

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





USPTO Office of Innovation Development

Patent Overview

Zandra V. Smith
Pro Se Assistance Center Coordinator

UNITED STATES
PATENT AND TRADEMARK OFFICE

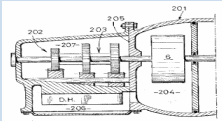








Objectives

- Overview of Intellectual Property (IP)
- Process of Filing a Patent Application
- Resources

Overview of Intellectual Property

	<u>Utility/Plant Patent</u>	<u>Design Patent</u>	<u>Trade Secrets</u>	<u>Copyrights</u>	<u>Trademarks</u>
What is protected	Inventions – Process, machine, manufacture, or composition of matter	Ornamental characteristics embodied in, or applied to, an article of manufacture	Commercially valuable information (e.g., formulas, techniques, processes)	Art, in an all-encompassing sense – original works fixed in a tangible medium	Marks in commerce that indicate the source or origin of goods or services
Protects Against...	Making, using, selling, offering for sale, and importing into the U.S.	Making, using, selling, offering for sale, and importing into the U.S.	Stealing or unauthorized disclosure	Copying, performing, displaying, and creating derivative works	Using a mark in a way that causes likelihood of confusion
Endures until...	Generally, from the patent grant date to 20 years from the earliest effective U.S. filing date	15 years from issuance of patent for applications filed on or after May 13, 2015	Publicly disclosed	The life of the author + 70 years	Abandoned or loss of distinctiveness or secondary meaning
Rights of Independent Third Party Creators	None	None	Full	Full	None
Examples			Coca Cola formula 		



Overview of IP: Types

- **Trademarks**
 - Protects marks in commerce that indicate the source or origin of goods or services
 - Source: Federal, State, and Common Law
- **Copyrights**
 - Protects original (art) works fixed in a tangible medium
 - Source: U.S. Const., Art. I, Sec. 8
- **Trade Secrets**
 - Protects commercially valuable information
 - Source: State and Common law
- **Patents**
 - Protects inventions
 - Source: U.S. Const., Art. I, Sec. 8

Overview of IP: Trademarks

- Key Purposes:
 - Allow consumers to identify the source or producer of different products and services – helps their buying decisions
 - Encourage trademark owners to provide goods and services of consistent quality and to build goodwill in the trademark



Federally Registered Trademarks

- Right to enforce nationally and bring legal action in federal courts
- Use of federal Trademark registration symbol ®
- Right to record mark with Customs
- Serve as basis for foreign filing
- Publication in U.S. Trademark database

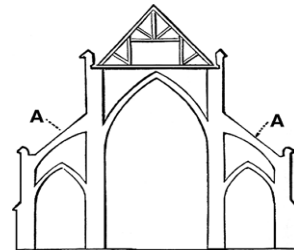
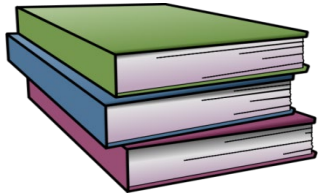


[guess
the mark](#)



Overview of IP: Copyright

- Protects “original works of authorship” including literary, dramatic, musical, artistic and other works fixed in a tangible medium
- Library of Congress administers registration; USPTO advises the Executive branch on intellectual property issues including copyright
- © symbol can be used without registration





Copyright Registration

- Copyright protection is secured **automatically** upon creation (fixation)
 - A work is “created” when it is fixed in a copy for the first time
- No publication or registration is required
 - There are, however, advantages to registration



Overview of IP: Trade Secrets



- Any information that derives economic value from not being generally known or ascertainable
- Can be formulas, patterns, compilations, programs, devices, methods, techniques or processes
- Protection stems from common law dating to the 1800's
- All states have some sort of trade secret protection
- Most laws based on the Uniform Trade Secrets Act
- In 2014 Congress considered, but did not pass, federal versions of the UTSA



Why are Trade Secrets useful?

- Protects commercially valuable proprietary information, e.g., formulas, recipes, or business information that gives a competitive advantage
 - Customer lists
 - Product formulations
 - Search algorithms
- Trade Secrets are not generally known and must be subject to reasonable efforts to preserve confidentiality
- No set term for protection



How to Lose a Trade Secret?

- Failure to take adequate steps to prevent disclosure
- Owner or owner-authorized disclosure
- Reverse engineering
- Independent development



Overview of IP: A Mobile Phone

Trademarks:

- Made by "Apple" (logo)
- Product "iPhone"
- Software "iOS", "Safari"

Patents:

- Semiconductor circuits
- Touch Screen
- Battery/Power Control
- Antenna
- Speaker
- Device Housing

Copyrights:

- Software code
- Instruction manual
- Ringtone

Trade secrets:

- ???

Designs (some of them patented):

- Form of overall phone
- Placement of button & speaker
- Color pattern of trim
- Surface finish



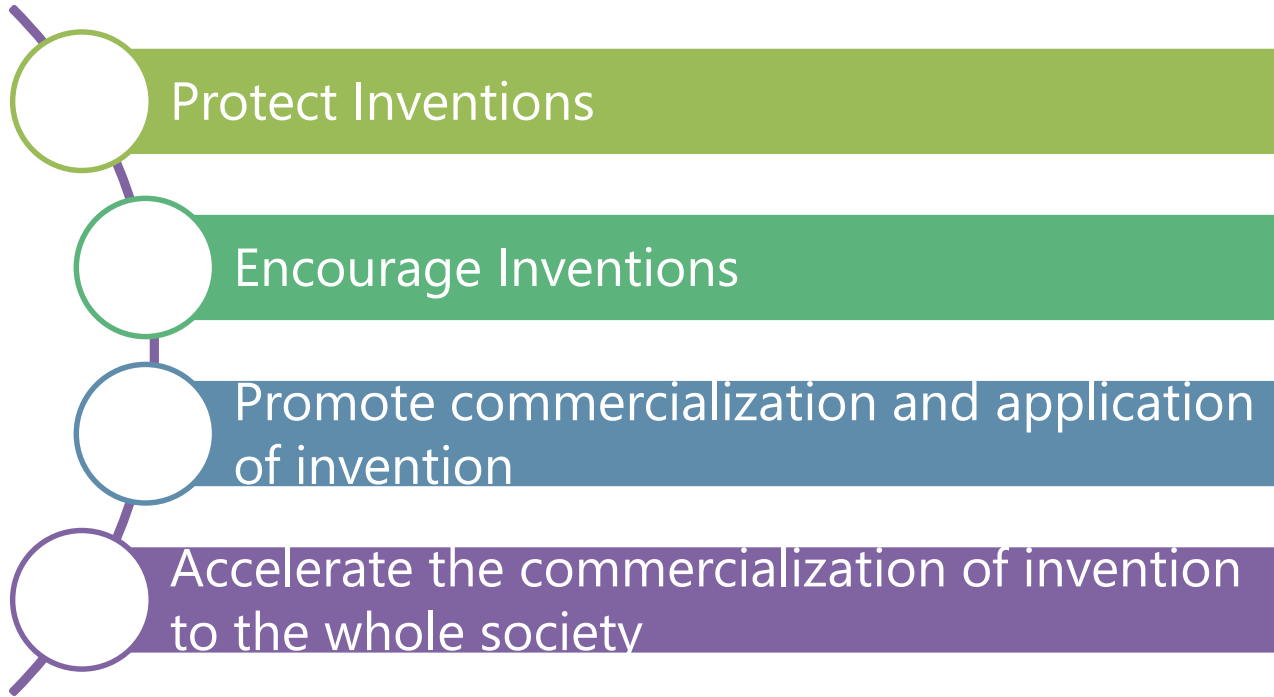
© Apple

Overview of IP: What is a Patent?

- A Property Right
 - Right to ***exclude others*** from making, using, selling, offering for sale or importing the claimed invention
 - Limited term
 - Territorial: protection only in territory that granted patent; **NO world-wide patent**
- Government grants the property right in exchange for the disclosure of the invention



The Role of the Patent System



Why get a Patent?

- A patent can:
 - Help to gain entry into, and deter others from entering into, a market
 - Attract investors
 - Be used as a marketing tool to promote unique aspects of a product
 - Be asserted against an infringer
 - Be used as collateral to obtain funding and increase leveraging power
 - Create revenue – sell or license like other property
- **Patents are a form of property that can add value to a company's assets**

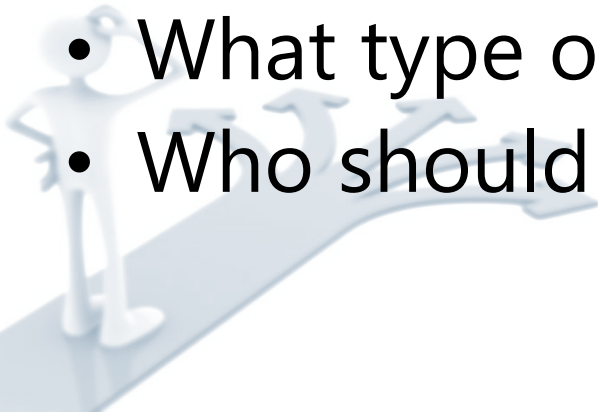


What happens after I get my patent?

- Licensing
- Enforcement
- More innovation and competition
- Etc...

Pre-filing Decisions

- Should I file an application?
 - Prior art search
 - Business plan – who will buy the invention?
- When should I file?
- Where should I file?
- What type of application(s) to file?
- Who should prepare the application(s)?





Provisional Utility Applications

- A low-cost way to establish an early effective filing date (priority date) with fewer formalities
- A provisional application does **NOT** issue as a patent, but a later-filed regular application may issue as a patent and benefit from the provisional application filing date
- 12 month window to file corresponding **utility patent application** in order to benefit from the priority date of the provisional application
- Provisional application is **abandoned automatically** at 12 months and is **not examined**



Provisional Utility Applications

Additional benefits of Provisional Applications:

- Patent term measured from filing date of subsequent **non-provisional** application
 - Patent term is currently 20 years from the date of filing
 - Provides up to an additional 12 months of protection on your invention based on filing of the non-provisional.
- Term **patent pending** allowed to be applied
 - Inventors may use term during time period after patent application (Provisional, Non-Provisional, Design, or Plant) has been filed, but before patent has issued



Provisional Utility Applications (MPEP 201.04(b))

- Low cost submission to establish filing date
 - \$140 small entity
 - \$70 micro entity
- For micro entity status, each inventor (and any assignee-applicant) certifies that he/she:
 - Qualifies as a small entity (less than 500 employees);
 - Has not been named as an inventor on more than 4 previously filed patent applications;
 - Did not, in calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding 3 times median household income; and
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in calendar year preceding the calendar year in which applicable fee is paid, had a gross income exceeding 3 times the median household income.

Provisional Utility Applications

(MPEP 201.04(b))

- Automatic abandonment after one year
- Inventor given time to investigate market potential / **make improvements**
 - Be careful - too much change could result in loss of provisional filing date
 - Many inventors file multiple provisional applications during the 1-year pendency of the first filed provisional to include improvements
- Also provide time to obtain counsel if desired
- **No patent issues**—not examined

Provisional Utility Applications

- Simplified filing requirements
- Items required:
 1. Specification - CLEAR DESCRIPTION - in compliance with 35 USC 112, Paragraph (a)
 - enablement, written description, best mode
 2. Drawings (needed in almost all cases)
 3. Filing fees
 4. Cover Sheet identifying Provisional Application



Provisional Utility Applications

Use of USPTO cover sheet [PTO/SB/16] encouraged:
Provides a clear indication that applicant is filing a provisional application.

- Inventor name(s)
- Inventor residence(s)
- Title of the invention
- Correspondence address
- Attorney information (if any)
- U.S. government interest (if any)

Where do you go from here?

Provisional Applications – As Basis for Priority

- Domestic Priority
 - For non-provisional applications
- Foreign Priority
 - Foreign Applications can claim benefit of Provisional Application filing date if filed within 12 months of the Provisional filing date under **Paris Convention Article 4**
 - **Patent Cooperation Treaty** (PCT) application can claim priority to US Provisional Application

Micro Entity Status (Gross Income Basis)

To qualify for micro entity status on the gross income basis, the applicant must comply with the:

1. Small entity requirement
2. Application filing limit
3. Gross income limit on applicants and inventors
4. Gross income limit on parties with an ownership interest

Use form PTO/SB/15A to certify status: <http://www.uspto.gov/sites/default/files/forms/sb0015a.pdf>

Patent Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses.
 - The America Invents Act calls on the USPTO to work with and support IP law associations to establish patent pro bono programs.
 - “pro bono” means that **patent practitioners volunteer their legal services**.
 - Inventors are still responsible for *all USPTO fees* (discounts may be available) and other potential fees, such as drawings.
- The Program is available in every state through 23 regional programs.
- Each regional program endeavors to match inventors and small businesses who apply with volunteer patent practitioners to file and prosecute patent applications.

General Criteria for Inventors

- **Gross household income** – regional program dependent, but usually limited to 300% of the federal poverty guidelines.
 - A single person could have an income of up to \$36,420 (<https://aspe.hhs.gov/poverty-guidelines>).
 - The limit increases with additional dependents.
- **Knowledge of the patent system**
 - Have at least a provisional application on file with the USPTO *and/or* successfully complete the certificate training course at <http://www.uspto.gov/video/cbt/certpck/index.htm>.
- **Have an invention**, not merely an idea.
 - To demonstrate that there is an invention one should be able to describe the invention so that someone could make and use the invention (“reduction to practice”).
- *Pay all USPTO fees* (discounts may be available).

The Law School Clinic Certification Program: Another Option for Pro Bono Assistance

- Permits law school students enrolled in a participating law school's clinic to practice patent and/or trademark law before the USPTO,
- under the guidance and supervision of an approved Faculty Clinic Supervisor,
- while providing their legal services *pro bono* (free) to Inventors/Applicants.
- Inventors/Applicants are responsible for USPTO filing fees and costs.
- See <http://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1>

Office of Innovation Development

- In Person Assistance (by appointment) for Pro Se Applicants
- Assistance Hotline 1-866-767-3848
- Patent Email Support innovationdevelopment@uspto.gov
- PTRC Partnership for Patent Education Courses
 - Virtual Assistance Pilot Program
- Inventor Outreach
 - Independent Inventor Conferences
 - Education for Inventor Organizations
- <http://www.uspto.gov/inventors>



UNITED STATES
PATENT AND TRADEMARK OFFICE

Thank You!

Office of Innovation Development
innovationdevelopment@uspto.gov



