

Attorney's View on How to Select and Work with Patent Counsel

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Introduction

Technology transfer offices at a university or other academic institution have only one product to sell—technology. The value attributed to such technology is impacted heavily by the quality and scope of the intellectual property protection, specifically 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, i.e., 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 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 technology transfer offices can work effectively with patent counsel in all these areas are also provided in this chapter.