



European IPR Helpdesk

10 steps to find a suitable IP professional

Intellectual property (IP) is a multi-disciplinary area at an intersection between law, science and research, arts and literature, finance, and social sciences. It requires vast expertise in several areas and comprehensive know-how when taking decisions regarding your IP assets and when having support from professional advisors.

IP professionals act as support mechanisms in helping to solve your IP based issues. Therefore, finding a suitable IP professional is of utmost importance in obtaining high quality advice.

Who are IP professionals?

- *IP Lawyers (Attorneys at Law)*: Law has many different fields from family law to bankruptcy law. IP is one of these fields and as such needs profound knowledge of IP systems, meaning that not all lawyers have this specialisation. Consequently, when searching for an IP lawyer, it is very important that the lawyer has in-depth expertise in IP. An IP lawyer might be needed, for example, to handle IP litigation issues (including representation before the courts), to perform pre-litigation activities, to draft IP-related contracts, etc.
- *IP Attorneys (IP Agents)*: An IP attorney is a professional who represents their clients before the IP authorities, e.g. the European Patent Office, national patent offices, drafts the IP filings and follows up application procedures. Unless explicitly stated, IP attorneys are not lawyers therefore IP attorneys cannot necessarily represent their clients before the courts.

In most European Union countries¹, it is possible to distinguish two types of IP attorneys: "Patent attorneys" and "Trade mark attorneys". It is usually required to take and pass an exam to be able to officially use such titles. Generally, candidates with a scientific or technical background such as biologists, physicists, engineers, etc. are allowed to sit the patent attorney examination which allows them to draft complex patent applications and/or evaluate the current state of the art². For trade mark attorneys, a university degree is generally sufficient.

- *Technology Transfer Officers, IP Commercialisation Experts, etc.*: These titles define expertise in different aspects of IP. As an example, technology transfer experts are the specialists who have expertise on technology transfer issues generally taking place between university – industry, and IP Commercialisation Experts are dealing with different steps of IP commercialisation activities such as IP auditing, IP valuating or IP exploitation, etc.

¹ Spain, Portugal and Poland are exceptions.

² Different rules apply in different countries for local patent and/or trade mark attorney examination prerequisites. In order to be a "European Patent Attorney", who represents the applicants before the European Patent Office, [the European Qualifying Examination \(EQE\)](#) must be taken.

10 steps to find a suitable IP professional:

BEFORE THE MEETING:

1. **Know before you go:** Being equipped with a minimum of IP knowledge and terminology is extremely helpful when discussing the topic with an IP specialist. Take advantage of the European IPR Helpdesk services and its freely available material³ to get essential information regarding your IP issues.
2. **Define your objectives:** Take your time in defining your objectives and the expected results. Then, try to figure out what type of IP professional you would like to consult according to your needs. For example, do you need an IP Lawyer or an IP Attorney, or both? Generally, IP law firms employ both profiles.
3. **Search for an IP professional:** Talking to people who have experienced the same problem you face and asking for their reference are always worth trying. Regional associations, websites, business referrals (businesses who provide services to key players in the IP area) and IP associations may also help you to identify the best IP professionals for you.
4. **Check official bar/representative lists:** Checking the bar lists for lawyers and attorney lists guarantees whether the IP professional is officially entitled to act on your behalf before the authorities. As an example, you can find online the databases of professional representatives before the [European Union IP Office \(EUIPO\)](#) and before the [European Patent Office \(EPO\)](#).
5. **Conduct a background search:** Collecting background information on the former IP filings and success rate of applications (you can conduct a “representative search” on the databases of [EPO](#) and [EUIPO](#)) or lawsuit histories will be highly useful to find out the former experience of the IP professional. On the other hand, checking the current clients of the IP professional is also essential since you may wish to avoid working with someone who is also serving for one of your competitors.
6. **Establish a short list:** Finalise your decision with a short list of IP professionals whom you are going to meet with. A list of 3-5 consultants is often sufficient for comparison.

DURING and AFTER THE MEETING:

7. **Interview with the IP professionals:** Sometimes, the first consultation with IP professionals is free of charge. Ask your questions and underline the key points which are substantial for you.
8. **Never disclose sensitive IP information in the first meeting:** You should never disclose any critical IP information (your drawings, invention in detail, your trade mark ideas, etc.) until you sign a contract.
9. **Think about cost and benefits:** Specialists can charge a little more, but if their specialised information is truly valuable, it can be money well spent. Make a quick cost-benefit analysis and make your decision wisely.
10. **Establish a contract:** It is always better to draft and sign the contract after reaching an agreement on a written proposal. The proposal should include the objectives, the methodology used, the budget and payment procedures, subcontracting (if needed), breach of contract/mission modalities, exclusivity and confidentiality issues and warranties.

³ The European IPR Helpdesk provides first line assistance through different services such as publications, training events and a Helpline. Consult www.iprhelpdesk.eu for more information.

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