Choosing the Right Patent Person for Your Inventions

This Patent Stuff and My Semiconductor Business – Part 5

Welcome to this post about patents and chips. Not a lot has been written about this combination, but there is a lot to know, especially for the innovators and entrepreneurs themselves. In this three-weekly series, I talk about various aspects, from my dual points of view of a patent agent and a semiconductor entrepreneur. If you like the article and read it on LinkedIn, give it a thumbs up, and/or click on Follow. If you like to work with us for your next patent, "contact us" info is on www.icswpatent.com. You can also subscribe/unsubscribe for short email alerts when the next post is available.

In this month's column we're going to look at finding you the right patent guy or lady. It could be me if your inventions are brilliant and relate to mixed-signal circuits, RF systems, digital communication systems, or some other stuff that I find fun and exciting. Or I can get or provide you the right person, or refer to her or him. Or, with the information in this article, you can bypass me completely and decide for yourself.

A patent *practitioner* can be either a patent *lawyer*, or a patent *agent*. In some countries, the distinction doesn't exist, and there are only patent lawyers. In other countries, even patent agents are called patent attorneys—making the situation more confusing. Let's make the distinction first. What I call a patent lawyer is a person who has a degree from a law school, and in the case of the US, who has passed both a state's bar exam as well as the patent bar exam. A patent agent is not a lawyer, and hasn't passed a state's bar exam, but has passed the patent bar exam. What matters most is the actual career path: a patent lawyer may have mostly legal experience, whereas a patent agent probably has mostly technical experience. In the US, a patent lawyer must still have at least a BSc in a technical or scientific field. In some other countries, this is not required, and patent lawyers may depend on contractors of their choice to "look at" the technical aspects of your invention.

Generally, a patent lawyer charges more per hour, so you must decide if a patent lawyer provides you with extra value above a patent agent.

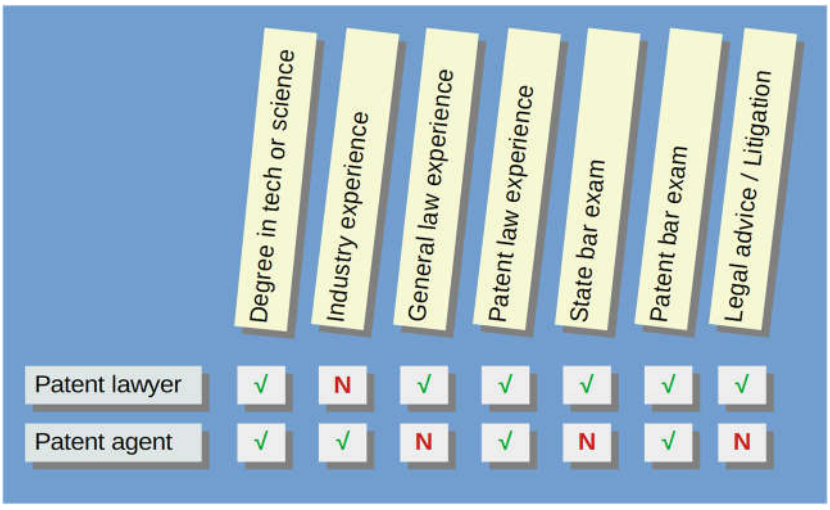

Figure 7 - Patent practitioners compared (US)

Figure 7 compares patent lawyers and patent agents. Note that this is specific to the US, and in some other countries it is really different. Having said so, generally a patent lawyer offers you the broadest range of legal skills, but he or she may not be very experienced in your technical field. He or she may be perfect if your inventions are understandable without deep field-specific knowledge. A patent agent may be perfect if your inventions require the right technical or scientific background and a deep level of understanding, but you are not looking at litigation. In other words, a new invention in communication systems or circuits may require a patent agent to get a stronger patent, but will require a lawyer when your competitor infringes, and you want to sue to stop them.

"May" and "may not" are not very definite indicators, so how are you going to screen the person? I'd say, here are a couple of things to ask:

- Do you have a law degree?
- What technical or scientific degree do you have? Which university?
- How many years of industry experience do you have? What work were (or are) you doing?
- Has your work focus been more on software or on hardware?
- Have you ever designed ICs? Did they go in production?
- Have you ever designed firmware? Was it used in production?
- Have you ever developed software that was rolled out to multiple customers?
- Have you ever been involved in process development? Did the process get into production?
- How many years of industry experience do you have, and how many years as a patent practitioner?
- Do you always fully understand an invention for which you write a patent application?
- When writing an application, do you ever rely on the inventor to know things that you don't know?
- When you receive an office action, do you check with the inventor: never/sometimes/regularly/often/always? (My vision: *sometimes* and *regularly* are good, but not *never*, *always*, or *often*. A practitioner who understands your invention is usually able to defend it without disturbing your inventor. But in some cases, the prior art may be complicated, or he or she needs to check what is really the most important for you, and what doesn't matter so much.)
- When fighting for an application, how often do you arrange an interview with the patent examiner? (My vision: sometimes, regularly, and even often are good, but not never or always. An interview helps the communication between practitioner and examiner, often resulting in fewer office actions, but it is not always needed.)
- For my type of invention, how many office actions do you expect before the patent is granted? (There is no guarantee here, though, because it depends on the quality of the invention, on the application, on the practitioner, on the examiner, and on how crowded the field is. If a practitioner is working in his/her sweet spot, the average number of office actions may be below 1.0. But for some areas of software like AI or user interfaces, it may be between two and four. Sometimes there are more than four office actions.)
- How soon do you advise to abandon? (If you have a patent strategy that prefers quantity over quality, you will want your practitioner to hang on like a pitbull. If you seek quality over quantity, you won't want to invest in patents that don't give you a competitive advantage, and you will want to abandon cases that look like they will depend on legalities.)

- What will you tell us when you feel that an invention we disclose will be hard to get patented?
- How will you help us when we experience an infringement case?

Patents can be costly, and not all practitioners charge the same. More expensive doesn't necessarily mean better, and neither does less expensive necessarily indicate a lower quality. This series teaches you at least some basics that help you form a first idea about the quality of a patent. If your practitioner writes a specification that cannot be followed, there is a red flag. If the claims contain weird language, they may be OK, but if (especially) claim 1 describes an invention that makes no commercial sense, you'll want an explanation what is going on. If you ask the practitioner to present you an overview of the likely patent costs all the way through granting (or even to expiry after 20 years) and you get an answer that just covers the cost through filing, or for throwing together a provisional application, then you may need to polity ask for the costs of prosecution, issuance, and maintenance.

After this discussion, you are likely to have a good idea what to expect. And after the first two or three patents, you will really know.

Upcoming:

6 How is a Chip or Firmware Patent Different than Other Patents? What About a Software Patent?

7 Woohoo! I Invented a Huge Improvement over My Competitor's Invention!

8 I'll Be A Billionaire Soon Enough. But Now I'll Just Buy This Book on Patent Writing on thriftbooks.com.

9 My CTO Can't Explain His Invention to Me. But He Is the Smartest Guy in the World.

10 Should I Do a Provisional, Non-Provisional, Or a PCT?

Published so far (find them on www.icswpatent.com or #ThisPatentStuff):

1 So You Got This Great Idea That Will Wipe Out Competition. Now What?

2 Developing an IP Protection Strategy for Your Semiconductor Company – PART I

3 Developing an IP Protection Strategy for Your Semiconductor Company – PART II

4 In What Countries Should I Patent, Anyway?

5 Choosing the Right Patent Person for Your Inventions

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