

EIP



Ask the Experts: Can a patent attorney help your business?

If you have watched the BBC programme 'Dragons Den', you'll almost certainly have heard entrepreneurs asked about intellectual property rights, such as patents, design rights, trademarks and so on.

These rights can significantly increase the value of your business because they can provide a barrier to competitors hoping to use similar technologies or branding. They may also provide an income in their own right, if you license the rights to others.

However, obtaining and managing these rights is not always straightforward, and in this series of articles, we'll explain how a patent attorney can help your business obtain valuable assets in the form of granted patents. In doing so, the aim is to demystify the role of a patent attorney.

EIP's 'Ask the Experts' series will be released once a week for the next four weeks. This series will answer common questions SMEs have about patents. Let's get started.

Q: What do you mean by a 'patent attorney'? I thought 'attorney' was a US term for a lawyer?

A: The term 'patent attorney' is protected in the UK and can only be used by someone on the register of patent attorneys, which is maintained by the regulatory body IPReg.

Registered patent attorneys have a degree in a science or technology area and have passed exams on patent law and practice. Typically, it takes at least four years of full-time, post-degree, training before qualification and registration as a patent attorney.

The exams cover all aspects of patent attorney work: from preparing new applications

and responding to patent office communications to legal questions, and they also cover giving advice in scenarios where there may be patent infringement occurring.

Although patent attorneys may come into the profession with deep knowledge of a particular technical field, they often branch out, or develop new areas of expertise. After all, because patents relate to new inventions, patent attorneys may be among the first to learn about new developments.

Q: Do I have to use a patent attorney to apply for a patent?

A: The short answer is 'no', and some inventors apply for and obtain patents entirely without engaging a patent attorney.

In the UK it is required to provide an address for communication with the patent office. If you live in the UK (or your company is based in the UK), you can use your own address. You can also represent yourself, or your company, if you are applying via the European Patent Office (EPO).

Having said that, most UK-based firms, from SMEs to large firms with in-house intellectual property departments, choose to be represented at the UK patent office and/or the EPO by a qualified professional representative, for reasons which will become clear.

Patent attorneys are obliged to protect the confidentiality of information provided by their clients. Bear in mind that sharing information and asking advice from someone who does not have such an obligation of confidentiality may be considered as a public disclosure which could affect your ability to obtain a patent.

Q: I have an invention; how do I get a patent for it?

A: If you have come up with an invention and intend to bring products or services to market which use that invention, this is a perfectly reasonable question to ask. You may well be aware that it is almost impossible to get a patent if the invention has been made available to the public (e.g., has been sold) before filing. However, a discussion with a patent attorney at this early stage is likely to address the more important questions of “**Can** I get a patent?”, “**Should** I apply for a patent?” and, if the answers to these are yes, “Is **now** the right time to apply?”.

A patent attorney may advise that other rights (such as design rights) may be more appropriate. It may also be the case that a patent could not be obtained for your invention, because of the subject matter of the invention.

Written by David Hole

Why not download [‘The Ultimate Patent Guide for SMEs’](#) to understand more about how your business can successfully use patents to accelerate growth?

Our in-house experts at EIP work with businesses of all sizes to provide practical commercial advice. We are a specialist patent firm with practising offices in the US and Europe, and capable of coordinating the filing and prosecution of patent applications worldwide.

The information in this article is for guidance only and should not be taken as legal advice. If you run or work for an SME and need advice regarding patents, [contact us today](#).

Click here for [articletwo](#), [articlethree](#) and [articlefour](#) of the series.