



Stanford eCorner

Who to Choose as a Patent Attorney?

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Entrepreneurs in need of a patent attorney must choose someone who knows the art of describing an invention in a way that distinguishes it as novel from both past and future inventions, according to Jeffrey Schox, a patent attorney who works exclusively with startups. Knowing the unique funding and technology-development curves of startup companies is also critical, according to Schox, who also lectures on the subject at Stanford University.

Why build a patent portfolio?
What is patentable?
How does the process work?
How to identify inventions?
When to file a patent application?
What do investors want to hear?
Who to choose as a patent attorney?

Transcript

- [Jeffrey] The last section they're going to cover, is who to choose as a patent attorney. Slightly tongue and cheek, here. The Supreme Court has said, that writing a patent application is actually the hardest legal document there is. And so, you want someone that has actually done this a few times. The concept of describing an invention, is a very technical thing, it's an engineering thing. But, to be able to figure out ... These are the claims, these are the 200 words. These are the 5 bullet points that we're going to go after. That's going to distinguish this invention from everything that's been done in the past. And, that is going to provide protection against everything that could happen in the future.

Is really hard. That's an art form. And it takes a long time to figure that out. To work with someone that actually has a decent amount of that legal experience. And, by decent amount, you know, has written 100 patent applications or more. When they're figuring out what 200 words to choose, they need to know what they're talking about. If you came to me with a hardcore pharma invention, I wouldn't know what half the words mean. So, how can I choose what those 200 words should be? We would go into the Patent Office with an independent claim. So, each patent attorney has some kind of background. And, they're going to have some kind of comfort zone.

Of what they can write intelligently on, and what they can't. My background's mechanical and electrical degrees. And, I do a significant amount of software. And, we actually do a decent amount of bio. And so, those are all areas that I feel comfortable with. But, there are certainly other areas that I don't feel comfortable in. And so, to work with someone that has that kind of technical background. And, by simply describing your invention to them, if they can't come back and describe it back to you. And reflect that, you know, be able to talk about what it patentable, and interesting about that. That is a huge, huge red flag.

You need to be working with someone that understands your technology. Start-up patent law is very, very different than Fortune 500 patent law. Fortune 500 companies, typically, don't use that provisional process. They typically don't use PCT process. To be able to delay what countries they should enter. And they typically, are working with folks that have patent attorneys that know or only know how to write a patent application on what they're given by in-house patent counsel at a Fortune 500 company. Work with someone that actually understands start-ups. And, understands these kind of, the technology development curves. And more importantly, the funding curves. So much about building a patent portfolio, is actually timing the provisionals.

So that, you file a provisional on a seed round, and you actually convert it after you raise an A round. Patent applications

are really expensive. Being able to understand, and work with, someone that gets that kind of, that typical flow, of a start-up, is incredibly important. And lastly, what I think is super important when choosing a patent attorney is, proximity. Being able to work on the same white board, and be able to have that brainstorming session. To be able to say, "Please come over to the lab." "We need to show you something." To be able to walk over, and to be able to say, "Hey, see our new demo." These are things that are very difficult to do over Skype. And, you know, when every single word counts in an independent claim, like, you want someone to make sure they understand every single bit about your invention. I think that proximity is incredibly important.