

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





Empowering Innovation: Introduction to Intellectual Property

Wright State University IP Day

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Director, Elijah J McCoy Midwest Regional USPTO

September 7, 2016

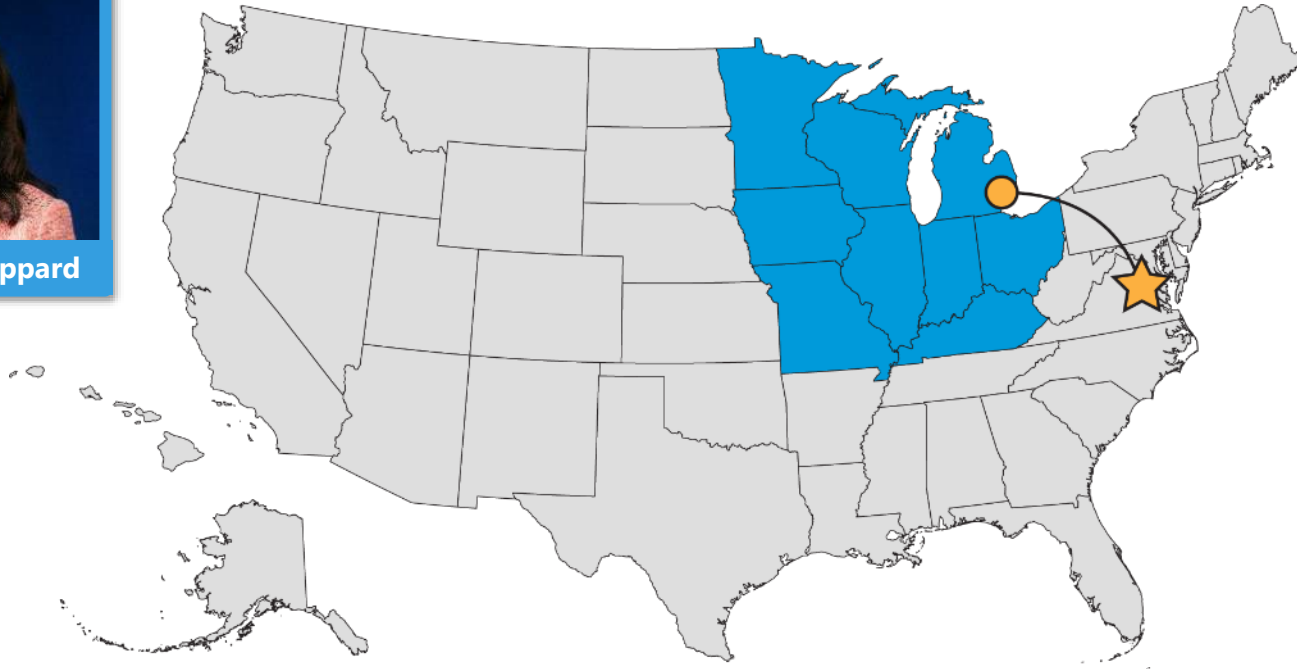
UNITED STATES
PATENT AND TRADEMARK OFFICE



Objectives

- **Establishing a Regional Presence: USPTO Regional Offices**
- **Intellectual Property Awareness**
- **Introduction to Patents, Trademarks, Copyrights, and Trade Secrets**

Meet the Regional Offices: Detroit



Elijah J. McCoy Midwest Regional Office



oto

Detroit Highlights

- Operational at 300 River Place since July 2012
- 121 Examiners Trained / 11 Administrative Patent Judges
- Outreach Highlights
 - Patent Trademark and Resource Center Tour
 - 7 Events between March and July 2016
 - K-12, University, and Law School Outreach
 - Monthly Programming
 - Trademark Tuesdays
 - Patent Wednesdays
 - IP Basics and Resource Tour
- Stakeholders Reached:
 - Approx. 5,500 between July 2012 and Jan 2015
 - Approx. 18,106* between Feb 2015 to Present



* - directly spoke to or interacted with



Detroit Highlights cont.

- **April 4-5, 2016 – Additive Manufacturing User Group**
 - St. Louis, Missouri
- **April 14, 2016 – Chicago Women in IP**
 - Chicago, Illinois
- **May 18-20, 2016 – AIPLA Spring Meeting**
 - Minneapolis, Minnesota
- **June 3, 2016 – Michigan SBA Encore Entrepreneurs**
 - Detroit, Michigan
- **June 15, 2016 – Oakland County Economic Development Medical Main Street Roundtable**
 - Pontiac, Michigan
- **July 11, 2016 – STAIRS to Success: STEM & Information Research Skills**
 - Highland Heights, Kentucky
- **July 18 – 20, 2016 – Association of University Technology Managers Central Regional Meeting**
 - Milwaukee, Wisconsin



AIA Section 23(b)

The purposes of the satellite offices established under subsection (a) are to—

- (1) increase outreach activities to better connect patent filers and innovators with the Office;
- (2) enhance patent examiner retention;
- (3) improve recruitment of patent examiners;
- (4) decrease the number of patent applications waiting for examination; and
- (5) improve the quality of patent examination.

USPTO Offices



Detroit

- Operational since July 2012

Denver

- Byron G. Rogers Federal Building
- Operational July 2014

Silicon Valley

- San Jose City Hall Building
- Operational October 2015

Dallas

- Terminal Annex Federal Building
- Operational November 2015



Working with Startups

Programs for the Innovation Community designed to:

- Increase Awareness of Intellectual Property
 - IP Strategy **IS** a Business Strategy
- Identify Risks of Early Public Disclosure
 - U.S. is now a First Inventor to File System
 - Understanding the Grace Period
 - Loss of rights internationally
 - % foreign filing
 - Crowdfunding Campaigns
 - Disclosure vs. On Sale Bar issues ?
- Where to get help

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

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**
 - Patents (Utility, Design, Plant)
 - Trademarks (Trademark, Service Marks, geographic certification, etc.)
 - Copyrights
 - Trade Secrets
- **Develop a plan, set goals and implement**
- **Get help!**

IP Awareness Assessment Tool

ipAwarenessAssessment Beta II uspto NIST

A business and inventors IP evaluation tool

IP Awareness Assessment

The IP Awareness Assessment, developed under the joint efforts of United States Patent and Trademark Office (USPTO) and National Institute of Standards and Technology/Manufacturing Extension Partnership (NIST/MEP), allows you to assess your intellectual property awareness. Following the completion of the assessment, you will receive a customized training material. [Learn more](#)

Feedback

Your **feedback** and comments are crucial for improving the IP Awareness Assessment.

Inventor Assistance Program

Important Notice

Please note that any information provided here does not constitute legal advice, but is intended to increase your IP awareness. When filing an application for obtaining specific IP rights, it is recommended that you obtain professional legal assistance. The IP Awareness Assessment contains links to external websites. USPTO does not maintain those external sites and is not responsible for the material found therein.

Welcome to the Intellectual Property Awareness Assessment Tool. The IP Assessment includes the below five general categories, that are included in all assessments.

- IP Strategies & Best Practices
- International IP Rights
- IP Asset Tracking
- Licensing Technology to Others
- Using Technology of Others

There are five additional categories that all can take or, which may be customized through a Pre-assessment. These five categories include:

- Copyrights
- Design Patents
- Trademarks
- Trade Secrets
- Utility Patents

Not all businesses have all categories of IP Assets so they have an opportunity to opt out of certain categories by using the customizer or Pre-assessment or may opt to take the full assessment of ten categories containing 62 questions.

The full assessment requires about 20-30 minutes to complete. The customizer or Pre-assessment can reduce the required time by 10-15 minutes.

enter the IP Awareness Assessment

Before starting the assessment, please note:

- Save the link for this page as a favorite/bookmark on your browser.
- In the "Internet Options" of your browser, deselect/uncheck history on exit. This will allow you to return and resume your assessment session in case you cannot finish it in one sitting. This will also allow you to access your training materials and assessment results at your convenience.
- As you are answering the assessment questions, choose the answer that best applies to your business or circumstances as an independent inventor or individual. Where applicable, choose all the responses that apply to your situation.
- Responses or data collected in the assessment are not stored or used by the USPTO or NIST MEP.

<http://www.uspto.gov/inventors/assessment/>

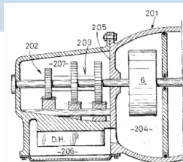


Overview of IP: Types

- **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 Intellectual Property

	<u>Utility Patent</u>	<u>Design Patent</u>	<u>Trade Secrets</u>	<u>Copyrights</u>	<u>Trademarks</u>
<i>What is protected</i>	Inventions – Process, machine, manufacture, or composition of matter	Ornamental characteristics embodied in, or applied to, an article of manufacture	Business-related information (formulas, techniques, information)	Art, in an all-encompassing sense	Marks that indicates the source or origin of goods or services
<i>Requirements</i>	Utility, novelty, and nonobviousness	Novelty and nonobviousness	Commercial value, generally not known, and reasonable efforts of secrecy	Original, authorship, and fixation in a tangible medium	Use in commerce and either distinctiveness or secondary meaning
<i>Protects Against...</i>	Making, selling, offering for sale, and importing	Making, selling, offering for sale, and importing	Stealing	Copies, performances, displays, and derivative works	Use of a mark that causes the likelihood of confusion
<i>Endures until...</i>	20 years from filing date	15 years from issuance	Publicly disclosed	The life of the author + 70 years	Abandoned
<i>Rights of Independent Third Party Creators</i>	None	None	Full	Full	None



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



Overview of IP: Trademarks



Common Law

- protection derived from use (™)

State Registration

- registered with one or more U.S. states

Federal Registration

- registered in the U.S. Patent and Trademark Office

Protects against confusion as to the source of goods or services, not from competition that does not confuse customers

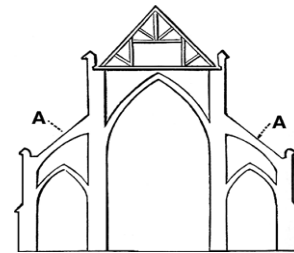
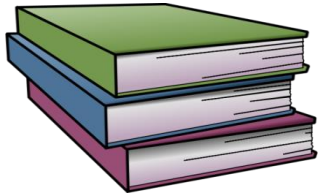
Federally Registered Trademarks

- 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: 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



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 1800's
- All states have some sort of trade secret protection
- Most laws based on the Uniform Trade Secrets Act
- In 2016, the Defend Trade Secrets Act was signed by the President



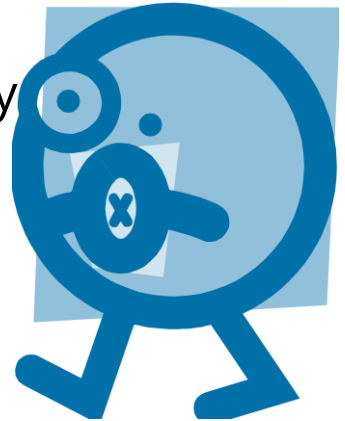
Why use a Trade Secret?

Trade Secret Basics:

- Protects commercially valuable proprietary information, e.g., formulas or business information that gives a competitive advantage
- Trade Secrets are not generally known and must be subject to reasonable efforts to preserve confidentiality

Common Ways to Lose a Trade Secret:

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



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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: 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

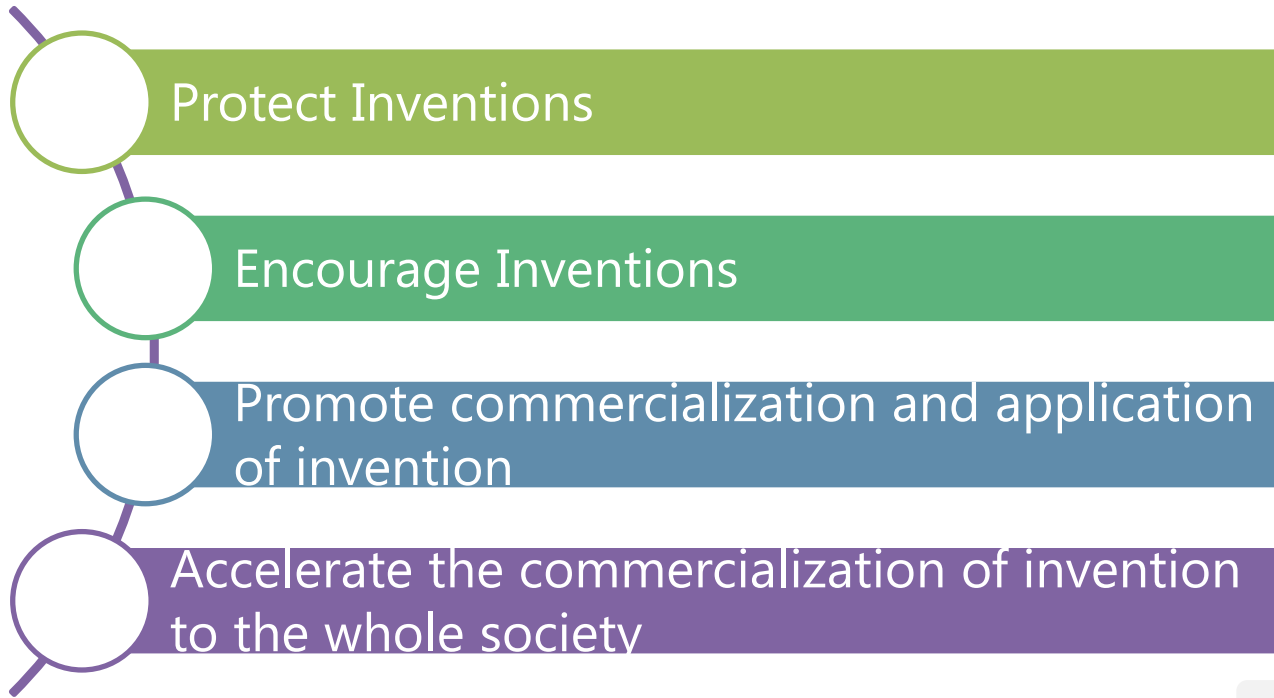


Why get a Patent?

- A patent can be:
 - Used to gain entry into, and deter others from, a market
 - Used as a marketing tool to promote unique aspects of a product
 - Assert/enforce rights against an infringer or competitor
 - Used as collateral to obtain funding
 - Create revenue – sell or license like other property



The Role of the Patent System



Design vs. Utility

- Design Patent – protects the way an article looks (35 U.S.C. § 171)
 - Protects *ornamental characteristics*
- Utility Patent – protects the way an article is used and works (35 U.S.C. § 101)
 - Protects *functional characteristics*

Overview of IP: A 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



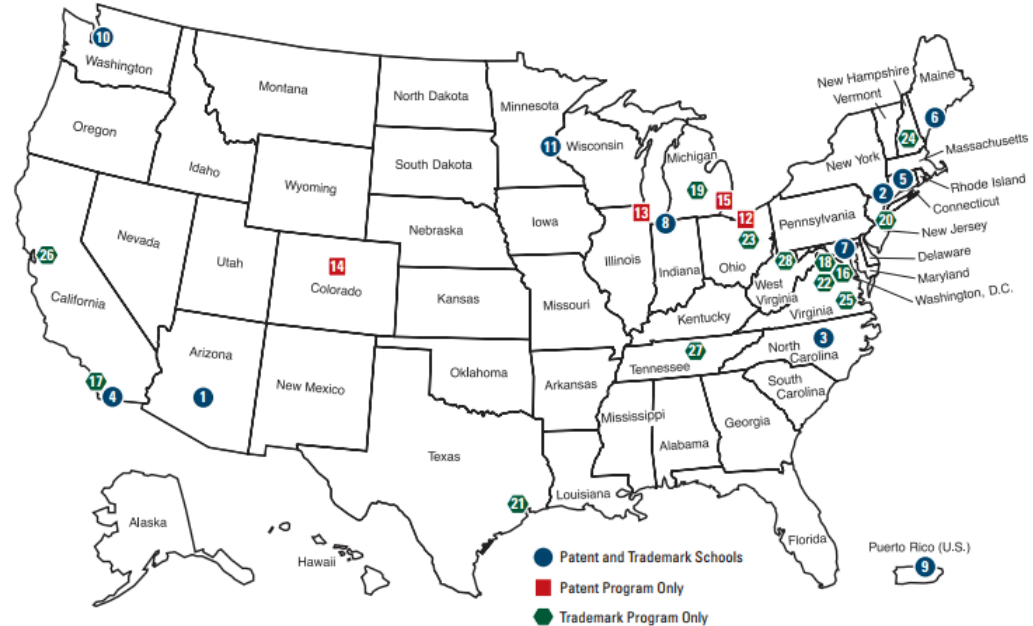
USPTO Initiatives

UNITED STATES
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Law School Clinical Programs

The Law School Clinic Certification Pilot program allows law students enrolled in a participating law school's clinic program to practice Intellectual Property Law before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor.



http://www.uspto.gov/ip/boards/oed/practitione/r/agents/law_school_pilot.jsp



Law School Clinic Program

- Students at participating law schools to practice IP Law before the USPTO
- Under strict guidance of Law School Faculty Clinic Supervisor
- Can assist independent inventors with drafting and filing applications, as well as prosecution
- Services are provided *pro bono*, each school has its own requirements for acceptance
- Local participating Universities include University of Detroit Mercy and Wayne State University

Patent Pro Bono Program

- **Assists financially under-resourced independent inventors and small businesses.**
 - Section 32 of the AIA calls on the USPTO to work with and support IP law associations to establish pro bono programs.
 - Executive Action in February 2014 required the USPTO to expand the programs to all 50 states.
 - 50 state coverage achieved and maintained since August 2015.
- **Promote small business growth and development.**
- **Help ensure that no deserving invention lacks patent protection because of a lack of money for IP counsel.**
- **Opportunity for patent attorneys to serve in their area of expertise.**

General Criteria for Inventors

- **Gross household income – region dependent, but most regions limit to 300% of the poverty levels.**
 - A single person could have an income of up to \$34,500.
 - A family of 4 could have a gross income of up to \$72,900.
- **Knowledge of the patent system.**
 - Have at least a provisional application on file with the USPTO or successfully complete the certificate training course at <http://www.uspto.gov/video/cbt/certpck/index.htm>.
- **Have an invention, not merely an idea.**
 - To demonstrate that there is an invention one should be able to describe the invention so that someone could make and use the invention (“reduction to practice”).
- **Pay all USPTO fees (discounts may be available).**
- **Be an active participant in your patent application prosecution!**

Applying to the Patent Pro Bono Program for Inventors

Two ways to apply:

1. Apply through an online portal, the National Clearinghouse, operated by the Federal Circuit Bar Association

- <https://fedcirbar.org/Pro-Bono-Scholarships/PTO-Pro-Bono/Overview-FAQ>

2. Apply directly to your regional program.

- See www.uspto.gov/probonopatents

Patent and Trademark Resource Centers

- A 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.
- Located in almost every state -
<http://www.uspto.gov/products/library/ptdl/locations/index.jsp>
- PTRC library staff can assist with the following:
 - Provide access to resources PubEAST and PubWEST, examiner-based search systems
 - Explain the application process and fee schedule
 - Demonstrate how to use search tools to conduct a patent or trademark search
 - Share a directory of local patent attorneys who are licensed to practice before USPTO
 - Offer classes on intellectual property (varies by location)
 - Offer assistance on how to do historical research on patents and trademarks
 - Show how to track current research by company or nonprofit
 - Help find assignee information and much more

Micro Entity Status

- **75% off most patent fees**
- **Low cost submission to establish filing date**
 - Provisional Application Filing Fees
 - \$130 small entity
 - \$65 micro entity
- **Micro entity certifies that he/she:**
 - Qualifies as a small entity (less than 500 employees);
 - Has not been named as an inventor on more than 4 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 3 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 3 times the median household income.

Inventors Eye – Easy to Subscribe!

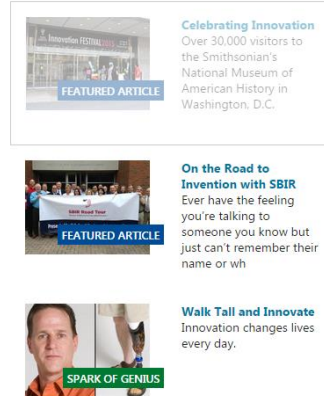


December's Featured Article Article



Celebrating Innovation

In This Issue



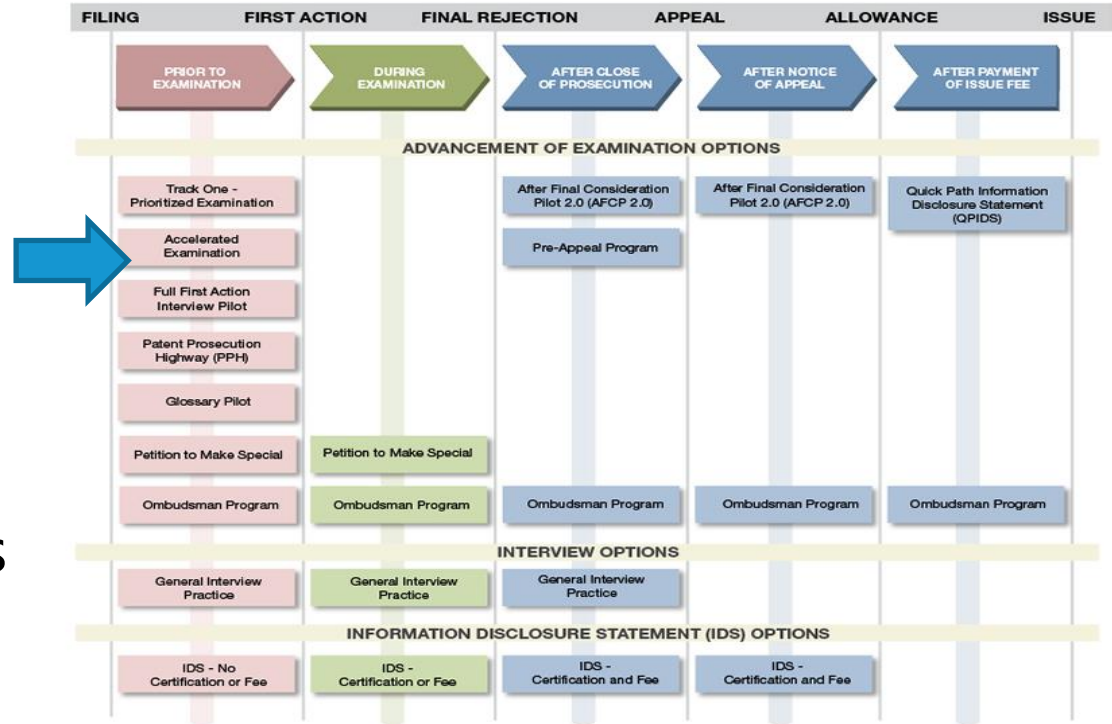
<http://www.uspto.gov/inventors/independent/index.jsp>



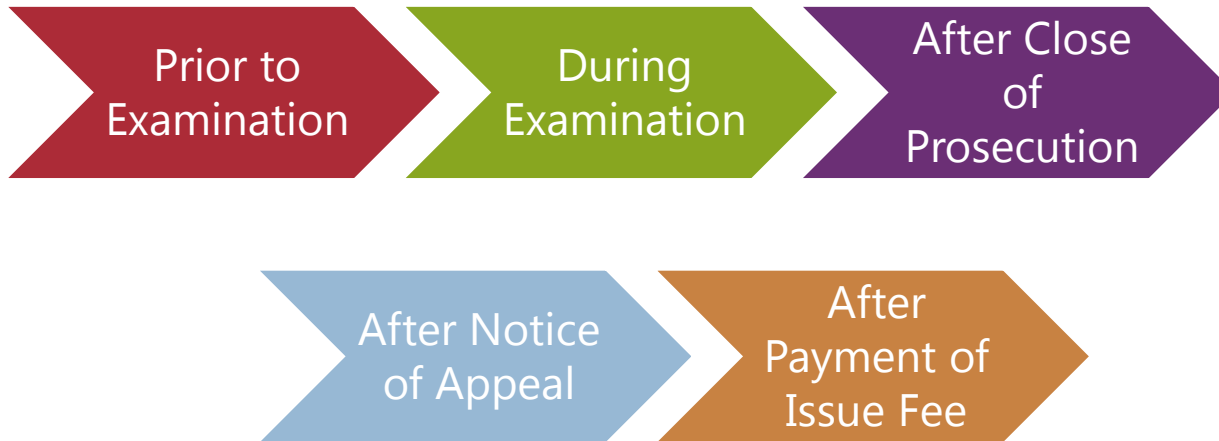
Patent Application Initiatives

You can get to the program pages by selecting a tile.

There are numerous programs that may speed up the examination process



USPTO Patent Application Initiatives



http://www.uspto.gov/patents/init_events/patapp-initiatives-timeline.jsp

Tools Prior to Examination

Track One –
Prioritized
Examination

Full First Action
Interview Pilot

Global Patent
Prosecution
Highway (IP5 -
1/6/14)

Patent Prosecution
Highway (PPH 2.0,
includes PCT PPH
2.0)

Glossary Pilot

Ombudsman
Program

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http://www.uspto.gov/patents/init_events/patapp-initiatives-prior.jsp

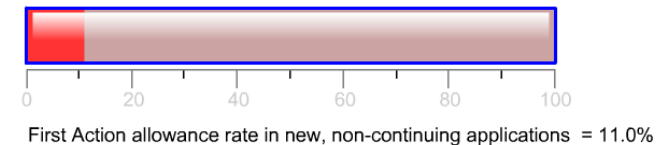
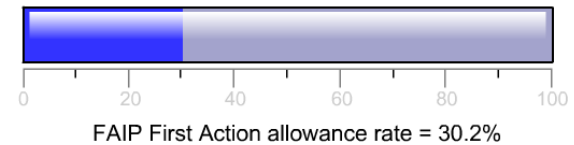
Track One – Prioritized Examination



- Fee – \$4000/\$2000/\$1000
- Claim Limits – 4 Independent, no more than 30 claims

First Action Interview Pilot

- Under this Program, an applicant is entitled to a first action interview, upon request, prior to the first Office action on the merits.
- Need to file a Petition.

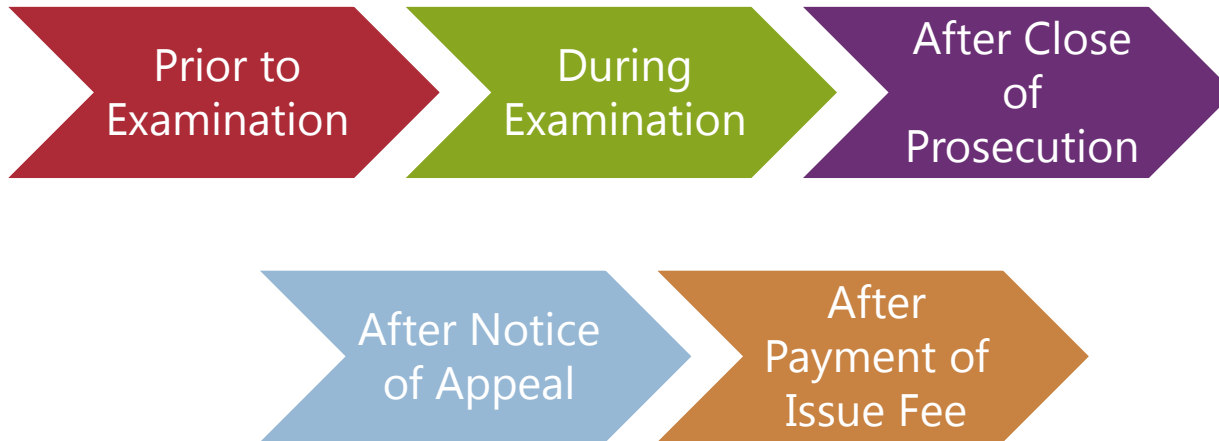


March 2013

http://www.uspto.gov/patents/init_events/faipp_full.jsp



USPTO Patent Application Initiatives



http://www.uspto.gov/patents/init_events/patapp-initiatives-timeline.jsp

Tools During Examination

Petition to
Make Special

Ombudsman
Program

General
Interview
Practice

IDS –
Certification
or Fee

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Ombudsman Program

- Enhances the USPTO's ability to assist applicants or their representatives with issues that arise during patent application prosecution.

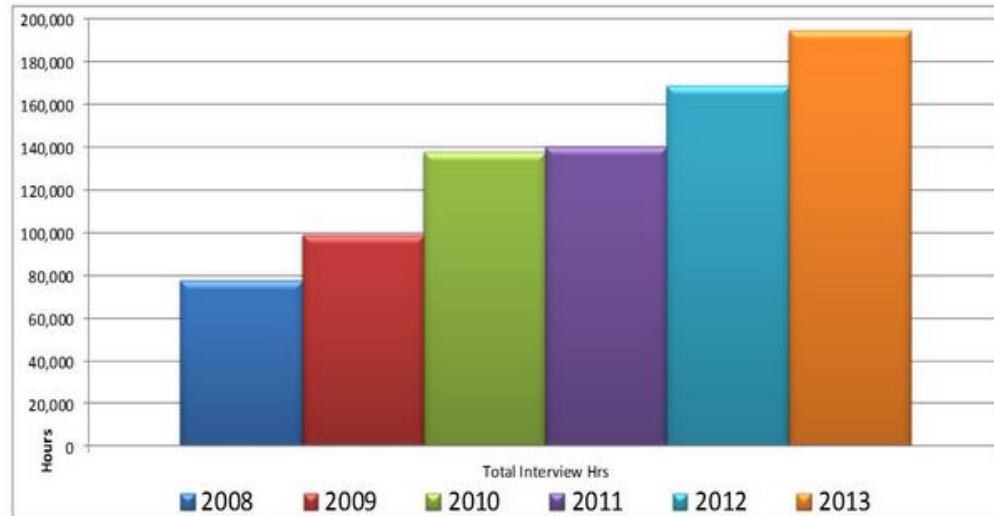


Contact an Ombudsman by:

<http://www.uspto.gov/patents/ombudsman.jsp>

General Interview Practice

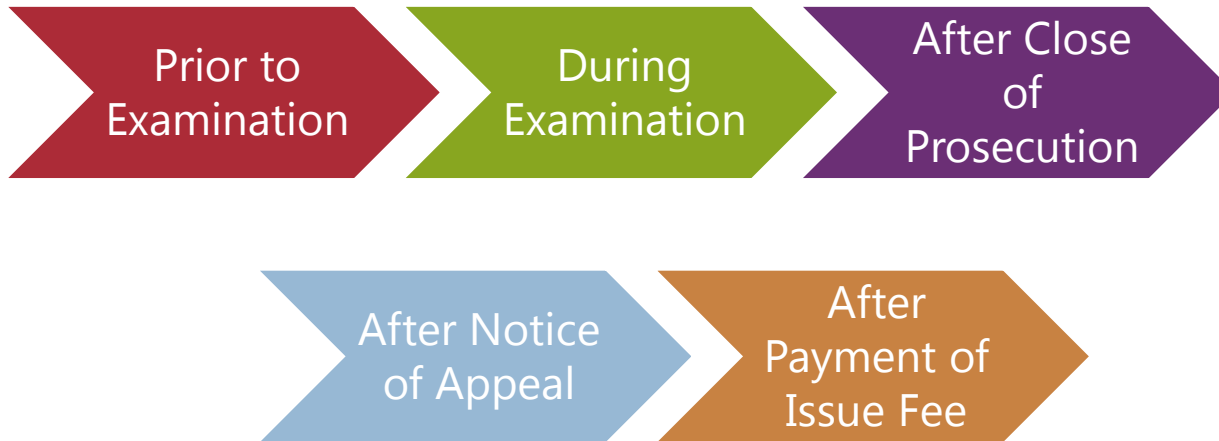
Interview Time FY 2008 – FY 2013



General Interview

- The USPTO encourages examiners to take a proactive approach to examination by reaching out and engaging our stakeholders in an effort to resolve issues and shorten prosecution.
- **WebEx** – Video conferencing tool that allows examiners and stakeholders to share information and collaborate in real time.
- **Public Interview Room** - Private room on the USPTO campus to hold video conferences via WebEx with remote examiners.
 - Established in Alexandria, Denver and Detroit.
 - Examiners will reserve the room.

USPTO Patent Application Initiatives



http://www.uspto.gov/patents/init_events/patapp-initiatives-timeline.jsp

Tools After Close of Prosecution

After Final
Consideration Pilot
2.0

Pre-Appeal
Program

Ombudsman
Program

General Interview
Practice

Quick Path
Information
Disclosure
Statement (QPIDS)

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http://www.uspto.gov/patents/init_events/patapp-initiatives-after.jsp

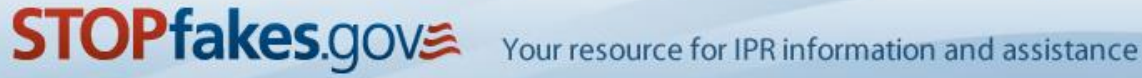
Patent Litigation Online Toolkit

Been Sued or Gotten a Demand Letter?

- Answers To Common Questions About Abusive Patent Litigation



STOPfakes.gov



- STOPfakes.gov was launched to serve as a one-stop shop for U.S. government tools and resources on intellectual property rights (IPR). The federal agencies behind STOPfakes.gov have developed a number of resources to educate and assist businesses, particularly small and medium-sized enterprises (SMEs), as well as consumers, government officials, and the general public.

The STOPFakes.gov Website

STOPfakes.gov Your resource for IPR information and assistance A A A 100%

HOME ABOUT STOPFAKES RESOURCES FAQs CONTACT US 

Consumer Tools

Learn how to spot a fake and where you can report counterfeit and pirated goods.

[read more](#)



1 2 3 4 

<h3>Business Tools</h3> <p>Find resources to protect your innovations, spur creativity, and market products safely at home and abroad. Read more</p>	<h3>Consumer Tools</h3> <p>Learn how to spot a fake and where you can report counterfeit and pirated goods. Read more</p>	<h3>U.S. Government Initiatives</h3> <p>Learn how we are working to improve intellectual property protection and enforcement for our companies in markets around the globe. Read more</p>	<h3>Global Partners</h3> <p>Discover information and tools developed by partner governments, private sector groups, and international organizations. Read more</p>
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- Intellectual Property**
Learn about intellectual property. What is it? How do I protect it?
- Find Help**
Information about U.S. Government offices that can help my business.
- Discussion Board**
Discuss, share strategies, and get industry insights about business issues, including intellectual property rights.

Find the best office to help you.

I am a...

China IPR Webinar Series 

IPR Training Module 



IP Attaché Program

- USPTO IP Attachés help improve intellectual property systems internationally.
- Assisted businesses in the protection and enforcement of their IP rights by...
 - Seeking improvements in policies, laws, and regulations
 - Educating host government officials on IP matters
 - Building grassroots support for U.S. policy positions by conducting public awareness programs on IP



IP Attaché Program

• IP ATTACHÉ ASSIGNMENTS

- Bangkok, Thailand (covering Southeast Asia)
- Beijing, China (covering China)
- Kuwait City, Kuwait (covering the Middle East and North Africa)
- Geneva, Switzerland (covering the WTO and WIPO)
- Guangzhou, China (covering China)
- Mexico City, Mexico (covering Mexico, Central America, and the Caribbean)
- Moscow, Russia (covering Russia and the Commonwealth of Independent States)
- New Delhi, India (covering South Asia)
- Rio de Janeiro, Brazil (covering South America)
- Shanghai, China (covering China)

Electronic Resources from the USPTO

- **Patent Process Overview** ▪ An 8 step overview of a patent application and maintenance process www.uspto.gov/patents-getting-started/patent-process-overview
- **Trademark Process Overview** ▪ A 6 step overview of a trademark application and maintenance process www.uspto.gov/trademarks-getting-started/trademark-process
- **EFS-Web Guidance and Resources** ▪ Provides information on using the Electronic Filing System (EFS-Web) www.uspto.gov/patents-application-process/applying-online/efs-web-guidance-and-resources#heading-1
- **Inventors & Entrepreneurs Resources** ▪ Provides links to patent and trademark resources, educational material and general information - www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources
- **Inventors Assistance Center (IAC)** ▪ Answers general questions concerning patent examining policy and procedure - 800-786-9199 www.uspto.gov/learning-and-resources/support-centers/inventors-assistance-center-iac

Electronic Resources from the USPTO

- **Free Legal Representation** ▪ The Patent Pro Bono Program
www.uspto.gov/patents-getting-started/using-legal-services/pro-bono
- **Law School Clinic Certification Program**
www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1
- **Where to Search** ▪ Visit us at one of our USPTO Office Locations
www.uspto.gov/about-us/uspto-office-locations
- **Patent and Trademark Resource Centers (PTRCs)**
www.uspto.gov/learning-and-resources/support-centers/patent-and-trademark-resource-centers-ptrcs
- **USPTO Fee Schedule** ▪ Provides information and fee rates for products and services provided by the USPTO
www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule

