USPTO Inventor Info Chat Series: Types of Patent Applications

Office of Innovation Development
Alford Kindred & Robert Hodge
February 16, 2017

Email questions to: inventorinfochat@uspto.gov
Office of Innovation Development (OID)

• 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
• Inventor Outreach
  – Independent Inventor Conferences
  – Education for Inventor Organizations
• http://www.uspto.gov/inventors

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Objectives

• To give an overview of intellectual property and the different types of patents
• To provide an understanding of provisional and non-provisional utility applications

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IP Awareness Assessment Tool

- The IP Assessment includes the 5 general categories that are included in all assessments.
  - IP Strategies & Best Practices
  - International IP Rights
  - IP Asset Tracking Licensing
  - Technology to Others
  - Using Technology of Others
- There are 5 additional categories that all can take or, which may be customized through a Pre-assessment.
  - Copyrights
  - Design Patents
  - Trademarks
  - Trade Secrets
  - Utility Patents

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Overview of IP: Types

- **Patents**
  - Protects inventions
  - Source: U.S. Const., Art. I, Sec. 8

- **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 of authorship fixed in a tangible medium
  - Source: U.S. Const., Art. I, Sec. 8

- **Trade Secrets**
  - Protects commercially valuable proprietary information that gives a competitive advantage and is subject to reasonable efforts to preserve confidentiality
  - Source: State, Common law and Defend Trade Secrets Act of 2016

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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**
What should you file?

• Types of US patents
  – **Utility**: any new and useful process, article of manufacture, machine, or composition, or improvement thereof
  – **Design**: a new, original, and ornamental design for an article of manufacture
  – **Plant**: any distinct and new variety of plant that is invented or discovered and asexually reproduced

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Design Patent Applications

- Design patents protect the way an object appears, ornamental features of invention
- No provisional application
- 15 year term, from issue
- No maintenance fees

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# Provisional vs. Non-provisional

<table>
<thead>
<tr>
<th>Provisional</th>
<th>Non-provisional</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Not examined or published</td>
<td>• Examined</td>
</tr>
<tr>
<td>• One-year time limit</td>
<td>• Published 18 months from earliest filing date (unless a request for a non-publication at filing)</td>
</tr>
<tr>
<td>• Available for utility and plant patent applications</td>
<td>• Can become a patent</td>
</tr>
<tr>
<td>• A low-cost way to establish an early effective filing date (priority date) in a non-provisional patent application with few formalities</td>
<td>• In general, 20-year patent protection from filing date*</td>
</tr>
</tbody>
</table>

*Subject to the payment of maintenance fees, the term of a patent begins on the date the patent issues and ends 20 years from the date the application was filed, or if the application claims the benefit of an earlier filed U.S. application or applications (excluding provisional applications), the patent term ends 20 years from the date the earliest such application was filed. (Note: A utility patent could be subject to a terminal disclaimer or patent term extension or adjustment which would affect the term of the patent.)

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Provisional vs. Non-provisional

• Not an either or proposition

• Claim priority to provisional application only in a non-provisional application (This is a domestic priority claim, which must be completed on the Application Data Sheet under the heading “Domestic Benefit/National Stage Information:”)

• Disclosure of provisional application must support non-provisional (to allow the claims to be entitled to the earlier effective filing date)

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Application Flow Chart

File **non-provisional** utility application claiming domestic benefit under 35 USC 119(e) in an Application Data Sheet

- 12 months pass
- Abandonment

- US Patent Granted
- Abandonment

Provisional Application

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Benefits of Provisional Utility Applications

• Inventor given time to investigate market potential
• May file multiple provisional applications during the 1-year pendency of the first filed provisional to include improvements
• Provides time to obtain counsel if desired
• Patent term measured from filing date of subsequent non-provisional application
• Term patent pending allowed to be applied

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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) International application can claim priority to US Provisional Application
    • Applicant receives an early indication of pertinent prior art and a written opinion as to the novelty, inventive step, and industrial applicability of the claimed invention

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## Current USPTO Fee Schedule

### Patent Application Filing Fees

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<tr>
<th>Fee Code</th>
<th>37 CFR</th>
<th>Description</th>
<th>Fee</th>
<th>Small Entity Fee</th>
<th>Micro Entity Fee</th>
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<td>140.00</td>
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<td>Provisional application filing fee</td>
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<td><strong>Fee Code</strong></td>
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<tr>
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<td>1.16(k) Utility Search Fee</td>
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<td><strong>Fee Code</strong></td>
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<tr>
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http://www.uspto.gov/patent

Getting Started with Patents

Applying for a patent successfully requires a strong understanding of the application process. This is the first step to a successful application.

1. Getting Started
2. Application Process
3. Maintaining Your Patent

Helpful Resources:
- General Information Concerning Patents
- Patent Process Overview
- Using Legal Services
- International Patent Cooperation
- Patent and Trademark Resource Centers (PTRCs)
- Patent Statistics

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Also has direct links to:

- Patent searching
- Patents Forms
- Online Filing
- Patent Trial and Appeal Board
- Check the status of an application
- Search for and change patent ownership
- Laws, Regulations, Policies, Procedures, Guidance and Training
Upcoming OID Events

• March 2, 2017 – Women’s Entrepreneurship Symposium – Pittsburgh, PA
• March 16, 2017 – Inventor Info Chat – “How to Search and why you want to?”
• March 23, 2017 – Working with Patents and Trademarks – Indianapolis, IN

For more information or to register for any of the above events contact us at oidevents@uspto.gov
Thank You!

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1.866.767.3848

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Robert Hodge