

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board

Inventor Hour: Episode 19

John Schneider, Administrative Patent Judge

Cynthia Hardman, Administrative Patent Judge

Robert Silverman, Administrative Patent Judge

LiLan Ren, Administrative Patent Judge

Lynne Browne, Administrative Patent Judge

Special guests:

Deborah Stephens, Deputy Chief Information Officer

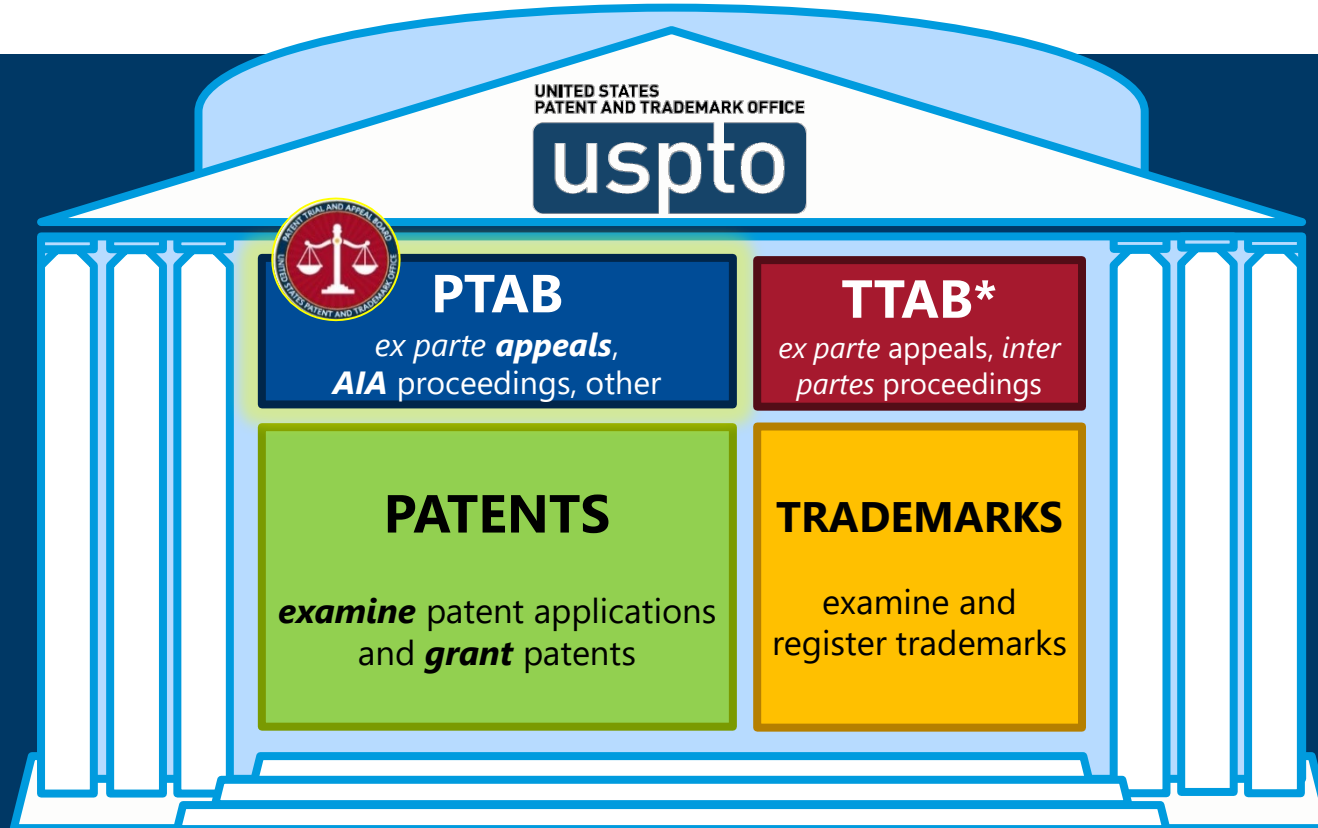
Mariessa Terrell, Attorney Advisor for Trademarks Customer Outreach

June 22, 2023



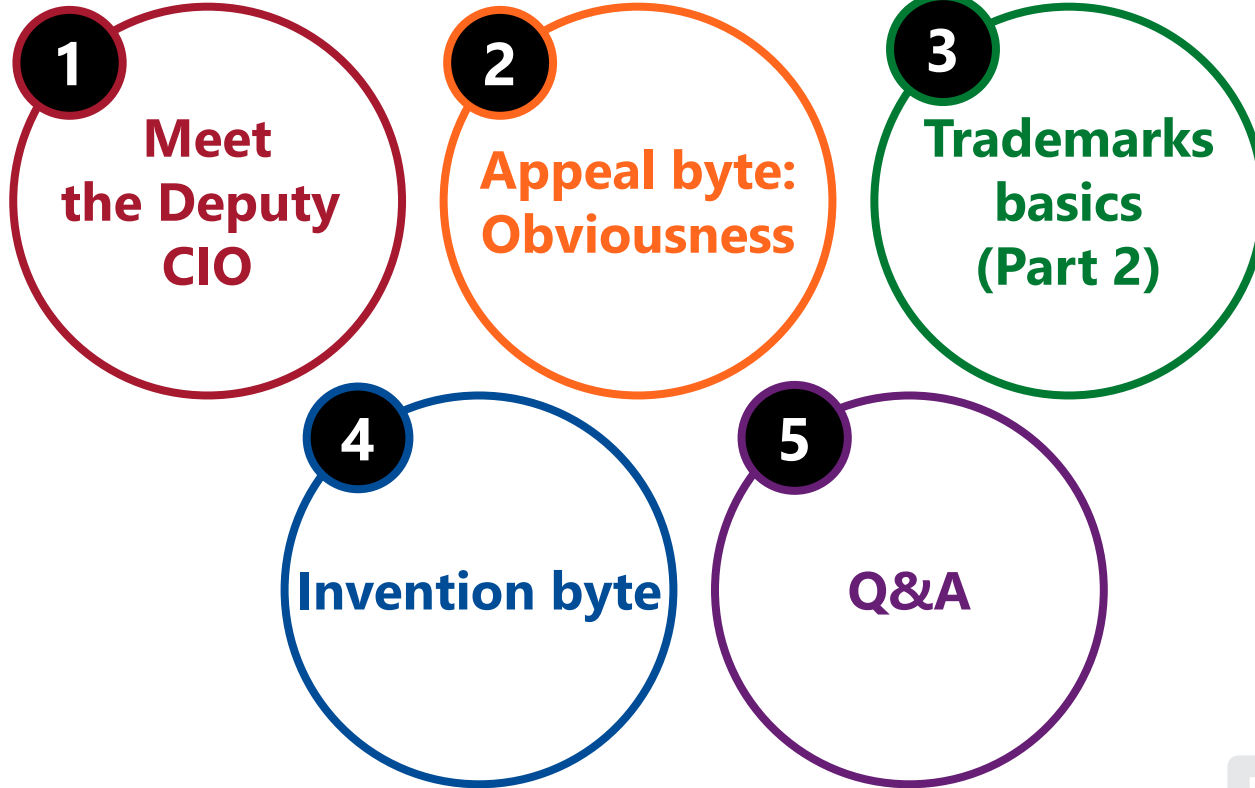
UNITED STATES
PATENT AND TRADEMARK OFFICE ®

What is the Patent Trial and Appeal Board?



*Trademark Trial and Appeal Board (TTAB)

Today's agenda



Question/comment submission

To send in questions or comments about the presentation, please email:

- PTABInventorHour@uspto.gov





Meet the Deputy CIO

Deborah Stephens



Deborah Stephens
Deputy Chief Information Officer

Question/comment submission

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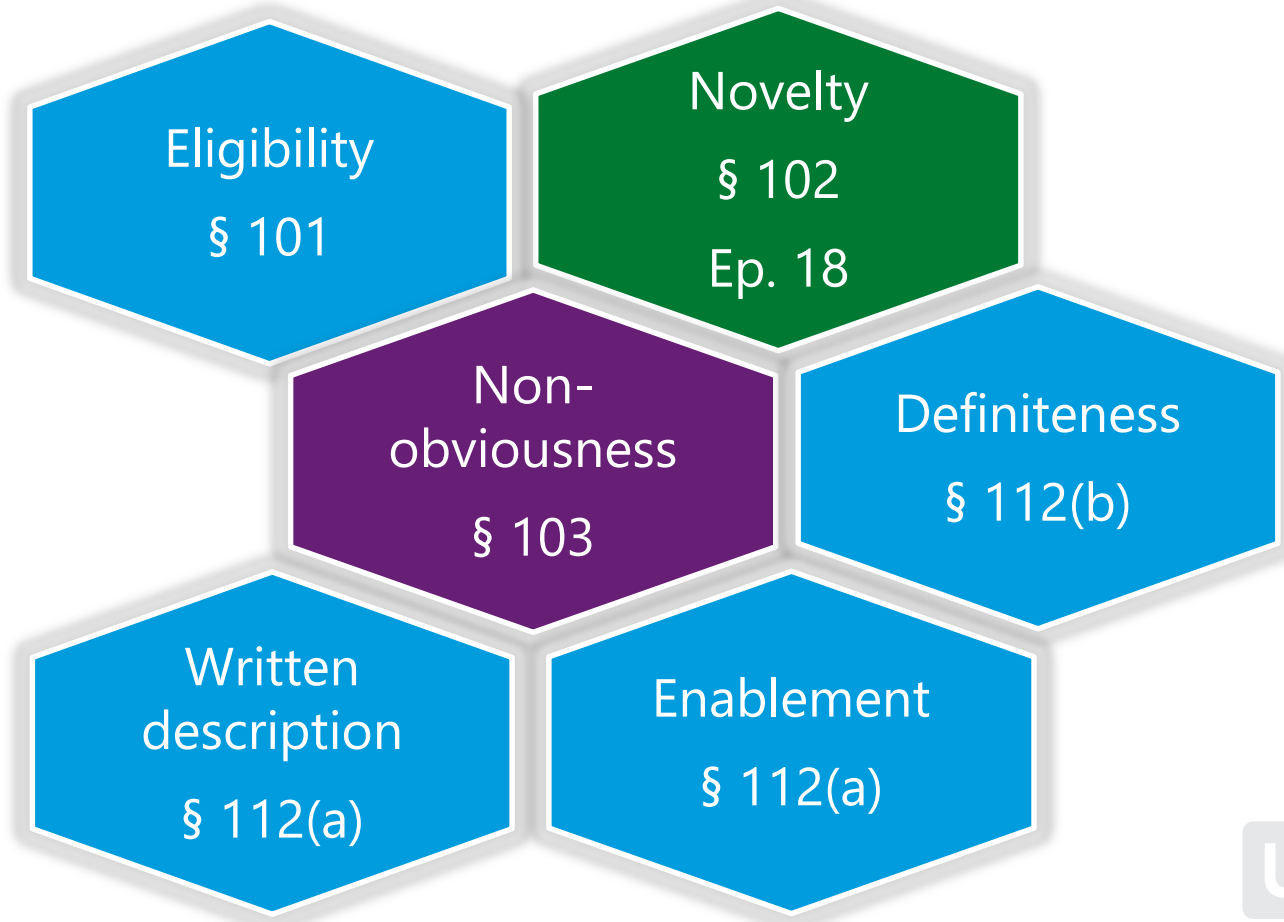
- PTABInventorHour@uspto.gov

Cynthia Hardman, Administrative Patent Judge



Appeal byte: **What is obviousness?**

Patentability: Statutory requirements



Non-obviousness

§ 103

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been **obvious** before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

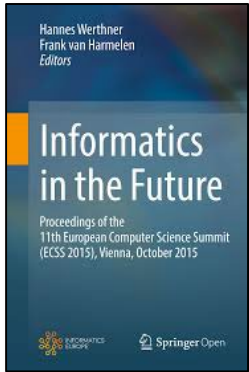
35 U.S.C. § 103.



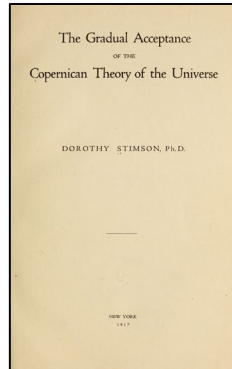
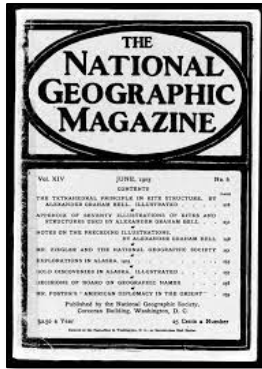
Compare with prior art

treatises

patents



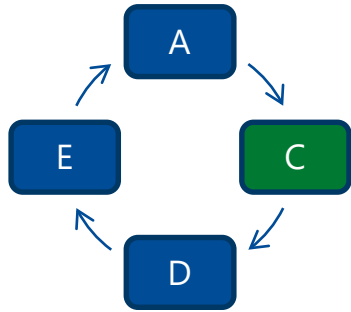
articles



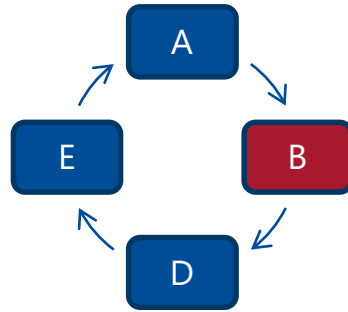
advertising/sales



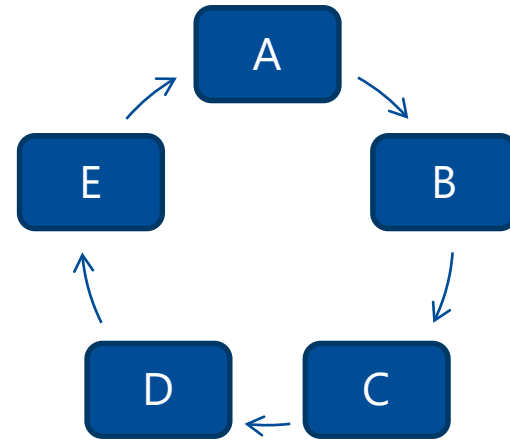
Differences from prior art



Prior art 1



Prior art 2



Invention

Ordinary skill

In determining the level of ordinary skill, various factors may be considered, including:

- (1) the educational level of the inventor;
- (2) type of problems encountered in the art;
- (3) prior art solutions to those problems;
- (4) rapidity with which innovations are made;
- (5) sophistication of the technology; and
- (6) educational level of active workers in the field.

Daiichi Sankyo Co. v. Apotex, Inc., 501 F.3d 1254, 1256 (Fed. Cir. 2007).



Example obviousness rationales

- (A) **Combining** prior art elements according to **known methods** to yield predictable results;
- (B) **Simple substitution** of one known element for another to obtain predictable results;
- (C) Use of known technique to **improve similar devices** (methods, or products) **in the same way**;
- (D) Applying a **known technique** to a known device (method, or product) ready for improvement to yield **predictable results**;
- (E) **“Obvious to try”** – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on **design incentives or other market forces** if the variations are predictable to one of ordinary skill in the art;
- (G) Some **teaching, suggestion, or motivation** in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Obviousness rationales

(B) Simple substitution of one known element for another to obtain predictable results

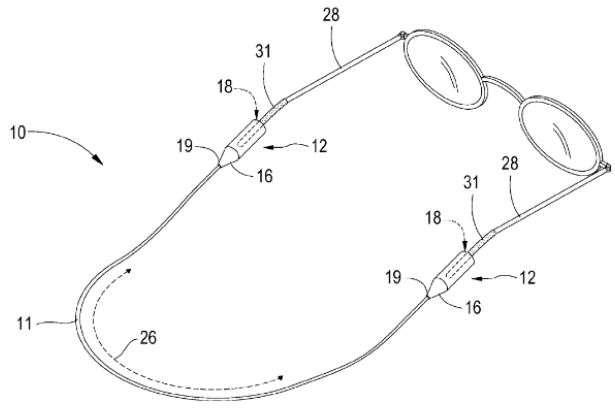


FIG. 4

Invention: eyewear retention device with temple retainers connected by cable around wearer's head



Prior art A - depiction of prior art glasses held by monofilament tied with dental floss.

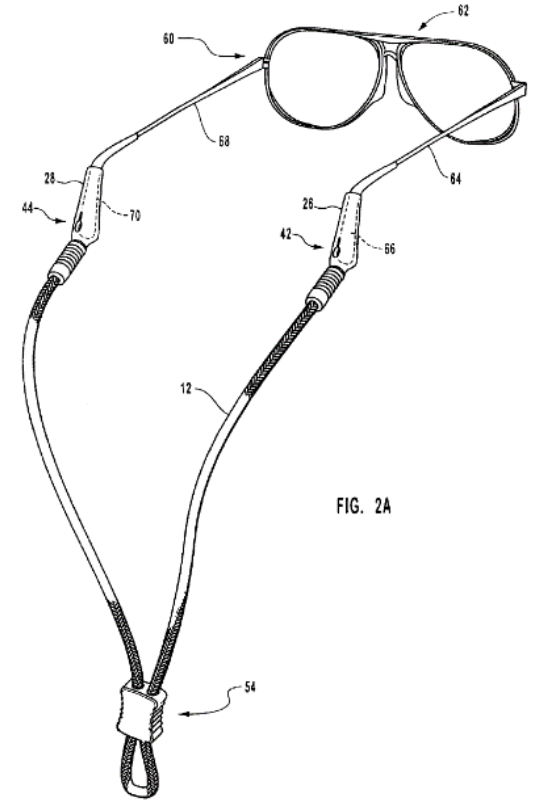


FIG. 2A

Prior art B – substitute attachment mechanism for that of Prior art A.

Example rebuttal arguments

- Element missing from prior art
- Art is not analogous
- No reason to combine references
- Unpredictability
- Art teaches away from invention
- Hindsight
- Secondary considerations



Example

Teaching away: A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

[In re Gurley, 27 F.3d 551, 553 \(Fed.Cir.1994\).](#)



Teaching
away



uspto®

Question/comment submission

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- PTABInventorHour@uspto.gov



Intellectual property basics and helpful resources sessions



Unfamiliar with **patents**, **trademarks**, **copyrights**, and **trade secrets**? Don't miss this opportunity to learn from USPTO experts about intellectual property (IP) basics and potential ways to protect your innovation as you transition from idea to product. The discussion will cover:

- An overview of patents, trademarks, copyrights, and trade secrets
- Why innovators and entrepreneurs should consider protecting their IP
- Local resources and assistance available through the USPTO and other agencies

Multiple online sessions

- July 6, 2023 at 12 p.m. – 1:30 p.m. ET
- August 3, 2023 at 12 p.m. – 1:30 p.m. ET
- September 7, 2023 at 12 p.m. – 1:30 p.m. ET

For more information, go to:

www.uspto.gov/about-us/events/intellectual-property-basics-and-helpful-resources-18



Mariessa Terrell, Attorney Advisor for Trademarks Customer Outreach



Trademarks basics

Part 2

Discussion topics

- Trademarks fundamentals
- Selecting a strong trademark
- Filing and registration
- How to find help

Discussion topic

Trademarks fundamentals

What is a trademark?



Coca-Cola



amazon

Google



 Microsoft



uspto[®]

What does a trademark do?

- Trademark
 - Identifies the source of goods and services.
 - Distinguishes them from the goods and services of another party.
 - Provides legal protection for a brand.

What does a trademark not do?

- Trademark
 - Does **not** mean you legally own a word or phrase.
 - Does **not** mean you can stop other people from saying a word or phrase.
 - Does **not** mean people owe you money if they saying a word or phrase.

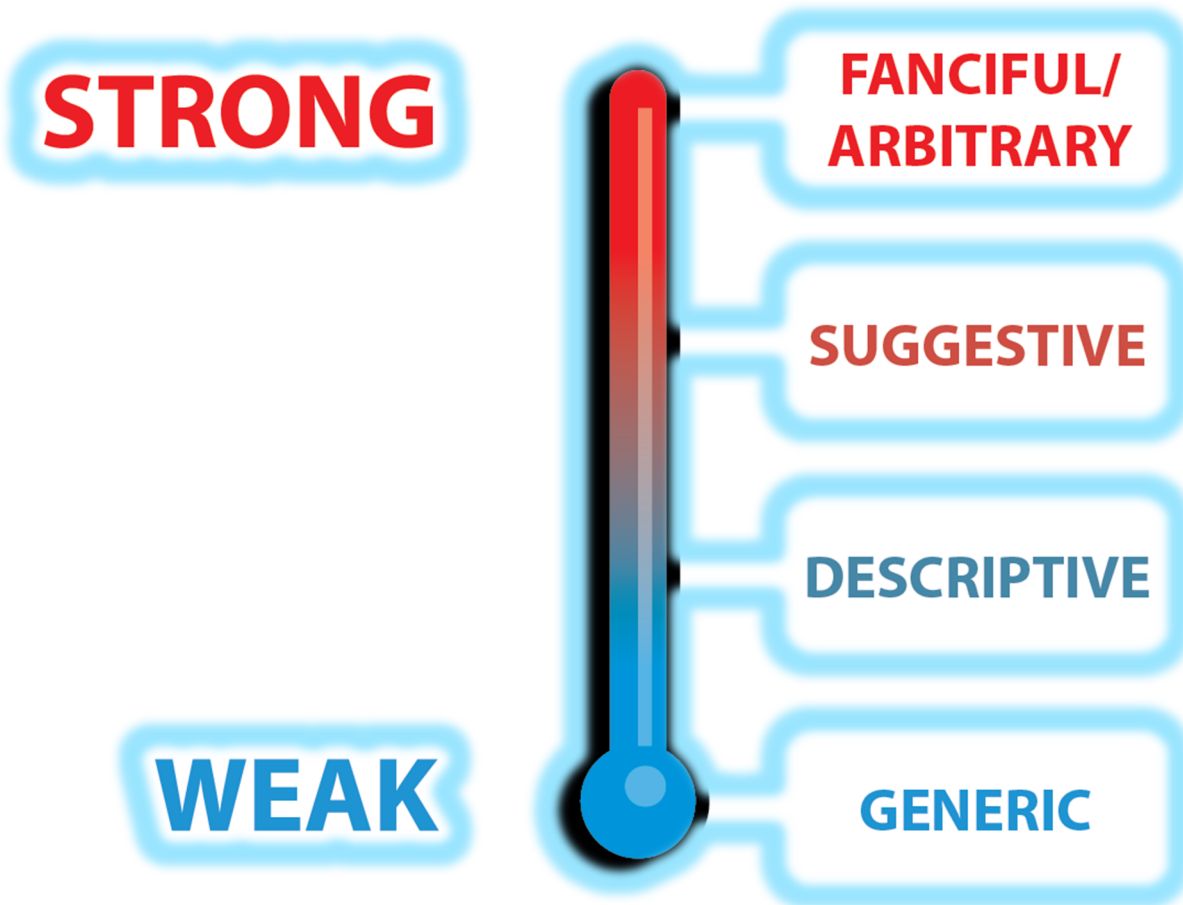
Discussion topic

Selecting a trademark: Strength of the trademark

Strength of trademark

- **Concept:**
 - Avoid using trademarks that fail to indicate the source of goods and services.
- **Test:**
 - Does the trademark merely describe the goods and services?

Strength of trademark



Strength of trademark examples

- **Generic terms**
 - Common, everyday name for the good or service
 - Unregistrable
- **Example**
 - MILK for “dairy-based beverage”

Strength of trademark examples

- **Descriptive trademarks**
 - Directly describe something about the goods and services
 - Unregistrable on the Principal Register
 - Except with showing of acquired distinctiveness
- **Example**
 - CREAMY WHIP for “whipped topping”

Strength of trademark examples

- Suggestive trademarks
 - Suggest a quality of the goods and services
 - Registrable
- Example
 - COPPERTONE for “suntan lotion”

Strength of trademark examples

- Fanciful trademarks
 - Invented words with no meaning in any language
 - Registrable
- Example
 - XEROX for “photocopiers”

Strength of trademark examples

- Arbitrary trademarks
 - Actual words, but no association with the goods and services
 - Registrable
- Example
 - APPLE for “computers”

Knowledge check

Which is registrable?

BICYCLE

for

bicycles

BICYCLE

for

playing cards



Discussion topic

Filing and registration

Filing for federal registration

Trademark registration process



Filing for federal registration

- Use the Trademark Electronic Application System (TEAS).
 - TEAS filing options
 - TEAS Plus: \$250 per international class
 - TEAS Standard: \$350 per international class
 - Total fee determined by how many classes you include in the application



Filing for federal registration

- Application requirements
 - Clear **drawing** of the trademark
 - Listing of the **goods and services** used with the trademark
 - Application **filing basis** for each good or service
 - **Contact information** for the trademark owner
 - Filing **fee**



Filing for federal registration

- Common bases for refusal
 - Likelihood of confusion
 - Merely descriptive
 - Geographically descriptive of the origin of the goods/services
 - Specimen does not support use for listed items
 - Trademark used in ornamental manner

Registration responsibilities

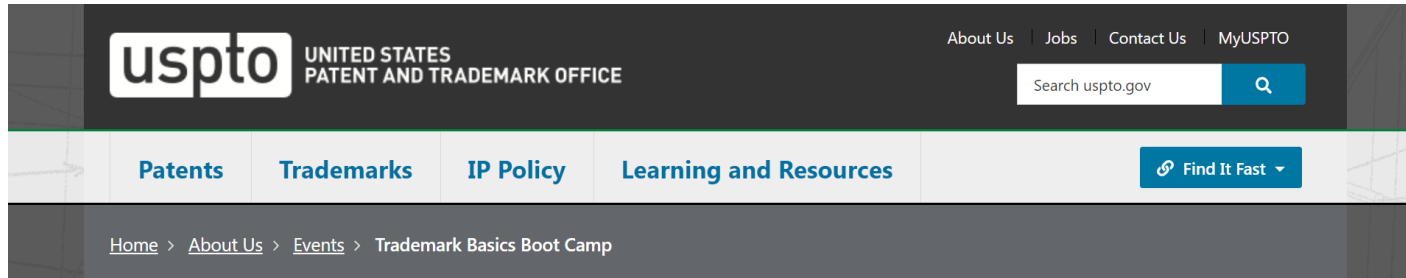
- Must enforce your own trademark rights.
 - May use your registration certificate to support a “cease-and-desist” letter.
 - May use your registration to sue an infringing user.
- Must file required post-registration documents with the USPTO.



Discussion topic

How to find help

USPTO resources



Trademark Basics Boot Camp

This free USPTO event series provides a comprehensive overview of the process for federal trademark registration and maintaining a federal trademark. If you're a small business owner or entrepreneur seeking to protect your brand and product identities, Trademark Basics Boot Camp is for you.

Trademark Basics Boot Camp is offered regularly throughout the year. During each series run, we cover one module weekly for eight weeks, with each module focusing on different aspects of trademarks and the registration process, from filing and examination to post-registration requirements for keeping your registration alive. Each module concludes with a question-and-answer period where you can ask our USPTO trademark experts questions.

You can attend the entire series or just the modules that best match your interests, but you must sign up for each module to attend. If you attend all eight modules, you can request a certificate of attendance. To learn more and sign up, select an individual module from the listing below.



USPTO resources

- Trademark Assistance Center
 - Phone: 1-800-786-9199
 - Email: TrademarkAssistanceCenter@uspto.gov
 - Web: www.uspto.gov/TrademarkAssistance
- USPTO trademark alerts
 - Subscribe: www.uspto.gov/subscribe



Question/comment submission

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Successful Inventing Series: Preliminary Marketing & Advertising



- **Wednesday, July 19, 2023, 4-5:30 p.m. PT**
- Topics include:
 - Finding customers
 - Distribution
 - Advertising
- Register at www.uspto.gov/about-us/events/successful-inventing-product-development
- The Successful Inventing Series are monthly presentations that cover various aspects of the invention process, presented by the USPTO and the Silicon Valley Chapter of the Licensing Executive Society.

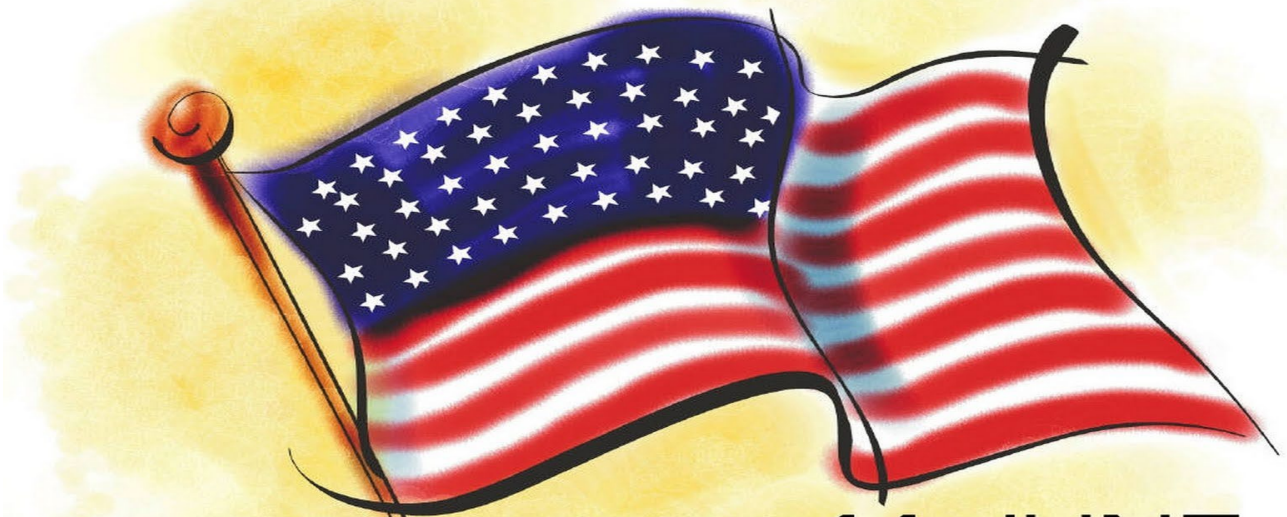
Lynne Browne, Administrative Patent Judge



Invention Byte

And the Invention Is . . .





14 JUNE
FLAG DAY



To properly display our country's flag, Gordon McLellan and Diane G. Wright invented

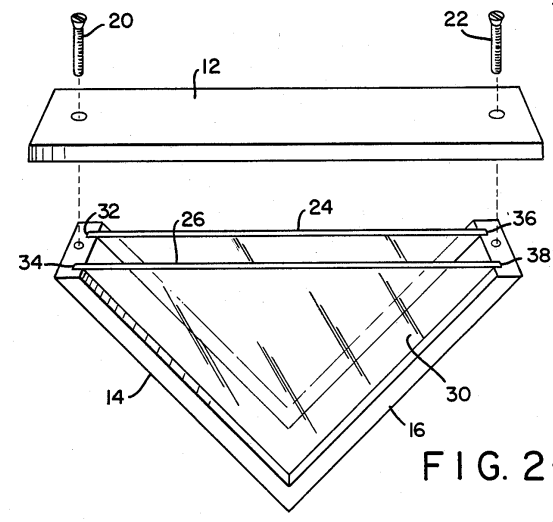
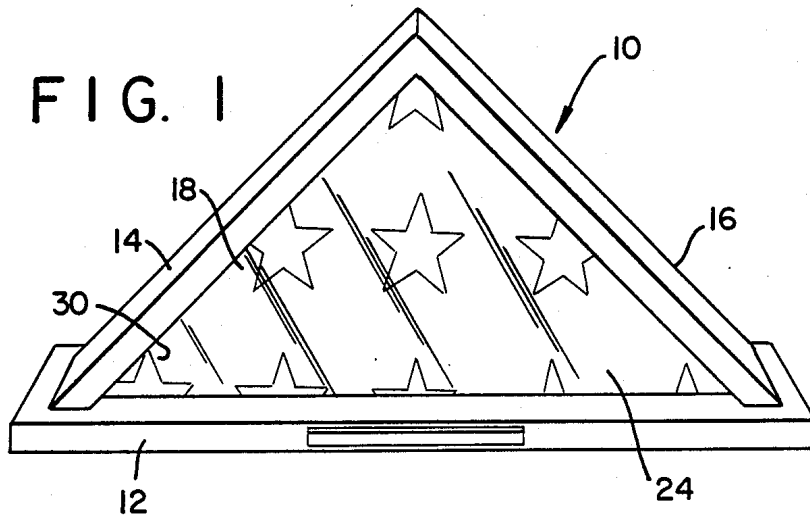
- A. A memorial flag display and storage case
- B. A rotating flag pole
- C. A customizable light-up banner
- D. None of the above

To properly display our country's flag, Gordon McLellan and Diane G. Wright invented

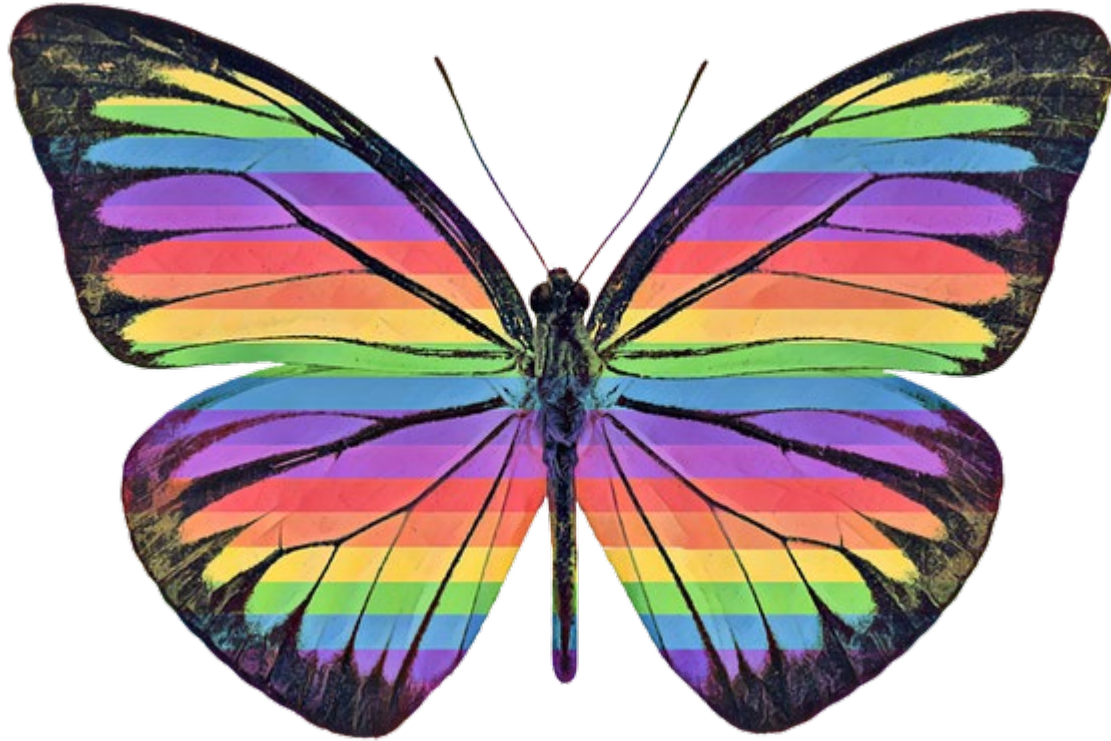
- A. A memorial flag display and storage case**
- B. A rotating flag pole
- C. A customizable light-up banner
- D. None of the above

US Patent 4,879,145

For a Memorial Flag Display and Storage Case



June is Pride Month



Currently the CEO of the non-profit organization Candid, technology expert and patent holder, Ann Mei Chang, also worked for which three of these technology giants?

- A. Meta
- B. Apple
- C. Google
- D. Intuit

Currently the CEO of the non-profit organization Candid, technology expert and patent holder, Ann Mei Chang, also worked for which three of these technology giants?

- A. Meta
- B. Apple**
- C. Google**
- D. Intuit**

US Patent 8,261,258: Common Installer Client

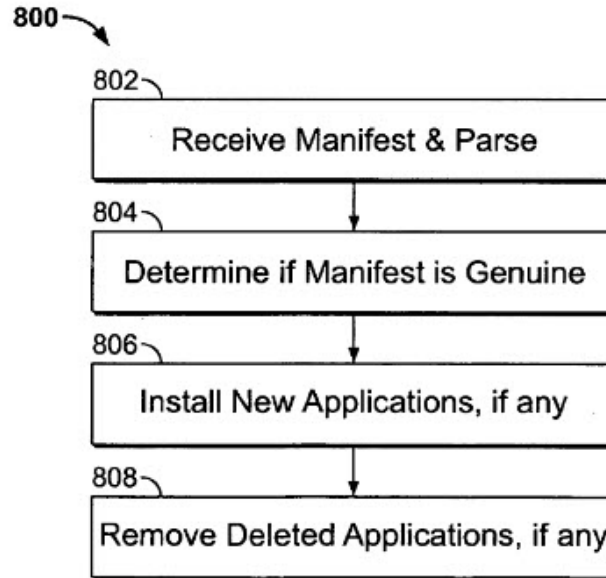


FIG. 8



Homemade Ice Cream

Who invented the first hand-cranked ice cream freezer?

- A. Dolly Madison
- B. Nancy Johnson
- C. William Breyer
- D. None of the above



Homemade Ice Cream

Who invented the first hand-cranked ice cream freezer?

- A. Dolly Madison
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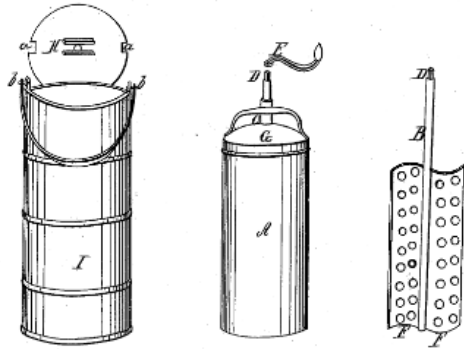


US Patent 3,254

N. M. JOHNSON.
ARTIFICIAL FREEZER.

No. 3,254.

Patented Sept. 9, 1843.



Nancy Johnson

Patent Pro Bono Program: Request for comment



- The USPTO seeks public comments about the functioning of the Patent Pro Bono Program (www.uspto.gov/patentprobono) and PTAB Pro Bono Program (www.uspto.gov/ptabprobono).
- Commenters are welcome to respond to a number of questions listed in the Federal Register at 88 FR 22012, which can be found here:
www.federalregister.gov/documents/2023/04/12/2023-07699/study-of-the-patent-pro-bono-programs-notice-of-public-listening-sessions-and-request-for-comments
- Comments may be submitted until July 11, 2023.





Future programs



Inventor Hour, Episode 20

Thursday, July 27, noon (ET)



