



# reining in PATENT COSTS

Be clear and complete. The less legwork you leave for your attorney, the lower the fee to your company. *By Kirk Teska*

If you hold a patent for something that everybody wants, you can make a fortune. And when you're rich and your patent expires, society in general can benefit from what you invented.

Of course, life doesn't often work like that. The inventions covered by some patents have no takers. They can be overshadowed by something that is perceived to be better or is more widely advertised. So there's a risk involved in applying for a patent, because, as savvy readers know, patents are expensive.

According to a 2007 survey, the average cost for a utility patent application in the United States is around \$12,000. By the time the patent is granted, the total cost could easily exceed \$20,000.

There is really no such thing as a poor man's patent. In the United States, there is a provisional patent applica-

tion, which may cost a fraction of a regular utility patent application, but that's a false economy.

Indeed, it's an extra expense: whatever the provisional application costs, it's an added cost, since a provisional does no good unless a utility patent application is prepared and filed within a year of the provisional.

But there are ways to lower the cost a patent attorney charges for drafting an application by reducing billable hours. In my experience, the more information that I do not have to chase down and the more concretely the invention is described, the less time that I will need to draft a given patent application.

As for basic patent application drafting information, provide any information that the attorney will need in order to set the deadline for filing the application. Has the invention been described in a published paper or embodied in a product sold or offered for sale? Are any of these events planned in the near future? If so, tell the attorney.

List the names, residential addresses, and citizenship of all the likely inventors. List and provide a copy of all relevant prior papers and patents you know about that are related to the invention. Many companies use "invention disclosure" forms for these purposes.

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Also, manage your patent program. You can bet a patent attorney will charge a lot more for a patent application that must be filed in one week versus a patent application that does not have to be filed until next month.

How about if the inventors write a rough draft patent application to be later polished by the patent attorney? It rarely helps me to start with such a rough draft of a patent application written by an engineer.

Patent attorneys think in terms of problem/solution statements. If you invented the basic paper clip, I might describe its advantages like this: the problem with staples, which punch holes in the attached pages and which are difficult to quickly remove, is solved by a bent wire which keeps the pages together via a spring force action. Engineers, in contrast, typically begin by describing dimensions, tensile strengths, materials, and the like.

The more concretely the true invention is described, the better, since inventions rarely have anything to do with dimensions, tensile strength, materials, resistance and capacitance values, or other details.

Do include with the invention disclosure form drawings of the invention from a highly conceptual level (in a product or system, where does the invention lie?) and then down to the nitty gritty details. Study the patents of others to learn what goes into them and how they are formatted.

Armed with the basic information and a concrete description of the invention, the patent attorney is ready to meet with one or more of the actual inventors. To ensure that you receive a quality first draft of the patent application, make sure that the patent attorney completely understands the true invention and its value proposition, that you understand what the patent application will cover, and that your understandings are the same as the patent attorney's.

Any disconnect between you and the patent attorney will only lead to rewrites which increase the cost. One worst case scenario is when you think the invention is X and the patent attorney procures you a patent covering invention Y. The probability of a disconnect is increased when the face to face meeting is forgone.

After the first draft of the application is received, have everyone review one copy. If the attorney has to incorporate changes from three different inventors and one project manager via four separate versions of the application lying on her desk, that will take extra time and result in a higher cost. The goal is to edit a first draft, incorporate the inventor's comments, and file the edited application with the Patent Office. As you become more and more patent savvy, you will enable the patent attorney to work faster and eliminate multiple drafts of an application.

So, why not just do most of the work for the attor-

ney and write a rough draft of the application yourself? Because patent attorneys write patent claims first. The rest of the patent application is based on the claims for a variety of legal reasons. So, drafting a patent application without writing the claims first just doesn't make sense and results in the attorney having to rewrite your initial write-up anyway.

That being said, you can draft short descriptions of why the invention is advantageous and what you know about prior versions of the same thing as well as the problems associated with them. If the patent attorney then asks you to describe in writing a specific alloy, drive train, circuit, or the characteristics of a device, do comply so that the attorney can cut and paste your write-up into his.

Finally, if the patent attorney is willing, ask for a discount for multiple applications and/or fixed cost applications. The overall cost may not be that much lower, but at least you will know the cost ahead of time and can budget your patenting efforts accordingly. ■

## Patent application checklist

- List all known "prior art" (anything that predates the invention).
- Discuss the shortcomings associated with the prior art.
- Discuss how the invention is different from the prior art.
- Tell exactly what it is that makes the invention different.
- List the advantages of the invention. Think about how the marketing department will tout a product including the invention.
- Take the time to write a short value proposition. Sleep on it and edit it. Have all the inventors agree on the wording.
- Describe any sales or prior uses of the invention and any papers or other publications describing the invention.
- List all the likely inventors. Include their names, residential addresses, and citizenship.
- CAD or detailed engineering drawings are not required. Sketches are usually OK.
- Are there any pending patent applications or issued patents related to the invention? If so, list them.