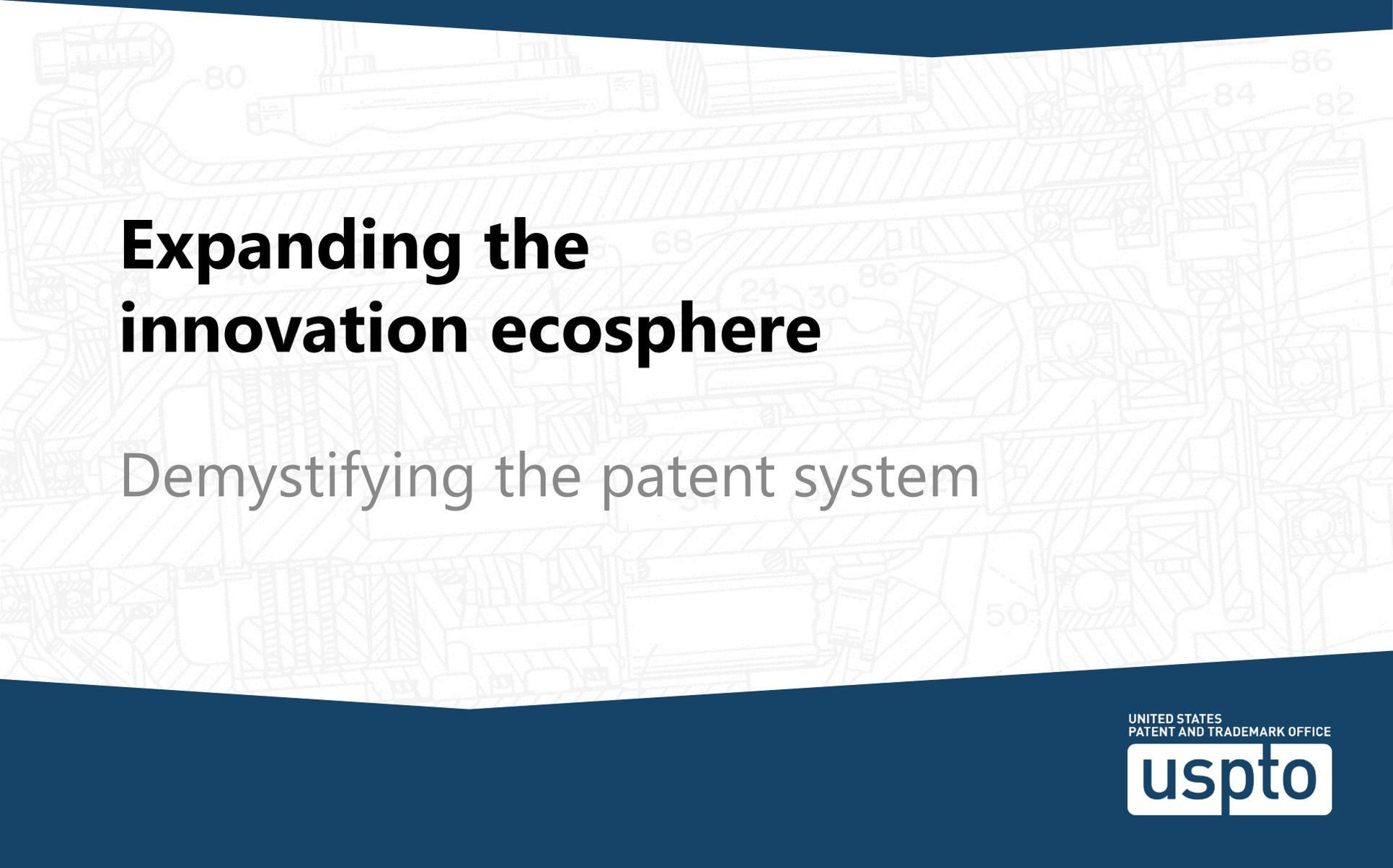


UNITED STATES
PATENT AND TRADEMARK OFFICE





Expanding the innovation ecosphere

Demystifying the patent system

UNITED STATES
PATENT AND TRADEMARK OFFICE



Notice

This content is for informational purposes only and is not legal advice. Please consult with appropriate sources for legal authority and guidance on these matters.

Objectives

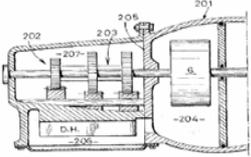
- History
- Overview of intellectual property (IP)
- Overview of the patent process

Historical foundation of intellectual property

- Intellectual property (IP) is deeply rooted in our nation's history.
 - U.S. constitution Article 1, Section 8, Clause 8:
"The Congress shall have Power ... to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries ... "



Overview of intellectual property

	Utility/Plant patent	Design patent	Trade secrets	Copyrights	Trademarks
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 for works created on or after 1/1/78	Abandoned or loss of distinctiveness or secondary meaning
Rights of independent third party creators	None	None	Full	Full	None
Examples					

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: 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:

The role of the patent system

- Protect inventions
- Encourage inventions
- Promote commercialization and application of invention
- Accelerate the commercialization of invention to the whole society

Overview:

What is a patent?

- Property right
 - Provides the right to exclude others from:
 - making, using, selling, offering for sale, or importing the claimed invention
 - Granted for a limited term
 - Territorial: A U.S. patent provides protection only in the U.S.
 - No worldwide patents
 - Granted by the USPTO in exchange for a full disclosure of the invention.



Overview:

Why get a patent?

- A patent can help companies grow by:
 - 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
- Benefit communities by making new goods and services available
- Promote innovation and help safeguard your inventions
- Provide personal growth, development, and advancement



Overview:

Who can apply for a patent?

- Inventor(s)
 - Anyone who contributes to the conception of an invention
- Assignee(s)
 - An individual or a company that has gained the rights and title to an invention
- Obligated assignees
 - An individual or company that will be obligated to be assigned the rights and title to an invention
- A person with a sufficient proprietary interest
 - A person with sufficient proprietary interest in a matter to file and prosecute an application on behalf of the inventor



Who can be an inventor on a patent?

- Anyone who contributes to the conception of an invention
 - Alone, or in combination with others



The USPTO is America's innovation agency

Committed to:

- Fostering innovation and economic growth
- Creating a reliable, predictable, and high-quality IP system

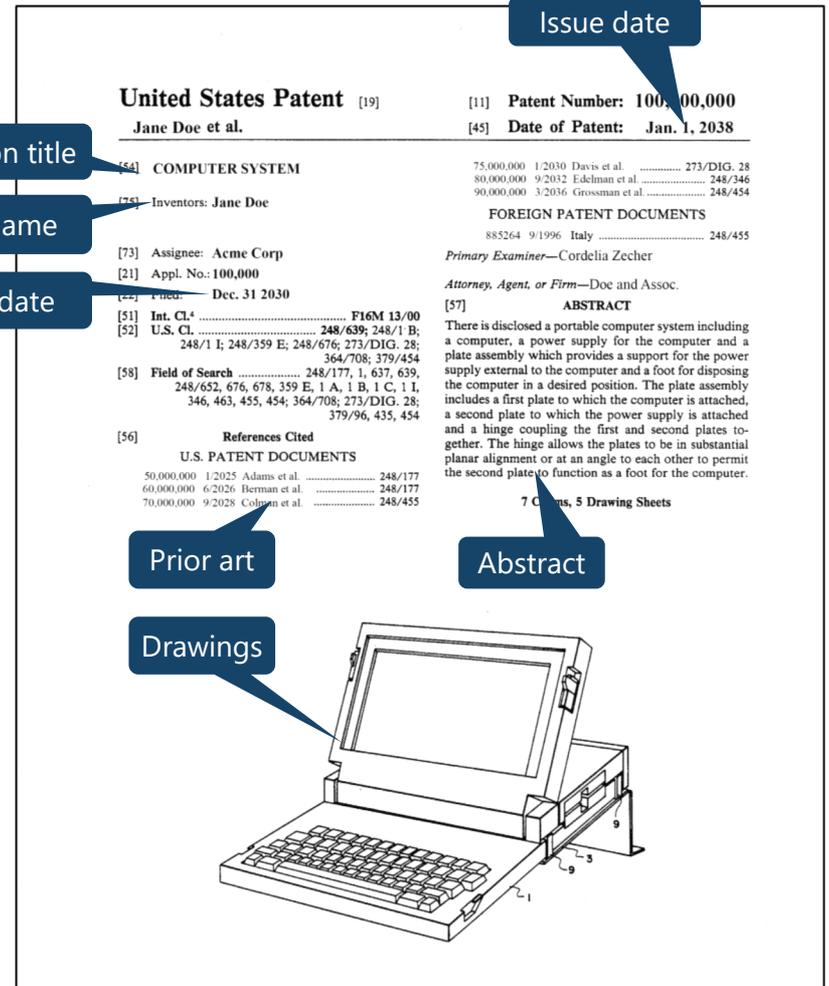


The patent application journey

Demystifying IP

Anatomy of a patent

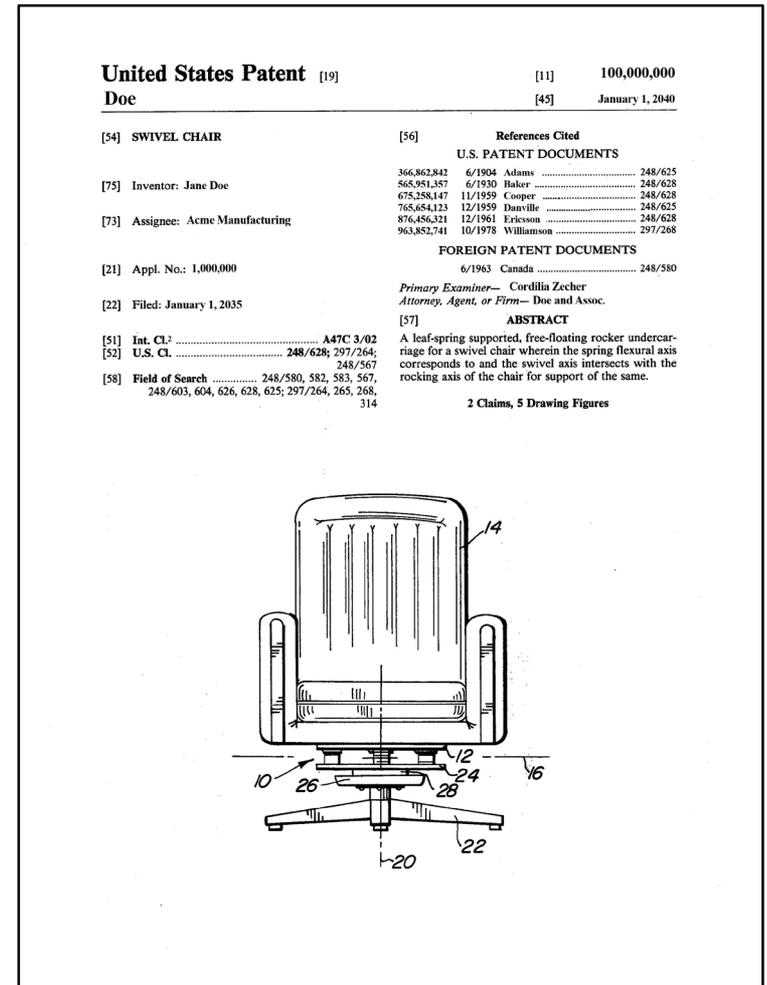
- Abstract
 - A short summary of the invention.
- Written description
 - How does it work?
How is it made or used?
- Drawings
 - What does it look like?
- Claims
 - The claim(s) define(s) the legal boundaries of the invention, similar to a deed to a property.



Sample claim

Claim 1. A chair comprising:

- a seat,
- a back support attached to the seat,
- support arms attached to the seat and back support, and
- a base comprising a plurality of legs attached to the seat.



The patent application journey

First, you need an idea!

Step 1

- Is your idea worth protecting?

Present your idea

Step 2

Draft application

Step 3

File application

Step 4



Is your idea eligible for protection?



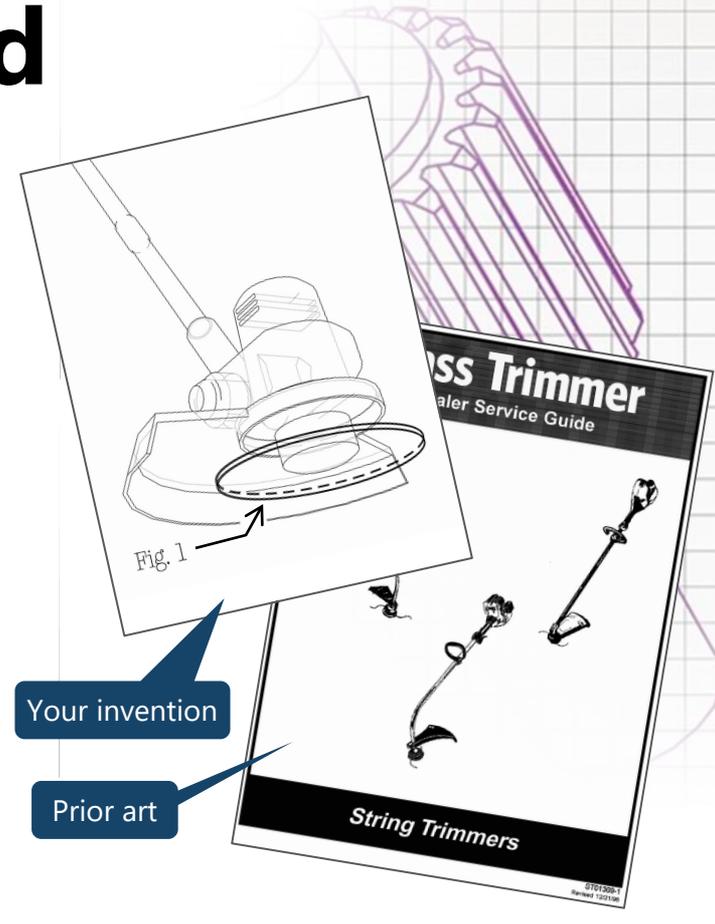
35 U.S.C. § 101

Is your idea novel and non-obvious?

- “Novel”: e.g., your invention is new, was not described in the prior art.
- “Non-obvious”: e.g., the differences between your invention and prior art would not have been obvious to someone in that field.

35 U.S.C. §§ 102 and 103

NOTE: Prior Art is all the information that has been made available to the public in any form (including Patents, Articles, Books, flyers etc.) before a given date.



The patent application journey

First, you need an idea!

Step 1

Present your idea

- Maintain confidentiality.

Step 2

Draft application

Step 3

File application

Step 4



Presenting your idea

- Don't be afraid to champion your idea.
 - Diagrams are helpful.
- **Best to** maintain confidentiality prior to filing your patent application.
- Consult with counsel about safe ways to disclose your invention before filing a patent application.
- The USPTO provides the **Pro Se Assistance Program** which provides outreach and education assistance to applicants who file an application without the assistance of an attorney.



The patent application journey

First, you need an idea!

Step 1

Present your idea

Step 2

Draft application

- It's now time to write the patent application.

Step 3

File application

Step 4

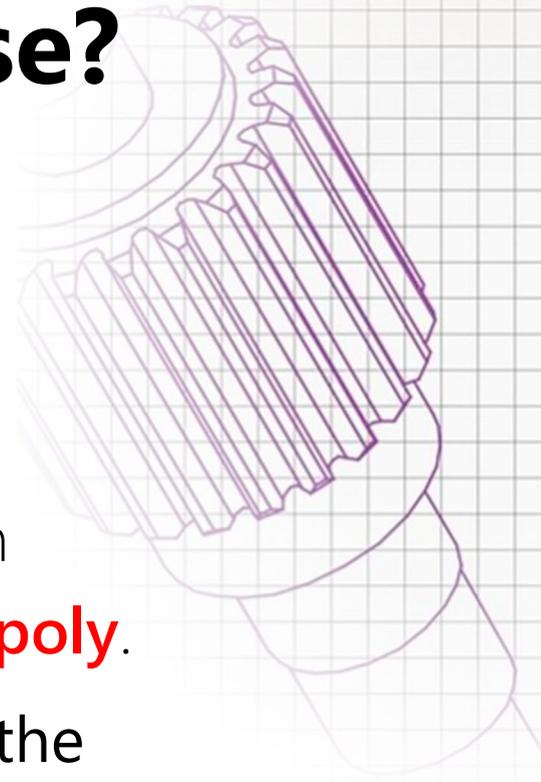


What do I need to disclose?

A patent is a *quid pro quo*:

- In exchange for:
 - The right to exclude others from making, using, importing, or selling your invention for a limited time period; **a limited monopoly**.
- You must **fully** disclose your invention so the public can benefit from it and expand on it.

35 U.S.C. § 112



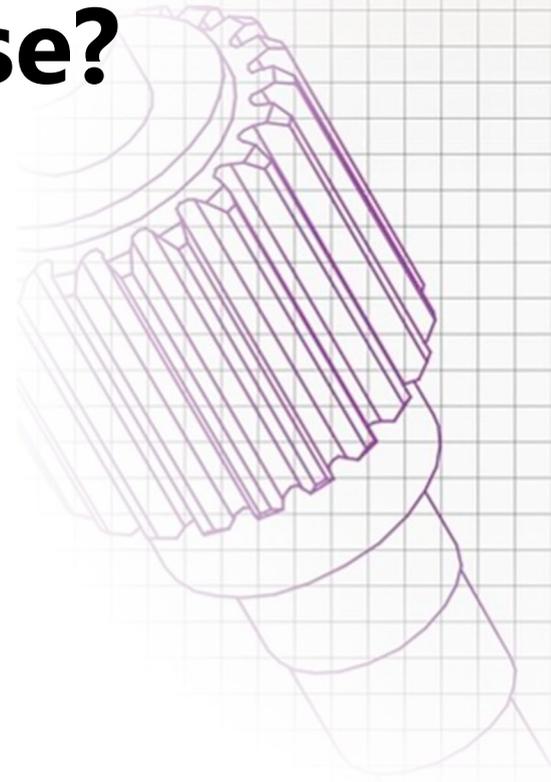
What do I need to disclose?

Slide 1 of 2

Does the disclosure:

- Demonstrate that the inventor was in possession of the claimed invention?
- Teach one of ordinary skill to make and use the invention without undue experimentation?
- Describe the best mode contemplated for carrying out the invention by the inventor?

35 U.S.C. § 112 (a)



What do I need to disclose?

Slide 2 of 2

Are the claims clear enough that:

- The public is informed of the boundaries of your invention?
- It can be determined whether the claimed invention meets all the criteria for patentability?

35 U.S.C. § 112 (b)

The patent application journey

First, you need an idea!

Step 1

Present your idea

Step 2

Draft application

Step 3

File application

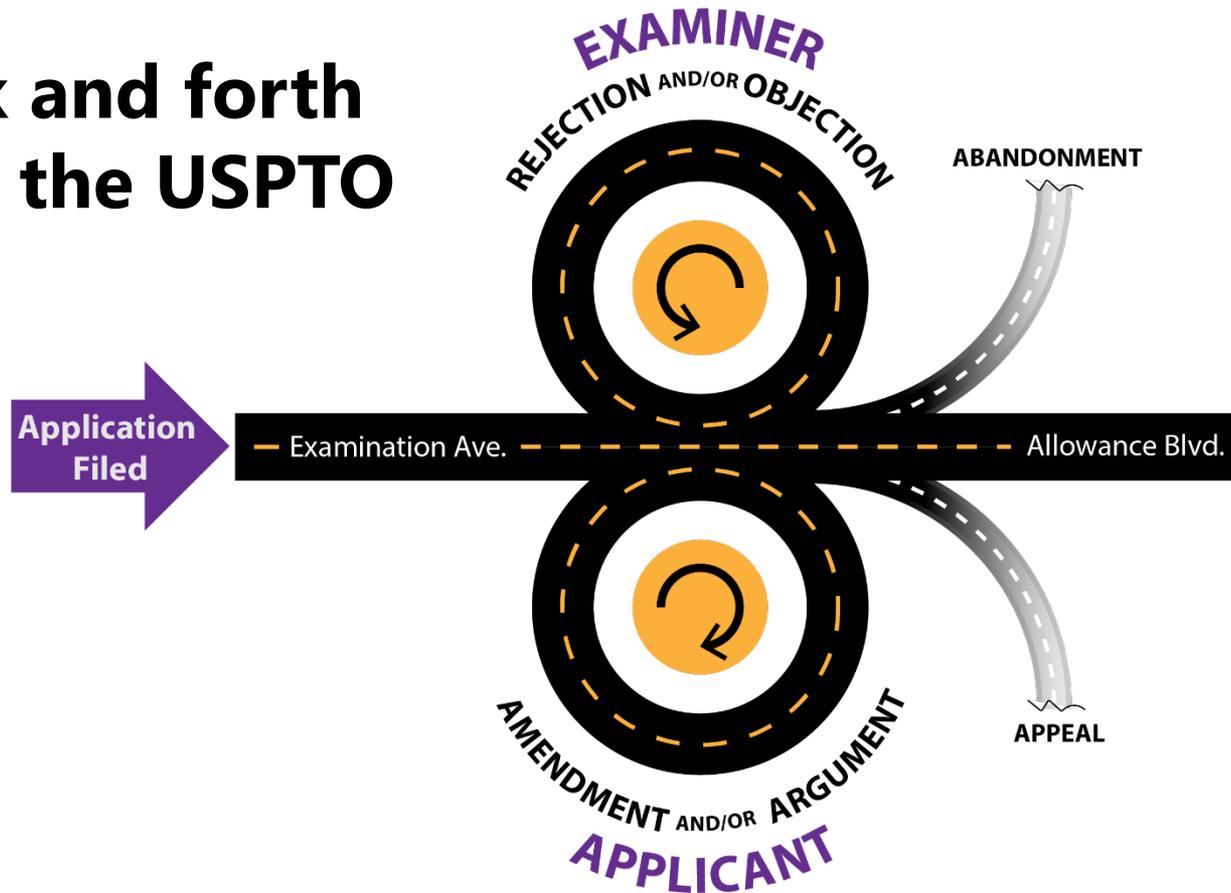
Step 4

- The application is filed with the USPTO. You will need to file a sworn oath or declaration that **you** invented the invention described in the application.



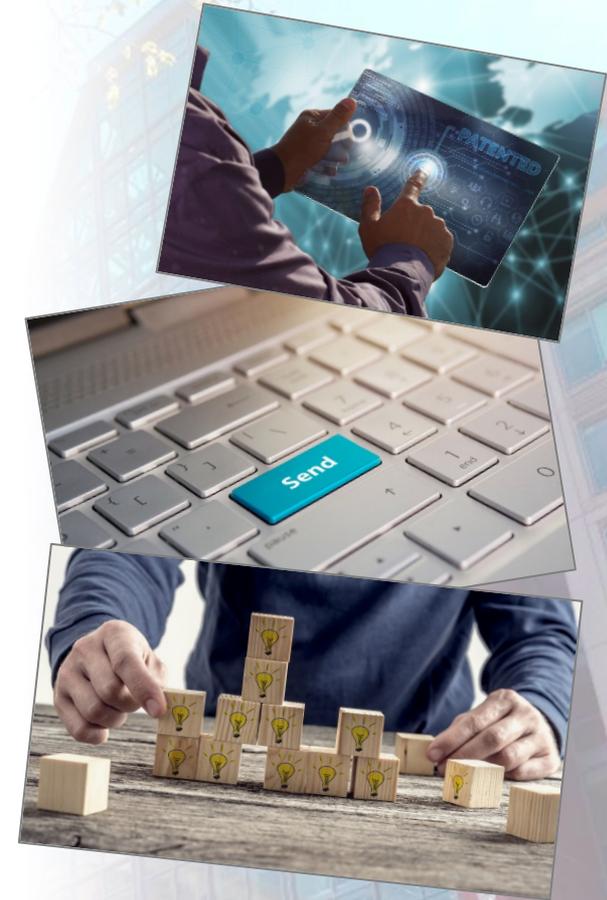
The patent application roadmap

Back and forth with the USPTO



Role of the applicant

- File a complete application
- Disclose all known prior art
- In response to examiner office actions:
 - Explain your position, and/or
 - Make good faith changes to the application



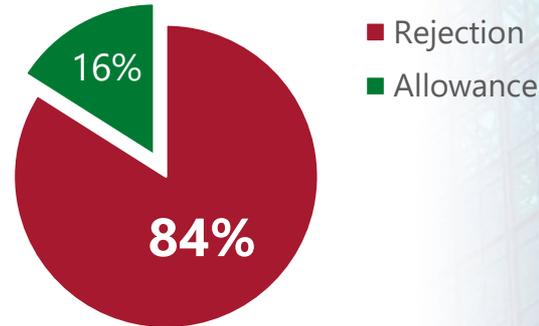
What does a rejection mean?

- Rejections are a normal part of the process.
- They help define what is patentable.
- Often due to existing prior art.
 - The examiner must have a basis to believe someone else may have come up with what you invented before you.
- Can often be overcome.

Received a rejection? Don't give up!

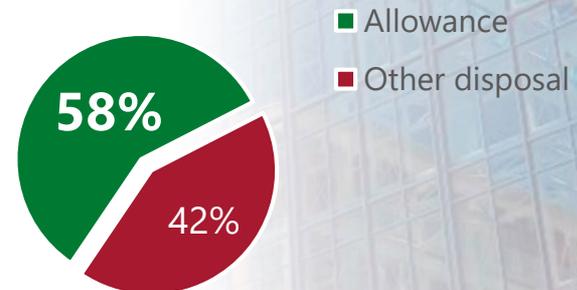
Fact: In FY 2019, 84% of original filings received a first office action containing a rejection.

FY 2019 first actions

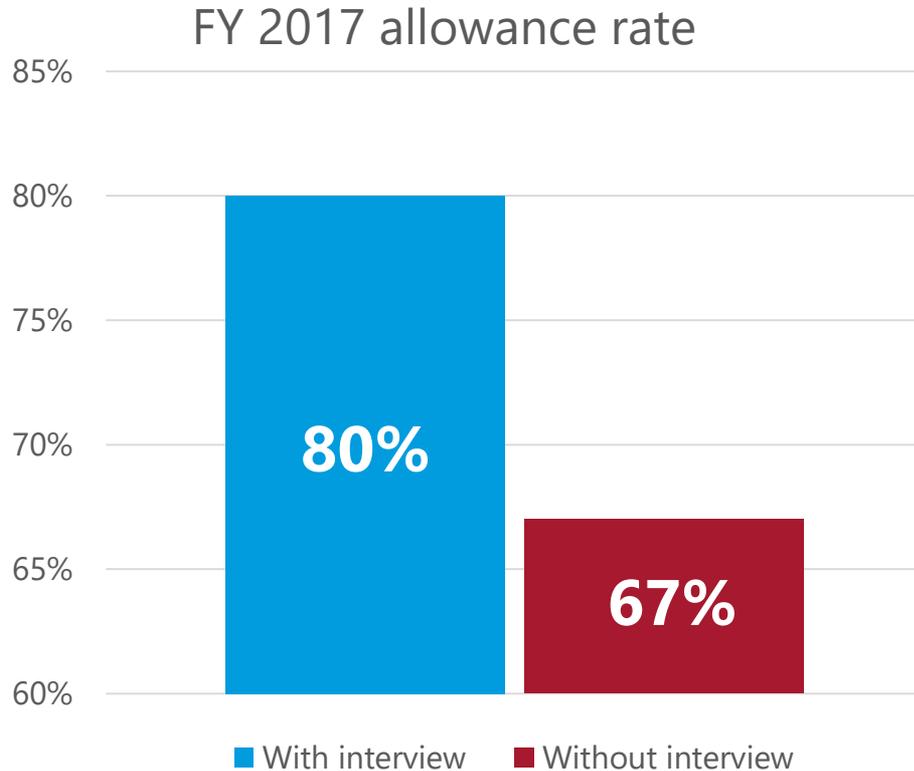


Fact: In FY 2019, 58% of examiner disposals were allowances.

FY 2019 percentage allowed

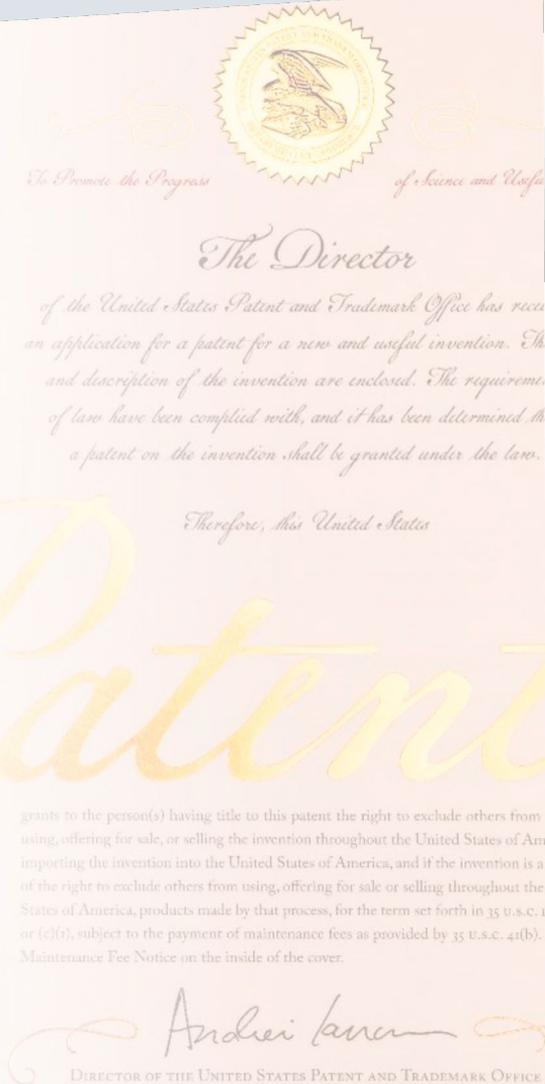


Power of the interview



Allowance and issuance

- A notice of allowance indicates all objections and rejections have been overcome and your application is ready for issuance.
- **Congratulations!**



Remember

- Stay involved throughout the process.



For more information

- Contact the Pro Se Assistance Center:
 - 866-767-3848
 - innovationdevelopment@uspto.gov
- Visit our Website:
 - <https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>

