

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**





# INVENTION-CON 2017

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# Patent Basics Overview

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# Constitutional Authority

- Congress shall have the power ...
  - to regulate commerce with foreign nations, and among the several states, and with Indian tribes. -- U.S. Const. art. I, § 8, cl. 3.
  - 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. -- U.S. Const. art. I, § 8, cl. 8.



# 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

# Why do startups file patents?

- Attractive to investors and buyers
- Patents are a form of property than can add value to a company's assets
- Can sever as an asset for financing (e.g. leverage financing)

# Do I really need a patent?

## - Myths -

- **“If I just publish, I will prevent anyone from getting a patent on my invention”**
  - What if already patented?
  - No Patent Claim = No Protection
  - Can’t exclude others from market
  - You may be excluded from making, using, or selling your products or services
- **“I’m not going to get a patent, because other countries will steal my invention”**
  - How will you keep it secret?



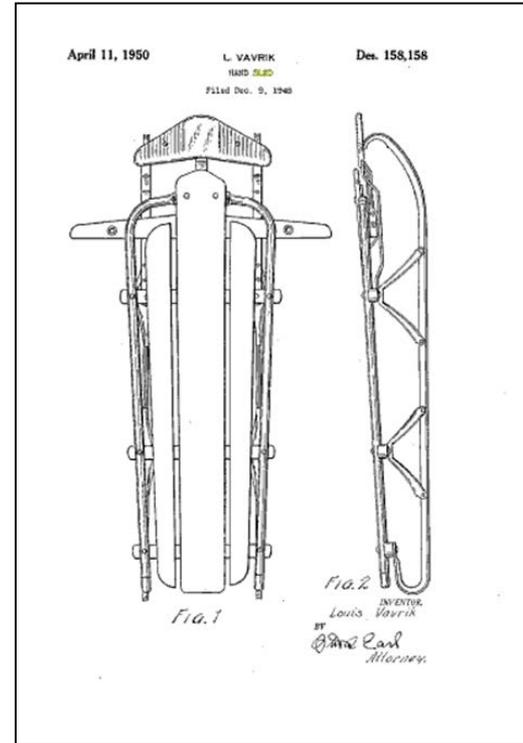
# What should you file?

- **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



# 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



# Provisional vs. Non-provisional

Provisional	Non-provisional
<ul style="list-style-type: none"><li>• Not examined or published</li><li>• One-year time limit</li><li>• Available for utility and plant patent applications</li><li>• A low-cost way to establish a US effective filing date (priority date) in a non-provisional patent application with few formalities</li></ul>	<ul style="list-style-type: none"><li>• Examined</li><li>• Published 18 months from earliest filing date (unless a request for a non-publication at filing)</li><li>• Can become a patent</li><li>• In general, patent protection is set by the filing date*</li></ul>

\*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.

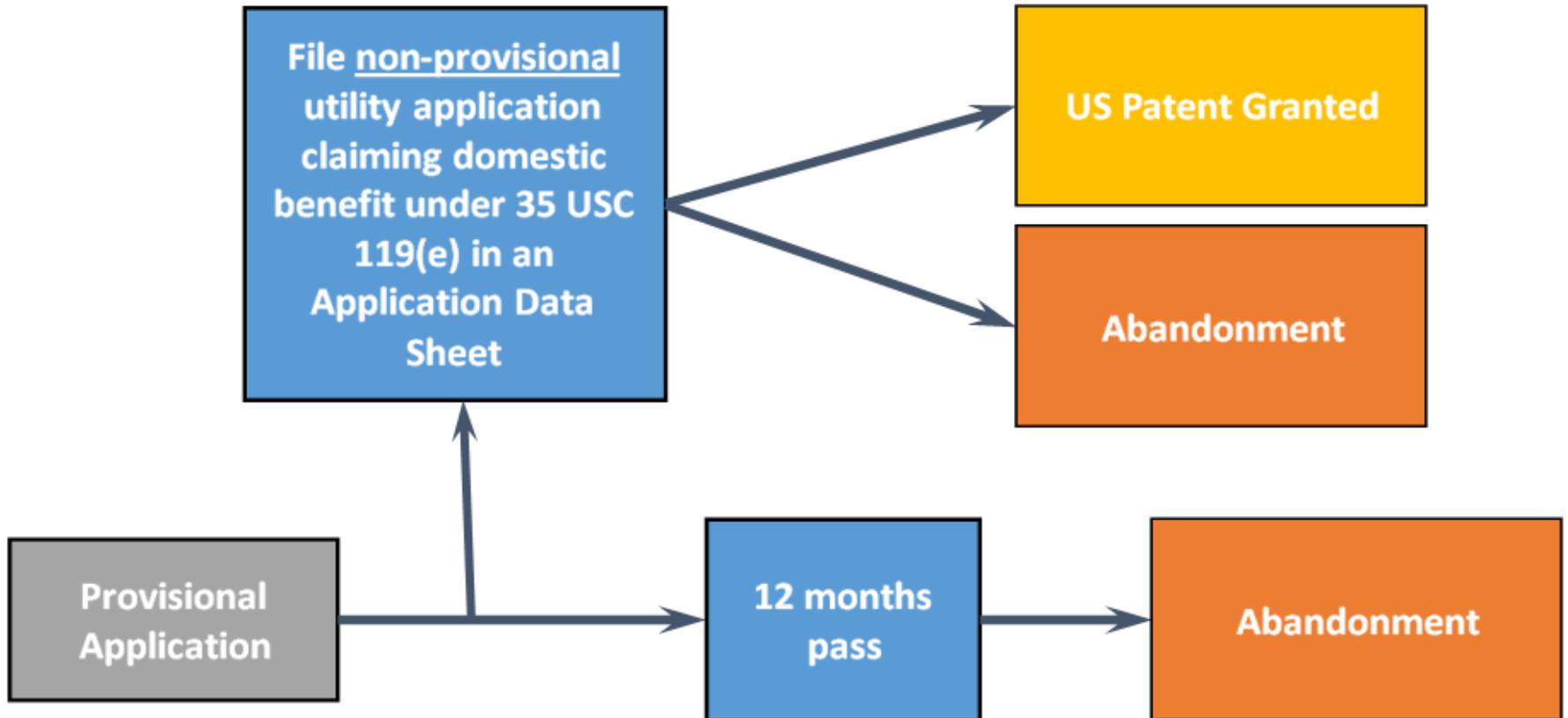
(Note: A utility patent could be subject to a terminal disclaimer or patent term extension or adjustment which would affect the term of the patent.)



# Provisional vs. Non-provisional

- Not an either or proposition
- Claim benefit to provisional application only in a non-provisional application (This is a domestic benefit 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)

# Application Flow Chart



# 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 used



# 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



# Where do you go from here?

## Provisional Applications – As Basis for Priority

- Domestic benefit
  - 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



# Current USPTO Fee Schedule

Patent Application Filing Fees			Back to Top		
Fee Code	37 CFR	Description	Fee	Small Entity Fee	Micro Entity Fee
1011/2011/3011	1.16(a)	Basic filing fee - Utility (paper filing – also requires non-electronic filing fee under 1.16(t))	280.00	140.00	70.00
1011/4011+/3011	1.16(a)	Basic filing fee - Utility (electronic filing)	280.00	70.00	70.00
1012/2012/3012	1.16(b)	Basic filing fee - Design	180.00	90.00	45.00
1017/2017/3017	1.16(b)	Basic filing fee - Design (CPA)	180.00	90.00	45.00
1013/2013/3013	1.16(c)	Basic filing fee - Plant	180.00	90.00	45.00
1005/2005/3005	1.16(d)	Provisional application filing fee	260.00	130.00	65.00
1090/2090/3090	1.16(t)	Non-electronic filing fee — Utility (additional fee for applications filed in paper)	400.00	200.00	200.00

Note: The Non-electronic Filing Fee does not apply to reissue, design, plant & provisional applications  
<http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>

# Current USPTO Fee Schedule

Patent Search Fees			Back to Top		
Fee Code	Fee Code	Description	Fee	Small Entity Fee	Micro Entity Fee
1111/2111/3111	1.16(k)	Utility Search Fee	600.00	300.00	150.00
Patent Examination Fees			Back to Top		
Fee Code	37 CFR	Description	Fee	Small Entity Fee	Micro Entity Fee
1311/2311/3311	1.16(o)	Utility Examination Fee	720.00	360.00	180.00
Patent Post-Allowance Fees			Back to Top		
Fee Code	37 CFR	Description	Fee	Small Entity Fee	Micro Entity Fee
1501/2501/3501	1.18(a) (1)	Utility issue fee	960.00	480.00	240.00

<http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>

# Find Help at

<http://www.uspto.gov/patent>

The screenshot shows the USPTO website header with the logo and navigation links. Below the header is a navigation bar with 'Patents', 'Trademarks', and 'Learning and Resources' tabs, and a 'Quick Links' dropdown. The main content area features a sidebar with three sections: '1. Getting Started', '2. Application Process', and '3. Maintaining Your Patent'. The 'Getting Started with Patents' section is highlighted, containing a sub-header and a paragraph. To the right, there is a 'Helpful Resources' section with a list of links.

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**1. Getting Started**

**2. Application Process**

**3. Maintaining Your 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.

Helpful Resources:

- > [General Information Concerning Patents](#)
- > [Patent Process Overview](#)
- > [Using Legal Services](#)
- > [International Patent Cooperation](#)
- > [Patent and Trademark Resource Centers \(PTRCs\)](#)
- > [Patent Statistics](#)



# <http://www.uspto.gov/patent>

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





