



THE VIRTUAL PATENT CONSULTATION

Frequently Asked Questions with ANSWERS

1. Who can I tell about my idea/invention, and what precautions should I take?
2. What are the chances that I will make money from my invention?
3. What is a Patent?
4. Can I get a patent on my idea or invention?
5. What is the difference between a Design Patent and a Utility Patent?
6. What are the steps to getting a patent?
7. Should I have a patent search done?
8. What are Claims and why are they so important?
9. How much will having a patent application prepared and filed cost me?
10. After the application is filed, are there any other expenses?
11. How do I know if I have a good or great idea and how do I know whether I should patent the idea?
12. I have no money: will you take a percentage of my invention's profits in exchange for preparing the patent application?
13. Can I write my own patent application?
14. What are your thoughts on provisional applications: I have heard they can save me a lot of money?
15. What is the difference between a Patent Attorney and a Patent Agent?
16. Can you help me market my invention or find a company that will buy the rights to my invention?
17. Do I even need a patent: can't I just submit my idea to one or more companies and let them decide whether they want to patent it after they buy the idea from me?
18. I can't decide whether to go forward: do you have any last thoughts to help me make a decision on how to proceed?



19. I have a patent and I think someone is infringing it: what should I do?
20. I manufacture a device and I am worried I am infringing someone else's patent: what should I do?
21. Do you offer any other patent or intellectual property legal services other than those discussed above?
22. I didn't find an answer to my question or concern on this page, what should I do?

1. Who can I tell about my idea/invention, and what precautions should I take?

Loose lips sink ships. Or applied to inventions, disclose and lose your patent rights! OK, not immediately, BUT if you do not get a patent application on file within one year of a public disclosure or an offer for sale, you have just dedicated your invention to the public – meaning anyone can make it, anyone can sell it and anyone can use it and you can't stop them. This one year grace period applies only to the United States and a select few other countries. In most other countries, you lose the right to patent the invention the minute you make a public disclosure. Luckily, the filing of a U.S. application will preserve your right to foreign file for one year provided the filing is made before a public disclosure or an offer for sale.

Accordingly, it behooves an inventor to avoid making a public disclosure for as long as possible. Luckily, this isn't very difficult: have anyone you disclose the invention to sign a Non-Disclosure Agreement (or NDA). We even have one that you can use on our website. Simply, an NDA prevents a disclosure to a third party from being a public disclosure; meaning the one year clock DOES NOT start ticking and your rights to file for foreign patent protection are preserved. So, if you want to talk with a machinist about making a prototype, have him sign an NDA. If you want to talk to an injection molder about the cost of producing your invention, have him sign an NDA. If you want to talk with marketing specialists about whether your invention is marketable, have them sign an NDA. If you want an engineer to help you design your invention, have him/her sign an NDA. If you want to tell your friends or co-workers about your invention to get their opinion, have them sign an NDA. Although a disclosure to close friends may not be a



public disclosure, it is wise to play it safe. **About the only people you do not need signed NDAs from are your immediate family and your attorney.**

Yes, you read that correctly, you can tell us about your invention and not jeopardize your patent rights. Attorneys have a legal duty to keep communications from clients and prospective clients confidential. If we were to break such a confidence, we could lose our licenses and find ourselves on the wrong side of a legal malpractice lawsuit.

You must be careful, however, even with a signed NDA, not to offer your invention or a product or service embodying your invention for sale because, just like disclosing your invention to the public, an offer for sale will start the one year clock ticking. **In the case of an offer for sale, unlike a mere disclosure of your invention, an NDA WILL NOT prevent the one year clock from beginning to run.**

In the end, you are always advised to seek legal counsel before making any disclosure. The answer provided herein is simplified and cannot take into account the various particulars of your situation. Accordingly, extreme caution should be exercised before making any disclosure whether under an NDA or not. Remember, to play it safe you may want to get a patent application on file prior to any public disclosure or offer for sale. We do realize, however, that this may not be practical for all inventors in all situations, SO it bears repeating, get advice from a qualified patent attorney as soon as is reasonably possible.

2. What are the chances that I will make money from my invention?

We have absolutely no idea! Your invention could be incredibly valuable to the particular market segment to which it pertains or it could be a dud. You are in a better position to evaluate that than us. Sometimes timing and luck play a significant role in bringing an invention to market. And then of course



there is your commitment to the invention. Are you willing to spend the time required to promote your invention? Are you willing to spend the money necessary to pursue your invention to its logical conclusion?

One thing is very certain; your chances of success are lowest if you do not protect your invention with a well-drafted patent. In fact, **your chances at licensing your invention without a patent are essentially zero** (of course, there are always rare exceptions). The decision to patent your invention should not be entered into lightly, but **if you are willing to devote the time, the money, the energy and the perseverance necessary to pursue your invention, the rewards can be huge**, and not just in terms of money but in terms of accomplishment.

One of our attorneys, Kurt Leyendecker, invented a product, formed a company to produce and market that product, and lived through the failure of the company. However, he does not regret having taken the chance. In fact, despite the outcome, he claims to have learned so much from the experience that it has made him a better businessperson and lawyer today. He feels his entrepreneurial experiences allow him to better assist the Firm's clients in their ventures.

In our opinion, the **two most important factors** to the success of an invention are (1) **a novel and good idea** for an innovative product or process, and (2) **a high degree of commitment** by the inventor. Everything else pales in comparison. And we would even be so bold as to say a very high level of commitment can even turn an idea that perhaps isn't so great into a successful product or process. So if you have the will, the desire and the fortitude to see the process of bringing a new product to market **your ultimate chances of success increase significantly**. The actual invention of a new or improved product or process plays a very small part in a product's ultimate success.



Obtaining a patent for your invention also plays a crucial part in the process of bringing your invention to market, especially if your goal is to license it to others. **Most large corporations will not even look at your invention unless you have at least applied for a patent.**

If you are going to produce and market your invention, a patent is not an absolute necessity. However, if your product is successful, watch out, because a well-heeled competitor may copy your product, cannibalize your market share, and there will be nothing you can do about it.

To summarize, you are the key to the success of your invention. If you have a good idea along with the will and the persistence to pursue your invention, your chances of success, although not guaranteed, are much improved over the typical independent inventor. **Obtaining a patent for your invention is your price of admission and the first step on the road to success.**

3. What is a Patent?

Simply, a **patent** is a personal property right granted by a government that **gives the owner an exclusive right to prevent others from making, using or selling a claimed invention for a certain period of time**. In the United States, the term of a utility patent grant is 20 years from the date of filing a patent application and the term of a design patent is 14 years from the date of the design patent grant.

Of particular note, a patent does not convey to the holder the right to make, use or sell their invention. Rather it only prevents others from making, using or selling the invention. In certain circumstances a patent owner may be prevented from making, using or selling his/her invention because the invention is also covered by another patent owned by someone else.



For example, let's assume you invented a pencil with an eraser on it, and no one else had ever put an eraser on top of a pencil. You apply for and receive a patent. Now, nobody can make your pencil with an eraser without your OK. But let's also assume the pencil was invented a few years before and another inventor owns the patent on the pencil. Your pencil has all the features of the other inventor's pencil except you have added the eraser. Unfortunately, your pencil reads on his patent and you must get permission from him before you can make your pencil. In the real world of business, you would probably approach the other inventor and reach some sort of agreement so that you can have your pencil produced and sold. Perhaps, you would have to license his pencil patent and give him a percentage of the revenues generated from the sale of your pencil with an eraser.

In reality, more often than not, no one else will hold a patent that prevents you from producing your invention, but the prudent inventor is wise to have his/her patent attorney review the patent references identified in a patent search to not only determine whether your invention is patentable, but also whether your invention will likely infringe another's patent if it is made, used or sold. While both patent attorneys and patent agents can legally provide advice on whether a particular patent is patentable, only attorneys, preferably patent attorneys, can provide advice about whether your invention might infringe another patent. See question #15 for more about the distinctions between patent agents and patent attorneys.

4. Can I get a patent on my idea or invention?

We have observed over the years that **many people think that in order to receive a patent a person must invent something earthshaking or of great significance. The truth is that merit, potential and/or groundbreaking significance have nothing to do with obtaining a patent for an invention.** The United States Patent Office makes no judgments as to the merit or potential value of your invention. Rather, they look to see that an invention satisfies three basic requirements: (1) utility; (2) novelty; and (3) nonobviousness.



Utility is by far the simplest requirement to satisfy requiring only that the invention serve a utilitarian purpose. In other words, the invention must be useful. Most inventions easily satisfy the utility requirement. Some types of creations excluded from patentability for lacking utility include: creative works, such as music, literature and sculpture; scientific or mathematical algorithms, which are considered to be discovered rather than invented; and purely mental processes, which can be performed solely in one's mind.

Novelty merely requires that someone else did not invent your invention and disclose it to the public before you. In general, a patent search combined with a patentability opinion is very effective in determining whether an invention is novel. If your attorney believes that your invention isn't novel, he/she will usually recommend that you do not file a patent application.

Nonobviousness simply requires that the invention not be obvious in light of prior art to someone of ordinary skill in the art in which the invention is to be practiced. Obviousness or the lack thereof is very difficult to objectively judge. Not surprisingly, nonobviousness is the most common hindrance to having the claims in a patent application allowed. Further, it represents the greatest source of disagreement between patent attorneys and the patent examiners in the patent office. An examiner will contend that a claim is obvious, the attorney will respond with a legal argument why it is not, and this may go on and on until one side gives up. Mind you, arguing with the examiner costs money in terms of (i) having your attorney draft office action responses and (ii) continuing the prosecution of the invention. Many attorneys will try to reach an accord with an examiner in a telephone interview after the second and typically final office action has been presented. We will, however, almost always recommend a telephone interview being conducted after the first office action

An obviousness rejection by a patent examiner usually takes the form of two or more prior art references (typically issued patents) that when combined teach all of the elements in one or more of the



patent application's claims. Often, however, the attorney can successfully argue that the combination of the references is not proper even if the two references contain all the elements of the claim. In order to combine references, the examiner must demonstrate that the two references pertain to the same field of art as the subject invention and that there is a motivation to combine the references. Interpreting these legal standards and applying them to the facts of a particular patent application and rejection are not easy and are best left up to a qualified patent attorney. Suffice it to say, just because you think an invention may be obvious does not mean that the invention is obvious in terms of the requirements for patentability. Obviousness as viewed by you is probably based on your common sense and life experiences while obviousness relating to patentability is based on statute and case law. In our experience, the legal standard of obviousness is much narrower than one would imagine and accordingly, can often be argued around to obtain a patent.

5. What is the Difference between a Design Patent and a Utility Patent?

A utility patent is typically what comes to the mind of most people when they think of a patent. Utility patents can be obtained for new and useful processes, machines, articles of manufacture or compositions of matter. Utility patents may not be obtained for: printed matter (usually protected with a copyright); naturally occurring articles; scientific principles, mathematical laws; and “inoperative” inventions, such as perpetual motion machines that are incapable of achieving a useful result.

Unless otherwise stated, throughout this web site when we use the term “patent” and “patent application”, we are referring to a utility patent and utility patent application, respectively.

Art is generally not within the purview of utility patents. Sculpture, paintings, and music are not considered to possess utility (or usefulness) and are, accordingly, not patentable. Creative works are typically protected through copyright. Patent law does overlap with copyright concerning design patents.



Design patents protect the novel and nonobvious ornamental designs of articles of manufacture.

In other words, the design patent protects the way an article looks. Unlike utility patents, there is no requirement that the ornamental design be useful. Rather, a design patent cannot protect the features of an article of manufacture that are dictated wholly by functionality. It is not uncommon to apply for and receive both a utility patent and a design patent for the same article provided the novelty and nonobviousness of the article resides in both its utility and its ornamental appearance.

As mentioned above, sculpture is protectable through copyright, but since it is an article of manufacture, it is also protectable through a design patent. Because registered copyrights are inexpensive to obtain when compared to design patents (typically about \$300 versus about \$1000-2000) and considering the much shorter term of a design patent (14 years), it is rarely prudent for a sculptor to apply for and obtain a design patent when a copyright will provide adequate protection. Furthermore, since copyright protection actually applies to a creative work immediately upon its creation, the sculptor need not even apply for a registered copyright, although by registering the copyright, the sculptor does gain certain additional avenues of legal recourse against those who copy his work.

Copyrights are not available, however, for articles of manufacture that are primarily functional unless the nonfunctional portion can be conceptually or actually separated from the functional elements of the article. For example, a 1.5-foot high sculpture of a person is protectable through copyright whether the sculpture stands alone or serves as the base of a table lamp. Interestingly, the lamp's design (i.e. the sculpture) would also be protectable for use in a lamp using a design patent. There is a degree of overlap between copyright and design patent protection but in general, design patents are most useful to protect the ornamental and non-functional features of an article of manufacture that possesses functionality.

Generally, a design patent by itself without an accompanying utility patent is of little use to the independent inventor. Some unscrupulous invention companies have in the past used the design patent as a



way to inexpensively (for them) obtain a patent for their customers. They, however, often failed to inform the customer that the design patent only pertains to the look of the device and that a competitor could produce a similar device that has the same functionality without infringing the design patent. And if the competitor cannot produce a device having similar functionality as the design-patented device without copying the look of the device, then the design patent is probably invalid because the look of the product is not wholly ornamental but is at least partially dictated by function.

We do recommend that an inventor or company consider obtaining design protection when they intend to produce an article of manufacture themselves and the design is unique enough in their opinion that there is a concern about someone copying it. Often a design patent is a good companion to the utility patent as it further protects a particular product.

6. What are the steps to getting a patent?

The steps to getting a patent are described in detail in reference to an associated flow chart on our Patent Process page on our website.

7. Should I have a patent search done?

If you are a solo inventor or a small company, **the answer is almost always yes**. Furthermore, any patent search should include a patentability opinion and cursory review for infringement issues from a qualified patent attorney (note that patent agents can only provide patentability opinions and cannot legally provide his/her opinion concerning infringement matters).

For \$795, we provide a patent search from a professional patent searcher and our expert analysis of the identified patents. Based on this analysis, we will give you an idea of the potential breadth of any claims



to be included in your patent. If it is determined that sufficient claim breadth cannot be obtained for your invention, you may decide not to file a patent application, saving the several thousands of dollars to draft and file the patent application, as well as, the future expense of prosecuting the application.

You may be familiar with patent searches that are advertised at prices from \$250 to \$500 on the Internet and in certain inventor magazines. These searches typically include a list and copies of the references that were found to be closest to your invention, and a very brief opinion of the searcher or someone with the search firm concerning the patentability of the invention. Typically, these brief opinions do not analyze the breadth of coverage that may be obtained for an invention. Understand, however, that most inventions are patentable in some manner over the prior art if the patent claims that define the legal scope of the invention are written narrowly enough. As discussed elsewhere on this site, narrow claims result in patents that are not very valuable; whereas, patents with broad claims are the most likely to get licensed. To get an idea of the potential breadth of patent coverage obtainable for an invention, a more in depth analysis of the prior art than is provided in the cheap searches is required. We have had clients come to us with results from inexpensive searches who were unclear on how to proceed with patenting their invention. To have us review the results from one of these searches, we charge about 2-4 hours of our time that amounts to about \$500-750. Ultimately, it is less expensive to hire us to perform both the search and an analysis in the first place.

If during the review of the patents identified during the search, it is determined that the one or more unexpired patents are sufficiently close in subject matter to your invention, an in-depth infringement analysis may be recommend. As discussed in Question 3, a patent only gives you the right to exclude others from making, using or selling your invention. The patent does not give you the right to make your invention. In fact, you may be prohibited from making and selling your invention by another patent. To determine whether this is an issue an infringement analysis is performed. Depending on the complexity of the subject patent(s), anywhere from about an hour to 5-10 hours may be required to perform the analysis. Of course,



this service will not be recommended unless a potential infringement issue is identified during the patentability analysis. In the majority of cases, no infringement issue will be identified or if one is, the necessary analysis can be performed within an hour.

It is to be understood that any patentability or infringement opinions offered by a patent attorney are limited to the prior art identified in the patent search. Patent searchers are not perfect and although they do their best to identify all of the most relevant prior art, they can and do occasionally miss a key reference. On that note, however, we use a highly qualified and competent searcher in whom we have great confidence. Our search typically includes a check of several foreign patent databases but this portion of the search is by no means as comprehensive as the search of the United States database. The scope of the search can be expanded to include more rigorous searching of various foreign patent offices, such as the European and Japanese Patent offices for an additional search fee. Further, searchers do not look for prior art that has not been patented. In fact, we recommend that before a search is even performed that the inventor gets on the web using a top notch search engine, such as Google, Yahoo or MSN, and search for any information that may be pertinent to his/her invention. You may find your invention is already on the market or was at some time in the past, in which case there would be no need to perform a formal patent search or apply for a patent.

To read more about patent searches go to our All About Patent Searching Page on the website.

8. What are Claims and why are they so important?

Simply, claims are one-sentence descriptions of what the inventor considers his invention. **The claims legally define the scope of an invention** and inventor's right to exclude others from making, using or selling his invention. Without question, the claims are the most important part of the patent application and subsequent patent.



The claims are also the most misunderstood part of a patent application. They are often written in patent attorney legalese and are very difficult for someone not trained in patent law to read and properly interpret. The typical inventor is unable to judge the quality of the claims provided in a patent application and **if the patent attorney has not done a good job, the scope of protection of any resulting patent may be severely limited to the point where the patent has little or no value** in preventing others from copying your invention. It is an unfortunate reality that many patent agents and attorneys are also not very adept at writing good legally defensible claims, whether that is because writing good claims would take too long or because of simple ignorance concerning the rapidly changing state of patent law. On the other hand, **a good patent claim may provide you with a scope of protection that is greater than you contemplated** before you went to see your patent attorney. Accordingly, the choice of quality patent counsel is of the utmost importance.

To give you a better understanding of claims, there are basically two types: independent claims and dependent claims. An independent claim is a complete description of the invention in and of itself. It comprises a set of elements (or limitations) that when taken together in combination defines a novel and nonobvious invention. A dependent claim is a claim that includes additional limitations that further define and limit an independent claim. Consider the example of a pencil with an eraser as provided below:

1. A writing device comprising:
 - (i) an elongated core comprised of a first material, the first material having a property of exfoliating when frictionally engaged with and moved across a surface;
 - (ii) an elongated shell comprised of a second material substantially surrounding the elongated core, the elongated shell having a first end; and
 - (iii) an eraser, the eraser being attached to the first end.

2. The writing device of claim 1, wherein the first material comprises graphite.



3. The writing device of claim 2, wherein the second material comprises wood.

Claim 1 is an independent claim. Claim 2 is a dependent claim that includes all of the elements of claim 1 plus the additional requirement that the first material be graphite. Accordingly, if these claims issued in a patent and a person made a wood pencil with a lead core, he would be infringing claim 1 while not infringing claim 2, because claim 2 requires that in addition to all the elements of claim 1 that the core be made of graphite. Claim 3 is dependent on claim 2 and accordingly includes all the limitations of claim 2 and claim 1 from which claim 2 depends as well as the additional limitation that the second material comprises wood. Accordingly, if a person made a mechanical pencil with a graphite core material and a plastic shell he would still be infringing claim 1 and claim 2, but he would not be infringing claim 3.

How does an inventor know if the claims that a patent attorney wrote for his invention are any good? We do not have an answer for you. Our basic response would be to question your patent attorney before you hire him. Listen to his responses. Does the attorney seem like he takes the claims portion of a patent application seriously. Ask him/her how much time it takes to draft a set of claims. If he/she indicates it can be done in a couple of hours, you can rest assured that the claims will probably not be very good. If you prospective patent attorney says he can draft an entire application for \$3000 and his hourly rate is \$225 or more, you can be confident he is not going to spend more than a few hours on the claims. In our opinion to draft three really good sets of claims (you can have up to three independent claims in your application for the basic filing fee) takes around 6-8 hours. And incidentally, the shorter the length of the claims, the better they are likely to be. Long claims with a lot of additional language are almost always too narrow!

9. How much will having a patent application prepared and filed cost me?



There are a number of steps to getting a patent as indicated in the Patent Process page on our website. Normally, however, it is the initial cost to get an application on file that concerns most inventors. Typically, the initial cost involves (1) a patent search to determine whether the invention is patentable and often to determine whether practicing the invention would potentially infringe another's patent, (2) analysis of the documents uncovered during the search, and (3) the drafting and filing of a patent application.

If you have done any research into the cost of getting a patent, you know the fees vary dramatically. One firm may charge \$250 for a patent search while another charges \$1000 or more. Some agents and attorneys advertise that they will prepare a utility application for \$2500-\$3000, while large national firms can charge upwards of \$10,000. It doesn't seem reasonable that one patent attorney will prepare an application for a mere \$2500 and another will charge around \$10,000 for the same invention.

Please remember not all patent applications are created alike, some are better than others, and typically for the better application you will pay more money. We liken it to choosing an automobile. A \$2500 application is most akin to a Yugo; whereas, the large law firm application is most akin to a Rolls Royce. Moderately priced applications from solo practitioners run the gambit from Yugo value and quality up to and exceeding Lexus and Infiniti value and quality.

You will find that large law firms will charge the most for an application. They are used to dealing with large corporate clients with much deeper pockets than small companies and individual inventors. The billing rates of attorneys in the large firms are very high, typically ranging from around \$225 for a new attorney that recently graduated from law school and does not have much experience to \$400 and above for partners. Considering that a patent application of low to medium complexity takes 17-28 hours to prepare properly, **a patent application prepared by a senior associate attorney at a large firm will typically cost between \$5,500 and \$9,100.**



Why are rates so high at the larger firms? There are several reasons. First, the overhead is substantially higher: they have to pay for the fancy offices, the secretaries, the numerous clerks to handle billing and docketing, the receptionist, and the fancy computer systems including personnel to maintain those systems. Many of these services that raise the hourly rate of the attorneys are valuable to large corporate clients. For instance, a large corporation may have dozens of U.S. and Foreign patents in their portfolio that need to be maintained and organized. Accordingly, docketing services are very important to them. However, many if not all of these services are of little value to independent inventors. Second, the hierarchy of the large law firm requires a substantial chunk of the amount billed by an associate be distributed among the firm's partners as profit. Typically, about 20% to 35% of the amount billed is pure profit distributed to the partners. A good rule of thumb is that a third of the amount billed goes to the attorney actually doing the work in the form of salary; the second third is applied to overhead costs; and the final third is partner profit.

Perhaps a question that begs an answer is whether patent attorneys from large national firms are more skilled at their craft than patent attorneys from smaller firms. In general, large national firms are very selective in who they hire. No more than 10% of all attorneys graduating from law school in any given year are even considered by the large national firms to be suitable for employment. So generally speaking, the academic abilities of the average large firm patent attorney are slightly better than those of the average small firm patent attorney or solo practitioner that has never practiced in a large firm. However, the distinction is typically not that great. In our experience, we have come across very good attorneys that are associated with large firms and that are solo practitioners. Conversely, we have come across mediocre patent attorneys in both large and small practices.

Concerning the low cost providers, stay away! As we stated above, **it takes an average of 17-28 hours to write a good patent application for an invention of low to medium complexity.** The hourly rates for solo patent attorneys typically range from about \$175 to about \$275. Even at low end, a properly prepared patent application should cost between \$3000 and \$5000. Even patent agents rarely charge below



\$125 an hour, although we do not generally recommend using most agents for drafting applications for the reasons listed in question 15.

So how can someone prepare an application for about \$2500? Well, they might write skimpy inadequately detailed applications. The patent office does not scrutinize patent applications for sufficient detail, and accordingly, many of these applications will issue into patents. But they will typically be very weak patents that are easy for a competitor to work around or easy for a competitor to challenge and have declared invalid in court. In other words, these types of patents tend to be very difficult to enforce. Because of this, **a holder of a weak patent would have a very hard time licensing his/her idea.**

Another trick of the low cost provider is to use unqualified writers, who are not registered patent agents or attorneys, to draft the applications. At best, the writers may be engineers or scientists, while at worst the writers may not have any formal technical training. In either case, the writers are almost assuredly not trained to draft a patent application that maximizes the potential coverage of the inventor's invention.

Finally, a low cost provider may charge an extremely low per hour rate that is well below market (<\$100 an hour). The thing for an inventor to consider is – why is this attorney or agent charging so little? Perhaps, they cannot get business at higher rates, unlike most other attorneys and agents, because their skills are lacking in some way. Perhaps, they are inexperienced. Perhaps, they do not believe they are worth the going rate. In any case, the inventor will probably not be well served.

So what is a reasonable cost? Well, it varies with the complexity of the application. **Expect to pay between \$4250 and \$6000 for the drafting services of a qualified attorney or agent for an invention of low to medium complexity.** Applications for more complex inventions can be much more. Further, expect to pay \$70-100 for every sheet of formal drawings required for the patent application. Additionally, filing fees of \$425 and up are required depending on the number of claims in the application. Of course, these fees



are on top of any patent search and analysis fees that can add an additional \$795-995 to the total cost. To see our comments concerning patent searches, see our All About Patent Searching page on our website. The total cost for preparing a quality patent application from the initial search through filing will typically cost the inventor between \$5700 and \$7200 (\$4900 to \$6200 if you forgo the patent search). Certainly this is not chump change and the decision to spend this amount of money should not be entered into lightly.

Understand that **there are ways to reduce the cost if you are willing to do some of necessary work yourself**. For instance, if you can prepare your own drawings you can save several hundred dollars. Further, if you can provide the attorney with a well written and detailed invention disclosure, the attorney may be able to use portions of the write-up in the application; reducing the amount of time he must spend drafting the application and thereby saving you hundreds to thousands of dollars.

We assume that because you are considering patenting your idea or invention that you believe the invention has value in the relevant market place. Presumably, you believe the idea is worth a significant amount of money, perhaps millions of dollars in potential revenue and/or thousands to hundreds of thousands of dollars in potential licensing revenue. While the difference between a \$5000 estimate to prepare and file a patent application with one provider and a \$3000 estimate with a low cost provider may seem significant now, please consider that **the \$2000 difference is relatively insignificant if the patent from the \$5000 application results in a license potentially worth hundreds of thousands of dollars and the patent from the \$3000 application is not licensable** because of significant insufficiencies in the patent document.

10. After the application is filed, are there any other expenses?

Unfortunately, yes. Please refer to our Patent Process page for an idea of the specific steps typically involved in procuring a patent. The truth of the matter is the total cost to procure a patent is typically a little less than double the cost to file the application in the first place. For example, if the cost to get the



application on file was around \$5,000 than the total cost once the application has been procured will be about \$8000-\$10000. And if the invention relates to a business method or is an Internet related invention, the total expense often can be as high as three times the cost to get the application on file.

What are the particular costs and expenses incurred after filing? For one, the claims in most patent applications are initially rejected by the patent office patent examiner. This is a normal part of the process and is usually not a reason for concern. However, we must respond to these rejections either by arguing that the rejections are improper and/or offering amendments to the claims. Preparing this document is time consuming and therefore costly. On average, an application will receive one or two office actions rejecting all or most of the claims in the application. Each office action cost about \$1000-\$2500 to prepare with about \$1500 being the most typical.

Assuming we are successful and are able to convince the patent examiner to allow the application to mature into a patent (we are successful in most cases), you will have to pay an issue fee to the patent office along with associated processing and document preparation charges. Currently, the issue fee is about \$1000 for a small entity.

If you'd like to get a better idea of the future costs involved in procuring the patent application, please see our Patent Rates page on our website.

11. How do I know if I have a good or great idea?

That's the million-dollar question. Unfortunately, we cannot answer that for you. Patent attorneys are experts at obtaining patent protection for their clients and are not in the business of product evaluation and marketing research. If you ask us what our opinion of your invention is, we might give it, but understand



there have been plenty of products that we thought would never make it and have, and conversely, there have been products we thought were great ideas that never panned out.

In general, you are a much better judge than your attorney at determining the value of your invention. Presumably, you have some knowledge of the field of art to which your invention pertains. In developing your invention, you may want to research related products that are currently available and analyze the differences between them and your invention. You may want to talk to those who market similar products and have some feel for the market size. **One caveat, do not reveal your invention to others without first consulting with your patent attorney as such disclosures could affect your ability to obtain patent protection.**

If you would like to explore the viability and market potential of your invention, contact us and we will try and direct you to reputable people who can help you.

12. I have no money: will you take a percentage of my invention's profits in exchange for preparing the patent application?

This question is easy to answer: NO. It is actually a Firm policy and a general view that is taken by many law firms across the country. Simply, we do not want our legal judgment to be impaired by our interest in your invention. Believe me, the decision to implement this policy was not an easy one. And we know that at some point in the future we will be looking back wondering why we didn't take a piece of the action from a number of our clients.

13. Should I write my own patent application?



Do you perform surgery on your family members to save money? We would guess the answer is no! The fact of the matter is that anyone can draft his or her own patent application and there is a good chance that application will issue into a patent. However, **you are not likely to have very good coverage for your invention**. In other words, competitors will likely find it very easy to work around your patent to avoid infringement but still gain the benefits your inventions provides. Further, **you might as well forget licensing your patent**. Why would a company pay for a license when they or their competitors can easily work around your invention? If you really believe your invention has merit and value, please commit to invest in it and have your patent application prepared by a qualified professional.

Although we do not recommend an inventor write his own patent, we do feel strongly that an inventor is well served by learning as much about the patenting process as possible. To that end, we suggest you read Patent It Yourself by David Pressman. It is a really good book that is generally respected by patent attorneys even though many of us may disagree with the book's premise.

If you are adamant about drafting your own patent application, at the very least have the document reviewed by a patent attorney. Depending on the length of your application, this will typically cost anywhere from \$200-1200, but will be well worth it. Better yet, work with a patent attorney from the beginning. He/she can help you outline the application and give you tips and pointers that will be invaluable. An even better idea is to have the attorney draft the claim sets to go along with your application.

Claims are the most difficult section of the application and are also the most important. As discussed in question #8, the claims define the legal scope of your invention: if they are too narrow, competitors will not have a difficult time designing around your patent. Conversely, they cannot be so broad as to read on the prior art. Claims are tricky things that are strangely written and are difficult for the layperson to understand let alone write. Depending on the patent application, a review of an inventor-written application coupled with the drafting of three high quality claim sets comprising a total of twenty claims (the number included



with your filing fee) will typically cost you between \$1200 and \$1800. Mind you, this is not an insignificant chunk of change, but it is much less than the \$4250 to \$6000, an attorney would charge to draft the entire application. Further, although an application written by the inventor with claims drafted by an attorney will be much better than one with claims drafted by the inventor alone, typically it will not be as good as an application drafted in its entirety by the patent attorney. At the very least, however, by having an attorney draft the claims, you will have the chance of getting a much stronger patent that can be licensed and can be enforced.

Another option for the inventor who is willing to help draft the application in hopes of reducing his/her costs is to **provide the attorney with a very detailed disclosure**, as provided on our website, that the attorney can cut and paste from in drafting the patent application. **A well-written disclosure can save the attorney significant time and reduce the inventor's bill substantially.** Further, if the inventor provides figures of the invention with sufficient level of detail (even if only rough sketches), these figures can help the attorney more quickly determine the number and type of formal drawings that will be required to fully illustrate the invention. A caveat: a poor written disclosure even if fairly detailed may not reduce the time necessary to prepare an application properly.

14. What are your thoughts on provisional applications?

In general, **we discourage their use**, especially when small companies or solo inventors are concerned. This view is contrary to much of what you will hear and read. **Some patent prosecutors trumpet the provisional application as an inexpensive way to patent your invention. Not true!** Some software companies will sell you provisional patent application software that you can use to “easily” draft your own patent application. Well, this is true to some extent: you can draft your own application, but that does not mean the application will be very good. Others will tell you how a provisional application is cheap



to file. Yes, it is, but it has to be matured within one year and you will pay the more costly filing fee for a nonprovisional patent application then.

First, what is a provisional patent application? In short without getting into unnecessary detail, a provisional patent application is a patent application without claims. As mentioned, claims are the most difficult section of an application to draft. Furthermore, they are the most important component of a nonprovisional patent application as they define the legal breadth and scope of your patent. Claims are also what a patent examiner examines when determining whether your invention is deserving of a patent. **Except for the claims, the content of the provisional application must satisfy all the other major requirements of a patent application.** Namely, it must enable your invention so that someone with ordinary skill of the art could practice your invention, and it must describe your best mode of using the invention at the time of filing. For more detail on the sections of a typical patent application and a description of them, see our Patent Anatomy page on our website.

Because a **provisional application** has no claims (or at least is not required to have any), it is never examined and **can NEVER issue into a patent**. In fact, a provisional application has a life span of no more than 1 year. If it is not matured into a nonprovisional patent application with the inclusion of at least one claim, it will go abandoned. It will, however, give you the right to list your invention as patent pending. So at the end of the one-year period, you will have to spend as much if not more than you originally spent to add claims and update the application. Our experience is that by splitting the process the overall cost of getting a proper nonprovisional patent application on file with the patent office that will be examined and can issue into a patent is at least 10-50% more expensive than filing the nonprovisional in the first place. Why? Well, if you have updated or improved upon your invention in any way, you will want this new information added to the application, especially if these improvements relate in some manner to a claim that is included in the nonprovisional patent application. Adding this new information takes time and money. Depending on the nature of the improvements and how they effect the invention as a whole, you may even be obliged to update



the application. Conversely, if you file a nonprovisional initially, you are under no legal obligation to update the application as you improve on the invention, although you can if you want by filing a related application that adds the new information. Further, because the attorney or agent that originally drafted the provisional application has probably not worked on the application in nearly a year, he or she will have to refamiliarize himself with the content of the application. Of course, you will be billed for that time or it will be figured into the quote to file the nonprovisional application.

So why do many attorneys and agents recommend provisional application then? In our opinion: Economics! That right, they want your business and they quickly ascertain that you are unable or unwilling to pay the full price to get a patent application on file. So they split the baby and offer to put the less expensive provisional application on file for a little over half the cost of the nonprovisional. They know, however, that you will be back in a year and that you will have to pay the necessary amount to mature the application into a nonprovisional, and at that point you will not be in the position or have the inclination to shop around for less expensive legal services. In the end, an unscrupulous patent attorney or agent can increase his/her revenues by steering an inventor towards the provisional application based on its lower initial cost.

Aside from the issue of cost, recent court cases in the Federal Circuit (the court when it comes to patent law) have been very unforgiving concerning patents that have been based on provisional applications. In at least one case in 2002, a patent was declared invalid because problems with the sufficiency of the provisional application that it was initially based. The legal basis is rather complicated to explain here, but suffice it to say if the applicant had filed a nonprovisional initially, the patent probably would not have been invalidated. In good conscience, **we cannot except work from an inventor to draft a provisional application without fully warning him/her of the potential pitfalls.** We will, however, prepare a provisional application if you still want one after we have explained the negatives.



The negatives aside, there are a few valid reasons for filing a provisional patent application. First, there are some advantages concerning the term of a patent that can make filing a provisional patent application valuable for certain types of inventions. For instance, if the inventor or applicant expects the patent to be worth more near the end of the patent's term, a provisional patent application may have value. However, to minimize any problems down the line, we usually recommend that a provisional application filed for term extension purposes be essentially complete and include a complete set of claims. Accordingly, such provisional applications typically cost about the same as a nonprovisional to prepare. Another instance where a provisional application may be of value is when an application must absolutely be filed within a couple of days to beat a hard date (such as the one year bar date) and there is no time for a proper nonprovisional patent application to be drafted. These situations occur most often when an inventor comes to the attorney a mere couple of days before the date desperate to avoid losing their right to obtain a patent.

In summary, provisional applications do not offer the inventor an easy or simplified way of getting a patent. Rather, there are significant pitfalls that need to be understood and considered before making a decision to file a provisional application. While it is true that the cost to prepare a provisional application is often cheaper than a nonprovisional application, in the end obtaining a patent by starting with a provisional application is often more expensive than immediately filing a nonprovisional application. Our job is to provide my clients with the best and most defensible patents that we can, so that the potential of capitalizing on their inventions are maximized. For this reason, we hesitate to recommend provisional patent applications even though promoting them could earn us more money.

15. What is the Difference between a Patent Attorney and a Patent Agent?

Both patent attorneys and agents have passed an exam administered by the United States Patent Office and are licensed to prepare and prosecute patent applications in front of the patent office for clients.



Patent attorneys, however, have also passed a state bar exam and are licensed to practice law and render legal advice.

At risk of being blunt, we generally do not recommend the use of patent agents to prepare your patent application EXCEPT when the patent agent is employed by a law firm that includes supervisory patent attorneys. That is not to say that there are no qualified agents. There are, but the risks involved with using an agent are potentially greater than using an attorney.

Patent attorneys are versed in the law. They know how to read case law and analyze it to determine its effect on the law of the land. By in large, patent agents are not similarly trained. Properly understanding case law is not an easy task and usually is a skill acquired after reading and analyzing hundreds of cases during three years of law school.

How does this affect you? Well, **patent attorneys are much more apt to be knowledgeable concerning how recent court cases effect your patent application** and the claims contained therein. Patent law is constantly changing and it behooves you to utilize someone to write your application that can make sure your application is written so not to be undermined in any manner by changes in the law.

Patent agents are only permitted to practice a limited form of patent law, i.e. patent law as it pertains only to obtaining a patent from the United States Patent Office. For instance, **a patent agent** can perform a patent search and render an opinion whether your idea is patentable, but they **cannot offer an opinion whether your invention infringes the patent of another**. As discussed in question #3, a patent only gives you the right to prevent others from making, using and selling your invention and it does not give you the right to actually make your invention. **For an opinion on whether an invention infringes another patent you must utilize an attorney.**



If you need someone to negotiate, draft or prepare a license agreement, you will need an attorney. Of course, if this need arises you can hire an attorney then and use an agent to draft and prosecute your application, right? Yes, but in most cases any cost savings you garnered by having an agent prepare the application will be lost getting the attorney up to speed.

This brings us to a significant question: do you really save that much money using an agent instead of an attorney? Perhaps, but be sure to compare apples to apples. We have come across web sites of patent agents promising to prepare nonprovisional patent applications for around \$2000. We figured the agent was just charging an extremely low effective hourly rate and not actually making much money. After all, an average application takes about 17-27 hours to prepare properly. We reviewed some of the patents written by these agents, the answer became extremely obvious: the low cost was a result of very skimpy specifications that, although adequate for obtaining the patent, might not have enough detail to satisfy potential licensees or hold up in court. We could prepare patent applications for \$2000 if we made them as skimpy as these; however, we wouldn't because they would not serve the best interests of our clients. If you are considering a patent agent because of the lower cost, ask the agent what hourly rate he uses to calculate the amount he charges for an application. Often, the hourly rate will be only slightly lower than that of an experienced patent attorney.

There are instances where we do not think using an agent is a bad idea. For instance, agents working under the supervision of a patent attorney are more likely to be kept abreast of changes in patent law. And certainly there are agents that are extremely knowledgeable and skillful just like there are plenty of patent attorneys that are suspect in their skills. The fact of the matter, however, is that you are more likely to get a good patent application from a patent attorney than a patent agent, although there are always exceptions.

16. Can you help me market my invention or find a company that will buy the rights to my invention?



Leyendecker & Lemire, LLC
An Intellectual Property and Business Law Firm

The simple answer to that is no. This is not what we do. Our job is to you to advise you on legal issues surrounding patents and intellectual property not to assist in marketing your invention. We will do whatever we can to obtain the best possible patent protection for your invention. After that, what you do with the patent is largely up to you. Believe me, you do not want us doing your marketing, our hourly rate is just too high.

The foregoing doesn't mean we will leave you hanging. We know of several reputable companies that we can refer to you. We can refer you to engineering companies that can assist in finalizing the design of your invention whether that comprises the preparation of a detailed CAD drawing of your product or even a physical prototype. We can refer you to marketing companies that will assist you in launching your invention in the marketplace. We can refer you to inventor coaches who will advise you along the entire process of commercializing your invention. We can also provide you with the name of a number of books related to inventing that will assist you in the process.

We will also advise you as to whom not to use in promoting your invention. The invention industry is filled with predators whose main objective under the guise of helping you is to separate you from your money. We know who many of these predators are and we know their tactics. If you read our [BLOG](#), you will see many of the articles we have written about these types of companies. As we have stated again and again, commercializing an invention is risky business to begin with, don't make it substantially more risky by getting hooked up with one of these invention predators.

And if you do find a company to manufacture your invention or a company that wants to license your invention, we will be there to provide you with legal support along the way. If you need to have contracts and/or licenses drafted, we can negotiate and draft documents that maximize your potential for return while minimizing your risk. Further, we will be there to review any licenses or contracts that the other side may

www.PatentDenver.com



have drafted to ensure that there aren't any clause, requirements or conditions hidden therein that would or could negatively impact you. **In short, we will be there to look out for your interests.**

17. Do I even need a patent: can't I just submit my idea to one or more companies and let them decide whether they want to patent it after they buy the idea from me?

Unfortunately, most larger companies will not even look at your idea until you have a patent application on file. And some of the few that will look at your idea sans patent protection will often require you to sign a Disclosure Agreement. A Disclosure Agreement is the exact opposite of Non-Disclosure Agreement discussed in another answer. In short, the Disclosure agreement states that save for your patent rights to exclude the company from using your idea, they can do whatever they want with it.

This hypothetical scenario is possible for an inventor who signs a Disclosure Agreement and doesn't have a patent or patent application in place:

Inventor: Here is my idea. It is a significant improvement over the competition's products and could make you a mint!

Big Company: Yes, that is a great idea. I think we will want to produce this.

Inventor: Glad to here it. So let's negotiate the price of the idea.

Big Company: Do you have patent protection or do you intend to get patent protection?



Inventor: No, I don't have any patent protection, and frankly, I can't afford to pursue any either. Of course, my financial situation will be different in the future when we both make a fortune off of my product.

Big Company: About that, we won't be paying you anything for this idea.

Inventor: Oh, so you are not going to make it?

Big Company: No, I didn't say that. We will be making it but we aren't going to pay you anything. You see, you signed a Disclosure Agreement that gives us the right to do anything we want with any information you give us. In other words, we aren't obligated to pay you anything. Furthermore, we are accountable to our shareholders. What would they say if we gave you're a 5% royalty for no other reason than to be nice? That is money the shareholders would not be seeing in dividends. You understand that this would upset them greatly. Additionally, our competition will be making this thing as well once they realize how successful the product is for us. If we were paying you a royalty and they weren't paying you the same royalty, they would have a huge advantage over us in the marketplace. We can't allow that. Sorry, but we are really grateful that you came in to see us. I guess I can give you the first unit we produce for free but that is about it.

Inventor: That's it! What if I get a lawyer?

Big Company: Feel free, who do think drew up our Disclosure Agreement: our lawyer, and he tells us it is air tight. Besides if you didn't have the money to get a patent, where are you going to get the money to sue us? Understand that if you had protected your invention, we would gladly pay you a royalty for an exclusive license. This would enable us to enforce your



patent against our competitors and with an exclusive and therefore no competition, we could charge more for the product in the marketplace than we would have to pay you in a royalty. It would have been a win-win for both of us. Hey, maybe next time.

OK, the hypothetical is a bit self serving, but it is a possibility nonetheless. The moral of the story is that if you can find a company that is willing to take a look at your invention prior to you having filed a patent application, please do not do so unless the company representatives are willing to sign a Non-Disclosure Agreement and by no means whatsoever should you sign a Disclosure Agreement unless of course your feeling particularly charitable.

18. I can't decide whether to go forward: do you have any last thoughts to help me make a decision on how to proceed?

Well, if you see an ad on the television or hear an ad on the radio from a company offering to help you with your invention, and more particularly, offer to present your invention to industry: your best bet is to RUN, RUN and RUN!

If you visit a patent attorney and he/she doesn't explain that you should seriously consider having a professional patent search done before paying thousands to have a patent application drafted, you probably should inquire why. If the answer doesn't make sense or if you get the feeling he/she is trying to separate you from your money, then look for another attorney.

Never let anyone pressure you into proceeding with a patent or any other form of intellectual property protection. Conversely, be aware of the dates and deadlines that could affect your intellectual property rights. If you are not comfortable moving forward, take day and think it over.



Realize that the inventing game is extremely risky. Generally speaking, don't spend money that you can't afford to lose. In a global sense, the chances of making money from an invention is perhaps a few in every hundred. Do you really believe you are one of the few? If you don't believe you are, why are you proceeding with your invention?

Commercializing an invention is both hard work and more expensive than you can imagine, and if you doubt your chances in the beginning, you probably don't have what it takes to make a success of your invention. And if you are certain that you are one of the few then perhaps you are but your chances are still a few in a hundred.

Twenty years or more from now when you are looking back on your life what would you regret more: (i) having tried to make a go of your invention and ending up having lost a fair amount of money despite giving it your all; or (ii) never having tried and wondering what would have happened if you had?

Ask our founding partner, Kurt Leyendecker for his answer. Fifteen years ago he left his career as an aerospace engineer to manufacture high end bicycle components incorporating a new technology that he had developed. Three years later he was broke and had to shutter the business. Sure the whole thing was rather traumatic for him at the time, but this many years later he is both financially and emotionally no worse for the wear. He tells us that, in fact, those three years helped shape who he is today. If he hadn't taken the chance back then he probably would have never gone to law school, and later opened a successful intellectual property law firm. And beyond that he says despite being constantly broke, the three years he spent starting and running his company were a blast.

So on that note, this Virtual Patent Consultation is concluded. Enjoy the process because sometimes it is the journey that offers the real reward no matter the ultimate outcome.



19. I have a patent and I think someone is infringing it: what should I do?

The first thing you should do is call us. Next, make an appointment with us to discuss your patent in relation to the accused product or service. Usually, for minimal expense, we can give you a good idea whether or not the accused product or service is actually infringing your patent. If it is a close call, a more in depth analysis may be required.

If the accused product or service that is, in our opinion, infringing your patent, we can give you advice on your options and how you might proceed from there. As you've probably heard, patent infringement litigation is extremely expensive, but we may be able suggest alternatives that can help resolve the situation more quickly for less money than would be required if litigation were pursued immediately. For instance, we can contact the infringer to open a dialogue and perhaps resolve the situation amicably. Perhaps, the infringing party would be interested in obtaining a license to make and sell your product. Perhaps, the infringing party is unaware that they are infringing your patent and, if they are honorable, they may cease the infringing activity once they are put on notice thereof.

If it becomes clear that the litigation option will be required, we can usually recommend one or two good patent litigators with whom we are familiar.

20. I manufacture a device and I am worried I am infringing someone else's patent: what should I do?

My first question is rather simple: do you know if someone has a patent that you may be infringing or are you worried that there may be a patent that you may be infringing but you're not aware of any particular one? Your answer to that question is critical. If you've actually been made aware of a particular patent that your device or service may infringe, you have an affirmative duty to investigate. Failure to investigate could subject you to treble damages if you are sued and lose a patent infringement case. On the other hand, if you really don't know of any patent you may be infringing and you are just generally worried that one might exist, then you are probably better off letting sleeping dogs lie.



I will briefly address the first situation. However, understand that this type of situation is very serious and you should immediately seek counsel from a qualified patent attorney. The first inquiry is to determine whether or not your product or service actually infringes the patent. Usually, we perform a cursory infringement analysis to make that determination. Often, this brief review of your product or service and the subject patent will be enough so that we may confidently advise you that you are not infringing the patent. A typical cursory infringement opinion requires several hours of our time and costs between \$750 and \$1500 depending primarily on the length of the subject patent and the number of claims contained in the patent.

If we cannot make a clear and convincing determination that your product or service is not infringing the subject patent, we will often suggest a comprehensive patent infringement analysis and opinion be undertaken. To prepare such a complex document, we will review not only the subject patent but its entire prosecution history in front of the patent office. The end result of the inquiry is typically a legal document concluding that a competent court would find that you are not infringing the subject patent. If in good faith we believe that your product or service is infringing the subject patent, we will not commit that opinion to paper, but rather we will call you into the office to discuss your options going forward.

Let us reiterate a point made above: if you know of a patent that your product or service may be infringing, the worst thing you can do is ignore it and hope the owner of that patent never finds you and never sues you. Because if you take this action, the chances that a court will find you to be willfully infringing a patent and therefore subject you to treble damages is significantly and substantially enhanced. Furthermore, if you are willfully infringing, a patent holder is much more likely to sue because of this prospect of being awarded enhanced damages.



Leyendecker & Lemire, LLC
An Intellectual Property and Business Law Firm

21. Do you offer any other patent or intellectual property legal services other than those discussed above?

The short answer is: of course, we do! We are a full service transactional intellectual property and business law firm. If your problem or your need is related to patents, trademarks, copyrights, trade secrets, business formations, contracts, computer cyber and Internet law, and/or entertainment law and you did not find an answer anywhere on this site, please give us a call. In the unlikely event that we cannot help, we will probably be able to refer you to someone who can.

And if you're apprehensive about calling us because we are attorneys and because you don't want to bother us, call anyway! We want you to.

22. I didn't find an answer to my question or concern on this page, what should I do?

Call us! Patent law in particular and intellectual property law in general are very complex and despite the immense size of this virtual consultation, we have not even begun to scratch the surface.