

Is Your Firm Able to Handle Patent and Trademark Matters?

by Andrew Rapacke

Many clients, especially business clients, often have intellectual property (IP) concerns or needs. The client might need to obtain trademark protection on a company name or logo or might need to put a stop to a competitor who is producing low-quality knock-off products that bear a trademark that is confusingly similar to the one used by the client. Or the client might be involved in the development of an innovative new technology and requires securing patent protection. When clients have IP issues involving, for example, patent or trademarks, it is in the best interest of the client to consult with an experienced patent and trademark attorney.

Patent and trademark law is a highly specialized area of IP law. In order to practice patent prosecution (i.e., to seek patent protection from the federal government on behalf of patent applicants), patent attorneys are not only required to have a technical background in science or engineering, but they must also pass the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office (USPTO)—more commonly referred to as the “patent bar exam.” Due to the additional qualifications that are often required for the practice of patent and trademark law, many major law firms have established dedicated practice groups for patent and trademark law, and a number of small-to-mid-sized boutique law firms exist that solely prac-

tice intellectual property law.

What Are Patents and Trademarks?

Patents and trademarks are forms of intellectual property. A patent is issued for a novel (i.e., new) and non-obvious invention. Patents can also be issued for ornamental designs. A patent is sought by filing an application with the United States Patent and Trademark Office. Once the USPTO grants a patent, the patent owner has the right to exclude others from making, using, selling, or importing the protected invention in the United States. Patent protection is time-limited, and once the life of the patent expires anyone is free to use the patented invention.

A trademark is a symbol, word(s), or mark that is used by a business to help consumers distinguish the source of a good. Use of a trademark in commerce automatically creates common law rights in the mark, but the protection offered by those rights is limited. To expand the scope of protection, a trademark can be registered at the state level, and/or at the federal level at the USPTO.

Helping Clients Control IP Legal Costs

For many businesses, patents and trademarks are significant company assets that help create and maintain a competitive advantage. When clients need IP legal services but have budget

constraints, they may be looking for ways to control costs since traditional hourly billing methods are notoriously unpredictable. The answer might take the form of a fixed-fee payment structure for IP legal services.

Fixed fee is a value-focused way for clients to obtain patent and trademark legal services packaged as a product for a given price. Some IP law firms offer fixed fee payment structures. A fixed fee structure is designed to offer clients several benefits. For starters, a fixed fee arrangement provides transparency and certainty for business clients. IP-related legal costs will be assessed up front so the client is unlikely to face any surprise charges or fees later down the road (unless there are extenuating circumstances).

In conclusion, attorneys should only take on patent and trademark work if they are qualified to do so. Make sure your clients understand that patent and trademark issues require the attention of a patent and trademark attorney. **B**



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