How to Select and Work with Patent Counsel

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ABSTRACT

Public sector technology transfer offices (TTOs) are in the business of "moving" technology from research and development to eventual commercialization in order to advance their missions of serving the greater public good. Intellectual property (IP) management is integral to this process, and integral to IP management is patenting. Maximal captured value for public sector technologies will be greatly affected by the quality and scope of the patent coverage and this, in turn, is greatly influenced by the quality of work done by patent counsel. It is therefore essential for a TTO to select a patent attorney whose work will enhance the institution's prospects for obtaining optimal licensing arrangements. From selection to hiring to ongoing interactions, it is important for the TTO and the patent counsel to develop and maintain a good working relationship. Central to this relationship is ensuring that patent counsel can prepare and prosecute patent applications in a manner that achieves positive results cost effectively. This is a complex process, and there are many responsibilities that both counsel and the TTO must assume. In addition, patent attorneys can provide general counseling: resolving inventorship issues, providing licensing and agreement support, and settling disputes. The TTO will be the patent attorney's actual client and function as the interface between counsel and the institution. By selecting qualified patent counsel and then developing a good relationship, a TTO can ease its workload and facilitate its mission. Therefore, retaining a skilled patent attorney and one that is well suited to the particular needs of the TTO is an essential element for operating a viable technology transfer program. The search for such an attorney must be approached thoughtfully.

1. INTRODUCTION

Technology transfer offices (TTOs) at a university or other academic institution have only one product to sell—technology. The value attributed to such technology is influenced heavily by the quality and scope of the patent coverage. If a patent is drafted poorly or does not provide adequate coverage for the technology and reasonable extensions thereof, licensing opportunities may either be lost or greatly devalued. Unlike manufactured goods, patents are not made by machines—they are prepared by people, in other words patent attorneys or patent agents. As a result, patents will vary in style and quality as a function of who prepares them. Due to the possibility of such variability, it is important to select carefully a patent attorney whose patent work will enhance the institution's prospects for obtaining profitable licensing arrangements. Guidelines on making this selection are suggested in this chapter.

Once suitable patent counsel is selected, it is important to develop a good working relationship between the patent counsel, the technology transfer manager, and any other individuals involved in these processes. One aspect of this developing relationship involves ensuring that patent counsel can prepare and prosecute patent applications in

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a manner that achieves good results in a cost-effective fashion. Beyond that, however, it is important to recognize that patent attorneys can provide general counseling, resolve inventorship issues, provide licensing and agreement support, and resolve disputes. Suggestions on how TTOs can work effectively with patent counsel in all these areas are also provided.

By selecting qualified patent counsel and developing a smooth working relationship with him or her, TTOs can develop a resource that will ease their workload and facilitate their ability to handle difficult situations. Inevitably, when patents are well prepared and prosecuted, they become more valuable, and licensing income may be enhanced. Making an appropriate selection of patent counsel and developing a good working relationship with him or her is one of the essential elements to operating a viable technology transfer operation.

2. SELECTING PATENT COUNSEL

2.1 *The patent attorney*

Patent attorneys must be registered with the U.S. Patent and Trademark Office (PTO) in order to practice before that governmental agency. Obtaining such registration is not like registering to vote. Patent attorneys must pass a written examination given by the PTO. In addition, patent attorneys must have a degree in science or engineering or a sizable amount of course work in those areas.

The PTO registers both patent attorneys and patent agents. Those with law degrees and admission to a state bar are registered as *patent attorneys*, while individuals who are not lawyers are registered as *patent agents*. In a law firm (as opposed to in a university setting) the practice of a patent agent is usually limited to preparing and prosecuting patent applications before the PTO. Patent attorneys also handle these responsibilities and, additionally, may litigate patent disputes, prepare and negotiate license agreements, and provide legal advice. Because patent agents usually handle only a limited scope of work within a law firm, a TTO is best served by selecting a patent attorney as its primary contact.

Names of patent attorneys can be obtained from a variety of sources. Like most professionals, patent attorneys are best located by seeking references and by "word-of-mouth." Listings in a telephone book and the PTO's register of patent attorneys are potential sources; however, they provide no basis for distinguishing between the listed individuals. The local bar association or intellectual property (IP) law association may be somewhat better resources, because these organizations would have some knowledge about individuals' reputations in the community and, presumably, would recommend someone with a solid reputation.

As members of the Association of the University of Technology Managers (AUTM), technology transfer managers are an excellent source of counsel who have experience with academic institutions and have provided quality assistance to peers in other TTOs. A few calls to the TTOs of other institutions should result in names of recommended individuals.

Local companies are another source of patent counsel recommendations. Companies with their own in-house patent attorneys are likely to use attorneys in private practice for some projects, so in-house patent attorneys are likely to be a very good resource. In companies with no in-house patent attorney capability, the individual in charge of research, development, or engineering or the company's general counsel are likely to be working with outside patent counsel and should be able to provide recommendations.

2.2 *Evaluating the Patent Attorneys*

Once the names of some patent attorneys have been obtained, the technology transfer manager is ready to begin the evaluation of those recommended. The following items are offered as criteria to be considered when determining which attorney will best meet the needs of the institution:

- size of the attorney's firm
- scope of the attorney's legal experience
- the attorney's experience with academic institutions
- the attorney's technological background
- the firm's location

2.2.1 *Size of the firm*

One consideration is the size of the firm with which the attorney is affiliated. Large firms will have a critical mass of patent attorneys and the resources to handle whatever problems the institution might encounter. These resources include large libraries, access to databases, staff to maintain and utilize the resources, and so on. The staff of patent attorneys at a large law firm is likely to include individuals with biotechnology, chemical, mechanical engineering, software, and electrical engineering backgrounds, so that the firm can handle work in virtually any technology. In addition, these attorneys will collectively have experience in patent prosecution, litigation, IP counseling, interferences, and licensing. As a result, a large law firm is generally able to handle most any legal problem that confronts a technology transfer manager. On the other hand, smaller firms might have the advantage of lower cost while having individuals with the skills needed to service the institution. Although firm size is a consideration, its significance should not be overstated. The technology transfer manager will be working with individual attorneys, and, therefore, the attorney's capabilities should receive the bulk of the manager's attention during this evaluation process.

2.2.2 *Scope of legal experience*

A manager should know the patent counsel's scope of legal experience. Because a significant portion of the work required by TTOs involves preparation and prosecution of patent applications, the attorney selected should have a solid patent prosecution background. Careful scrutiny of an individual's capabilities in prosecuting patent applications is appropriate. Ask how long the attorney has been doing such work, how many applications he or she has prepared and prosecuted, and so on. Make sure the attorney does a significant amount of original patent-application drafting as opposed to prosecuting cases that originated overseas. Ask to review patents that the attorney prepared and the files of issued patents he or she prosecuted (these are publicly available after the patent issues or the patent application publishes). The technology transfer manager should also examine whether the attorney being considered has experience in other areas, such as litigation, interferences, licensing, and counseling. There will inevitably be times when a TTO will need such skills.

2.2.3 *Experience with academic institutions*

It is also beneficial for the patent attorney selected to have experience representing academic institutions. Attorneys with such a background are comfortable working with TTOs as clients and in dealing with faculty. Unfortunately, such experience includes the ability to prepare patent applications under the seemingly constant pressure of filing a case prior to publication. Another facet of expertise in handling patent matters for academic institutions is the ability to work with faculty who have little knowledge about IP and have a variety of undertakings competing for their time and attention. Lastly, the attorney needs to be acquainted with procedures commonly used by TTOs to delay or minimize costs. For example, patent counsel should be familiar with the Patent Cooperation Treaty procedure for foreign filing in order to delay payment of national filing fees in the selected foreign countries. Further, patent counsel without experience working with universities may not know that a reference to government rights should be inserted in the specification. Rapport and mutual respect between patent counsel and faculty inventors are also crucial to cost-effective, strong patent protection.

2.2.4 *Technological background*

Another selection criterion is the extent that patent counsel's technological background matches the needs of an academic institution. Larger institutions may have work in myriad technologies from electrical engineering to biotechnology. As a result, such institutions must retain different attorneys with these backgrounds (or a firm with such attorneys). On the other hand, a smaller institution, such as a medical center, may only need an attorney with a biotechnology or medical background. In selecting patent counsel, TTOs should evaluate their needs technologically and find someone with a matching background.

2.2.5 *The firm's location*

How close are patent counsel's offices to the institution? Generally, it is preferable to use a local attorney if he or she is otherwise satisfactory. If there is no local attorney with the necessary legal and technical expertise, however, proximity must give way to quality. If a manager needs to go outside the local vicinity to find a patent attorney with suitable credentials, the manager should try to structure the relationship so that the attorney has maximal opportunities to visit the institution. For example, if possible, the technology transfer manager should give the attorney more than one project to work on at a time so that he or she can come to campus, talk to the inventors, and handle the matters in a cost-effective fashion. Personal meetings between TTO personnel and patent counsel are important for fostering a good working relationship, and making it easier for the technology transfer manager and office staff to receive advice. When personal meetings are not possible or cost effective, a patent attorney outside the local area should be able to work effectively with the technology manager and the institution's faculty by telephone, fax, e-mail, and overnight courier.

2.3 *Selecting one firm vs. many*

Another criterion to consider in retaining patent counsel is how many individuals or firms the technology transfer manager should select. This depends on the volume of work generated at the institution. The technology transfer manager must, of course, select enough individuals or firms to handle the institution's work volume. On the other hand, it is preferable to use as few firms as possible to ease administrative requirements on the TTO. It is also easier to establish a good working relationship and to ensure that the institution's procedures are followed when only a few firms are used. Nevertheless, it may not be a good idea to use only one firm, because that firm may not be able to handle certain projects for any of a variety of reasons. For example, the legal profession has rigorous conflict of interest standards that prevent attorneys from representing one client in an action against another client. In patent matters, conflict of interest issues are complicated by the need to avoid representing clients with technologically similar inventions. It is difficult to anticipate conflict of interest issues; they may never arise or may arise years after patent counsel is first retained. Another potential problem is that the counsel or the firm selected may not, at some distant time in the future, have the capacity to handle a particular project. This may occur because the attorney or the firm are otherwise engaged or lack the required technical expertise. Rather than dealing with a conflict of interest or a lack of capacity situation on a crisis basis, it may be better to select and work with a back-up firm that can handle such projects.

2.4 *Conditions of representation*

Once the technology transfer manager has selected patent counsel, the conditions of representation should be established. In many jurisdictions, lawyers are required to establish such a relationship in writing through a retainer letter.

One purpose of the retainer letter is to establish contact people on both sides to handle administrative matters, particularly billing issues. The TTO should select the person from its staff who is most likely to interact with patent counsel as counsel's contact person. The retained attorney or law firm will designate the attorney who will prepare and send out bills. It may also be appropriate to use one attorney as the point of contact between the institution and the law firm. That person can act as ombudsman within the law firm to ensure that the institution's special needs or requirements are met. It is still a good idea, however, to know which attorney will be taking primary responsibility for particular projects and to ensure that the individual is qualified.

The retainer letter should also establish billing procedures. Because most law firms work on an hourly rate basis, the retainer letter should specify billing rates for the attorneys likely to be handling the institution's work. There is an occasional desire to utilize alternative billing procedures, such as fixed fees or fee and equity combinations. Further, some TTOs

choose to pay their counsel a monthly retainer fee to cover routine counseling and advice. This makes TTO personnel and faculty less reluctant to contact counsel with small but important questions. The terms of any special fee arrangement should be stated in the retainer letter. The retainer letter will also specify billing cycles. Generally, bills are rendered by most law firms every month.

Another feature of the retainer letter will be a specification of the bill content. An acceptable bill will include, on a daily basis, an indication of which attorney worked on a particular project, the amount of time spent daily on that project, and what that work involved. This will make clear the services for which the TTO is being charged. Block bills containing a narrative of all work done on a particular project without specifying which attorney did that work, how much time the attorney spent on a particular task, and when that task was done should not be accepted.

TTOs should also prepare their own retainer letter for newly selected patent counsel. In the institution's retainer letter, the TTO should state what it expects from counsel. One important point that this letter should stress is that the TTO—not the faculty—is counsel's client. This is a seemingly simple concept, because the TTO is receiving and paying the attorney's bills. Nevertheless, things can become confusing in academic settings where patent counsel is working heavily with faculty members who generally operate as "free agents" with respect to the institution. It is easy for such faculty members to regard patent counsel as their attorney and to begin asking the attorney to handle their other projects without approval from the TTO. In such situations, patent counsel should refer such requests back to the TTO. The TTO's retainer letter should emphasize this point and inform counsel that charges for unauthorized work will not be paid. To diminish further the possibility of such a problem, the TTO should emphasize to faculty that patent counsel represents the TTO—not the individual faculty member—and that any patent work the faculty member wants carried out should be channeled through the TTO.

3. WORKING WITH OUTSIDE PATENT COUNSEL

3.1 *Allocation of work*

Having selected patent counsel, the TTO should begin to establish a working relationship with that attorney. Determining how work is to be allocated between patent counsel and the TTO is an important starting point in establishing such a relationship. Generally, the less work that is sent to the attorney, the lower the TTO's legal fees. On the other hand, the more work the TTO retains for itself, the less time its staff will have for other matters. It is, therefore, important for the TTO to assess how its resources are to be utilized and then to distribute its workload accordingly.

3.2 *Evaluating the invention disclosure*

Quite often, a TTO will receive an invention disclosure from a faculty member while the underlying research is ongoing. An evaluation must then be made to determine whether the matter is ripe for filing a patent application.[11] The TTO should consider:

- the invention's commercial value
- whether there will soon be a public disclosure regarding the invention
- whether that publication will enable those skilled in the art to practice the invention
- whether meaningful protection can be obtained at this stage of the invention's development

Generally, the TTO should make an initial effort to decide whether (and when) a patent application should be applied for on a particular technology. However, where resolution of this issue becomes legally and technically complex, patent counsel should be consulted.

Another important consideration with respect to a newly submitted invention is *whether that invention warrants an investment* in patent protection. This decision should be made by the

TTO that has experience in marketing and valuing technology.

3.3 *Pre-filing patentability evaluation*

Once the TTO makes a preliminary decision to proceed with obtaining patent protection, it is advisable to make a *pre-filing patentability evaluation*. An initial evaluation of this type can be conducted by the TTO if it has access to computer-search databases or is willing to work directly with an outside search firm. Generally, computer searching is appropriate for biotechnology and chemical inventions. On the other hand, devices are best searched by manually reviewing the U.S. Patent and Trademark Office's collection of patents in the relevant area. The TTO, of course, must have the staff to conduct and/or evaluate such searches.

One possibility to increase staff assistance in a TTO is to use engineering, science, or law students on a part-time basis for such work. When utilizing such part-timers, however, it is recommended that their role be restricted to gathering information for evaluation by patent counsel or a staff person who has experience in evaluating patentability. Staff persons making initial patentability evaluations need to acquire a working knowledge of patentability standards and what is considered prior art (in other words, subject matter capable of preventing issuance of a patent). An ideal way to gain such an understanding is to attend AUTM programs on the subject. Other organizations also have basic courses about patents and patentability. Ultimately, however, knowledge is best obtained over time by working with (and learning from) patent counsel.

A TTO that does not have the staff to make an initial patentability evaluation should send disclosures out to patent counsel who can then arrange for a patentability search and make an evaluation. This, of course, is the most expensive route, because patent counsel is taking responsibility for obtaining a patent search, evaluating that search, and providing a recommendation. Many TTOs, however, utilize this approach because their staffing resources are committed to marketing and technology transfer.

3.4 *Preparation and prosecution of a patent application*

Once a patentability search has been obtained and a decision is made to proceed with preparation and prosecution of a patent application, patent counsel will bear the bulk of work responsibility. Nevertheless, the TTO should act to facilitate the process (to minimize costs and to ensure that there is valuable IP to license). This can be achieved in a number of ways.

3.4.1 *Inventor participation*

The TTO should make introductions between patent counsel and the inventor(s), personally or by mail. The TTO should insist that the number of meetings between counsel and the inventor(s) be held to a minimum. In most cases, one meeting to discuss the invention and one meeting to discuss a draft application is sufficient. Brief telephone conferences can be used to fill in gaps left by such meetings.

It is important to impress upon the inventor(s) the need to cooperate with counsel's requests for information. The inventor should furnish any draft journal article to facilitate preparation of written examples for the patent application. If the article does not provide sufficient information for examples, the inventor will be requested to provide additional experimental write-ups. This often requires a fair bit of work, but the inventors are much better able to do this than patent counsel. Moreover, having the inventors undertake this task (as opposed to patent counsel) will reduce cost.

For biotechnology and chemical inventions, patent applications will frequently be faced with a rejection (35 U.S.C. §112, 1st paragraph: failure to disclose and explain the invention in detail) because the application's disclosure does not support the broad scope of protection being sought. To overcome this problem, the scope of protection may have to be narrowed to an often unacceptable extent. Applications based on little more than draft publications are particularly susceptible to such problems, because publications generally report only the work actually carried out by the researcher; it does not usually discuss alternatives or way in which the invention can

be expanded. To obtain a broad scope of protection, the inventor(s) will be requested to assist patent counsel by providing information about how the invention can be utilized. The TTO should impress upon the inventor(s) the importance of their cooperation in this regard so that commercially valuable patent rights are obtained in a timely manner.

3.4.2 *Duty of disclosure*

It is important for the TTO to understand the duty of disclosure to the PTO. Under this duty, patent applicants must disclose all information that a reasonable examiner would consider important in deciding whether a patent should issue. Inventors must not submit inaccurate data and must disclose all patents, publications, and other disclosures (such as prior art) which would be relevant to patentability. This includes the inventor's own efforts to disseminate information as well as those of others. Published abstracts and information disseminated at poster sessions must also be disclosed. This duty is not extinguished upon filing of the application. If the inventor discovers prior art after his application for patent has been filed, he has a continuing duty to submit such information to the PTO.

The TTO will need to advise patent counsel which aspects of an invention it considers to be valuable. The attorney can then frame the patent claims in a way that will provide the desired protection and enhance licensing opportunities. It would be prudent for the TTO to monitor what is being claimed initially and throughout prosecution to ensure claim scope expectations are met.

3.4.3 *Office Actions*

After the application has been filed, the PTO will eventually issue an "Office Action" that must be responded to by patent counsel. Generally, counsel will need input from the inventors when preparing this response. The technology transfer manager can assist in this process by stressing to the inventors that a prompt response to the attorney's request for information or additional experimental data is imperative. If a response to the PTO Office Action is filed without all the information requested by counsel, it is likely that the PTO will mail another Office Action; thus requiring the TTO to incur the expense of filing another response, which includes the information that should have been put into the prior response.

In responding to Office Actions, extensions of time can be obtained by payment of additional fees. To minimize costs, there should be limited use of such extensions.

3.4.4 *Foreign filing*

After an application is on file in the United States, counsel will eventually inquire whether the case needs to be filed overseas. Decisions on foreign filing require consideration of whether:

- the return on foreign filing justifies the expense
- such filing is going to be considered valuable by domestic licensees
- the invention has sufficient value to attract a licensee in a particular foreign country

There are, of course, other factors that must be considered in deciding whether to foreign file, but they are beyond the scope of this chapter. A technology transfer manager should provide the attorney with plenty of advance notice about foreign-filing plans. This will enable the necessary papers to be prepared without a last-minute rush.

3.4.5 *Further research and new data*

After an application is filed, inventors often breathe a sigh of relief and assume that they are done with patent applications. They then continue their research without informing the TTO or patent counsel of any developments. This is unfortunate, because such later work can be the basis for further (and, indeed, often more valuable) patent protection. The technology transfer manager should impress upon the inventors the need to keep either patent counsel or the TTO apprised of future developments.

3.5 *Maintenance fees and annuities*

Once patent protection is obtained in the United States or overseas, it is necessary to decide who

will be responsible for paying maintenance fees and annuities. The TTO can undertake this task itself or work directly with an annuity service. On the other hand, it can rely upon patent counsel and counsel's docketing system to handle this task.

4. WORKING WITH PATENT COUNSEL ON OTHER MATTERS

Working with patent counsel should not be thought of only in terms of preparing and prosecuting patent applications. There are a number of other areas where counsel can provide valuable assistance.

4.1 *Dispute resolution*

Quite frequently, inventorship disputes arise in academic settings. These issues are best resolved before any patent application is filed.

Inventorship disputes may arise between faculty members and their graduate students. Sometimes, graduate students are merely "a pair of hands" who simply follow instructions from the faculty member. In other situations, the student conceived or helped conceive the invention. To make a proper inventorship determination, it is necessary to interview the parties and to review their documents to ascertain each inventors' contribution. Patent counsel should have a level of expertise in resolving inventorship disputes that will make all parties involved feel that their views have been properly considered.

Faculty often collaborate with scientists at other institutions or companies. Such collaboration is rarely undertaken with an eye toward patents. However, once a decision is made to go forward with a patent application, disputes can arise regarding who will be named as inventors. Again, patent counsel can be useful in investigating the situation and providing an opinion on how to resolve the matter. This is particularly important when dealing with a collaborating institution or company, because, in order to maintain what has been up to that point a good working relationship with the collaborating institution, the technology transfer manager may choose to use patent counsel as an advocate to resolve conflicts. Moreover, early involvement of patent counsel in any such dispute will enable the attorney to position the dispute to the advantage of the client—the TTO.

4.2 *Preparation and negotiation of agreements*

Patent counsel can also provide TTOs with support in the preparation and negotiation of licenses and other agreements. Some TTOs have a great deal of experience in these efforts and do not need to use patent counsel for such services. On the other hand, other TTOs lack this experience and should strongly consider involving patent counsel in these activities. For instance, counsel can prepare agreements, review draft agreements from potential licensees or the TTO, provide selected clauses for inclusion in any agreement, and negotiate with potential licensees. Involving patent counsel in such negotiations is particularly critical where discussions are centered around substantive patent issues, such as the scope of patent protection available, and whether the potential licensee has rights in the subject technology due to a dispute over inventorship or over who was first to invent. Patent counsel should be involved in such negotiations to help persuade potential licensees that the client has a meritorious position. At the very least, patent counsel should be kept apprised of the substance of any license negotiations so that any changes needed to enhance the quality of the application can be promptly made.

4.3 *Interference proceedings*

Issues of *priority of invention* (who was first to invent) are resolved in the PTO through proceedings known as *interferences*. Often, these issues become apparent during license negotiations as discussed above. Alternatively, the inventors may become aware of similar work by others when they attend conferences. No matter how this information becomes known, it is important that patent counsel be kept apprised. This enables the attorney to undertake a strategy that will put the TTO in the most advantageous position possible in any interference proceeding. The attorney should be involved in such situations at a very early stage and should meet with the inventors to discuss strategy. In the event that an interference is declared, such a proceeding is like a mini-patent

litigation. This is a complex proceeding, and patent counsel will need to be involved. Indeed, the attorney should be the institution's representative in any such proceeding.

4.4 *Getting questions answered*

Lastly (and most importantly), patent counsel can serve a TTO by being available to answer simple questions on IP matters. Most patent counsel are willing, without charge, to help a technology transfer manager in patent awareness efforts by giving seminars to groups of institution faculty or participating in special events such as invention fairs relating to the technology transfer program. By providing such advice to that office and faculty, patent counsel can help ensure that protection for valuable technology is not lost but, instead, enhanced.

5. CONCLUSIONS

The mission of public sector research institutions is research and development of technological advances that will eventually provide benefits to the public, especially in terms of health and nutrition. IP management (of which patenting is integral) advances this mission by facilitating the development and commercialization of public sector innovations. Therefore, for public sector TTOs, the products that they will want to disseminate will be their technology and the patents covering this technology. To ensure that the greatest value is realized from the fruits of the institutions' research scientists, it is essential that good patents are drafted, prosecuted and maintained. Therefore, it is of the utmost importance to select the institution's patent counsel carefully. This will involve evaluating several key factors, such as size of the attorney's firm, scope of the attorney's legal experience and capabilities, the attorney's experience with academic institutions and technological background, and the firm's geographic location. Once counsel is selected, a good working relationship with him or her should be actively pursued. This will require defining the conditions of representation, the allocation of work, and the dynamics and management of patent counsel's relationship with its client (the TTO) and also with the institution's administration, staff and scientists. By carefully taking all of these steps, the TTO can ensure that quality patents are obtained and managed in a cost effective and timely manner. ■

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1 See also in this *Handbook*, chapter 9.1 by L Nelsen and chapter 9.3 by R Razgaitis