

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



United States Patent and Trademark Office

Office of Innovation Development Understanding the Basics of Intellectual Property

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Associate Commissioner for Innovation Development

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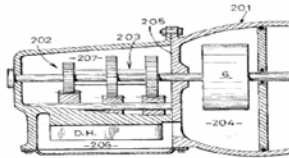
Objectives

- Overview of intellectual property (IP)
- Process of filing a patent application

Overview of intellectual property

	Utility/Plant Patent	Design Patent	Trade Secrets	Copyrights	Trademarks
What is protected	Inventions – Process, machine, manufacture, or composition of matter	Ornamental characteristics embodied in, or applied to, an article of manufacture	Commercially valuable information (e.g., formulas, techniques, processes)	Art, in an all-encompassing sense – original works fixed in a tangible medium	Marks in commerce that indicate the source or origin of goods or services
Protects Against...	Making, using, selling, offering for sale, and importing into the U.S.	Making, using, selling, offering for sale, and importing into the U.S.	Stealing or unauthorized disclosure	Copying, performing, displaying, and creating derivative works	Using a mark in a way that causes likelihood of confusion
Endures until...	Generally, from the patent grant date to 20 years from the earliest effective U.S. filing date	15 years from issuance of patent for applications filed on or after May 13, 2015	Publicly disclosed	The life of the author +70 years for works created on or after 1/1/78	Abandoned or loss of distinctiveness or secondary meaning
Rights of Independent Third Party Creators	None	None	Full	Full	None

Examples



Overview of IP: Types

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

- **Trade secrets**

- Protects commercially valuable information
- Source: State and common law

- **Patents**

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

Overview of IP: Trademarks

Key purposes:

- Allow consumers to identify the source or producer of different products and services – helps their buying decisions
- Encourage trademark owners to provide goods and services of consistent quality and to build goodwill in the trademark

Federally registered trademarks

- Right to enforce nationally and bring legal action in federal courts
- Use of federal trademark registration symbol ®
- Right to record mark with customs
- Serve as basis for foreign filing
- Publication in U.S. trademark database

Overview of IP: Registered trademarks



Word Mark:

North Carolina State University

Serial Number 2932440

Overview of IP: Copyright

- Protects “original works of authorship” including literary, dramatic, musical, artistic, and other works fixed in a tangible medium
- Library of Congress administers registration; USPTO advises the executive branch on IP issues including copyright
- © symbol can be used without registration

Copyright registration

- Copyright protection is secured automatically upon creation (fixation)
 - A work is “created” when it is fixed in a copy for the first time
- No publication or registration is required
 - There are, however, advantages to registration

Overview of IP: Trade secrets

- Any information that derives economic value from not being generally known or ascertainable
- Can be formulas, patterns, compilations, programs, devices, methods, techniques, or processes
- Protection stems from common law dating to the 1800s
- All states have some sort of trade secret protection
- Most laws based on the Uniform Trade Secrets Act
- Defend Trade Secrets Act of 2016
- In 2014 Congress considered, but did not pass, federal versions of the UTSA

Why are trade secrets useful?

- Protects commercially valuable proprietary information, e.g., formulas, recipes, or business information that gives a competitive advantage
 - Customer lists
 - Product formulations
 - Search algorithms
- Trade secrets are not generally known and must be subject to reasonable efforts to preserve confidentiality
- No set term for protection

How to lose a trade secret?

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

Overview of IP: Mobile phone

Trademarks:

- Made by "Apple" (logo)
- Product "iPhone"
- Software "iOS", "Safari"

Patents:

- Semiconductor circuits
- Touch Screen
- Battery/Power Control
- Antenna
- Speaker
- Device Housing

Copyrights:

- Software code
- Instruction manual
- Ringtone

Trade secrets:

- ???

Designs (some of them patented):

- Form of overall phone
- Placement of button & speaker
- Color pattern of trim
- Surface finish



© Apple

Overview of IP: 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
- Government grants the property right in exchange for the disclosure of the invention

The role of the patent system

- Protect inventions
- Encourage inventions
- Promote commercialization and application of invention
- Accelerate the commercialization of invention to the whole society

Why get a patent?

- A patent can:
 - Help to gain entry into, and deter others from entering into, a market
 - Attract investors
 - Be used as a marketing tool to promote unique aspects of a product
 - Be asserted against an infringer
 - Be used as collateral to obtain funding and increase leveraging power
 - Create revenue – sell or license like other property
- Patents are a form of property that can add value to a company's assets

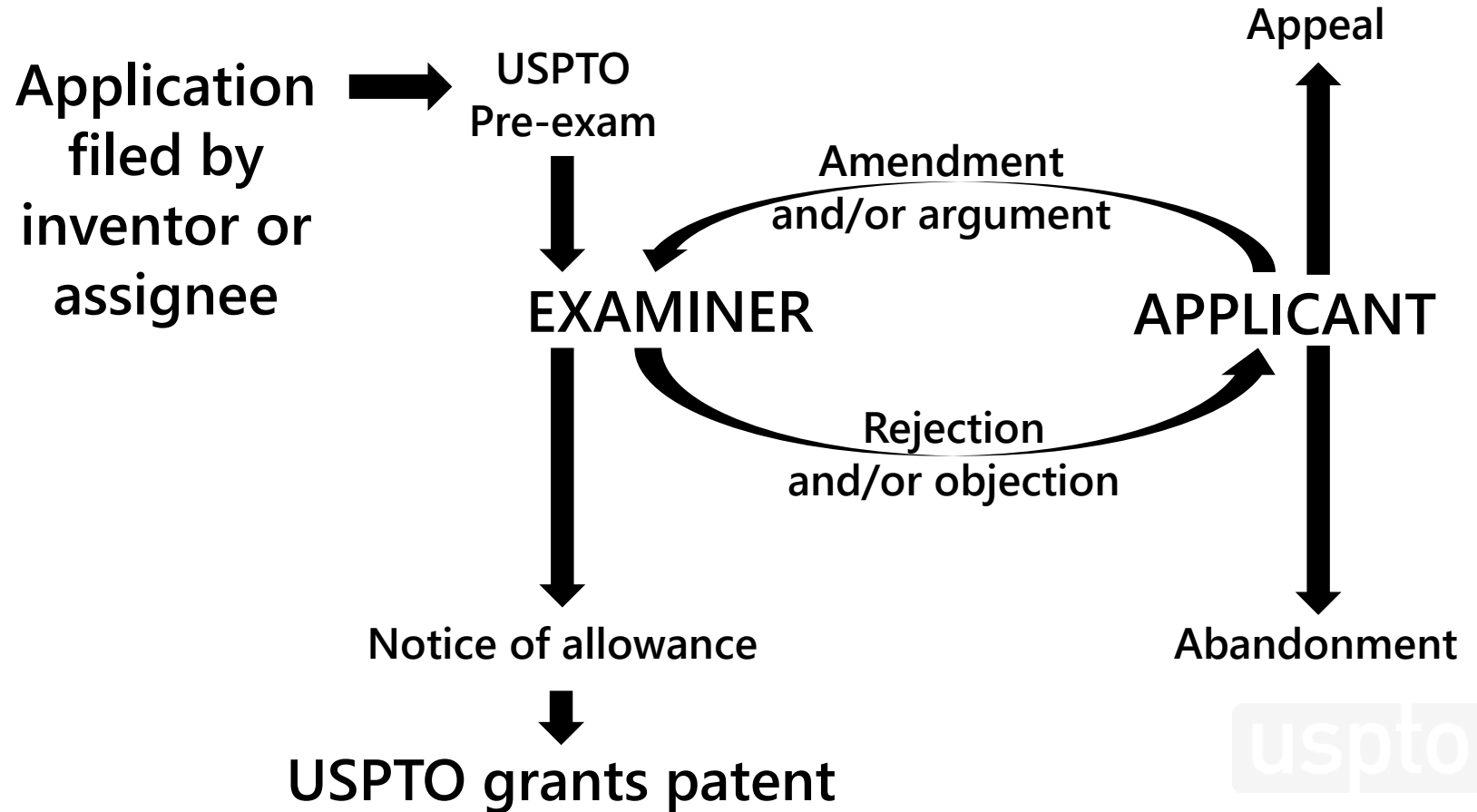
Who can apply for a patent?

- Inventor(s)
- Assignees
- Obligated assignees
- A person with a sufficient proprietary interest

What happens after I get my patent?

- Licensing
- Enforcement
- More innovation and competition
- Etc...

Patent examination process overview



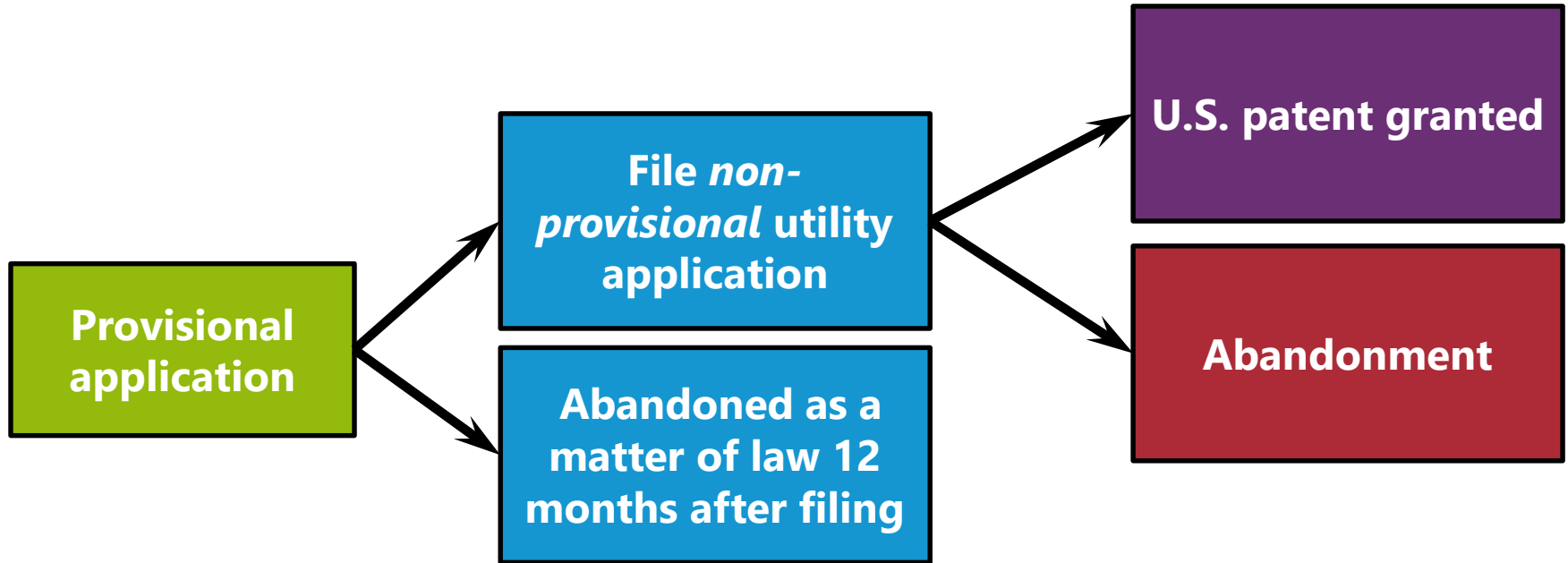
Pre-filing decisions

- Should I file an application?
 - Prior art search
 - Business plan – who will buy the invention?
- When should I file?
- Where should I file, i.e. electronic or USPTO office?
- What type of application(s) to file?
- Who should prepare the application(s)?

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 applications



Provisional utility applications

Additional benefits of provisional applications:

- 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

Provisional utility applications

(MPEP 201.04)

- Low-cost submission to establish filing date
 - \$140 small entity
 - \$70 micro entity
- For micro entity status, the following certifications are made:
 - Qualifies as a small entity (less than 500 employees);
 - Has not been named as an inventor on more than four previously filed patent applications;
 - Did not, in calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding three times median household income; and
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in calendar year preceding the calendar year in which applicable fee is paid, had a gross income exceeding three times the median household income.

Provisional utility applications

(MPEP 201.04)

- Automatic abandonment after one year
- Inventor given time to investigate market potential / make improvements
 - Be careful - too much change could result in loss of provisional filing date
 - Many inventors file multiple provisional applications during the 12-month pendency of the first filed provisional to include improvements
- Also provide time to obtain counsel if desired
- No patent issues—not examined

Provisional utility applications

- Simplified filing requirements
- Items required:
 - Specification - CLEAR DESCRIPTION - in compliance with 35 USC 112, Paragraph (a)
 - enablement, written description, best mode
 - Drawings
 - Always required where necessary for an understanding of the subject matter sought to be patented
 - May be required by the office where the nature of the subject matter admits of illustration
 - Filing fees
 - Cover sheet identifying provisional application

Provisional utility applications

Use of USPTO cover sheet [PTO/SB/16] encouraged:

Provides a clear indication that applicant is filing a provisional application

- Inventor name(s)
- Inventor residence(s)
- Title of the invention
- Correspondence address
- Attorney information (if any)
- U.S. government interest (if any)

Where do you go from here?

Provisional applications – as basis for priority

- Domestic benefit
 - For non-provisional applications
- Foreign priority
 - Foreign national 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) application can claim priority to U.S. provisional application

Thank you!

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