

Library

# Start Your Business: Intellectual Property Basics and Patent Applications

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May 20, 2020



# Overview

- Patent and Trademark Resource Center with Azalea Ebbay
- Intellectual property basics with Sudhanshu Pathak
- San Diego Volunteer Lawyer Program, Inc. with Roya Bagheri
- Questions & Answers

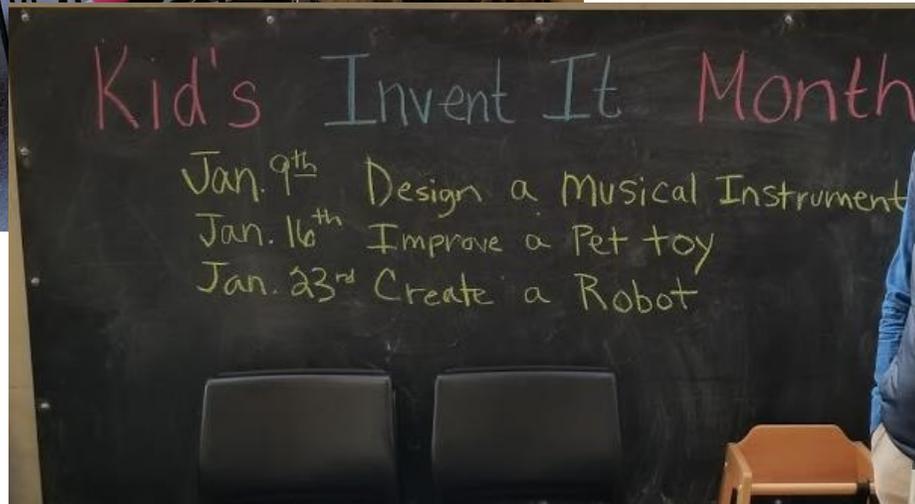
# Patent and Trademark Resource Center

- Provide free access to patent and trademark resources provided by the USPTO
- Direct you to information and explain the application process and fee schedule
- Demonstrate how to use patent and trademark search tools
- Show you a directory of local patent attorneys and agents who are licensed to practice before the USPTO
- Assists with patent searches for an ancestor's inventions
- Offers free educational programs

Note: We cannot provide business or legal advice. We cannot perform patent or trademark searches.



2019 Start Your Business event  
with San Diego Volunteer Lawyer  
Program, Inc. and Procopio



Kid's Invent It Month, a children's themed program



Teaching patents to high school students for UCSD Rady School of Management's LaunchPad program

# Upcoming WebEx Events

All events take place from 2:00-4:00 p.m. PST.



## **May 27th: Trademark Basics**

<https://sandiego.librarymarket.com/events/start-your-business-trademark-basics-webex-event>

## **June 10th: Learn How to Draft a Patent Application**

<https://sandiego.librarymarket.com/events/start-your-business-learn-how-draft-patent-application-webex-event>

## **June 17th: Trademark Application Walk-through**

<https://sandiego.librarymarket.com/events/start-your-business-trademark-application-walk-through-webex-event>

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# **United States Patent and Trademark Office**

## **Office of Innovation Development**

### **Understanding the Basics of Intellectual Property**

Sudhanshu Pathak, Pro Se Assistance Program  
Coordinator

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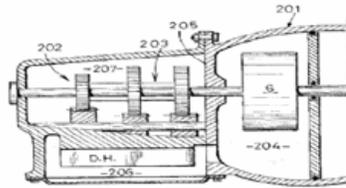
# Objectives

- Overview of intellectual property (IP)
- Process of filing a patent application

# Overview of intellectual property

	Utility/Plant Patent	Design Patent	Trade Secrets	Copyrights	Trademarks
<b>What is protected</b>	Inventions – Process, machine, manufacture, or composition of matter	Ornamental characteristics embodied in, or applied to, an article of manufacture	Commercially valuable information (e.g., formulas, techniques, processes)	Art, in an all-encompassing sense – original works fixed in a tangible medium	Marks in commerce that indicate the source or origin of goods or services
<b>Protects Against...</b>	Making, using, selling, offering for sale, and importing into the U.S.	Making, using, selling, offering for sale, and importing into the U.S.	Stealing or unauthorized disclosure	Copying, performing, displaying, and creating derivative works	Using a mark in a way that causes likelihood of confusion
<b>Endures until...</b>	Generally, from the patent grant date to 20 years from the earliest effective U.S. filing date	15 years from issuance of patent for applications filed on or after May 13, 2015	Publicly disclosed	The life of the author + 70 years for works created on or after 1/1/78	Abandoned or loss of distinctiveness or secondary meaning
<b>Rights of Independent Third Party Creators</b>	None	None	Full	Full	None

Examples



# 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 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

# 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: Registered trademarks



## **Word Mark:**

North Carolina State University

Serial Number 2932440

# 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 IP 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 1800s
- All states have some sort of trade secret protection
- Most laws based on the Uniform Trade Secrets Act
- Defend Trade Secrets Act of 2016
- In 2014 Congress considered, but did not pass, federal versions of the UTSA

# 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: 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

# 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

# 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

# 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

# What happens after I get my patent?

- Licensing
- Enforcement
- More innovation and competition
- Etc...

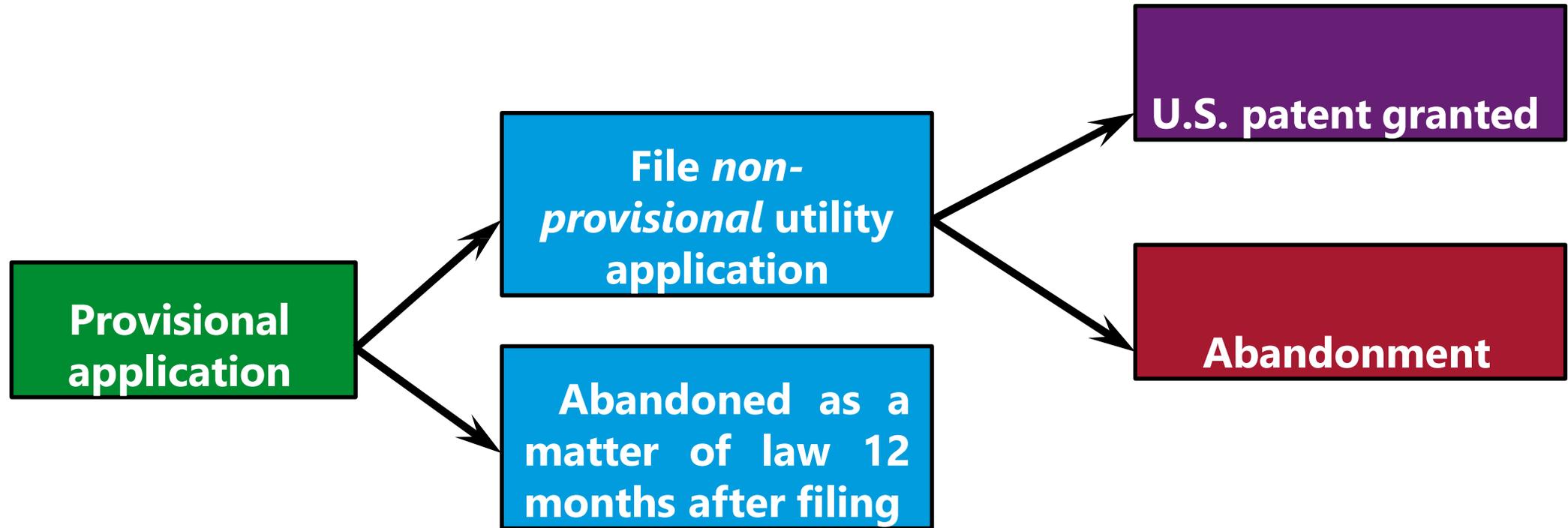
# Pre-filing decisions

- 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)?

# 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 applications



# Provisional utility applications

## Additional benefits of provisional applications:

- 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 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 applications (MPEP 201.04)

- Low-cost submission to establish filing date
  - \$140 small entity
  - \$70 micro entity
- For micro entity status, the following certifications are made:
  - Qualifies as a small entity (less than 500 employees);
  - Has not been named as an inventor on more than four 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 three 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 three times the median household income.

# Provisional utility applications (MPEP 201.04)

- Automatic abandonment after one year
- Inventor given time to investigate market potential / make improvements
  - Be careful - too much change could result in loss of provisional filing date
  - Many inventors file multiple provisional applications during the 12-month pendency of the first filed provisional to include improvements
- Also provide time to obtain counsel if desired
- No patent issues—not examined

# Provisional utility applications

- 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 applications

Use of USPTO cover sheet [PTO/SB/16] encouraged:

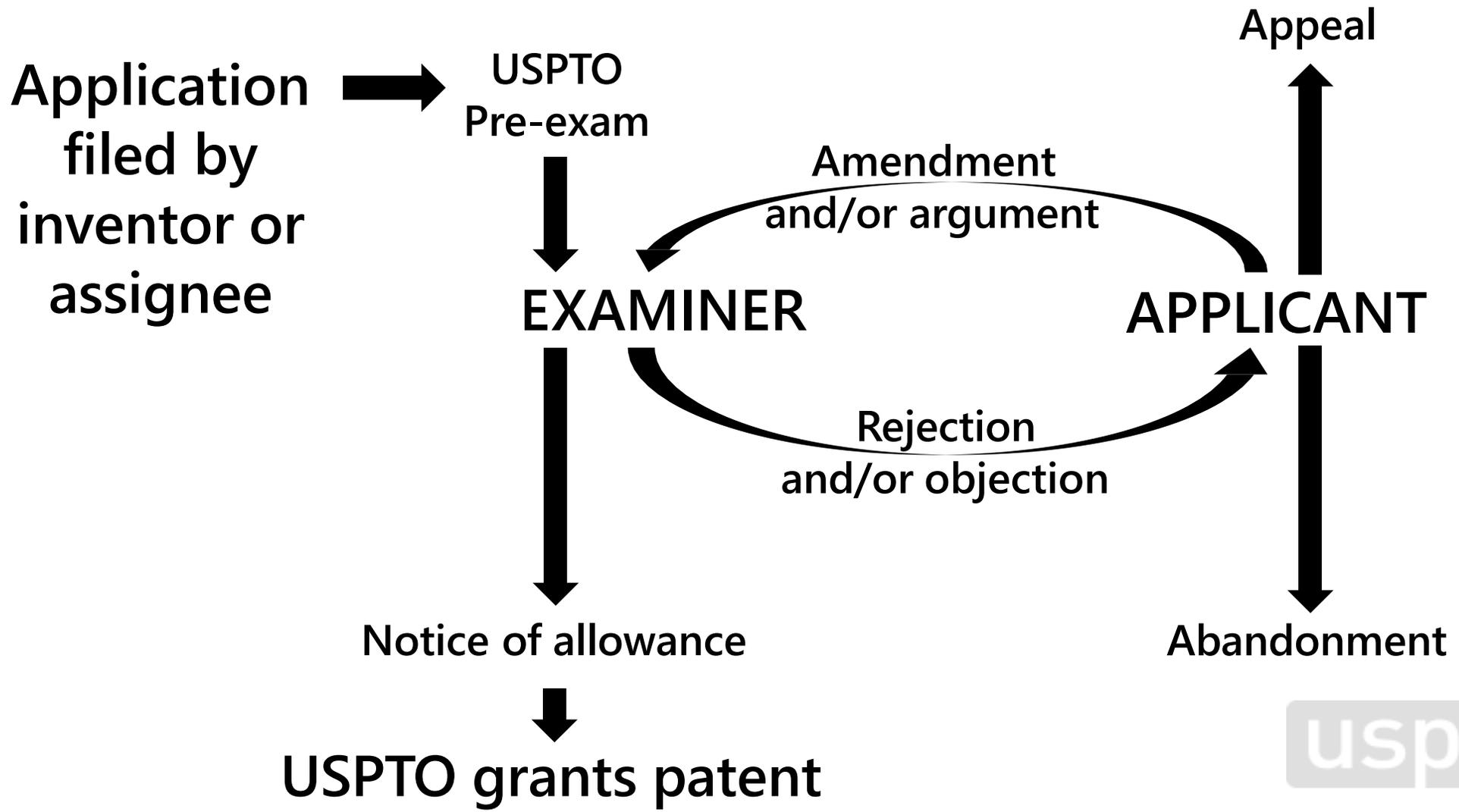
Provides a clear indication that applicant is filing a provisional application

- Inventor name(s)
- Inventor residence(s)
- Title of the invention
- Correspondence address
- Attorney information (if any)
- U.S. government interest (if any)

# Non-Provisional *utility* applications

- Is an application, for a patent, that is examined by the USPTO and may be issued as a patent, if all the requirements for patentability are met.
- Filing Requirements Include:
  - A Specification providing a detailed written description of the invention.
  - Drawings, when necessary, to pictorially describe the invention.
  - Abstract of the Disclosure.
  - Title of the Invention.
  - *Claims*
  - Appropriate Fees.
  - Executed Oath or Declaration.
  - Application Data Sheet (ADS)

# Patent examination process overview



# How to File an application:

A patent application (provisional or non provisional) can be filed via:

- Mail Application related documents via USPS to:
  - Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450
- Hand Delivery to USPTO (only) in Alexandria, Va. Campus:
  - USPTO  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, Virginia 22314
- USPTO's web-based electronic filing system (EFS-Web) for patent application submissions.
  - For More Information about EFS-Web please visit:
    - <https://www.uspto.gov/patents-application-process/applying-online/about-efs-web>
    - <https://www.youtube.com/watch?v=JAaS6Dptx2Y> (video)



# Pertinent Forms:

- *Provisional* Application Cover Sheet:
  - <https://www.uspto.gov/sites/default/files/documents/sb0016.pdf>
- *Non-Provisional* Utility Patent Application Transmittal:
  - <https://www.uspto.gov/sites/default/files/documents/aia0015.pdf>
- *Provisional/Non-Provisional* Fee Transmittal Form:
  - <https://www.uspto.gov/sites/default/files/documents/sb0017.pdf>
- Oath and Declaration Form:
  - <https://www.uspto.gov/sites/default/files/documents/aia0008.pdf> or
  - <https://www.uspto.gov/sites/default/files/documents/aia0001.pdf>
- Application Data Sheet (ADS) Form:
  - <https://www.uspto.gov/sites/default/files/documents/aia0014.pdf>

# Additional information

- Pro Se Assistance (1-on-1 Application Assistance):
  - <https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>
- Filing online:
  - [www.uspto.gov/patents-application-process/file-online](http://www.uspto.gov/patents-application-process/file-online)
- Application status:
  - [www.uspto.gov/patents-application-process/check-filing-status-your-patent-application](http://www.uspto.gov/patents-application-process/check-filing-status-your-patent-application)



# Electronic Business Center (EBC)

Electronic Business Center (EBC) offers in-depth technical support to external users of the USPTO's Patent e-Commerce systems.

The EBC can assist with:

- Submitting your patent application via EFS-Web
- Viewing application information in Public and Private PAIR
- Searching for patents in AppFT and PatFT
- Digital certificate, customer number issues and assistance
- Java and web browser problems
- Technical problems or errors with your patent application
- PDX/DAS registration inquiries and issues
- Technical problems with biotech tools such as PatentIn and Checker

## Hours

Monday – Friday,  
6 a.m. – midnight (ET),  
except federal holidays

## Contact info

- Toll-Free: 866-217-9197
- Local: 571-272-4100
- [ebc@uspto.gov](mailto:ebc@uspto.gov)



**For More Information Contact the  
*Pro Se Assistance Center* at:**

**866-767-3848**

**[innovationdevelopment@uspto.gov](mailto:innovationdevelopment@uspto.gov)**

**<https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>**

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# Thank you!

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[innovationdevelopment@uspto.gov](mailto:innovationdevelopment@uspto.gov)

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*San Diego Volunteer Lawyer Program, Inc.*

# **Microbusiness and Nonprofit Support Program (MNSP)**

**SDVLP**



**SAN DIEGO  
VOLUNTEER LAWYER  
PROGRAM**

*Pursuing justice | Transforming lives*

**uspto**

# Microbusiness and Nonprofit Support Program (MNSP):

Provides free legal services to:  
qualifying entrepreneurs and microbusinesses in San Diego, and  
nonprofit organizations whose primary purpose is to serve  
disadvantaged, low-income San Diegans.

# Microbusiness Support:

Staff and volunteer attorneys provide legal help in a variety of transactional legal areas, including:

- Business Entity Formation (LLCs, Partnerships, Sole Proprietorships, etc.)
- Review and Drafting of Business Contracts
- Lease Agreements
- Intellectual Property (Trademarks, Copyrights and Patents)
- Employment Issues
- Insurance
- Permitting

# Microbusiness Application and Eligibility:

- Application is available on our website: [www.sdvlp.org](http://www.sdvlp.org)
- Individual must be low-income and a resident of San Diego County. We will evaluate an individual's financial situation as well as all business partners.
- In some cases, if you are starting a new business, we will need to see a business plan.

# Microbusiness Support Screening Form



**IMPORTANT:** Due to limited resources, we can only help residents of San Diego County. If you do not live in San Diego County, please do not complete this form. There may be similar assistance available where you live.

**IMPORTANTE:** Debido a los recursos limitados, sólo podemos ayudar a los residentes del Condado de San Diego. Si usted no vive en el Condado de San Diego, favor de no llenar este formulario. Es posible que haya una asistencia similar disponible donde usted vive.

Please do not complete this form if you are seeking help for a nonprofit organization. Please [click here](#) to download the Application for Legal Services for nonprofit organizations.

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## Your information / Su información

First Name / Nombre \*

Middle Name / Segundo Nombre

Last Name(s) / Apellido(s) \*

Maiden Name or Other Name(s) Used / Apellido de Soltera u otros nombres utilizados

How did you hear about SDVLP's legal services? / ¿Cómo se enteró de los servicios legales de SDVLP?

Date of Birth / Fecha de Nacimiento \*

Last 4 digits of your Social Security Number / Últimos cuatro números de seguro social



# MNSP Process:

- If you are deemed eligible for our services, we will discuss your business and issue spot the potential legal issues.
- SDVLP will send you a Legal Services Agreement that details the scope of the representation. After you read over and sign the agreement, you will become an official SDVLP client.
- We will reach out to pro bono attorneys to place your case with a subject matter expert.
- You will work one-on-one with your assigned pro bono attorney.
- SDVLP remains involved throughout the process until the case is fully completed.

# Microbusiness Support:

## Intellectual Property:

### Trademarks:

Assist entrepreneurs with protecting the name and logo of their business.

### Copyrights:

Assist entrepreneurs protect their own original works of authorship, and properly use other copyrighted work.

For example: A catering business using photographs that other people took for their website.

### Patents:

Will assign a patent attorney to assist entrepreneur with entire patent application, including designs, filing, and follow up communication with USPTO.

# COVID-19 Small Business Brief Legal Advice Clinic

Our program just launched a brief legal advice clinic to assist small businesses and nonprofit organizations impacted by the pandemic. Volunteer attorneys will provide remote consultations to eligible businesses on legal issues arising out of the pandemic, including questions relating to:

- Labor and Employment
- Real Estate/Commercial Leases
- Insurance
- Contracts
- Tax Law
- Paycheck Protection Program
- SBA Economic Injury Disaster Loans/Grants
- Small Business Debt Relief Program
- Business Operations (e.g., operating as an essential business)
- Bankruptcy/Restructuring
- Other COVID-19 Related Questions

# COVID-19 Small Business Brief Legal Advice Clinic

Consultations will last up to 45 minutes, and are provided free of charge.

Small Businesses can apply at: [SDVLP.ORG/COVID-19-MNSP](https://sdvlp.org/covid-19-mnsp)

Or Call: (619) 235-5656 ext. 130

# Questions?

Roya Bagheri, Esq.  
Staff Attorney  
rbagheri@sdvlp.org  
(619) 235-5656, ext. 131



Please type your questions in the Q&A chat box.  
**Thank you for attending!**

**Contact Us**

**Azalea Ebbay, San Diego Public Library**

[AEbbay@sandiego.gov](mailto:AEbbay@sandiego.gov)

(619) 238-6683

**Pro Se Assistance Center at the U.S. Patent and Trademark Office**

1 (866) 767-3848

[innovationdevelopment@uspto.gov](mailto:innovationdevelopment@uspto.gov)

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