

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**

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# IEEE – Consultants' Network of Silicon Valley

## *The USPTO and Establishing a Regional Presence*

Palo Alto, California  
May 11, 2015

**John Cabeca**

*Director of the Silicon Valley United States  
Patent and Trademark Office*

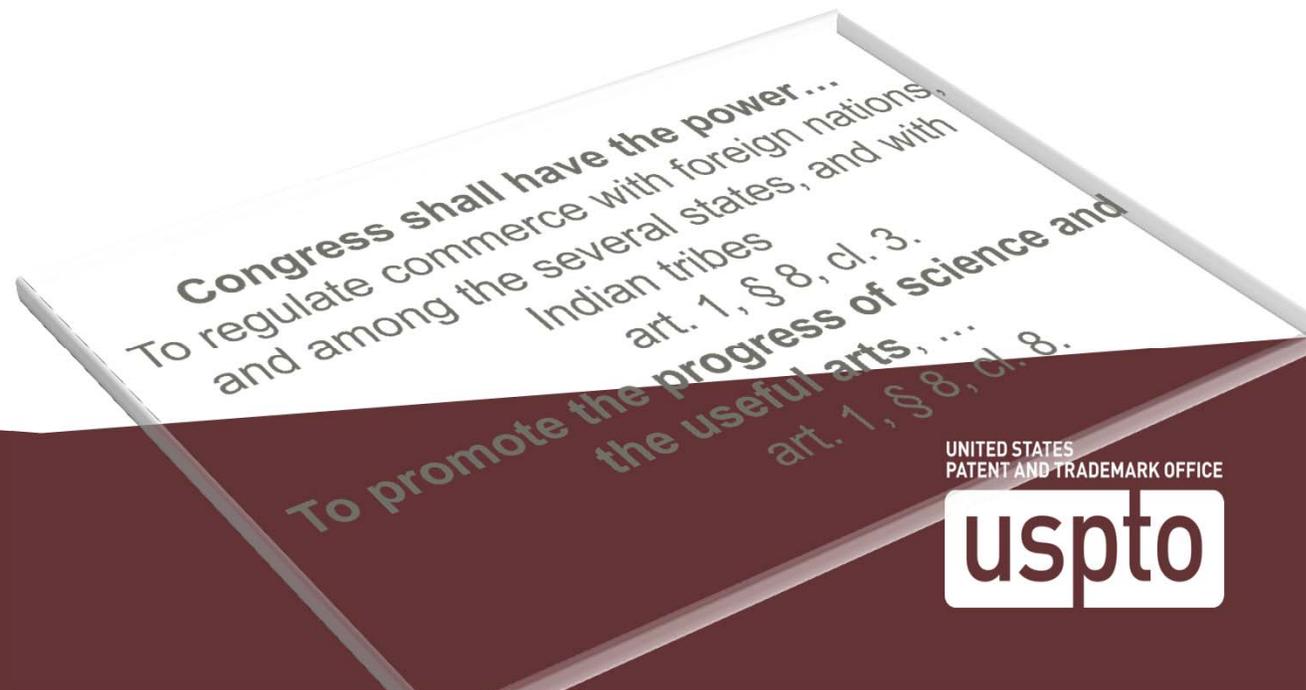
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# Outline

- Types of Intellectual Property
- The Patent Process
- Patent Examination & Training
- Sharing Your Expertise with Examiners
- Establishing a Regional Presence and working with the local tech community
- Resources for Applicants

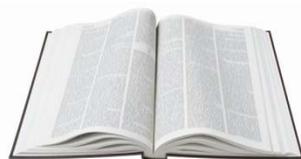
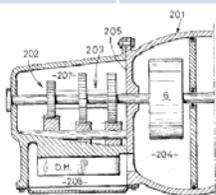
# Types of Intellectual Property



# 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	14 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 for some works, 95 years from first publication)
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

5/11/2015



# Can you find the IP in a mobile phone?

## Trademarks:

- Made by "Nokia"
- Product "N95"
- Software "Symbian", "Java"

## 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**



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# 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

# 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

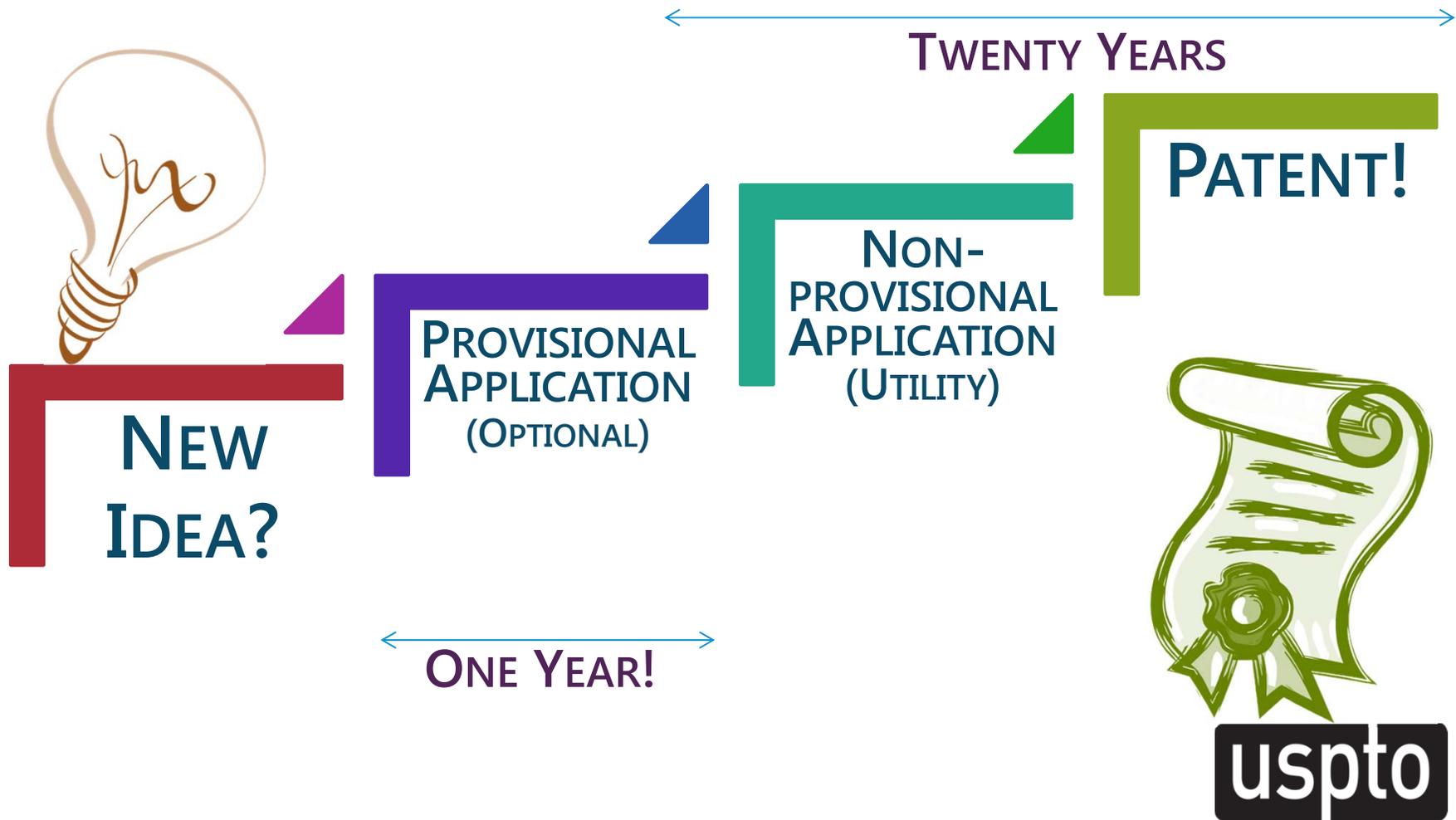


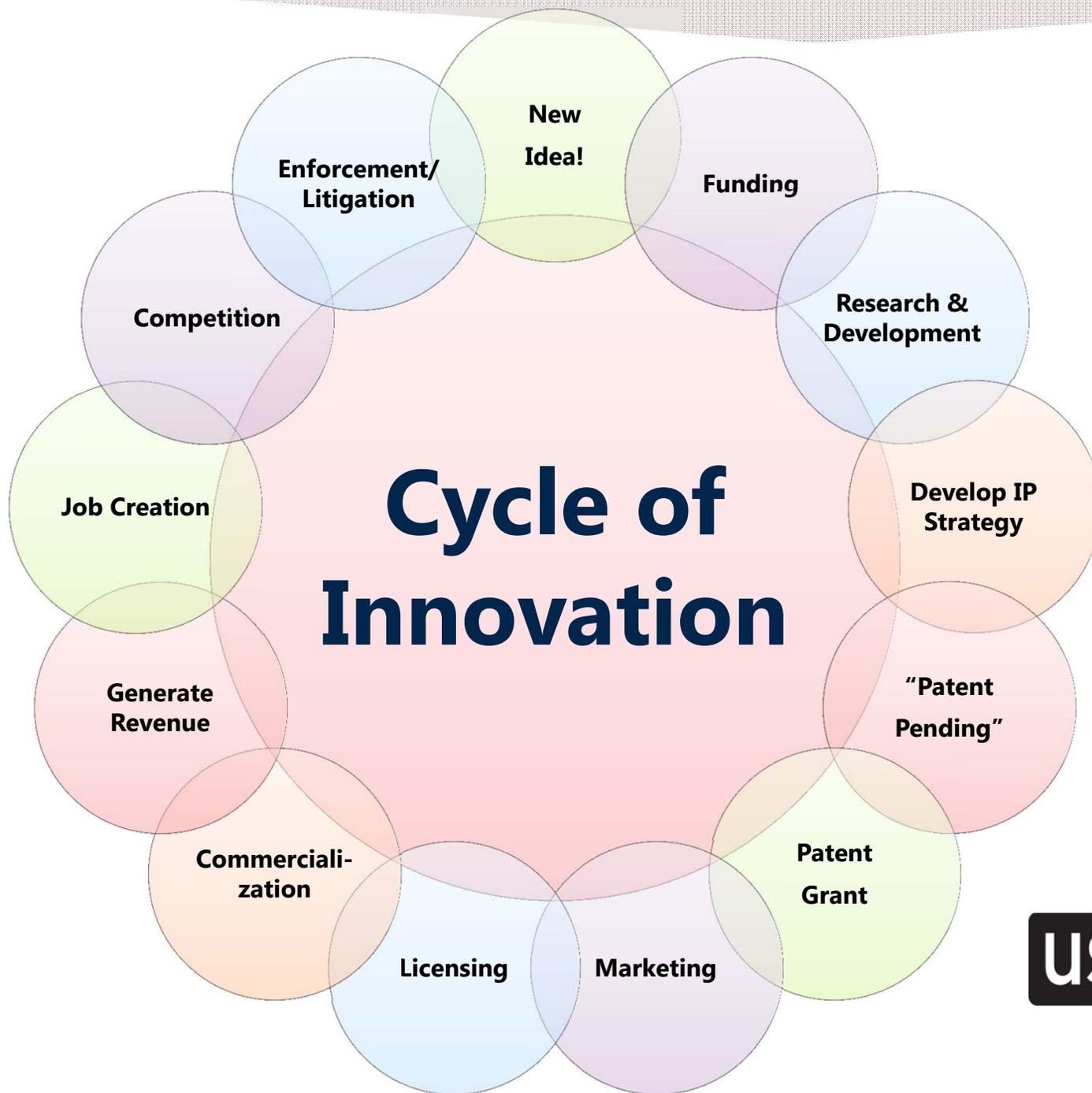
# IP Strategy IS a Business Strategy

- Attractive to investors and buyers
- Deter patent infringement lawsuits
- Can increase leveraging power
  - i.e. mergers and acquisitions
- Patents are a form of property than can add value to a company's assets



# The Path to a Patent





# Who May Apply For A U.S. Patent ?



Anyone...from anywhere may apply, with only one exception\*

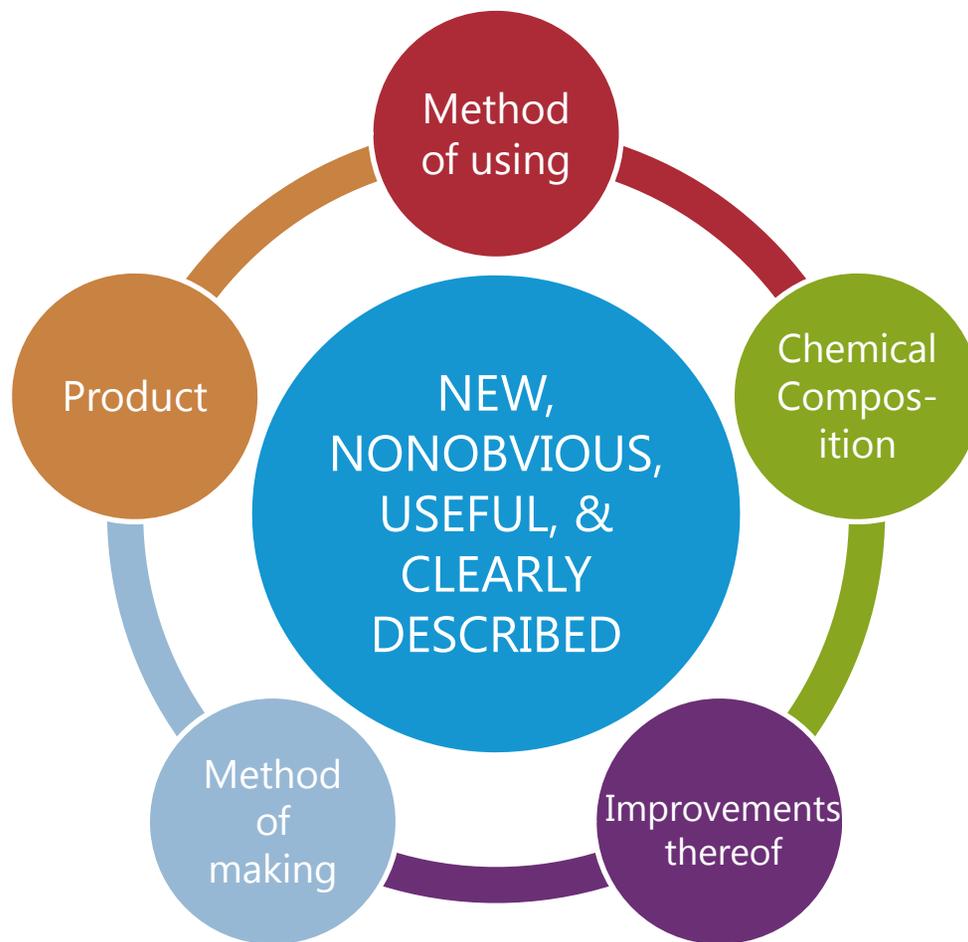
- Application must name at least one inventor.

# Who May Not Apply ?

Officers and employees of the  
U.S. Patent & Trademark Office

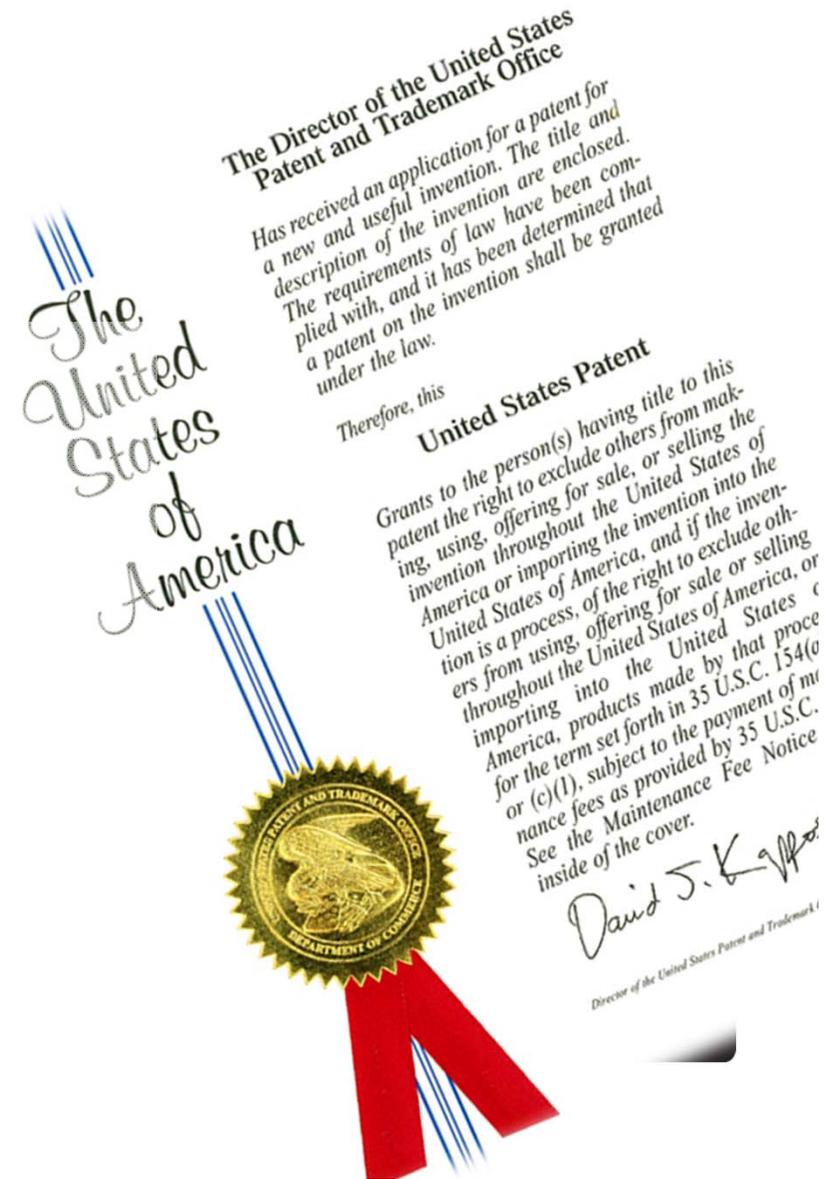


# What is patentable?



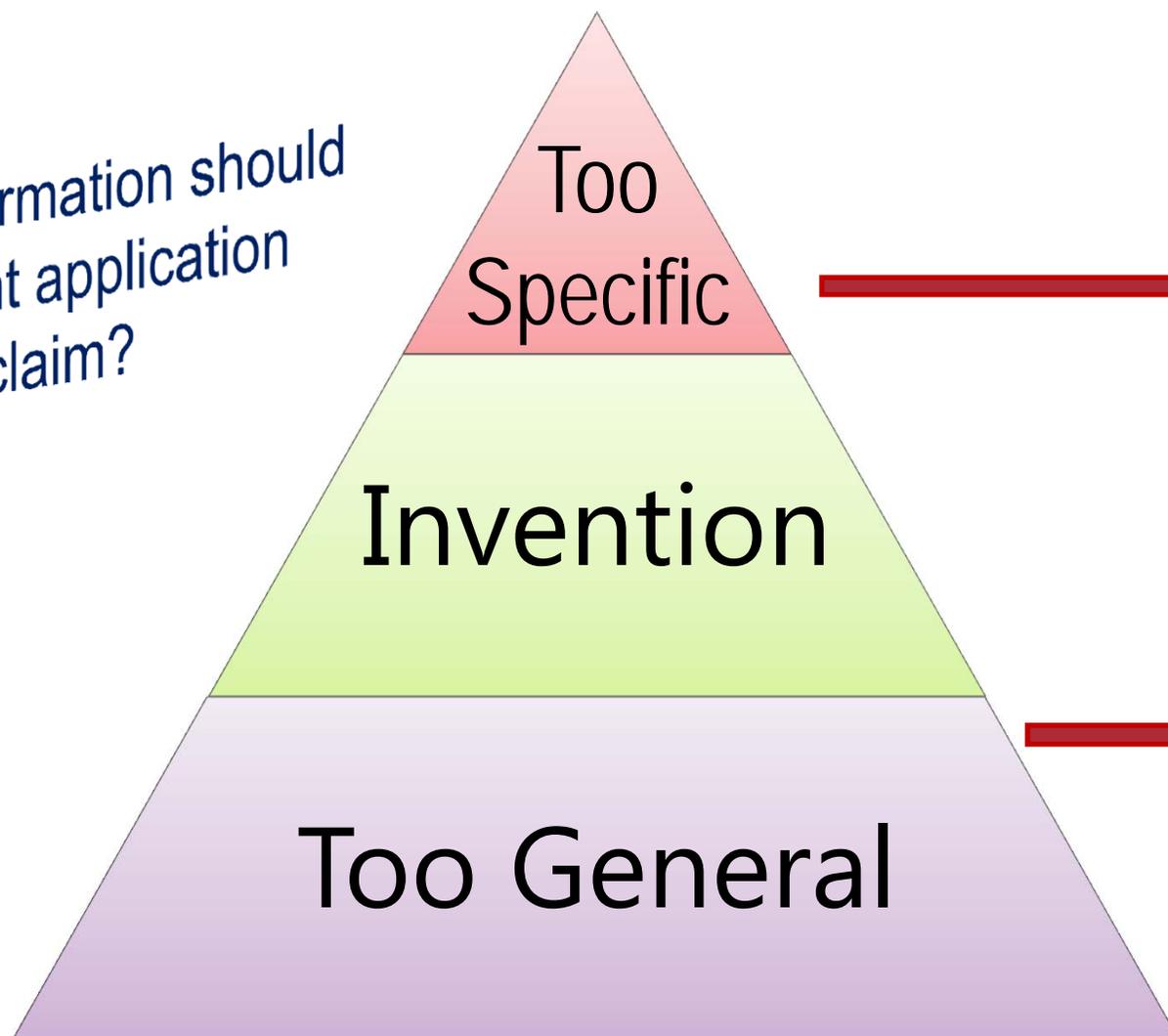
# Patent “Claims”

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



# Patent Scope

What information should  
a patent application  
claim?

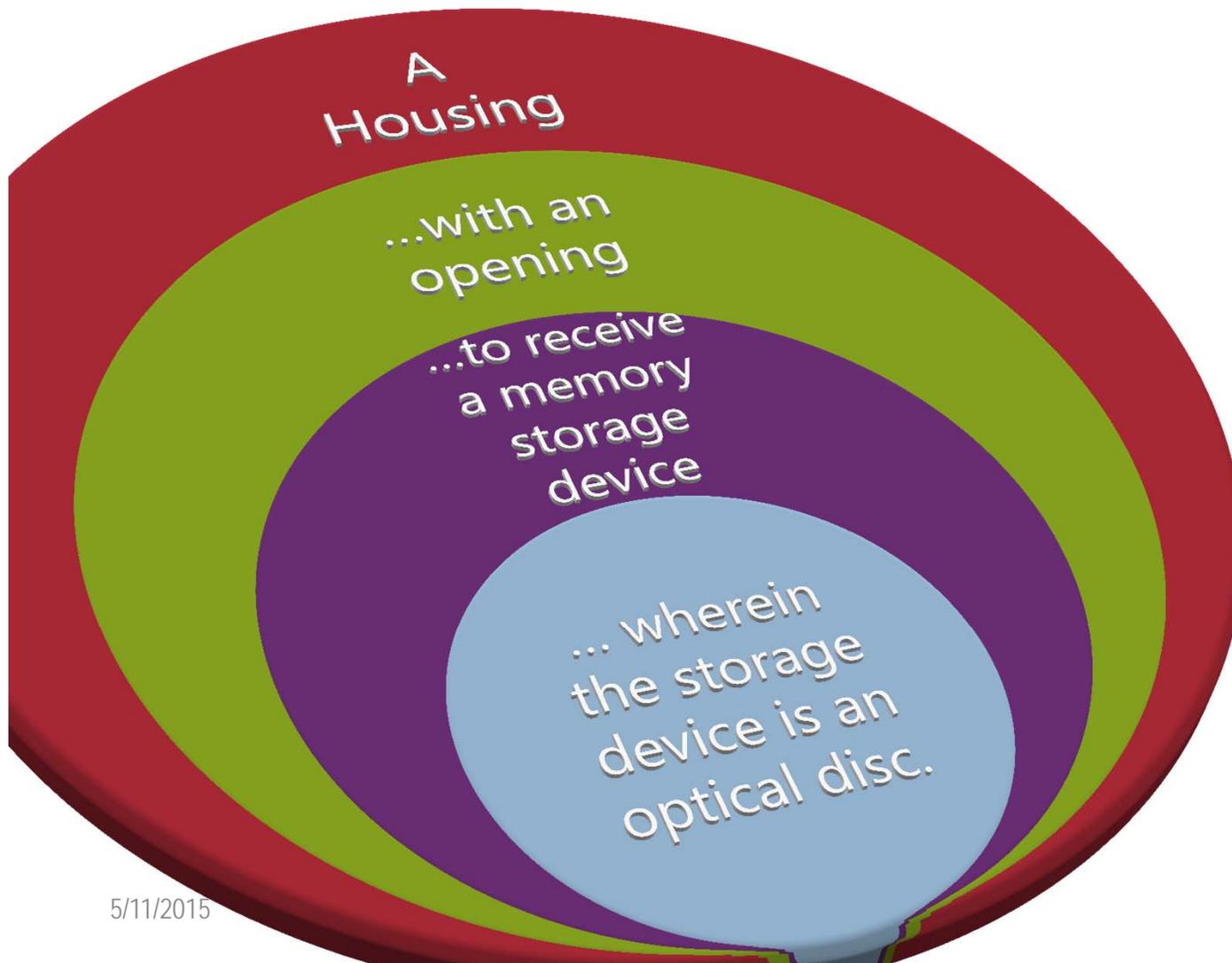


Not valuable

Not patentable

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# Patent Claim Example



Phone  
Laptop  
Battery  
Suitcase

Phone  
Laptop  
Suitcase

Phone  
Laptop  
Suitcase

Laptop  
Suitcase?



*Patent Operations*

# **PATENT EXAMINATION & TRAINING**



# Patent Examination

- ◆ Read and understand specification
- ◆ Determine whether spec is adequate
- ◆ Determine scope of the claim
- ◆ Search existing technology for claimed invention
- ◆ Determine patentability
- ◆ Write/mail a legal office action on the patentability
- ◆ Respond to applicants response
- ◆ Issue patent or abandonment



# Engineers & Patents



## Awareness of the law

- How and when to apply
- Infringement issues
- Defensive posture
- First to File (AIA Rules)
- IP Strategy **IS**  
a Business Strategy

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# Patent Examiner Requirements



- ◆ U.S. citizenship required
  - ◆ Relocate to Washington DC/ or Satellite Office locations
- ◆ Technical degree (BS or higher)

# Patent Examiner Skill Set



- ◆ Good engineering common sense
- ◆ Practical not theoretical
- ◆ Ability to make independent decisions
- ◆ Enjoys structured goals/productivity
- ◆ Enjoys expressing/articulating decisions
- ◆ Memory for details
- ◆ Enjoys environment of learning

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# Year After Year, USPTO is Voted as



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# Benefits of being a Patent Examiner

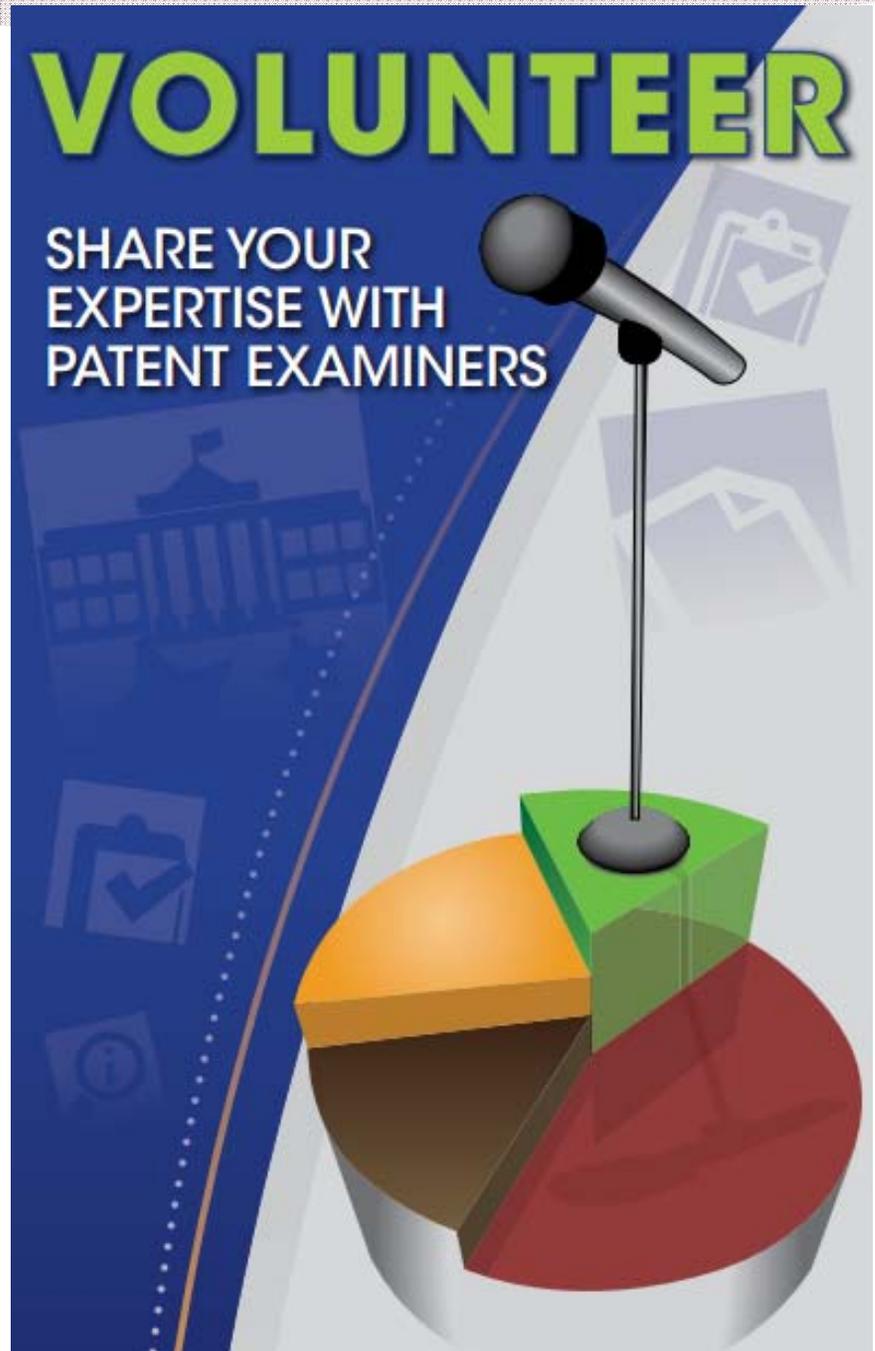
- ◆ Patent Training Academy/in-house technical/legal trainings
- ◆ Flexible work schedules
- ◆ Promotion potential freedom
- ◆ Performance awards
- ◆ Telework opportunities (time and grade requirements)
- ◆ Overtime/bonuses
- ◆ Continuously growing organization
- ◆ Pride in individual accomplishments

## Examination Guidance and Training Materials

35 U.S.C. 101	
Subject matter eligibility	<ul style="list-style-type: none"> <li>● <a href="#">2014 Interim Guidance On Patent Subject Matter Eligibility</a> (December 2014) <b>new</b> <ul style="list-style-type: none"> <li>● <a href="#">2014 Interim Eligibility Guidance Quick Reference Sheet</a> (December 2014) [PDF]</li> <li>● <a href="#">Nature-Based Product Examples</a> (December 2014) [PDF]</li> <li>● <a href="#">Abstract Idea Examples</a> (January 2015) [PDF]</li> <li>● <a href="#">Feedback</a></li> </ul> </li> <li>● <a href="#">Preliminary Examination Instructions in view of the Supreme Court Decision in <i>Alice Corporation Pty. Ltd. v. CLS Bank International, et al.</i></a> (June 2014) [PDF]</li> <li>● <a href="#">2014 Procedure For Subject Matter Eligibility Analysis Of Claims Reciting Or Involving Laws Of Nature/Natural Principles, Natural Phenomena, And/Or Natural Products</a> (March 2014) <ul style="list-style-type: none"> <li>● <a href="#">Eligibility Guidance Quick Reference Sheet</a> (March 2014)</li> <li>● <a href="#">Training Slides</a> (March 2014)</li> <li>● <a href="#">Feedback</a></li> </ul> </li> <li>● <a href="#">Evaluating Subject Matter Eligibility Under 35 U.S.C. 101: August 2012 Update</a> <ul style="list-style-type: none"> <li>● <a href="#">Slides</a></li> <li>● <a href="#">Computer Based Training (CBT)</a></li> </ul> </li> <li>● <a href="#">Flowchart - Subject Matter Eligibility Analysis for Claims to Laws of Nature/Natural Principles</a> (August 2012)</li> <li>● <a href="#">2012 Interim Procedure for Subject Matter Eligibility Analysis of Process Claims Involving Laws of Nature</a></li> <li>● <a href="#">Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of <i>Bilski v. Kappos</i></a> (through 2010 update)</li> <li>● <a href="#">Subject Matter Eligibility of Computer Readable Media</a> (2010)</li> <li>● <a href="#">Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101</a> (August 2009)</li> </ul>
America Invents Act	
First Inventor To File (FITF)	<ul style="list-style-type: none"> <li>● <a href="#">First-Inventor-to-File Training Plan for USPTO Examiners</a> [PDF]</li> <li>● <a href="#">First-Inventor-to-File Statutory Framework Chart</a> [PDF]</li> <li>● <a href="#">Overview CBT</a> (March 2013) (46 min) <a href="#">Video</a>   <a href="#">Slides</a> [PDF]</li> <li>● <a href="#">Overview Follow-On Video</a> (March 2013) (27 min) <a href="#">Video</a>   <a href="#">Slides</a> [PDF]</li> </ul>

# Patent Examiner Technical Training Program (PETTP)

- The USPTO requests voluntary assistance from Scientists, Engineers, Professors, and Industrial Designers to participate as guest lecturers.
- Volunteer your time and expertise as a guest lecturer to ensure patent examiners keep pace with state of the art developments.
- Flexible Presentation Formats



# SEE Program Information

- Help Us Improve the Quality of the Patent Examination Process
- Your Chance to Interact Directly with Patent Examiners
- Showcase Your Real-World Technologies
- An Opportunity to Conduct On-Site Training



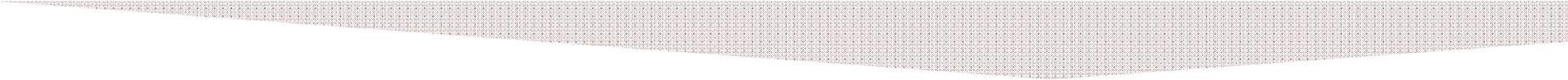
*Want to*

Find Out

*more?*

[www.uspto.gov](http://www.uspto.gov)

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Establishing A Regional Presence

# **THE SILICON VALLEY OFFICE**



# America Invents Act



President Barack Obama signs the America Invents Act September 16, 2011, Thomas Jefferson High School for Science and Technology in Alexandria, VA

# USPTO Offices



## Detroit

- Operational since July 2012

## Denver

- Byron G. Rogers Federal Building
- Operational July 2014

## Silicon Valley

- San Jose City Hall Building
- Planned to be operational in 2015

## Dallas

- Terminal Annex Federal Building
- Planned to be operational 2015



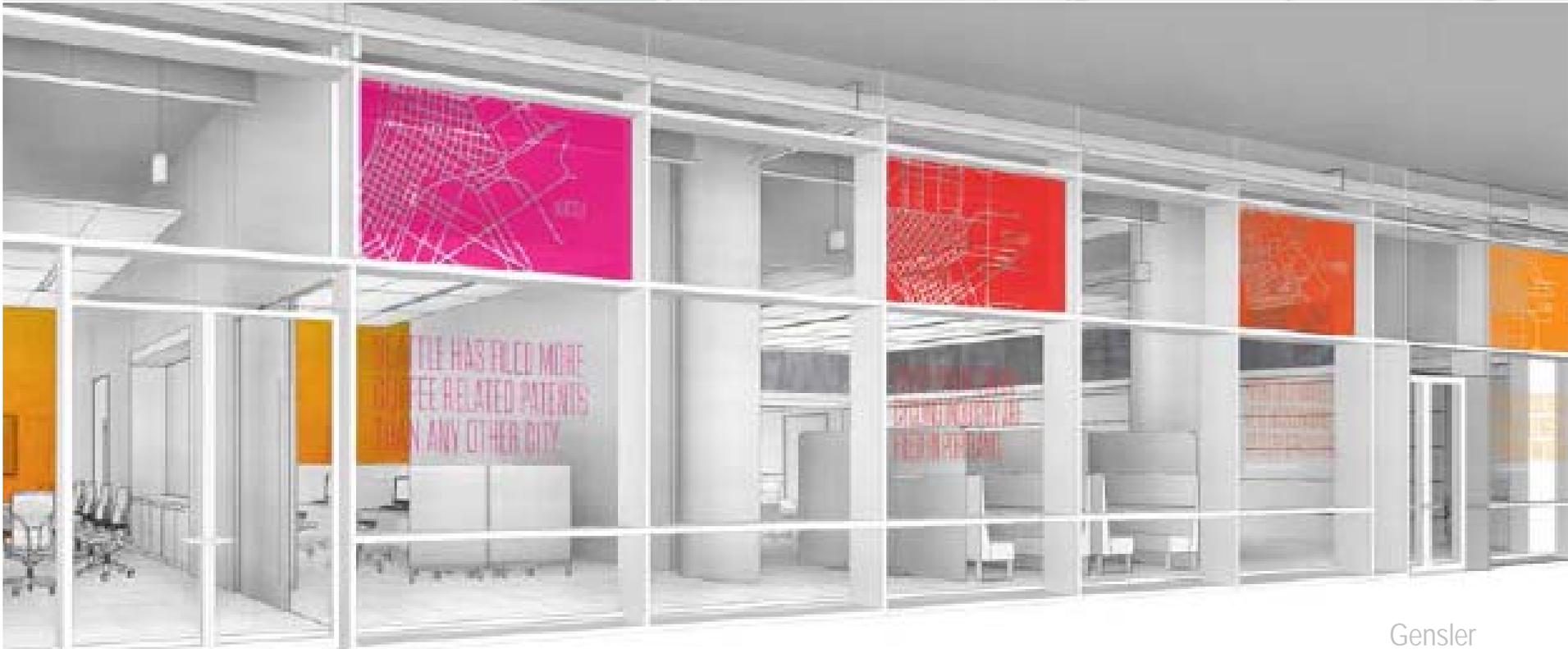
# Satellite Office Program



# Silicon Valley U.S. Patent and Trademark Office Wing of San Jose City Hall



First Floor Public  
Outreach Facility



# Outreach services will provide:

- **Walk-in services** to obtain information about the USPTO
- **Workstations for searching** patents and trademarks
- **A regional focus** for workshops, just-in-time training, conferences and roundtables (at all levels)
- **A hearing room** to host Patent Trial and Appeal Board (PTAB) and Trademark Trial and Appeal Board (TTAB) proceedings – including remote access to hearings taking place in Alexandria or elsewhere
- **Interview rooms** to connect applicants to patent examiners working in Alexandria and across the country
- **Remote Training Capability** from local experts to all patent examiners working in their specialized technical fields
- **Office hours** for strategic partners like Small Business Development Centers and the Export Assistance Center



# Regional Focus for Workshops

- For All Levels – From K-12 to IP professionals
- From basic facts to updates on law and procedure
- Stakeholder roundtables
- Inventor conferences
- Focus on startups
- Tech Specific Partnership Meetings
  - Software
  - BioTech
  - CyberTech
- International programs
- 1 on 1 assistance, both in-person and virtually
- Just-in-time programming (e.g. FITF, Paralegal Workshops, etc.)
- Co-host programs with strategic community partners

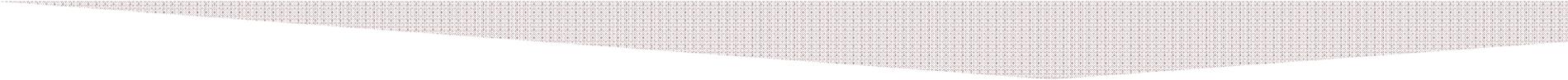


# Working with Startups

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?**





Help for Applicants

# **RESOURCES AND OPTIONS**

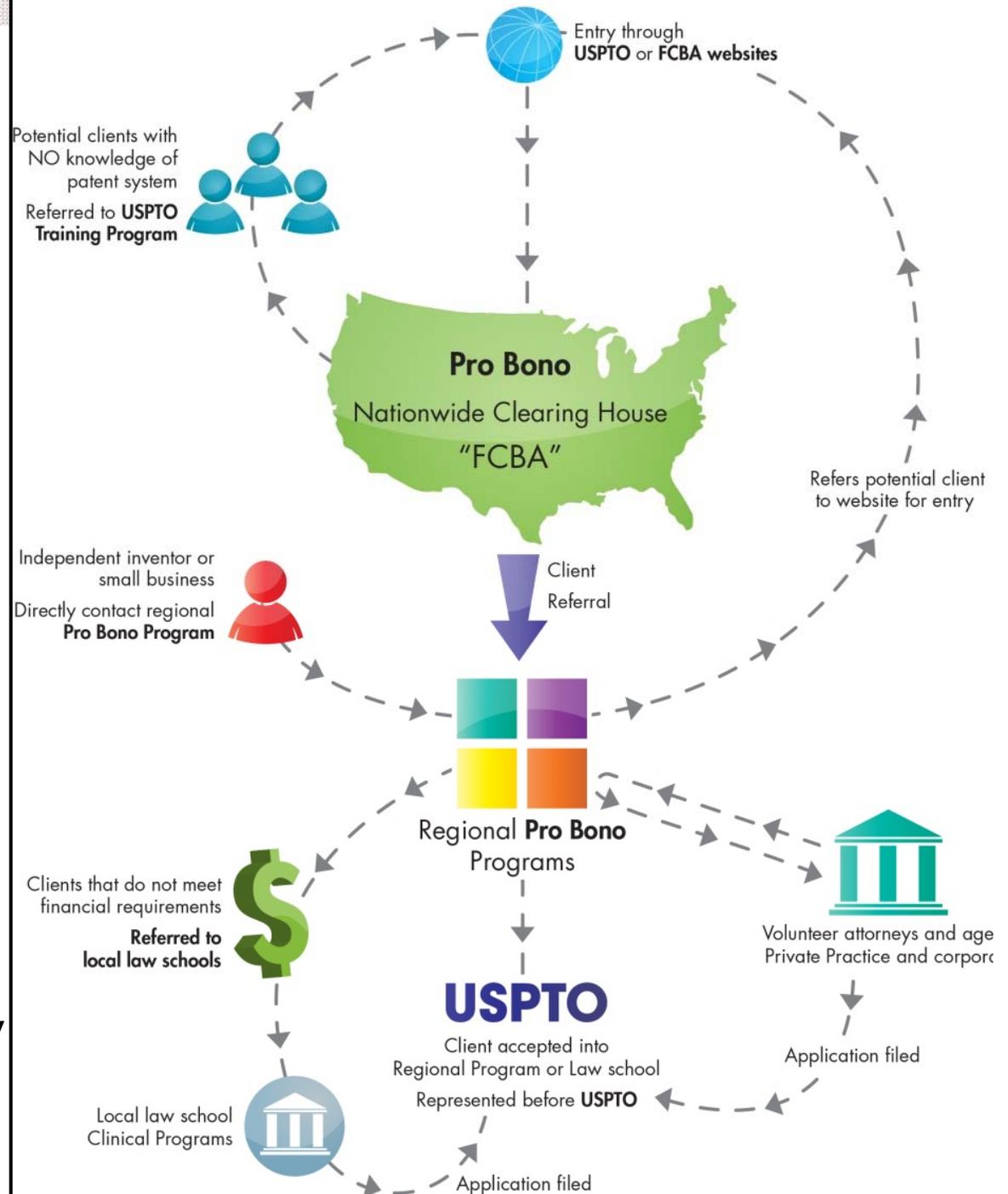


# Pro Bono Help

In California: California  
Lawyers for the Arts

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

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



# Law School Clinics

The USPTO's Law School Clinic Certification 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.

- California schools participating in the USPTO's law school clinic program:
  - California Western School of Law
  - Lincoln Law School
  - Thomas Jefferson School of Law
  - University of California
  - Los Angeles School of Law
  - University of San Francisco School of Law



## 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**

<http://www.uspto.gov/inventors/assessment>

# trackone

P R I O R I T I Z E D   E X A M I N A T I O N

**Need to FAST track your patent? Use Track One!**

Move your ideas quickly with USPTO's Track One



# 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!!!!!!”



# Resources

- Utility Patent Application Guide:  
[www.uspto.gov/patents/resources/types/utility.jsp](http://www.uspto.gov/patents/resources/types/utility.jsp)
- Patent Process: [www.uspto.gov/patents/process/index.js](http://www.uspto.gov/patents/process/index.js)
- USPTO Patent Search Guide: [www.uspto.gov/patents/process/search/index.jsp](http://www.uspto.gov/patents/process/search/index.jsp)
- Inventor resources: [www.uspto.gov/inventors/patents.jsp](http://www.uspto.gov/inventors/patents.jsp)
- Micro Entity Limit: [www.uspto.gov/patents/law/micro\\_entity.jsp](http://www.uspto.gov/patents/law/micro_entity.jsp)
- Pro Bono Program and video on patent process:  
[www.uspto.gov/inventors/proseprobono](http://www.uspto.gov/inventors/proseprobono)
- Law school clinic pilot:  
[www.uspto.gov/ip/boards/oed/practitioner/agents/law\\_school\\_pilot.jsp](http://www.uspto.gov/ip/boards/oed/practitioner/agents/law_school_pilot.jsp)
- Comprehensive Information and Training Material for First Inventor to File:  
[www.uspto.gov/aia\\_implementation/patents.jsp#heading-10](http://www.uspto.gov/aia_implementation/patents.jsp#heading-10)



# Thank You

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**SiliconValley@uspto.gov**

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