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Patent Agent - Suggested Preference

The article excerpts below suggest advantages of a patent agent to prepare, file, and prosecute for gaining patent rights, and if needed then seek a patent attorney for any post patent issue concerns.

Reasons for patent agent preference are substantive, and affirmed by the article excerpts listed below.

See 1 below	**The patent attorney and patent agent, are the two primary USPTO practitioners.**
See 2 below	**Patent attorneys and patent agents are licensed to prepare, file, and prosecute patent applications before the USPTO.**
See 3 below	**Courts have ruled that patent agents are equivalent to patent attorneys before the USPTO.**
See 4 below	**Patent agents provide a stronger technical and legal combination.**
See 5 below	Patent attorneys and patent agents must both have a technical academic
See 6 below	background, but usually only patent agents have technical experience.
See 5 below	Patent agents must pass the U.S. Patent Law "Patent Bar Exam" to practice before
See 7 below	the USPTO, just like Patent Attorneys to show their U.S. Patent Law expertise.
See 8 below	**Many general attorneys cannot achieve this technical and legal combination.** Why?
	Most attorneys do not have a technical academic background so are disqualified.
	Many attorneys with a technical academic background do not pass the U.S. Patent Law "Patent Bar Exam" (~30% first time pass rate, ~52% ultimate pass rate).
See 9 below	Most patent attorneys do not have technical experience as they move directly from technical education to legal education, never leaving the academic realm.
See 10 below	Patent Attorneys are often diverted to more post-patent issue court concerns, leaving less focus and experience for building expertise in the different skill set of patent preparation, filing, and prosecution before the USPTO for initial patent issue.
See 11 below	**Patent agents limit their representation to the USPTO.**
See 12 below	Patent agent focus sharpens expertise in representation before the USPTO
See 10 below	Patent agents do not lead, focus on, but can support issues before the courts, contract drafting, and filing trademaks. (*Fortress PATENTS / IP* files trademarks with a patent attorney affiliate and offers non-legal, but business opinion contract review, negotiation support, etc.)

The validity of the above is manifest by the following general trends.

See 13 below	**Patent agents are increasingly preferred by corporations due to more personalized service and lower fees.**
See 14 below	**Patents agents are an equivalent and an attractive alternative to more costly patent attorneys with all the skills and experiences necessary to prosecute patents.**

The expertise of the patent agent occurs as a result of their technical and U.S. Patent law experience and focused attention on the unique skills of patent preparation, filing, and prosecution to gain granted rights.

Actually, the need for a costly patent attorney is a last resort for court action, but before that *Fortress PATENTS / IP* will exhaust a phased escalation of notices, interrelationship, and all other business strategies. The costs of the patent attorney can then be limited to just any final court infringement action.

If contract drafting or work is needed, use *Fortress PATENTS / IP* to draft a more comprehensive contract that accounts for technical, business, U.S. Patent Law, and other legal considerations and then have it simply reviewed by any attorney (even a non-patent attorney).

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Intellectual Property Practice in the United States

Maier and Maier, PLLC, http://www.maierandmaier.com/Patent_Attorney_Lawyer.aspx, Downloaded June 28, 2014

The United States enjoys two primary types of patent practitioners, the patent attorney and the patent agent. Patent attorneys and patent agents are both federally registered to practice before the United States Patent and Trademark Office as a result of having achieved one or more technical qualifications and passing the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office (also known as the "Patent Bar Exam"). Thus, both patent attorneys and patent agents are licensed to represent clients in preparing, filing and prosecuting patent applications before the USPTO. Additionally, patent attorneys and patent agents in the United States may also render Patentability Opinions, as decided by the United States Supreme Court in Sperry v. Florida (373 U.S. (1963).

As a further note, the patent bar, contrary to some beliefs, does not test candidates on technical issues. Rather, the patent bar tests candidates on every aspect of patent law, as elucidated in the Manual of Patent Examining Procedure (MPEP). The MPEP, as its title suggests, provides the guidelines for the examination of patents before the USPTO. Patent examiners employed by the USPTO use the MPEP as the basis for examining patent applications and rely on it and updates made thereto to maintain the current state of law with regards to patents at the USPTO.

The Role of the Patent Agent in the Patent Process

1999, http://www.ipfrontline.com/depts/article.aspx?id=11&deptid=4, download June 28, 2014

The patent agent is an individual having expertise in providing representation before the [U.S. Patent and Trademark] Office. The patent agent's sound scientific and technical background coupled with an understanding of the patent law allows him or her to better understand the technical aspects of an invention and to write a technically and legally sound patent application. In turn, the patent agent fills a niche market where there is a need for a technical expert having knowledge of patent law.

In 1963, the U.S. Supreme Court ruled on Sperry v. Florida (373 U.S. 379) and changed who can give patent advice in the U.S. The Court ruled that the states may not prohibit a federally licensed patent agent (non-lawyer practitioner) from giving advice on patent law, even though it would constitute unauthorized practice of law at the state level. Below, Joy Bryant discusses the role of the patent agent today, 25 years [now decades] after Sperry v. Florida.

In order to provide representation in the U.S. Patent and Trademark Office (the Office), an individual must fulfill the requirements set forth in 37 C.F.R. §10. Included in these requirements is the requisite that one must possess the necessary legal, scientific, and technical qualifications to render valuable service to patent applicants. Many general attorneys are not able to meet this requirement.

The patent agent's practice is limited to patent matters before the Office. Unlike a patent attorney, an agent is not allowed to practice contract law such as drafting assignments; [file trademarks]; take an appeal to the Federal Circuit; or advise a client on matters relating to patent infringement [if matter is in the courts and outside USPTO authority]. This narrow focus creates a patent specialist who has sharpened expertise in providing representation before the Office. By concentrating on preparing and prosecuting applications, the patent agent becomes an expert in helping an applicant get a patent. Having only to focus on patent law, the patent agent is able to stay current and up to date on the interpretation of the patent laws.

According to a survey of its members conducted by the National Association of Patent

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Practitioners (NAPP)(www.napp.org), approximately 75% of the patent agents have advanced degrees in a technical field. Additionally, many patent agents have worked at least five years in a technical field prior to becoming a patent agent. This expertise in science and technology works to the applicant's advantage. A strong understanding of the scientific and technical aspects of an invention helps the patent agent to prepare a technically sound patent application. The patent agent's knowledge and understanding of the technology permits him or her to intelligently question the applicant and broaden the definition of the invention. Most patent agents make an effort to continue to remain current in their scientific fields. Thus, the patent agent usually has a good understanding of what the current state-of-the-art is with respect to technologies in his or her area of expertise.

The patent agent must also remain current with respect to changes in the patent laws. Many patent agents obtain their training on the job. Most have worked under the supervision of a skilled patent practitioner (either an attorney or agent). In this situation, the practitioner usually trains the patent agent how to conduct legal research. Some patent agents rely on advanced patent practice courses to keep their legal skills sharp, while others rely on reading the case law found in various journals and publications such as the United States Patent Quarterly (U.S.P.Q.). Whatever the mechanism, most patent agents make an effort to stay current with respect to issues in patent law.

Recently, it appears as if many of the larger corporations and academic institutions are sending work to patent agents in solo practice. The sole practitioner, on average, charges lower fees than a larger firm and provides more personalized service. For the Start-up Corporation or an institution on a tight budget, using the services of a patent agent in solo practice may be a plausible solution.

Attorney-Client Privilege When Using a Patent Agent

Last Updated: September 18 2013, Article by Nutter McClennen & Fish LLP's Intellectual Property Practice Group, http://www.mondaq.com/unitedstates/x/263570/Patent/AttorneyClient+Privilege+When+Using+a+Patent+Agent, downloaded June 28, 2014

Hiring patent agents—persons who do not hold a license to practice law but are licensed to practice in front of the United States Patent and Trademark Office (USPTO)—can be an attractive alternative to more costly patent attorneys. Typically, patent agents can have all of the experience and skills necessary to prosecute patents at the USPTO, but often work at discounted rates in comparison to their attorney brethren. Thus, as companies continue to strive toward lean operation, patent agent hiring may increase.

Most recently, in April, 2012, the Central District of California in Buyer's Direct Inc. v. Belk, Inc., held that "privilege may be invoked over communications between a client and the client's registered patent agent." The Buyer's Direct court was persuaded by reasoning espoused in In re Ampicillin (available via Westlaw) that the congressional goal of allowing clients to chose between an attorney and a patent agent in proceedings before the USPTO would be frustrated if the attorney-client privilege were not available to communications with registered patent agents.

In Ampicillin, the court stated that "in appearance and in fact, the registered patent agent stands on the same footing as an attorney in proceedings before the Patent Office." The court also noted that "freedom of selection, protected by the Supreme Court in [Sperry], would, however, be substantially impaired if as basic a protection as the attorney-client privilege were afforded to communications involving patent attorneys but not to those involving patent agents."

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