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Manager's Guide to AV Design and Development

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Picking A Patent Lawyer

By Paul C. Remus and Thomas Druan

In the November/December 2006 issue of *Multi Media Manufacturer*, the important topic of picking an engineer was discussed in Bob Cordell's article, "Picking an Engineer—Making the Right Choice." As discussed in that article, choosing the right person for the job is crucial. This applies not only to engineers putting an invention together, but also to patent lawyers protecting the invention.

DEFINING THE INVENTION

The first hurdle is defining the invention you want to protect. If the invention can potentially be reverse-engineered, it is likely that patent protection is the right route. If it is a novel method of making something that would be very difficult, if not impossible, to discover from the outside, perhaps trade secret protection is the way to go. If the latter applies, a lawyer who has experience and expertise in keeping things secret should be brought in to ensure all the proper employment and confidentiality agreements are effectively drafted and utilized, and proper procedures are in place to keep the trade secret locked up. If, on the other hand, a product or method is better protected with a patent, then a lawyer with a different skill set is helpful.

TECHNICAL KNOWLEDGE

Just as for an engineer, it is important for a patent lawyer to be knowledgeable in the technology in which patent protection is being sought. If a novel crossover configuration has been invented, a patent attorney with experience in circuit design is better able to understand the invention as opposed to another patent attorney who is more versed in adhesive materials. A patent lawyer who has experience writing patents for crossovers is even better.

The more familiar a patent lawyer is with the specific technology, the less time he/she needs to come up to speed learning the nuances that can mold your patent protection. Understanding the technology also decreases the time it takes to interview the inventors, write the application, and produce claims that accurately reflect the invention. As everyone knows, the old adage, "time is money" is especially true when dealing with lawyers. The less time needed, the more "bang" you get for your buck.

INITIAL CONTACT

Once you have determined the desired type of protection and the technical field, the next step is finding the lawyer. Just as flipping to the "Engineer" section of the telephone

directory probably will not land you the best engineer for a job, locating a patent lawyer is not as simple as flipping through a directory. The primary methods of finding a lawyer with experience and expertise in a particular area are word of mouth, published patent documents, and the Internet.

Talking to other people in the industry about whom they use as suppliers, engineers, lawyers, and so on can provide a valuable network of information regarding the right person for just about any job. Referring back to the crossover example, it may be helpful to talk to someone in the industry who has dealt with patenting a crossover. Ask them about the lawyers they either recommend—or, sometimes just as important, do not recommend—for that technology. While industry peers are often competitors, referrals are commonly the best method of finding legal counsel who is a good fit for you and who will provide the level of service you desire.

If nobody in the industry wants to talk, the next place to look is in

published patent documents, which includes issued patents and published applications. You can search patents through multiple methods, including from the United States Patent & Trademark Office (“USPTO”) website (www.uspto.gov/patft/index.html), Google Patents (www.google.com/patshp?hl=en&tab=wt&q=), the European Patent Office (<http://ep.espacenet.com/>), and several others. Using keywords or classification, finding patents and applications in a particular technology is fairly straightforward. Once you locate a particular technology, it is easy to find individual attorneys or firms that handled the prosecution of the relevant patents. If a name keeps coming up in a particular field, you can be confident that this person knows what he/she is doing.

Recently, the USPTO has provided the public not only with images of published patents and applications, but also their prosecution history through their Patent Application Information Retrieval (“PAIR”). This is helpful both in finding lawyers who

have worked on a particular technology and determining how efficiently they prosecute applications in that technology. For example, if you find that a lawyer is not, in your opinion, making sound arguments about the patentability of an invention, you may work better with another lawyer.

When all else fails, a quick Internet search for patent lawyers can provide a starting point. Many attorney websites include a “bio” section that discusses a lawyer’s educational background, prior work experience, memberships in various associations, and other possibly important qualifications. Also, forums and weblogs can open up technology-centered communities well beyond the local industry. This more informal and fairly anonymous meeting ground encourages a freer flow of information in which lawyer recommendations may be made.

OTHER FACTORS

As with any professional relationship, how well a particular lawyer will work

with you goes beyond pure technical abilities. Availability, personality, and resources can make or break a relationship with an otherwise qualified attorney—and then there are rates.

Availability can come in two flavors: having time to take on your patent application and being located close enough to stop by and get a good feel for an invention. While having time to devote to your patent application is of obvious importance, especially in patent law where time limits can have dire consequences if not heeded, geographic availability is also important. In areas of law such as torts or contracts, having a local attorney who is knowledgeable about your state's laws is important in receiving good legal advice. In the patent world, once admitted to the patent bar, a lawyer in any state can prosecute a patent application for an inventor in the same or different state. Nevertheless, this does not remove the benefit of the lawyer actually being able to visit an inventor to see the invention first hand.

If a lawyer is available, it is important that his/her personality meshes well with yours. Not only does a good personal relationship with your lawyer help by facilitating the free flow of information between lawyer and client, but there is a better chance that this lawyer will more zealously advocate your case. Also, some lawyers may be better at "thinking outside the box" about your situation, and conversations regarding an invention can illuminate an ability to see problems from many different perspectives. While a lawyer may be technically sound, knowledge of the practical world within which you operate can provide personalized protection based on your specific situation.

It also follows logically that the

more resources a lawyer has, the better job he/she can do. Resources such as support staff to help file paperwork, an effective docketing program to keep deadlines organized, available search services to conduct prior art searches before filing, and an established network of peers or industry experts to help prosecution can all increase the quality of a patent lawyer's work product. In general, the larger the firm, the more resources are available to an attorney, but this is not always the case. Thus, you should conduct an interview with a potential patent lawyer to determine what tools and resources are available.

Finally, another big consideration in hiring a lawyer is the cost. In general, you get what you pay for, and lawyers with significant experience and expertise and ample resources will cost more than a new lawyer with fewer resources. That is not to say that the newbie working at home cannot provide a quality product, but some people might prefer to pay more for the possibility of better service from an experienced lawyer.

CONCLUSION

One main difference between picking an engineer and picking a patent lawyer is that you can determine relatively quickly the quality of the engineering services provided. Sometimes it can take years for a patent application to be examined, and by then it can be too late to rectify issues with the quality of the application.

Considering the factors described here in this article before hiring a patent lawyer can provide some level of confidence that the lawyer you choose will be a good fit for you and has competency in your technical field. Combined with a good engineer, the right patent attorney can provide

you with that competitive edge you need to succeed. **M²**

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ON-LINE RESOURCES

Martindale-Hubble: www.martindale.com—contains searchable information and biographies of lawyers by specific state and practice area.

LegalMatch: www.legalmatch.com—you select the field, your location, the amount you are willing to spend, and a brief description of your needs, and the program provides a list of attorneys.

USPTO Website: www.uspto.gov/patft/index.html—provides a list of people who are able to practice in front of the Patent Office, as well as the ability to search through patents, published applications, and prosecution history.

Google Patents: www.google.com/ptshp?hl=en&tab=wt&q=—pure Boolean patent searching.

European Patent Office: <http://ep.espacenet.com/>—provides very good patent searching capabilities across US and foreign databases.



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