

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**

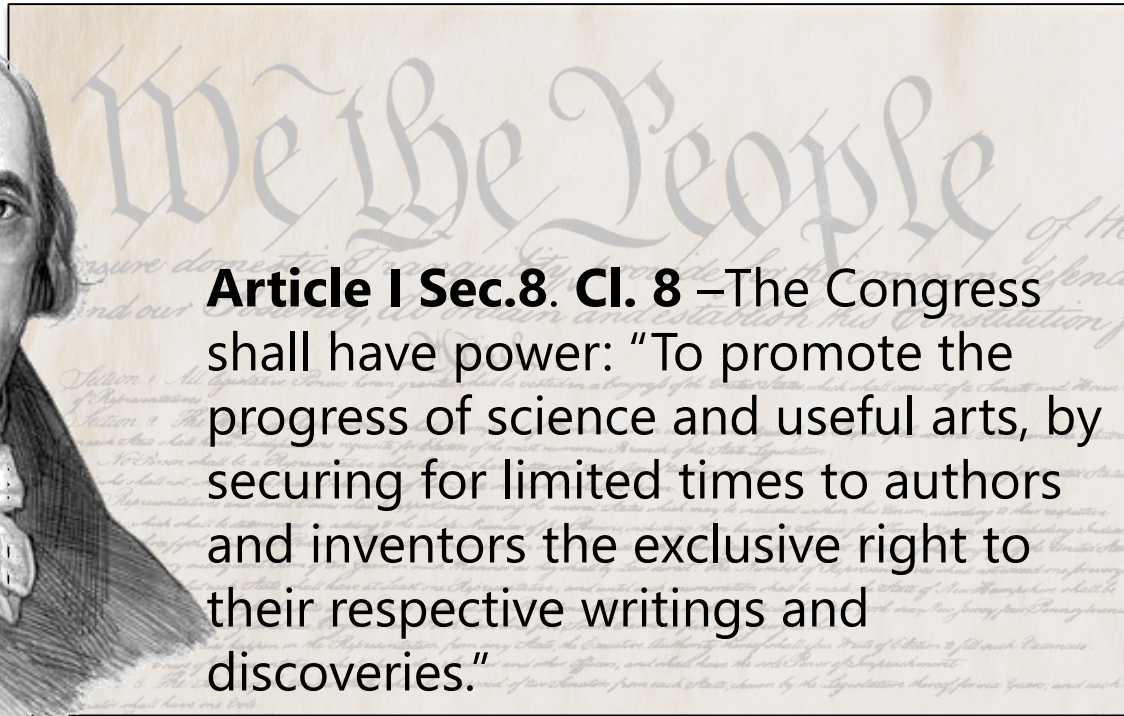
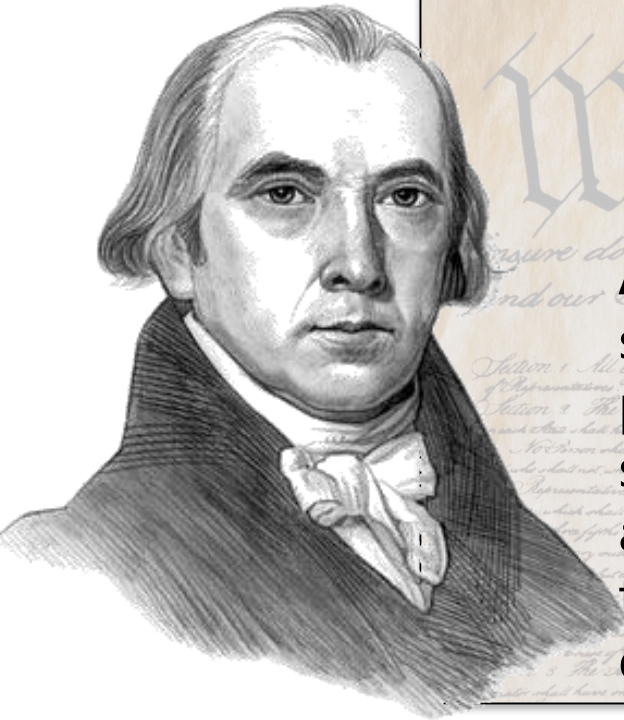


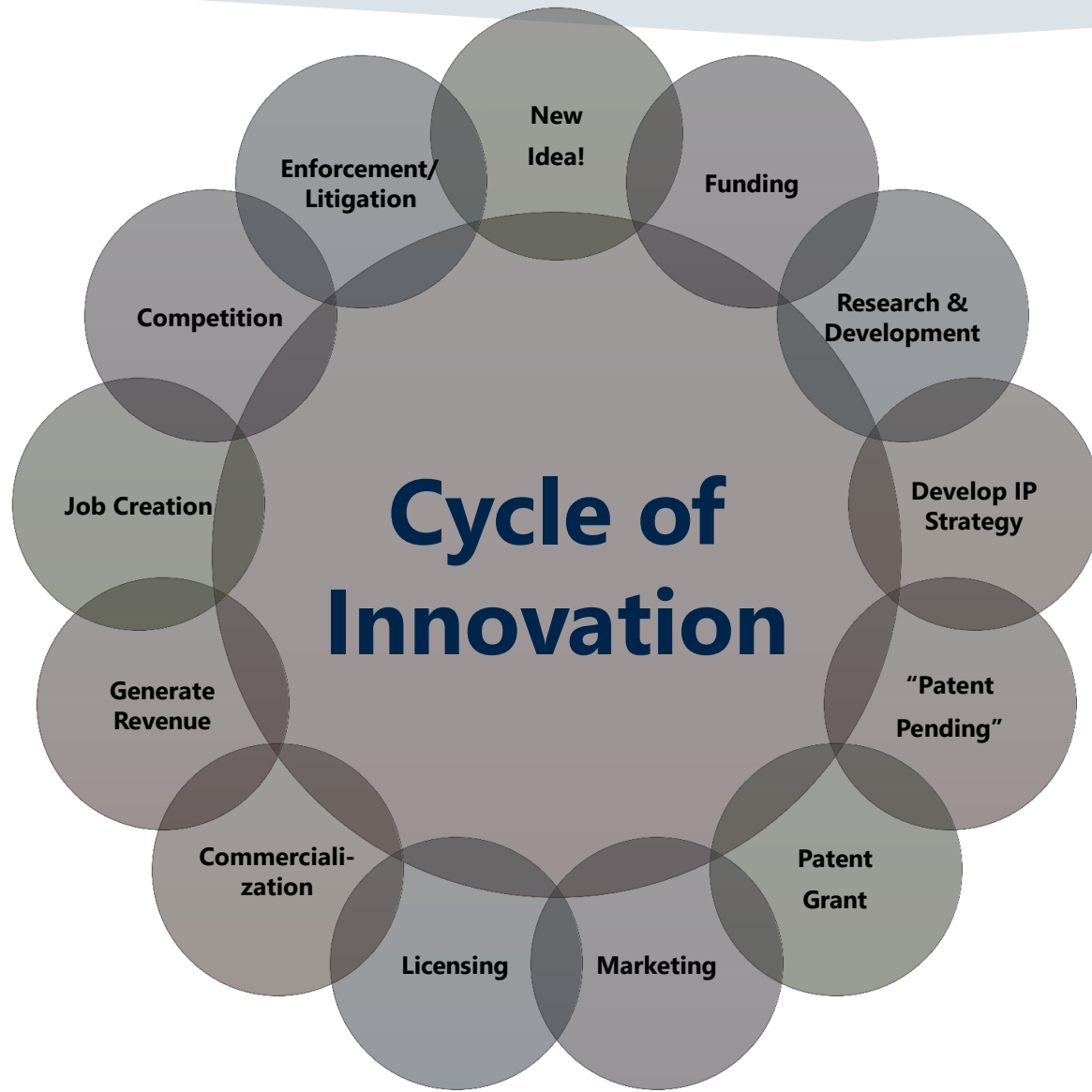
# What is Intellectual Property (IP)?

- Intellectual Property refers to “creations of the mind,” something you create like an invention or a poem or a logo.
- Patents, trademarks, copyrights, and trade secrets do not protect the same things.
  - A person or company may own some or all of these types of intellectual property.



# The Constitutional mandate for intellectual property





# 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 than can add value to a company's assets
- Is Global

# Developing an IP Strategy

- Assess your company's IP assets and prioritize
- Know your competition & what they're up to
- What's the pace of innovation & opportunities for growth?
- Determine the best way to protect your IP

# How tangible are your assets?

50 years ago: Factory, Equipment and Inventory

Today: Designs, Processes, Inventions,  
Algorithms and Brands

Intellectual Property protects both  
tangible and intangible assets!

Patents, Copyrights, Trademarks & Trade Secrets



# How do I get value from my IP?

IP can be used:

- To gain entry into, and deter others from, a market
- As a marketing tool to promote unique aspects of a product or asset
- To assert/enforce rights against an infringer or competitor
- To leverage/use as collateral to obtain funding
- To create revenue – sell or license like other property

# Basic US Patent Practice

Elizabeth L. Dougherty

Eastern Regional Outreach Director

February 5, 2020

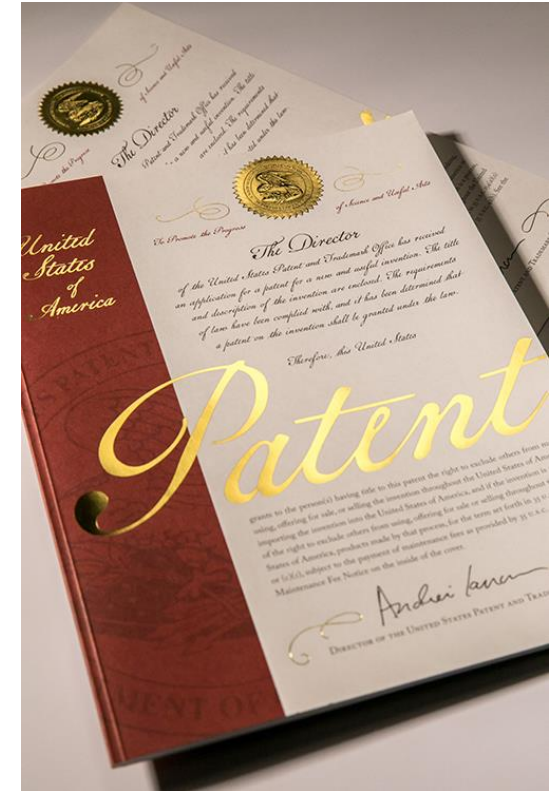
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# What is a patent?

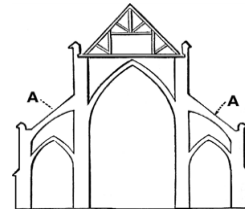
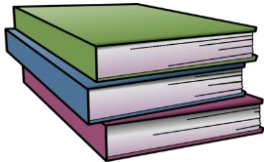
## A U.S. patent is

- 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



# 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 intellectual property issues including copyright
- © symbol can be used without 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 1800's
- All states have some sort of trade secret protection
- Most laws based on the Uniform Trade Secrets Act
- In 2014 Congress considered, but did not pass, federal versions of the UTSA

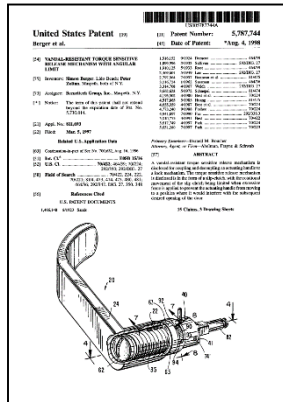
# Balancing of interests

- Patents provide a right to exclude for a limited period of time.
  - Public benefit: inventors' discoveries enter public domain upon expiration of patent
  - Quid pro quo: limited period of exclusivity in exchange for public disclosure of inventions

# Types of patents

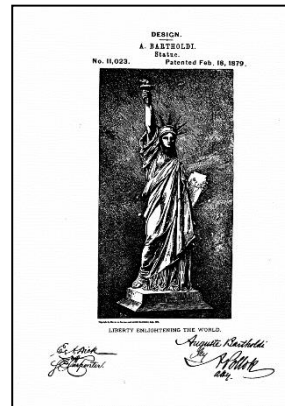
## Utility

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

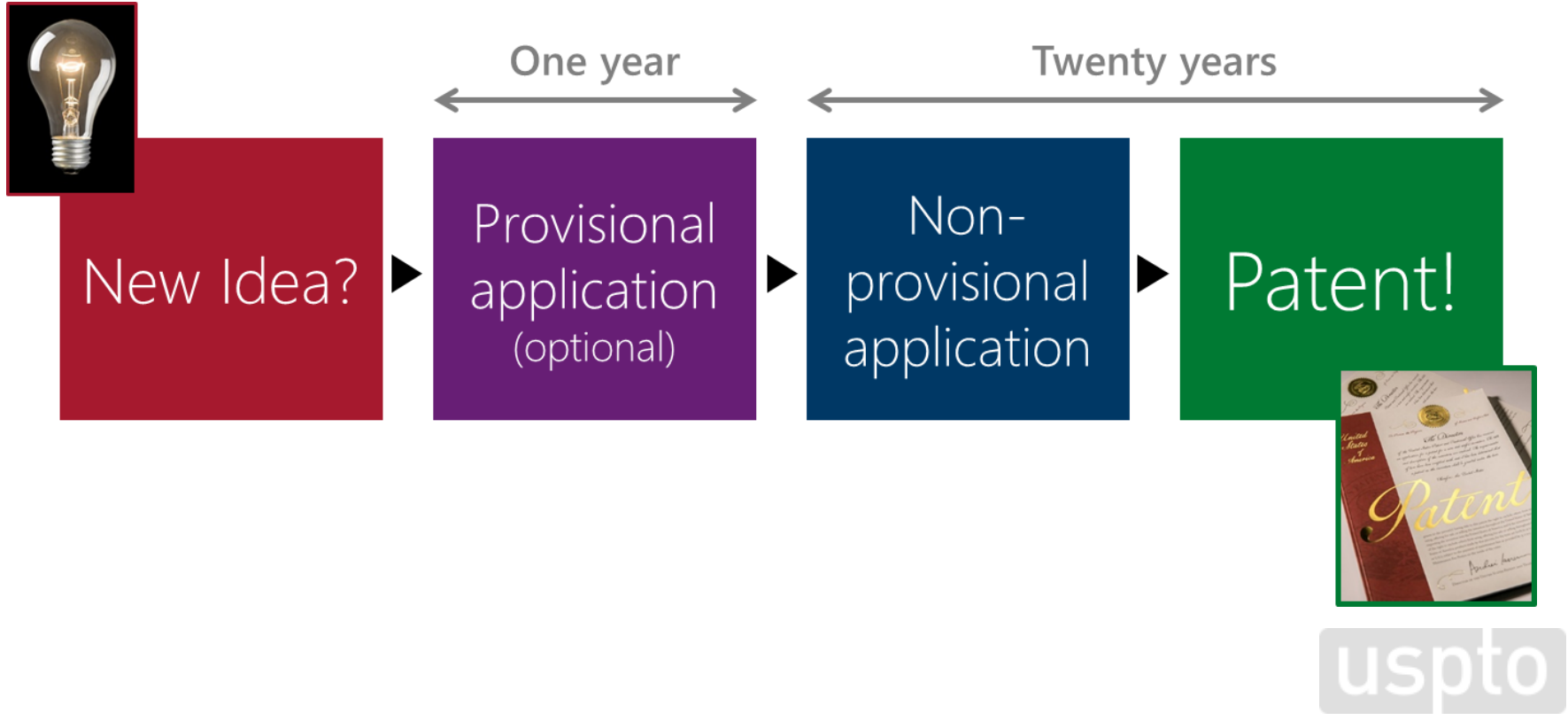
Whoever invents or discovers and asexually produces any distinct and new variety of plant



# 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)?

# The path to a patent



# 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>• Only for utility patents</li><li>• A low-cost way to establish an early 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></ul>

**Provisional utility application**

# 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

# Provisional utility application

- 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



# 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 US provisional application

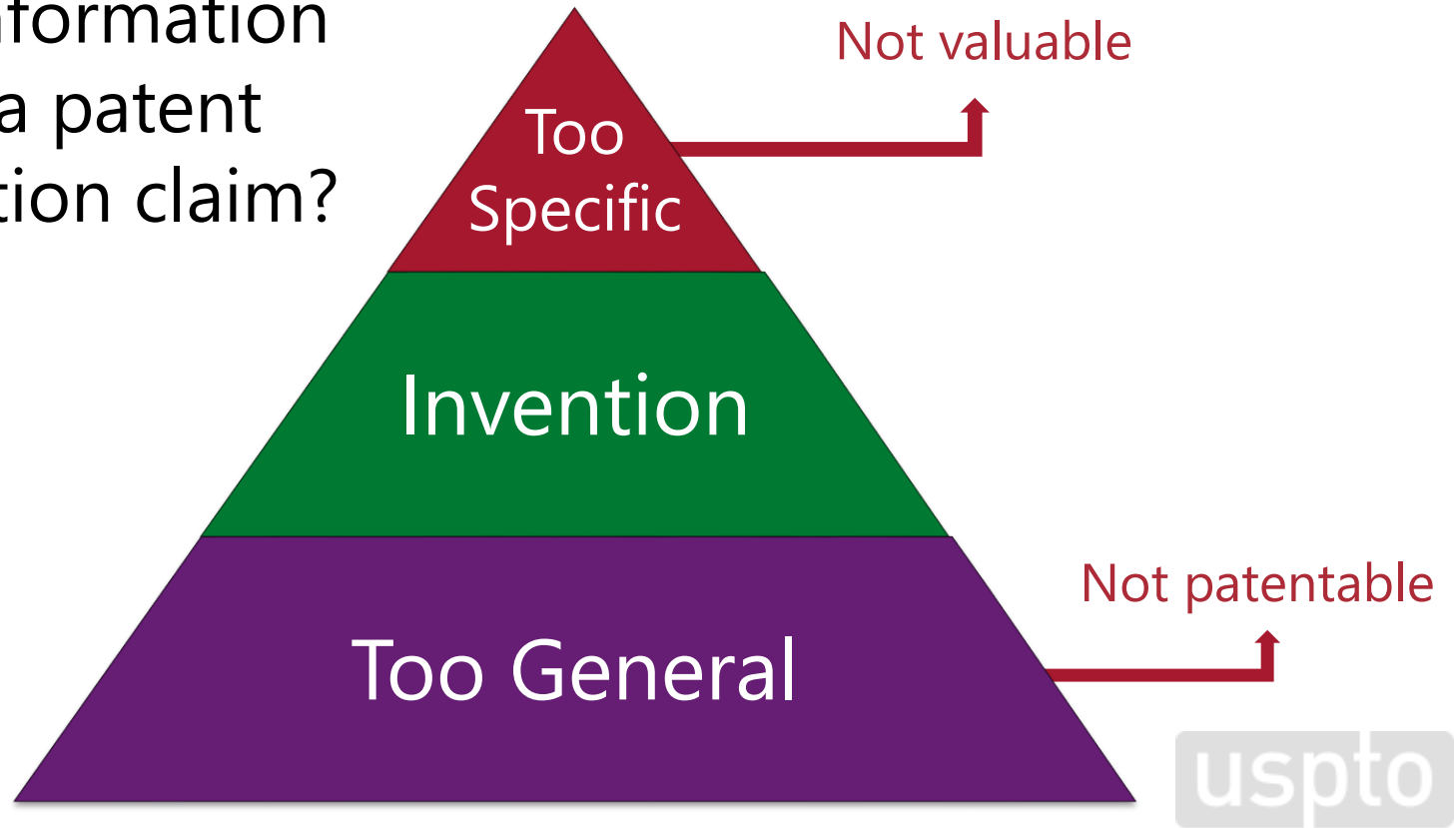
**Non-provisional patent application**

# Nonprovisional patent application

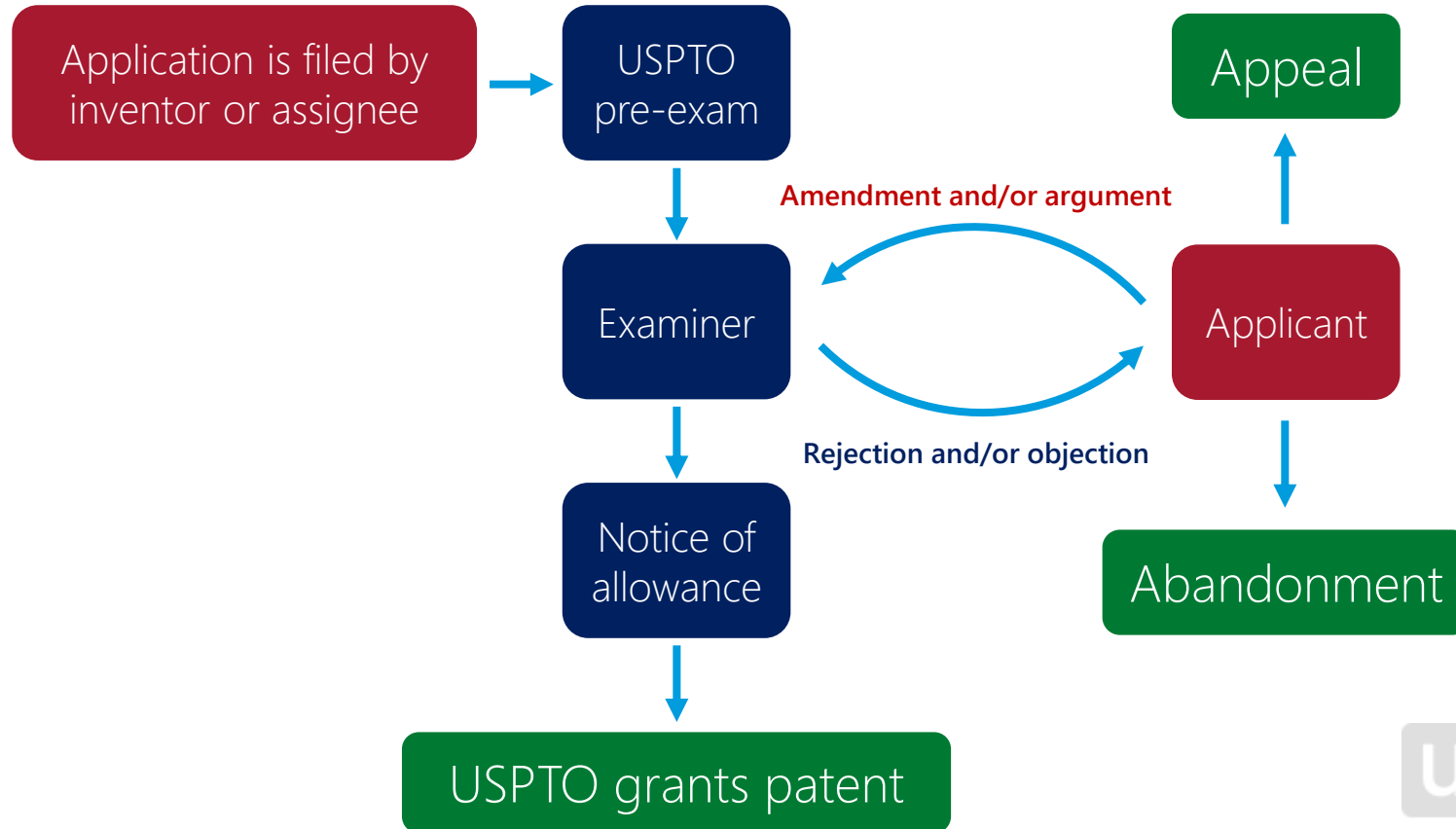
- **Filing Requirements for Examination**
- A specification, including a description and a claim or claims
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
  - Oath or declaration or an application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

# Claim scope

What information should a patent application claim?



# Patent examination

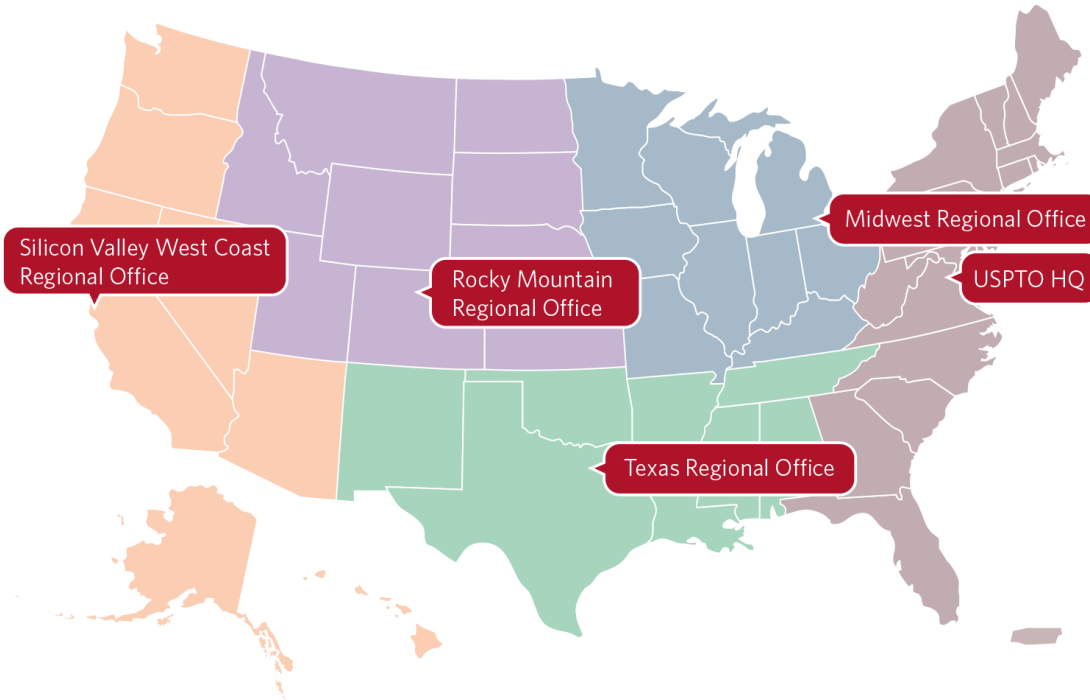


# What happens after I get my patent?

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

**USPTO resources**

# USPTO offices



## **Detroit**

- Operational since July 2012

## **Denver**

- Byron G. Rogers Federal Building
- Operational since July 2014

## **Silicon Valley**

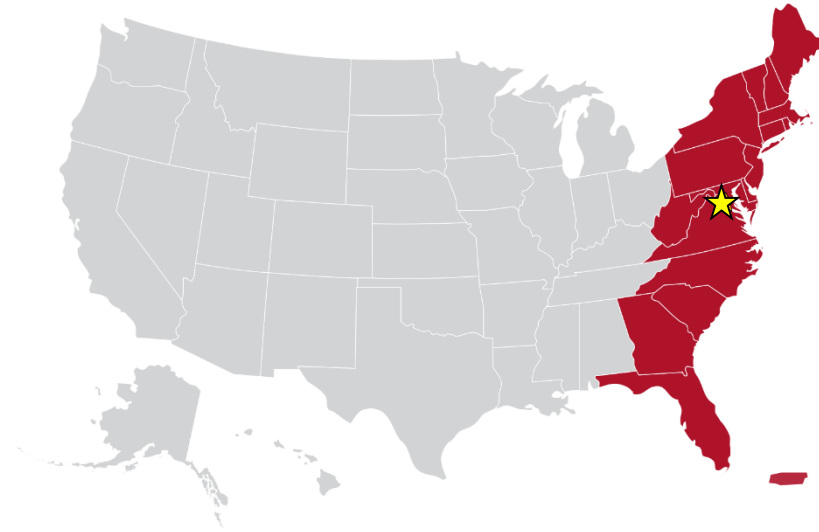
- San Jose City Hall Building
- Operational since October 2015

## **Dallas**

- Terminal Annex Federal Building
- Operational since November 2015

# Eastern Region – USPTO headquarters

600 Dulany Street, Alexandria, Virginia



## Core Functions:

- Receipt and examination of patent and trademark applications
- U.S. and international IP policy development
- Oversight and management of USPTO operational functions
- Stakeholder engagement and training



- Office hours: 8:30 a.m. – 5 p.m. ET, M – F
- Services
  - Public search facility hours  
8 a.m. – 8:00 p.m.
  - Examiner interview rooms
  - PTAB and TTAB hearing rooms
  - Public meeting space
  - National Inventors Hall of Fame Museum,  
10:00 a.m. – 5:00 p.m.

# Eastern Regional Outreach Director

- **C**onduct USPTO programming
- **C**oordinate USPTO engagement
- **C**ollaborate with USPTO stakeholders
- **C**ommunicate USPTO priorities and programs



# Inventor and entrepreneur resources

- USPTO's hub for resources and information for inventors, entrepreneurs, and small businesses.
- Webpage: <https://www.uspto.gov/inventors>

The screenshot shows the USPTO website's 'Inventor and entrepreneur resources' page. The header includes the USPTO logo, 'UNITED STATES PATENT AND TRADEMARK OFFICE', and navigation links for 'About Us', 'Jobs', and 'Contact Us'. A search bar is located in the top right. Below the header is a navigation menu with 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. The main content area is titled 'Inventor and entrepreneur resources' and is divided into several columns of links and information:

- Patents for startups:** The patent process can be challenging if you are not familiar with it. Here is basic information on the patent process. Links include: Patent process overview, Inventors Assistance Center, Patents FAQs, Patents homepage, Search for patents, and Official Gazette for patents.
- Trademarks for inventors and entrepreneurs:** The trademark process can be confusing for a beginner, so the links below provide useful information on registering a trademark with the USPTO. Links include: Trademark Basics, Trademark Electronic Search System (TESS), Trademark Electronic Application System (TEAS), Trademark Status and Document Retrieval (TSDR), Electronic Trademark Assignment System (ETAS), Assignments on the Web (ACTW), Trademark Trial and Appeal Board (TTAB), Trademark Manual of Examining Procedure (TMPEP), Pro Se and Pro Bono, and Law School Clinics.
- Inventor and entrepreneur assistance:** The Inventors Assistance Center (IAC) provides patent information and services to the public. The IAC is staffed by former supervisory patent examiners and experienced primary examiners who answer general questions concerning patent examining policy and procedure. The Trademark Assistance Center can answer general questions about the trademark process or provide guidance on the type of information to include on a form, but may not provide specific legal advice. Links include: Inventors Assistance Center, Patents Ombudsman Office, BusinessUSA, Trademark Assistance Center, and University Outreach Program.
- Education and information:** Guides and additional resources and information for inventors. Links include: Scam prevention, Provisional Application for Patent, General Information, A Guide to Filing a Nonprovisional Utility Patent Application, A Guide to Filing a Design Patent Application, Basic Facts About Trademarks, Financial Manager, U.S. map of state resources, and IP Awareness Assessment.
- Scam Prevention:** While the USPTO does not investigate complaints or participate in any legal proceedings against invention promoters/promotion firms, under the American Inventors Protection Act of 1999, the USPTO will provide a public forum for the publication of complaints concerning invention promoters/promotion firms. Links include: Scam prevention basics, Non-USPTO trademark solicitations, American Inventors Protection Act of 1999, Federal Trade Commission, and Consumer protection.
- Current Events:** Information about conferences and conventions. Link: Upcoming events.
- Other federal resources:** Helpful resources for inventors and entrepreneurs from other federal agencies. Links include: myRA: a retirement savings account from the U.S. Dept. of the Treasury, Small Business Innovation Research Program, and myRA: a retirement savings account from the U.S. Dept. of the Treasury.

# Inventor and entrepreneur resources by state

Resources and assistance in your state for filing for a patent or registering a trademark

- Free patent and trademark legal assistance
- Learn to search inventions and trademarks
- Attend events in your region
- Network with inventor and entrepreneur organizations in your state
- Accessible via uspto.gov homepage

– New to IP? Find help in your area

**New to IP?**

Learn the basics of intellectual property.



[Patent basics >](#)

[Trademark basics >](#)

[Find help in your area >](#)

There are lots of resources and assistance to make filing for a patent or registering a trademark easier, more affordable, and ultimately result in strong legal protection for your invention or brand. For example, if you can afford an attorney, there are several programs that provide free legal representation. Use the map below to find out what is available in your state.

And remember, our [Inventor and entrepreneur resources page](#) is the USPTO hub for resources and information for inventors, entrepreneurs, and small businesses.

Select your state below to find resources



This map derived from [commons.wikimedia.org](https://commons.wikimedia.org)

**List of State Names**

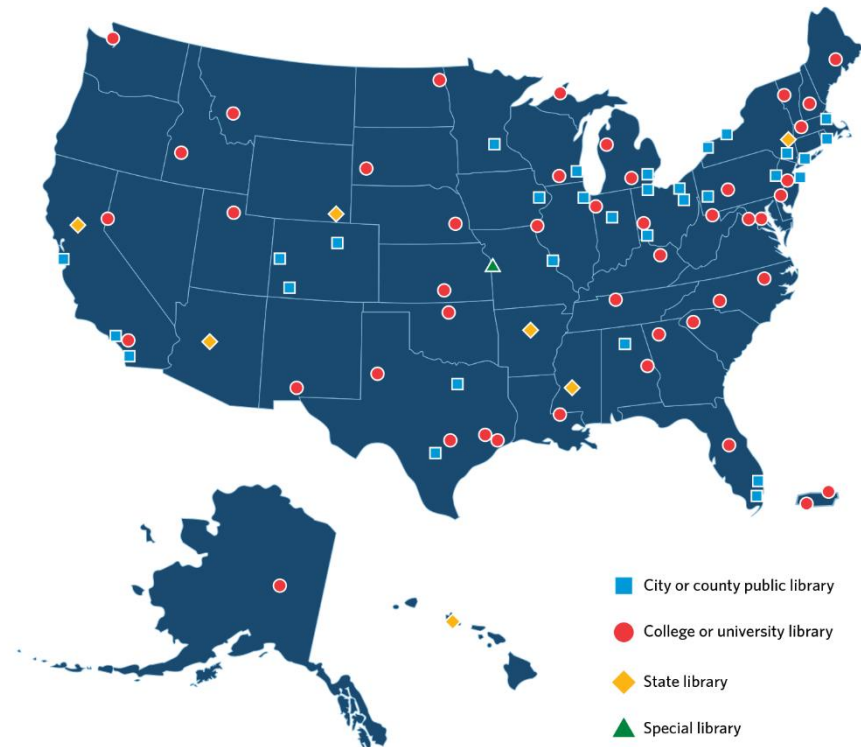
Alabama	Georgia	Maryland	New Jersey	Rhode Island	Wisconsin
Alaska	Hawaii	Massachusetts	New Mexico	South Carolina	Wyoming
Arizona	Idaho	Michigan	New York	South Dakota	
Arkansas	Illinois	Minnesota	North Carolina	Tennessee	
California	Indiana	Mississippi	North Dakota	Texas	
Colorado	Iowa	Missouri	Ohio	Utah	
Connecticut	Kansas	Montana	Oklahoma	Vermont	
Delaware	Kentucky	Nebraska	Oregon	Virginia	
District of Columbia	Louisiana	Nevada	Pennsylvania	Washington	
Florida	Maine	New Hampshire	North Brn	West Virginia	



# Patent and Trademark Resource Centers (PTRC)

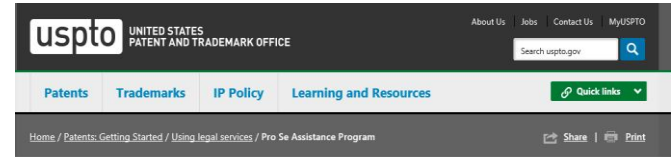
Nationwide network of public, state, and academic libraries that are designated by the USPTO to disseminate patent and trademark information and to support intellectual property needs of the public.

[www.uspto.gov/ptrc](http://www.uspto.gov/ptrc)



# Pro Se Assistance Program

- Hours of Operation
  - 8:30 a.m. – 5 p.m. (ET), Monday – Friday
- Email
  - innovationdevelopment@uspto.gov
- Phone
  - 866-757-3848
  - Webpage
    - <https://www.uspto.gov/ProSePatents>



- Intellectual property legal assistance programs
- Patent pro bono program
- Pro Se Assistance Program**
- Scam Prevention
- Law school clinic program

## Pro Se Assistance Program

The Pro Se Assistance Program is the United States Patent and Trademark Office's comprehensive pilot to expand outreach to inventors who file patent applications without the assistance of a registered patent attorney or agent (also known as "pro se" filing). On this page, you will find information about the program and how it works, and guides and resources for some of the most common issues that pro se applicants encounter.

If you've got a great idea for an invention but you're not sure what a patent is or why you might need one, watch the animated video below.



- [Getting started with pro se assistance](#)
- [Application checklist](#)
- [Nonprovisional Utility Patent Application Checklist](#)



# Free legal assistance

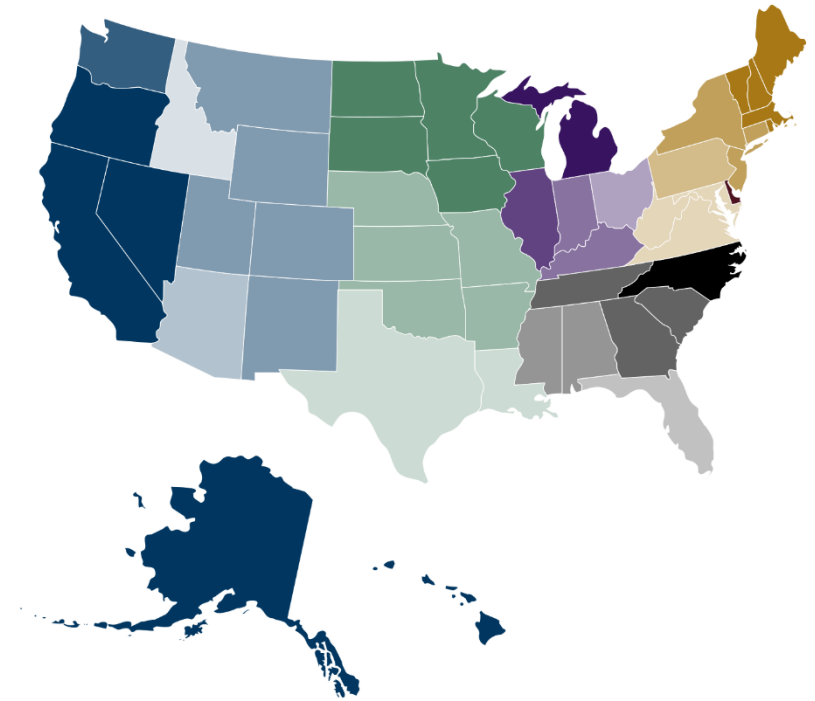
- Patent Pro Bono Program
- Law School Clinic Certification Program

*Applicant(s) must pay for all USPTO fees*

# Patent Pro Bono Program

**File and prosecute patent applications:** The program matches financially under-resourced inventors and small businesses with registered patent attorneys.

- 22 regional programs across the country provide matching services.





USPTO

# Law School

CLINIC CERTIFICATION PROGRAM





# Thank you!

**Elizabeth Dougherty**

Eastern Regional Outreach  
Director

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571.272.8600

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

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Protecting your trademark in the United States

Craig Morris, managing attorney for  
Trademark Educational Outreach

February 5, 2020

Images used in this presentation are for educational purposes only.

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Discussion topics

1. Definitions/types of marks
2. Benefits of federal registration
3. Selecting a mark
4. Filing and registration
5. How to find help

# Discussion topics

Definitions/types of marks

# What is a trademark or service mark?

A trademark/service mark is any word, symbol, design, or combination of those that serves to:

1. **Identify** the source of goods/services; and
2. **Distinguish** them from the goods/services of another party.

# Definitions

## **TRADEMARK** for goods/products

- Also seen as "TRADE MARK" or "TRADE-MARK"

## **SERVICE MARK** for services

## **Symbols** <sup>TM</sup> <sup>SM</sup> <sup>®</sup>

- Not required, but help put public "on notice" of claimed rights



# Types of marks

## Word mark (and slogan)

COCA-COLA

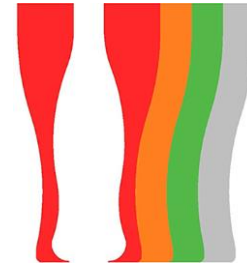
## Special form mark

*Coca-Cola*

## Composite mark



## Design mark



uspto

# Types of marks

- Configuration (shape)
- Sound
- Color
- Scent
- Motion
- Hologram

In sum, anything that functions as a **source identifier**.

# Different purposes, different results

- Domain name  $\neq$  Trademark registration
- Business name  $\neq$  Trademark registration

# Discussion topics

Benefits of federal 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).
- Symbols: <sup>TM</sup> <sup>SM</sup> (optional)
- Note: U.S. is a first-to-use country, while most countries are first-to-file countries.

# Federally registered trademark

- Legal presumption that registrant owns the mark in all 50 states and U.S. territories (but **not** other countries)
- Legal presumption of right to use the mark
- Public notice of ownership of mark
- Permits use of federal registration symbol: ®

# Federally registered trademark

- Automatic listing in the USPTO database
- Right to bring legal action concerning mark in federal court
- Use as a basis for foreign filing (e.g., under the Madrid Protocol)
- Recordation with U.S. Customs and Border Protection, to help prevent importation of infringing products



# Discussion topics

Selecting a mark

# Mark selection challenges

- Not every mark is registrable.
- Not every mark is enforceable.
- Even if a mark is registered, another party may be able to assert superior common law rights.

# Likelihood of confusion

Confusion as to **source**:

1. Are the marks confusingly similar?

- Look alike? Sound alike? Have similar meanings? Create similar commercial impressions?

and

2. Are the goods and/or services related?

- Encountered in the same channels of trade?  
Complementary?



# Suggestions for searching

On your own:

- USPTO database
  - TESS (Trademark Electronic Search System)
  - [www.uspto.gov/SearchTrademarks](http://www.uspto.gov/SearchTrademarks)
- The internet
  - Only option for searching for common law use

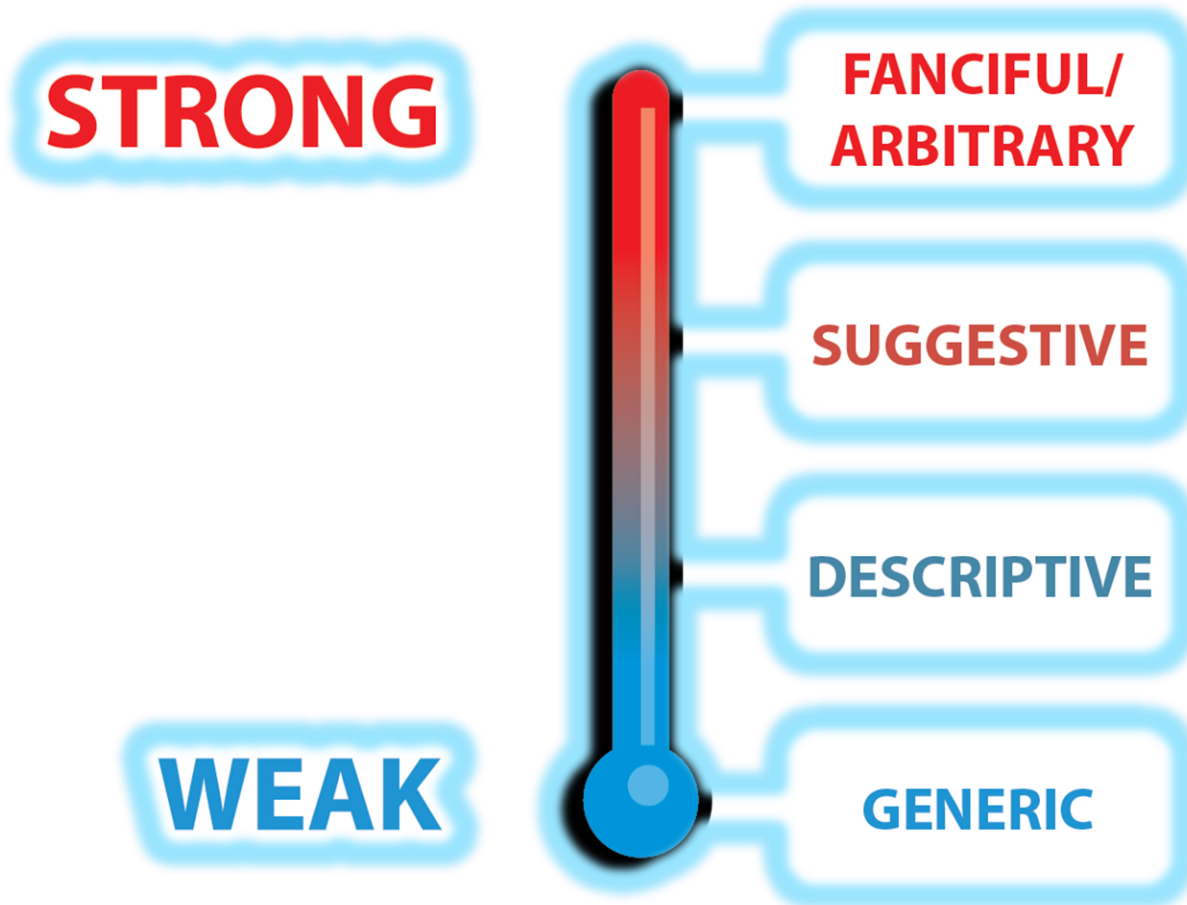


# Suggestions for searching

Hire a private trademark attorney or search firm:

- Full clearance search
  - TESS (Trademark Electronic Search System)
  - State trademark databases
  - Business name registries
  - Foreign trademark databases
  - The internet

# Strength of mark



# Discussion topics

Filing and registration

# Filing for federal registration

- Trademark Electronic Application System (TEAS)
  - [www.uspto.gov/TEAS](http://www.uspto.gov/TEAS)
- Basis for initial filing may be:
  - Use in commerce (interstate or between the U.S. and another country)
  - Intent to use (bona fide intent to use in the future)
  - Foreign application
  - Foreign registration



# Caution: misleading notices

All application data becomes **public information**

Be aware of misleading notices and offers,  
particularly for fees **not** required by the USPTO

[www.uspto.gov/watch/TMINSolicitations](http://www.uspto.gov/watch/TMINSolicitations)



# Registration responsibilities

- The mission of the USPTO is to register any mark that is eligible for registration.
- NOTE: The USPTO has no enforcement powers.
- It is the right and responsibility of the owner of any registration to enforce its rights.



# Registration responsibilities

- Registration is a sword, not a shield.
- May use registration certificate to support a “cease and desist” letter.

# Post-registration requirements

- Between fifth and sixth years after the registration date, **must** do new filing (Section 8 declaration) to show continued use of mark in commerce.
- May combine with optional filing (Section 15 declaration), if qualify, to claim incontestability.
- Between ninth and tenth years, must do new filing (Combined Section 8 and 9) to show continued use **and** request renewal, with same requirement every ten years.
- USPTO emails reminder notices.



# Discussion topics

How to find help

# USPTO resources

- USPTO.gov website
- “Basic Facts About Trademarks” booklet
  - [www.uspto.gov/TrademarkBasicsPDF](http://www.uspto.gov/TrademarkBasicsPDF)
- “Basic Facts About Trademarks” videos
- “Trademark Information Network” (TMIN) videos
- “TEAS Nuts-and-Bolts” videos
  - [www.uspto.gov/TMvideos](http://www.uspto.gov/TMvideos)



# Legal resources

The best resource may be an experienced trademark attorney.

The USPTO does **not**:

- Provide legal advice
- Enforce legal rights
- Recommend specific private attorneys



# USPTO contact

Trademark Assistance Center

Phone: 1-800-786-9199

Email: [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Web: [www.uspto.gov/TrademarkAssistance](http://www.uspto.gov/TrademarkAssistance)



