

**UNITED STATES
PATENT AND TRADEMARK OFFICE**

uspto

IP Strategy IS a Business Strategy

Anchorage, Alaska

October 06, 2016

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*Director of the West Coast Regional Office
United States Patent and Trademark Office*

UNITED STATES
PATENT AND TRADEMARK OFFICE



What is USPTO?

USPTO is the Federal agency that grants U.S. patents and registers trademarks. The Agency also advises the President and Federal agencies on intellectual property (IP) policy, protection, and enforcement, and promotes stronger and more effective IP protection around the world.

Mission:

Fostering innovation, competitiveness and economic growth, domestically and abroad to deliver high quality and timely examination of patent and trademark applications, guiding domestic and international intellectual property policy, and delivering intellectual property information and education worldwide, with a highly skilled, diverse workforce.

What is IP?

Intellectual property (IP) refers to creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce.

(Source: World Intellectual Property Organization, <http://www.wipo.int/about-ip/en/>)

Role of the USPTO in IP

- **100% fee funded agency** - no tax dollars are spent by the USPTO
- **Named One of the Best Places to Work in Federal Government**
- **FY2015 Key Statistics:**
 - **More than 617,000** new patent applications filed; more than **320,000** patents issued
 - **More than 503,000** new trademark applications filed; more than **280,000** trademarks registered
 - Approximately **12,600** employees, including roughly **8,300** patent examiners and **500** trademark attorneys



We're Open for Business!

The USPTO's West Coast Regional Office in Silicon Valley

Establishing A Regional Presence

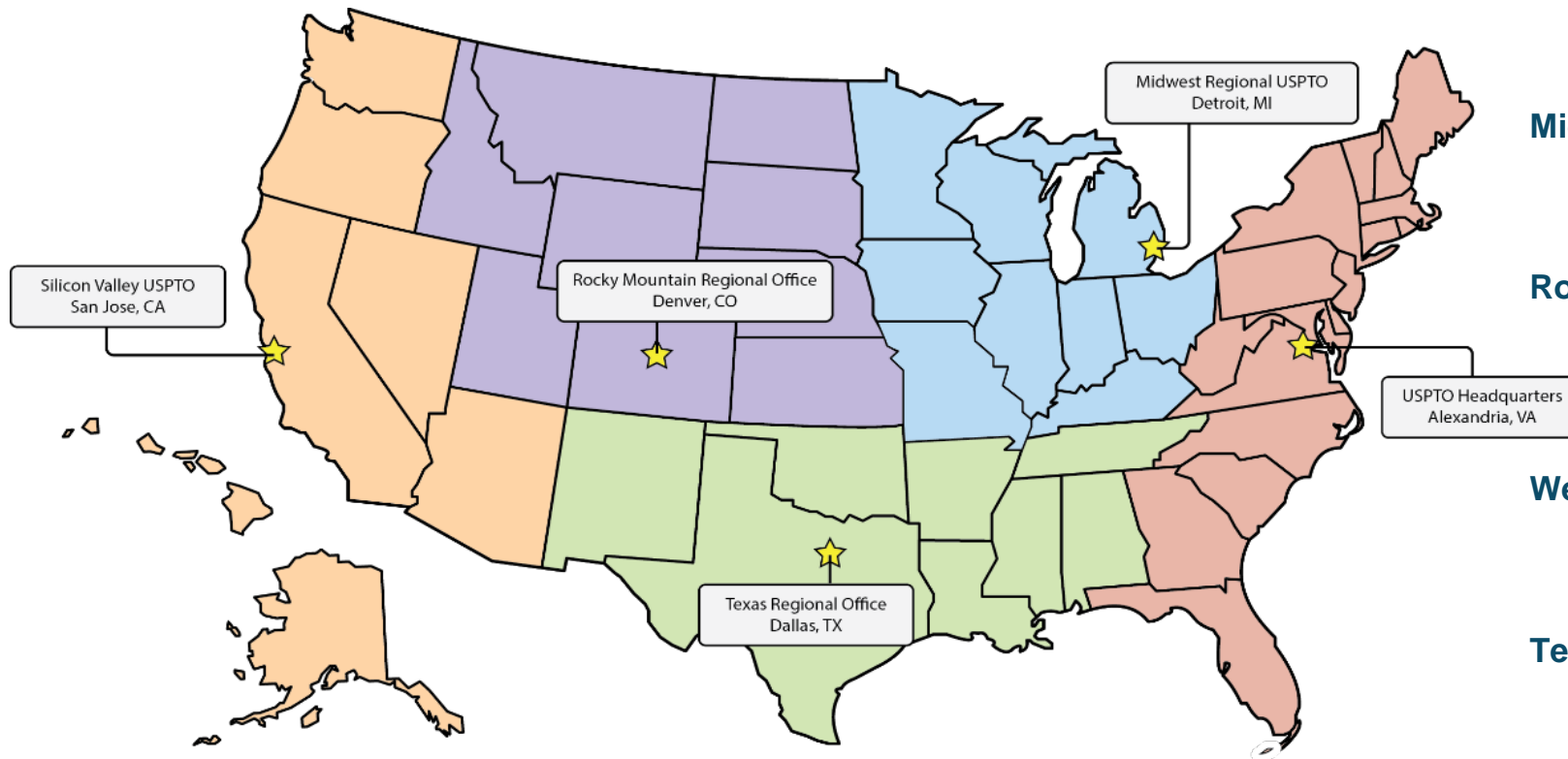
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USPTO Offices



Midwest – Detroit, MI

- Elijah J. McCoy
- Opened July 2012

Rocky Mountain – Denver, CO

- Byron G. Rogers
Federal Building
- Opened July 2014

West Coast – Silicon Vally

- San Jose City Hall
- Opened October 2015

Texas – Dallas, TX

- Terminal Annex
Federal Building
- Opened Nov. 2015



Regional Office Expansion

Three primary goals:

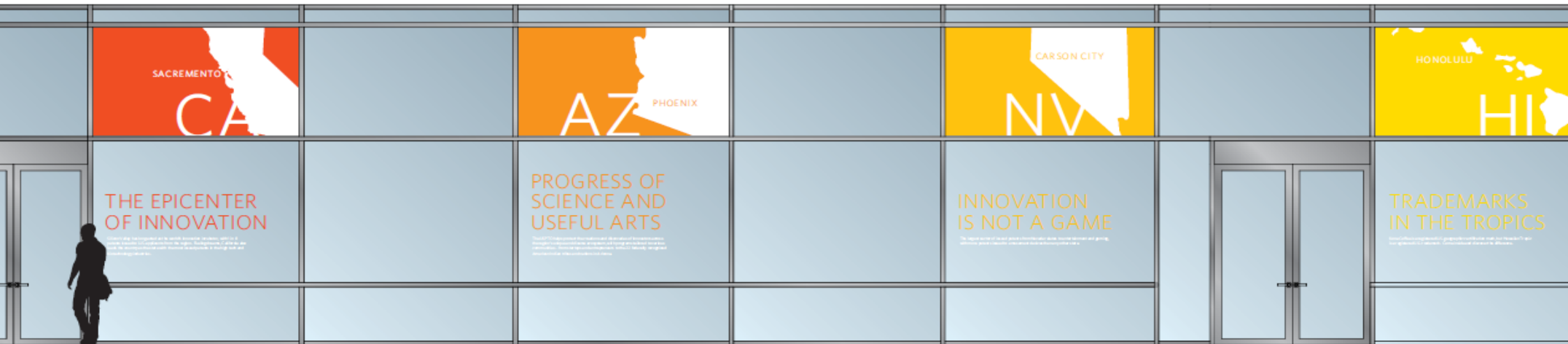
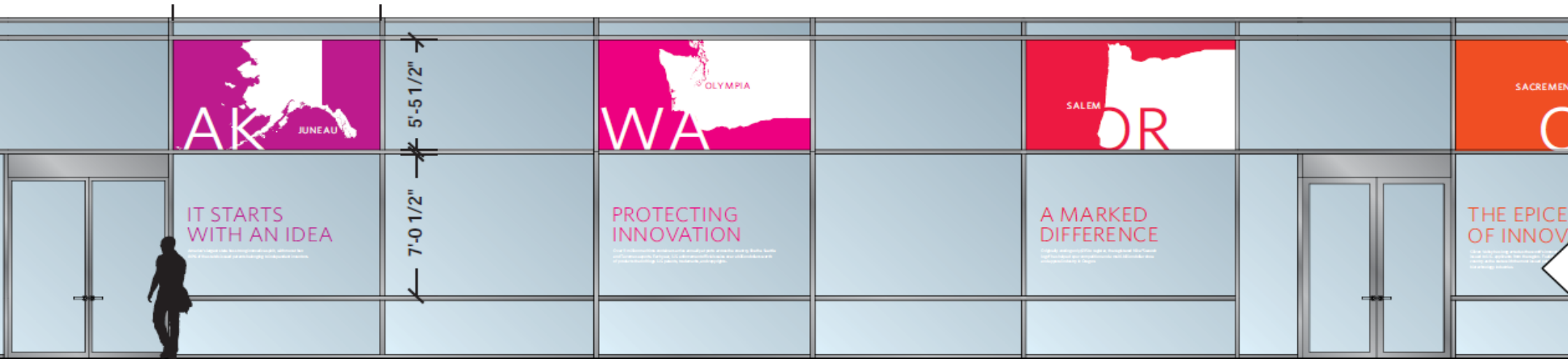
- 1. Bring USPTO services to the region**
... to improve access for stakeholders
- 2. Attract, hire and retain top talent**
... to help keep backlogs low and quality high
- 3. Serve as a hub of outreach and education**
... to support the innovation ecosystem

The Silicon Valley USPTO

West Coast Regional Office



USPTO's West Coast Regional Office San Jose City Hall





SACRAMENTO

CA

THE EPICENTER OF INNOVATION

Silicon Valley has long acted as the world's innovation incubator, with 1 in 8 patents issued to U.S. applicants from the region. Fueling dreams, California also leads the country as the state with the most issued patents in the high tech and biotechnology industries.

Services to the Public:

- **Walk-in services** to obtain information about the USPTO
- **Workstations for searching** patents and trademarks
- **A hearing room** to host Patent Trial and Appeal Board (PTAB) and Trademark Trial and Appeal Board (TTAB) proceedings – remote as well
- **Interview rooms** to connect applicants to examiners working in the region, at HQ or across the country

Outreach & Education Programs:

- **A regional focus** for workshops, just-in-time training, conferences, roundtables, webinars

Across the Innovation Ecosystem – At All Levels – Tailored to your needs!

- **K-12 STEM Institutes** – for Students and Teachers
- **Office hours** for strategic partners like the Small Business Administration, Export Assistance Center, etc...
- **Remote Training Capability** from local experts to all patent examiners in their specialized technical fields

Approximately 125 Employees

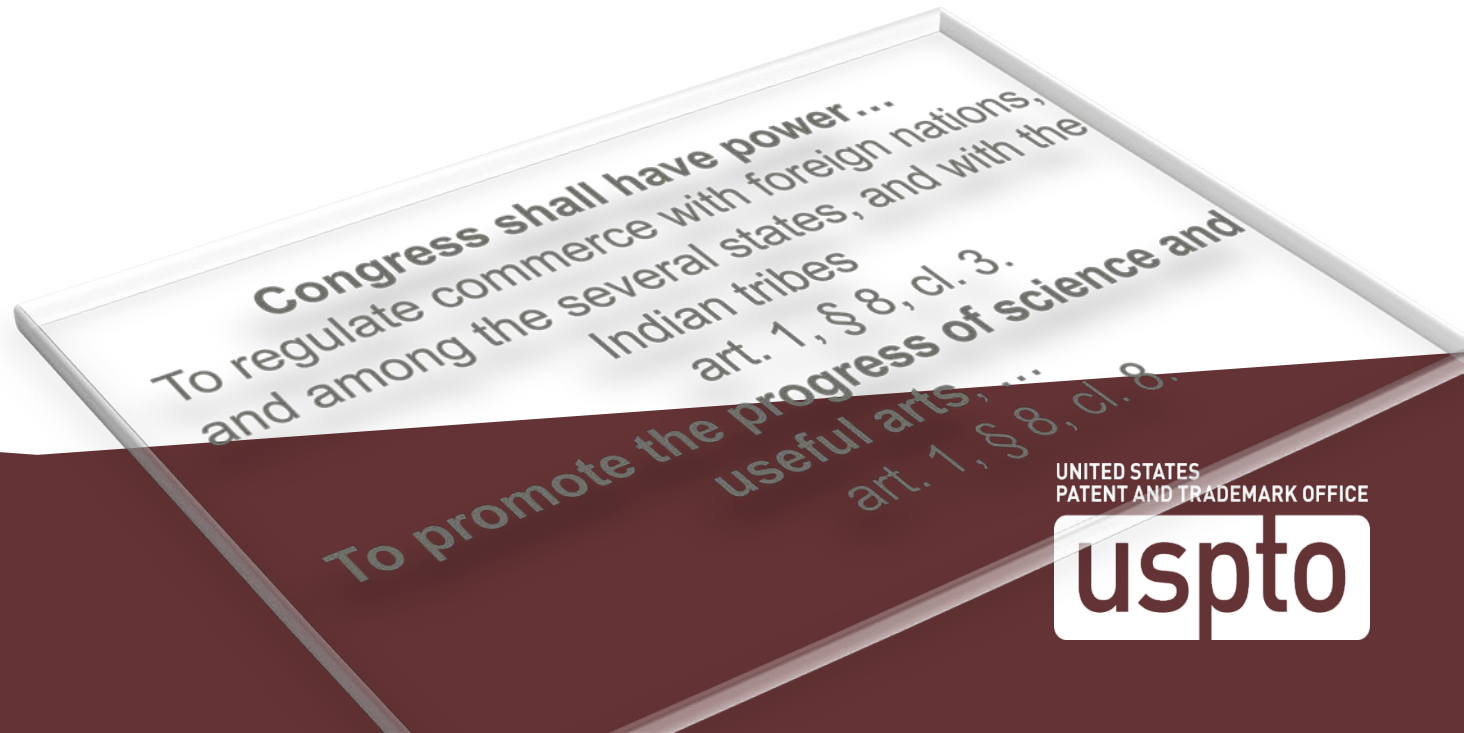
- ~ 80 Patent Examiners
- ~ 25+ Patent Trial and Appeal Board Judges
- + Outreach and Administrative Team



Regional Focus for Workshops

- For All Levels – From K-12 to IP professionals
- From basic facts to updates on law and procedure
- Stakeholder roundtables & roadshows
- Inventor conferences w/ focus on startups
- Tech Specific Partnership Meetings
 - Software, BioTech, CyberTech, Additive Manufacturing
- Facilitated USPTO Webinars
- Lunch & Learn Programs
- International programs
- 1 on 1 assistance, both in-person and virtually
- Just-in-time programming (FITF, §101, Paralegal Workshops, etc.)
- Co-host programs with strategic community partners

Types of Intellectual Property



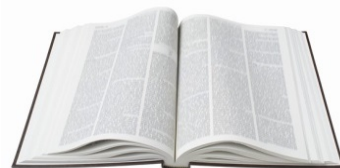
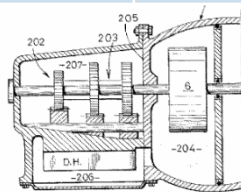
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Overview of Intellectual Property

	What's Protected?	Examples	Protection Lasts for:
Utility Patent	Inventions	iPod, chemical fertilizer, process of manipulating genetic traits in mice	20 years from the date of filing regular patent application
Design Patent	Ornamental (non functional) designs	Unique shape of electric guitar, design for a lamp	15 years
Copyright	Books, photos, music, fine art, graphic images, videos, films, architecture, computer programs	Michael Jackson's Thriller (music, artwork and video), Windows operating system	The life of the author plus 70 years (or some works, 95 years from pub., and others 120 years from creation)
Trade Secret	Formulas, methods, devices or compilations of information which is confidential and gives a business an advantage	Coca-Cola formula, survey methods used by a pollster, new invention for which patent application has not been filed	As long as information remains confidential and functions as a trade secret
Trademark	Words, symbols, logos, designs, or slogans that identify and distinguish products or services	Coca-Cola name and distinctive logo, Pillsbury doughboy character	As long as business continuously uses trademark in connection with goods or services – renew every 10 yrs

12/27/201



Can you find the IP in a mobile phone?

Trademarks:

- Made by "Nokia"
- Product "N8"
- Software by Microsoft "Windows"

Patents:

- Data-processing methods
- Semiconductor circuits
- Chemical compounds
- Battery/Power Control
- Antenna
- Optics

Copyrights:

- Software code
- Instruction manual
- Ringtone
- ...

Trade secrets:

- ???

Designs (some of them registered):

- Form of overall phone
- Arrangement of buttons in oval shape
- Three-dimensional wave form of buttons
- Sliding screen



© Nokia



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**



The Peoples' Benefit

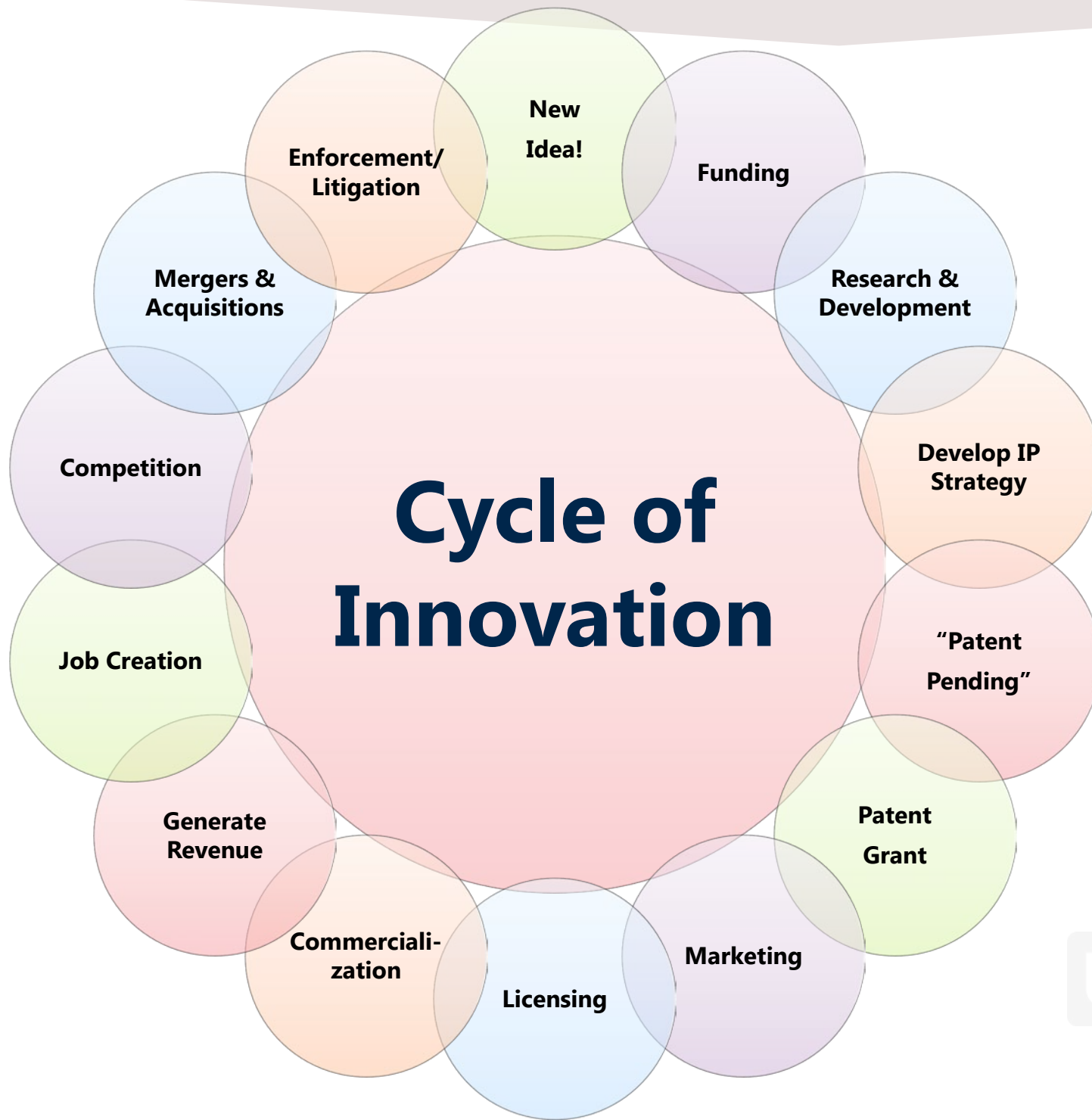
- ◆ To ensure that investment of time and money is rewarded to continue future inventive stimulation
 - Patent gives inventor limited rights
 - 20 Year Term
- ◆ Public is provided disclosure of how to use and make invention
 - Patenting requires publication
 - Accelerates development
 - Strengthens national economy

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





Working with Startups

- **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
 - ~50% 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 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
 - Patents (Utility, Design, Plant),
 - Trademarks (Trademark, Service Marks, geographic certification, etc.)
 - Copyrights
 - Trade Secrets
- Develop a plan, set goals and implement
- Get help!

How tangible are your assets?

50 years ago: Factory, Equipment and Inventory

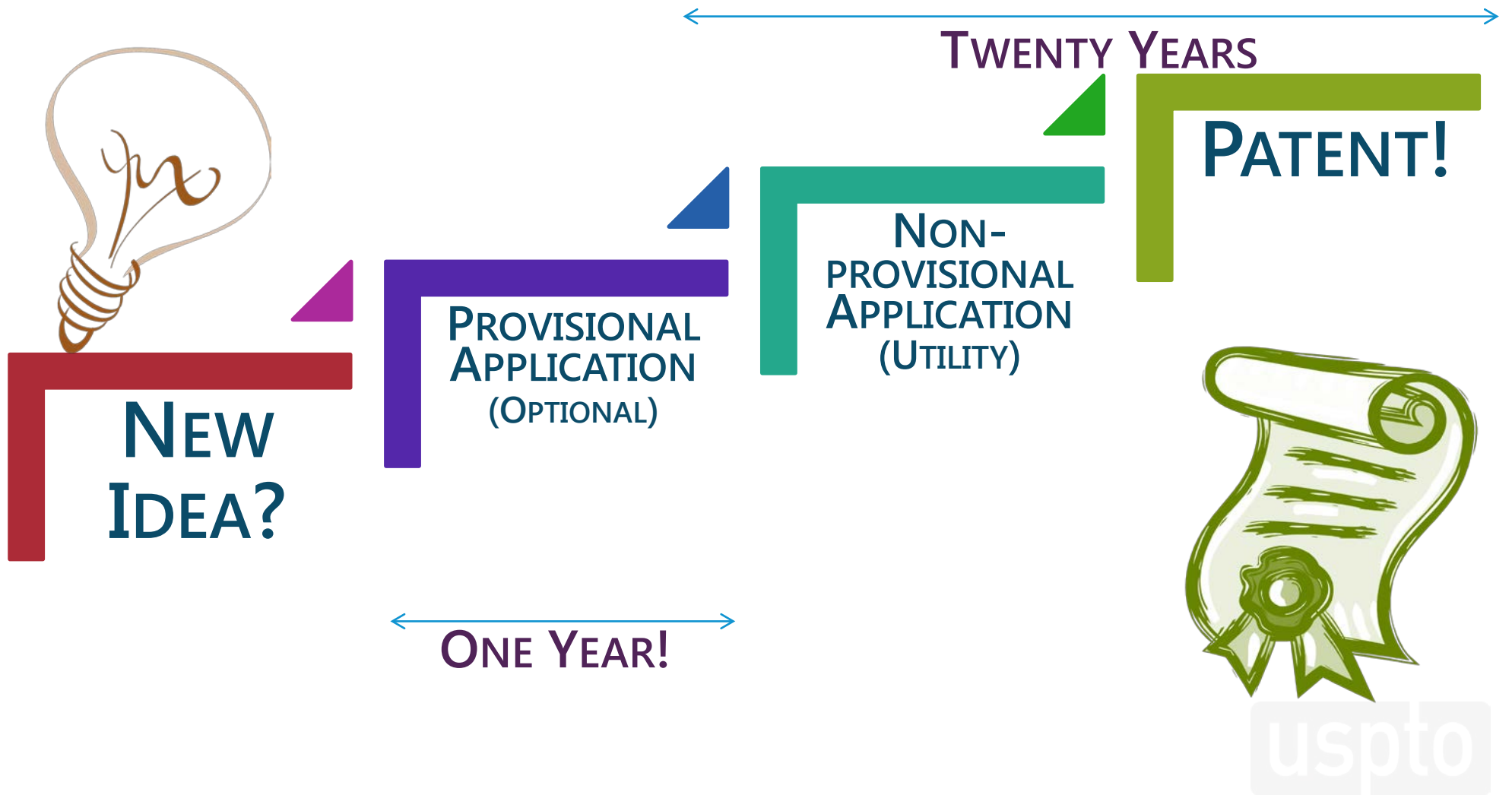
Today: Designs, Processes, Inventions,
Algorithms and Brands

Intellectual Property protects both
tangible and intangible assets!

Patents, Copyrights, Trademarks & Trade Secrets



The Path to a Patent



What are the risks of disclosure?

- What can I say before filing?
- When do I know I've said too much?
- Disclosure vs. Sale
 - Crowdfunding Campaigns
- Can't I just keep it secret?

Examples of Public Disclosure:

- displaying your invention at a trade show,
- posting your invention on the Internet
- offering to sell your invention
- a description of your invention in a newspaper or journal article, or
- publicly demonstrating your invention.

Provisional Utility Applications

- Simplified filing requirements
- Items required:
 1. Specification - CLEARLY DESCRIBED - in compliance with 35 USC 112, Paragraph (a)
 - enabled, written description, best mode
 2. Drawings (needed in almost all cases)
 3. Filing fee
 4. Cover Sheet identifying Provisional Application



What is patentable?



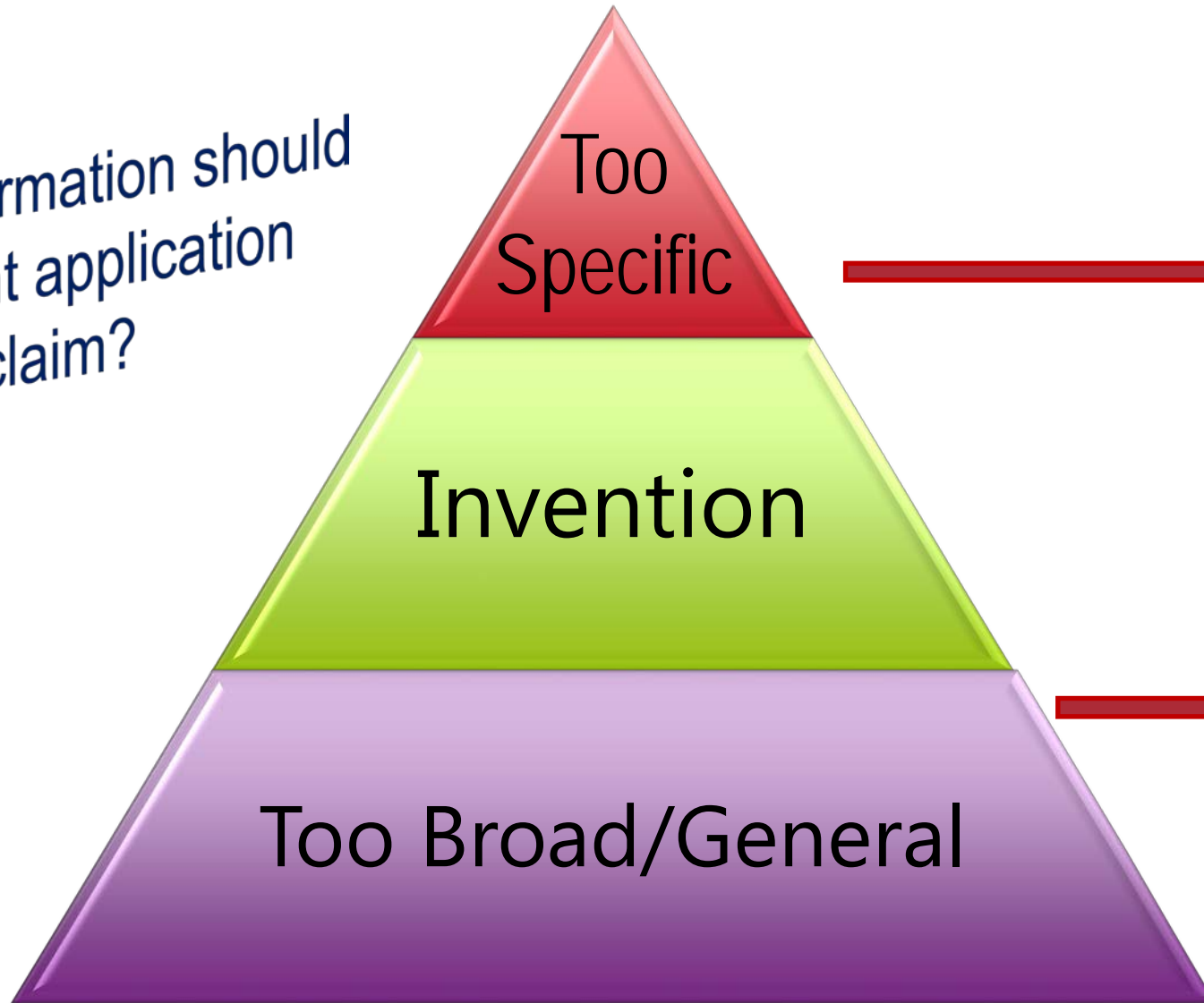
Patent “Claims”

- ◆ The “heart” of the patent grant
- ◆ Specific definition of the invention
- ◆ Metes and bounds of the patent coverage



Patent Claim Scope

What information should
a patent application
claim?



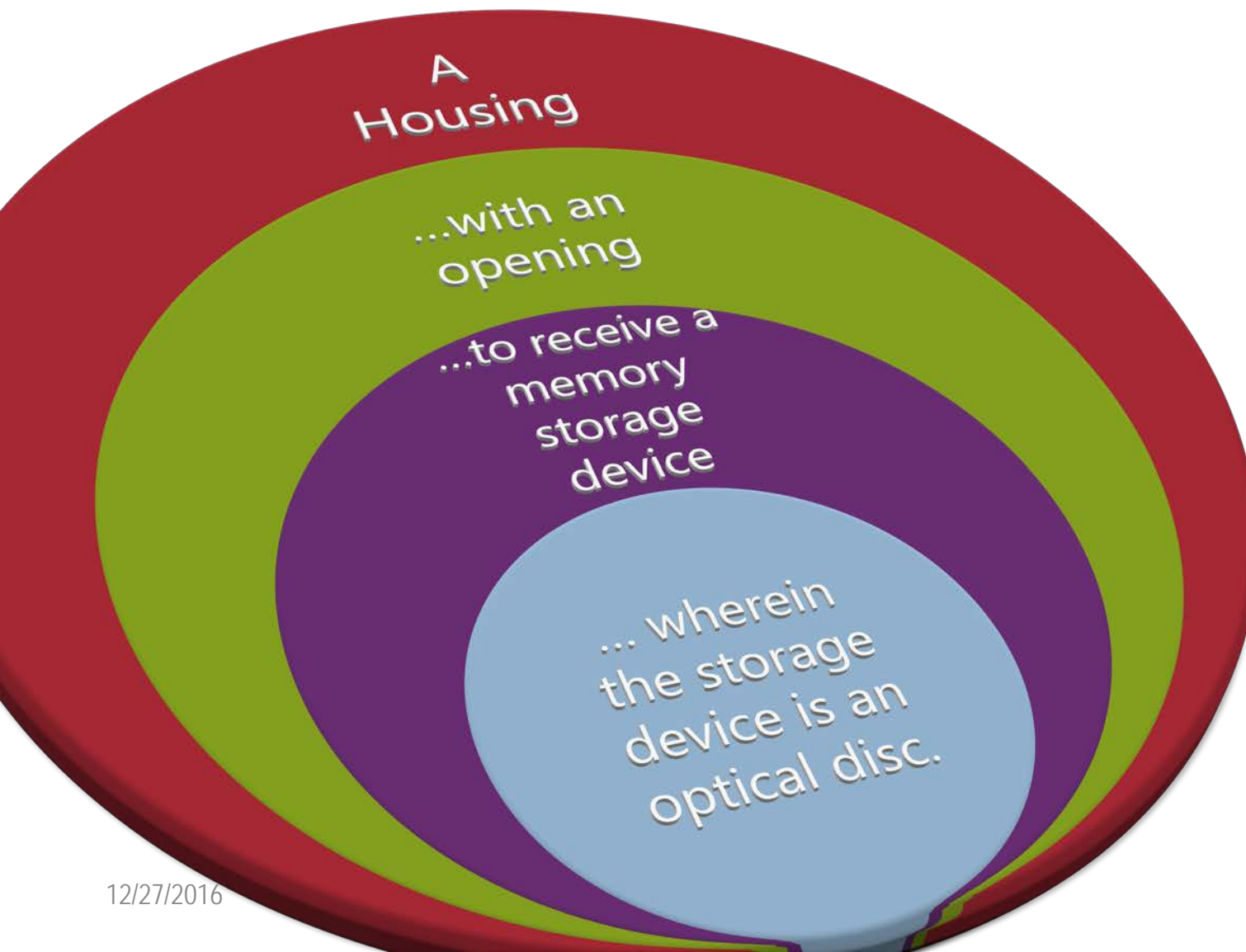
Not valuable

Too Broad/General

Not patentable

uspto

Patent Claim Example



Phone
Laptop
Battery
Suitcase

Phone
Laptop
Suitcase

Phone
Laptop
Suitcase

Laptop
Suitcase?

IP Strategies -

- Patent Claim Drafting Strategies
- Patent Application Filing Strategies
- Licensing Strategies
 - Creating an IP system that works for you
 - You control how your invention is used
 - You control how your rights are transferred
- Defensive vs. Offensive Strategies

When should you file a patent application?

United States is a **First Inventor to File System!**

- Looking for international protection?
 - You'll want to file **before** public disclosure
- Only want US protection?
 - You can file within **one year after** public disclosure



Get patent protection fast!

- File a Provisional application
 - Lock in filing date & preserve foreign filing rights
 - Adds to patent term
- Enter Track One
 - Accelerates examination process (avg. < 1year)
- Get Help!
 - Work on an IP strategy
 - Seek Pro Bono Assistance or the assistance of a registered practitioner
 - Talk to the examiner!



Help for Applicants

RESOURCES AND OPTIONS

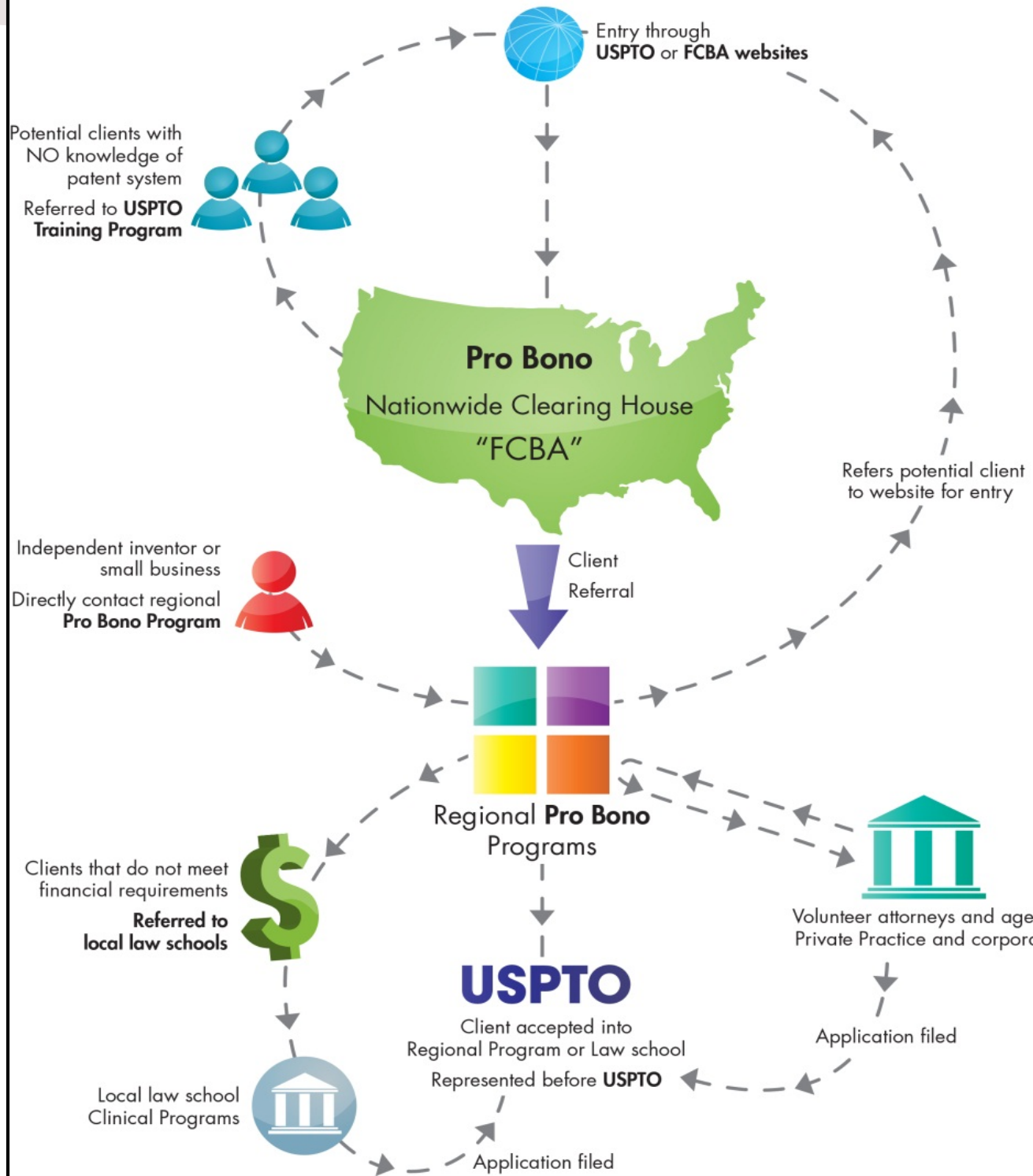


Pro Bono Help

In Alaska: California Lawyers for the Arts

<http://www.calawyersforthearts.org/CIAP>

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



Pro Bono Program vs. Law School Clinics



- Some pro bono law school clinics utilize law students in various ways. This is specific to each regional program.
- A pro bono program's affiliation with a particular law school does not mean that the school participates in the USPTO Law School Clinic Program.

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

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

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.





- Process designed for issues that arise during patent application prosecution; used to get an application “back on track”
- Use on-line ombudsman form at <http://www.uspto.gov/patents/ombudsman.jsp>

“This program brings a voice to the inventor that he normally would not have ... THANK-YOU!!!!!!!!!!”



Need Patent Protection Fast?



Need to FAST track your patent? Use Track One!

Move your ideas quickly with USPTO's Track One



Resources

- Utility Patent Application Guide:
www.uspto.gov/patents/resources/types/utility.jsp
- Patent Process: www.uspto.gov/patents/process/index.js
- USPTO Patent Search Guide: www.uspto.gov/patents/process/search/index.jsp
- IP Awareness Assessment Tool:
<http://www.uspto.gov/inventors/assessment/index.html>
- Inventor resources: www.uspto.gov/inventors/patents.jsp
- Micro Entity Limit: www.uspto.gov/patents/law/micro_entity.jsp
- Pro Bono Program and video on patent process:
www.uspto.gov/inventors/proseprobono
- Law School Clinic Program:
www.uspto.gov/ip/boards/oed/practitioner/agents/law_school_pilot.jsp
- Comprehensive Training Material for First Inventor to File:
www.uspto.gov/aia_implementation/patents.jsp#heading-10



Thank You

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<http://www.youtube.com/user/USPTOvideo/>

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