

## U.S. Patent Process – From Start to Finish

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## U.S. Patent Process – From Start to Finish

*Presented by:*

Tim Van Dyke, Beusse Wolter Sanks Mora & Maire PA

June 6, 2013

# Questions?

We will be taking questions during a designated question and answer period at the conclusion of the presentation. Please hold all questions until this designated period.

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**Tim Van Dyke**  
*Registered Patent Attorney*  
Beusse Wolter Sanks Mora & Maire PA

## US PATENTING PROCESS EXPLAINED FROM START TO FINISH

Title here

Intellectual property (IP) =  
creations of the mind

- Inventions
- Literary and artistic works and symbols
- Names
- Images
- Designs used in commerce



## FOUR MAJOR TYPES OF IP PROTECTION

- PATENT
- COPYRIGHT
- TRADEMARK
- TRADE SECRET

## Copyright

- Protects certain works that are:
- Original
- Sufficiently creative
- “Fixed in a tangible medium of expression”
- Copyright protects expression of ideas, not the ideas themselves

## Trademark

- Any word, name, symbol, or device...used to identify and distinguish the goods (or services) of one seller from goods (or services) manufactured (provided) or sold by others, and to indicate the source of the goods (or services).”

## Trade Secret

- A formula, pattern, physical device, idea, process or compilation of information that:
  - provides the owner with a competitive advantage in the marketplace, and
  - is treated by the owner in a way that can reasonably be expected to prevent the public or competitors from learning about it

## Patents

- A US patent grants you:
  - “the right to exclude others from making, using, offering for sale, or selling” your invention in the US or importing your invention into the US

## Types of US Patent Applications

- Provisional
- Regular Utility (nonprovisional)
- Continuations and Divisionals
  - Daughter Applications to parent nonprovisional

## Legal Requirements for a Patent

- Invention must pertain to patent eligible subject matter
- Invention must be novel
- Invention must be nonobvious
- Novelty and Nonobviousness judged in view of prior art

## Disclosure Requirements for a Patent

- Enablement
- Written Description

## Prior art

- Prior art is any disclosure that was publicly available before the filing of an application that is related to the invention
  - Written (Scientific Journal Articles, Abstracts, Posters, Web sites (even if material is later removed), Published or issued patents, Sales Literature, etc.
  - Inventor's own publication
  - Publications of others Oral (Any oral disclosure not made under an NDA)
  - Public Use
  - Offer for Sale/Sale

## Loss of Patent Rights

- There is a bar to obtaining a patent if the invention:
  - Was patented or described in the prior art before the filing of an application
  - 1 year grace period (for cases having an effective filing date before March 15, 2013)

## Prefiling Considerations

- Patentability searches
  - A search of prior art to determine patentability or scope of protection
- Licensing or commercialization potential
  - Vibrant Market?
  - Scope of Protection?
  - Licensing Partners?
  - Inventor Connections?

## Parts of a Patent

- Two main parts of patent include the following:
  - 1) Specification
  - 2) Claims
  - 3) Drawings

## Claims

- Section at the end of specification that provides the legal definition of the patent
- Most important part of a Patent Application
  - All of the requirements of patentability are judged in relation to claims
  - The negotiation process with Examiners centers around claims
  - Dictates infringement of Patent

## Claim Example

- 1. A method of determining user input from a series of video frames, the method comprising: identifying at least one location of a fingertip in at least one of the video frames; and mapping the location to a user input based on the location of the fingertip relative to a virtual user input device, wherein said identifying at least one location of a fingertip comprises identifying a target pixel in a first one of the video frames, the target pixel representing a potential fingertip location; tracking motion of the target pixel in video frames occurring after the first one; determining whether the target pixel is a confirmed pixel, the confirmed pixel representing a probable fingertip location; and tracking motion of the confirmed pixel to produce a plurality of fingertip locations.

## Typical subsections found in Specification

- Title of Invention
- Cross-reference to related applications
- Federal Funding clause
- Background Of Invention
- Summary Of Invention
- Description of drawings
- Detailed Description
- Examples

## Bayh-Dole Considerations

- Cross-reference to related applications
- Federal Funding Clause



## Other Patent Filing Documentation

- Application Data Sheet
- Power of Attorney
- Inventor Declarations
- IDS
- Assignments

## Information Disclosure Statement

- Applicant and all interested parties are under an obligation to provide references to USPTO that are material to patentability
  - Interested parties include Tech Transfer Office Personnel and Patent Attorney
- Failure to comply with disclosure obligation can result in nullification of patent rights

## Patent Examination Process Initial examination

- The Patent application and support documents are first reviewed by the Office of Initial Patent Examination (OIPE)
- Notice of Missing Parts
  - Typical sent out 3-4 weeks after filing
  - Have two months to respond

## Patent Examination Process (Assignment to a Patent Examiner)

- After review by OIPE and Filing any necessary documentation, case is assigned to Examiner
- Restriction Requirement
  - Too many inventions
- Preparation and Filing of Election
  - Extendible due date = 1 month after mailing of restriction requirement

## Examination Process (Cont.)

### Substantive Examination

- Examiner reviews claims and specification and conducts prior art search
  - Examiner searches for references related to novelty and obviousness
  - Evaluates the claims for patentability (novel, nonobvious, enabled and sufficiently described)
- Examiner issues written report about her findings, typically referred to as an “office action”

## What Happens after Office Action Issues?

- Patent attorney reviews the issues raised by the Examiner and devises response strategy
  - A response to an office action typically includes amendments to the claims that try to distinguish from prior art accompanied by legal arguments refuting the findings/conclusions of the Examiner
- The typical time period for filing a response is 3 months after mailing date and is extendible up to 6 months

## “Final” Office Action

- If the Examiner is not convinced by the amendments/arguments made in Applicant’s response, Examiner will issue a “Final” office action.
- Final does it really mean final?
  - Applicant is given less leeway in making arguments and amendments
  - Examiner may consider arguments and amendments but is not obligated to do so

## Applicant’s Options for responding to Final Office action

- File a Response
  - more aggressive claim amendments?
  - Advisory Action issued if issues not resolved
- File an Appeal
- File a Request for Continued Examination
  - Essentially involves paying a fee to restart the Examination process

## Timing after Final Office action

- Early response = 2 months after mailing date of Final action
  - Ensures issuance of Advisory Action
- File Notice of Appeal
  - Due date (extendible) = 3 months after mailing date of Final action
  - Appeal Brief Due date (extendible) = 2 months after filing Notice of Appeal

## Success!!

- If Applicant's response addresses all issues of patentability or Applicant wins appeal, USPTO will issue a NOTICE OF ALLOWANCE
- Applicant will need to pay issue fee and submit an issue fee transmittal form that includes related information about ownership
  - Issue fee payment due date= 3 months after the mailing date of Notice of Allowance (nonextendible)

## Daughter Applications?

- At filing the issue fee, need to consider whether there is interest in filing a continuation or divisional application
  - Applications described and enabled by parent application but which claim different subject matter
  - Given benefit of priority date of parent
- Must be filed on or before the parent issues
  - Issuance typically occurs 4-6 weeks after issue fee paid
  - Varies and is unpredictable = best practice to file at or near time of paying issue fee

## What Happens after patent issues

- Patent may be enforced against infringers
  - Litigation in court
- Patent needs to be maintained
  - Payment of fees to USPTO every 3.5 years after issuance
  - Failure to pay fees = expiration of patent

## How long does a patent stay in force?

- Term of patent = 20 years from the filing date
- Daughter applications
  - Patent term based on parent = 20 years from filing date of parent
- Patent term extension
  - If USPTO delays occurred during prosecution, USPTO will extend term of patent
  - This calculation is provided on issue notification

## Questions? Comments?





# Discussion and Q&A

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