

Paper Cuts

I don't care. I don't care what the books sold by Amazon claim. I don't care that it is expensive. I don't care what the rules say. I don't care what the little voices are telling you.

When the time comes to file a patent application you need representation. Filing and prosecuting a patent application is a technical, complicated and confusing process and mistakes made early in the process can inhibit or even disqualify you from getting a patent.

In order to represent clients in patent matters, a patent attorney or agent must be registered with the US Patent and Trademark Office. Registration requires an applicant to demonstrate technical competence through a technical degree or other methods. Applicants must also pass a comprehensive registration exam, informally known as the patent bar that demonstrates competency in patent law, regulations and procedures.

While about three-quarters of registered practitioners are attorneys, this is not a requirement for registration with the USPTO. Registered practitioners who are not attorneys are called agents. Patent attorneys and agents are equally qualified to represent clients through all USPTO processes, however, only attorneys can do patent litigation. The difference is similar to CPAs and tax attorneys: while only attorneys can represent you in court, both CPAs and attorneys are qualified to represent you with the IRS.

When choosing representation, experience, quality, comfort level, and service are more important than the attorney/agent distinction. When the above factors are nearly equal, I would make the following observations:

If you are fairly certain that your patent will be heading to litigation, I would suggest an attorney who can provide consistent representation from the application process through the litigation process.

If cost is an issue, I would suggest an agent. In the same way that CPAs are generally less expensive than tax attorneys, patent agents are less expensive than patent attorneys.

If your invention has technical problems or issues, I would suggest an agent. While patent attorneys have technical degrees, my personal observation is that patent agents seem to have more practical technical experience to bring to the table.

A final observation: while a patent attorney is preferable for patent litigation, once a patent matter reaches the US courts they are not necessary. Registration is not required for an attorney to handle a patent matter in the courts.

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