

# What Makes a Good Patent Attorney?

**P**atent attorneys have unique educational backgrounds relative to attorneys in other legal specialty areas. For example, many patent attorneys have advanced science or engineering degrees. Those with engineering degrees are engrained with an engineering problem-solving approach that focuses on analyzing known and unknown information, and finding very specific solutions.

On the other hand, patent attorneys have legal backgrounds and are trained to logically and convincingly justify a predetermined position or outcome. The combination of these somewhat contrary backgrounds sets patent attorneys apart from other types of attorneys and allows them to work closely and effectively with inventors.

A good patent attorney must have strong technical, legal and communication skills. They must also understand that their job is not limited to obtaining patent protection for clients, but also involves leading or guiding clients through the patenting process and, ultimately, advancing a client's business.

## Communication is Key

After gaining experience and confidence, a patent attorney can become familiar with aspects of the patenting process that clients may find confusing or daunting. Being able to stand in a client's shoes and understand and explain what might be unfamiliar is an important characteristic of a good patent attorney. Rather than take a "just trust me" attitude, a good patent attorney should understand the importance of fully explaining the patenting process to his/her clients.

Patent attorneys should explain the basis for the federal government's granting of patents to inventors. In order to inspire the development of new technologies, the federal government—through the patenting process—gives inventors a limited time (20 years from the filing date) to monopolize on and commercially exploit their inventions. The tradeoff is that after patents expire, the inventions become part of the public domain and anyone is free to make, use, and practice the inventions without compensation to the original inventors.

When patent attorneys make their clients aware of this principle, it leads to an understanding of why an inventor has a limited period of time (one year) to apply for patent protection in the U.S. This is so inventors cannot subvert the system by



delaying the application for patent protection while promoting or using their inventions and thereby extending the time period of exploiting their inventions. Being aware of this principle also leads to an understanding that patent applications have to provide a full enabling disclosure of inventions (including the best mode of practicing the inventions) so that, after the expiration of a patent, inventors cannot maintain a competitive advantage using information that was known and withheld when the patent application was filed.

A good patent attorney should also fully explain the process for obtaining patent protection. In order to obtain a patent for an invention, the invention must be found to be patentable by the U.S. Patent and Trademark Office (USPTO). A two-prong test is used for determining patentability; each prong involves comparing the invention to be patented with prior publications that describe similar technologies.

The first prong of the patentability test involves *novelty*. If an invention has already been described in a prior publication, the invention is not novel and is considered "anticipated" by the prior publication. The second prong of the test for patentability is *obviousness*. An invention is determined to be obvious when a U.S. patent examiner concludes that an invention to be patented could have been relatively easily



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foreseen or derived from the teachings of one or more prior publications.

Obviousness is both a technical and legal issue. The legal constraints for determining obviousness continue to evolve as patent cases are decided in the judicial system. A good patent attorney keeps abreast of changes in patent law and important case decisions.

tance of conducting a search of prior publications (a “patentability search”) on similar technologies with clients. Ideally, a patentability search will uncover the most relevant prior publications that a U.S. patent examiner would consider during the patent examination process, and allow the patent attorney and their client to evaluate and consider

## A seasoned patent attorney can explain why almost all applications are initially rejected.

It is also important for good patent attorneys to explain what to expect after a patent application has been filed. Last year, it took an average of 25.8 months for the USPTO to begin examination of newly filed applications. Accordingly, a client should be told it will be a long time before their patent application sees any activity.

The vast majority of patent applications that are ultimately allowed are initially rejected by the USPTO. While companies that file numerous applications are aware of the large initial rejection rate, first-time and even seasoned inventors are often disappointed to have their patent applications initially rejected. It may be prudent to warn at least new inventors not to be surprised if their patent applications are initially rejected by the USPTO. Beyond such counsel, a seasoned patent attorney can explain why most all applications are initially rejected. Events and costs that occur during the prosecution, allowance, and post allowance of a patent application should also be explained in advance to clients.

### Patentability Search

Good patent attorneys plan for success. Because of the manner in which novelty (or patentability) is determined, a patent attorney should discuss the impor-

such publications prior to drafting and filing a patent application.

A patentability search aids in drafting the background of a patent application, determines if special features of an invention should be emphasized or if working examples may be necessary to distinguish over prior published technologies, and helps determine the scope of protection an inventor may obtain for their invention.

### The Extra Mile

A good patent attorney becomes involved with a client’s business. Between undergoing training as an associate in a law firm and becoming viably involved in a client’s business, patent attorneys transition from working for their law firm to representing their firm and working for their clients.

There is a big difference between understanding a client’s invention and understanding what the invention means to the client’s business success. While obtaining an allowed patent can be viewed as a personal success for a patent attorney, especially after disputing over time with a patent examiner, understanding how the allowed patent furthers a client’s business and success provides greater satisfaction and gratification. A good patent attorney can also assist clients in the enforcement of their patents, licensing opportunities, and other patent-related services. 🌐

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