



Protecting Intellectual Property

- ✂ "Necessity is the mother of all invention and Nuisance is the father"
- ✂ 1788 First US steamboat patent is issued to Briggs & Longstreet due to a necessity to travel more efficiently
- ✂ 1985 Carmela Vitale was granted a patent for the "package saver" in a pizza box due to the nuisance of having pizza cheese stick to the box top.
- ✂ Both methods lead to inventions that need protection – We will discuss several ways to do that during this presentation.



3 Types of Intellectual Property Protection

- ✚ Trademark

- ✚ Copyright

- ✚ Patents



Trademark/Service mark

- ✦ Trademarks are words, names, symbols or a device that is used in trade with goods to indicate the source of the goods and to distinguish them from the goods of others.
- ✦ Servicemark is similar except it identifies the source of a service
- ✦ TM or SM can be used by anyone to identify a unique symbol, word or name. ® Can only be used when a trademark has been registered with the USPTO.



Copyright

- ✚ Copyright is a form of protection provided to authors of “original works of authorship”
- ✚ Can include literary, artistic, musical, and certain other intellectual works both published and unpublished.
- ✚ Only protects the form of expression and not the subject matter.



Patents

- ✚ Issued by the United States Patent and Trademark Office. (USPTO)
- ✚ Good for 20 years from the date of application.
- ✚ Gives grantee the “right to exclude others from making, using, offering for sale, or selling” the invention in the US or “importing” the invention into the US



Discussion Topics for the Patent Process

- ✚ Types of protection
- ✚ Outline of process
- ✚ Pros/Cons of Patent Attorneys
- ✚ Recommendations for how to proceed
- ✚ Resources



Patent Types

- ✚ Design Patent

- Primarily focuses on ornamental designs

- ✚ Provisional Patent

- Uses the same complete content as Non-Provisional application but expires in 1 year

- ✚ Non-Provisional Patent

- Commonly know as a Utility Patent



Design Patent

- ✚ Granted only for ornamental design
- ✚ Defended by proving that “public would not confuse” someone else’s design for yours.
- ✚ 1879 August Bartholdi was granted a design patent for the Statue of Liberty.
- ✚ Generally considered weak and difficult to defend.



Provisional Patent

- ✂ Provides the inventor with immediate “Patent Pending” status after it is filed with the USPTO.
- ✂ All information remains confidential.
- ✂ Less costly than a complete application.
- ✂ Expires after one year unless a complete application is filed.
- ✂ Reasonable to complete, with the help of software, without the use of a Patent Attorney.
- ✂ Must have at least clear drawings and a detailed description – not used for Design Patents



Non-Provisional/Utility Patent

✚ Consists of at least the following elements:

- Application form
- Fee transmittal form and fee
- Application Data Sheet
- Specifications (with at least one claim)
- Drawings
- Oath or Declaration

*Typically best to use a Patent Attorney



Specifications

- ✦ Includes a written description that explains the manner and process of making it.
- ✦ It is critical that this section describe exactly how a person “skilled in the art or science” to which the invention pertains would be able to construct it.
- ✦ This section also includes – Title of the invention, cross references to other patents, information on federal research related to the topic, invention background, invention summary



Claims

- ✚ This is the most critical section of the application and usually determines success or failure.
- ✚ Every utility application must have at least one claim
- ✚ Each claim is a single sentence with dependent claims referenced in the same section as primary claims.



Abstract and Drawings

✚ Allows the public to quickly determine the nature of the technical disclosures of your invention.

- Less than 150 words
- Lists what is new in the art about your idea

Drawings are typically required and recommended and are usually prepared in such a way as to provide 6 views of an object.



Other Patent Types

✚ Plant Patent

- For instance, a new soybean that is pest resistant, a new flower, etc.

✚ International Application

- May be applied for in as many countries as desired.
US Patents only protect from importation of products made in other countries.



Where Do I Begin?

- ✚ Will you produce this part yourself or market it to others?
- ✚ Are you on your own or funded by a company?
- ✚ Initial research on your invention should include at least: patent research and market research.
- ✚ Is this a design or utility patent?



Patent Search

- ✚ Use the USPTO web site or the patents.ibm.com site to find relevant patents.
- ✚ Using keywords, print and read any pertinent, related patents.



Market Research

- ✚ Find all similar products on the market.
- ✚ Catalogs, stores, internet, and trade journals/magazines are great sources.
- ✚ “Feel out” other professionals in the industry related to your device.
- ✚ Order and test anything that you can afford that appears close but not as good as yours.



Decision Point!!

- ✖ Pursue companies that can manufacture the device and market it to them.
 - Use confidentiality agreements and meet face to face when possible.
- ✖ Use the resources of your employer to patent and produce the device.
- ✖ Scrap or shelve it and move on!



● Conclusions and Views Toward Patent Rights

- ✚ Assignment to a company or person
- ✚ Royalties
- ✚ Rewarding and encouraging employees
- ✚ Patent Infringement

Online Resources

- ✦ National Inventor Fraud Center, Inc. (www.inventorfraud.com) - Covers the process and invention promotion companies.
- ✦ (www.freepatentforms.com) - Free patent forms for inventors to utilize.
- ✦ United States Patent & Trademark Office (USPTO) (www.uspto.gov) - Information for inventors from the United States Patent & Trademark Office (USPTO) web site.
- ✦ IBM Patent Server (www.patents.ibm.com) - A free on-line patent search engine for inventors to utilize.
- ✦ PatentWizard is a great software for self help on provisional patents (www.patentwizard.com).