Tips for Navigating the Patent Process

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Patent Tip 1: Recognize and Understand the Different Forms of IP

- Different types of intellectual property are protected by different means
- Multiple forms of IP protection may be valuable and/or necessary in a business enterprise
- Try: IP Awareness Assessment Tool
Patent Tip 2: If Seeking a Patent, Know What Type of Patent is Right for You

• What is the nature of your invention, or what is it you are trying to protect?
• Keep in mind, oftentimes more than one type of patent may be useful or necessary
Types of Patents/Patent Applications

• 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

• Plant
Whoever invents or discovers and asexually produces any distinct and new variety of plant
Patent Tip 3: Know the Difference Between a Provisional and Non-Provisional Patent Application

- **Provisional** - one year period, no claims required, written disclosure must meet same requirements as non-provisional, not allowed for design.
- **Non-Provisional** - claims required, written disclosure must meet requirements of 35 USC 112 1st paragraph. Examined for patentability, can result in a patent.
Patent Tip 4: Conduct a Thorough Prior Art Search

What Documents are Available to be Searched?
• US Patents and US Published Applications
• Foreign Patent Documents
• Non-Patent Literature (any published documents publicly available other than Patents or Published Patent Applications)
• Internet Searches (Google, Yahoo, etc.)
• Trade Publications and Databases (e.g., IEEE)
“I haven’t seen it at a store or on the Internet.”
What Searching Provides for You

- New ideas
- Improvements to your invention
- History of technological advances
- Trends and developments in field
- To see if any Prior Art related to your invention exists
- Helps determine if you want to file an application

- Familiarize yourself with patent documents & process
- Better prepared to discuss with attorney
- Helps to determine the appropriate claim scope when drafting claims
- Avoid duplicating R&D efforts
- Identify competitors/experts/investors in the field
Patent and Trademark Resources Centers


• Over 80 located nationwide
• Offer training and events
• Search assistance at PTRCs and online training:
  – CBT: How to Conduct a Preliminary U.S. Patent Search
  – Seven step strategy Guide
Patent Tip 5: Recognize and Provide the Proper Parts, Form and Content When Filing a Patent Application

- Study relevant patents in your technological field – use as a guide
- Patent Specification: Use appropriate headings and sections
- Patent Claims
- **Use USPTO forms** available at: http://www.uspto.gov/forms/index.jsp
Patent Tip 6: Timely Pay Correct Fees

• Question: Are you a large, small or micro-entity filer?

• Regularly visit: Current Fee Schedule (as fees may change)

• Surcharges incurred with delays or insufficiencies

• Note: Non-electronic filing fee
“Getting a patent is very/too expensive.”
“My patent cost me, (Insert amount . . . ).”
Micro Entity

Applicant must certify that applicant:

- Qualifies as a small entity
- Previous application limit: Has not been named as an inventor on more than 4 previously filed applications
- Gross income threshold: Did not have a gross income exceeding 3 times the median household income in the preceding calendar year, and
- Assignment: Did not convey a license or other ownership interest in the application to an entity that had a gross income exceeding 3 times the median household income in the preceding calendar year
Patent Tip 7: Respond Thoroughly and Timely to All Communications

• Respond in writing to all objections and rejections set forth by examiner
• Present arguments as appropriate
• Consider requesting an examiner interview
  – Telephonic, in-person
  – Ask for help and/or clarification
“My patent examiner doesn’t understand my invention.”

“My patent examiner won’t grant my patent.”

- View USPTO listing of registered attorneys and agents
- Law School Clinical Programs and pro bono assistance available in some areas
“How do I find a patent attorney or agent?”
“Do I need a patent attorney or agent?”
Pro Bono Requirements

- Determined by regional programs
- Income < 300% of federal poverty level
  - Depends on location and household size
- Knowledge of the patent system
  - Pending application
  - Completion of Certificate Training Course
- Possession of an actual invention
  - Not just an idea
Certificate Training Course

Basic Patent Training
For
Independent Inventors and Small Businesses

A full transcript can be found under the “Notes” tab

http://www.uspto.gov/ac-cbt/certificationpackage/
Pro Bono

Patent Pro Bono Program

The Program provides free legal assistance to under-resourced inventors interested in securing patent protection for their inventions.

Inventors  Attorneys  News & Events
Pro Se Assistance

- The Pro Se Assistance Program offers various services for the public, including:
- Dedicated personnel for assisting people filing applications without the assistance of an attorney
- Walk-in assistance for the general public at USPTO Headquarters (by appointment)
Pro Se Assistance (cont’d)

• A fully equipped public computer workstation for walk-in visitors at the USPTO
• Targeted support to connect applicants with relevant resources and information
• Online resources found at uspto.gov
• 1(800)786-9199
Pro Se Checklist


Application Checklist

A patent application is a collection of documents that conform to U.S. laws, rules, and guidelines outlined in the Manual of Patent Examining Procedure. The specific list of documents and forms depends on a number of factors, including the type of patent application, the protection sought, and the invention itself. The Pro Se Assistance Program makes this checklist of documents and forms available for your use in preparing your application. While not comprehensive, it contains the most commonly required elements to form a nonprovisional utility patent application.

Nonprovisional Utility Patent Application Checklist

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Patent Tip 9: Avoid Getting Scammed

- Always check the reputation of invention promoters/promotions firms before making any commitments
  - View published complaints
  - Request required information disclosures
- Be cautious of non-USPTO solicitations
Patent Tip 10: For Resources and Tools
Visit USPTO on the Web

www.USPTO.gov
Overview of Website

Click on “Learning and Resources”
Inventors, Entrepreneurs, Startups

- Wide variety of resources

Inventors & Entrepreneurs Resources

- Patents for Inventors
- Trademarks for Inventors & Entrepreneurs
- Scam Prevention
- Pro Se - Pro Bono
- Current Events
- State Resources
- Education & Information

- Patents
- Trademark Basics
- Trademark Examining Policy
- Trademark Status and Document Retrieval (TSDR)
- Trademark Applications (TAS)
- Trademark Manual of Examining Procedure (TMEP)
- Guide to Filing A Design Patent Application
- Basic Facts About Trademarks

- Patents
- Trademarks
- Inventions Assistance Center
- Trademarks Ombudsman Program
- Business
- Trademark Assistance Center
State Resources
• Listing of attorneys & agents
• PTRCs
• Law School Clinical Programs
• Pro Bono Programs
• Inventor Organizations
• Attorney General
“It takes too long to get a patent.”

“Why does it take so long?”
May 2016 Patents Data, at a Glance

In response to public comment, we have redesigned the Patents Data Visualization Center. We hope you find the Dashboard useful. If you have any questions, comments, or feedback, please click here to send an e-mail to the Dashboard administrator.

The Patent Composite was discontinued at the end of Fiscal Year 2015 and new quality metrics are currently being baselined. For additional information regarding the Enhanced Patent Quality Initiative, please click here.
Application Information

Check the Status of Your Application

Public PAIR
For documents and status on publicly available patents and applications
Check the status of a published application

Private PAIR
Securely access information on your pending patent application
Check the status of a pending application

Key Resources
FAQs
Quickstart Guides
PAIR Usage Policy
First Office Action Estimator

“My U.S. patent protects me around the world.”
International Patent Filing

The establishment of the Office of International Patent Cooperation reflects the USPTO’s commitment to the IP community in improving the international patent system,” said Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the USPTO Michelle Lee. “It will allow us to increase certainty of IP rights while reducing costs for our stakeholders and moving towards a harmonized patent system.

The USPTO's Office of International Patent Cooperation efforts will improve the quality, efficiency, and predictability of the patent family prosecution-increasing the certainty of global patent rights.
“Can I renew/extend my patent?”
Maintenance Fee Portal

• Checking the Maintenance Status of Your Patents
  – Bibliographic data and the fee amounts due for a specific patent are available through the Office of Finance Online Shopping Page.
  – This information is also available through our Maintenance Fee Branch. To contact the Maintenance Fee Branch, call 571-272-6500.
Features of the Website

- Apply Online for a Patent using EFS-Web
- Obtain Status of a Patent Application
- Determine when application will be picked up for examination, see First Office Action Estimator
- Search US Patent Database
- Search Patent Classification Manual
- Download Forms and Fee Schedules
- Patent Help Resources
- Access Details of All Currently Pending Published Patent Applications (Public PAIR)
- IP Awareness Assessment Tool
Resources

- Utility Patent Application Guide:  
  www.uspto.gov/patents/resources/types/utility.jsp


- IP Awareness Assessment Tool:  

- 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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