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Suggested Pathway for First-Time Inventors

A Message to Potential Clients and Inventors:

There is an abundance of "free" advice available claiming to provide the proper path to obtaining a patent for a first-time inventor, and it can be difficult to distinguish which suggestions are valid and which are more designed to separate the inventor from his or her money. The following information provides what we consider to be the least expensive option that maximizes the value for the inventor.

First, you must ask yourself "Does your invention work?" If you aren't sure that it is functional, it doesn't make sense to try to patent and manufacture your product, as no consumer willingly buys a product that doesn't work. Your first step should be to talk with an **engineer** with experience in your particular field to see if your invention will function as you have envisioned. Once you have an invention that is functional, you should conduct your own **patent search**, using a service such as **Google Patents**, **FreePatentsOnline**, **PatentStorm**, and/or the **USPTO website**. If you don't find any prior art that resembles your invention, have a professional prior art searching company like **National Patent Services** or **Legal Advantage** see what else they can find in addition to your searches. You should expect to pay around $400 to $600 for an average prior art search.

If you find that someone else may have already patented part of your invention, you should consider paying for a **Freedom-to-Operate Assessment**. This should give you an idea of whether or not you would be infringing someone else's patent by making your invention. These can be expensive, but you can minimize your costs by only having the patent attorney review the patents that appear right on part of your invention.

If there is prior art that is close to your invention, you should consider either a **patentability assessment** by a patent law firm, which will detail "how dangerous" the prior art appears to be to your invention and/or go back to the engineers to see if they can advise you on how to design around the prior art that was found.

We frequently run into inventors who like to email us the entire prior art search and ask us to review it for free and estimate whether they will get a patent or whether they infringe someone else's patent. **We cannot do this work for free**. To adequately review a patent and compare it with an invention takes around an hour of work per patent reviewed, and if there may be infringement, it can take up to 5 hours per patent to prepare the necessary claims charts and analyze infringement. Sometimes during the examination of a patent we will find references to other patents, which requires the review of these patents as well. Other times when we review the file wrapper for a patent or patent application, we find that the inventor initially claimed a much broader scope of the invention, and had to narrow the claims in response to an Office Action.

In these cases, we need to review the Office Action and look for other prior art cited therein that required the narrowing of the claims. Thus, to adequately review an entire prior art search just for a patentability assessment would cost upwards of $5,000. We find that inventors get the best ROI on assessments of patentability and freedom-to-operate assessments when they give us only the two or three most dangerous items of prior art and have us only work on these items.

If neither you nor the professional prior art searcher found anything close to your idea, you should consider filing a **provisional patent application** (expect to pay around $3,500 to $6,000), then use the year of provisional grace period to refine your invention, get at least a proof-of-concept prototype made, seek investors, test the market, sell the invention outright, etc. Before the year grace period expires, the inventor needs to have a **utility patent application** filed that **claims priority** from the provisional.

For those more comfortable with an outline:

1. Does it work? If your invention doesn't work, there is no point in trying to patent it. I realize that this sounds overly simplistic, but we have been amazed at the number of people who want to pay money for a patent application on something they have not tested yet and have no basis for thinking that the invention actually works as intended.

2. Do your own Patent Search. If you find prior art that is very similar to your invention, consider going to patent attorneys to see if they can "write around' the prior art and/or to an engineer to see if they can "design around" the prior art.

3. Hire a professional company to do a prior art search (National Patent Services, Legal Advantage). If they find prior art too close to your invention, repeat the steps in #2. As an alternative to #2 and #3, if you want, we can handle the entire prior art search process. Average cost to arrange the prior art search and analyze the results varies from $2,000 to $5,000. If there are patents that appear to be right on part of your invention, consider paying for a Freedom-to-Operate assessment.

4. If they don't find anything, file for a provisional patent application (but be careful, provisional patents aren't the perfect solution and have pitfalls. Please check out the links below that explain the provisional patent application process in greater detail.

   Videos:

   - Provisional Patent Applications - Potential Issues An Inventor May Face
   - Intellectual Property With Eric Hanscom - Provisional Patents
   - Eric Hanscom Discusses Provisional Patents
   - Should I Write My Own Provisional Patent?

5. Now you have 1 year of "patent pending" status. Use this year wisely!
    A. Proof of concept prototype.
       Video: Intellectual Property - Ideas Without Execution & Prototypes

    B. Look for investors.
       Video: Investment Funding - Kickstarter

    C. Begin developing product and establish market.

6. Before the year grace period is up, decide whether to file a utility patent application using the provisional application as a priority date.

7. Consider protecting your foreign filing rights through use of a PCT (Patent Cooperation Treaty) filing.

8. Be careful along the way of scams, there are plenty of them out there.
   Video: Intellectual Property Pitfalls and Scams to Avoid

Best of luck and just let us know if you want us to help out on any step of this process.

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