

PATENT IT YOURSELF

Few people know that the US Patent and Trademark Office allows and supports inventors to write, submit and correspond with them without using a patent lawyer or patent agent. This can greatly reduce the cost of applying for a patent.

If you don't feel comfortable doing the whole process yourself, you can also do most of the research and writing yourself and hire an expert only to advise you. Since much of the cost of acquiring a US patent is spent on a search, writing the description, making illustrations, and responding to the US Patent and Trademark Office (USPTO), this hybrid can reduce cost and still provide an expert to back you up.

This paper summarizes the issues and opportunities of doing patent work yourself. It's designed as a quick read and references additional material (especially an excellent book called *Patent it Yourself*) should you wish to learn more. This paper should not be viewed as giving legal advice on any specific item—only a lawyer can do this.

Who May Apply a US Patent

Anyone who is the true inventor of something can apply for a patent, regardless of age, nationality, mental competency, or incarceration. Even dead people can apply through a personal representative. The application for a patent and subsequent correspondence with the USPTO can be made by:

- **A patent attorney.** A patent attorney is someone who is both a qualified lawyer and has passed the examination given by the USPTO. Patent attorneys can represent an inventor in front of the patent office and they can also represent you in court, should you need to defend a patent or should you want to try to invalidate someone else's patent.
- **A patent agent.** A patent agent is someone who has passed the examination given by the USPTO. Patent agents can represent inventors in to the patent office, but not in court.
- **The inventor.** When an inventor applies for a patent himself, this process is called a *pro se* application.
- **A combination of the above.** Most patent attorneys use paralegals, patent agents, and outside illustrators to do most of the work, and then proof everything before sending it. You could do the up front work and have a patent attorney or patent agent submit it. In this case, you still need to have

enough money in your budget to let the expert "fix things", because they could be liable for errors and omissions. Alternatively, you could do most of the work yourself, have a patent attorney or agent review it, but submit and correspond with the USPTO yourself. In this case, costs are lower, but you're responsible for the quality of your work.

How Much Does it Cost

The filing fee for a utility patent with the US PTO is typically between \$500 and \$1000 (depending upon the number of claims, etc) if you qualify as a small entity (less than 500 employees) and \$1000 and \$2000 if you don't qualify. When a utility patent is issued, there is an issuing fee of \$385 for small entities and \$770 for all others. There are also maintenance fees due at 3.5 years, 7.5 years, and 11.5 years after issuance. These fees change annually, so it's best to look them up at <http://www.uspto.gov>.

Generally, the above fees are only a small proportion of the total cost of getting a patent. Most of the cost is in the labor of researching and writing the patent application and corresponding with the patent examiner. If you use outside help, you can expect to pay \$200-300+/hour for a good patent lawyer, \$100-200 per hour for a good patent agent, and various fees for support staff. If you do this yourself, the cost depends on how you value your time. You must also leave room in your budget for the time required to follow up on comments from the patent examiner.

Thus, a simple patent that you file yourself as a small entity might cost less than \$1000 for the application. \$5000 is more realistic if you use a patent attorney to help in critical areas (like the claims). You can get more of an idea of how many hours are involved by understanding the key steps of the process.

What are the Main Steps to Apply for a Patent

The following are the main steps involved in the US patent application process.

1. Search for prior art

This is to find out if there is anything similar enough to your proposed invention that has either been presented in a patent or has been publicly disclosed in some other way. One can do this search for patents over the internet using the <http://www.uspto.gov> website. Keep in mind that prior art also can include foreign patents, products using the same idea as your invention that were not patented, and any public disclosure of the same combination of elements you wish to patent.

2. Writing a Description and Making Drawings

In this step, you try to explain what your invention does and how to create a device that uses your invention.

3. Writing the Claims

Claims (definitions of exactly what you wish to get patent protection on) must be written in a specific way. This is the most critical and most difficult element of a patent application. If you don't have experience, you should either study a lot of examples and books on the subject or get an expert to help you. This is the best area in which to seek and pay for outside help.

4. Submitting the Application

There are specific forms that must be completed correctly. A book such as *Patent it Yourself* does a good job of explaining how to do this for a US Patent. It's not difficult if you can follow directions.

5. Waiting

It typically takes 2-4 years for a patent application to be processed. It can take more than two years before you receive your first correspondence from the patent office.

6. Responding

Once you do get correspondence from the patent office, you then have 30 days in some cases and 90 days in others to respond. You should expect that it will take time and effort to respond effectively. This is another area where it may be useful to consult and pay for an expert. Keep in mind that if you do not respond in time, your application will be thrown out.

7. Paying a fee when the patent is granted

If you have successfully made it through the above steps, you will need to pay the issuing fee (described above) to actually be awarded the patent.

The time and costs involved in these steps vary greatly depending upon what you've invented, how many things similar to this have been invented, and how important it is to have a really solid patent.

Preliminary Patent Applications

If you are not ready to spend the time and effort to file a full patent application, it is possible to file a Preliminary Patent Application (PPA). A PPA for a small entity costs \$80 (as of April 2004) and does not need to include claims. A PPA is basically a way in which a document can be deposited with the USPTO for a year. It allows you to claim "patent pending", but does not start the clock on processing your patent application.

It is feasible to write the PPA yourself. However, it is beneficial to consult a good reference book and to think through what the full patent application will look like. You should make sure that the PPA does a thorough job of describing your invention. Whatever is not written in the PPA will not give you protection as the "first to invent."

Getting a Patent Internationally

The process of patenting a product beyond the US is substantially more costly and time consuming. Each country has its own rules and will do its own reviews. The fees for a US patent are lower than those of many other countries. Every country in Europe requires its own application. In addition, the applications must be in that country's national language. As a result, even large multinationals only get patents in major markets.

However, it is possible to keep your options open for a reasonable fee by filing a PCT (Patent Cooperation Treaty) application within 12 months of filing your US Patent application. This typically costs \$1500 - \$3000 and buys you a couple of years before you need to decide which countries to file in and start paying the fees for this.

Conclusion

This paper is an overview. Here are two in-depth references that I use and two papers I wrote recently to let you further explore this and related topics:

- Lo, Jack and David Pressman. *How to Make Patent Drawings Yourself*. Nolo Press. 3rd edition. © 1997-2001. <http://www.nolo.com>.
- Pressman, David. *Patent It Yourself*. Nolo Press. 9th edition. © 1985-2002. <http://www.nolo.com>.
- Vermeulen, Bert. *Patent Strategy*. (c)2003-2004. See: <http://www.corp21.com/PatentStrategy.pdf>.
- Vermeulen, Bert. *Software Patents*. ©2004. See: <http://www.corp21.com/SW-Patents.pdf>.

It is also quite useful to look at the US Patent and Trademark Office website at <http://www.uspto.gov>.

Please contact me if you would like more info. I recommend that you contact an experienced patent attorney or patent agent if you need specific advice.

About the Author

Bert Vermeulen owns Corp21, a company that supports, incubates and advises businesses, entrepreneurs, and inventors around the world. For more information, see <http://www.corp21.com>.