



Stanford eCorner

How Does the Process Work?

Jeffrey Schox, *Schox Patent Group*

April 13, 2016

Video URL: <http://ecorner.stanford.edu/videos/4612/How-Does-the-Process-Work>

Attorney and Stanford lecturer Jeffrey Schox breaks down the total cost and time for obtaining a U.S. patent and discusses the art of crafting a description broad enough to ensure the best claim protection, but also narrow enough to distinguish an invention from anything previously patented. Schox also explains the value of submitting a provisional application and what it involves.

Why build a patent portfolio?
What is patentable?
How does the process work?
How to identify inventions?
When to file a patent application?
What do investors want to hear?
Who to choose as a patent attorney?

Transcript

(zoom in) - [Instructor] Typically, when the inventors come to me or startups come to me, it's "Hey, there's some invention there." Well, and I'll often push back making sure that the timing is just right. We'll have another section on when should you actually start this process. Let me tell you a little bit about what's actually in it. So typically you would file a provisional. A provisional is great for startups. It gives a startup a relatively easy cheap way to get into the patent system. You go to the Patent Office with a provisional application and now your spot is kind of held in line. You now can go and say, within twelve months one year turnaround and convert that provisional into a full patent application. If those claims, the part of the patent application that's what is distinguishing that patent application from what the prior art, or everything else as ever actually ever been done. If that's described in the provisional, and you get the date of the provisional, it's as if that full patent application was filed on the date of the provisional.

This is called the priority date. And so anything that was filed after the provisional, is discounted, and is ignored from the standpoint of examining your full patent application. This is why we do file provisionals. There's two tracks at the Patent Office, there's the normal track and there's a fast track. The normal track probably takes somewhere around two or three years after you file this full application, to hear back anything from the Patent Office. The fast track is another two thousand dollars for startups, and what that does is allows you to effectively jump to much closer to the front of the line. I've actually had the next response from the Patent Office within just a few months. So we're moving from three years to potentially three months in terms of that next step. The next step is typically what's called an Office action. The Patent Office does an examination and takes a look at all the prior art they could find and says, "Hey, your invention is not new.

We've actually already seen this a decade ago." Or "Your invention is merely an obvious combination of this thing that was old and this other thing that was old." These things are just called, simply called rejections. The first one is a novelty rejection, the second one is a non-obviousness rejection. The AMD stands for an amendment, or a response. And so, now that the Office action came, we can now respond and effectively argue with the Patent Office, and say "No, this is different for these directions, for these reasons." So you could argue. You could also amend. You could say "All right, you're right. This device, as I described in these two hundred words, is actually found in the prior art. Let me add a few more words to this claim," we're now up to two hundred and fifty or three hundred, "Can you find this?" And so that's the amendment process. So you could either argue, or you could amend, or you could do a little bit of both. You send it back to the patent office, typically, you get two or three Office actions, and so you would come back with another Office action and you would repeat this entire process.

The national average I think is a little over two. My law firm typically gets it done in a little under two, but it takes a couple of back and forth with the Patent Office. Keep in mind that you could almost always get a patent if you really wanted to. You could go ahead and just add a ton of words. As I mentioned earlier, in terms of almost a hundred percent chance of getting something, is, hey, just add a thousand words into that claim, or a million words into that claim. But now you're getting something that's worthless. What we're trying to do, is trying to tease out the best claim protection we can possibly get, and that's why we go back and forth. It's expensive. It's frustrating, both for the client and honestly for us, but this is what the process, to try to get the best claims that we can. If all goes well, this ends up with an actually, an issued patent.

As I mentioned, the process from provisional to application is usually a year, no longer, sometimes faster. And the process from application to an issued patent could be as short as a year, if you're on the fast track, and you've paid that government fee. Or more likely, three to four years if you're on the slower, slower track. Let's talk briefly about the cost. Provisional applications, they're meant to be cheap. They're meant to be relatively easy. These documents can be actually self prepared and self written. The class that I teach here at Stanford actually is teaching engineers how to write their own provisional application. There's some tricks to it and it takes a little while, to actually prepare the document, but that's something that as an owner, as a CTO, as a CEO, as a founder, as an inventor certainly within your scope of being able to do this. What the provisional needs to is describe and teach someone else how to make and use your invention, and that's what an inventor typically can do.

The application is typically a whole lot more expensive. And the reason here is that we're actually trying to come up with those two hundred words. You don't have to write claims in a provisional. You do in a full application. And so the art of actually picking those, that independent claim, this is how we're actually going to describe this, in a way that is now broad, to be able to prevent any of our competitors from designing around, but still narrow to be able to distinguish it from everything that's been done in the past. That's hard. There's an art to that. And that's what the big bulk of the expense is coming up with the claims. In a provisional, you might file it in five pages, ten pages. We typically prepare about a fifteen to twenty page provisional at my firm.

An application might double, triple, quadruple that size. And the reason is, is that you've now learned quite a bit over the course of that twelve months. And you can put those details into the full application even though they weren't there in the provisional. The amendments typically cost somewhere in the order of a few thousand dollars to go back and forth. And you might get a few of those. And the issue fee is about, I think, five hundred bucks or so. When you add up all these numbers, you're looking at somewhere in the order of twenty to forty K, for a patent application from beginning to end. And that's how the patent process works.