Empowering Innovation: Introduction to Intellectual Property
Wright State University IP Day

Dr. Christal Sheppard
Director, Elijah J McCoy Midwest Regional USPTO

September 7, 2016
Objectives

• Establishing a Regional Presence: USPTO Regional Offices
• Intellectual Property Awareness
• Introduction to Patents, Trademarks, Copyrights, and Trade Secrets
Meet the Regional Offices: Detroit

Christal Sheppard
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

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

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

- Protect Inventions
- Encourage Inventions
- Promote commercialization and application of invention
- Accelerate the commercialization of invention to the whole society
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”

**Copyrights:**
- Software code
- Instruction manual
- Ringtone

**Patents:**
- Semiconductor circuits
- Touch Screen
- Battery/Power Control
- Antenna
- Speaker
- Device Housing

**Trade secrets:**
- ???

**Designs (some of them patented):**
- Form of overall phone
- Placement of button & speaker
- Color pattern of trim
- Surface finish

© Apple
USPTO Initiatives
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/practitioner/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](https://fedcirbar.org/Pro-Bono-Scholarships/PTO-Pro-Bono/Overview-FAQ)

2. Apply directly to your regional program.
   - See [www.uspto.gov/probonopatents](http://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.
- 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!

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.

http://www.uspto.gov/patent/initiatives/uspto-patent-application-initiatives-timeline
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

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.

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

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

http://www.uspto.gov/patents/law/ipractice/index.jsp
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

- Prior to Examination
- During Examination
- After Close of Prosecution
- After Notice of Appeal
- After Payment of Issue Fee

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)

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.
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

9/16/2016
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  

• 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)  

• 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