

Section 2

“Obtaining a Patent: The Four Basic Steps”

Chapter 9

Step Two: Hire a Registered Patent Attorney

The preliminary patentability results look good.

Great!

Now it is time to HIRE an attorney to vet the completed application. If, at this point, an attorney has not yet been consulted, I repeat, NOW is the time!

Is that really true? In a word: YES.

With a registered patent attorney, the inventor is dealing with an agent that has been registered with the USPTO. This means that this individual has passed a SPECIALIZED patent bar as well as (at least one) state bar. He or she should be an expert in not only patent law, but the laws of the states they practice in.

Keep in mind, attorneys who may understand business law, transactional law, contract law, etc., are good to have on your team of advisers, but are NOT patent agents, are never advisable substitutions.

For instance, a patent attorney has the specialized ability to look at the law from a point of view that understands the trajectory of the USPTO and the federal laws that govern patent infringement. This ability includes unique knowledge regarding trends in order to be proactive when consulting on claim language, drawings, and written specifications.

Should an inventor hire an attorney who is not registered with the USPTO, or if he or she attempts to complete and submit the application without representation, they are taking a HUGE risk with their invention and the power of their claims, and ultimately the potential rights and revenue/profit the exclusivity could bring.

It happens quite often in my practice. Usually, it is the inventor who has decided that in order to save money they draft their own application. I understand that in someone else's opinion; from one who is NOT a patent attorney, writing and submitting one's own application may seem acceptable.

The non-represented inventors may lay out their cases to the best of their abilities. They might very well produce the invention claims, a strong description and/or make beautiful drawings all without consulting an attorney. To be sure, the claims, descriptions and/or drawings that inventors put together as the initial draft of a patent application are crucial. The sad part is that these do-it-yourself

inventors may actually get one or more claims through the patent office all the way to grant. The catch is that the claims that are granted are usually not worth the paper they are printed on because they do not adequately cover the invention, or are so narrow that future innovators can easily design around them to compete in the marketplace – thus losing any competitive advantage.

To further emphasize the importance of such a review, I'll bring up the concept of **enablement**, or, according to the Manual of Patent Examining Procedure (MPEP), “any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.”⁵

It hurts (usually) when I have to tell an inventor that they have not enabled all the areas in which they wish to claim. In developing perhaps only one aspect of their invention and not elaborating or thoroughly defining the invention in its entirety, one will almost certainly drastically limit their outlook and the potential claims that may exist for them.

⁵ Chapter 2100. Section 2164: 2164.01 Test of Enablement [R-08.2012]
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It can be a tough conversation. Usually, I approach the client with a solution that focuses on expanding the breadth and nature of the claims.

I explain that there IS a risk that someone else in their field beat them to the patent office in the time since filing their own.

However, I also explain to them that it is certainly worthwhile to review and edit those areas that they did not describe thoroughly. Some inventions that are indeed different but happen to be similar in nature or subject matter may appear to be the same. It is therefore imperative that the application—especially the claims—illustrate the distinctive properties and functions of an invention as clearly as possible.

This means that there will be a second round of examinations and that we (the client and I) need to prepare. The inventor's job is to update the application to reflect the changes and feedback from the USPTO. The attorney's job is to analyze and give the inventor an expert opinion on that feedback, for the most part, in terms of what rights to focus on obtaining.

So not to worry! This back and forth is pretty standard. But there is one thing...

For clarity's sake, I then broach the obvious: this also means more time. Maybe a lot more. And more professional work hours⁶.

It is, however, part of the purpose of this book to inform prospective applicants BEFORE they make any formal commitments or submissions. In this way, I aim to get people familiar with the process in the hopes of saving future applicants from (at least any further) frustration and/or discouragement.

In any event, when embarking on the patent process, I highly recommend that every creator work with a registered patent attorney. As I mentioned, the patent laws change frequently. We saw some of the reasons for this when we discussed the state of software patents in Chapter 7. As I said, this change in software that I described happened within the past eighteen months, since the summer of 2014 and the decision of Alice⁷. All subsequent decisions happened within months, if not weeks, prior to the transcription of this book. Though I have said it before, I'll say it again very clearly: Do not file an application through the USPTO alone. This invention could be extremely valuable. It could change the world. Do it right: make sure it is properly protected.

⁶ See Chapter 10 for details

⁷ Alice Corp. v. CLS Bank