

Top 10 Things to Consider When Selecting an Attorney to Help Patent
Your Invention
by Kirk Coombs

You have a great idea and need to get a patent to protect it. Great! What's next? *Before you make any public disclosure of your idea*, you need to find an attorney to help you file the patent application with the United States Patent and Trademark Office (USPTO). Where do you begin? What should you look for? Here are a few things to consider.

1. **You need a “patent attorney.”** Not just any attorney will do. You need to find an attorney who is qualified and registered to practice before the USPTO. In addition to a law degree, a patent attorney has a technical background in the sciences (often a degree in physics, chemistry, biology, or engineering), and has passed the USPTO's “Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office” (usually referred to as the “patent bar”). General practice firms may have one or more patent attorneys, while specialty firms (such as Workman Nydegger) focus specifically on patents and other intellectual property (IP) matters.
2. **Don't hesitate to shop around to find the right fit.** Many people are hesitant to reach out to an attorney fearing they will receive a bill in the mail. A firm should not bill you anything until you have actually signed an engagement letter with the firm, with terms of billing being spelled out in that letter. Most patent attorneys are happy to meet with you, free of charge, for an hour or so prior to any engagement. These meetings are helpful for the attorney to get to know you, to familiarize you with the firm and its attorneys, and to discuss your options for protecting your idea at a general level. Meet with multiple firms until you have found one that you feel comfortable with.
3. **Find an attorney with expertise in your idea's technical field.** A patent application is both a legal document and a *technical document*. As such, make sure that you find an attorney who is able to fully understand your invention at the most technical level so that he/she can draft a document that fully and clearly describes it. Most firms that practice intellectual property place attorney profiles on their websites that include each attorney's technical background. When shopping for a firm, look for one that has an attorney(s) with the appropriate technical background, and consider asking specifically for that attorney when you contact the firm.

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4. **Meet the attorney who will be drafting your patent.** Often times, the attorney(s) you initially meet with will not be the one who actually drafts your patent application. Don't hesitate to find out which attorney will actually draft your patent, and ask to meet with him/her-even during your first meeting with the firm. When "disclosing" your invention to that attorney, be sure that he/she is conversant in the technology and understands what you are disclosing. Look for an attorney who is able to ask insightful questions and demonstrates a thorough understanding of your invention.
5. **Discuss billing arrangements.** You should not engage a firm to draft your patent application until you have a clear idea of how much it will cost. Often times, once the attorney understands the technology and complexity, he/she will provide an anticipated cost, a range of anticipated costs, or even a fixed fee for drafting your patent application.
6. **Discuss the total cost of obtaining a patent.** Filing a patent application is only the first step. Once it is filed, it is queued for consideration by a Patent Examiner. It is normal for a patent application to be rejected by the Patent Examiner one or more times prior to being approved or abandoned. You should discuss what the firm charges for "prosecuting" the patent, including typical costs for responding to rejections from the USPTO.
7. **Discuss the firm's relationship with the USPTO.** Often times, the speed and quality of the examination of a patent application can be greatly improved by conducting "examiner interviews" when a patent application is rejected. This involves the attorney discussing the patent application and the grounds of the rejection(s) with the Patent Examiner on the phone, in a video conference, or in person at one of the USPTO's locations. You can be well-served by choosing a firm that has a good reputation with the USPTO and that has a regular habit of conducting examiner interviews, particularly in-person interviews.
8. **Consider the firm's experience with foreign filing.** If you are interested in also filing your patent application internationally, you should ascertain the firm's experience with foreign filing. You may want to ask questions such as:
 - How many international patents does the firm file each year?

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- Does the firm have relationships with other firms in the particular jurisdictions you are interested in?
- How familiar are the firm's attorneys with the patentability requirements in the particular jurisdictions you are interested in?
- What are the typical costs involved with foreign filing?

9. **Determine if the firm also litigates patents.** Some firms focus solely on "prosecuting" patents—i.e., filing patents with the USPTO and working with Patent Examiners to get them approved. Other firms (such as Workman Nydegger) also litigate patents—i.e., enforcing and defending patents in the courts. You may want to consider a firm that does both.
10. **Determine if the firm has experience with other IP matters.** There is much more to IP than just patents. Determine if the firm can help you with other IP matters such as trademarks, copyrights, software licensing, patent licensing, patent valuation and sales, nondisclosure agreements, trade secrets, patent infringement analysis, freedom to operate analysis, etc.

Choosing an attorney for any type of matter can be daunting, especially for something as specialized as patents. When engaging any firm, it is essential to find one that is a good fit for you and your business. Being mindful of the considerations above should help you ask the right questions and make an informed decision.