

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**

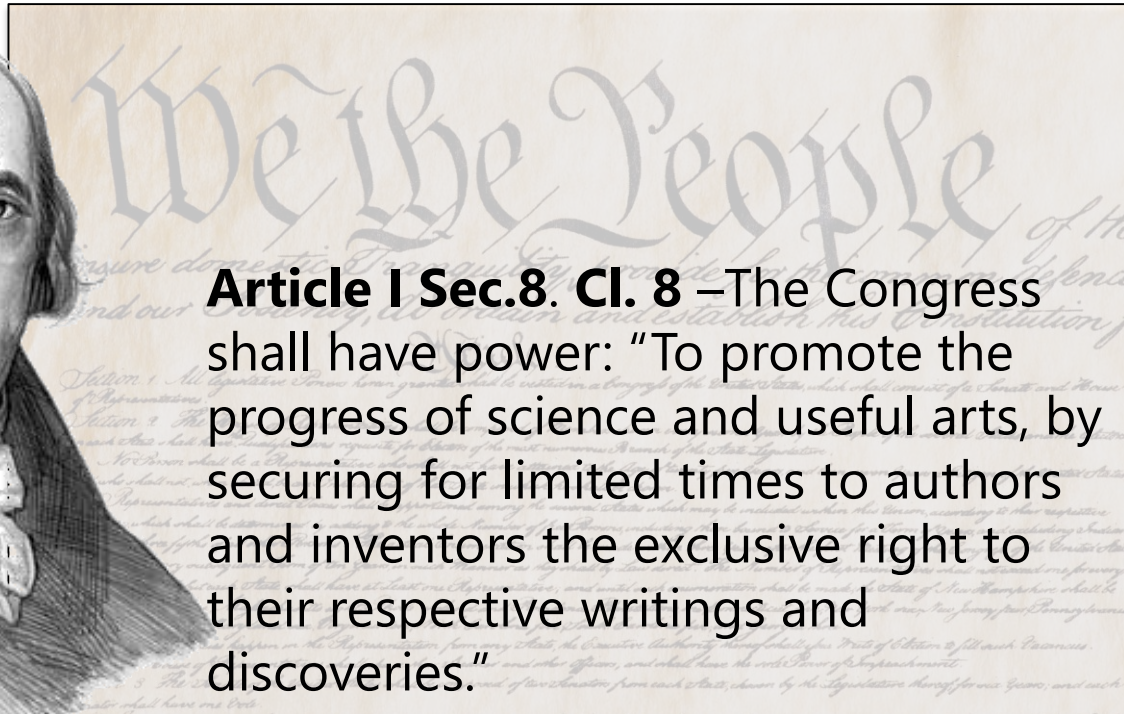
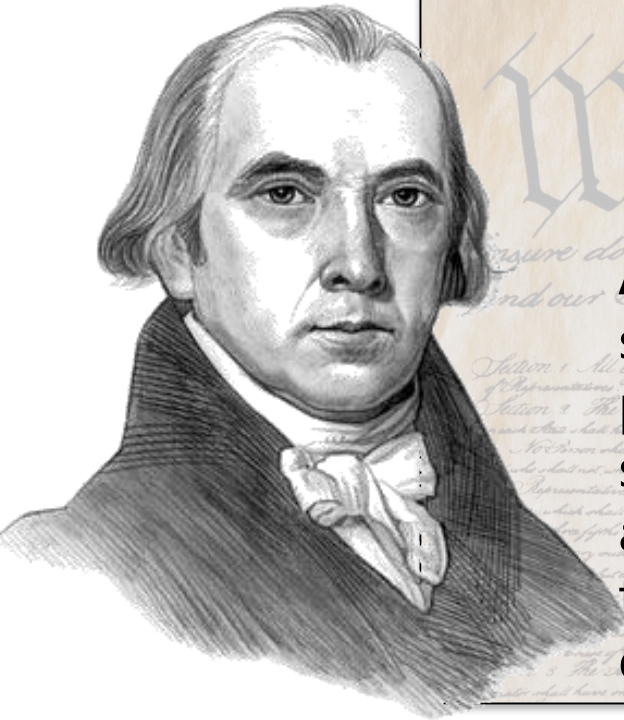


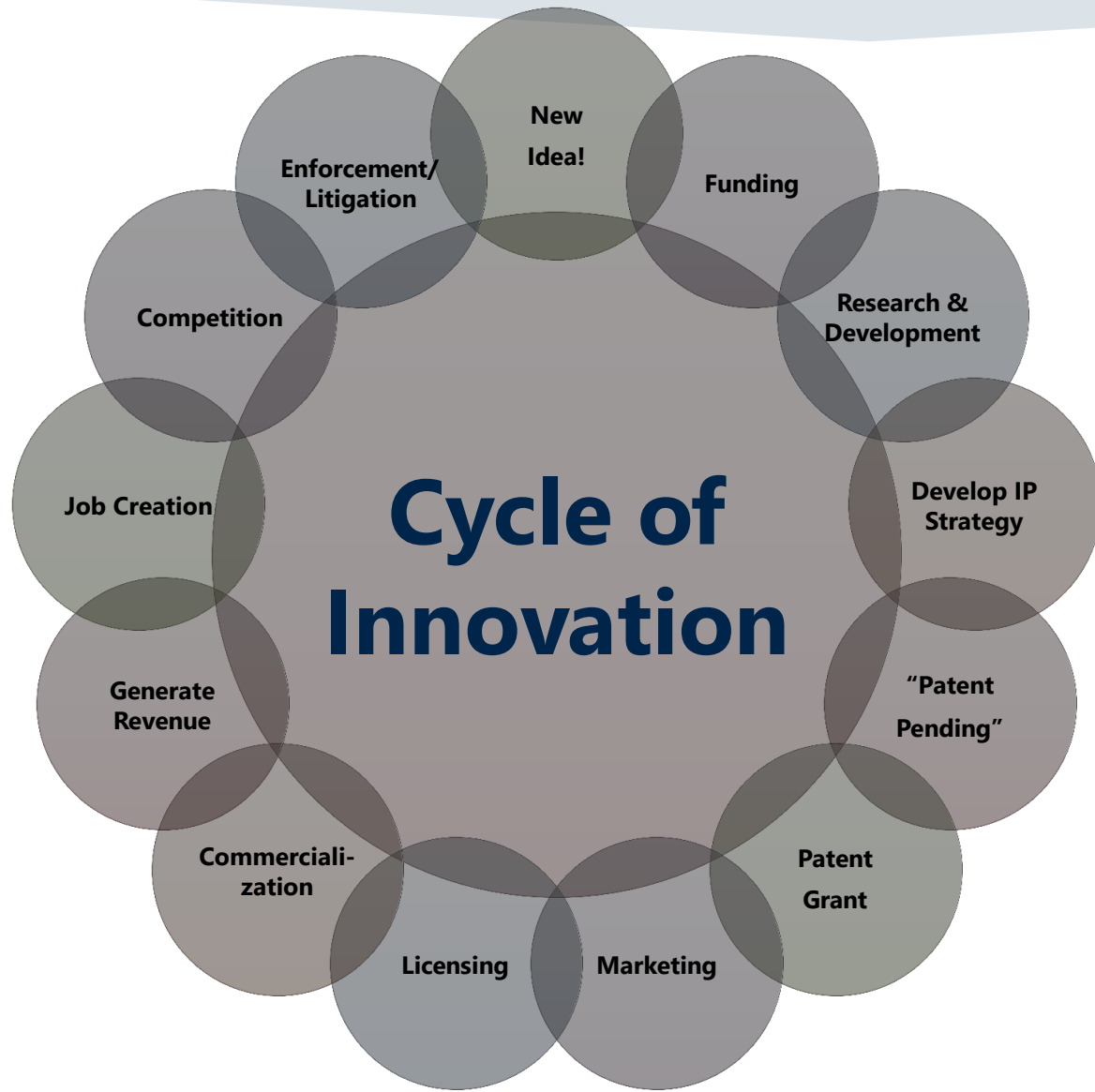
# What is Intellectual Property (IP)?

- 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

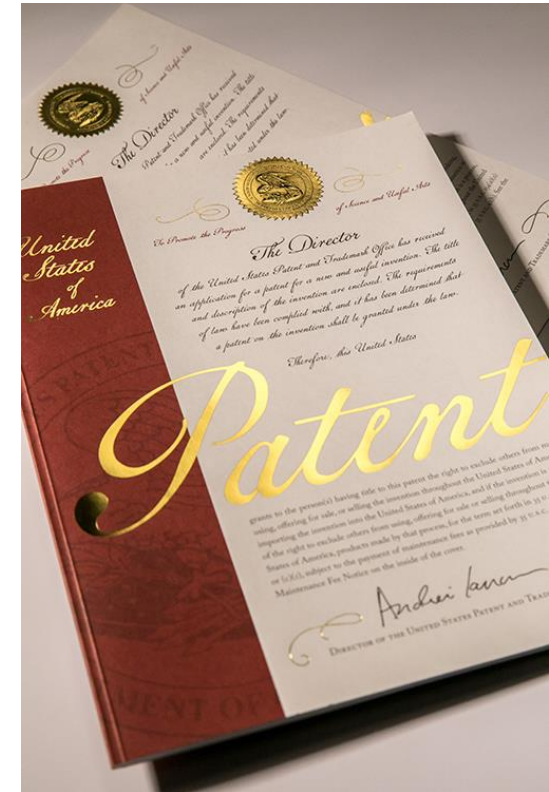
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# What is a patent?

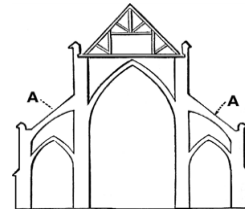
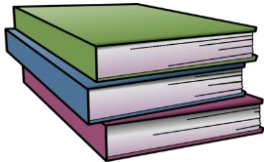
## A U.S. patent is

- 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

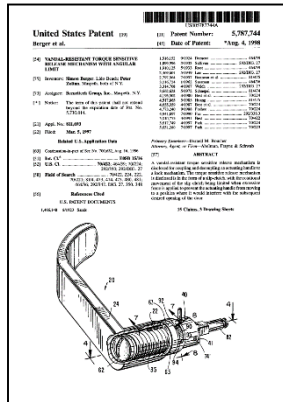
# Balancing of interests

- 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

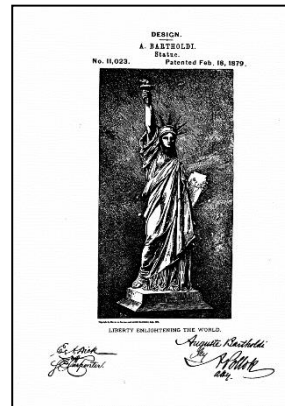
## Utility

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

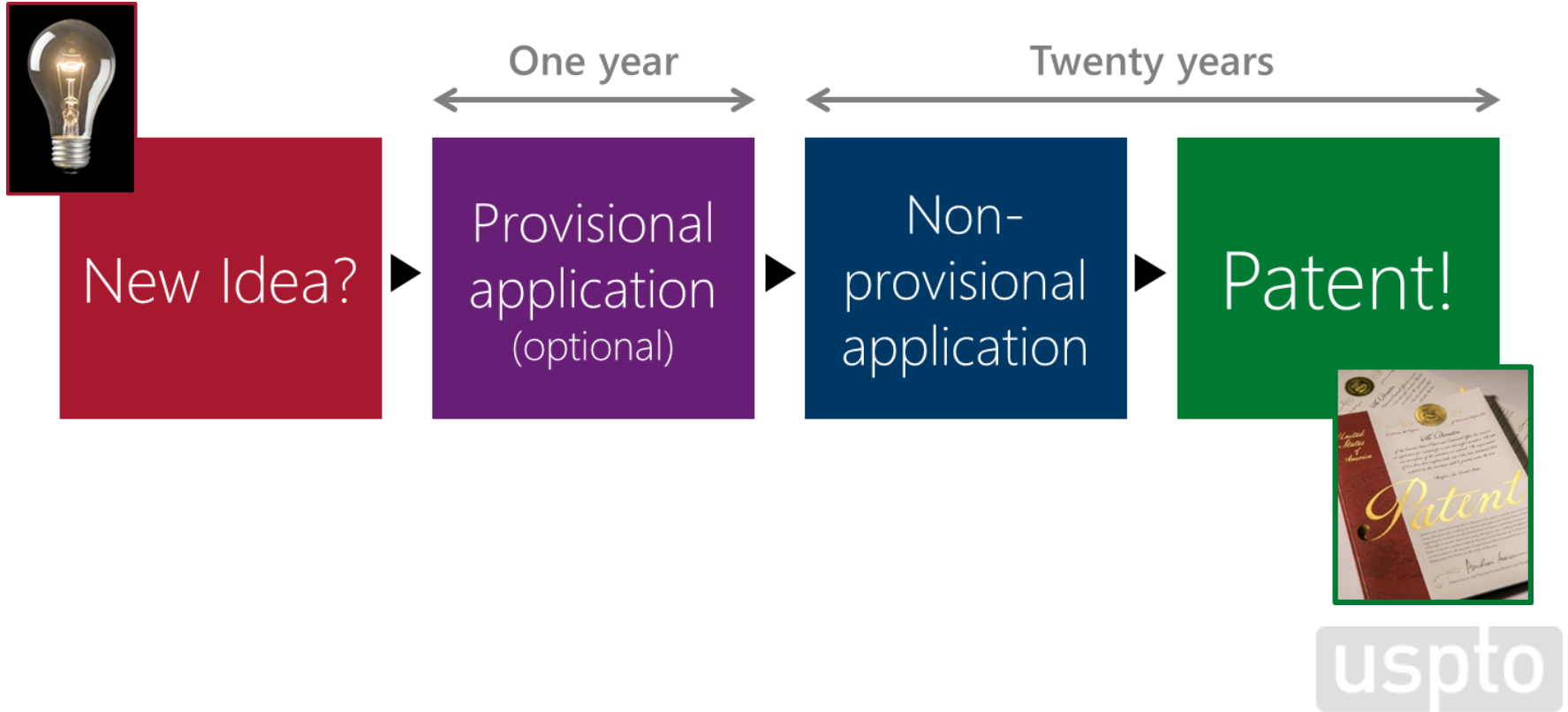
Whoever invents or discovers and asexually produces any distinct and new variety of plant



# 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

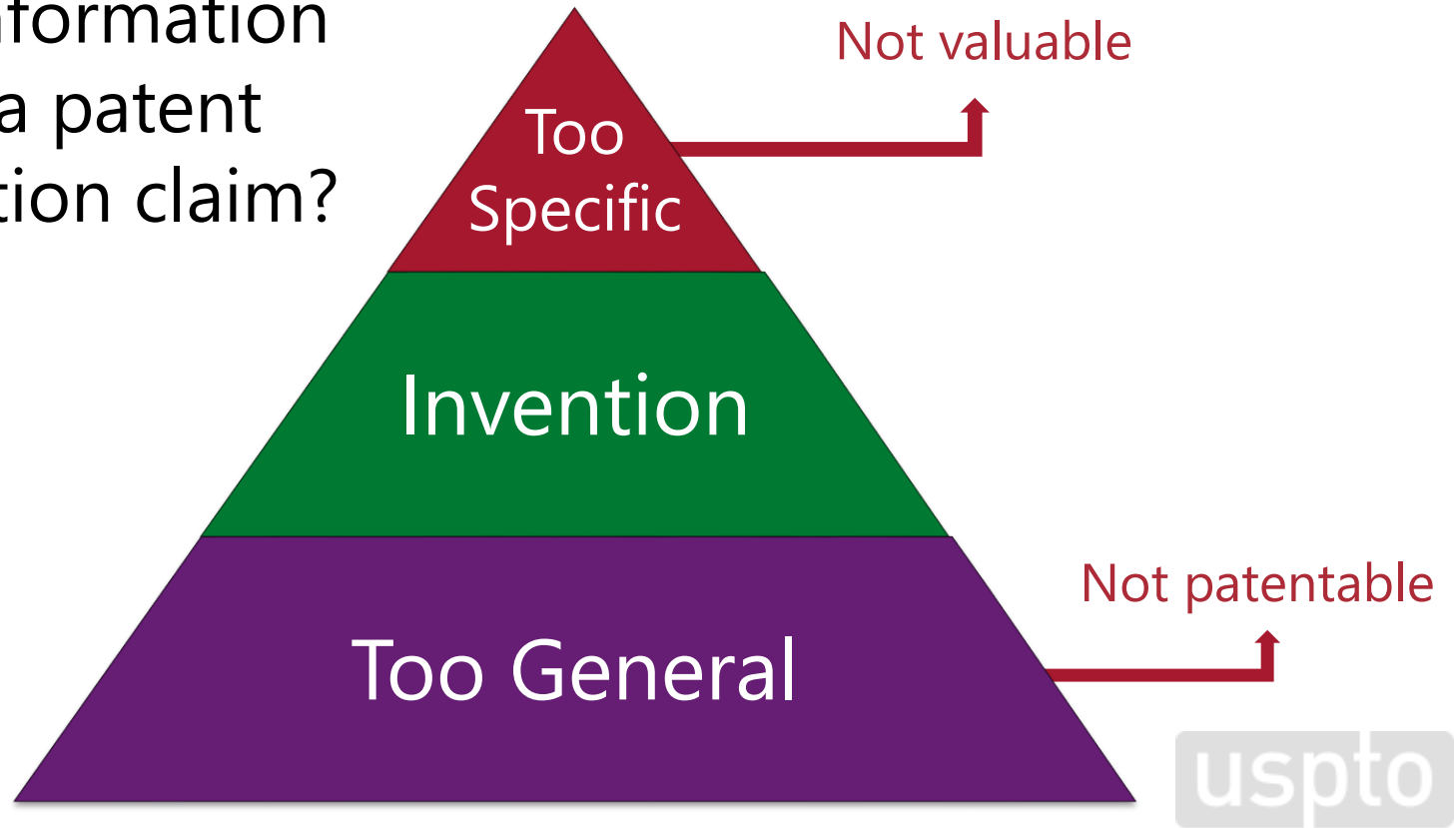
**Non-provisional patent application**

# Nonprovisional patent application

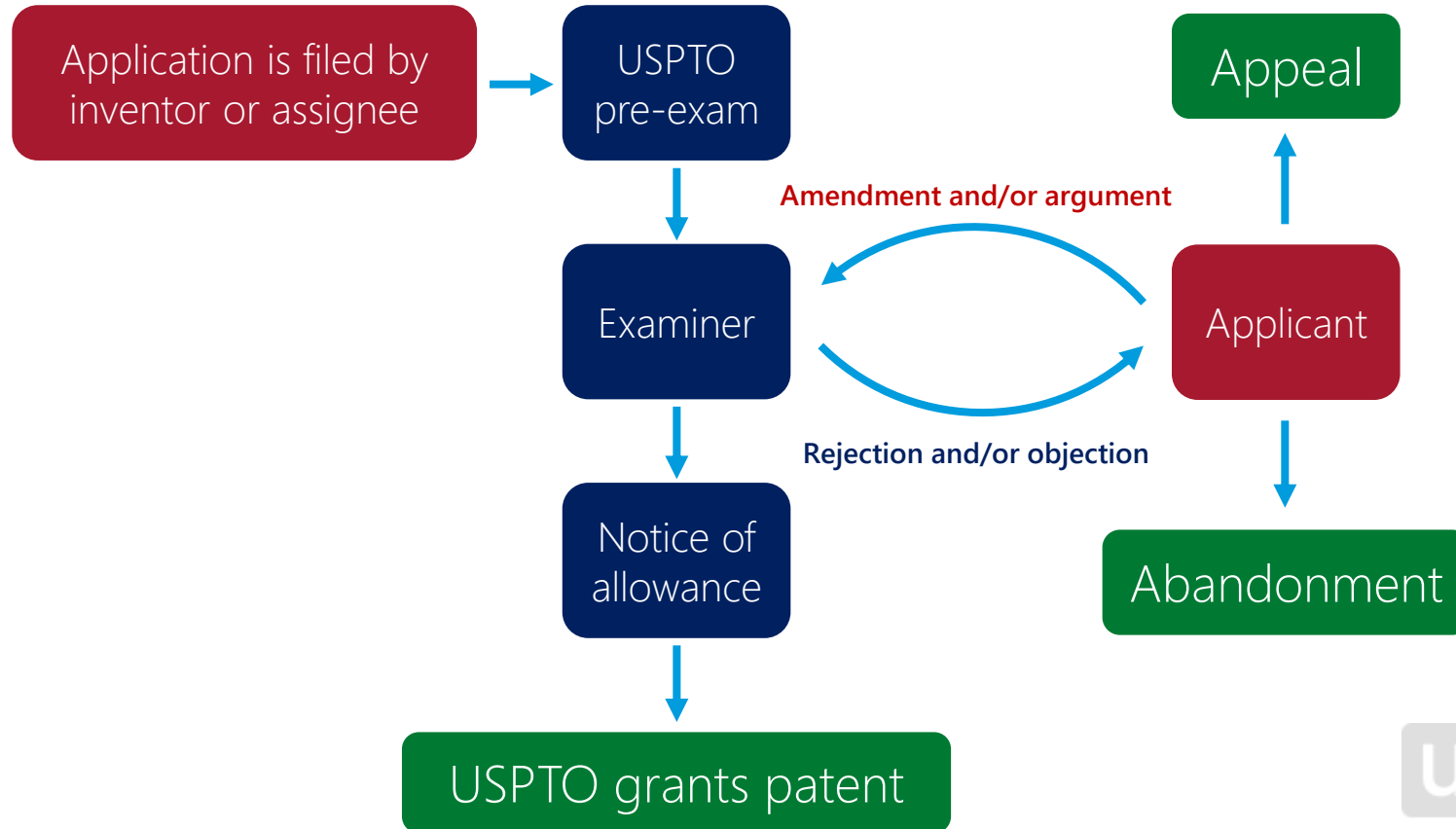
- **Filing Requirements for Examination**
- A specification, including a description and a claim or claims
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
  - Oath or declaration or an application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

# Claim scope

What information should a patent application claim?



# Patent examination

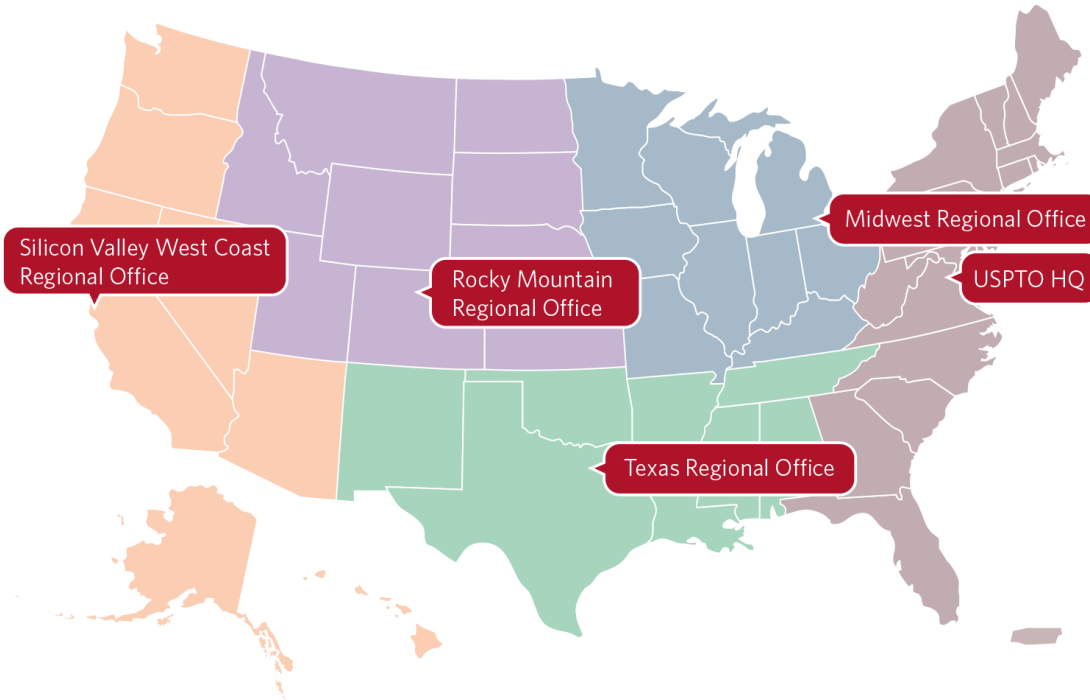


# What happens after I get my patent?

- 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**

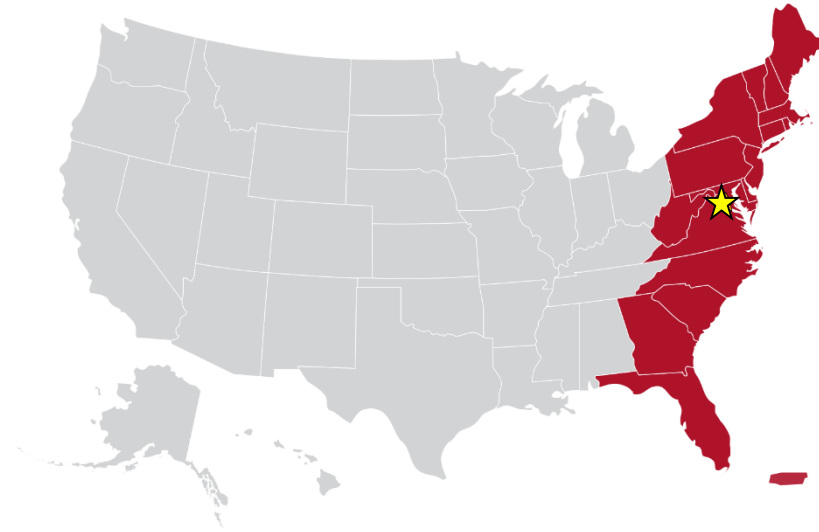
- San Jose City Hall Building
- Operational since October 2015

## **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 navigation and content for inventor and entrepreneur resources. The header includes the USPTO logo, the text 'UNITED STATES PATENT AND TRADEMARK OFFICE', and a search bar. Below the header is a navigation menu with tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. The main content area is titled 'Inventor and entrepreneur resources' and is organized into four columns of resource cards.

- Patents for startups:** Describes the patent process as challenging for beginners and provides links to 'Patent process overview', 'Inventors Assistance Center', 'Patents FAQs', 'Patents homepage', 'Search for patents', and 'Official Gazette for patents'.
- Trademarks for inventors and entrepreneurs:** Explains the trademark process and provides links to '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:** Describes the Inventors Assistance Center (IAC) and provides links to 'Inventors Assistance Center', 'Patents Ombudsman Office', 'BusinessUSA', 'Trademark Assistance Center', and 'University Outreach Program'.
- Education and information:** Provides guides and information for inventors, with links to '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:** Warns that the USPTO does not investigate complaints and provides links to 'Scam prevention basics', 'Non-USPTO trademark solicitations', 'American Inventors Protection Act of 1999', 'Federal Trade Commission', and 'Consumer protection'.
- Pro Se and Pro Bono:** Explains the Pro Bono Program and provides links to 'Pro Se', 'Pro Bono', 'Patent and Trademark Resource Centers', and 'Law School Clinics'.
- Current Events:** Provides information about conferences and conventions, with a link to 'Upcoming events'.
- Other federal resources:** Lists helpful resources from other agencies, including '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**

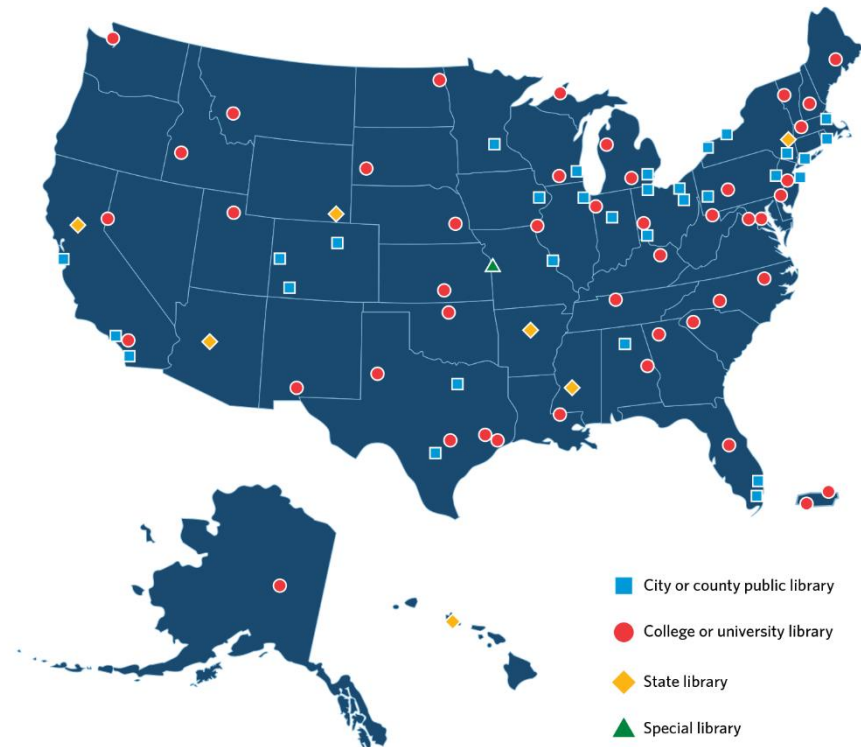
|                      |           |               |                |                |           |
|----------------------|-----------|---------------|----------------|----------------|-----------|
| Alabama              | Georgia   | Maryland      | New Jersey     | Rhode Island   | Wisconsin |
| Alaska               | 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 Brno     | West Virginia  |           |



# Patent and Trademark Resource Centers (PTRC)

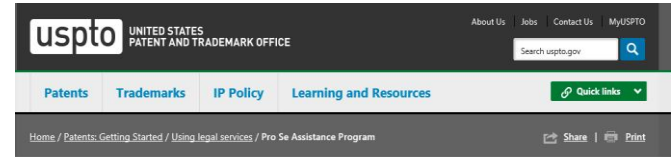
Nationwide network of public, state, and academic libraries that are designated by the USPTO to disseminate patent and trademark information and to support intellectual property needs of the public.

[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

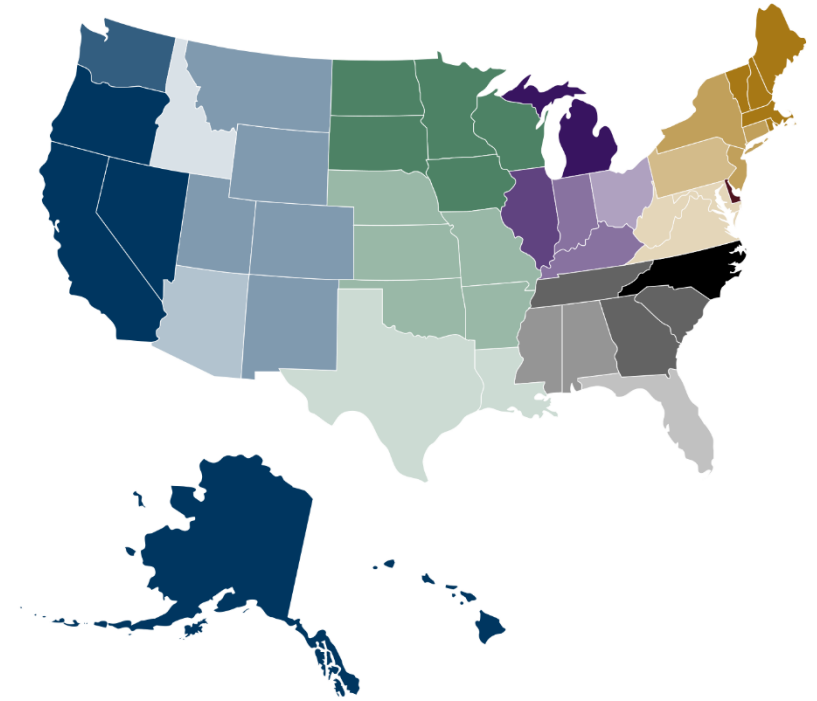
- Patent Pro Bono Program
- Law School Clinic Certification Program

*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)