

Patents pending: IP attorneys advise clients on longer process

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The next Thomas Edison or Bill Gates may take a little longer to get discovered, if at all.

Intellectual property attorneys are enduring an increasingly arduous patent process on behalf of their clients, coupled with a backlog of approximately 1 million applications at the United States Patent and Trademark Office.

As a result, some inventors are reconsidering or even abandoning applications because they can't afford a series of appeals or have simply grown impatient with the system.

"For the first time ever, clients are saying, 'I just can't put any more time and money into this invention. It's just not worth it,'" said IP attorney Keith M. Baxter of [Boyle Fredrickson SC](#) in Milwaukee.

He said most clients accept the fact that the process will be relatively rigorous, and "nobody gets patents on fads." But even before the recession hit, the timeline between filing an application and receiving a first office action or response from the Patent Office had begun to widen.

And the situation has gotten worse.

Baxter, who deals primarily with clients in the technology field, said that patents which previously had seen first office action in six months are taking three or four times as long.

He suggested this could be a product of examiners granting a high volume of applications in recent years — and now the Patent Office is looking at them with more scrutiny.

"It could be too many patents getting through," he said. "[For me] it may mean people with simple mechanical cases just get rejected."

[Michael Best & Friedrich](#) attorney Thomas J. Otterlee said smaller inventors, especially, are concerned about the length of the process.

"When I tell them it can take, two, three or four years, they are a little surprised," said Otterlee, who deals with mechanical devices. "Every time we respond to an office action, they ask 'When is this going to end?'"

Timeline hard to predict

Otterlee said it is increasingly common for inventors to have to file several responses with the examiners at the Patent Office, and because it's also taking longer to initially hear back, attorneys are having a hard time giving clients an accurate timetable.

[Quarles & Brady](#) patent attorney Jean C. Baker, who has 20 years experience, said that it's particularly difficult for someone just starting out to have an accurate expectation of how long the process will take.

"We have attorneys here that filed applications years before they started seeing office actions," she



Quarles & Brady patent attorney Jean C. Baker along with other lawyers in the Intellectual Property practice are advising clients on how to handle an increasingly lengthy application process as well as a growing backlog within the U.S. Patent and Trademark Office. Baker said the complexity of applications, especially in the technology industry has contributed to the slowdown.

WLI Photo by Corey Hengen

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Baker also attributed the lengthier process to more complex applications, especially in the technology industry, and increased back and forth among patent examiners.

“They [examiners] are getting different things to look at than 10 years ago,” she said.

That may be why examiners appear to be less confident in granting applications and there always seems to be a lot of “double-checking.”

“There are more situations where people agree to something on the phone, then change their minds because they go up the chain and someone else disagrees with them,” Baker said.

In those cases, inventors often have to file a continuance or appeal the decision, which means an additional cost.

“That’s another filing fee, another office action and more lawyers’ fees,” Baker said. “You can easily add \$3,000 to the process just because an examiner wanted to clarify something you had an interview about.”

But despite the hassles, attorneys say they haven’t noticed a significant dip in the number of clients seeking patent protection.

In fact, while some clients are abandoning the process, Baxter said that given what can be riding on approval, other clients may be more willing to fight than in the past.

“In my first 15 years I probably had two cases in appeal, and now I have five or six ... because people are just not getting what they believe should be allowed through,” he said.

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