A SOLO'S ADVENTURES IN THE PATENT MICROVERSE

By Justin D. Cotton

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), the patent process suddenly became accessible to an entirely new class of inventor, and, by extension, a new class of patent attorney.

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 U.S. 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, 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. 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.

Lost in (the patent) space. How did we get here? In much the same way that small-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 small-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.

> AS YOU IDENTIFY POTENTIAL MICRO ENTITY CLIENTS, GAUGE HOW SUCCINCTLY THEY CAN DESCRIBE THEIR INVENTIONS.

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. 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; 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.

The value proposition for small-scale inventors, following an explanation of the patent process itself and its seemingly miniscule odds of success without extended proceedings, 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.

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

Justin D. Cotton (thepatentfoundry@gmail.com) is the founder of The Patent Foundry, LLC, an Internet-based law firm.

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 and commercially 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 whom I met through a young professionals networking event. 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. 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.

To infinity and beyond. 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 should consider getting patented. Every person you interact with knows at least ten 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 a nondisclosure agreement is signed, tends to show that the invention has been fleshed out in some level of detail, a potential client who suggests, "wouldn't it be great if there were a gadget that could" or "I had an idea" without anything substantial 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 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. ■

ABA SECTION OF INTELLECTUAL PROPERTY LAW

This article is an abridged and edited version of one that originally appeared on page 31 of *Landslide®*, July/August 2018 (10:6).
For more information or to obtain a copy of the periodical in which the full article appears, please call the ABA Service Center at 800/285-2221.
WEBSITE: americanbar.org/iplaw
PERIODICALS: *Landslide®* magazine, published six times annually (both in print and online); *eNews*, timely Section developments sent monthly.
CLE AND OTHER PROGRAMS: Annual Intellectual Property Law Conference; fall IP WEST seminar; multiple CLE webinar/teleconferences throughout the year.
BOOKS AND OTHER RECENT PUBLICATIONS: *IP Strategies for Medical Device Technologies: Be Your Own Incubator; Pre-ANDA Litigation: Strategies and Tactics for Developing a Drug Product and Patent Portfolio*, 2d ed.; *IP Valuation for the Future: Trends, Techniques, and Case Studies; DMCA Handbook: For Online Service Providers, Websites, and Copyright Owners*, 2d ed.; *Intellectual Property and Technology Due Diligence.*