

American Chemical Society AMA: My Name is Bruce Winchell,
Patent Attorney, I focus on helping inventors obtain patents that
can be used to make money, AMA!

AmerChemSocietyAMA¹ and r/Science AMAs¹

¹Affiliation not available

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Hi Bruce. It seems that nearly everybody in technology is agreed that patent trolls are a serious problem to business. The constant threat of being sued for an obvious idea that was patented represents constant risk to every business. This particular risk can't really be planned for because timing, frequency, and magnitude are all unknown.

My question is: What are you specifically and others in your profession doing to fix the system and change laws to deal with these trolls? By and large, it seems to a bystander as though the patent attorneys have the most to gain by having the trolls around. Are you and your colleagues willing to go against your vested interests to fix the system?

[NoFunHere](#)

Hi. Good question. I as a patent attorney want to see our patent system meet the U.S. Constitutional requirement of Article 1, Section 8, Clause 8. "Congress shall have the power to promote the progress of science and the useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries. That said, the patent laws in the U.S. do that. The patent laws don't say that the only way you are allowed to profit from your invention is to make and sell products and services covered by the claims. I would not recommend that we take all other rights away from those who did obtain the patents. There are some intentional infringers out there. Microsoft lost many cases of patent infringement with the courts saying that the infringement was intentional and awarded a total of about \$9 Billion to the patentees. The Wall Street Journal published the 2013 list of Patent Troll Targets. 1. Apple, 2. Amazon, 3. AT&T, 4. Google, 5. Dell, 6. HTC, 7. Samsung, 8. Microsoft, 9. LG, and 10. HP. Notice that the patent trolls go after the money. Another publication of the list of top Patent Trolls included Apple, Motorola Mobility, Ericsson, and Pfizer. I think that the courts are generally handling this situation well. The lawyers don't have the authority to legislate and neither do the judges. The U.S. Constitution has set forth the responsibilities of each branch of government and I believe in the U.S. Constitution. That is kind of a long answer but I hope you will not be deterred from inventing or authoring by the patent troll stories which the media may have blown out of proportion.

Hi Bruce. You write in your bio that you have helped two large companies make billions with patents. How about those 972 small inventors? Did their patents make money for them, or were the valuable

ones squashed by large companies with in-house legal teams?

[49j](#)

Hi. I have helped an inventor get a patent that made him make many \$ Millions. The large companies are more focused on very large markets right from the start. If the inventor gets good protection, the in-house legal teams more often take a license because it is usually cheaper than litigation. The exception to this is if the CEO is emotional about the invention. In those cases the large legal team is just told to ignore economics and litigate. The Lawyers do not generally make the business decisions about which course to take.

This may be a little outside of your area of focus, but what can you tell us about where the line is drawn on concepts/ideas/objectst that are naturally occurring, versus ones that are patentable.

I am specifically thinking about cases like the [Myriad Genetics BRCA1 and BRCA2](#) case, or the [WARF Stem Cell Patents](#). Have there been any more recent developments from the USPTO or the Courts that give guidance on what they will allow or not allow? Where do you see it going in the future?

[kerovon](#)

Hi. The U.S. Supreme Court decision of June 13, 2013 in the AMP v. Myriad Genetics case was important to this area of technology. After this decision came out the USPTO gave advice to Examiners on how to examine these applications for patent. You can find them online at USPTO.gov where the advice was labeled as MPEP Section 2106. The short answer to your question found there is that: "Naturally occurring nucleic acids are not patent eligible. Examiners should reject product claims drawn solely to naturally occurring nucleic acids or fragments thereof, whether isolated or not, as being ineligible subject matter under 35 USC section 101. Claims clearly limited to non-naturally occurring nucleic acids, such as a cDNA or a nucleic acid in which the order of the naturally occurring nucleotides has been altered, remain eligible. Other claims, including method claims, that involve naturally occurring nucleic acids may give rise to eligibility issues and should be examined under the existing guidance in MPEP 2106, Patent Subject Matter Eligibility."

Hi Bruce. I'm another tech transfer person here in Europe. Why do you think so many US inventors don't file in the EU once they get to national phase? I'd very rarely not file in the US for a EP priority, but the other way around happens a lot. Is this a result of no grace period in EP, or inventors not thinking globally when planning commercialisation?

[Jimbo516](#)

Hi. I think it is a matter of costs. Because the U.S. offers an inventor filing as a Micro Entity for the first 4 patent applications, the inventor gets a 75% discount of all USPTO fees. EPO costs are very high compared to that. U.S. Inventors Micro Entities must have venture capital before they get to the national phase or they opt out.

Hi Bruce! Thanks for the AMA!

I used to work in technology transfer here in the UK, so I've interacted between inventors (mainly scientists) and patent lawyers. I've previously found that scientists with brilliant ideas, that could be patented and commercialised, often didn't want to do so without publishing findings and papers first; however they didn't fully comprehend that once their ideas and inventions were in the public domain they were much more difficult to protect.

Is this something that you've found to be the case in the US, or are scientists more commercially minded over there?

[OldBoltonian](#)

Hi This is a problem in the U.S. too. It occurs more often when U.S. Government money is involved in the research. Publishing before you file a patent application is a problem. Only two industrialized countries, the U.S. and Canada have grace periods that allow you to publish up to one year before you file. If you use the grace period approach you will be giving up all of the rest of the industrialized world that have an absolute novelty requirement. Therefore, I recommend filing an application in your home country before you do anything else if you want to have really effective patent protection. Publishing first can also help others find ways of patenting around you before you get your application on file which leads to bad commercial results in the market place.

What are your thoughts on the change from the "first to invent" to the "first to file" patent system in the U.S.?

[SirT6](#)

Hi. In the U.S. in 2011 before the first to file came into effect I found in researching the United States Patent Office records, that the first to file won the patent 99.98% of the time even under the first to invent system. Therefore, I do not consider that change to be the real issue with the new America Invents Act.

How do companies and organizations determine the value of a patent beyond just the dollar value of products directly patented? What metrics are used to differentiate "novel" from "oh-so novel"?

[nate](#)

Hi. Large companies begin these valuations as soon as an invention disclosure is written by the technical staff. They use extensive market research along with studies of recently issued patents and published applications of the competition. They come up with their best guesses to arrive at priorities for filing patent applications because most companies do not have the budget to file on everything that comes out of their research organizations. At the time as the patent has issued so that we now know how the allowed claims read, we compare that to what we are actually selling to arrive at the best valuation we can so the company can thereafter make the best business decisions that they can. The allowed claims are the key new part of the valuation of the issued patents because that was the negotiated part with the patent office examiners who picked to examine the application based on what technical expertise they have as it appears in the claims made for the invention. Thomas Edison was named inventor on 1093 patents that issued. In 1883 he was the inventor named on 106 patents in that one year. He was named inventor on about 200 patents on light bulbs. Not all of those were truly valuable but enough of them were valuable that we now know him as a terrific inventor. This concept also applies to large companies.

Perhaps not your specialty, but I'm curious about your thoughts on the length of protections. Right now, Patents last roughly 20 or 14 years depending on the type of patent. Copyrights, on the other hand, last 70 years after the author/designers death.

Do you think these long lengths of protection stymie or encourage innovation? What makes you believe this?

It seems like the argument typically is that "without these protections there's no incentive to innovate" but do you honestly believe that the determinants of artistry and innovation primarily include the ability to extract rents from these creations?

[apc0243](#)

Hi. I think that Copyrights may be too long. BUT, there should be something to help Congress to promote the progress of science and the useful arts. We have done this since the writing of the U.S. Constitution and it has worked in my opinion. The U.S. is one of the most advanced countries in the world.

If you have taught Intellectual Property Strategies for Technical Professionals and Writing Your Own Patent Applications many times, could they be made available on-line for free for everyone?

[Mkhbrt](#)

Hi. I have been asked this question many times. The problem is that as fast as I teach one class the materials become out dated by the court decisions that are occurring on a daily basis. I have to rewrite the materials for each class.

Do you think patent attorneys generally have an ethical or moral obligation to turn away clients with lousy or sham ideas? if so, do you think patent attorneys generally do this?

[jR2wtn2KrBt](#)

Hi. Patent Attorneys and Patent Agents have an ethical obligation to help the client to put forth the best arguments that they can for patentability. We do also advise clients that it may not be worth trying to get a patent if we see that the subject matter does not meet the legal requirements of the law or USPTO rules.

At what point is there a difference between a new process and an invention that is patentable? The process is not obvious, but each step is not original either. The combination of steps leads to an improved outcome that is not in the market. Is this more of a trade secret than a patent?

[metahivemind](#)

Hi. This very specific question should be taken to your lawyer but see: KSR v. Teleflex, U.S. Supreme Court, 2007 decision which said in part that: a patent claim for a new combination which only unites old elements with no change in their respective functions, is obvious under 35 USC Section 103.

We had a patented concept stolen and used by a state highway department. After paying the patent maintenance fees for years, our patent attorney told us we could do nothing unless we had the money to protect our patent. Are patents by small inventors like us worthless against government agencies and wealthy entities?

[rkim777](#)

Hi. No, your patent is not worthless, but if you cannot negotiate a deal then maybe you have to go to court which is very expensive. Try to negotiate a deal.

Hi Bruce! I am currently an engineering student and had a patent attorney do a presentation in one of my classes. I thought it was a pretty interesting field and something I would enjoy doing. What steps would you recommend I take if I wanted to learn more about being a patent agent/patent attorney?

[clever_something](#)

Hi. I recommend that you get the engineering degree first. Then you qualify to sit for the US Patent Bar Exam. Several of my friends did that and after practicing as a Patent Agent, they then went to law school to get the J.D. needed to sit for State Bar Exams. I wish you the best.

Hi Bruce, I really appreciate you doing this as I am interested in going into the Intellectual property Field once I graduate.

I was wondering if you needed to have a science background to become a patent attorney in Canada and also what were some of the tell us some of the most interesting patents that you've ever helped a client acquire.

Thanks Alot!

[4ceTheAznlvazn](#)

Hi. All of the patent offices require technical backgrounds. How much is different in different jurisdictions.

Hi Bruce, and thank you for doing this AMA.

My question to you is, how do you respond to the accusation that the patent industry is a parasite that feeds of the work of the many to profit the few? I understand the arguments for patents, and have answered them all in depth in articles [such as this one](#).

There is no data to show that patents promote innovation in any sense, and significant data to show the reverse, stretching back to the industrial revolution and Watts' patents on the steam engine. In my own industry, software, we see patents as a tool for extortion and cartels.

So clearly individual patent holders *do* benefit, yet the cost is borne by society at large, is it not? How do you feel about being a part of such a system, that takes from the many to give to the few?

[pieterh](#)

Hi. Unfortunately only a very few patents that issued actually make money. Patent Professionals try to help inventors file applications and get patents to issue. We never promise that the patents will make money. We don't have any better crystal ball than anyone else about making money.

What is your stance on having patents on GMOs? If a company modifies a seed to the point that it makes non-modified seeds obsolete, or non-competitive, should they have the right to charge whatever they want to farmers for their modified seeds because they own them?

I could go on, but I think you know what I am getting at. Thanks for doing the AMA.

[ProbablyHighAsShit](#)

Hi. If the subject matter is patentable they can charge what they want for 20 years from the filing date of the patent application, if the claims cover what they are selling.

