

# Ten Costly Misconceptions about Filing a Patent Application

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**How to  
Avoid Ten  
Patent Filing  
Ripoffs**

# INVENTOR'S GUIDE TO FILING A PATENT APPLICATION

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## BASIC INFORMATION REGARDING PATENTS

### What Is a Patent?

A patent is a government-granted right (granted by the United States Patent and Trademark Office (“USPTO”)) that provides you with the right to exclude someone else from making, using, selling, offering for sale, or importing the invention covered by a valid claim of your patent. A patent is not an affirmative right to do these things with your invention. This is an important distinction.

The exact nature of the right conferred must be carefully distinguished, and the key is in the words “right to exclude” mentioned above. The patent does not grant the right to make, use, offer for sale, sell or import the invention but only grants the exclusive nature of the right. Any person is ordinarily free to make, use, offer for sale, sell or import anything that person pleases, and a grant from the government is not necessary. The patent grants only the right to exclude others from making, using, offering for sale or selling or importing the invention. Since the patent does not grant the right to make, use, offer for sale, sell, or import the invention, the patent owner’s own right to do so is dependent upon the rights of others and whatever general laws might be applicable. A patent owner, merely because he or she has received a patent for an invention, is not thereby authorized to make, use, offer for sale, sell, or import the invention if doing so would violate any law. An inventor of a new automobile who has obtained a patent thereon would not be entitled to use the patented automobile in violation of the laws of a state requiring a license, nor may a patent owner sell an article, the sale of which may be forbidden by a law, merely because a patent has been obtained.

Neither may a patent owner make, use, offer for sale, sell, or import his or her own invention if doing so would infringe the prior rights of others. A patent owner may not violate the federal antitrust laws (such as by resale price agreements or entering into combinations in restraint of trade) or the pure food and drug laws merely by virtue of

having a patent. Ordinarily there is nothing that prohibits a patent owner from making, using, offering for sale, selling, or importing his or her own invention, unless he or she thereby infringes another’s patent which is still in force. For example, a patent for an improvement of an original device already patented would be subject to the patent on the original device.

### What Can Be Patented?

In the language of the patent statute, any person who “invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent,” subject to the conditions and requirements of the law. The word “process” is defined by law as a process, act or method, and primarily includes industrial or technical processes. The term “manufacture” refers to articles that are made, and includes all manufactured articles. The term “composition of matter” relates to chemical compositions and may include mixtures of ingredients as well as new chemical compounds. These classes of subject matter taken together include practically everything that is made by man and the processes for making the products.

The Atomic Energy Act of 1954 excludes the patenting of inventions useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon 42 U.S.C. 2181 (a).

The patent law specifies that the subject matter must be “useful.” The term “useful” in this connection refers to the requirement that the subject matter has a useful purpose. The term “useful” also includes operativeness, which means that machine that will not operate to perform the intended purpose would not be useful, and therefore would not be granted a patent.

Interpretations of the statute by the courts have defined the limits of the field of subject matter that can be patented. Thus, it has been held that the laws of nature, physical

phenomena, and abstract ideas are not patentable subject matter.

A patent cannot be obtained upon a mere idea or suggestion. The patent is granted upon the new machine, manufacture, composition or improvement, as has been said, and not upon the idea or suggestion of the new machine. A complete description of the actual machine or other subject matter for which a patent is sought is required.

## Are There Different Types of Patents?

Yes. The three most common types of patents are utility patents, design patents, and plant patents.

## What Is a Utility Patent?

A utility patent protects the structure, operation, or composition of a machine or process or improvements to a machine or process. The duration of a utility patent is twenty years from the priority date, which is usually the filing date. The owner of a new utility patent must pay periodic fees to maintain the patent in force.

## What Is a Design Patent?

Generally, a design patent protects nonfunctional, ornamental features of a new article of manufacture. The duration of a design patent is fourteen years. There are no periodic fees required to maintain the patent in force. The patent laws provide for the granting of design patents to any person who has invented any new and nonobvious ornamental design for an article of manufacture. The design patent protects only the appearance of an article, but not its structural or functional features. The proceedings relating to granting of design patents are the same as those relating to other patents with a few differences. A design patent has a term of 14 years from grant, and no fees are necessary to maintain a design patent in force. If on examination it is determined that an applicant is entitled to a design patent under the law, a notice of allowance will be sent to the applicant or applicant's attorney or agent, calling for the payment of an issue fee. The drawing of the design patent conforms to the same rules as other drawings, but no reference characters are allowed and the drawing should clearly depict the appearance, since the drawing defines the scope of patent protection. The specification of a design application is short and ordinarily follows a set form. Only one claim is permitted, following a set form that refers to the drawing(s).

## What Is a Plant Patent?

Generally, a plant patent is awarded to someone who has invented or discovered, and asexually reproduced, any distinct and new variety of plant. The term of a plant patent shall be 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed applica-

tion under 35 U.S.C. 120, 121 or 365(c), from the date the earliest such application was filed.

The specification should include a complete detailed description of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, expressed in botanical terms in the general form followed in standard botanical text books or publications dealing with the varieties of the kind of plant involved (evergreen tree, dahlia plant, rose plant, apple tree, etc.), rather than a mere broad non-botanical characterization such as commonly found in nursery or seed catalogs. The specification should also include the origin or parentage of the plant variety sought to be patented and must particularly point out where and in what manner the variety of plant has been asexually reproduced. The Latin name of the genus and species of the plant should be stated. Where color is a distinctive feature of the plant, the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary. Where the plant variety originated as a newly found seedling, the specification must fully describe the conditions (cultivation, environment, etc.) under which the seedling was found growing to establish that it was not found in an uncultivated state.

A plant patent is granted on the entire plant. It therefore follows that only one claim is necessary and only one is permitted.

The oath or declaration required of the applicant in addition to the statements required for other applications must include the statement that the applicant has asexually reproduced the new plant variety. If the plant is a newly found plant, the oath or declaration must also state that the plant was found in a cultivated area.

Plant patent drawings are not mechanical drawings and should be artistically and competently executed. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation. When color is a distinguishing characteristic of the new variety, the drawing must be in color. Two duplicate copies of color drawings must be submitted. All color drawings should include a one-inch margin at the top for Office markings when the patent is printed.

## How Do You Obtain a Patent?

A patent is obtained by filing and successfully prosecuting a patent application so at least one allowed claim is present. A patent application is written according to the type of invention and scope of protection desired. The application is provided to the United States Patent and Trademark Office (electronically, by United States postal service, or by hand delivery) along with the appropriate fees. The Patent Office confirms that basic filing requirements are met and assigns an Application Number and routes the application to an Art Unit. The application initially is held in a queue by a Supervisor of the Art Unit in submission date order until it is time for the application to be examined. The Supervisor assigns the application to a specific Examiner for process-

ing. In the United States, patent applications are examined by Examiners (this is in contrast to some countries where patent applications are registered) who review the entire application and evaluate whether the application and its contents satisfy the requirements of all the patent laws and regulations. The Examiner issues an Office Action to you through your representative that details the results of this evaluation. The details may include formal and/or substantive objections and/or rejections, as well as indications of allowable or allowed claims. The details typically include citations of prior art and statements regarding a comparison of elements of the patent application to characterizations of both the patent application elements and of the prior art. A deadline is set by which you must respond to all the objections and rejections the Office Action. A failure to respond within the allotted time results in abandonment. The response is tailored to the rejection and typically includes corrections, arguments asserting an error in a characterization or analysis in the Office Action, and/or amendments to the application. The Examiner considers the response and may conduct further searching or consideration and issue another Office Action. Unless all the claims are allowed and no objections remain, the Office Action will typically be a Final Office action. A filing fee entitles the applicant to two searches/considerations of the application by an Examiner and the Final Office Action signifies that the quota has been reached. Further action on the application may be pursued by further limited argument, refiling the application and paying another fee for further review by the Examiner, or filing an Appeal (with the Patent Office or suing the Commissioner for Patents in Federal District Court). These processes, when successful, result in returning the application to the Examiner, sometimes with specific directions for disposition of one or more issues. The process of Examiner review, response, and extra-Examiner review is called prosecution. Prosecution ends with issuance of a patent or abandonment of the application. You may stop the process at any point and incur no further fees. Patent prosecution has a variable duration resulting from different application pendencies for the Art Units (time for first communication from the Examiner), quality and timeliness of responses, and aggressiveness or reasonableness of you, your representative, and the Examiner. Some applications may receive special expedited treatment due to the subject matter of the invention or because of the age of an inventor. Such special treatment must be specifically requested.

## What Is a Patent Application?

A patent application is a prose narrative written specifically for the invention sought to be protected. The contents and requirements of the narrative are specific to the type of patent desired to be obtained and to the particular invention. A patent application for a design application is a short document made up of a series of different views of the invention and a description of the contents of the different views. A patent application for a plant patent consists of the same parts as other applications.

A non-provisional application for a patent is made to the Director of the United States Patent and Trademark Office and includes: (1) A written document which comprises a specification (description and claims), and an oath or declaration; (2) A drawing in particular cases in which a drawing is necessary; and (3) Filing, search, and examination fees. The applicant must determine that small entity status is appropriate before making an assertion of entitlement to small entity status and paying a small entity fee (in most cases these fees are one half of the standard fees). Fees typically change each October with the current fee schedule available from the USPTO Web site ([www.uspto.gov](http://www.uspto.gov)).

All application papers must be in the English language or a translation into the English language will be required along with the required fee set forth in 37 Code of Federal Regulations 1.17(i). All application papers must be legibly written on only one side of a sheet of flexible, strong, smooth, non-shiny, durable and white paper, either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation. The papers must be presented in a form having sufficient clarity and contrast between the paper and the writing to permit electronic reproduction. Additional details of the requirements are available from the USPTO website.

The specification must conclude with a claim or claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention. The portion of the application in which the applicant sets forth the claim or claims is an important part of the application, as it is the claims that define the scope of the protection afforded by the patent. The claims must commence on a separate physical sheet of paper.

More than one claim may be presented provided all claims differ from each other. Claims may be presented in independent form, which means the claim stands by itself, or in dependent form, which means referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers back to more than one other claim is considered a "multiple dependent claim."

The specification must include a written description of the invention and of the manner and process of making and using it. The specification is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the technological area to which the invention pertains, or with which it is most nearly connected, to make and use it. The specification must set forth the precise invention for which a patent is sought, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter, or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor for carrying out the invention must be set forth.

In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which

the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

A patent application is not forwarded for examination until all required parts, complying with the related rules, are received by the Patent Office. If an incomplete or defective application is filed without all the required parts for obtaining a filing date, the applicant will be notified of the deficiencies and given a time period to complete the application filing, at which time a filing date as of the date of such a completed submission will be obtained by the applicant. If the omission is not corrected within a specified time period, the application will be returned or otherwise disposed of; the filing fee if submitted will be refunded less a handling fee as set forth in the fee schedule.

The filing fee and declaration or oath need not be submitted with the parts requiring a filing date. It is, however, desirable that all parts of the complete application be deposited in the Office together; otherwise each part must be signed and a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. If an application which has been assigned a filing date does not include the filing fee or the oath/declaration, the applicant will be notified and given a time period to pay the filing fee, file an oath/declaration and pay a surcharge.

All applications received in the USPTO are numbered in sequential order and the applicant will be informed of the application number and filing date by a filing receipt.

The filing date of an application for a patent is the date on which a specification (including at least one claim) and any drawings necessary to understand the subject matter sought to be patented are received in the USPTO or the date on which the last part completing the application is received in the case of a previously incomplete or defective application.

## Patentability Standards

In order for an invention to be patentable it must be new as defined in the patent law, which provides that an invention cannot be patented if: "(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," or "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the application for patent in the United States . . ."

If the invention has been described in a printed publication anywhere in the world, or if it was known or used by others in this country before the date that the applicant made his/her invention, a patent cannot be obtained. If the invention has been described in a printed publication anywhere, or has been in public use or on sale in this country more than one year before the date on which an application for patent is filed in this country, a patent cannot be obtained. In this connection it is immaterial when the invention

was made, or whether the printed publication or public use was by the inventor or by someone else. If the inventor describes the invention in a printed publication or uses the invention publicly, or places it on sale, he/she must apply for a patent before one year has gone by. Otherwise, any right to a United States patent will be lost. The inventor must file on the date of public use or disclosure, however, in order to preserve patent rights in many non-U.S. countries.

Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be nonobvious to a person having ordinary skill in the area of technology related to the invention. For example, the substitution of one color for another, or changes in size, are ordinarily not patentable.

These standards are referred to as novelty and obviousness standards. In addition, the patent application must meet some formal requirements as well, including enablement, written description, and best mode as described earlier.

## What Is a Provisional Patent Application?

A provisional application is a special type of application that preserves the filing priority date. A provisional application expires within one year and is never examined, but is able to serve as priority for regular utility applications or international applications. Inventors sometimes prefer a provisional application because the filing fee is much less than for a regular application. Because a provisional application is never examined, a patent is never issued from a provisional application. A provisional application is simply a temporal placeholder for a regular patent application of the same content, provided the regular application is timely filed. Most of the requirements for the contents of these two types of applications are the same. One exception is that claims are not required to be submitted with a provisional application.

## How Do Trademarks Differ from Patents?

In addition to issuing patents, the United States Patent and Trademark Office also issues trademarks and service marks. A mark, a trademark or a service mark is anything used to identify the source, origin, or quality of a good or service. A trademark or service mark may be used only by the trademark or service mark owner or authorized licensee to mark goods and services. A trademark or service mark does not prevent others from making or selling the same goods or services under different trademarks or service marks.

## How Do Copyrights Differ from Patents?

Copyright is a form of protection provided to the authors of "original works of authorship" including literary, dramatic, musical, artistic, and certain other intellectual works, both published and unpublished. The 1976 Copyright Act generally gives the owner of a copyright the exclusive right to reproduce the copyrighted work, to prepare derivative works, to distribute copies or phonorecords of the copyrighted work, to perform the copyrighted work publicly, or to display the copyrighted work publicly.

A copyright protects the form of expression rather than the subject matter of the writing. For example, a description of a machine could be copyrighted, but this would prevent others only from copying the description; it would not prevent others from writing a description of their own or from making and using the machine. Copyrights are registered by the Copyright Office of the Library of Congress as opposed to the United States Patent and Trademark Office.

## Ten Costly Misconceptions About Filing a Patent Application

1. **A PATENT SEARCH IS ALWAYS NECESSARY:** Not true. A patent search is research into potential relevant prior art to estimate patentability. A patent search is useful to guide 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. Before 2000, 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. 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 with which the inventor is up to date on the current state of the art. For mature technologies (such as golf, bicycling, cooking apparatus, and simple mechanical inventions), patent searches are usually recommended.
2. **IF A PATENT SEARCH IS NECESSARY, ON-LINE SEARCHING IS ADEQUATE:** Not true. On-line 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 on-line 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 on-line 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. It is often easier to search images with respect to some inventions in appropriate cases than to search words. A manual search sometimes allows the searcher to find correspondence between a patent and the searched invention more efficiently than an on-line search.
3. **A PROVISIONAL PATENT APPLICATION ALWAYS SAVES MONEY:** Not true. A properly written provisional application will not usually cost less because U.S. patent law requires that a provisional application include exactly the same information as a regular patent application absent the claims. A patent application is required to enable a person of ordinary skill in the art to make and use the invention; it is also required to 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 that is the subject of the application will meet the requirements of patentability without proper care. Thus a properly written provisional application often includes claim drafting as part of the provisional drafting process.
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 itself have economic merit in order to generate money from the patent process. It is most often the case that 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. 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. A patent owner must self-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 of

the existence of the patent. 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. **IT IS EASY TO DETERMINE THE PROPER AMOUNT OF DETAIL TO BE INCLUDED IN A PATENT APPLICATION:** Not true. When providing too much detail, the extra details might include theory of operation, detailed discussions of related technologies, or redundant figures. A patent application is not a production document and need not include many details that would be useful in other contexts. Patent applications and patents issued from them are presumed to be read by a person of 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. Since this amount of detail is unnecessary and can cause problems, it is best to exclude too much detail. On the other hand, inventors sometimes desire to try 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 may lack sufficient detail for patentability requirements and can be rejected on that basis 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, and in some cases even longer, 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.
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, 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, these attorneys and agents are not necessarily 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. For an economically valuable invention, the inventor should have chains and sequences of patents to protect the idea because any one patent can be held invalid at any time. Usually one does not know in advance 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.

## How to Avoid Ten Patent Filing Ripoffs

1. Don't be persuaded by exceptionally high or exceptionally low price offers for filing a patent application. A high price offer for filing a patent application usually promises extra benefits that are not typically realistic or practical, such as finding investors, locating manufacturers, and bringing in licensees. Since these benefits are not usually realized, the high price for the patent application may be unjustified. A low price offer for filing a patent application usually means that insufficient time will be spent on the application and the application may be too narrow or include insufficient detail to be of economic value.
2. Employ a registered patent attorney or patent agent to assist you with filing your patent application. Using a helper who is not registered is usually a ripoff because you will not then 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. The patent laws and regulations change frequently, as do current best practices. Thus you should 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.
4. Be wary of needless searches which lead to additional expense and delayed filing.
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 then worthless and 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 when assisting in filing your patent application. The patent process has 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 without even obtaining a patent at the end of the process.
7. 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 required to protect the rights that the patent has afforded.
8. 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 try to test the market for an invention. Doing so is not without risk, but an inventor 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 an inventor from obtaining any international protection. The USPTO operates a disclosure program to assist with establishing a date of invention.
9. In some cases it is undesirable to employ a patent agent instead of a registered patent attorney 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. 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.) Patent agents by law cannot discuss certain legal matters not related to patent prosecution, such as infringement and validity, and thus 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. Patent agents may also emphasize extensive background education that is often not current or directly applicable to the inventor's idea. For the best protection and most flexibility, use a patent attorney and confirm their registration by visiting the USPTO website.
10. It may be a ripoff to employ a large law firm to assist you in filing your patent application. Such 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 Clients Who Choose The Patent Law Offices Of Michael E. Woods to Assist Them in Filing Their Patent Applications

1. All inventor meetings take place between Michael and the inventor, and all applications are written by Michael. Michael is a very experienced and highly qualified registered patent attorney. Michael has been a registered patent attorney since 1989. He has been a partner at the prestigious national law firms of Townsend and Townsend and Crew 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.
2. The applications Michael writes for clients are timely filed with no unnecessary delay.
3. Michael's patent applications are written with an eye toward exploitation of the invention, based on Michael's significant experience in the areas of enforcement, litigation, and licensing.
4. Representation by Michael may continue after the filing of the application, and encompasses prosecution of the application, related applications and any issues that may arise if a patent issues, such as enforcement, possible litigation, and licensing.
5. Michael uses electronic filing for filing patent applications. Michael uses electronic filing rather than filing by mail, which saves money and ensures confirmation from the USPTO at the time of filing.
6. 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.

## Guarantee

Michael will meet with you for one hour to discuss applying for a patent for your invention. If you are not fully satisfied with the quality of the advice you receive and the plan devised for handling your invention, there will be no charge for this meeting and Michael will provide referrals to three alternate highly qualified patent attorneys that you may contact.

## 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.