requests, and it takes quite some time to go through them all.

My day is filled with client meetings to discuss any projects those clients have given us. Sometimes, I also have calls with foreign patent agents to discuss potential oppositions or actions.

In the afternoon, I work on filings.

We have due dates for the USPTO and for PCT applications, and I review those filings. As patent prosecutors, we don’t want to miss due dates.

Our firm has a docketing system that allows us to avoid doing so, and I also have a personal docket where I keep track of deadlines.

Sometimes I have internal meetings with associates or paralegals that can include training or working on client matters.

I also teach courses at the firm. We just had a patent prosecution roundtable yesterday, and I moderated the discussion.

I have foreign clients, so sometimes I have calls late at night too.

What do you do for fun (outside of work)?

I go to the movies.

Wellbeing is also very important, so I do yoga, Pilates and I hike on the weekends.

I go on an eight-to-10-mile hike almost every week and do some meditation to try to calm myself and take care of myself.

My favourite hike is Old Rag Mountain in Virginia.

What would you like scientists and inventors who work with patent prosecutors to know?

When scientists communicate with me, their communication is protected under attorney client privilege.

But this privilege can be waived – and when they discuss freedom to operate issues with potential collaborators, they need to be extremely careful that they’re not discussing too much.

When they write emails, they don’t want to say that they’re infringing a patent because that could be discovered down the road.

Ji-Eun Kim has [spoken to](#) Managing IP in the past about reviving seemingly failed patents at the USPTO.

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Carla Ji-Eun Kim is a director in Sterne, Kessler, Goldstein & Fox's Biotechnology & Chemical Practice Group. She also serves as the chair of the firm's Patent Prosecution Practice. Carla advises a diverse group of biotechnology companies on building worldwide exclusivities around their products. In her practice, Carla focuses on finding and creating innovative ways to extend exclusivities that are well integrated with her clients' technological and business objectives. For example, Carla counsels her clients on the preparation, prosecution, and management of complex worldwide patent portfolios in areas of

biotechnology such as therapeutic antibodies, antisense technologies, personalized medicine, vaccines, nucleic acid therapies, formulations, bioinformatics, pharmaceuticals, and cell culturing/bioprocessing methods.

Carla also has extensive experience in IP due diligence investigations and freedom to operate studies, and she prepares patentability, validity, and noninfringement opinions in connection with licensing, acquisition, and investment.

Carla received her J.D. from the University of Minnesota Law School,

cum laude, her M.S. in pharmacology from the University of Minnesota and her M.S. in cell and molecular biology from the University of Pennsylvania. Carla's graduate research focused on molecular genetic mechanisms of DNA repair in mammalian cancer cells and developing an anti-angiogenic approach to cancer therapy and treatment. She earned her B.A. in biology, magna cum laude, from the University of Wisconsin, Stevens Point.

Carla is an Adjunct Professor at George Mason University Antonin Scalia Law School, teaching patent prosecution.