INVENTOR RESOURCES SERIES · PART 3

Do You Need a Patent Attorney, or Can You File Your Own Patent Application?

How to decide whether to hire a patent attorney or agent, what to look for when choosing one, and where independent inventors can find free assistance.

One of the first questions new inventors face when considering a patent is whether they need to hire a patent attorney or agent. That question is usually followed by another: *How much is this going to cost?* And perhaps a third: *Can I do some or all of this work myself?*

The answers aren't as straightforward as you might think. You can hire a patent attorney from a large national law firm, work with an independent patent agent, or prepare and file your own application. You can also do much of the preliminary work yourself and hire a professional to handle the parts you're not comfortable doing. All of these are legitimate approaches, and each has its advantages and disadvantages.

In this article, we'll look at the pros and cons of filing your own patent application, how to choose a patent attorney or agent, and how to investigate their qualifications and previous patent work before you hire them. We'll also look at some of the extensive free resources available through the United States Patent and Trademark Office (USPTO).

This is Part 3 in the Inventor Resources series. Part 1 covered local and national resources for building your business entity and Part 2 covered what a provisional patent application needs to contain. This article takes up the decision to file on your own or hire a practitioner, with a step-by-step method for vetting a practitioner.

Does Spending More Money Get You a Better Patent?

Let's start by clearing up a common misconception. There is no reliable correlation between how much you spend on a patent application and the quality of the claims you receive. Just because one attorney charges $25,000 and another charges $5,000 doesn't mean you're getting five times better representation.

Certainly, some inventions are more complicated than others. A biotechnology application involving complex molecular structures, for example, may require considerably more research and drafting than an application for a relatively simple mechanical device. But the hourly rate charged by a patent practitioner doesn't necessarily tell you anything about the quality of the work.

Much of the quality of a patent application depends on you, the inventor. How thoroughly have you described your invention? Have you explained how it works, how it's made, and how someone experienced in the field could reproduce it? Have you identified alternative ways of making or using it? Have you distinguished between what you've actually built or tested and what you believe should work but haven't yet demonstrated?

These are important questions because a patent practitioner can only work with the information available. A good practitioner will ask questions, identify missing information, and help you recognize aspects of your invention that deserve protection. But the starting point is always the inventor's disclosure.

> If you haven't adequately described your invention, even an excellent attorney may have difficulty preparing claims that provide the protection you're looking for. And no amount of money can make an invention patentable if it doesn't satisfy the legal requirements.

Is a Large Patent Law Firm Better Than a Solo Practitioner?

Not necessarily. Large patent law firms certainly have their advantages. They may employ attorneys with experience across many technical disciplines, have litigation departments, and offer

services for international patent protection, licensing, and other intellectual property matters. But all of that comes with overhead.

If you're working with a large practice, you're helping pay for office space, administrative staff, paralegals, partners, and all the other expenses associated with operating a substantial law firm. There's nothing inherently wrong with that. Those resources may be valuable, particularly for large companies managing extensive patent portfolios.

But does an independent inventor developing a new mechanical device or electronic sensor necessarily need all those resources?

Probably not.

Consider a solo patent practitioner working from a modest office. That practitioner may have decades of experience, access to the same USPTO databases and commercial patent research tools, and an extensive history of preparing and prosecuting applications. They may also have considerably lower overhead. They don't have to maintain an expensive corner office, support a large administrative staff, or pay someone to come in and water the ficus every week.

You may be paying primarily for their experience and professional time.

The important question isn't how large the firm is. It's whether the person handling your application has the experience and technical understanding needed to do the job well.

Match the Practitioner to Your Technology

Experience in your particular technical field is especially important. Patents aren't interchangeable. Someone who has spent twenty years preparing mechanical patents may be exceptionally good at that work but have little experience with molecular biology, pharmaceutical formulations, or semiconductor fabrication. Likewise, a practitioner who specializes in biotechnology may not be the best choice for an invention involving automotive suspension systems.

You should look for someone who understands your general technical field. That doesn't necessarily mean they must have previously patented exactly what you've invented, but they should be comfortable with the underlying science or engineering and understand the patent examination issues commonly encountered in that field.

Patent Attorney or Patent Agent?

Another question inventors frequently ask is whether they need an attorney or whether a patent agent can handle the work. Both registered patent attorneys and registered patent agents can prepare, file, and prosecute patent applications before the USPTO. Both must satisfy the USPTO's technical qualification requirements and pass the registration examination, commonly called the patent bar.

The principal difference is that a patent attorney is also licensed to practice law in at least one jurisdiction. A registered patent agent is authorized to practice before the USPTO in patent matters but is not authorized, merely by being a patent agent, to provide legal services outside that permitted scope.

TASK	PATENT ATTORNEY	PATENT AGENT
Prepare and file patent applications	Yes	Yes
Draft claims, respond to Office actions, communicate with examiners	Yes	Yes
Passed the USPTO registration exam (patent bar)	Yes	Yes
Licensed to practice law	Yes	Not by virtue of registration
Represent you in an infringement lawsuit	Yes, if qualified to handle litigation	No
Licensing agreements and complex contracts	Yes	May require an attorney

For example, a patent agent can prepare patent applications, draft claims, respond to patent office actions, and communicate with patent examiners. However, if you need someone to represent you in a patent infringement lawsuit, you'll need an attorney qualified to handle that litigation. Patent licensing agreements, complex contracts, and other legal matters may also require an attorney.

For many independent inventors who primarily need help preparing and prosecuting a patent application, a registered patent agent may be an excellent choice. The key is finding someone with the right experience.

Finding Someone You Can Work With

I've worked in several different patent environments over the years. I've been a solo practitioner, worked with a patent firm, worked in a corporate patent environment, and been an independent inventor myself. Each situation is different.

One thing I've learned is that not every inventor and patent practitioner are a good match. Sometimes the problem is technical. The invention may fall outside the practitioner's area of experience. Sometimes it's a matter of personality or communication. And sometimes the inventor and practitioner simply have different expectations about how the work should proceed.

I've encountered prospective clients whose inventions were outside my particular area of expertise, and others where I simply didn't feel we would work well together. There's nothing wrong with recognizing that a professional relationship isn't a good fit.

Remember that preparing a patent application is a collaborative process. You may spend considerable time explaining your invention, reviewing drawings, discussing alternative embodiments, and revising claims. If you're not comfortable communicating with the person handling your application, that can become a serious problem.

Location can also matter. Some inventors are perfectly comfortable conducting the entire process by email, telephone, and video conferences. Others prefer sitting across a desk from someone, spreading drawings out on a table, and discussing the invention face-to-face. Neither approach is inherently better. Choose a practitioner whose working style fits your needs.

Can You File Your Own Patent Application?

Yes. The USPTO allows inventors to represent themselves in patent matters. This is known as filing *pro se*. You don't have to hire a patent attorney or agent to file an application covering your own invention.

However, there's an important distinction between being legally permitted to prepare an application and preparing one that adequately protects your invention.

Patent applications are technical and legal documents. A good application must describe the invention in sufficient detail to satisfy the disclosure requirements of patent law. For a nonprovisional utility application, the claims must also define the invention clearly enough to distinguish it from the prior art. You also need to understand the filing procedures, deadlines, fees, and formal requirements.

For many inventors, the most practical approach is somewhere between doing everything themselves and paying a professional to handle the entire process.

For example, you might conduct an initial patent search, prepare a detailed invention disclosure, organize your drawings, and identify the features you believe distinguish your invention from existing technology. You can then take that material to a patent practitioner. This may reduce the time the practitioner needs to spend gathering information and help you have a more productive discussion about the invention.

It doesn't eliminate the need for professional review, and the practitioner may need to revise or expand your materials substantially. But it gives you a much better starting point.

Provisional Applications and Independent Inventors

Provisional patent applications can be particularly attractive to independent inventors. A provisional application generally has lower filing fees, doesn't require formal patent claims, and isn't examined by the USPTO. It establishes a filing date for the subject matter adequately disclosed in the application.

However, a provisional application doesn't become a patent, and it doesn't automatically protect everything you develop afterward. To obtain the benefit of its filing date, you generally must file a corresponding nonprovisional application within twelve months. The later claims are entitled to that earlier date only to the extent the provisional application adequately supports them.

> That makes the quality of the original disclosure extremely important. A poorly prepared provisional application can create a false sense of security. I've discussed this subject in more detail in What Does a Provisional Patent Application Actually Need to Contain?

Free Help for Inventors Filing Without an Attorney

One of the things that surprises many first-time inventors is how much assistance the USPTO provides. The Patent Office doesn't require you to hire a professional before asking questions or

learning how the system works. There are several programs specifically intended to help independent inventors, and many of them are free.

USPTO Pro Se Assistance Program

The Pro Se Assistance Program is specifically designed to help inventors who are preparing and prosecuting patent applications without professional representation. The program provides information about patent procedures, filing requirements, and navigating the application process. Inventors can contact the Pro Se Assistance Center at 866-767-3848 or by email at proseassistancecenter@uspto.gov. The center's published hours are Monday through Friday, 8:30 a.m. to 5:00 p.m. Eastern Time. The staff can help you understand procedures and requirements, although they cannot act as your attorney or provide legal advice.

Inventors Assistance Center

The Inventors Assistance Center provides general information about patent procedures. The center can help answer questions about application requirements, filing procedures, forms, fees, and other administrative matters. This can be particularly helpful when you understand what you're trying to accomplish but aren't sure how to navigate the Patent Office's procedures.

Patent Pro Bono Program

Not every inventor can afford professional representation, and the USPTO recognizes that problem. The Patent Pro Bono Program helps financially under-resourced inventors and small businesses obtain assistance from volunteer patent attorneys and agents. The program operates through regional organizations and has eligibility requirements. If you have a potentially patentable invention but limited financial resources, it's worth investigating before deciding that professional assistance is beyond your reach.

Law School Clinic Certification Program

The USPTO also operates a Law School Clinic Certification Program. Participating law schools allow qualified students, working under appropriate supervision, to provide patent-related assistance to accepted clients. These programs can be particularly valuable for independent inventors and small businesses that meet the clinics' eligibility requirements. Availability varies by school, and not every clinic accepts every type of invention.

Patent and Trademark Resource Centers

Another resource that deserves more attention is the Patent and Trademark Resource Center Program. These centers are located in participating libraries around the country. They provide access to patent and trademark information and can help inventors learn how to use USPTO search tools. The staff generally cannot perform a patentability search for you or provide legal opinions about your invention, but they can teach you how to conduct your own research. For an independent inventor who wants to learn patent searching, that's a valuable service.

What Happens When the Patent Examiner Rejects Your Claims?

Suppose you've prepared and filed your own nonprovisional application, and several months later you receive an Office action rejecting some or all of your claims.

First, don't panic. Receiving an Office action rejecting claims is a normal part of patent prosecution. It doesn't necessarily mean your invention is worthless or that your application has failed.

The examiner may have identified prior art that appears to anticipate your claims or make them obvious. There may also be objections or rejections relating to the clarity of the claims, the written description, or other requirements.

You have an opportunity to respond.

The USPTO provides information about responding to Office actions. Depending on the circumstances, you may be able to amend your claims, explain why the cited prior art doesn't apply, or address other issues raised by the examiner.

But be careful. Changes made during prosecution can affect the scope of your patent rights, and amendments cannot introduce new matter into the application. This is one stage where professional assistance can be particularly valuable.

Many new inventors also don't realize that patent applicants can request interviews with their examiners. The USPTO has established procedures for arranging these discussions, described in its Examiner Interview Practice.

An examiner interview can help clarify the examiner's position, discuss the cited prior art, and explore possible amendments. It can be considerably more productive than exchanging written arguments without fully understanding the examiner's concerns. There are formal requirements for requesting and documenting interviews, so review the USPTO's current procedures before arranging one.

How Do You Find a Good Patent Attorney or Agent?

Suppose you've decided that you want professional assistance. How do you find someone qualified, and more importantly, how do you determine whether they're the right person for your invention?

I suggest doing a little investigating before hiring anyone. You want to know whether they're actually registered and authorized to practice before the USPTO, whether they have experience preparing and prosecuting patents in your technical field, and whether their professional history and working style make you comfortable.

Fortunately, much of this information is publicly available. You don't have to rely entirely on advertising, recommendations, or a firm's website.

1. Verify Their USPTO Registration

Not everyone who advertises intellectual property services is registered to practice patent matters before the USPTO. Some attorneys specialize in trademarks, copyrights, licensing, or litigation but aren't registered patent practitioners.

The USPTO maintains a searchable directory through its Office of Enrollment and Discipline (OED). You can access it through the USPTO Patent Practitioner Search. You can search for a practitioner by name, registration number, or other available identifying information. If you're considering hiring someone, ask for their USPTO registration number. A registered practitioner should have no objection to providing it.

Use the directory to confirm their identity, registration category, and current status. If you cannot find someone, don't immediately assume they're misrepresenting their credentials. There may be a spelling issue, name variation, or status question that needs clarification. But don't hire someone to represent you before resolving that question.

2. Check Their State Bar Standing (Attorneys)

If the person is a patent attorney, you should also check their standing with the appropriate state bar. USPTO registration and state bar membership are separate matters.

3. Look for a Disciplinary History

It's also worth investigating whether the practitioner has a disciplinary history. The USPTO's Office of Enrollment and Discipline investigates allegations of professional misconduct involving practitioners under its jurisdiction. Public disciplinary decisions and related information can be found through the USPTO's Finding a Patent Practitioner resources.

A disciplinary history doesn't necessarily tell you everything about someone's competence, but serious or repeated problems deserve careful consideration. Likewise, the absence of disciplinary action doesn't establish that someone is an excellent patent practitioner. It's simply one part of your investigation.

How to Find Out What Patents an Attorney or Agent Has Handled

This is one of the most useful steps in choosing a patent practitioner, and one that many inventors overlook.

You can search USPTO patent records to identify published applications and granted patents that list a particular attorney or agent. This gives you an opportunity to examine the kinds of inventions they've handled, how the applications were written, how the claims were structured, and whether the technical subject matter resembles your invention.

To do this, open the USPTO Patent Public Search website and select Advanced Search. For issued patents, select the USPAT database. If you also want to search published patent applications, include the US-PGPUB database.

The search system includes an attorney field identified by the code `.att.`. Suppose, for example, you're investigating a patent attorney named John Smith. You can enter `(john NEAR3 smith).att.` in the search box. This searches the attorney field for those names appearing within the specified proximity.

You can also search for a law firm's name using the attorney field.

Patent records aren't always consistent about how names are entered. A practitioner might appear as John Smith, John A. Smith, John Andrew Smith, or J. A. Smith. Try several variations if your initial search produces few results. The attorney field can also contain law firm names, so searching a firm may help identify additional patents associated with that practice.

Keep in mind that these searches have limitations. Not every patent record contains complete attorney information, and the search may not identify every application a practitioner has handled. Also, the attorney listed on a patent may not be the person who actually drafted the application.

Nevertheless, this is a useful way to investigate someone's experience.

And don't simply count the number of patents. Someone with 500 patents listed under their name isn't necessarily a better practitioner than someone with 50.

> **Look at the subject matter.** If you're developing a medical sensor, have they worked on medical devices, electrochemical sensors, diagnostic systems, or related technology? If you're working on a new manufacturing process, have they handled process claims and patents involving similar industrial technologies?

Open several patents and read the claims. Do they appear to be carefully drafted? Are the independent claims reasonably broad while remaining supported by the specification? Are there dependent claims covering useful variations?

These are more meaningful questions than simply counting patent numbers.

Of course, evaluating claim quality requires some familiarity with patent practice. A granted patent alone doesn't establish that its claims are commercially valuable or would survive a serious validity challenge. But reviewing previous work can help you identify practitioners worth interviewing.

For more information about the available search fields, the USPTO publishes a guide to its Patent Public Search Indexes.

What Should You Ask Before Hiring Someone?

Once you've identified two or three possible candidates, arrange an initial discussion. You don't need to turn it into an interrogation, but you should understand how they work and what services you're purchasing.

- **Field experience.** Start by asking whether they've handled patent applications in your technical field. If they have, ask whether they can point you toward examples of published patents or applications involving similar technology.
- **Who does the work.** Find out who will actually prepare your application. At a large firm, the senior partner you initially speak with may not be the person drafting the application. There's nothing necessarily wrong with that, but you should know who will be doing the work.

- **Fees.** Discuss fees in some detail. Does the quoted fee include a prior-art search, drawings, preparing the specification and claims, and USPTO filing fees? Are responses to Office actions included, or will those be billed separately? Will you receive a draft to review, and how many rounds of revisions are included?
- **Prosecution.** Ask how the practitioner handles prosecution after the application has been filed. What happens if the examiner rejects the claims? How are additional responses billed? What should you expect if the application requires several rounds of examination?
- **Foreign filing.** If international markets are important to you, find out whether the practitioner has experience coordinating foreign patent filings. International patent protection can become expensive, and the filing deadlines and procedural requirements deserve attention early in the process.
- **Enforcement.** If you're working in a highly competitive field, you may also want to discuss what happens if litigation eventually becomes necessary. A patent agent or a prosecution-focused attorney may not handle infringement litigation. That doesn't disqualify them from preparing an excellent application, but you should understand what happens if you later need enforcement assistance.
- **Reducing costs.** Finally, ask what work you can do yourself to reduce costs. Some practitioners welcome detailed invention disclosures, organized drawings, and preliminary prior-art research. Others prefer to handle most of the process themselves. Ask what information would be most helpful and whether doing preliminary work will actually reduce the fee.

Do You Need a Patent Attorney Who Can Also Handle Litigation?

This depends on your circumstances. If you're developing an invention in a highly competitive field, particularly one involving substantial commercial value, patent enforcement may eventually become an important consideration.

You may want a firm that can provide both patent prosecution and litigation services. But that doesn't necessarily mean the same attorney should handle both.

Patent prosecution and patent litigation are different specialties. A practitioner who is excellent at drafting and prosecuting applications may have little courtroom experience. Conversely, an experienced patent litigator may not spend much time preparing new patent applications.

For many independent inventors, the immediate priority should be obtaining a well-prepared application with claims that provide meaningful protection. If litigation becomes necessary later, you can retain appropriate litigation counsel.

> What's important is recognizing that obtaining a patent and enforcing a patent are two different things.

Preparing Your Own Materials Before Hiring a Practitioner

There is another approach that deserves consideration. Instead of choosing between doing everything yourself and hiring someone to handle everything, consider preparing the preliminary materials before consulting a practitioner.

You can learn to search patent databases, review competing technologies, organize your invention disclosure, and prepare preliminary drawings. You can also identify the features you believe are novel and the alternative ways your invention might be implemented.

This work doesn't replace professional judgment. A patent practitioner may identify important issues that you missed, find additional prior art, or recommend a different claiming strategy.

But the better you understand your own invention and the surrounding technology, the more effectively you can work with that professional.

This is particularly important for independent inventors working with limited budgets.

Modern research tools, including AI-assisted systems, can help organize technical information and prepare preliminary materials. However, they also have limitations. AI systems can invent

technical details, misinterpret prior art, and produce patent claims that appear convincing but are legally or technically defective.

> Never allow an AI system to add features, experimental results, or working examples that you haven't actually disclosed without clearly identifying them as proposed or hypothetical. And always verify patent references and legal information against authoritative sources.

The objective is to make the inventor better informed and better prepared, not to pretend that software can replace professional experience.

Making the Right Decision for Your Invention

There isn't one correct answer to whether you should hire a patent attorney, work with a patent agent, or file your own application. It depends on the invention, your technical background, your financial resources, and what you're trying to accomplish.

A first-time inventor developing a relatively simple mechanical device may have very different needs from a biotechnology startup preparing a portfolio of patents for international markets. Likewise, someone preparing an initial provisional application may not need the same level of assistance as a company responding to a complicated rejection or preparing for patent litigation.

What I would strongly recommend is that you educate yourself before spending money. Learn the basics of the patent process. Conduct some preliminary prior-art research. Understand what makes your invention different. Investigate the qualifications of anyone you're considering hiring, and take advantage of the free resources offered by the USPTO.

Remember that you're not simply purchasing a document. You're making decisions about how to protect something you've created, potentially for the next twenty years.

The Bottom Line

A good patent practitioner can be an invaluable partner. But an informed inventor is in a much better position to choose that partner and to work effectively with them.

For a step-by-step guide to the whole process, see Patent It Now!

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