

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Intellectual Property, and Resources for Small Businesses, Entrepreneurs, and Independent Inventors

Elizabeth Dougherty
Eastern Regional Outreach Director
Eastern Regional Outreach Office

UNITED STATES
PATENT AND TRADEMARK OFFICE



Discussion Topics

- **Introduction**
 - IP is a business strategy
 - What is intellectual property (IP)?
 - Trade secrets, copyrights, trademarks, patents
- **Fundamentals about patents: what are they and applying for a patent in the U.S.**
- **USPTO Resources**

IP-intensive industries are a critically important component of the U.S economy

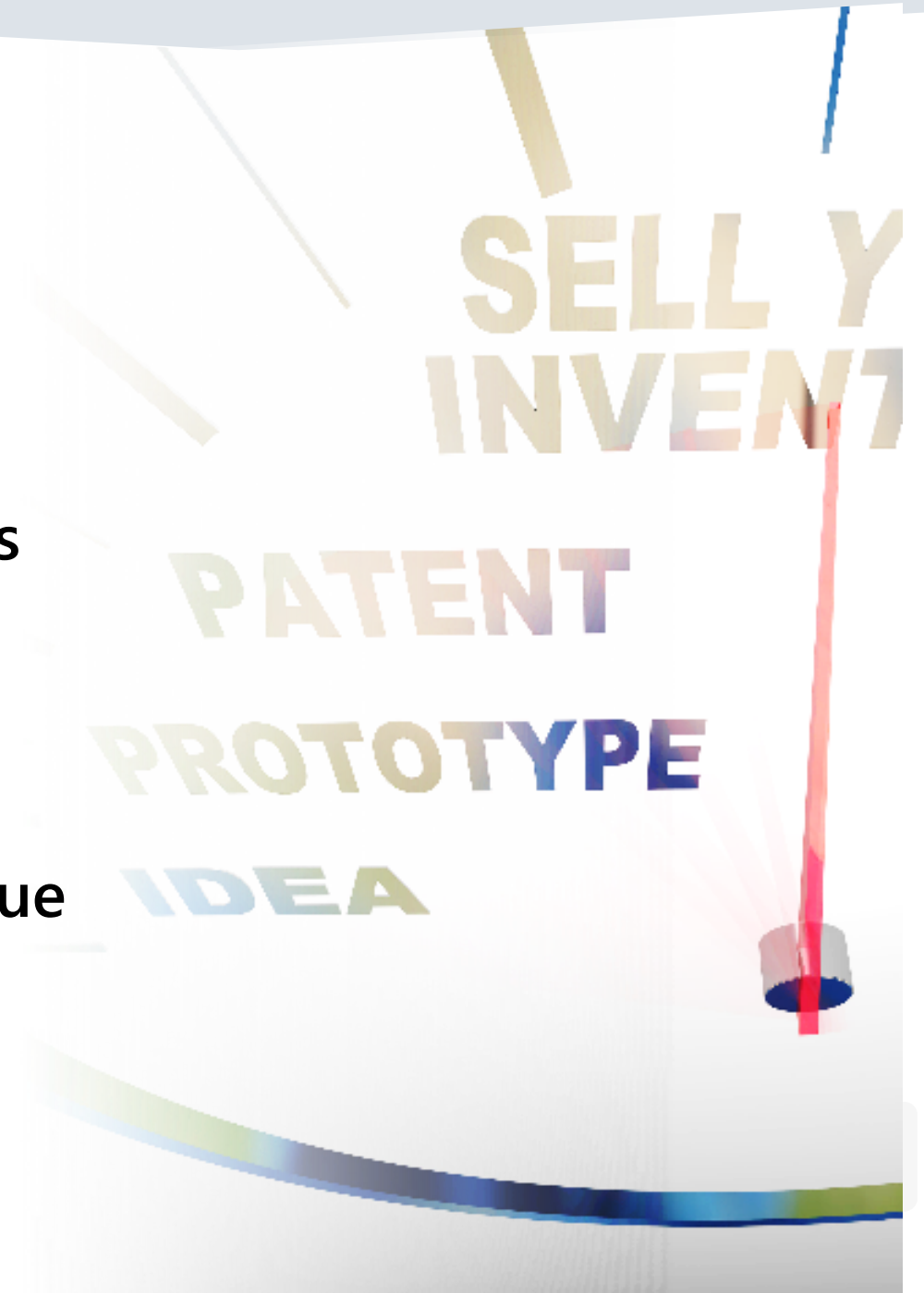
- 45.5 million jobs⁴
- 38.2% of U.S. GDP⁴
- 46% higher pay⁴



IP strategy IS a business strategy

IP:

- Is attractive to investors and buyers
- Deters infringement lawsuits
- Can increase leveraging power
 - Mergers and acquisitions
- Is a property right that can add value to a company's assets
- Is Global



Why invention matters/ what this means to you

Patents can:

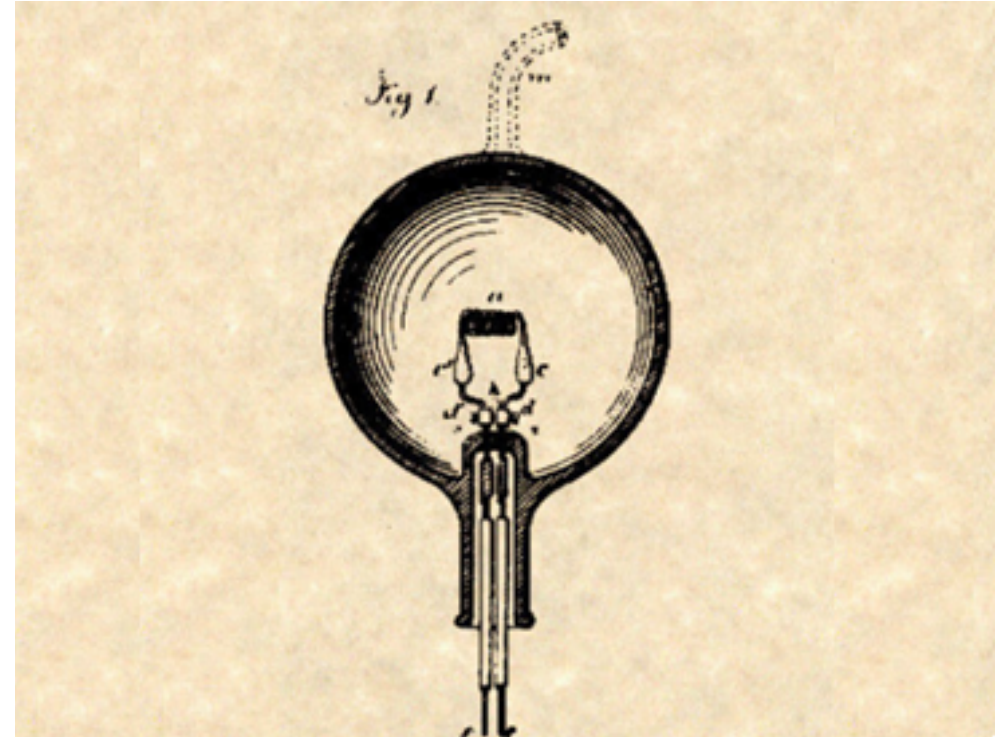
- Promote innovation and help safeguard your inventions
- Help companies grow
- Benefit the community by making new goods and services available
- Provide personal growth, development, and advancement



What is intellectual property?



Real property



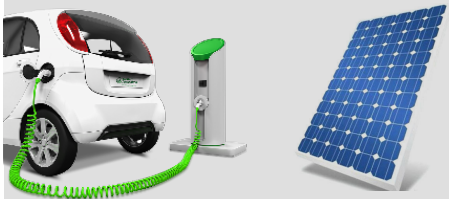
Intellectual property

Types of intellectual property



Patent

New, inventive ideas



Trademark

Identifies the origin of goods or services



Copyright

Creative expression stored in a tangible form



Trade secret

Any information that is valuable & kept confidential



The USPTO in FY19

12,652 employees

- **9,614** patent examiners
- **701** trademark examining attorneys
- **383** Patent Trial and Appeal Board team
- **73** Trademark Trial and Appeal Board team

Patents

- **665,231** applications filed
- **370,434** patents issued

Trademarks

- **673,233** trademark applications
- **297,774** Certificates of Registration

USPTO headquarters in
Alexandria, VA





Let's talk Trade Secrets!

Trade secrets



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Ways to lose a trade secret

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



Let's talk Copyrights!

Copyright

- Library of Congress
- Protects “original works of authorship” including literary, dramatic, musical, artistic, and certain other intellectual works
- Term: Author’s life + 70 years
- www.copyright.gov

Things protected by copyrights



Songs



Books



Movies



Sculptures





Let's talk Trademarks!

What is a trademark?

- Any word, slogan, symbol, design, or combination of these that:
 1. Identifies the source of your goods or services and
 2. Distinguishes them from the goods and services of another party

Examples of trademarks

Trademarks can be **WORDS**

STARBUCKS

NIKE

TARGET

Trademarks can be **DESIGNS**

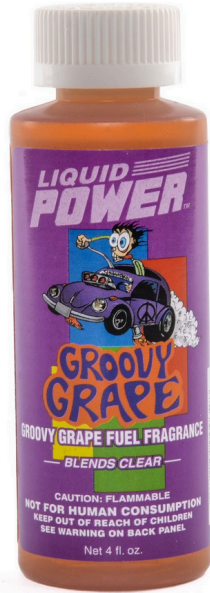


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Nontraditional marks – colors



Nontraditional marks – scents



verizon✓



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Nontraditional marks – sounds



NBC



uspto

Common law trademark

- Trademark that is **used** in commerce in connection with specified goods and services, but **not registered**
- Rights are limited to geographic area (based on use in that area)
- Optional symbols: TM SM
- U.S. is a first-to-use country
 - most countries are first-to-file



Federal registration advantages

- Public notice of claim of ownership
- Legal presumption of ownership and exclusive right to use mark in U.S. on/in connection with the goods/services listed in registration
- Ability to bring an action in federal court
- Use of U.S. registration as a basis to obtain registration in foreign countries
- Right to use the federal registration symbol ®
- Listing in the United States Patent and Trademark Office's online databases
- Registration may be recorded with U.S. Customs to prevent importation of infringing foreign goods
 - Recordation fee for trademarks is US \$190 per International Class of goods



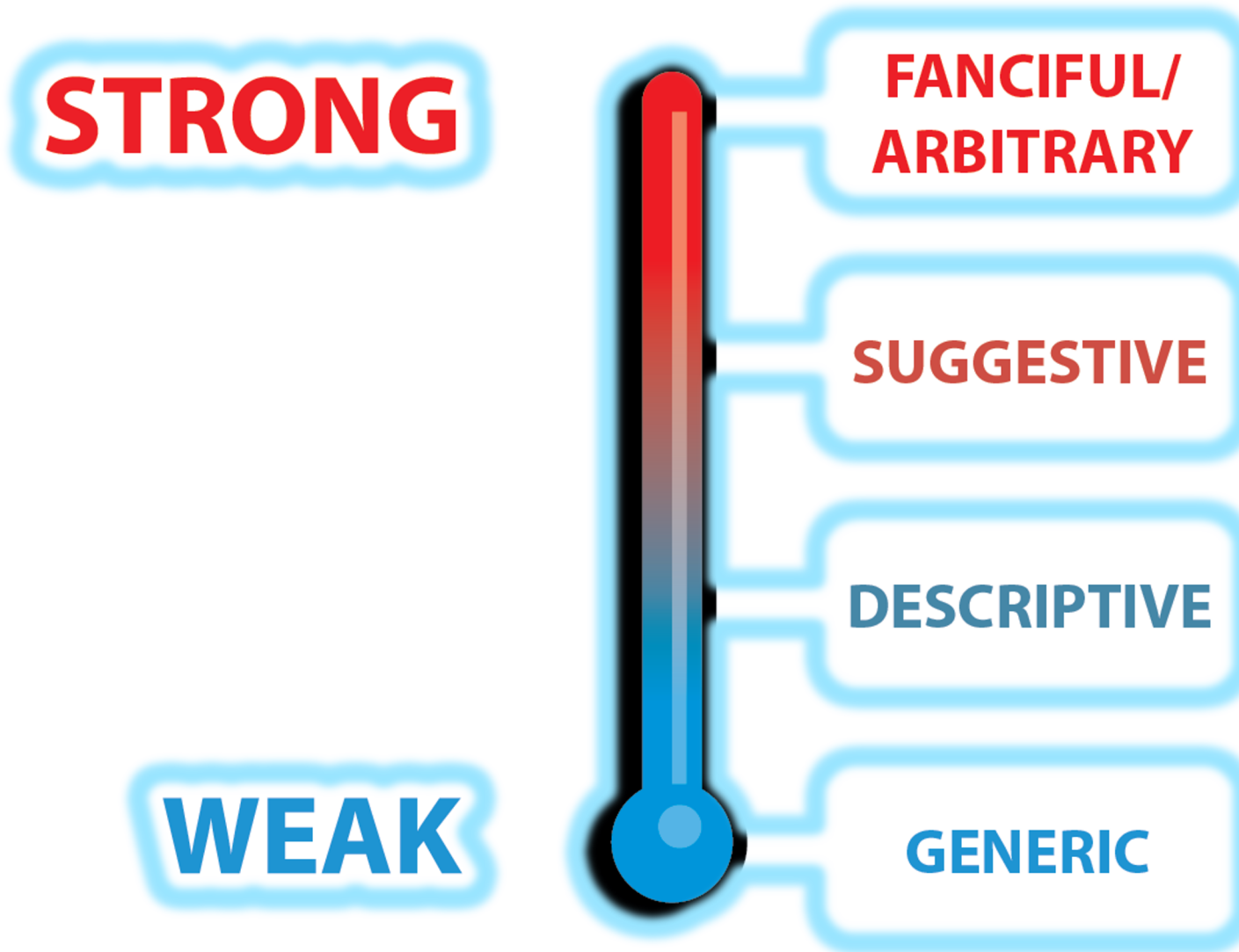
Trademark fees

- Trademark
- Application fee: \$225 per class (electronic filing, TEAS plus)
- Post-registration fees
 - Affidavit of use \$125 per class (after five years)
 - Application for renewal \$300 per class (after nine years)

Likelihood of confusion

- Are the marks confusingly similar?
 - Look alike? Sound alike? Have similar meanings?
Create similar commercial impressions?
- Are the goods and/or services related?
 - Encountered in the same channels of trade?
Complementary?

Strength of mark



Let's talk Patents!

What is a patent?

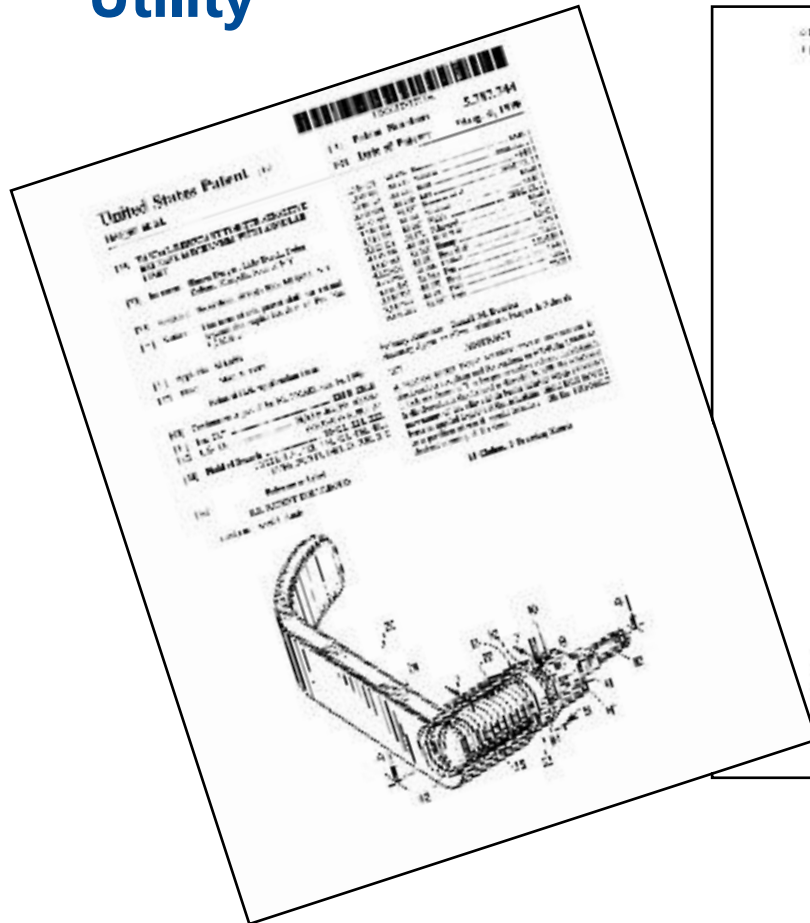
The right to **exclude others** from:

- making, using, selling, offering for sale, or importing the claimed invention
- Limited term
- Territorial: A U.S. patent provides protection only in the United States
 - No worldwide patents

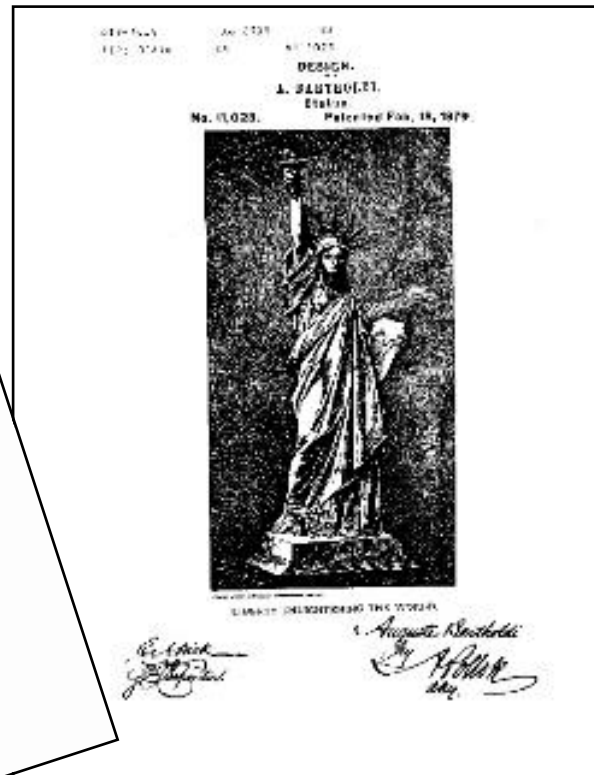


Types of patents

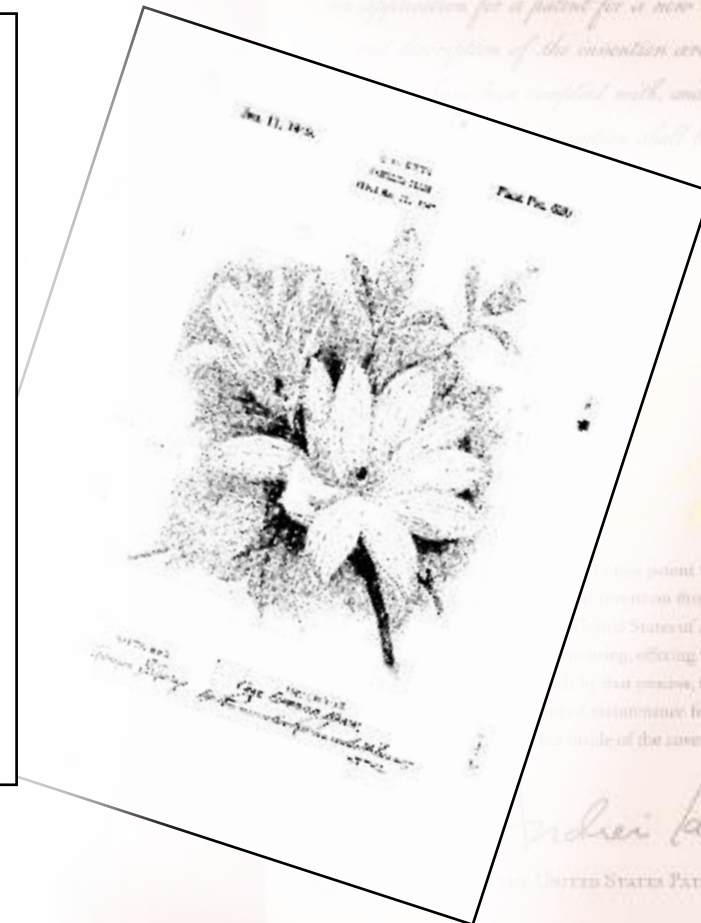
Utility



Design

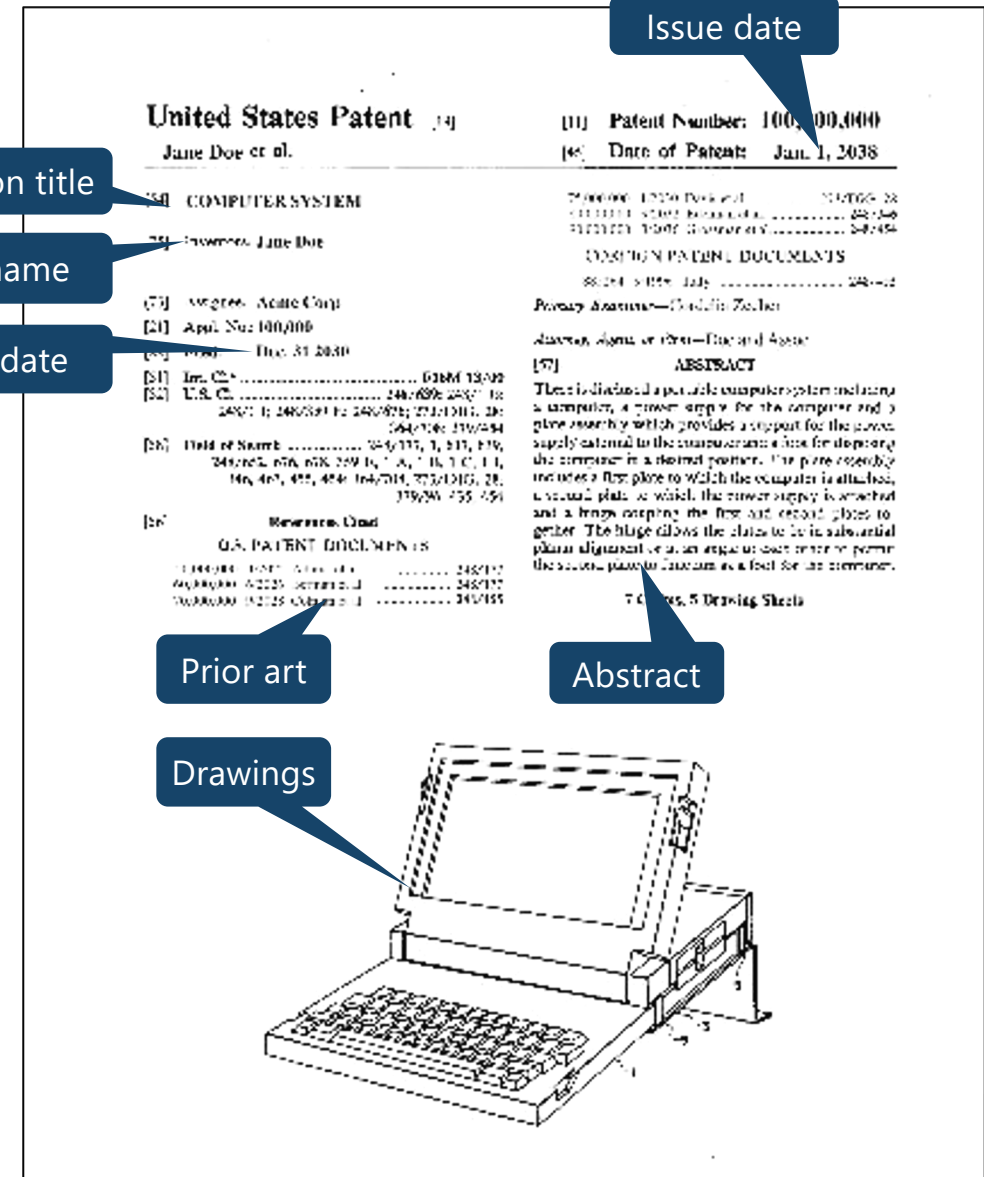


Plant



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.



Is your idea eligible for protection?



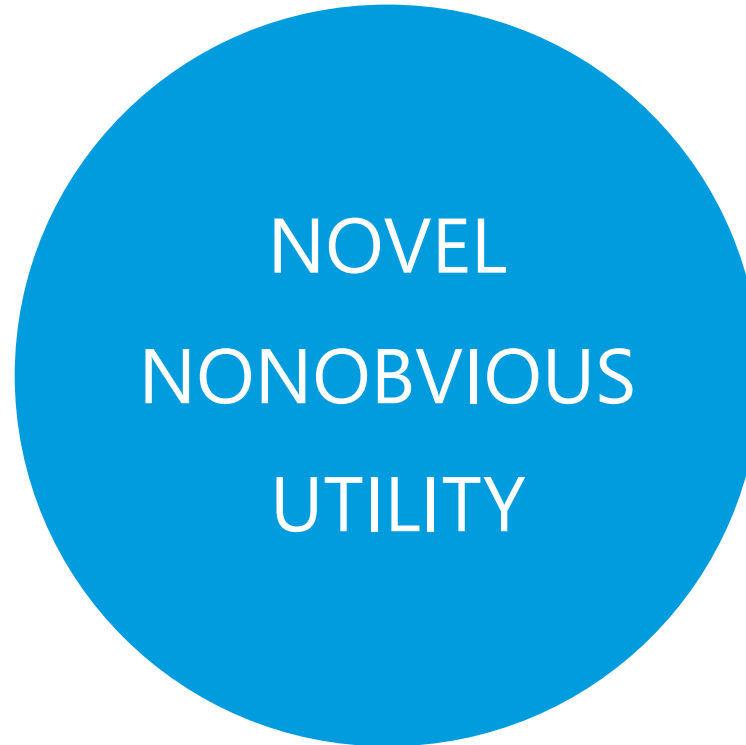
35 U.S.C. § 101



What Is patentable?

Products

- Physical Thing
- Manufacture
- Composition of Matter



Processes

Means to an end

- Means of doing something new
- New way of doing something old

Hurdles to Patenting

Is your invention:

- “Novel”: e.g., your invention is new, was not described in the prior art or known
- “Non-obvious”: e.g., the differences between your invention and prior art would not have been obvious to someone in that field
- Does it have “utility”: e.g., does it function as intended

35 U.S.C. §§ 101, 102 and 103



What is prior art?

Prior art includes: patents, printed publications, and other disclosures in the field of your invention that have been published before your effective filing date.



What is NOT patentable?

- **Cannot** patent an idea
 - Must be able to be developed into a **new, nonobvious** and **useful machine, manufacture, process**, or **composition of matter** that can actually accomplish the task
- **Cannot** patent natural phenomena
- **Cannot** patent abstract ideas

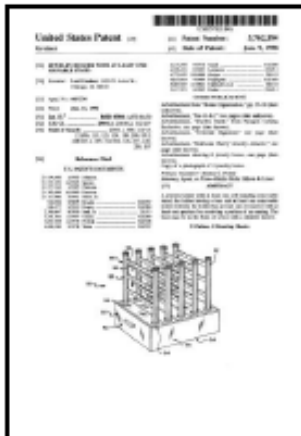
Applying for a Patent

Types of patents

Utility

Protects how an invention works, functions, or is made for 20 years from filing date

- Process
- Machine
- Article of manufacture
- Composition of matter



Design

Protects the way a product or article looks, the ornamental expression for 15 years from the date of grant



Plant

Protects newly invented strains of asexually reproducing flowering plants, fruit trees, and other hybrid plants for 20 years from filing date



Determine Filing Status

- **Large Entity**
- **Small Entity**
 - Universities, Non-profits, and Small Businesses with fewer than 500 employees
- **Micro Entity**
 - Entities with a gross income less than 3x the U.S. media household income.
 - *Certification required

Utility patent fees

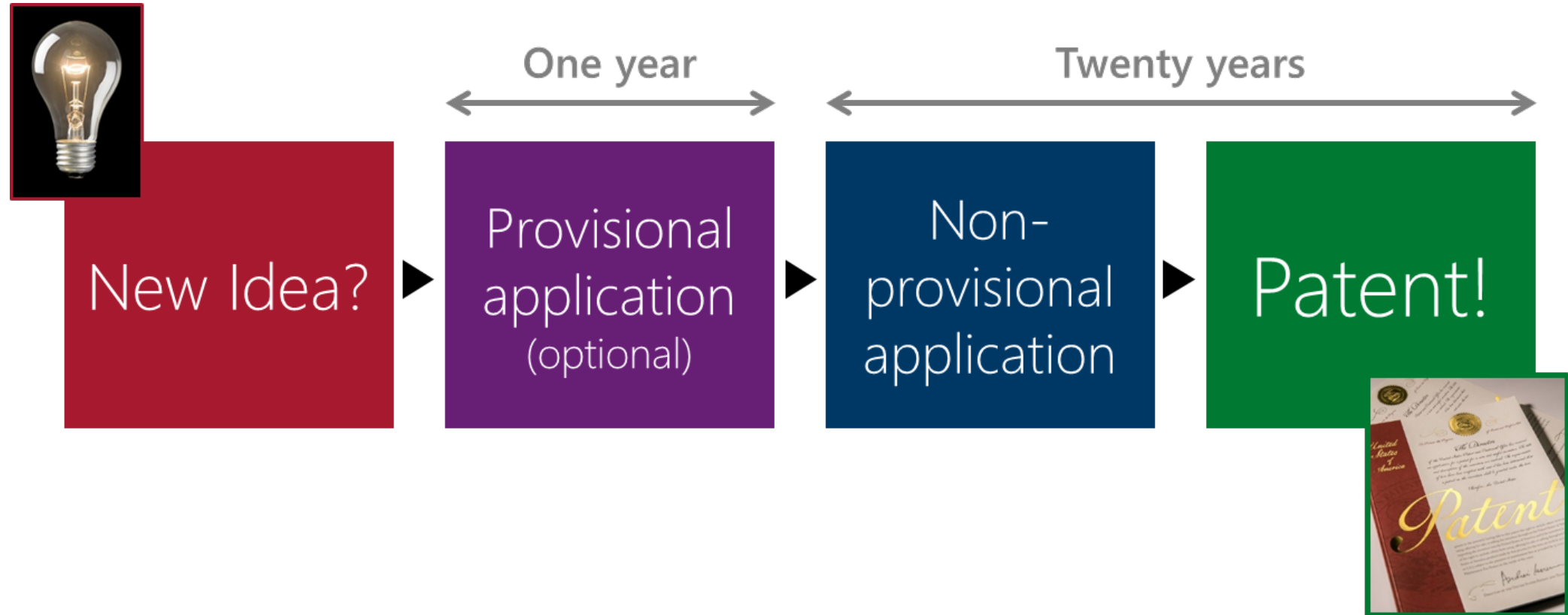
	Large entity	Small entity	Micro entity
Basic filing fee	\$300	\$150	\$75
Search fee	\$660	\$330	\$165
Examination fee	\$760	\$380	\$190
Initial cost	\$1720	\$860	\$430
Issue fee	\$1000	\$500	\$250

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 path to a patent



Provisional vs. non-provisional

Provisional	Non-provisional
<ul style="list-style-type: none">• Not examined or published• One year time limit• Only for utility patents• A low-cost way to establish an early effective filing date (priority date) in a non-provisional patent application with few formalities	<ul style="list-style-type: none">• Examined• Published 18 months from earliest filing date (unless a request for a non-publication at filing)• Can become a patent

Provisional utility applications

- A low-cost way to establish an early effective filing date (priority date) with fewer formalities
- A provisional application does NOT issue as a patent, but a later-filed non-provisional application may issue as a patent and benefit from the provisional application filing date
- 12 month window to file corresponding utility non-provisional patent application in order to benefit from the priority date of the provisional application
- Provisional application is abandoned automatically at 12 months and is not examined



Provisional utility application

Additional benefits of a provisional application:

- Patent term measured from filing date of subsequent **non-provisional** application
 - Patent term is currently 20 years from the date of filing
 - Provides up to an additional 12 months of protection on your invention based on filing of the non-provisional.
- 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

Nonprovisional patent application

- **Filing Requirements for Examination**
- A specification, including a description and a claim or claims
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
 - Oath or declaration or an application data sheet
- The prescribed filing, search, and examination fees



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,
- You must fully disclose your invention so the public can benefit from it and expand on it.

35 U.S.C. § 112



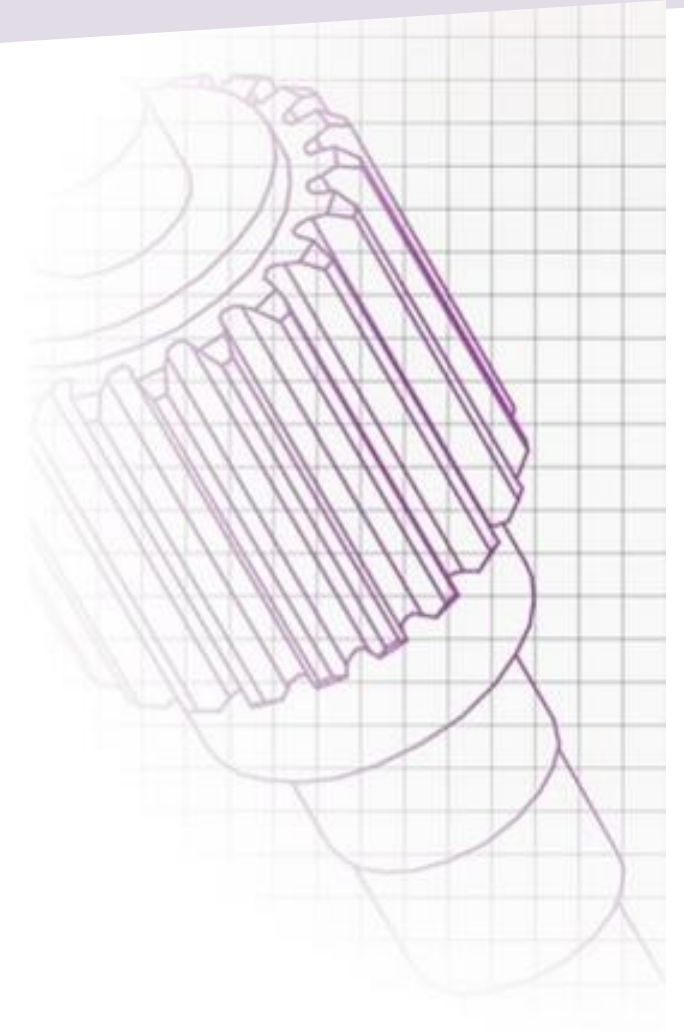
What do I need to disclose?

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)



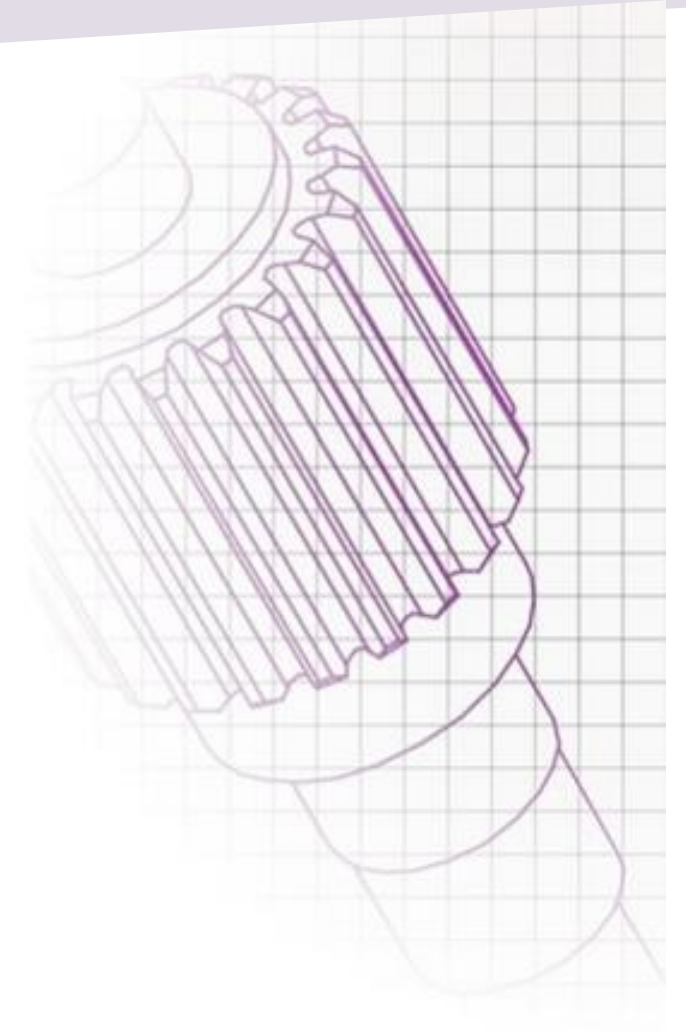
What do I need to disclose?

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)



Sample claim

Claim 1. A chair comprising:

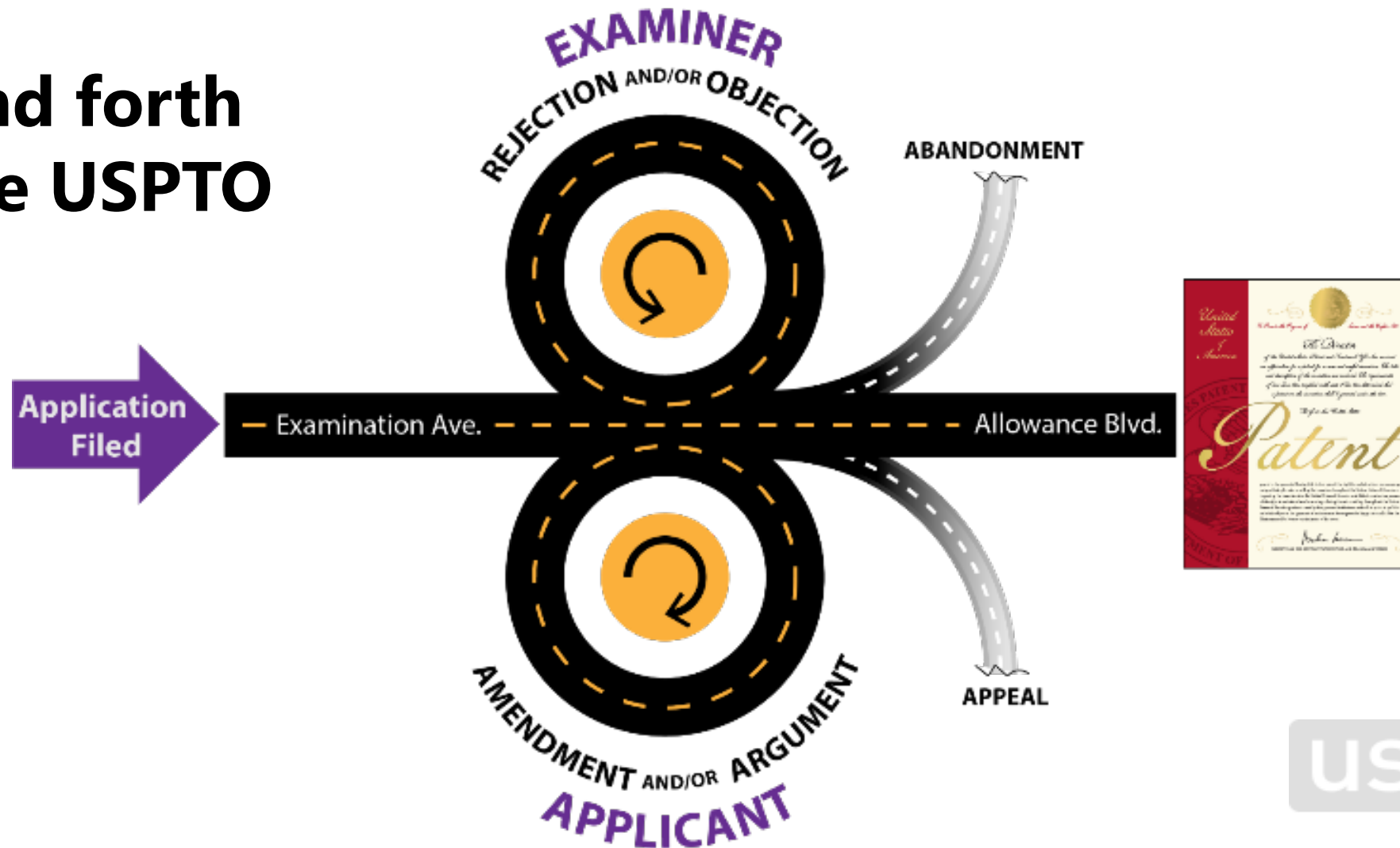
- a seat,
- a back support attached to the seat,
- support arms attached to the seat and back support, and
- a base comprising a plurality of legs attached to the seat.

United States Patent		101,000,000
Doe		January 1, 2000

<p>[57] SWIVEL CHAIR</p> <p>[58] Inventor: Jane Doe</p> <p>[59] Assignee: Anne Manufacturing</p> <p>[60] Appl. No.: 1/000,000</p> <p>[61] Filed: January 1, 2000</p> <p>[62] Int. Cl.: A47C 3/03</p> <p>[63] U.S. Cl.: 298/224; 297/284; 518/507</p> <p>[64] Field of Search: 298/224; 297/284; 518/507; 298/224; 297/284; 518/507</p>	<p>[70] References Cited</p> <p>U.S. PATENT DOCUMENTS</p> <table border="0"> <tr> <td>4,567,890</td> <td>1/19/91</td> <td>Adams</td> <td>248/222</td> </tr> <tr> <td>5,678,901</td> <td>7/19/91</td> <td>Boles</td> <td>248/222</td> </tr> <tr> <td>6,789,012</td> <td>11/19/91</td> <td>Conrad</td> <td>248/222</td> </tr> <tr> <td>7,890,123</td> <td>12/19/91</td> <td>Dunlop</td> <td>248/222</td> </tr> <tr> <td>8,901,234</td> <td>10/19/91</td> <td>Williams</td> <td>257/288</td> </tr> </table> <p>FOREIGN PATENT DOCUMENTS</p> <table border="0"> <tr> <td>5,678</td> <td>Canada</td> <td>248/222</td> </tr> </table> <p>Primary Examiner: Candice Yachet Attorney: U.S. & Foreign Law Firm</p> <p>[54] ABSTRACT</p> <p>A rotating swivel 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.</p> <p>3 Figures, 5 Drawing Figures</p>	4,567,890	1/19/91	Adams	248/222	5,678,901	7/19/91	Boles	248/222	6,789,012	11/19/91	Conrad	248/222	7,890,123	12/19/91	Dunlop	248/222	8,901,234	10/19/91	Williams	257/288	5,678	Canada	248/222
4,567,890	1/19/91	Adams	248/222																					
5,678,901	7/19/91	Boles	248/222																					
6,789,012	11/19/91	Conrad	248/222																					
7,890,123	12/19/91	Dunlop	248/222																					
8,901,234	10/19/91	Williams	257/288																					
5,678	Canada	248/222																						

The patent application roadmap

Back and forth
with the USPTO



Role of the USPTO examiner

- Read and understand the application
- Search for prior art
- Evaluate the specification and claim(s)
- Respond by office action(s) describing findings
- Hold interviews, as requested



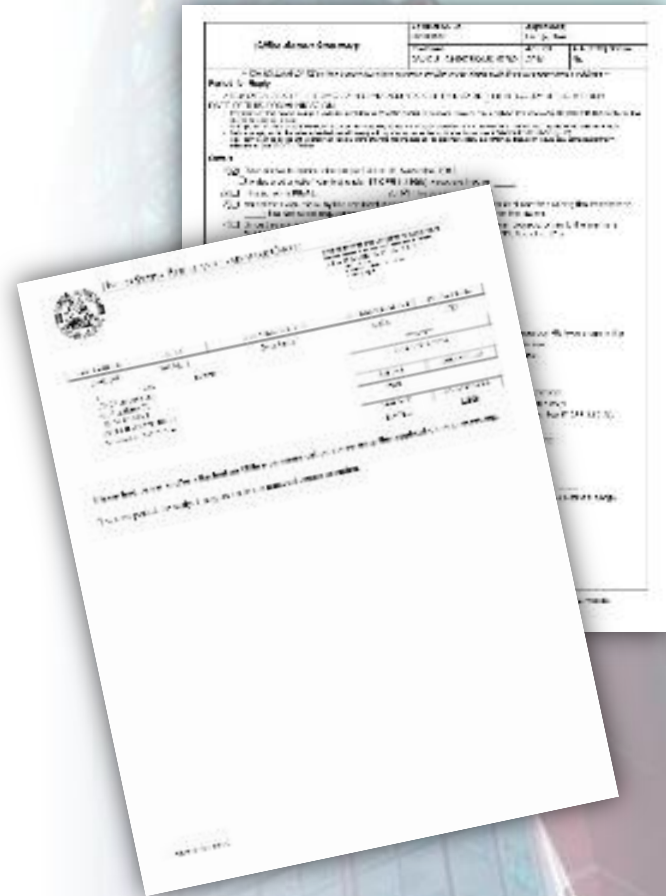
Role of the applicant

- 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 is a USPTO office action?

An office action sets forth the basis for any objections, rejections, and allowability.



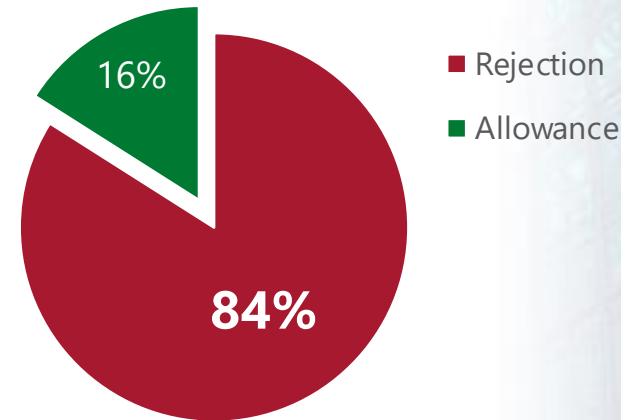
What does a rejection mean?

- 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.

Receive a rejection? Don't give up!

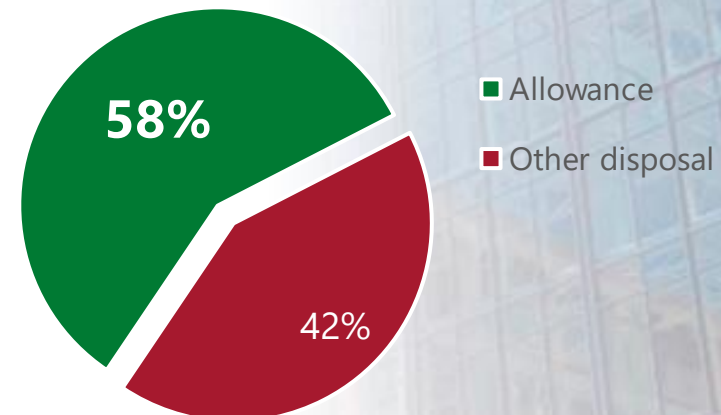
Fact: In FY 2019, 84% of original filings received a first office action containing a rejection.

FY 2019 first actions

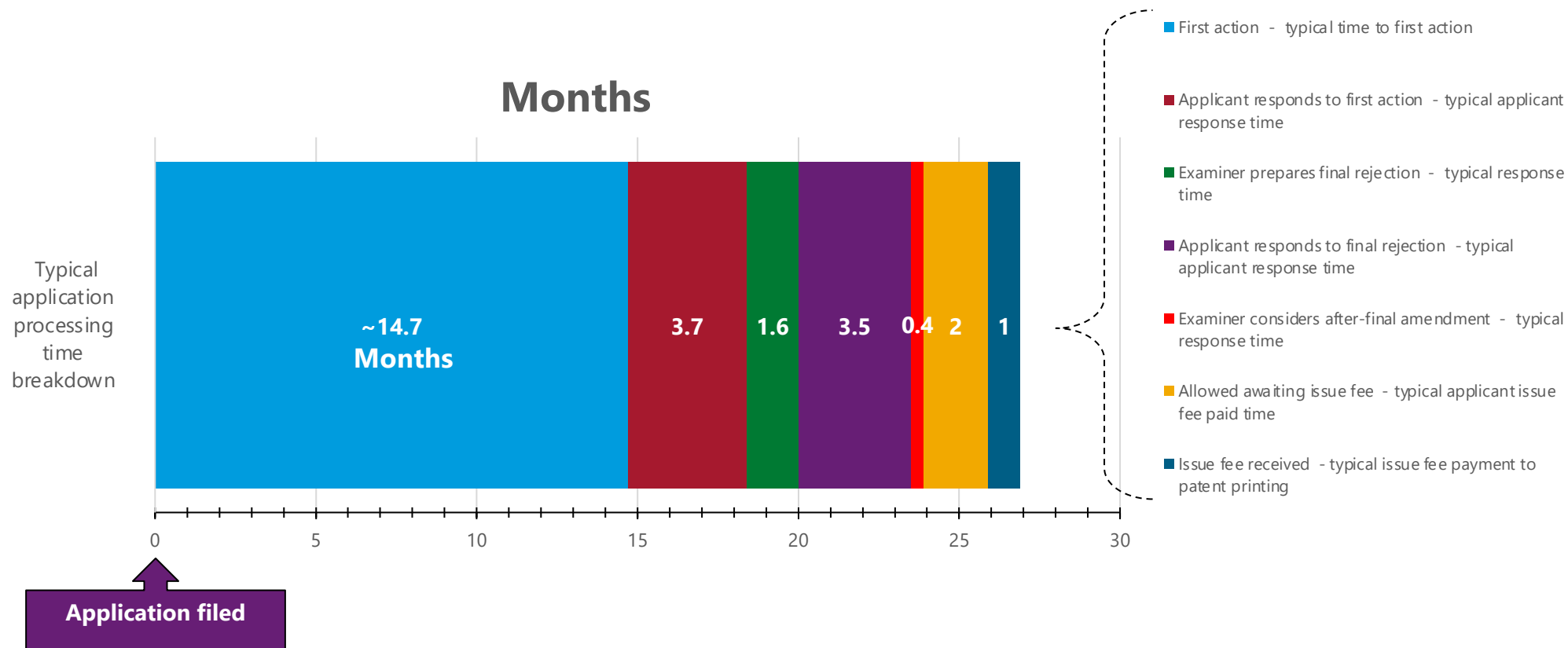


Fact: In FY 2019, 58% of examiner disposals were allowances.

FY 2019 percentage allowed



Typical processing timeline*



*Based on FY 2019 data

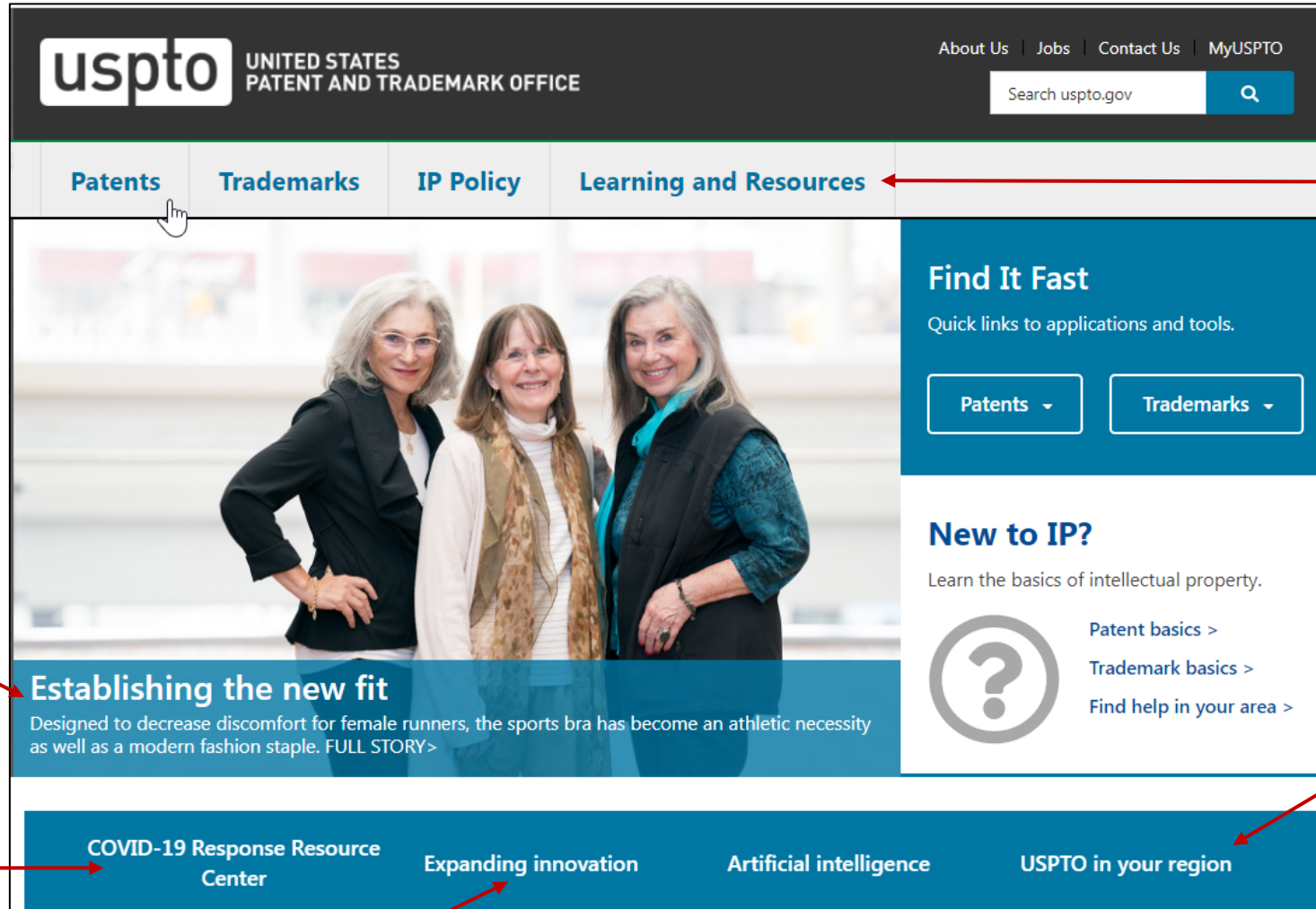
Allowance and issuance

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



USPTO resources

www.uspto.gov



Entrance into education for inventors, entrepreneurs, start-ups, kids, and teachers.

Inspiring stories of invention and innovation.

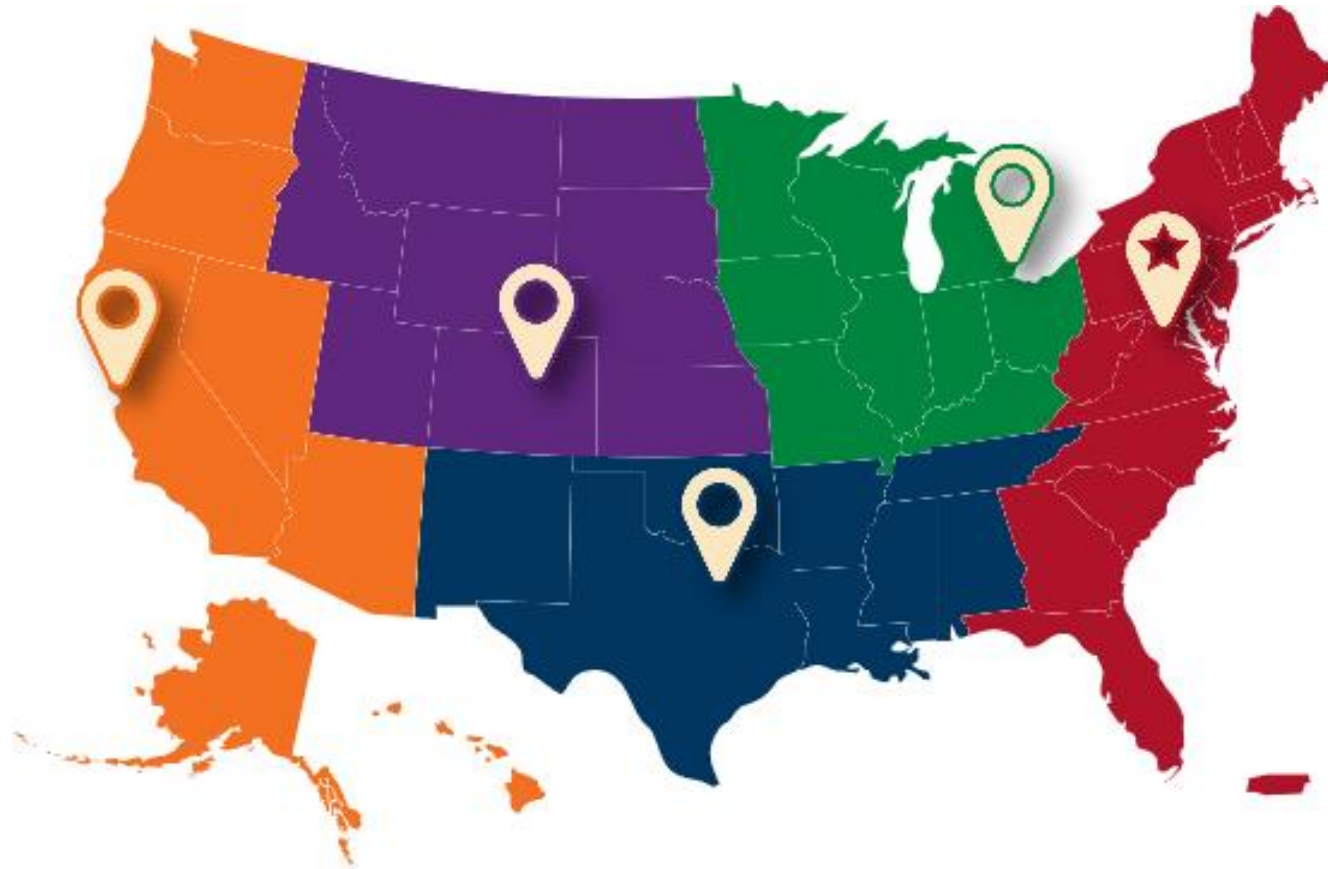
Easy access to COVID-19 relief and support



Find direct resources in your geographic location.




Includes demystifying the patent system toolkit.



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Find help in your area



 USPTO office location
 USPTO headquarters

 West Coast region
 Rocky Mountain region
 Texas region

 Midwest region
 East Coast region

USPTO offices:

Headquarters:

- Alexandria, VA

Regional offices:

- Detroit
- Denver
- Silicon Valley
- Dallas

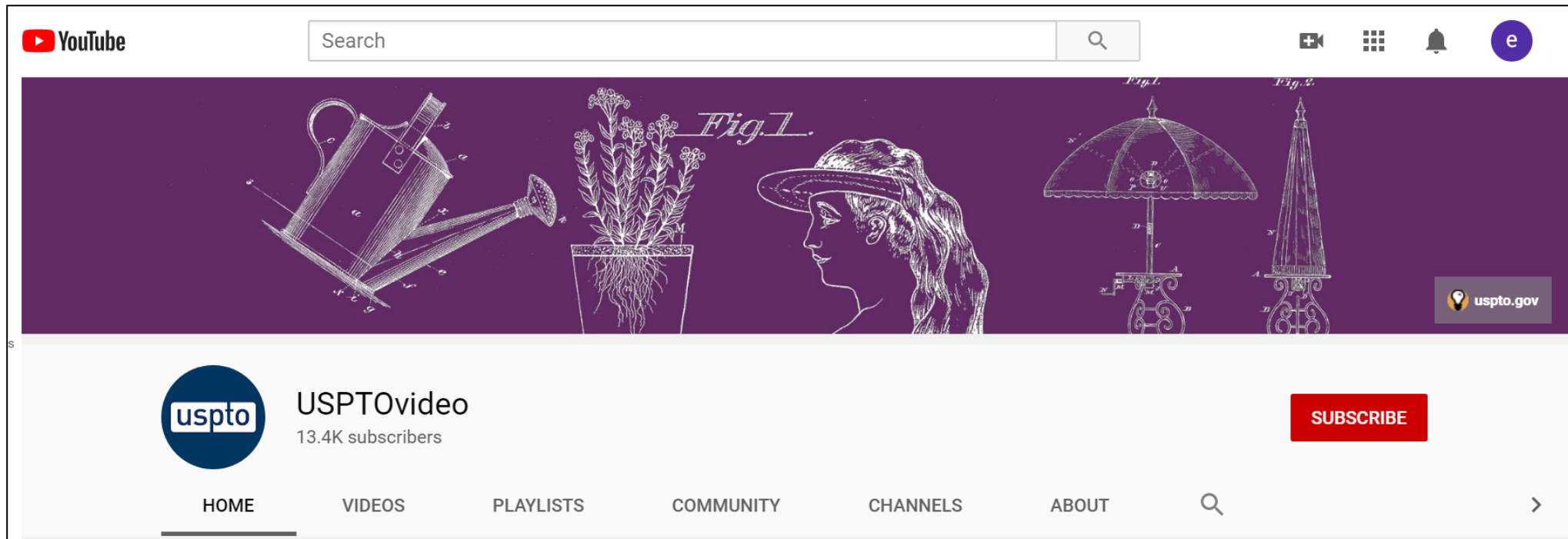
Additional resources:

- Inventors Assistance Center
- Patent Pro Bono Program
- Law school clinics
- Patent and Trademark Resource Centers

[uspto.gov](https://www.uspto.gov)



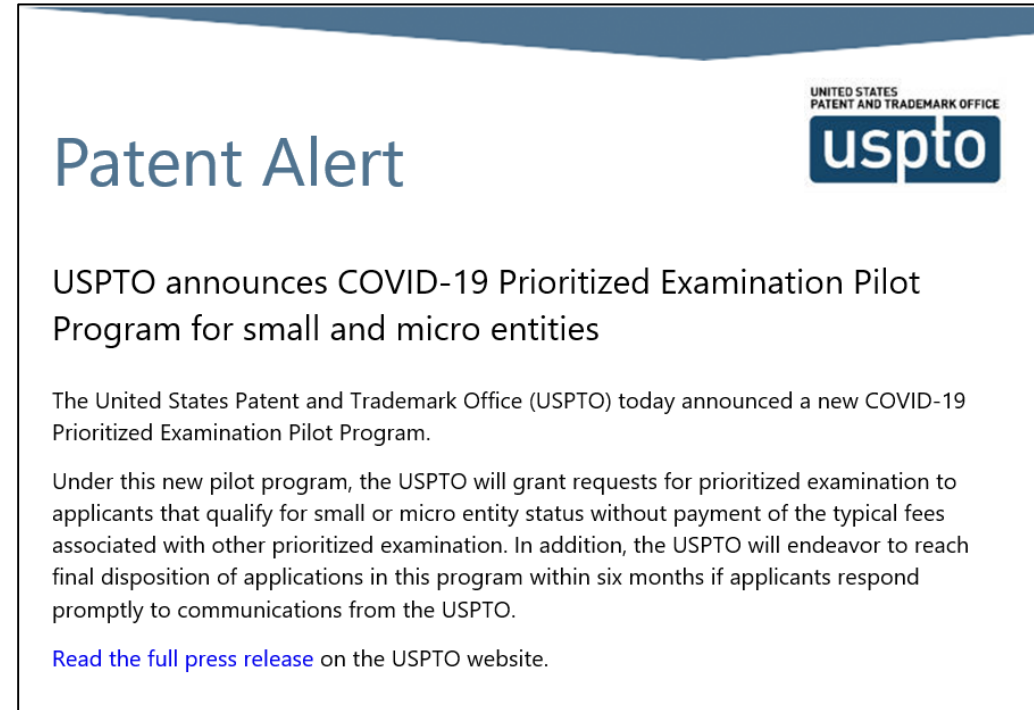
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- Copyright Alerts
- Patent Trial and Appeal Board
- USPTO Regional Office Updates
- USPTO Press Releases
- USPTO Director's Forum Blog
- USPTO Monthly Review
- FYI at the USPTO
- Inventors Eye
- Intellectual Property for K-12 Educators
- USPTO Awards



USPTO Events Webpage

The screenshot shows the USPTO Events webpage. At the top is the USPTO logo and navigation links. Below are tabs for Patents, Trademarks, IP Policy, and Learning and Resources. The main content area is titled 'Events' and includes filters for topics (Patents, Trademarks, General, Technical) and event types (Public Events, Changes to Law and Policy, Guidance / Training, Student / Parent / Teacher Programming, International Initiatives). A list of events for May 2020 is displayed, including sessions on claim drafting and patent application.

May	2020
12	Agents and attorneys: Learn to think like an examiner (STEPP) 3-day course - POSTPONED Boston, MA US 8:30 AM ET
14	Learn to argue before PTAB Virtual 12:00 AM ET
14	Small business owners: Learn to contract with the USPTO - POSTPONED Fort Belvoir, VA US 9:00 AM ET
14	Attend Patent Center and DOCX filing training 1:00 PM ET
15	Learn how to draft patent claims - virtual only San Jose, CA US 10:00 AM PT
15	Learn how to draft patent claims - teleconference only Virtual and Denver, CO US 11:00 AM MT

Learn how to draft patent claims - virtual only

Claim drafting may be the most important part of protecting your invention. Learn the basics of claim drafting from USPTO experts in this interactive workshop. You will develop a better appreciation of how a patent examiner views a claim during the course of examination. This event is free and open to the public, so [register early](#).

The May 15 session will be offered virtually via WebEx for those that have registered for the class.

To get the most out of this workshop, you should have an intermediate knowledge of the intellectual property system and of patents specifically. We recommend that you complete the previous sessions, "Learn the basics of intellectual property with a focus on patents" and "Learn how to draft your patent application" before attending.

Please note that the Silicon Valley USPTO is a federal facility. **Attendees are required to present a valid form of government-issued identification (driver license or passport)** and may be subject to screening to gain access.

This event is accessible to individuals with disabilities. To request a reasonable accommodation, including captioning, sign language interpreting, or other, please email siliconvalley@uspto.gov or call 408-918-9900.

[Register today](#)



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Startup Resources

Many startup businesses face unique IP-related challenges, such as IP portfolio prerequisites to secure funding, and the possibility of costly patent infringement demand letters and lawsuits. We have tailored this area of our website to suit the specific needs of startup businesses, a segment of our stakeholders that continues to be recognized as an outsized engine of job creation, economic growth, and unparalleled innovation in the United States.

Patents for startups

The patent process can be challenging if you are not familiar with it. Here is basic information on the patent process.

- [Patent Process Overview](#)
- [Inventors Assistance Center](#)
- [Patent FAQs](#)
- [Patent Homepage](#)
- [Search for Patents](#)

Trademarks for startups

The trademark process can be confusing for a beginner, so here is basic information on registering a trademark.

- [Trademark Basics](#)
- [Search for Trademarks](#)
- [Filing online](#)
- [Trademark Homepage](#)

Startup assistance

The Inventors Assistance Center and Trademark Assistance Center provide information and services to the public. Center staff can answer questions on patent and trademark processes, but cannot provide specific legal advice.

- [Inventors Assistance Center](#)
- [Trademark Assistance](#)

Current events

Information about conferences, conventions and other opportunities to engage.

- [Upcoming USPTO Events](#)

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Inventors Assistance Center (IAC)

The Inventors Assistance Center (IAC) provides patent information and services to the public. The IAC is staffed by former supervisory patent examiners and experienced former primary examiners who answer general questions concerning patent examining policy and procedure.

Monday – Friday,
8:30 a.m. – 8 p.m. ET,
except federal holidays

- 800-PTO-9199
(800-786-9199)
- 571-272-1000

**TTY customers can dial
800-877-8339 for
customer assistance**

Trademark Assistance Center (TAC)

- Provides general information about the registration process
- Responds to status inquiries
- Hours of Operation
 - 8:30 a.m. – 8 p.m. (ET), Monday through Friday
- Phone
 - (571) 272-9250 or (800) 786-9199
- Email
 - TrademarkAssistanceCenter@uspto.gov
- Webpage: www.uspto.gov/TrademarkAssistance



Pro Se Assistance Program

The USPTO recognizes that the cost of legal assistance is prohibitive for many applications, particularly independent inventors and small businesses.

The Pro Se Assistance Program is dedicated to help independent inventors and small businesses meet their goal of protecting valuable intellectual property

- Provides outreach and education to applicants who file patents applications without the assistance of a registered patent attorney or agent
- The USPTO aims to increase the quality of pro se applications and assist pro se applicants with making informed decisions regarding their patent applications
- One-on-one assistance via video conference or telephone to meet with applicants to answer questions and assist in filing applications
- innovationdevelopment@uspto.gov
- 1-866-767-3848



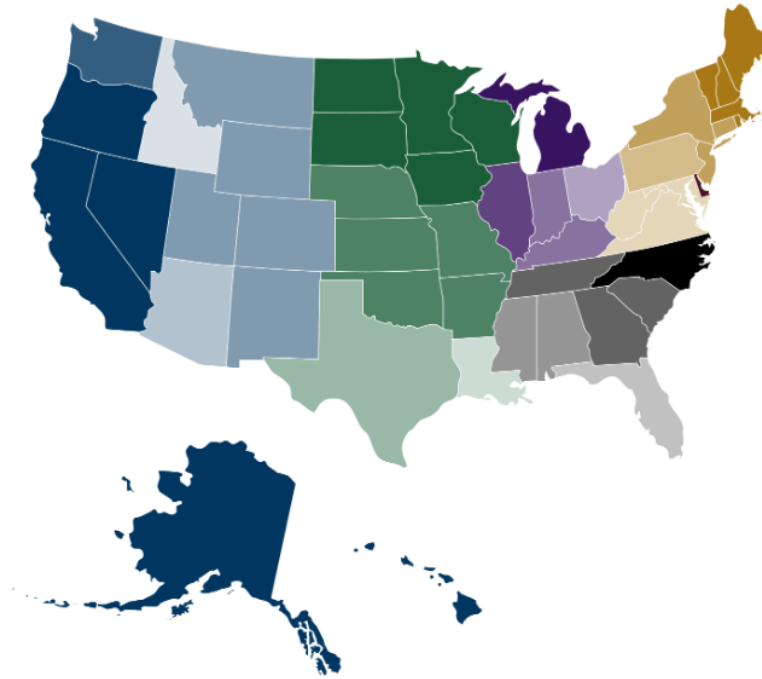
USPTO Patent Pro Bono Program

Nationwide network that assists financially underresourced independent inventors and small businesses.

- Coverage in all 50 states achieved and maintained since August 2015
- Program participants must:
 - Have income of 300% below federal poverty guidelines
 - Pay USPTO filing fees and costs
 - Demonstrate knowledge of the patent system
 - Take training course at www.uspto.gov/video/cbt/certpck/index.htm
 - Have application prescreened to ensure that there is more than an idea



Pro Bono Program organizations



- | | | |
|--------------------------------------|--------------------------------------|------------------------------|
| ■ Washington Pro Bono Patent Network | ■ Gateway Venture Mentoring Service | ■ New York Tri State Program |
| ■ Idaho Patent Pro Bono | ■ TALA | ■ Delaware Program |
| ■ CLA | ■ The Ella Project | ■ FCBA (Mid-Atlantic) |
| ■ ProBoPat | ■ Chicago-Kent Patent Hub | ■ PA Patent |
| ■ Arizona Public Patent Program | ■ PatentConnect for Hoosiers (IN KY) | ■ NC Leap |
| ■ LegalCorps (MN) | ■ Ohio Inventis | ■ Georgia Patents |
| ■ Pro Bono Patent Project (MI) | ■ BBVLP Patent Program (MS AL) | ■ Patent Pro Bono FL |
| | ■ New England Program | |



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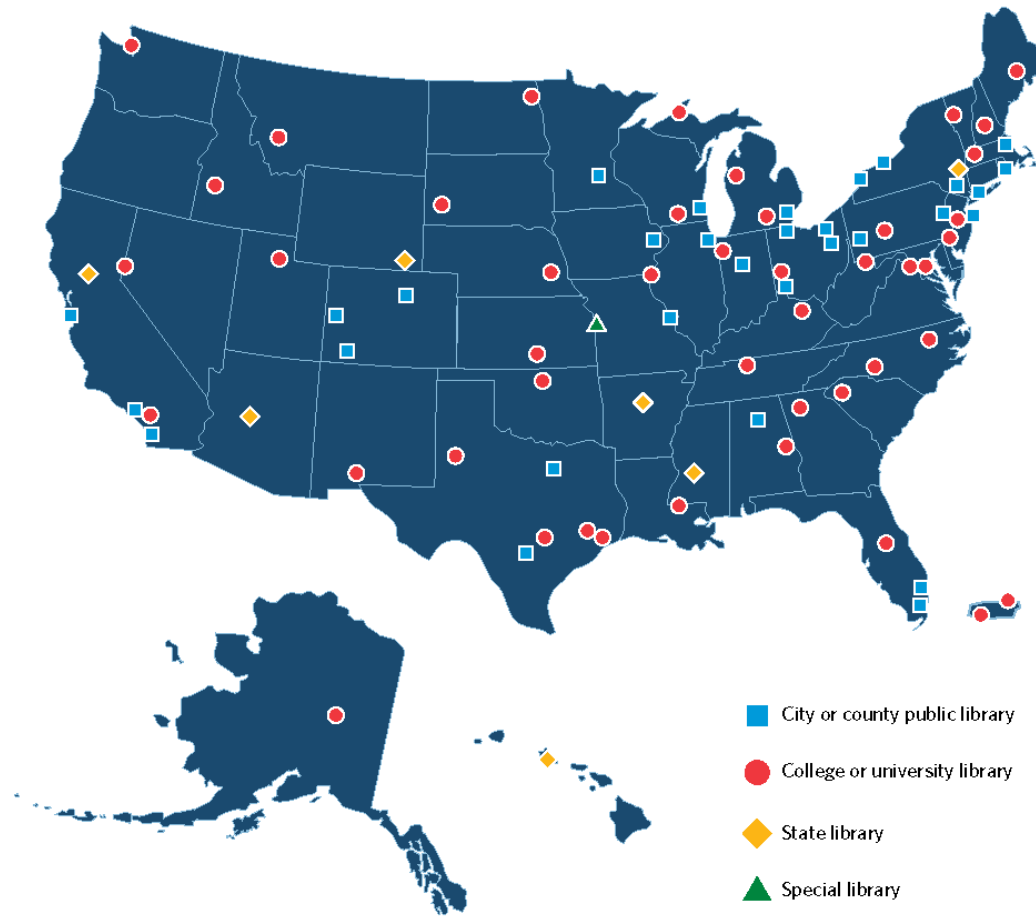
Law School

CLINIC CERTIFICATION PROGRAM



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Patent and Trademark Resource Center (PTRC) locations

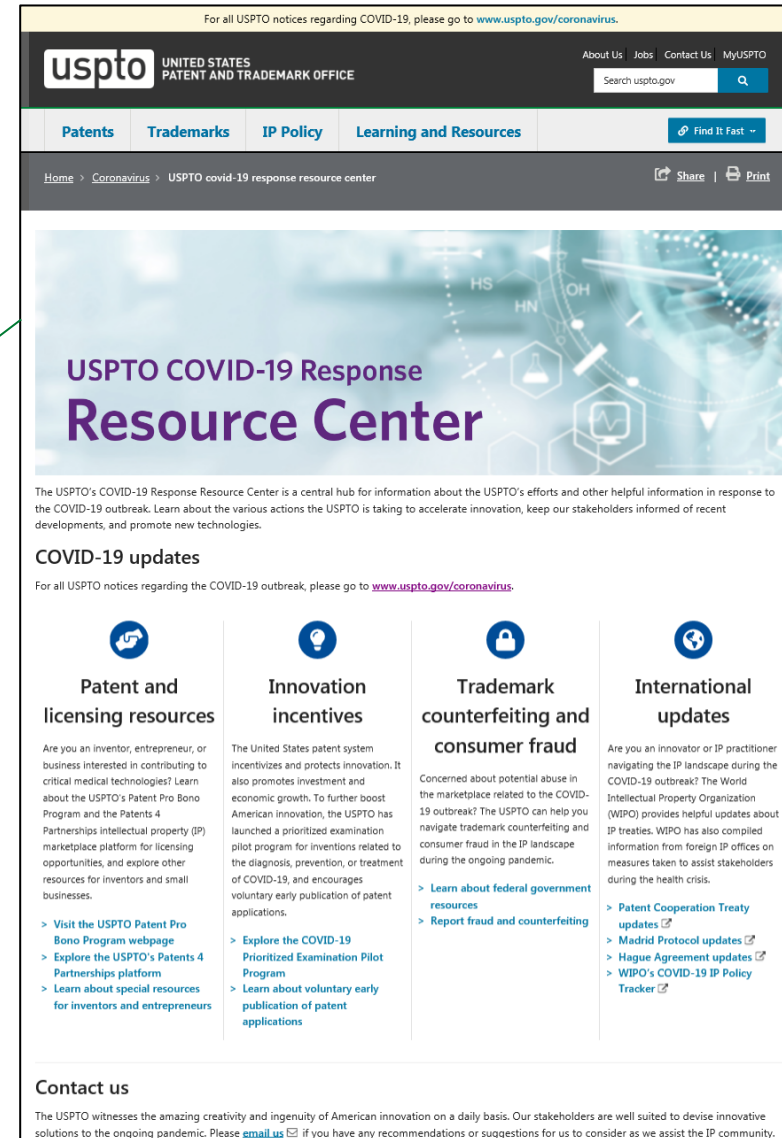
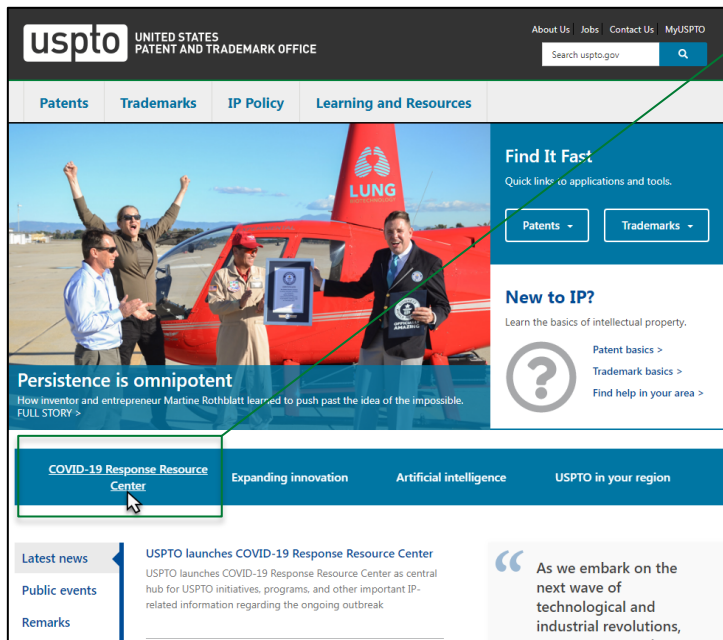


COVID-19 Response Resource Center

Response Resource Center

The United States Patent and Trademark Office (USPTO) has posted all COVID-19 resources and updates on a page dedicated solely to COVID-19.

The COVID-19 Response Resource Center webpage is accessible via the USPTO homepage.



Response Resource Center

- The COVID-19 Response Resource Center is a central hub for information about the USPTO's efforts to accelerate innovation, keep our stakeholders informed of recent developments, and promote new technologies.
- The webpage details:
 - Patent and licensing resources
 - Innovation incentives
 - Trademark counterfeiting and consumer fraud
 - International updates
 - Contact information for the USPTO

For all USPTO notices regarding COVID-19, please go to www.uspto.gov/coronavirus.



USPTO COVID-19 Response Resource Center

The USPTO's COVID-19 Response Resource Center is a central hub for information about the USPTO's efforts and other helpful information in response to the COVID-19 outbreak. Learn about the various actions the USPTO is taking to accelerate innovation, keep our stakeholders informed of recent developments, and promote new technologies.

COVID-19 updates

For all USPTO notices regarding the COVID-19 outbreak, please go to www.uspto.gov/coronavirus.

Patent and licensing resources	Innovation incentives	Trademark counterfeiting and consumer fraud	International updates
<p>Are you an inventor, entrepreneur, or business interested in contributing to critical medical technologies? Learn about the USPTO's Patent Pro Bono Program and the Patents 4 Partnerships intellectual property (IP) marketplace platform for licensing opportunities, and explore other resources for inventors and small businesses.</p> <ul style="list-style-type: none"> > Visit the USPTO Patent Pro Bono Program webpage > Explore the USPTO's Patents 4 Partnerships platform > Learn about special resources for inventors and entrepreneurs 	<p>The United States patent system incentivizes and protects innovation. It also promotes investment and economic growth. To further boost American innovation, the USPTO has launched a prioritized examination pilot program for inventions related to the diagnosis, prevention, or treatment of COVID-19, and encourages voluntary early publication of patent applications.</p> <ul style="list-style-type: none"> > Explore the COVID-19 Prioritized Examination Pilot Program > Learn about voluntary early publication of patent applications 	<p>Concerned about potential abuse in the marketplace related to the COVID-19 outbreak? The USPTO can help you navigate trademark counterfeiting and consumer fraud in the IP landscape during the ongoing pandemic.</p> <ul style="list-style-type: none"> > Learn about federal government resources > Report fraud and counterfeiting 	<p>Are you an innovator or IP practitioner navigating the IP landscape during the COVID-19 outbreak? The World Intellectual Property Organization (WIPO) provides helpful updates about IP treaties. WIPO has also compiled information from foreign IP offices on measures taken to assist stakeholders during the health crisis.</p> <ul style="list-style-type: none"> > Patent Cooperation Treaty updates > Madrid Protocol updates > Hague Agreement updates > WIPO's COVID-19 IP Policy Tracker

Contact us

The USPTO witnesses the amazing creativity and ingenuity of American innovation on a daily basis. Our stakeholders are well suited to devise innovative solutions to the ongoing pandemic. Please [email us](mailto:email.us) if you have any recommendations or suggestions for us to consider as we assist the IP community.



Thank you!

Elizabeth Dougherty

Eastern Regional Outreach
Director

Elizabeth.dougherty@uspto.gov

571.272.8600

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