

ASSOULINE & BERLOWE, P.A.

ATTORNEYS AT LAW

3250 Mary Street, Suite 404

Miami, FL 33133-5232

Telephone: 305-567-5576 · Facsimile: 305-567-9343

How to Qualify a Patent Attorney

Choosing the wrong patent attorney can lead to years of frustration and unnecessary costs. Worse, a badly written patent might not even protect your invention and could bar you from filing a corrected patent application.

While most of my clients have never been taught how to qualify a patent attorney, many start in the right place. They ask a trusted advisor or attorney for a referral. Most attorneys recommend an established patent firm or a law-school classmate.

This may be a good start but any qualified patent attorney should pass all of the following objective tests.

1. Find a Registered Patent Attorney

A registered patent attorney is a member of both the U.S. Patent Bar and the local state bar.

To file and argue patent applications, a practitioner must be “registered” in the United States Patent and Trademark Office (USPTO). Being a member of a state bar is not enough. So, a practitioner who is not registered, even a trademark attorney or an Intellectual Property attorney, cannot file a patent application.

A “patent agent” is not a patent attorney. A patent agent is a practitioner who has passed the patent bar exam but not the local state bar. A patent agent can file patent applications. However, a patent agent cannot discuss legal issues such as licensing or infringement.

To confirm if a practitioner is registered check <https://oedci.uspto.gov/OEDCI/>

To check if a practitioner is a member of the Florida Bar check <http://www.floridabar.org/names.nsf/MESearchDK?OpenForm>

2. Choose a Board Certified Intellectual Property Attorney

The Florida Bar recognizes specialists in the field of Intellectual Property by awarding them a Board Certification. Board Certification is based on the following criteria: a minimum of five years in law practice, a satisfactory showing of substantial involvement in the field of law for which certification is sought, a passing grade on the examination required of all applicants, satisfactory peer review assessment of competence in the specialty field as well as character, ethics and professionalism in the practice of law, and satisfaction of the certification area’s continuing legal education requirements.

A list of Florida Bar Board Certified Intellectual Property Attorneys can be found at <http://www.floridabar.org/DIVCOM/PI/CertSect.nsf/9736b6935363096385256fd4005e5cea/79e88f175562f769852571d30050c699!OpenDocument>

3. Check the Attorney's Discipline History

The United States Patent Office's Office of Enrollment and Discipline (USPTO-OED) maintains a forum of complaints by inventors:

http://www.uspto.gov/inventors/scam_prevention/index.jsp

The Florida Bar posts the discipline history of every attorney on each attorney's profile:

<http://www.floridabar.org/names.nsf/MESearchDK?OpenForm>

4. Choose a "Hands-On" Attorney

"Hire an attorney, not a law firm." It is a cliché known among in-house attorneys but not by most other legal-service consumers. Make sure the patent attorney that you are hiring is the one who will do the work. Many large firms have expert senior attorneys who originate work but then send the case to an entry-level attorney for completion. So, simply ask any potential patent attorney, "Who will do the work?" Using a qualified associate can be a way to save legal fees. However, if an associate attorney is to be involved, qualify that associate.

5. Embrace Alternative Billing

Have you ever hired a plumber or car repairmen without a set fee? Don't make the same mistake with an attorney. Do not hire an attorney using hourly billing. Hourly billing gives an attorney all the wrong incentives and leads to frustrated and cynical clients.

Set a flat fee. At least set a flat fee for writing the patent application and for processing each step of the application. Even better ask for one price for the entire project. Know that contingency fees are almost never offered for patent prosecution.

For more than one invention, ask for retainer or subscription billing.

About the Author:

Loren Donald Pearson is a partner at Assouline & Berlowe, P.A. He is a registered patent attorney and Florida Bar Board Certified Intellectual Property Attorney. He leads the firm's patent and trademark prosecution practice.

For a consultation for patent prosecution, call Mr. Pearson at (305)-567-5576
Blog: www.LorenPearson.com