



In the News

How to Choose a Patent Attorney

December 05, 2019 | (Time to read: 3 minutes)

Choosing a patent attorney to prosecute your patent is an important and complex decision. There are obvious factors to keep in mind, such as cost of the patent prosecution services and how experienced your attorney is. However, there are other key questions to keep in mind while selecting who you trust to handle the patent prosecution for your invention.

Drafting a patent requires understanding the technology to be protected. A patent for an invention within a technical field is safest in the hands of an attorney with educational and work experience within the same industry. A patent attorney who understands the complexities of your invention can write thorough patents that outline the precise details of your invention, maximizing the protective benefits of your patent. In addition, selecting a patent attorney with prior experience in your field allows for easier communication and streamlines the patent process, allowing your attorney to work in a timely and cost-efficient manner.

Patent Litigation

Another question you need to ask your attorney is if their firm provides patent litigation services. If you believe your invention falls within a relatively uncontentious field and is at a low risk of being the subject of a patent infringement lawsuit, then selecting a patent attorney that works within a firm that only provides patent prosecution is acceptable. However, if your invention is in a particularly competitive or profitable field, it is wise to ensure that your patent attorney's firm also offers patent litigation services.

In competitive industries such as pharmaceuticals, semiconductors, telecommunications, medical devices, and computer hardware components, patent infringement lawsuits abound as companies work to ensure that they have unequivocal control of key technologies within the industry. If you work in one of these industries, keep in mind that you may face claims that your product infringes upon a competitor's intellectual property or you may need to pursue legal action against a competitor infringing upon your intellectual property.

Protection From Patent Trolls

In addition to the possibility of legitimate patent infringement contentions, it is important to also keep the threat of patent "trolls" in mind. Patent trolls are entities that collect broad, vague patents and target the owners of patents that arguably infringe upon their intellectual property, and who generally do not market any of their own products or services. They extort licensing fees through the threats of lawsuits or sue in hopes of a big payout. These patent trolls especially target those working in lucrative industries or smaller entities likely to cave under the threat of legal action.

If you think there is a significant chance that you may face an intellectual property dispute with a competitor or become the target of a patent troll, select a patent attorney whose firm offers patent litigation services and who works with the litigation team in asserting and defending patent suits. In the patent prosecution process, your information will be deemed confidential between you and your patent attorney. This means that if you later want that information released to another law firm that provides patent litigation, your patent litigator would need to file a formal request in order to be able to receive this information, delaying their ability to work on your case. These issues are nonexistent if your patent litigation team works within the same practice as your patent attorney, as your litigation team would have the authorization to view the necessary documents and would already be familiar with your patent.

Choose Experienced Patent Attorneys

More important than these delays are the perspectives from which your patent is written. Patents written by law firms that only prosecute patents and do not litigate them are at risk of not being easily defensible from a litigation viewpoint. Attorneys who only deal with patent prosecution don't always know the realities of patent litigation and how a patent may be interpreted during a legal dispute. As a result, their patents may leave gaps in what is protected or have other flaws that make your patent impossible or needlessly expensive to enforce. Munck Wilson Mandala has a team of patent attorneys who have worked with clients for more than 20 years developing market-focused offensive and defensive patent portfolios and teaming with trial lawyers to prosecute and defend patent infringement lawsuits.

A poorly written patent is useless at best and a liability at worst. When shopping for a patent attorney, keep in mind that a litigation perspective should be considered if the patent you seek is in a competitive industry so that it can hold its own in court. As such, it is highly advisable that you select a law firm that combines patent prosecution and patent litigation services. This is your best strategy to ensure your patent is written for maximum protection of your intellectual property.

Related People

- Matthew S. Anderson
- John J. Arnott
- Neil G. Ferrari
- Keith D. Harden
- Gregory M. Howison
- William G. Howison
- Jared M. Hoggan
- Jacob L. LaCombe
- Robert D. McCutcheon
- William A. Munck