Selecting a Patent Attorney and Avoiding Invention Marketing Companies

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I. Considerations When Selecting a Patent Attorney.

A. The Goal

The goal is to obtain a patent with valuable, broad claim scope. You want a patent potentially worth millions - not a worthless piece of paper framed on your wall collecting dust. Obtaining a patent is not an exercise in negotiating a "middle ground" with the United States Patent and Trademark Office ("USPTO"), and certainly not in unnecessarily conceding every argument to the USPTO and leaving valuable claim scope, and market potential, behind.

B. Is the Attorney a Patent Lawyer Licensed to Practice in the U.S. Patent Office?

If not, find someone else.

C. Speak with the Attorney.

Before selecting an attorney, speak with the attorney to gauge his/her understanding of the patent rules and how to create a valuable patent. Does the attorney discuss broad claim scope? Know how to obtain it? Look online at the patents that the attorney prepared and prosecuted. Are they thorough? Well organized?

D. Who Will Do the Work?

Is the attorney with whom you speak, or a different attorney, going to prepare your application? Often senior attorneys work with junior attorneys, or other senior attorneys. If a different attorney will prepare your application, speak with him/her.

E. What is the Attorney's Technical/Professional Background?

The attorney should have a technical or professional background that demonstrates he/she is qualified to understand your invention, and is able to prepare and prosecute an application that can mature into a strong patent.

F. Hourly Rates Versus Total Cost.

An attorney's *hourly rate* is often irrelevant to the total cost to prepare a patent application, prosecute the application, and obtain a patent. What is relevant is quality and *total cost*. Many attorneys with higher hourly rates are more efficient than those with lower rates, and use lower-cost paralegals or other staff to perform routine tasks, such as filing, docketing, and reporting communications from the USPTO to you. When comparing costs, the *total* anticipated cost is the only relevant metric.

G. How Are USPTO Deadlines Tracked?

USPTO deadlines are often inflexible. If an attorney uses an appointment calendar for reminders, and has no specialized patent-docketing software, or docketing staff, you may be dealing with an operation that could miss dates, which could lead to a loss of rights.

H. What Resources Are Available?

A one- or two-person shop may have difficulty juggling multiple obligations such as vacations, illnesses, family commitments, workload, and staying current on patent laws and USPTO procedure. Firms with more depth are better suited to cover multiple tasks and handle emergencies.

I. Red Flags.

When selecting a patent attorney, each of these issues should raise a red flag:

1. The attorney is not a patent attorney registered with the USPTO.
2. The importance of broad claim scope and how to obtain it is not discussed.
3. The attorney is overly anxious to push you into preparing a patent application.
4. The attorney is overly enthusiastic about the market potential for your invention. Patent attorneys are not marketing experts.
5. The estimated costs are extremely low, or difficult to understand.
6. The attorney does not explain what type of patent application, such as utility, design, or provisional, he/she will prepare.
7. The attorney pushes you towards filing a "low-cost" provisional application.
8. *Prosecution* of your application, and the associated costs, are not explained. Only the cost of *preparing and filing* the application is discussed. Prosecution costs are often more expensive than preparation and filing.
9. The attorney does not understand your invention. Whether the attorney has prepared applications for inventions in the exact same technical field as your invention is not important (and, if so, he/she may be legally disqualified from representing you). But, the attorney should at least have an understanding of your invention and how to protect it.
10. A review of patents prepared by the attorney on the USPTO site shows that they are difficult to understand, or use outdated constructs that could adversely impact your patent, such as including "objects" of the invention in the summary section, or a lengthy synopsis of others' patents in the background section.

II. Avoiding Invention Marketing Companies.

Invention marketing companies are organizations that claim to be turn-key operations, allegedly assisting inventors in all aspects of getting an idea to market – from patenting to marketing to sales. They are not law firms, often have no expertise in the market for your invention, no contacts in that sector, and outsource patent services. Their "marketing" may be nothing more than providing *you* with form letters and general information about businesses obtained from public sources. Problems with invention marketing companies were so bad that in 1999 Congress enacted a law to curb the false expectations, improper selling techniques, and excessive prices they charged. The law requires invention marketing companies to disclose the following information:

1. The number of inventions evaluated by the Company in the past 5 years.
2. The number of the inventions evaluated by the Company that it turned down.
3. The number of inventors who contracted with the Company over the past 5 years.
4. The number of inventors who received a net financial profit as a *direct result* of the services provided by the Company.

5. The number of inventors who received license agreements for their inventions as a *direct result* of the services provided by the Company.

6. The name(s) and address(es) of the previous invention Companies with which the Company or its officers have been affiliated for the last ten years.

In addition to the above six items, ask any invention marketing company the following, and leave if you do not receive a straight answer:

1. What will be the *total cost* of the Company's "advice" and "marketing assistance"? You should at least get an estimated range. Does the Company take a percentage of licensing or sales revenues in addition to the fees you are obligated to pay?

2. Can you select your own patent attorney? If not, why not? Can you meet with the patent attorney used by the Company? Can you review the attorney's work on line? If not, why not?

3. What experience does the Company have marketing inventions in your field?

4. What will the Company do to contact potential buyers or licensees? Often, the Company does nothing more than provide you with a form letter and public list of businesses. The burden of contacting businesses and selling or licensing the invention falls on you.

5. Do you have an "invention" or merely an "idea"? If you only have a general idea, and do not know the physical structure, or operational parameters, in sufficient detail to teach others how to make and use the idea, you have not yet conceived an "invention" that can be patented. If you are being pushed into signing a contract without having a patentable "*invention*" – walk away.

Obtain this information, take it home, and think it over before signing a contract. The best advice is not to entrust the patenting of your invention to anyone other than a patent attorney with whom you deal directly. Also, be wary of people (often invention marketing companies) that contact you after your patent application publishes, or when your patent issues, offering to help you "market" the invention. If you respond to them at all, ask them the above questions.

III. Conclusion

Selecting a patent attorney should be based on your overall comfort with the attorney and his/her organization. Best to stay away from invention marketing companies, which may overcharge and under deliver.

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David Rogers practices patent, trademark, trade secret and unfair competition law, including litigation, patent and trademark preparation and prosecution; trademark oppositions, trademark cancellations and domain name disputes; and preparing manufacturing, consulting and technology contracts.