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
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
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
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

New Idea? → Provisional application (optional) → Non-provisional application → Patent!
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
Provisional utility application

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 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
What information should a patent application claim?

- Too General
- Too Specific
- Invention

Not patentable
Not valuable
Patent examination

Application is filed by inventor or assignee

USPTO pre-exam

Examiner

Notice of allowance

USPTO grants patent

Appeal

Amendment and/or argument

Rejection and/or objection

Applicant

Abandonment
What happens after I get my patent?

• Licensing
• Enforcement
• More innovation and competition
• Etc...
USPTO resources
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
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Eastern Regional Outreach Director

- Conduct USPTO programming
- Coordinate USPTO engagement
- Collaborate with USPTO stakeholders
- Communicate 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
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 »
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/pтри
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• Hours of Operation
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• Email
  – innovationdevelopment@uspto.gov

• Phone
  – 866-757-3848
  – Webpage
  https://www.uspto.gov/ProSePatents
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.
Thank you!

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