UNITED STATES PATENT AND TRADEMARK OFFICE



Intellectual Property, and Resources for Small Business Owners, Entrepreneurs, and Independent Inventors

David Le Rocky Mountain Regional Office



IP and the U.S. economy

27.9m

IP intensive jobs (2014)

38.2%

IP intensive industries share of total US GDP (2014)

\$6.6 trillion

Value add of IP-intensive industries (2014)

\$1,312/week

(46% higher)

Avg. weekly wages for workers in IPintensive industries **\$115.2** billion

Revenue specific to the licensing of IP rights totaled (2012)

28 industries

Deriving revenues from licensing

Source: Department of Commerce. 2016. "Intellectual Property and the U.S. Economy: 2016 Update". September 26. www.uspto.gov/sites/default/files/documents/IPandtheUSEconomySept2016.pdf (January 3, 2018).



The USPTO in FY19

12,652 employees

- 8294 patent examiners
- 627 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

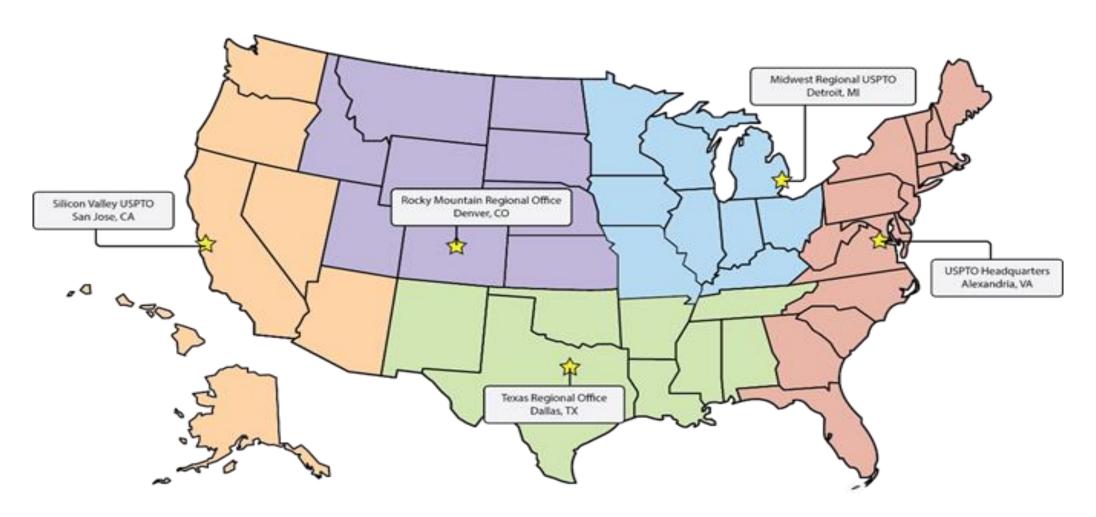
Trademarks

- 494,513
 trademark
 applications
- 297,774
 Certificates of Registration

USPTO headquarters in Alexandria, VA





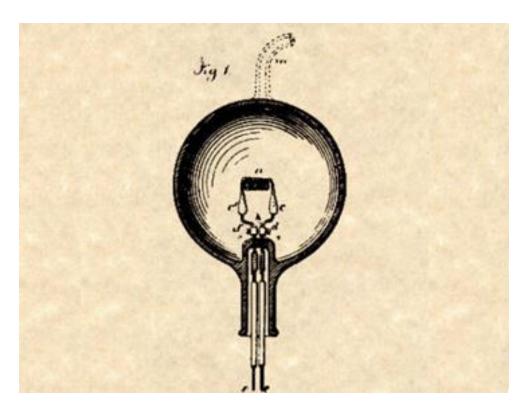


uspto

What is intellectual property?



Real property



Intellectual property



Types of intellectual property



New, inventive ideas





Trademark

Identifies the origin of goods or services







Creative expression stored in a tangible form







Trade secret

Any information that is valuable & kept confidential





Trade secrets



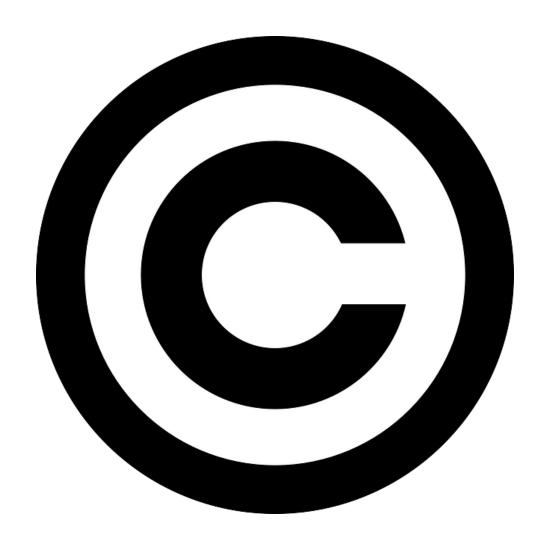




Ways to lose a trade secret

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





uspto

Things protected by copyrights



Songs













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





Different purposes, different results

- Domain name # Trademark registration
- Business name # Trademark registration



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)

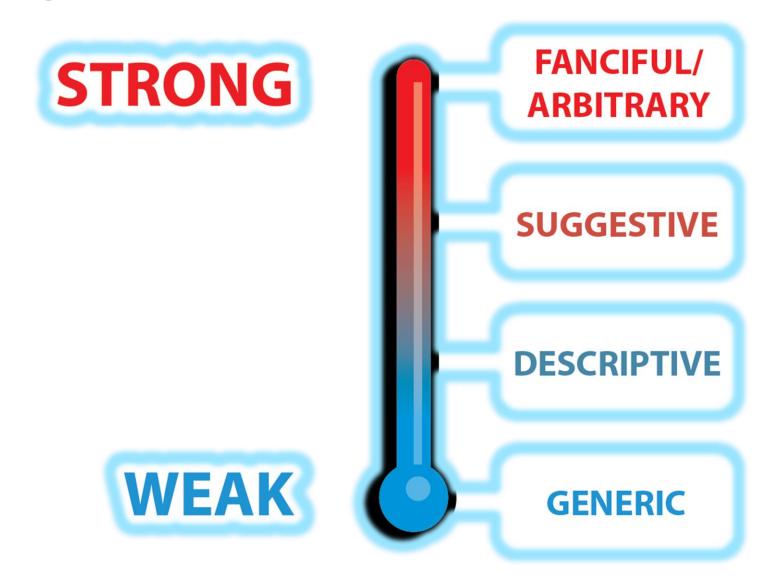


Likelihood of confusion

- 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





Examples of trademarks

Trademarks can be **WORDS**

Trademarks can be **DESIGNS**

STARBUCKS



NIKE



TARGET





Nontraditional marks – colors









Nontraditional marks – scents

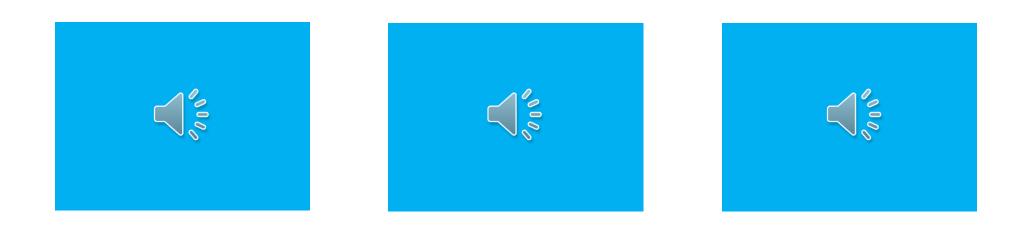








Nontraditional marks – sounds





Trade dress







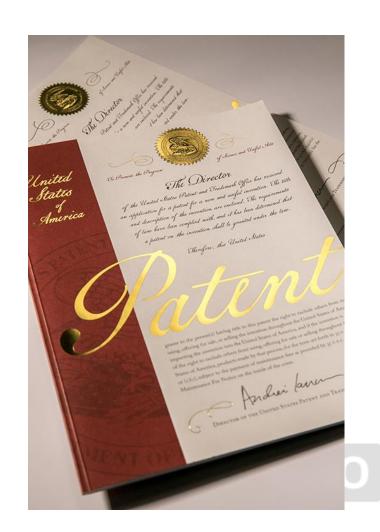




Patents

A U.S. patent is

- A property right granted by the United States government to an inventor
- To exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States
- For a limited time
- In exchange for public disclosure of the invention



Why get a patent?

- Gain entry to a market
- Exclude others from a market
- Use it as a marketing tool to promote unique aspects of a product
- Sell or license, like other property



Why invention matters

- Patents promote innovation and help safeguard your inventions.
- Innovation benefits the community by making new goods and services available.
- Patents help companies grow.
- Patents shape industries.



Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.



Patent eligibility requirements

What can be patented:

- Process
- Machine
- Article of manufacture
- Composition of matter
- Improvement of any of the above
- Ornamental design of an article of manufacture
- Asexually reproduced plant varieties

What cannot be patented:

- Law of nature
- Physical phenomena
- Abstract ideas
- Literary, dramatic, musical, and artistic works
- Inventions which are:
 - Not useful or
 - Offensive to public morality



How do I know if my invention is patentable?

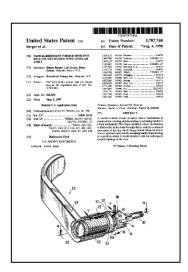
- Search
 - U.S. patents
 - Foreign patents
 - Printed publications
 - The internet
- Part II of this presentation in two weeks is focused on searching



Types of patents

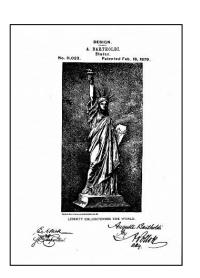
Utility

New and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof



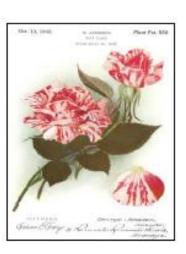
Design

Any new, original and ornamental design; protects the way an object appears



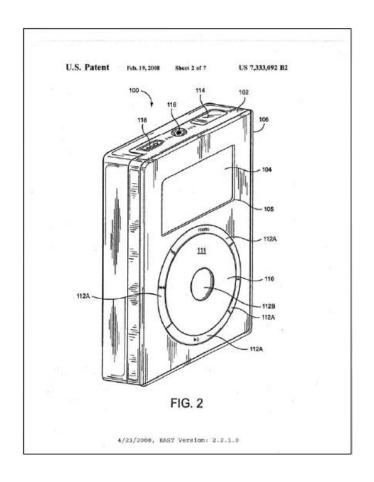
Plant

Whoever invents or discovers and asexually produces any distinct and new variety of plant



Utility patents

- Protect the function of an invention—the way it works
- Valid for 20 years from the date the application is filed





Provisional vs. nonprovisional

Provisional application

- Establishes a filing date
- No claims required
- Inexpensive
- Not published or examined
- One year to pursue nonprovisional

Nonprovisional application

- Statutory requirements for what has to be filed
- More expensive
- Published and examined
- Can result in a patent



Filing your application

- Submit online using EFS-Web
 - Upload all necessary documents
 - Payment of required fees
- Receive an application number and filing date



Small entity

- Must be
 - an individual or
 - a small business (less than 500 employees) or
 - a non-profit organization

Independent micro-entity

- Qualify as a small entity
 - Filed no more than four previous applications
 - Income not greater than 3x median income
 - September 2019: \$184,116
 - Not assigned to other than a micro-entity
 - Inventions assigned to employer don't count against you
 - A 75% reduction in fees

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

Electronic Business Center (EBC)

The EBC can assist with:

- Submitting your patent application via EFS-Web
- Viewing application information in Public and Private PAIR
- Searching for patents in AppFT and PatFT
- Digital certificate, customer number issues, and assistance
- Java and web browser problems
- Technical problems or errors with your patent application
- PDX/DAS registration inquires and issues
- Technical problems with biotech tools

Contact Info

Hours: Monday – Friday, 6 a.m. to midnight ET, except federal holidays

Telephone Numbers:

- Toll-Free: 866-217-9197
- Local: 571-272-4100

Email: ebc@uspto.gov



Enforcement

- Onus is on the owner to enforce their patent rights
 - Monitor marketplace for infringing products
 - Respond to infringement when detected
- Government enforcement resources
 - STOPfakes.gov
 - Customs and Border Protection



STOPfakes.gov

- The International Trade Administration (ITA), U.S. Department of Commerce, manages STOPfakes.gov to assist U.S. businesses in protecting and enforcing their intellectual property rights against counterfeits and pirated goods in the global marketplace
- Provides information, guidance, and trainings for businesses and consumers by both industry and country of interest
- www.stopfakes.gov/IPR-Toolkits

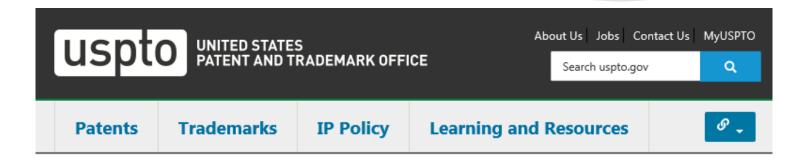


U.S. Customs and Border Protection

- Customs and Border Protection (CBP) can detain and seize imported goods which violate intellectual property rights in the United States
- CBP officers can access the recordation database at each of the 317 ports of entry



USPTO resources



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.

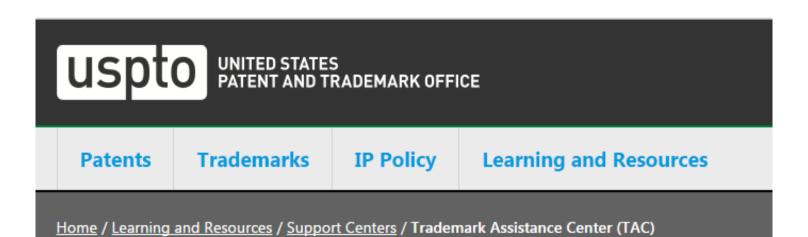
- <u>Inventors Assistance</u> <u>Center</u>
- Trademark Assistance

Current events

Information about conferences, conventions and other opportunities to engage.

Upcoming
 USPTO Events





Trademark Assistance Center (TAC)

The Trademark Assistance Center (TAC) provides general information about the trademark registration process and responds to inquiries about the status of trademark applications and registrations. The location of the Trademark Assistance Center is Madison East, Concourse Level, 600 Dulany Street, Alexandria, VA 22314. Telephone assistance is available Monday through Friday (except federal holidays) from 8:30 a.m. to 8 p.m. ET. Walk-in assistance is available Monday through Friday (except federal holidays) from 8:30 a.m. to 5 p.m. ET

You can also check the status of an application or registration through Trademark Applications and Registrations Retrieval ("TARR") database at http://tarr.uspto.gov/.

800-786-9199 (toll-free) | 571-272-9250 (local)



Inventors Assistance Center (IAC)

What IAC can do for you:

- Answer general questions regarding patent examining policy
- Answer questions concerning necessary formats and items needed for your patent application
- Assist you with forms needed and with filling out the forms
- Direct your calls to appropriate USPTO personnel or <u>www.USPTO.gov</u> web pages, as necessary
- Provide you with general information concerning patent examining rules, procedures, and fees
- Send you patenting information and forms via USPS mail or facsimile

What IAC cannot do for you:

- Give an opinion as to whether an invention is patentable
- Provide legal advice or legal interpretations
- Provide patent searches or other intellectual property research
- Provide specific line-by-line completion of forms (but can provide directions)

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 <u>www.uspto.gov/video/cbt/certpck/index.htm</u>
 - Have application prescreened to ensure that there is more than an idea



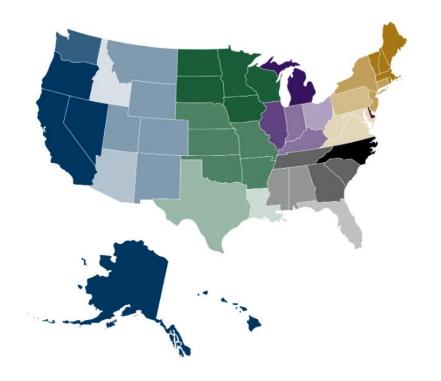


Patent Pro Bono Program

- Mi Casa Resource Center Pro Bo Pat
 - Serves Colorado, Montana, New Mexico, Utah, and Wyoming
 - probopat@micasaresourcecenter.org
 - 303-539-5643
 - \$50 application fee
- Gateway Venture Mentoring Service
 - Serves Arkansas, Kansas, Missouri, Oklahoma and Nebraska
 - www.gatewayvms.org
 - 314-862-4867
- LegalCORPS Inventor Assistance Program
 - Serves Minnesota, North Dakota, South Dakota, Iowa, and Wisconsin
 - Legalcorps.org/inventors
 - iap@legalcorps.org



Pro Bono Program organizations



- Washington Pro Bono Patent Network
- Idaho Patent Pro Bono
- CLA
- ProBoPat
- Arizona Public Patent Program
- LegalCorps (MN)
- Pro Bono Patent Project (MI)

- Gateway Venture Mentoring Service
- TALA
- The Ella Project
- Chicago-Kent Patent Hub
- PatentConnect for Hoosiers (IN KY)
- Ohio Invents
- BBVLP Patent Program (MS AL)
- New England Program

- New York Tri State Program
- Delaware Program
- FCBA (Mid-Atlantic)
- PA Patent
- NC Leap
- Georgia Patents
- Patent Pro Bono FL



Patent and Trademark Resource Center (PTRC) locations





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

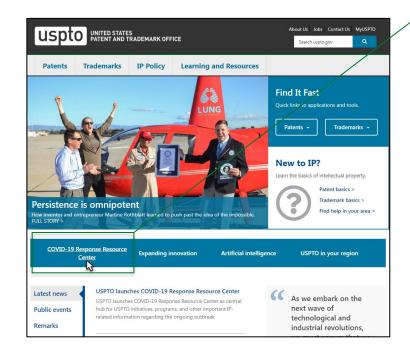
- Provides outreach and education to applicants who file patents applications without the assistance of a registered patent attorney or agent
- The USPTO aims to increase the quality of pro se applications and assist pro se applicants with making informed decisions regarding their patent applications
- 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

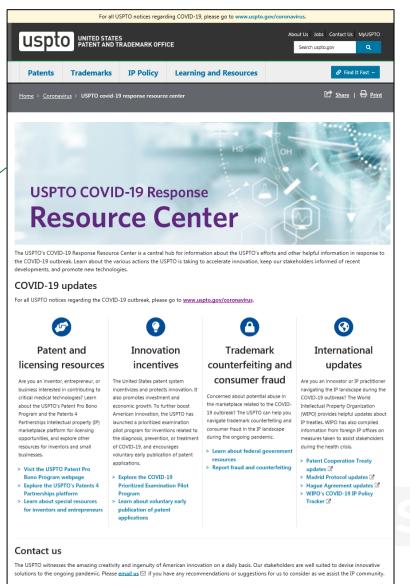


COVID-19 Response Resource Center

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.





- 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



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 ☑ if you have any recommendations or suggestions for us to consider as we assist the IP community.

- Patent and licensing resources:
 - The USPTO's Patent Pro Bono Program
 - Patents 4 Partnerships platform
 - Other special resources for inventors and entrepreneurs







Innovation incentives:

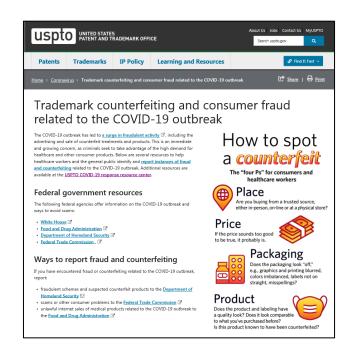
- COVID-19 Prioritized Examination Pilot Program
- Voluntary early publication of patent applications





Trademark counterfeiting and consumer fraud:

- Federal government resources
- How to report fraud and counterfeiting





International updates:

- **Patent Cooperation Treaty Updates**
- **Madrid Protocol Updates**
- **Hague Agreement Updates**
- The World Intellectual Property Organization's **COVID-19 IP Policy Tracker**





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

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 🖾 if you have any recommendations or suggestions for us to consider as we assist the IP community

We encourage our stakeholders to send any recommendations or suggestions for us to consider as we assist the intellectual property community to COVIDcomments@uspto.gov.



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 ☑ if you have any recommendations or suggestions for us to consider as we assist the IP community.

Thank You

rockymountain@uspto.gov 303-297-4600



