



WHO'S WHO IN THE FIELD OF INTELLECTUAL PROPERTY

Welcome to another edition of Protecting Your Creativity by The Livingston Firm. Each edition of Protecting Your Creativity will discuss various aspects of intellectual property law and related business matters. This edition discusses the differences between IP attorneys, patent agents and U.S. Registered Patent Attorneys.

There are many factors to consider before choosing an attorney to handle your IP matters. Before making a decision you should first understand the differences between U.S. registered patent attorneys, patent agents and IP attorneys and what services each may offer. The IP field of law is expansive and includes patents, trademarks, copyrights, trade secrets, licensing and franchising. Patent agents and IP attorneys are limited by law as to what IP services they may offer, whereas U.S. registered patent attorneys are allowed to offer all services in the IP area of law, including preparing and prosecuting patent applications. U.S. registered patent attorneys are required to hold dual licenses, which requires the passage of a state bar exam and the passage of a federal bar exam administered by the United States Patent and Trademark Office ("USPTO").

The preparation of a patent application and the subsequent prosecution of a patent application in the USPTO is an undertaking which requires knowledge of patent law and rules, USPTO procedures and knowledge of the scientific or technical matters involved in a particular invention. For these reasons, inventors may only employ the services of U.S. registered patent attorneys or patent agents to draft, file and prosecute patent applications on their behalf.

The USPTO registers patent attorneys and non-attorney patent agents only upon their meeting the requirements set forth by the USPTO. Some of those requirements include having a background in technical subject matters, such as engineering or science, and passing a rigorous bar exam. No other persons are permitted by law to represent inventors before the USPTO. Although patent agents are allowed to prepare patent applications and conduct the prosecution of patent applications in the USPTO, these are the only services a patent agent may legally provide to an inventor. Patent agents cannot render legal advice or obtain trademarks, negotiate licenses, conduct patent litigation in the courts, or perform various other services, all of which the Florida Bar considers the practice of law. On the other hand, U.S. registered patent attorneys can prepare patent applications and conduct the prosecution of patent applications in the USPTO in addition to providing legal services such as handling litigation matters, negotiating and/or drafting contracts relating to the sale or licensing of a

patent, submitting your ideas to companies, preparing and filing trademark and copyright applications, franchising, incorporating your business and rendering legal advice. A U.S. registered patent attorney is able to assist in all areas of intellectual property law and is not limited in the services they can provide as are patent agents and IP attorneys.

It is important to note that just because an attorney is a U.S. registered patent attorney, it does not mean that he or she is allowed to practice law in the particular state where he or she is residing. If a U.S. registered patent attorney is offering patent services from within a state and he or she is not a member of that state's bar, then that U.S. registered patent attorney is technically practicing as a patent agent and should not be holding himself or herself out as a U.S. registered patent attorney or offering services which would make him or her guilty of the unlicensed practice of law. Therefore, it is important to always make sure that a patent attorney is a member in good standing of your state's bar association before retaining him or her to perform any services.

If an attorney advertises as being an IP attorney, but is not a U.S. registered patent attorney then that IP attorney is unable to prepare patent applications, conduct the prosecution of patent applications in the USPTO or render advice regarding these matters. However, IP attorneys are allowed to provide the other legal services involving IP matters, including litigating patent infringement cases.

One other group worth mentioning that offers services in the patent and IP fields are so-called invention development companies. Invention development companies are private companies that claim to help inventors develop, patent, and promote their inventions so they can be commercially licensed or sold. While some of these organizations are legitimate, the majority of them are not. In fact, due to the many problems inventors have had with such companies over the years, the USPTO discourages inventors on their web site, www.USPTO.gov, from dealing with any invention development company and recommends that inventors retain the services of a U.S. registered patent attorney or patent agent.

CONCLUSION

Selecting the right attorney is always an important decision, especially when dealing with the patent process and other IP matters. You should consider whether the attorney you choose has the expertise to assist you with all aspects of your intellectual property matters, including rendering legal advice regarding business, licensing and franchising matters. For example, if you are interested in obtaining a patent on a new idea and intend to license the idea to others in the future, it is better to find one law firm that specializes and handles patent as well as all other areas of IP and business law. Choosing a law firm that can assist you with all of your IP matters, as well as the business issues associated therewith will help you attain your goals more efficiently. However, no matter whom you choose to handle your patent and IP matters it is important that you seek advice from competent counsel as a first step prior to investing money and/or time into any venture.

The Livingston Firm specializes in all areas of intellectual property law including patents, trademarks, copyrights, trade secrets, franchising, litigation and business law. As the largest full-service intellectual property law firm in Southwest Florida with over forty years of combined experience, The Livingston Firm can be there to assist you from beginning to end with protecting your ideas and inventions and getting those ideas and inventions to market.

Thank you for taking the time to read this edition of Protecting Your Creativity. If you are in need of our services then please contact us to schedule an appointment.

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