Adventures in the Microverse: A Solo Practitioner's Learning Experiences in a Post-AIA World

By Justin D. Cotton

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As if out of an episode of *Futurama* or an H.G. Wells novel, it almost seems otherworldly that people and enterprises of more modest means can finally participate in the patent sector. After years of being priced out of the process by the high cost of patent filing, prosecution, and legal representation, micro entities—these "garage, workbench, and coffee shop" inventors—can finally afford to pursue patent protection for their works of individual and small business genius. Thanks to the 2011 Leahy-Smith America Invents Act (AIA), [1] the patent process suddenly became accessible to an entirely new class of inventor, and by extension, a new class of patent attorney.

I offer my learning experiences as a new patent law solo practitioner as I first aimed to provide affordable yet solid patent prosecution services to fellow entrepreneurs and startups—all while navigating the culture shock that is the patent system. [2]

To Boldly Go Where No Micro Has Gone Before

One of the many changes enacted by the AIA over the course of its rollout was the pricing structure for fees payable to the United States Patent and Trademark Office (USPTO). What was once a two-tiered system, which offered a 50 percent discount on certain patent filing fees for applicants that qualified for "small entity" status, [3] became a three-tiered system with the addition of a "micro entity" status that provides a 75 percent discount on certain fees for qualified applicants, effective March 19, 2013. [4] To date, the basic undiscounted cost to file a nonprovisional patent application before the USPTO is $1,720, which presumes that the application includes no more than 20 claims, no more than three independent claims, no multiple dependent claims, and no more than 100 total pages. [5]

These figures do not even include fees payable to patent attorneys to navigate the asteroid belts of office actions and other post-filing activities, or issue fees ($1,000 at full price compared to $250 for micro entities). But should counsel get through prosecution in one piece, this significant reduction in fees gives smaller scale inventors enough exit velocity to at least take part in the patent law "galaxy." [6] Meanwhile, some daring patent practitioners can find themselves in another dimension in representing this group of clients—one not only of new filing fee structures, but also of more reasonable flat rate legal retainers to accommodate these clients.

"We are now entering the 'microverse'"—a nod to the late Rod Serling as I broadcast this message to my fellow practitioners who serve micro entity patent clients.

Lost in (the Patent) Space

How did we get here? In much the same way that smaller scale inventors have been overlooked, due to what has been an expensive and marginally understood patent process, would-be patent practitioners have also been subject to the high barriers to entry in patent law practice. To get experience, one must (somehow) *have* experience. Further complicating this paradox is that full-price and small entity patent filing fee structures have often made it impractical for true patent law startups to represent fellow budding entrepreneurs. Patent law novices have, until more recently, been lost in this patent "space": We seldom have been taken seriously by large patent law firms that are reticent to train new patent practitioners for fear of talent jumping ship. We have been financially unable to gain experience on our own because large clients have refused to gamble on small patent practices. And smaller scale clients simply could not afford the patent process. At least part of this problem was apparently resolved thanks to the AIA micro entity pricing structure described above, but there's another black hole: the lack of understanding of what patents are, and why they are worth the associated time and cost, by this new class of inventor.

File. Or File Not. There Is No Try.

Upon starting my own firm, I was not sure how much client volume to expect. As it turned out, my first year was indeed full of calls (always a great thing for new business ventures). But many client consultations ended with informing the party that either (1) what they were seeking protection for was merely an idea at that point, and therefore not patentable yet; (2) what they had created was an idea for a business, which would not be patentable (although I could create a business entity for them for a reasonable price); or (3) what they had created was a logo, for which I could file a trademark application on their behalf. It became clear that one of my biggest hurdles in patent law practice would be explaining to my market what a patent is, [7] both to better identify the right clients and to subsequently make the value pitch to them about why it would be worth paying hundreds of dollars, at best, to possibly have their patent applications receive final rejections years later, at worst.

The value proposition for smaller scale inventors, following an explanation of the patent process itself and its seemingly miniscule odds of success without extended proceedings, [8] is a difficult one for many reasons. But the main one is because micro entities are, and perhaps must be, price-sensitive. My initial solo patent law practice was full of frustrating phone calls dealing with daunting factors including costs and delays associated with the patent process amid the low probability of ultimate patent allowance. Fortunately, my practice was propelled by a few exceptional clients that I was fortunate to represent along the journey.

Live Long and Patent

The perfect client really is out there. Two clients stand out who were knowledgeable about patents and the patent process, had developed inventions that were ripe for patent filing, and had uncanny motivation along with supernatural patience to pursue patent applications despite the commitment of time and resources. The first client had already done some research on possible prior art, and she had

already budgeted for the upcoming patent application process for a product that she, and soon both of us, believed was technologically (in the "can we patent this?" sense) and commercially (in the "can we sell this?" sense) promising. As a result, the value pitch and patent application drafting phase went smoothly, and both the patent application's progress and the client relationship were stellar.

Another exceptional client was one who I met through a young professionals networking event. There often is a lot of overlap between the different professional "worlds," and here there were web developers, engineers, hackers, "makers," blockchain enthusiasts, and entrepreneurs all exchanging business cards, QR codes, and social media handles over cocktails. This client had been busy for months developing an exciting invention, and he had already filed a provisional patent application on his own. It demonstrated his belief in his product, which I soon shared, and he was as pleased to meet a reasonably priced patent attorney as I was to meet an inventor motivated to quickly pursue a patent for such a groundbreaking device. Given the one-year deadline to file the nonprovisional following the already filed provisional application, the client and I worked together diligently to fully disclose the invention in the specification and drawings. My original vision of patent law solo practice seemed to come into clear view: partnering with fellow entrepreneurs and startups to produce something that could change how end users connect with each other and their world. This client and I are now pursuing international patent protection for his invention, working with foreign counsel in multiple languages and connecting with patent offices in countries that we will perhaps never visit.

All my clients exemplify the innovation, entrepreneurship, and perseverance that intellectual property lawyers often strive to empower, but which have until recently been adrift, due to the insurmountable fee structures of the patent process and legal representation, as well as the galactic rift between would-be inventors and sometimes incomprehensible information about patents.

To Infinity and Beyond

The micro entity pricing structure made possible by the AIA, as well as the vastly improved resources that the USPTO provides for inventors and patent practitioners, have made it possible for micro entity inventors, as well as their "micro" patent attorneys, to participate in the patent process and give their inventions and law practices their much-deserved and long-awaited time in the sun.

Here are some of my recommended takeaways to help other aspiring patent law solo practitioners:

- Be prepared to explain what patents are, along with a stratospheric view of the patent process, and find a way to make it fun! An out-of-this-world website with interactive features or games, along with a solid "elevator pitch" that you can use at networking events and during impromptu small talk, can spark anyone you interact with to think of inventions that they (or their friends) should consider getting patented. Every person you interact with knows at least 10 other people, and that means 11 potential clients for you.
- As you identify potential micro entity clients, the best gauge of whether they are ripe for representation often is how succinctly and confidently they can describe their inventions. While a well-organized explanation, ideally in a written invention disclosure after an NDA is signed, tends to show that the invention has been fleshed out in some level of detail, a potential client that suggests "wouldn't it be great if there were a gadget that could" or "I had an idea" without anything substan-

tial may present red flags related to how much they have actually invented up to that point, and how seriously they have investigated possible prior art. Before a potential client is ready to shoot for the moon, you must to help them evaluate their dream from mere idea to full-fledged invention.

- Among the potential clients you identify with inventions ready for patent prosecution, the most important remaining pivot points are their appetite for cost, delay, and risk. It is crucial to emphasize early on that despite the availability of the micro entity fee structure, it can take years to navigate the patent process from application to possible allowance, and that the mission will not necessarily be successful in the end. The limited resources of micro entities make them decidedly and reasonably sensitive to price, lags, and uncertainty, so the patent attorney must account for this when advising such clients on how, when, or whether to proceed. Ultimately, micro entity patent clients that are expressly willing to commit to the process, with full knowledge of the stakes, are ready for launch.

Endnotes

1. Pub. L. No. 112-29, 125 Stat. 284 (2011).

2. U.S. CONST. art. I, § 8, cl. 8.

3. 35 U.S.C. § 41(h)(1); 13 C.F.R. § 121.802(a); U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 509.02 (9th ed. Rev. 8.2017, Jan. 2018).

4. 37 C.F.R. § 1.29; Changes to Implement Micro Entity Status for Paying Patent Fees, 77 Fed. Reg. 75,019, 75,033–34 (Dec. 19, 2012).

5. 37 C.F.R. § 1.16.

6. *See id.*

7. A JavaScript card game I programmed on my firm's website helps *a little*.

8. *See* Michael Carley et al., *What Is the Probability of Receiving a U.S. Patent?*, 17 YALE J.L. & TECH. 203 (2015).