INVENTION-CON 2017
The Place for Inventors, Makers, & Entrepreneurs
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High Level Overview of Intellectual Property

Presented By: Zandra Smith
Outline

• Types of Intellectual Property
• Why get a Patent?
• Design Patents vs Utility Patents
• What is Patentable?
• The Patent Process
• Tools for Applicants
## Overview of Intellectual Property

<table>
<thead>
<tr>
<th>What’s Protected?</th>
<th>Examples</th>
<th>Protection Lasts for:</th>
</tr>
</thead>
<tbody>
<tr>
<td>Utility Patent</td>
<td>Inventions</td>
<td>iPod®, chemical fertilizer, process of manipulating genetic traits in mice</td>
</tr>
<tr>
<td>Design Patent</td>
<td>Ornamental (non functional) designs</td>
<td>Unique shape of electric guitar, design for a lamp</td>
</tr>
<tr>
<td>Copyright</td>
<td>Books, photos, music, fine art, graphic images, videos, films, architecture, computer programs</td>
<td>Michael Jackson’s Thriller (music, artwork and video), Microsoft Windows® operating system</td>
</tr>
<tr>
<td>Trade Secret</td>
<td>Formulas, methods, devices or compilations of information which is confidential and gives a business an advantage</td>
<td>Coca-Cola® formula, survey methods used by a pollster, new invention for which patent application has not been filed</td>
</tr>
<tr>
<td>Trademark</td>
<td>Words, symbols, logos, designs, or slogans that identify and distinguish products or services</td>
<td>Coca-Cola® name and distinctive logo, Pillsbury® doughboy character</td>
</tr>
</tbody>
</table>
Can you find the IP in a smart phone?

**Trademarks:**
- Made by “Apple®”
- Product “iPhone®”
- Software “Siri®, “Safari™”, “iOS™” (under license from Cisco®)

**Utility patents:**
- Semiconductor circuits
- Chemical compounds
- Battery/Power Control
- Antenna
- Electronic displays

**Copyrights:**
- Software code
- Instruction manual
- Ringtone
- …

**Trade secrets:**
- ???

**Design patents:**
- Form of overall phone
- Graphical user interface/computer icon
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
Why get a Patent?

• A patent can be:
  • Used to gain entry into, and deter others from, a market
  • Used as a marketing tool to promote unique aspects of a product
  • Assert/enforce rights against an infringer or competitor
  • Used as collateral to obtain funding
  • Create revenue – sell or license like other property
Design Patents v. Utility Patents

**Design Patents** (35 U.S.C. § 171)
- Protects the non-functional ornamental design of an article of manufacture
- No provisional application or maintenance fees
- 15 year term, from issue

**Utility Patents** (35 U.S.C. § 101)
- Protects any new or improved useful process, machine, manufacture, or composition of matter, which are functional
- It is possible that you can obtain both design and utility patent protection

Can obtain both a design and utility patent
Why do ‘savvy’ startups file Patents?

• Attractive to investors and buyers
• Patents are a form of property that can add value to a company’s assets
• Can serve as an asset for financing (e.g. leverage financing)
What is patentable?

Any New, Useful, Non-obvious, Invention that is Described, Enabled, and Clearly claimed.

Processes

Machines

Compositions of Matter

Articles of Manufacture

Improvements thereof

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Process to a Patent

Process for Obtaining a Utility Patent

**STEP** | **WHO?** | **ACTIVITY**
--- | --- | ---
1. | Applicant | **Has your invention already been patented?**
   - Search: [http://patft.uspto.gov](http://patft.uspto.gov)
   - **Yes** → end
   - **No** →
2. | Applicant | **What type of Application are you filing?**
   - **Design Patent** (ornamental characteristics)
   - **Plant Patent** (new variety of asexually produced plant)
   - **Utility Patent** (most common) (useful process, machine, article of manufacture, composition of matter)
3. | Applicant | **Determine filing strategy**
   - **File Globally?**
     - **Yes** → **Need international protection?**
       - **File in U.S.?**
         - **Yes** → end
         - **No** →
     - **No** →
4. | Applicant | **File in U.S.?**
   - **Yes** → **Which type of Utility Patent Application to file?**
     - Provisional or Nonprovisional
   - **No** →
5. | Applicant | **Consider expedited examination**
   - Prioritized Examination
   - Accelerated Examination Program
   - First Action Interview
   - Patents Prosecution Highway

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Process to a Patent (cont.)

6. **Applicant**
   - Who Should File?
     - File yourself (Pro Se)
     - Use a Registered Attorney or Agent (Recommended)

7. **Applicant**
   - Prepare for electronic filing
     - Determine Application processing Fees
     - Apply for a Customer Number and Digital Certificate

8. **Applicant**
   - Apply for Patent using Electronic Filing System as a Registered eFiler (Recommended)
     - About EFS-Web

9. **USPTO**
   - USPTO examines application
     - Check application status

10. **Applicant**
    - Allowed?
    - Yes
        - Applicant files replies, requests for reconsideration, and appeals as necessary
    - No

11. **USPTO**
    - If objections and rejection of the examiner are overcome, USPTO sends Notice of Allowance and Fee(s) due

12. **Applicant**
    - Applicant pays the issue fee and the publication fee

13. **Applicant**
    - Maintenance fees due 3 ½, 7 ½, and 11 ½ years after patent grant
    - end

USPTO

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Process to a Patent (cont.)

- Patent Law is complex
  - Applicants must make many decisions along the way
- What happens after I get my patent?
  - Licensing
  - Enforcement
  - More innovation and competition
  - Administrative Trials
  - Litigation
  - Etc.
Please note that a negative opinion by the examiner may be correct. In those instances, a patent will not be granted. The Appeal Process can include appeals to the Patent Trial and Appeal Board, The US District Court for the Eastern District of Virginia, US Courts of Appeals for the Federal Circuit and The US Supreme Court.
When should you file?

• United States is a First Inventor to File System!

• Looking for international protection?
  • You must file before public disclosure

• Only want US protection?
  • You can file within one year after public disclosure
Get patent protection fast!

- **File a Provisional application**
  - Locks in filing date
- **Enter Track One**
  - Accelerates examination process (avg. < 1 year)
- **Get Help!**
  - Work on a strategy
  - Seek Pro Bono Assistance
  - Talk to the examiner!
  - Seek the assistance of a registered practitioner
Features of www.USPTO.gov

• Apply Online for a Patent using EFS-Web
• Obtain Status of a Patent Application (must be a registered user to see the status of unpublished applications)
• Determine when applications will be picked up for examination, see First Office Action Estimator
• Search US Patent Database
• Search Patent Classification Manual
Features of www.USPTO.gov

• Download Forms and Fee Schedules
• Patent Help Resources
• Access Details of All Currently Pending Published Patent Applications (Public PAIR)
• IP Awareness Assessment Tool
• Information about Pro Se and Pro Bono programs
• Link to StopFakes.gov site
Pro Bono (Free Legal Representation)

In general, there are three basic requirements:

• Income below a certain threshold;
• Knowledge of the patent system; and
• Possession of an actual invention (not just an idea).

More information can be found at:

• http://www.uspto.gov/inventors/proseprobono/index.jsp
Volunteer Lawyers for the Arts

- Fill out the appropriate intake form online or call the Art Law Line listed on the website, and find out if you qualify for Pro Bono services.
- Qualified applicants will be advised of the administrative fees to be placed on a Caselist, and scheduled for a consultation with a staff attorney to discuss the process and give you some preliminary advice.
- [http://www.vlany.org/legalservices/patent_program.php](http://www.vlany.org/legalservices/patent_program.php)
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.
Pro Se Assistance Program

- The Pro Se Assistance Program offers various services for the public, including:
  - Dedicated personnel for assisting pro se applicants
  - In person assistance (by appointment) for the general public at all USPTO Offices (Alexandria, VA; Detroit, MI; Dallas, TX; Denver, CO & San Jose, CA)
  - A fully equipped public computer workstation for visitors at all USPTO Offices on a first come first served basis
  - Targeted support to connect applicants with relevant resources and information
  - Online resources
Thank You!

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