

Popular Threads on Solosez

Any Patent Attorneys Here?

A couple years ago I thought about taking the USPTO Exam since I'm also an Engineer. Noticing that the Manual of Patent Examination Procedures was about 2,000 pages and that the review classes, including travel and lodging, cost about \$5 for every page in the MPEP, I didn't do it. It appears that most of the work is dealing with the USPTO which is mostly via US Mail, is this correct? It also follows that clients or subcontracts should not be hard to get since some job guides state that there is a deficit of patent attorneys both current and projected. Is there an abundance of work out there? What I am thinking is that I could practice in an area of law that does not require many appearances or the requirement to live in an urban area to have a large enough client base and most likely practice out of my house or on the top of a mountain as long as internet and mail service are available.

Tom Mattiacci

If you like to put inventions into words and battle with the PTO, which can be sluggish, it does offer the opportunity to work most anywhere. Corresponding with the PTO is mostly done by mail and Express Mail, but may now be done by e-filing.

As for the exam, it is open book (at least it was when I took it) and difficult. Don't let the open book freedom fool you. You should know it cold because most do not have time to crack open a book and answer all the questions. The pass rate is lower than the California Bar which is often far less than 50%. A review course is recommended.

I don't know about any dearth of patent attorneys, but I believe the demand is greater than for practitioners in many other areas of law. To obtain work, you need clients. If you can get them atop a mountain, maybe your talents are grand and your calling should be elsewhere

Craig McLaughlin, Irvine, California

I think Carl Oppedahl holds the patent on the patent-attorney-with-lots-of-clients-living- on-a-mountaintop-thing.

James S. Tyre, Culver City, California

In fact, Carl's web site, <http://www.patents.com>, has a wealth of information for practitioners and non-practitioners, alike. Carl is one of the pioneers in bringing the patent system into the 20th (not a typo) century.



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Mike Phillipsm North Carolina

Almost all of our interactions with the PTO (patent and trademark) are electronic, whether online or telephone. They do still send out a lot of paper, but the volume is declining steadily.

Twelve years ago when I was making the decisions you're making, there was a shortage of patent attorneys. Now, there are too many. There is some discussion that the pendulum is swinging back, but who knows?

It is a tough job, but if you get paying clients, it pays well. My objective is to one day be able to sit in a hotel room and make a few thousand bucks while my wife does things she enjoys, but to make this objective a reality, you have to have someone, whether it is your own firm or another firm that trusts you and is willing to feed you business, supply you with the work. Unless you have a stable and committed client base, it's hard to do business from a mountain top. (However, if you master Internet marketing and are able to get all of your business from the Internet, that statement doesn't apply.)

I know of several patent attorneys who are billing \$1M per year, but they have no lives -- at all. They will likely breathe their last breath sitting at their desks writing patent applications. That's not for me. Carl, mentioned by Jim in another thread, is the Energizer bunny. He works seven days per week. He's amazing.

Good luck in whatever you decide to do. It is a commitment. Not everyone can write a patent application well. Turning inventions into words is an art as much as it is a skill.

Mike Phillips, North Carolina

With regard to the PTO exam, I found it to be much easier than the NJ and PA bar exams, but that was due to the fact that I was filing and prosecuting patent applications for 1.5 years before taking the exam (of course I could not sign anything - was doing it under the tutelage of an experienced patent practitioner). You can pass without taking this route, but I would definitely recommend trying to get some experience before taking the exam as a means to making it easier for you to pass. One year should be sufficient.

I agree that it is the sort of work one can do from home/ a mountain BUT, as noted by others, getting clients is not quite as easy as the "deficit" of patent attorneys would have you believe. But once you do manage to establish a client base, I am sure you could move to that mountain of yours. While we are on this topic, any advice from you patent solo veterans for use newbies regarding getting clients in this field?

Chip M. Jolibois, Langhorne, Pennsylvania

Regarding your question about getting clients, that's tough. Here are my opinions on how and where a solo gets clients, in no particular order.

1) Go solo after working for a patent firm, ethically taking clients with you who particularly like you. 2) Yellow pages and other advertising media 3) Internet (web page, bulletin board posts, spamming (just kidding), Google AdWords, Solosez) 4) Local inventors groups 5) Volunteer speaking engagements 6) Write a book (this can be a biggie!) 7) Referrals from non-patent attorneys with whom you have relationships 8) Inherit a patent law firm with a stable of clients 9) Cold calling on businesses (best clients, lowest probability of success)

I'm not very good at the high octane marketing that many attorneys are beginning to use. Referrals are our life blood. Once you build a client base, there will be some attrition, but you will likely make a comfortable living with repeat business. Most inventors do not have just one invention.

The problem that I see with most marketing efforts for a patent practice is that you generally attract a lot of sole inventors who have no experience in the patent system and do not have a clue how expensive the process can be. A \$5000 client who has never filed a patent application before takes more time and work than a \$10,000 corporate client. However, corporate clients are zealously protected by patent practitioners, and solos are generally not going to pick them up without some sort of inside connection. The good news is that it only takes a few corporate clients to pay the overhead.

Mike Phillips

With regard to taking the Patent Bar, certainly you could sit for the exam and pass it. I have talked to people that have done just that. However, IMHO when it comes to actually representing a client before the PTO it is really quite different. I worked for a large multinational corporation and they generally made you practice under a practicing patent attorney for a year or so before you could sit for the exam. Personally, I would feel very uncomfortable representing a client without some experience first.

Today's practice and into the future patent prosecution will be moving to a paperless process via the internet. The PTO just had a training seminar on the new system which convinced me to go electronic. The ability to practice in odd places is actually true. I have drafted patent applications in hotel rooms and in the Bahamas on a dive trip with my trusty laptop. However, I did have support staff back in the office.

The key ingredient to doing this is the client. If there is no client, there is nothing to draft. So you have to figure out how to acquire clients. This is not as easy as it sounds because of the large cost up front. It seems that most inventors do not have the capital to hire you and have no clue how the system works. But, there are clients out there. In my case, I have pulled from the relationships that I have had over the years.

I hope this helps.

If there are any questions, please feel free to contact me.

Gary F. Witting, Scottsdale, Arizona

I take it that you've not visited patents.com lately. Interesting way to deal with such an incredibly valuable domain name when a law firm breaks up.

James S. Tyre, Culver City, California

No, I haven't, until now. I guess it happens to the best of us. It'll be back. Carl and his ex- partner Marina have both been very helpful to me.

Carl has never been accused of being a web designer, either.

Mike Phillips

I'm not certain if "web designer" existed when Carl first registered the domain name. '-)

(I have some clients with older domain names, but I wouldn't be surprised if Carl was one of the very first attorneys to have a law firm web presence.)

James S. Tyre, Culver City, California

Here's something I did find on their new site that I find quite interesting. Carl is saying what many patent attorneys think but don't want to say for fear of losing business. We actually work with a lot of independent inventors.

"Information for individual inventors

"Oppedahl & Olson LLP does not encourage inquiries by individual inventors. Of the many individual inventors that our attorneys have served over the years, only a handful have ever made enough money from their inventions even to cover what we charged them. This does not mean the inventions were not good ones --- indeed we have seen some very clever and promising inventions from individual inventor clients, and we have obtained some patents for individual inventors of which we are very proud from a professional point of view. There is much in life, however, that depends on luck and being in the right place at the right time, with inventions as with anything else. For every deserving invention that makes money for its inventor, there are probably ninety-nine other very deserving inventions that happen not to fulfill their promise.

"When we do accept work from a new client, we ask to be paid in advance. We put the money into an escrow account, to be applied toward

later bills due. If the work we are asked to do does not use up the advance, we refund the balance. If the work we are asked to do goes beyond the amount of the advance, we expect to be paid for that additional work. Depending on the type of work and the technological area, the amount of the advance which we ask for may be anywhere from a thousand dollars to over ten thousand dollars.

"What should you do next?

"If you are thinking about patents, we suggest you purchase the book Patent It Yourself! from Amazon and read it. After reading it, you might want to try writing and filing your own patent application. Alternatively, if you do choose to hire a patent and trademark firm such as ours, you can do it while being a much more knowledgeable consumer of the services of the firm. In either case, the money spent to purchase the book and the time spent reading it will all be well spent.

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"If you are thinking about copyrights, we suggest you purchase the book The Copyright Handbook: How To Protect & Use Written Works from Amazon and read it. After reading it, you might want to try preparing and filing your own copyright application. Alternatively, if you do choose to hire a patent and trademark firm such as ours, you can do it while being a much more knowledgeable consumer of the services of the firm. In either case, the money spent to purchase the book and the time spent reading it will all be well spent.

"Keep in mind that reading this page, or buying these books, does not make you a client of our firm. If, despite what we have said here, you nonetheless wish to explore whether our firm can accept you as a client, you may contact us. We emphasize that in such a contact you must not reveal anything to us of a confidential nature. We could then do a conflict check to see whether we are aware of any conflict that would prevent us from accepting you as a client. Please do not, however, waste your time and ours with such an inquiry if you are not prepared to pay for the work and indeed to advance funds to us to pay for such work."

Mike Phillips

I haven't started studying yet, but the new PLI home study course (40 CDs with audio and video courses, huge book of practice questions and material, new MPEP) are sitting on the bookshelf and I'm starting on it after finals this semester (~May 15th) So I hope to do pass it as well. I can tell you that the new exam is computerized and that you no longer have access to any physical object other than the pencil and 2-3 scratch pieces

of paper they give you. In the past, the study courses recommended you spending ample time indexing and referencing your MPEP, but that's no longer an option, so you have to know more of it to pass. The MPEP is provided in searchable PDF format and you have to switch back and forth between it and the exam (can't look at both on the screen simultaneously.) A friend of mine just took it, and failed, this past October so he's spending more time studying for it to take again this summer as well. Good luck!

William Devine, II

You have been given good advice on the Patent Bar Exam, so I will just throw my two cents in on clients.

The struggle is getting what I call "pipeline" patent clients versus "single-shot" patent clients. Pipeline clients are corporate clients that have consistent or repeating needs for patents and trademarks. Single-shot patent clients are more likely to be the independent inventor who has a single need. Most likely they want a single patent application and maybe a single trademark application.

Pipeline clients are the hardest to get because they are the holy grail. As previously posted, a few pipeline clients will cover the overhead, plus some. With pipeline clients you don't need to be constantly marketing and bringing in new work-you simply service your client first.

It's a different story with single shot clients. They are one and done, so you must constantly be networking and marketing to first find a supply of inventors and then convince them to retain you. These types of clients are very inefficient because your ROI is so low.

W. Pete Reid, Charleston, South Carolina

I would like to take a second to thank everyone who responded on this issue. Your advice is well taken.

Tom Mattiacci

Ditto to the comments below - the patent bar is easier than other bars, it helps if you have some experience before you take it, if you can develop a client base, it can be a successful business. That being said, I would strongly encourage you to get some experience in a firm or at the USPTO before going out on your own. This is a specialized area and there are some nuances that are not intuitive and you will not necessarily learn on your own, unless you make a mistake.

Good luck to you.

Jaconda Wagner, South Orange, New Jersey

Mike, I have reserved wpetereid.com and am building my site and blog as we speak. I hope to have it finished soon, and plan on 'beta-ing' the site here, so to speak, for critique.

Thanks for the pointer to your site. I like to bookmark as many other solos that I can in case I need to refer something out or need local counsel.

Pete Reid.

Pete:

Do you have a web site? I'm at <http://www.millspatentlaw.com>.

Mike Phillips, Cary, North Carolina

I have taken the California bar, Connecticut bar, and the patent bar. The patent bar was by far the hardest for me.

Michael A. Blake, Milford, Connecticut

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