

# What you need to know about the USPTO

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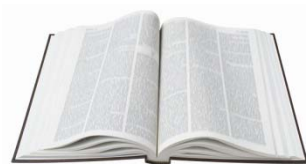
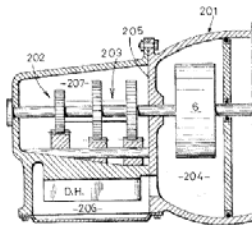
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# Outreach in NYC



# Overview of Intellectual Property

	What's Protected?	Examples	Protection Lasts for:
Utility Patent	Inventions	iPod, chemical fertilizer, process of manipulating genetic traits in mice	20 years from the date of filing regular patent application
Design Patent	Ornamental (non functional) designs	Unique shape of electric guitar, design for a lamp	14 years
Copyright	Books, photos, music, fine art, graphic images, videos, films, architecture, computer programs	Michael Jackson's Thriller (music, artwork and video), Windows operating system	The life of the author plus 70 years (or for some works, 95 years from first publication)
Trade Secret	Formulas, methods, devices or compilations of information which is confidential and gives a business an advantage	Coca-Cola formula, survey methods used by a pollster, new invention for which patent application has not been filed	As long as information remains confidential and functions as a trade secret
Trademark	Words, symbols, logos, designs, or slogans that identify and distinguish products or services	Coca-Cola name and distinctive logo, Pillsbury doughboy character	As long as business continuously uses trademark in connection with goods or services



# 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

# Quid Pro Quo



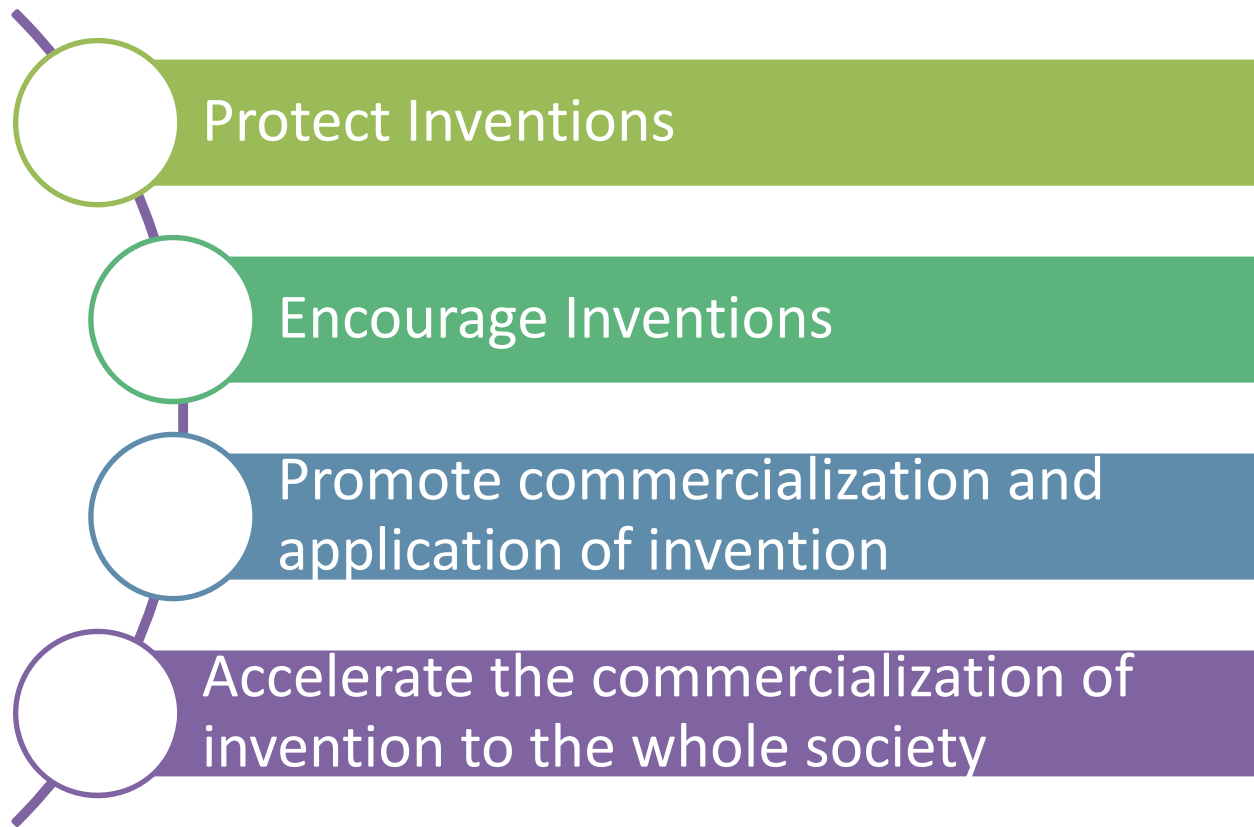
Time-Limited  
Monopoly



*Franklin*

Discloses Invention

# Role of the Patent System



# Why Get a Patent?

- A patent can be
  - Used to gain entry to a market
  - Used to exclude others from a market
  - Used as a marketing tool to promote unique aspects of a product
  - Sold or licensed, like other property

# What is the Role of Patent Examiner?

- Issue Valid Patents
  - Make appropriate objections
  - Make only reasonable rejections
  - Help applicant identify allowable subject matter
- Act as an advocate for the Public
  - Ensure development of a clear and complete file wrapper record
  - Patent prosecution before the Office should not be adversarial, instead it should be cooperative investigation between the Examiner and the Applicant, which ensures an Applicant receives a patent only for that which they are entitled to in accordance with Patent laws.



# What is the Role of Patent Examiner? (cont.)

- To serve as advocate/protector of public interest with respect to intellectual property (clearly define property right)
- To provide direct service and assistance to customers from inside and outside the U.S. Patent & Trademark Office
- To serve as a judge on patentability with respect to inventions claimed in a patent application under conditions for patentability set forth in Title 35 of the United States Code

# Congress and the USPTO

- Congress passes the patent laws that govern all substantive and procedural functions of the USPTO
  - 35 USC §§ 101 – defines what is eligible to be patented
  - 35 USC §§ 102 – must be new
  - 35 USC §§ 103 – must be non-obvious
  - 35 USC §§ 112 – must be sufficiently described, enabled, with best mode disclosed

# What Does a Patent Examiner Do?

- **Reads and understands** the invention set forth in the specification
- Determines whether the application is adequate to define the **metes and bounds** of the claimed invention
- Determines the **scope of the claims**
- **Searches** existing technology for claimed invention
- Determines **patentability** of the claimed invention

## What Does a Patent Examiner Do? (cont.)

- Writes an Office Action which identifies and analyzes all issues in the application pertinent to patentability of the claimed invention
- Responds completely to Applicant's reply
- Issues Notice of Allowance or Notice of Abandonment
- Ensures that all pertinent procedural steps necessary for obtaining a patent are complied with during prosecution of an application

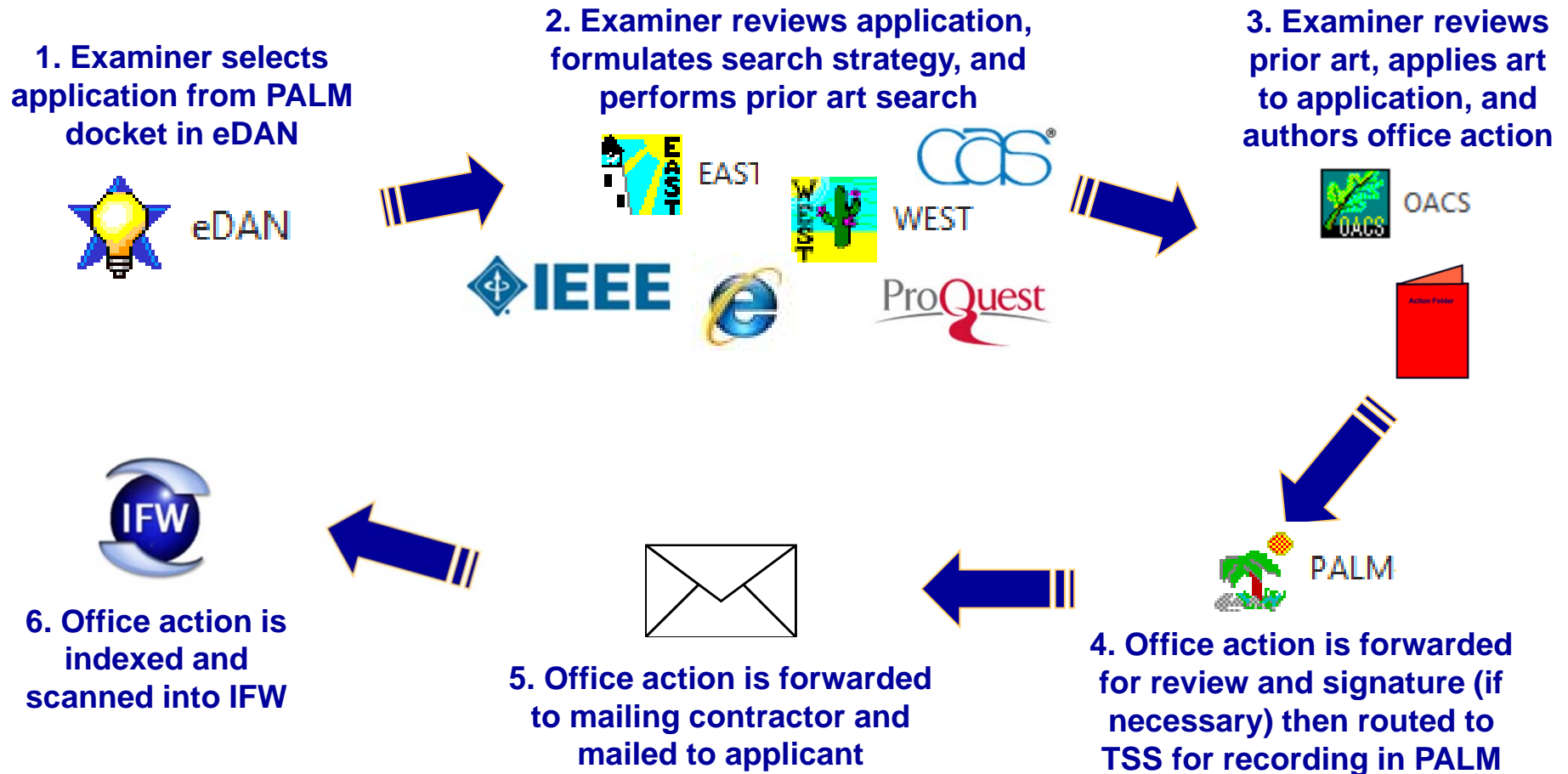
# What May an Examiner Do?

- Advise on advantages of, and appropriate classification fields for, pre-examination search
- Advise on advantages of securing services of a competent patent attorney or agent
- Advise on Office fees and Office procedures in general
- Assist public in conducting a search, short of rendering patentability advice or opinion as to whether an application should be filed

# Patent Examination

- Patent Examiner reviews contents of the application for compliance with all U.S. legal requirements
- **Burden is on the examiner: An applicant is entitled to a patent unless...**
  - Requirements of U.S. Law are not met

# Simplified Patent Examination Process



# Patent Infringement in the U.S.

Occurs when –

Without authorization of patent owner:

- Making or using the invention
- Offer to sell or sells within the U.S.
- Import the invention into the U.S.
- Actively induce infringement by another



# Enforcement Considerations

- Burden is on the Patent Owner
- Enforceability of patents
  - Effectiveness of enforcement laws and procedures in the country/region of interest
    - Some countries allow recordation of patent with customs
- Competitor products should be monitored
  - In stores
  - At trade shows
- Licensing may be beneficial
  - Limit as to time, geographical area, or field of use

# Trade Secret Law

- Protects a commercially valuable proprietary information
- Valuable business information that gives a competitive advantage
- Trade Secrets are not generally known and must be subject to reasonable efforts to preserve confidentiality
- Examples
  - Formulas (e.g. Coca-Cola®)
  - Manufacturing processes
  - Business strategies
  - Business management information
  - Customer lists
  - Design concepts

# Trade Secret vs. Patent

## Trade Secret

- Indefinite
- Not registered or disclosed
- Can be separately discovered
- Remedy only if the secret is illegally appropriated

## Patent

- 20 year term
- Public disclosure
- Right to exclude others
- Remedy for infringement

# Common Ways to Lose a Trade Secret

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

# Provisional Patent Applications

- A low-cost way to establish an early effective filing date (priority date) in a non-provisional patent application with fewer formalities
  - Specification & Drawings
  - No claims required
- 12 month window to file a corresponding utility patent application in order to benefit from the priority date of the provisional application
  - Caution – will lose priority date for any new matter filed in the utility application
- Provisional application is abandoned automatically at 12 months and is not examined

# Provisional Utility Applications

## (MPEP 201.04(b))

- Low cost submission to establish filing date
  - \$130 small entity
  - \$65 micro entity
- Micro entity 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**
- No patents rights—not examined
- 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

- Claims and Oath/Declaration are not required
- Items required:
  - Specification in compliance with 35 USC 112, Paragraph (a) **(enabled, written description, best mode)**
  - Drawings (needed in almost all cases)
  - Filing fees
  - Cover Sheet identifying Provisional Application

*USPTO Received 163,040 Provisional Applications in FY 2012*



# Provisional Applications

- 35 U.S.C. §111(b)
- Act as a “placeholder”
  - Never substantively examined
  - Automatically lapse one year from the filing date
  - Must file a non-provisional within the year to get priority date
- Once filed, applicants can use “patent pending”
- Can not claim priority from another application
- Patent term measured from filing date of subsequent **non-provisional** application

# Provisional Applications

## Filing Date Requirements

### •Required

- A specification
- A drawing (if required to understand the invention)
- A cover sheet or cover letter
- Fee

### Not Required

- A claim
- An oath or declaration (37 C.F.R. §1.63)
- An IDS

The provisional application must be made in the name(s) of all of the inventor(s). It can be filed up to one year following the date of first sale, offer for sale, public use, or publication of the invention. (These pre-filing disclosures, although protected in the United States, may preclude patenting in foreign countries.)

# 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) can claim priority to US Provisional Application

# Provisional Applications – Domestic Priority

- Requirements
  - Non-provisional application (35 U.S.C. §111(a))
  - Within 12 months of the filing date of the provisional
  - At least one common inventor
  - Reference to the provisional application must be made in non-provisional
  - Provisional application must satisfy **§112(a)** for the invention claimed in the subsequent non-provisional application

# America Invents Act Implementation

## Patent Related

- Inventor's oath / declaration
- Preissuance submission
- Supplemental examination
- Citation of patent owner claim scope statements
- **First Inventor to File**

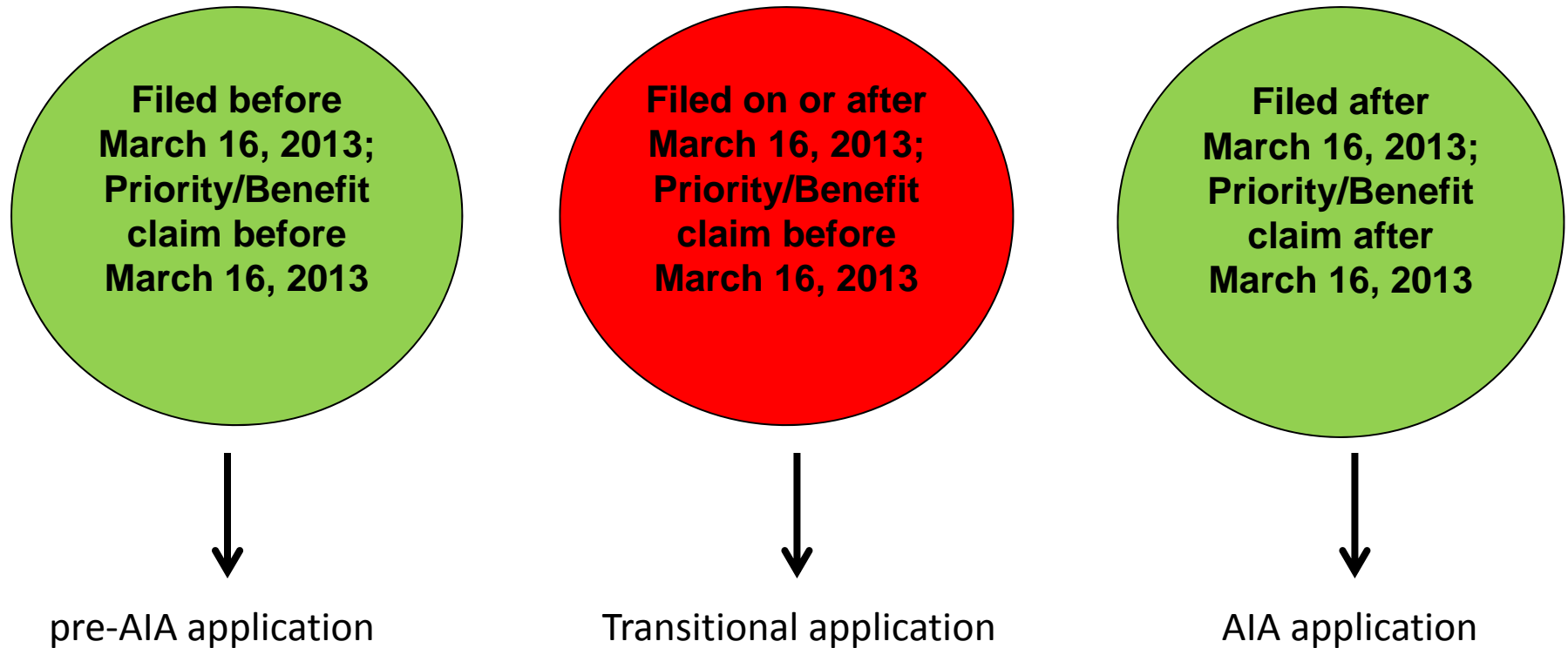
## Administrative Trials

- Inter partes review
- Post grant review
- Covered business method review

# America Invents Act – New Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
<b>102(a)(1)</b> Disclosure with Prior Public Availability Date	<b>102(b)(1)</b>	<b>(A)</b> Grace Period Disclosure by Inventor or Obtained from Inventor
		<b>(B)</b> Grace Period Intervening Disclosure by Third Party
<b>102(a)(2)</b> U.S. Patent, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date	<b>102(b)(2)</b>	<b>(A)</b> Disclosure Obtained from Inventor
		<b>(B)</b> Intervening Disclosure by Third Party
		<b>(C)</b> Commonly Owned Disclosures

# Applicability of AIA



# Resources

- Comprehensive Information and Training Material for First Inventor to File: [http://www.uspto.gov/aia\\_implementation/patents.jsp#heading-10](http://www.uspto.gov/aia_implementation/patents.jsp#heading-10)
- Inventor Resources: <http://www.uspto.gov/inventors/index.jsp>
- Scam Prevention: [http://www.uspto.gov/inventors/scam\\_prevention/index.jsp](http://www.uspto.gov/inventors/scam_prevention/index.jsp)
- Pro Se & Pro Bono: <http://www.uspto.gov/inventors/proseprobono/index.jsp>



Thank You!

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