YOUR PATENT GUY

PATENT LAW OFFICES OF MICHAEL E. WOODS

Ten Costly Misconceptions about Filing a Patent Application

& How to Avoid Ten Patent Filing Ripoffs

Ten Costly Misconceptions About Filing a Patent Application

1. A PATENT SEARCH IS ALWAYS NECESSARY

Not true. A patent search for most inventors is research into potential relevant prior art in order to estimate patentability. The search is useful in guiding the scope of the patent claims and in some cases to help a patent Examiner during examination of a patent application. A patent search is typically done only among issued U.S. Patents and pre-grant publications. Since 2000, the USPTO has been publishing patent applications, both on its website and in the Patent Office Gazette. Prior to that, patent applications were confidential. In certain cases relating to international filing activities, an applicant may prevent the application from being published. There may be advantages to publication, however, including assertion of provisional rights, which may result in pre-grant royalties.

Current patents and publications do not reflect the state of current technology but rather the state of the technology at the time the application was filed, which could be two or three years ago or even much longer. For technology areas in which innovations occur rapidly, such as computer software, internet and communications inventions, there is often little to be gained from a patent search from technology sources if you are up to date on the state of the art. For mature technologies i.e., golf, bicycling, cooking apparatus, and simple mechanical inventions, patent searches are usually recommended.

2. IF A PATENT SEARCH IS NECESSARY, ONLINE SEARCHING IS ADEQUATE

Not true. Online searching relies upon key words related to the invention. The problem is that not everyone uses the same words to describe the same features or structures of an invention. Therefore, although an online search can be quick, it can also be artificially constrained and narrow when the term or phrase used by the person who wrote the patent application is not used in the search.

The alternative to an online search is a manual search in the USPTO, commenced after talking to a patent Examiner. A manual search includes a review of pictures and images in prior art as well as a search of words. In some cases it is easier to search images than to search words. A manual search sometimes allows the searcher to find matches between a patent and the searched invention more efficiently than an online search.

3. A PROVISIONAL PATENT APPLICATION ALWAYS SAVES MONEY

Not true. A properly written provisional application will not necessarily cost less than a regular patent application because U.S. patent law requires that a provisional application include exactly the same information, absent the claims. A patent application must enable a person having ordinary skill

in the art to make and use the invention; it must also teach the best mode of practicing the invention. Typically, the expression of an invention in a patent application is reflected by the claims. When claims are omitted from a patent application, as they are in a provisional application, it can be difficult to ensure that the invention will meet the requirements of patentability without proper care. Thus, a properly written provisional application often includes at least consideration of claim drafting.

4. MONEY SPENT TO FILE A PATENT APPLICATION WILL ALWAYS BE RECOUPED

Not true. Money spent to file a patent application may never be recouped. Usually, the idea or product embodied in a patent application must have economic merit in order to generate money from the patent process. In most cases, there is no independent value to owning a patent or filing a patent application. Generally, all patent applications are equally valuable. The patent application process is expensive, and on average, only a few out of a hundred issued patents have any economic value. When a patent is economically valuable, however, it can generate large amounts of money for the patent owner.

5. OWNING A PATENT MEANS YOUR IDEA WILL NOT BE COPIED

Not true. Owning a patent does not mean your idea won't be copied. In the United States, it is not a crime to infringe a patent. Therefore, there is no governmental agency enforcing the rights of patent owners. As a patent owner, you must police the patent. A patent owner should understand similar competing products in the marketplace, and it is best when the claims of a patent are written in a way that infringement may be gauged by direct inspection of the competing product or service. Most patent owners also typically hire a patent attorney to perform infringement analyses and issue notice letters to warn potential infringers. In the worst case, a patent owner must file a lawsuit in federal district court to stop an infringer. It is not uncommon for patent litigation budgets to be in the millions of dollars.

6. DETERMINING THE PROPER AMOUNT OF DETAIL TO BE INCLUDED IN A PATENT APPLICATION IS EASY

Not true. A patent application is not a production document and need not include many details that would be useful in other contexts, such as theory of operation or detailed discussions of related technologies. Patent applications and patents issued from them are presumed to be read by a person having ordinary skill in the art; everything that such a person would know is made inherently part of the application. In some cases, misstating a theory of operation or mischaracterizing a state of the relevant technology as a result of providing too much detail may constitute independent grounds for invalidating an otherwise good invention or patent. On the other hand, inventors sometimes want to file a patent application on a bare idea for which there are no or too few details of how to make it or how to use it, or to provide an arrangement of necessary structural elements. These patent applications can be rejected on that basis alone without recourse to recoup filing fees

and attorneys' fees. Including the proper amount of detail is part of the "art" of drafting a patent application.

7. THE PATENT PROCESS IS FAST

Not true. Even with respect to an application which is ultimately successful, it is not uncommon for three or more years to pass, before the USPTO issues a patent. An inventor has no enforceable rights until a patent actually issues. With the introduction of pre-grant publication, however, limited rights begin to accrue upon publication in certain narrow situations, but these rights are realized only if and when a patent is actually issued.

8. DESIGN PATENTS OFFER SIGNIFICANT PROTECTION

Not true. A design patent is usually very narrow. A design patent is generally thought to be easily designed around and can be difficult to enforce. A design patent is better than no protection, however, and in some cases design patents can be quite valuable. Rarely does a design patent application require significant time investment from a patent attorney and most of the legal expense will be associated with preparation of suitable drawings and the USPTO fees. Design patent application pendency is usually less than that for utility patent applications. As such, for some types of infringements a design patent may provide interim protection until a utility patent issues.

9. ALL PATENTS ARE WRITTEN THE SAME WAY WITH THE SAME GENERAL GUIDELINES

Not true. There is actually a wide range of philosophies, goals and drafting styles that go into the patent application process. Some people draft specifications first and then add the claims, strategizing that the claims will be amended during prosecution (though this now has significant risks to an inventor). Others write the claims first and then derive the application body from the claims. Still others write broad claims first and then narrow claims, or narrow claims first and then broad. Whatever method is used, the most important part of the application is the claims, both independently and as they are connected to the rest of the application.

To be valuable, claims must have sufficient scope to cover products made by competitors, now and throughout the life of the patent. That determination is ultimately done by a judge or jury in litigation for each product accused of infringement. Therefore, when the person writing a patent application is familiar with the litigation process the value of the patent application can be enhanced because this possible post-issuance procedure has been anticipated.

Many patent attorneys and patent agents complete their entire careers without having any of their patents litigated. As a result, they are not intimately familiar with the issues raised in defending and enforcing patents, particularly patents they have written. The claims written by these attorneys and agents are not forged in the same way as those written by attorneys who have participated in

the patent litigation process first-hand with their own patents and who are familiar with the strategies that will be necessary in successful litigation and licensing.

10. ONE PATENT APPLICATION WILL SUFFICE TO PROTECT YOUR INVENTION

Not true. Rarely does one patent application suffice to protect an economically valuable invention. Rather, the inventor should have chained and sequenced patents and patent applications to protect the invention because any one patent can be held invalid at any time. It's difficult to predict whether a particular novel product or service is going to be economically valuable. Thus, an inventor is generally advised to file on everything available within a given budget. Monitoring the progress of the patent prosecution and market interest in the product is factored into decisions to pursue additional aspects of a product in related or new applications.

Ten Patent Filing Ripoffs & How to Avoid Them

1. Don't be persuaded by exceptionally high or exceptionally low price offers for filing a patent application. A high price tag for filing a patent application usually includes promises of extra benefits that are not realistic or practical, such as finding investors, locating manufacturers and bringing in licensees. Since these benefits are not usually realized, the high price may not be justified. A low price offer for filing a patent application usually means that insufficient time will be spent on the application and the result may be too narrow or lacking in detail, reducing its economic value. Whatever the fee, make sure you are going to receive an application for a utility patent rather than a design patent.

2. Don't hire a helper who is not registered. Using a helper who is not registered is usually a ripoff because you will not be protected by patent law statutes concerning ethical conduct or, in the case of a registered patent attorney, State Bar ethical conduct rules. And, you cannot be sure that your helper is qualified to protect inventions. These statutes and rules prohibit a registered patent attorney or patent agent from making an unethical or unlawful use of your invention. Patent laws and regulations change frequently, as do current best practices, thus it's in your best interest to seek someone who routinely prepares and files patent applications. To become registered before the United States Patent and Trademark Office, an agent or attorney must meet certain educational requirements and pass an examination. Additionally, a patent attorney must be admitted to practice law.

3. Be wary of charges for prototypes or engineering development. Prototypes and engineering development are rarely necessary before filing a patent application. There are sometimes good reasons, however, for pursuing a prototype first. For example, sometimes useful details for your patent application are developed by making even a crude prototype.

4. Be wary of needless searches that lead to additional expense and delayed filing. See Question 1 under "10 Misconceptions".

5. Don't be persuaded that filing a provisional application will be quick, effective and inexpensive. When a provisional application fails to meet the patent filing guidelines, it is not only worthless, but results in a false sense of security that an invention is protected when it is not. Because of various deadlines, an inability to use the date of the earlier provisional application could jeopardize domestic and international rights.

6. **Be cautious when a patent agent or patent attorney promises specific results.** The patent process has both objective and subjective components. Depending upon how broad the claims and how reasonable or unreasonable the inventor, the particular examiner and the representatives involved are, it may take a long time and cost a considerable amount of money to navigate the patent process with no guarantee of obtaining a patent at the end of the process.

7. Don't be seduced into believing that any single patent application is a sure-fire path to great wealth. Only a few out of every hundred patents are economically important. If an inventor obtains an economically important patent, she or he will undoubtedly have to expend significant resources in enforcing, licensing, and developing the patent portfolio. Be aware that a successful patent can lead to more legal fees and more time will be required to protect the rights that the patent has afforded.

8. Don't be needlessly rushed into filing your patent application. Only file when you have the information you need and can present it in the best possible way in a patent application. You may have more time available than you think to get your patent application on file. Remember that in the United States, an inventor is allowed to test the market for an invention. Doing so is not without risk, but you can try to market an invention to see whether there is any interest before filing a patent application. The USPTO allows a one year grace period after public disclosure, offer for sale, or commercial use of an invention to get a patent application on file for a domestic patent. Relying on this period, however, may prevent you from obtaining any international protection. The USPTO operates a disclosure program to assist with establishing a date of invention.

9. Hiring an unregistered helper or a patent agent can lead to problems. It is often preferable to employ a registered patent attorney rather than a patent agent to help you file your patent application. A patent agent is admitted to practice before the U.S. Patent and Trademark Office, but has not provided evidence to the Patent Office of admittance as an attorney in any state. On the other hand, a registered patent attorney is admitted to practice law in at least one state and is admitted to practice before the U.S. Patent and Trademark Office.

Some people also use the term "patent attorney" to describe an attorney who is not admitted before the U.S. Patent Office but who represent clients in patent litigation or other patent matters such as licensing. By law, patent agents cannot discuss certain legal matters unrelated to patent prosecution, such as infringement and validity, except validity in the context of a reexamination

proceeding. Thus they cannot answer many questions that are related to the patent application process or provide additional services to help in the exploitation of your idea.

Patent agents often compare their rates to those of an attorney to emphasize a cost saving. They may also emphasize extensive background education that is often not current or directly applicable to the inventor's idea. Even so, you as the inventor are usually the most technically proficient in understanding your invention. Your representative is there to help with the areas about which you are less familiar – the patent laws, the USPTO, anticipating how a judge or jury will see your invention now and in the future. For the best protection and most flexibility, hire a patent attorney and confirm their registration by visiting the USPTO website. For example, YourPatentGuy's registration number is 33,466.

10. It may be a ripoff to employ a large law firm to assist you in filing your patent application. Some large firms often use "bait and switch" tactics. You will initially meet with a very experienced and very qualified attorney who represents the firm, but ultimately a different, less experienced, less qualified attorney may be the person who writes your patent application. The inventor is often subsidizing the education and training of these junior attorneys.

Benefits for Inventors Who Choose the Patent Law Offices of Michael E. Woods to Assist Them in Filing Their Patent Applications

All inventor meetings take place between Michael and the inventor, and all applications are written by Michael, a highly experienced and qualified patent attorney, registered since 1989. He has been a partner at the prestigious national law firms of Townsend and Townsend (now Kilpatrick Townsend) and McCutchen, Doyle, Brown & Enersen (now known as Bingham McCutchen). Several of Michael's patents in different technologies have been successfully enforced, either through litigation in several courts or through licensing. Inventor demands in some infringement litigation cases have exceeded $300 million. While the exact amounts of licensing revenues are confidential in particular cases of patents issued from applications written by Michael, these revenues have often been in the millions of dollars. Michael is also an inventor and has successfully licensed his technology.

The applications Michael writes for clients are timely and filed with no unnecessary delay. Michael's patent applications are written with an eye toward exploitation of the invention (with an eye towards future-proofing your invention), based on his significant experience in the areas of enforcement, litigation and licensing.

Representation by Michael may continue after the filing of the application and encompasses prosecution of the application, related applications and any situations that may arise if a patent issues, such as enforcement, possible litigation, and licensing.

Michael uses encryption technology for electronic filing and retrieval of confidential patent applications. Doing so saves you money and ensures confirmation from the USPTO at the time of filing, and speedy notification of developments in your case.

Michael's fees are currently much less than he previously charged when he worked as a partner in large firms, and much less than other attorneys at large firms having fewer years of experience.

PATENT LAW OFFICES OF MICHAEL E. WOODS
YOUR PATENT GUY
16 Hazel CT
San Rafael, California 94901
Phone: 415.419.5524 • Fax: 415.419.5523
email: mewoods@YourPatentGuy.com

Disclaimer

This guide is intended as general educational material and is no substitute for specific legal advice. You should not rely on your understanding of this material in deciding whether a particular course of conduct is appropriate or necessary or advisable; rather, you should always consult with a qualified expert apprised of all the relevant details to guide you. Offering this guide to you is not intended to, and does not, create an attorney-client relationship between you and the Patent Law Offices of Michael E. Woods. You should divulge confidential information only after having established such a relationship in writing so you know that you may submit the information in confidence.

