

What to Expect When You Change Patent Firm

This Patent Stuff and My Semiconductor Business – Part 36

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 a dual perspective 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.

There can be several reasons why you'd want to change patent firm. Or have to. Whatever the reason, a key factor in the success of the change is how realistic your expectations are for the new firm. You can look at a couple of objective things first, like what type of firm you engage with, and who will service you. Do both the law firm, its areas of expertise, and its practitioners match your company? By asking the right questions, you may get expectations that are both high and realistic.

"Big Law" vs Boutique Shop

In a Big Law firm, you may expect a number of partners, and a number of practitioners working for them. There is often a focus on "billable hours", meaning revenues per practitioner. The company will likely accept work related to whatever technology. However, they can have dedicated technology teams, such as one or more teams dealing with electronics. They probably focus on big customers that have a steady budget for patent work.

A boutique shop is of course on the other end of the spectrum. They may be as small as one or two practitioners, and everybody but the owner/partners is a contractor. They are likely dedicated to one technology (hopefully semiconductors ;-). They may focus on providing the best value for that technology, or providing a particular service model, and they may not be very interested in large clients. They may even decline work that is profitable but outside the focus area.

The above characterizations are generalized and may not always be correct. There are of course also quite a few law firms in between these two extremes. The point is basically that the culture may vary significantly with the type of company, and the culture may impact the type of work. But you have to check, because there are stars all over the sky.

What you can ask to get an idea what to expect is: (1) how many of their practitioners are specialized in semiconductors; (2) how many applications does each practitioner write in an average month; (3) who are some of their current

customers; and (4) provide some examples of patents filed for other customers. Note that each client with a published application is in the public domain, and the firm doesn't need to give away privileged information.

Another issue to consider is whether the new firm can only do prosecution, or both prosecution and litigation. Prosecution means getting the patent for you. Litigation means fighting a challenger or competitor in court. It is convenient to have the same under one roof, although the litigator is probably a different person than the prosecutor, who has the technical background. Litigation is important for larger clients, who have the budget to support it. Smaller patent law firms will pull in a larger firm with which they're associated and with which they have ongoing business.

Patent Lawyer vs Patent Agent

Regardless of the company you're engaging with, you also want to check the practitioner(s) (patent lawyers or agents) you'll work with. I wrote about this before, there are real differences between the two groups: lawyers have more background in law, and agents have more background in technology. Both groups have a science or engineering degree, and both groups have passed the patent bar exam. Lawyers often lack industry experience, but they have completed law school and passed a state bar exam. They may have litigation experience. Agents lack the general law experience, but they usually have industry experience—and sometimes for decades.

In your case, if you are an expert in some area of chip design and you have made a new invention, there may be no patent practitioner in the world with your level of expertise. Whoever drafts a patent for you may need to ramp up and learn to understand the words, acronyms, and architectures you're using. This can take time. A patent agent may catch up quicker and reach a deeper understanding, but some lawyers have built up a very respectable level of expertise in some areas.

One downside to finding the most expertise is that the expertise may come from one of your competitors, and the expert patent agent may not be allowed to work with you.

Again, before you commit, you want to have a chat with the practitioner(s) proposed to take on your work, and see if you like them. Ask about their industry background, design experience, and to see some of their applications. Also, ask them how they expect to interface with you during the process of drafting a patent application, and while defending it at the patent office.

No two personalities are the same, but I have some good news. ALL patent practitioners I know who understand semiconductors are great people! The downside is that there are very few of us, and unfortunately quite a few chip patents are written by people who don't understand semiconductors. However, please judge people by their work, not by their formal qualifications. I know a lawyer who writes great AI chip patents, despite having a background in industrial design rather than electronics. He just happens to love math, and caught on to AI pretty early.

The Transition

Different practitioners have different styles and experience, and this will impact how they describe, claim, and defend an invention. My golden rule is that whoever will defend your application at the patent office should also be the person

who writes it, including the claims. You don't always have that luxury, though. If you change patent law firms before a pending application is granted, the new firm will inherit the application.

Often, the new practitioner first needs to go through the learning process to understand the invention. Sometimes it is hardly necessary, but in some cases it takes significant time. You will probably not be charged for it, since we all love new clients. But the practitioner and the inventor may need some time to talk to get on the same line.

What If You Still Have Doubts?

First, ask your practitioner why he or she does things the way he/she does. Good practitioners don't mind explaining. If he or she modifies your claims to no longer be understandable, discuss it. If you keep feeling uncomfortable, see if you can change practitioner first before you change law firm again. In general, take a pause before making any changes.

Upcoming:

37. They're Selling Our *&^\$#%@* Design!

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33. Five Ways Great Inventions Ended up with Not-So-Great Patents
32. My Invention Can Be Implemented with 500 Different Circuits. Can A Patent Cover That?
31. Can't I Just Hide My Invention in My Chip?
30. How Patents, Secrets, Open Source, and Reverse Engineering Help Humanity
29. Geez, One-And-A-Half Page to Describe My Netlist in One Sentence!
28. CES or DAC Is within Weeks. I Got to Present and Demo There!
27. Is it OK if I Can Hardly Recognize My Own Invention in the Application?
26. So What If the Patent Guy Doesn't Understand?
25. I Can't Wait for the Patent Office for 3 Years, Can I?
24. Can I Check If My Patent Guy/Gal is Doing a Good Job?
23. Do I Really Need to Spend So Much Time to Get a Patent?
22. They Don't Understand My Invention!!
21. Why Are Patent Claims So Weird, Anyway?
20. My Company is in Brazil. How Do I Manage Patenting Worldwide?
19. How Many of Those Patent Office Actions Should I Budget For?
18. Should I Pay Extra to Get the Patent Faster?
17. A Prior Art Search Before Filing the Application
16. How Do I Screen My Employee's Invention Before Deciding on a Patent?
15. How Do I Know If My Invention Is Patentable?
14. I Want to Use an FPGA Before an ASIC. Can It Be One Patent?
13. I Want to Protect It Now, But Am Still Working Out Architecture Details. Can I Add Those Later?
12. My Invention is Vital for My Business Plan. But I Don't Have Much Money Yet. How Can I Save?
11. What Makes an Inventor, and How Can I Stimulate Innovation?
10. Should I Do a Provisional, Non-Provisional, Or a PCT?

9. My CTO Can't Explain His Invention to Me. But He Is the Smartest Guy in the World.
8. I'll Be A Billionaire Soon Enough. But Now I'll Just Buy This Book on Patent Writing on thriftbooks.com.
7. Woohoo! I Invented a Huge Improvement over My Competitor's Invention!
6. How is a Chip or Firmware Patent Different than Other Patents? What About a Software Patent?
5. Choosing the Right Patent Person for Your Inventions
4. In What Countries Should I Patent, Anyway?
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2. Developing an IP Protection Strategy for Your Semiconductor Company – PART I
1. So You Got This Great Idea That Will Wipe Out Competition. Now What?

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