

UNITED STATES  
PATENT AND TRADEMARK OFFICE



>>Lisa Friedersdorf: Good afternoon, and welcome to the first webinar in our new series for entrepreneurs. My name is Lisa Friedersdorf, and I'm the Director of the National Nanotechnology Coordination Office. This webinar series is one of the activities we support for the new Nanotechnology Entrepreneurship Network, or NEN. The NEN brings new and seasoned entrepreneurs together with the people and resources available to support them.

This emerging network provides a forum for sharing best practices for advancing nanotechnology commercialization and the lessons learned along the technology development pathway. A key stop along the technology development pathway is protecting the underlying intellectual property. Entrepreneurs intending to commercialize an emerging technology – such as a nanomaterial or a nanotechnology-enabled product – need to be aware of the intellectual property issues that might impact their business.

In this webinar, we welcome guests from the U.S. Patent and Trademark Office. Elizabeth Dougherty is the Eastern Regional Outreach Director, and Craig Morris is the Managing Attorney for Trademark Educational Outreach. With that, I will turn it over to Elizabeth to get things started.

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>>Elizabeth Dougherty: Thank you, Lisa. It is really a pleasure to be here on behalf of the U.S. Patent and Trademark Office. We enjoy the opportunity to get out and to speak with our stakeholders and to speak with such a unique community – the nanotechnology space. Nanotechnology is certainly becoming ubiquitous within the practice, and certainly across technology, and we're seeing it in more and more applications each and every day. So, we're excited to have the opportunity to work with your network and to provide an initial conversation about the importance of intellectual property.

In our hour today, we will just scratch the surface of what intellectual property is. I would like to say, starting out for myself – and I think I can speak for my colleague Craig – that three of our key takeaways are as follows. First, protecting your intellectual property is an important business strategy. For anyone who is looking to start, build, and grow a business, it's a business strategy that should be present in your business thinking from the very beginning. It shouldn't be a rainy-day project. It's not a project to get to when you have more time or money, because oftentimes by preventing or delaying intellectual property, you could preclude yourself from protecting your intellectual property. So, we encourage people to think of it very early on in the process.

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>> Elizabeth Dougherty: Second, there are different forms of intellectual property, and they are each protected by very different vehicles. Today, we will touch on patents and trademarks primarily, because we are the U.S. Patent and Trademark Office. But there are also copyrights, which are administered by the Copyright Office (which is part of the Library of Congress), and trade secrets, which are generally protected by contract law or state law.

Third, one of the other takeaways that I would love for our audience to appreciate today is that there are numerous resources – available through the U.S. Patent and Trademark Office and our partners and collaborators – that are there to assist people who are getting started in protecting their intellectual property. We will talk about some of those during our presentation today. Also, many of these resources reflect my favorite four-letter word, which is “free.” Many of these resources are free. So, I hope that we will have the opportunity to touch on them, so people are aware they exist. With that, let's go ahead and jump right into the materials, because I know our time is limited and we want to also encourage questions, as we go along.

# What is Intellectual Property (IP)?

- Intellectual Property refers to “creations of the mind,” something you create like an invention or a poem or a logo.
- Patents, trademarks, copyrights, and trade secrets do not protect the same things.
  - A person or company may own some or all of these types of intellectual property.



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>> Elizabeth Dougherty: So what is intellectual property? Intellectual property is property that is created by the mind – whether you're creating an invention, a poem, or a logo. These are all things *we* have created, and they're in opposition to real property. When we talk about real property, we're talking about a house, a car, a boat – something that one has ownership of, that is protected in another form. When you think about owning a home or a car, it's often protected by a deed, it's often protected by some type of a contract. Differently, intellectual property is property that is created by an individual or an organization, starts as an idea, and builds into something that is protectable.

## The Constitutional mandate for intellectual property



**Article I Sec.8. Cl. 8** –The Congress shall have power: “To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

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>> Elizabeth Dougherty: Where does the thought of protecting intellectual property in the United States come from? It comes from the Constitution itself. When creating the Constitution of the United States, the founding fathers of our country recognized that in order to build a strong and growing industrialized nation, it was going to be important to protect authors and inventors for a limited period of time – their ability to protect their writings and discoveries. So, we find language in the Constitution itself that protects those patents and copyrights, and Craig can address the fact that trademarks are in there, too. As we see, Article I, Section 8, Clause 8 provides that Congress shall have the power “to promote the progress of science and useful arts by securing for limited times [and that limited time is going to be important] to authors and inventors the exclusive right to their respective writings and discoveries.”

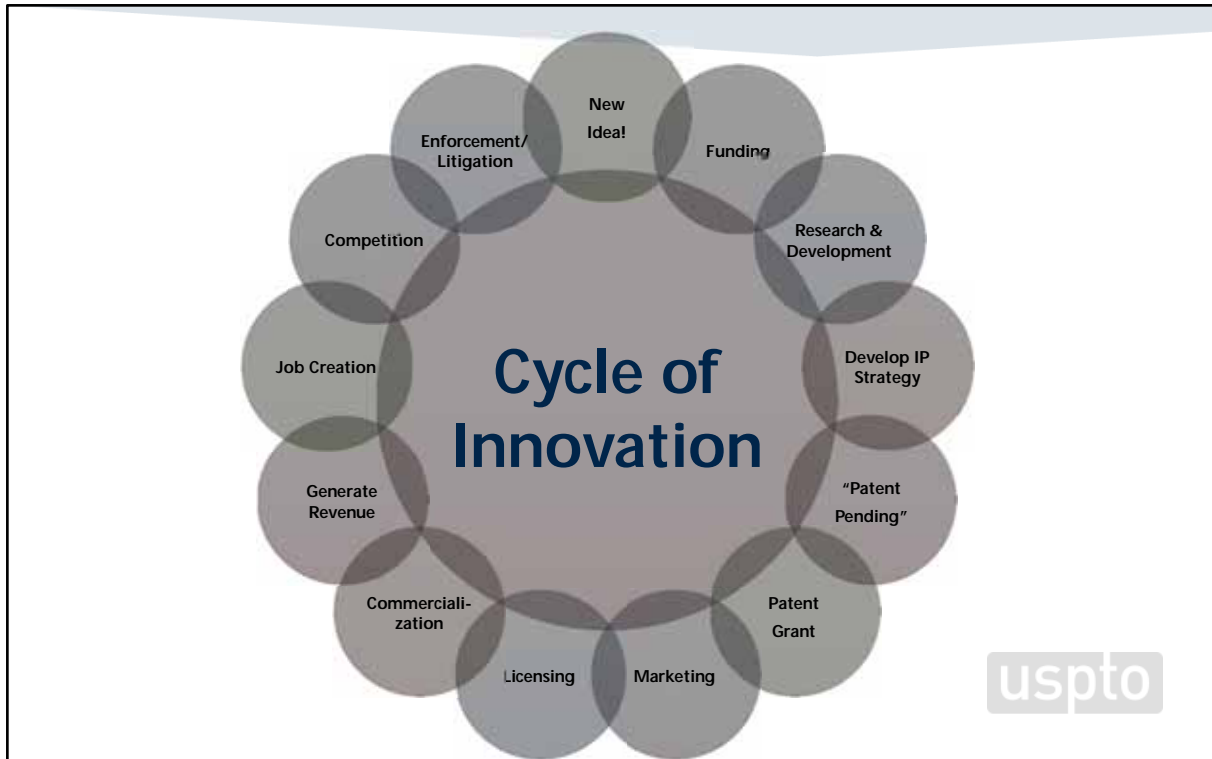
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>> Elizabeth Dougherty: In fact, on an interesting historical note, this is the only place where one will find the word "right" in the U.S. Constitution: here in Article I, Section 8, Clause 8, where we set forth the protection of patents and copyrights. On another historical note, for those who are considering applying for a patent, a little over a year ago, we have issued patent number 10 million. This is something we've been doing since 1790. The U.S. Patent Office (prior to becoming the U.S. Patent and Trademark Office) is arguably one of the oldest federal agencies and has been at our work since 1790.



>> Elizabeth Dougherty: As I mentioned right up front, it's important to note that protecting your intellectual property should be part of your business strategy. Why is that? How does that go about? As we see from this graphic (the cycle of innovation), there are many different facets to the cycle of innovation, starting with creating that new idea and then what one does with that new idea. You seek funding and research & development, you develop your IP strategy, etc. These are all pieces of a critical puzzle, where you take that idea and hope to bring it to the marketplace and be successful in creating a business and perhaps going on to build an industry.

# IP Strategy IS a Business Strategy

IP:

- Is attractive to investors and buyers
- Deters infringement lawsuits
- Can increase leveraging power
  - Mergers and acquisitions
- Is a property right than can add value to a company's assets
- Is Global



2/12/2016

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>> Elizabeth Dougherty: Now, why is an IP strategy a business strategy? That's because IP is an asset. It's an asset for any business. For those of us who have ever seen *Shark Tank* – and when I speak to an audience, invariably, there's always a number of people in the audience who raise their hand that they have seen *Shark Tank* – what is one of the first questions the Sharks have asked? “Have you protected your intellectual property?” (whatever that product it is that they’re bringing forward). Lori Greiner, one of the Sharks, has over 150 patents in her own name. She is an inventor and a very strong proponent of the patent system. IP is also important for increasing your leveraging power. It creates that portfolio that you can bring forward to a company if you are trying to leverage financing or if you were trying to attract investors. Also, it is a property right, and it is global.



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>> Elizabeth Dougherty: We will talk a little bit today about the fact that intellectual property is global. That does not mean to suggest that there is a worldwide patent, because, in fact, there is not. Patents are territorial. Patents only protect an invention for the country in which they are issued. With that said, one can protect your invention across the globe. There are a number of different vehicles and a number of different intellectual property offices. But it's a great conversation to have as a registered patent attorney or patent agent. So while one could protect globally in each and every country across the globe, that's a very expensive proposition, one where there might be a strategy behind where you would like to file.

## Developing an IP Strategy

- Assess your company's IP assets and prioritize
- Know your competition & what they're up to
- What's the pace of innovation & opportunities for growth?
- Determine the best way to protect your IP



>> Elizabeth Dougherty: In developing your IP Strategy, it's important to assess your company's IP assets and prioritize. As I mentioned earlier, you may be creating an IP portfolio, and that portfolio may consist of not only multiple patents, but multiple types of patents: utilities, designs, plants, and even provisional patent applications. Note that I say "provisional patent application," because there is no such thing as a provisional patent. That's important to note.

Know what your competition is and what they are up to. This could be important both when looking to the innovations that you are creating but also where you want to file to protect your intellectual property.

What is the pace of growth and innovation and opportunities for growth? Interestingly, we would argue or suggest that the majority of patents that are issued are for improvement technologies. In fact, it's been said anecdotally that 99% of the patents issued are for improvement technologies, meaning someone is building upon an existing technology. You know that a two-wheel bicycle works really well, but you think "I can add a third wheel, it will be more efficient and I can cover more ground more quickly." That will be an improvement upon an existing technology. It's argued that only 1% of patents that are issued are for disruptive technology. This is a conversation for another day but certainly an interesting point to consider, because the U.S. patent applications that are published and the patents that are available worldwide are an incredible wealth of information, and one on which we are able to build upon. One of the inherent beauties of the patent system is that by disclosing these inventions to the public, we are all able to gain and to benefit from them and to build upon them.

## How tangible are your assets?

50 years ago: Factory, Equipment and Inventory

Today: Designs, Processes, Inventions,  
Algorithms and Brands

Intellectual Property protects both  
tangible and intangible assets!

Patents, Copyrights, Trademarks & Trade Secrets



>> Elizabeth Dougherty: Taking a historical perspective, how tangible are your assets? This is just an interesting note: In previous times, a company might have listed its most important assets. Approximately 50 years ago, if a company were to list its primary assets, they would be hard assets: factory, equipment, and inventory. Today, oftentimes, companies consider their most valuable assets to be more intangible things: designs, processes, inventions, algorithms, brands – things that are protected by intellectual property. That's the importance of our conversation today.

>> Lisa Friedersdorf: You mentioned several different types of patents. So, when an inventor or entrepreneur is developing a new product, how do they think about an early-stage patent versus when they complete the entire process?

>> Elizabeth Dougherty: This is a great question. This brings us to an important part of the presentation, where we talk about provisional patent applications and non-provisional patent applications. Before we get to that content, maybe we could touch very quickly on the different types of patents: utility, design, and plant.

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>> Elizabeth Dougherty: When an individual is thinking about filing a U.S. patent application, most frequently what we receive are utility patent applications, which cover the majority of what we think inherently as inventions: a bicycle, a cellular communications device, a new chemical composition. It can protect the chemical composition, the method of manufacture, the article of manufacture. It can also protect business methods, or methods of doing business.

Our design patents protect the ornamental appearance of an article of manufacture. So, interestingly, when we talk about utility patents and design patents, those are often secured by an inventor hand in hand, or in a similar process.

They are two different forms of intellectual property, or two different types of patents, and they require two different patent applications, because they can oftentimes work together to provide great value in protecting an invention.

Let's take for example, a cellular communication device. In all likelihood, the components of that cell phone are protected by hundreds, if not thousands, of utility patents: the chips that are within the phone, the various components of the phone itself. But then these components may also be protected by a design patent, which protects the ornamental appearance of that cellular communication device. So whether one is inventing a new mailbox or a new cellular communication device, oftentimes, people will create this patent portfolio to protect all of the various aspects of that particular device.

## How do I get value from my IP?

IP can be used:

- To gain entry into, and deter others from, a market
- As a marketing tool to promote unique aspects of a product or asset
- To assert/enforce rights against an infringer or competitor
- To leverage/use as collateral to obtain funding
- To create revenue – sell or license like other property



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>> Elizabeth Dougherty: How do I get value from my IP? Some of these are very intuitive, and I will leave these for you to review at a later time. Let's boil it down just to say that IP can be used in a number of ways to bring value to you as an individual, you as a company, you as an organization. It can be used similar to real property as an asset.

# Basic US Patent Practice

Elizabeth L. Dougherty

Eastern Regional Outreach Director

February 5, 2020



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# What is a patent?

## A U.S. patent is

- A property right granted by the United States government to an inventor
- To **exclude others** from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States
- For a limited time
- In exchange for public disclosure of the invention



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>> Elizabeth Dougherty: So let's talk about patents themselves. What is a patent? I'm sure that many of you in our audience today and many of you who may be listening to this at a later date are very familiar with a patent and hopefully you will have many of them, hopefully you are one of our frequent flyers and have received a number of U.S. patents. But for those of you who are not as familiar, a U.S. patent is a property right granted by the United States government to an inventor.

## Balancing of interests

- Patents provide a right to exclude for a limited period of time.
  - Public benefit: inventors' discoveries enter public domain upon expiration of patent
  - Quid pro quo: limited period of exclusivity in exchange for public disclosure of inventions



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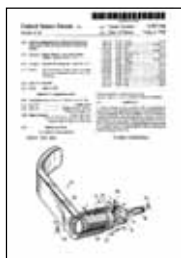
>> Elizabeth Dougherty: Our system is what we call a quid pro quo system, where in exchange for the inventor disclosing their invention to the public (with such specificity that others can make and use their invention), the government is willing to protect their right, is willing to give them the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing for a limited period of time.



# Types of patents

## Utility

New and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof



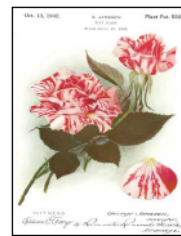
## Design

Any new, original and ornamental design; protects the way an object appears



## Plant

Whoever invents or discovers and asexually produces any distinct and new variety of plant



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>> Elizabeth Dougherty: We just touched briefly on utility patents and design patents. Utility patents under current U.S. law protect an invention for 20 years from the date of filing that application. Design patents protect an invention for 15 years from the date of issuance of the patent. So, going back to one of our initial talking points, there are different forms of intellectual property, they protect very different things, and they oftentimes have very different terms. So, as you create your portfolio, it's important to be aware that there are different forms, with different terms, and to keep track of those. We won't talk about it today, but when one has a utility patent, maintenance fees are required in order to keep that patent in force (once you have received a U.S. patent).

## 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 intellectual property issues including copyright
- © symbol can be used without registration



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>> Elizabeth Dougherty: As I mentioned, there is something called copyright. We won't talk about it in any great depth today, it is handled by the U.S. Copyright Office, which is part of the Library of Congress. It protects an original work of authorship which is placed in a fixed and tangible medium.

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

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>> Elizabeth Dougherty: Trade secrets, as I also referenced, are any information that derives economic value from not being generally known or ascertainable. Trade secrets are incredibly interesting in that they can protect an invention or some other form of valuable intellectual property as long as the information can be kept secret. As we just mentioned, patents are for a limited period of time, as put forth in the Constitution: utility patents, 20 years from the date of filing; and design patents, 15 years from the date of issuance. For trade secrets, as long as one can maintain that information in secret, they can last forever. So, think about that, as you are creating your intellectual property: If you have something that you have created, that you can maintain as a secret (either through employee regulations or employee contract), consider it. It's one of the valuable forms of intellectual property.

## 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)?



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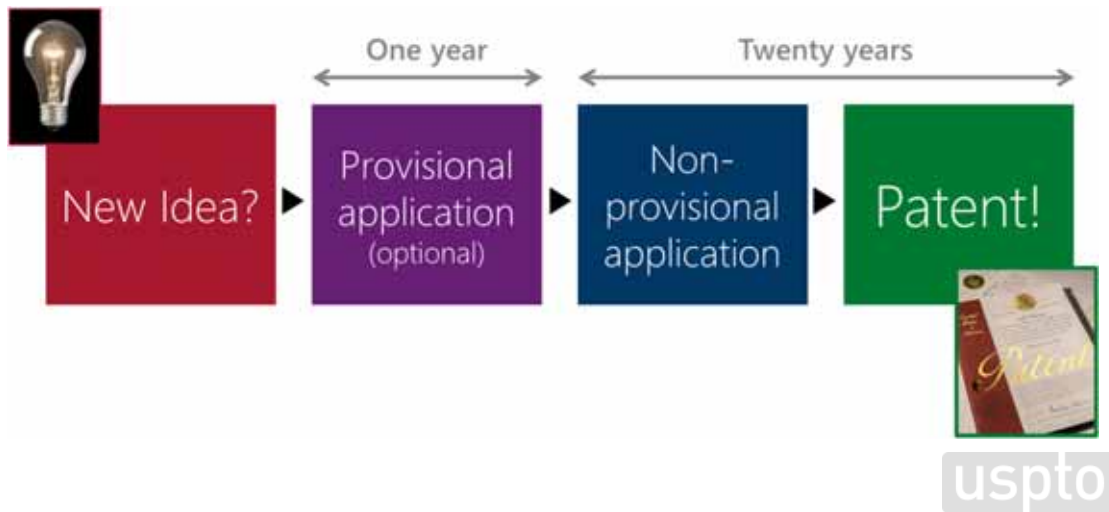
>> Elizabeth Dougherty: So with that, let's start looking more at patents. As I mentioned, there are utility, design, and plant patents. I would suspect that many of you who are listening today or are listening to this in the future will be pursuing either utility or design, or perhaps both. When considering what type of patent to file, one needs to determine what it is you are trying to protect (that's really the key question, as I mentioned for utility patents): new and useful processes, machines, articles of manufacture, compositions of matter for any new and useful improvement. Remember, we mentioned that 99% of patents that are issued are for improvements.

So, when one starts going down the patent path, there are some pre-filing decisions that should be considered:

- Should you file an application? It is a significant endeavor to undertake.
- When should you file?
- Where should you file? This should be a question of whether you should file with the U.S. Patent and Trademark Office, or whether you should file abroad, or both. The majority of our applicants file electronically. While you can deliver a paper application, that is very infrequently done.
- What type of application to file? Are you seeking utility, design, or plant application?
- Who should prepare the application?

These are all questions that one should be asking before undertaking this significant endeavor.

# The path to a patent



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>> Elizabeth Dougherty: The path to a patent generally begins with a new idea, or hopefully it is a new idea. With that said, perhaps your idea is so great that someone has thought of it. This is where it's a good opportunity to consider the idea of doing a prior art search. In filing a provisional or non-provisional patent application, one is not required to do a prior art search, although it is strongly encouraged. Your idea may be so great that someone else has already thought of it.

Now, one can take the step of filing a provisional patent application. The slide indicates that it is optional but it is a useful tool. If one wants to seek a U.S. patent, however, one must file a non-provisional patent application. That is a document filed with the federal government that can result in a U.S. patent – if your invention meets the criteria.

# Provisional vs. Non-provisional

Provisional	Non-provisional
<ul style="list-style-type: none"><li>• Not examined or published</li><li>• One-year time limit</li><li>• Only for utility patents</li><li>• A low-cost way to establish an early effective filing date (priority date) in a non-provisional patent application with few formalities</li></ul>	<ul style="list-style-type: none"><li>• Examined</li><li>• Published 18 months from earliest filing date (unless a request for a non-publication at filing)</li><li>• Can become a patent</li></ul>



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>> Elizabeth Dougherty: So let's do a deeper dive on the provisional versus non-provisional patent application. The provisional application is something which is filed as a placeholder with the U.S. Patent and Trademark Office. It is a document which is not examined nor published. When I say it is not published, that means it is maintained in confidence within the U.S. Patent and Trademark Office. It is only good for one year, and it is only available for utility patents. It allows an applicant to file, for a low cost of entry and a relatively low barrier to entry, a document with the U.S. Patent and Trademark Office, which puts on notice that you are seeking or pursuing, perhaps, patent protection. By filing a provisional patent application, one can begin to use the term "patent pending" if a provisional application has been filed (and, of course, certainly if a non-provisional application has been filed).

As I mentioned, if you want to seek a U.S. patent, you must file a non-provisional patent application. It is examined by one of our over 8,000 trained engineers and scientists who review the over 650,000 applications that we receive each year. These applications are published 18 months from the earliest filing date and can become a patent if the standards are achieved.

# Provisional utility application

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## 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



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>> Elizabeth Dougherty: With respect to the provisional utility application, it is a low-cost way to establish an early effective filing date. It does not issue as a patent, and it is only good for a one-year period. It can serve as the basis for your non-provisional application and, in fact, if one files a non-provisional patent application within the year of the provisional patent application, one is effectively achieving a 21-year patent. So that's another benefit.

While one can use the term "patent pending" while either a provisional patent application or a non-provisional patent application is pending, one cannot pursue in a court of law or go after a competitor until the U.S. patent issues. This is just a point of notice. As I mentioned earlier, the provisional patent application is a patent application. It is not a patent. Keep in mind that it is not something that is examined.



## Provisional utility application

Additional benefits of a provisional application:

- 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 filing of the non-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



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>> Elizabeth Dougherty: As I mentioned, the provisional application can serve as a basis of priority for your non-provisional application, as well as for filing an application in a foreign country.

# Provisional utility application

- 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



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# Where do you go from here?

## Provisional applications – as basis for priority

- Domestic benefit
  - For non-provisional applications
- Foreign priority
  - Foreign national applications can claim benefit of provisional application filing date if filed within 12 months of the Provisional filing date under Paris Convention Article 4
  - Patent cooperation treaty (PCT) application can claim priority to US provisional application



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# Non-provisional patent application

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## non-provisional patent application

- **Filing Requirements for Examination**
- A specification, including a description and a claim or claims
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
  - Oath or declaration or an application data sheet
- The prescribed filing, search, and examination fees



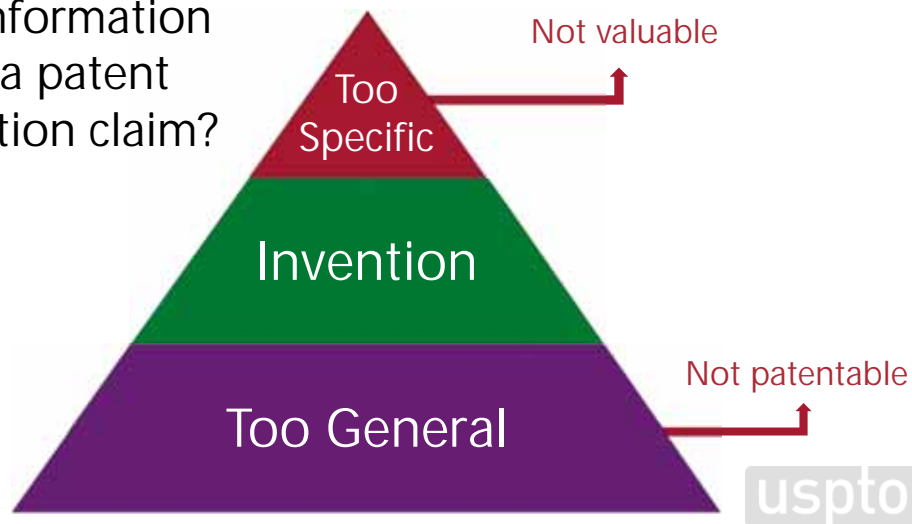
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>> Elizabeth Dougherty: So let's get down to brass tacks here, because I see our time is going rapidly. Let's talk about the application which can advance into a U.S. patent, because that's really what we're hoping to achieve here and the information that we're hoping to deliver.

For that non-provisional patent application, there are filing requirements. In filing a U.S. patent application, we do follow a very specific form. For anyone who has not looked at a U.S. patent, I would suggest and recommend that prior to considering filing a patent application or pursuing a U.S. patent, you look at patents that have issued in the field of endeavor in which you're inventing. It not only provides you with information as to what's happening in your space, or field of technology, but it also allows you to see this format: one must have a specification, one must have drawings, one must provide certain biographical information, and for a basic filing, one must provide a filing fee, a search fee, and an examination fee.

# Claim scope

What information should a patent application claim?



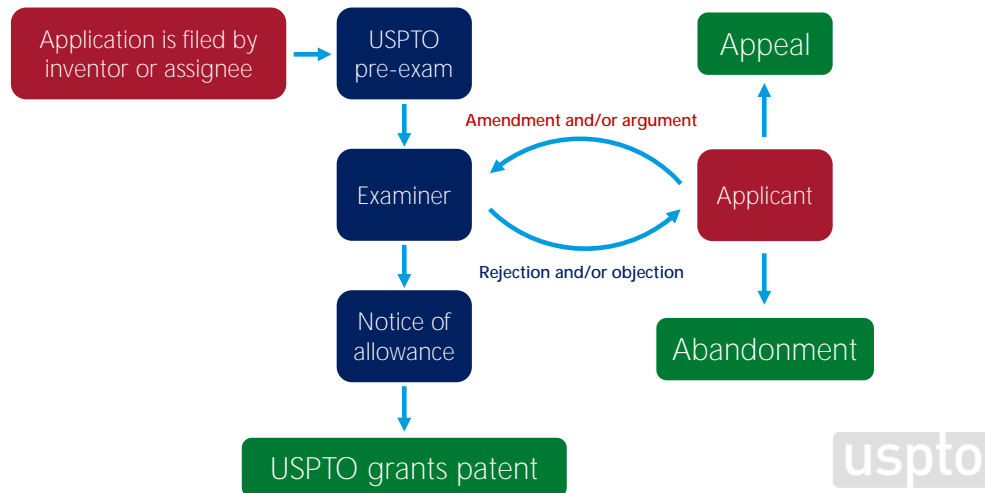
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>> Elizabeth Dougherty: When we talk about a U.S. patent and the scope of a patent, we are, in large part, focusing on the claims of the application. As was set forth in one of the most significant patent cases of our generation, the claims are the name of the game. That's where people are going to go to, first and foremost. Look at your patent to see exactly what you are protecting, what you have invented, and what is protected by your patent. So, you are going to want to take great care in drafting the claims of your application.

This might be a great place to take a step aside and answer the question: "Can one pursue a patent application on one's own?" And the answer is "yes." Now, I will say with that "yes" that only about 3% of our applicants do so, and they are pro se applicants – individuals who file without the assistance of a patent attorney or a patent agent.

Now, some of them do it very successfully, so it's not to be discouraged. However, we do strongly encourage the use of a patent attorney or a patent agent, because it can be considered a complicated process, and it is receiving a right from the federal government, so there are a number of hurdles to pass. As I mentioned, there are formats to comply with, and the complexity of the process is not to be dismissed.

# Patent examination

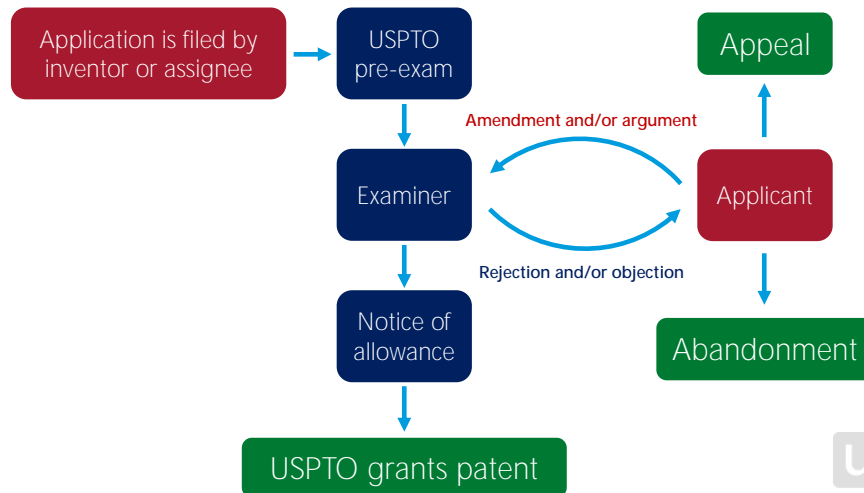


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>> Elizabeth Dougherty: So when one files a patent application, what happens? Well, it is received by the U.S. Patent and Trademark Office and is distributed to one of our 8,000 patent examiners. Having been one of them for the first portion of my career, these individuals are committed to serving the American people and take their jobs very, very seriously. They are technologists, they are scientists and engineers from all backgrounds within the scientific endeavors.

Your application is received, which then allows us to begin the process of communication and collaboration, because we want the same thing that our inventors want: We want to issue them a valid U.S. patent if they are entitled to one. We are the U.S. Patent and Trademark Office, not the U.S. rejection office. We want to issue you a patent if you are entitled to one, but we want it to be a patent you can take to the bank and not to the courthouse.

# Patent examination



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>> Elizabeth Dougherty: With that said, we begin a back-and-forth process with the applicants, and this is usually through their patent attorney or patent agent. We begin to boil down the invention to what may be a patentable invention. This is where the patent examiner is going to look for whether the invention is novel, whether the invention is nonobvious, and whether the invention has utility.

The patent examiner will also look to ensure that it is subject matter-eligible. Is it something that is eligible to be protected by a patent? These are all considerations that play into the patent examination process, or the patent prosecution of your application.

Now, in all hope, you receive a U.S. patent, you become one of our over 10 million patents that are filling our world with new inventions to make our own lives better, more efficient, more effective, and more fun.



## What happens after I get my patent?

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



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>> Elizabeth Dougherty: Once one receives the U.S. patent, it falls to the rights-holder to enforce that patent and to determine what to do with it. My father has a patent. He never commercialized that technology, but he is extremely proud of the fact that that patent hangs on his wall, and for some people, that is enough. But you may decide that you want to start building and growing a company. You may decide that your heart, or passion, is in creating the invention itself. So, you may choose to license your technology for someone else to commercialize your technology. This is really one of the beauties of our system: that as the patent's rights-holder, you have so many choices as to what to do next.

## USPTO resources

>> Elizabeth Dougherty: As I see my time is nearly up, I just want to hit some quick USPTO resources before I turn to my colleague Craig to talk to you about the importance of trademarks and protecting your intellectual property.

# USPTO offices



## **Detroit**

- Operational since July 2012

## **Denver**

- Byron G. Rogers Federal Building
- Operational since July 2014

## **Silicon Valley**

- San Jose City Hall Building
- Operational since October 2015

## **Dallas**

- Terminal Annex Federal Building
- Operational since November 2015



>> Elizabeth Dougherty: Very quickly, I just want to alert you to the fact (because I'm sure some of you may be tuning in from outside the Washington, D.C. Metro area) that we do have regional offices located in Detroit, Denver, Silicon Valley, and Dallas. Just like our Alexandria, Virginia, headquarters, all of these offices have resources and welcome you to come and visit. They also reach out to their communities and enjoy doing direct stakeholder engagement.

So, if you have a company and you would like to have the USPTO come visit, whether from our regional office or from headquarters, we enjoy engaging with you.

# Eastern Region – USPTO headquarters

600 Dulany Street, Alexandria, Virginia



## Core Functions:

- Receipt and examination of patent and trademark applications
- U.S. and international IP policy development
- Oversight and management of USPTO operational functions
- Stakeholder engagement and training



- Office hours: 8:30 a.m. – 5 p.m. ET, M – F
- Services
  - Public search facility hours  
8 a.m. – 8:00 p.m.
  - Examiner interview rooms
  - PTAB and TTAB hearing rooms
  - Public meeting space
  - National Inventors Hall of Fame Museum,  
10:00 a.m. – 5:00 p.m.

>> Elizabeth Dougherty: This is just a quick photo of our Alexandria headquarters, where Craig and I are located. We have a public search facility there, as well as the National Inventors Hall of Fame Museum. So, we encourage you to come and visit us up in Alexandria.

## Eastern Regional Outreach Director

- **C**onduct USPTO programming
- **C**oordinate USPTO engagement
- **C**ollaborate with USPTO stakeholders
- **C**ommunicate USPTO priorities and programs



>> Elizabeth Dougherty: Skipping past the photo of myself, let's talk very quickly about inventor and entrepreneur resources.

# Inventor and entrepreneur resources

- USPTO's hub for resources and information for inventors, entrepreneurs, and small businesses.
- Webpage:  
<https://www.uspto.gov/inventors>



The screenshot shows the USPTO website's 'Inventor and Entrepreneur Resources' page. The header includes the USPTO logo and navigation links for Patents, Trademarks, Policy, Learning and Resources, and a Search bar. The main content area is titled 'Inventor and entrepreneur resources' and is organized into four columns of links and information. The first column, 'Resources for inventors', includes links for 'How to get started with the USPTO', 'Patent process overview', 'Patent application basics', 'Patent search basics', and 'Patent prosecution basics'. The second column, 'Resources for inventors and entrepreneurs', includes links for 'Patent process overview', 'Patent application basics', 'Patent search basics', 'Patent prosecution basics', 'Patent law basics', 'Patent law basics', 'Patent law basics', and 'Patent law basics'. The third column, 'Resources for entrepreneurs', includes links for 'Patent process overview', 'Patent application basics', 'Patent search basics', 'Patent prosecution basics', 'Patent law basics', 'Patent law basics', 'Patent law basics', and 'Patent law basics'. The fourth column, 'Other helpful resources', includes links for 'Patent process overview', 'Patent application basics', 'Patent search basics', 'Patent prosecution basics', 'Patent law basics', 'Patent law basics', 'Patent law basics', and 'Patent law basics'. The footer of the page includes the USPTO logo and the text 'U.S. DEPARTMENT OF COMMERCE'.



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US Patent & Trademark Office

USPTO

Patents • Trademarks • IP Policy • Learning and Resources

IP Tools & Info
- ## Inventor and entrepreneur resources
- ### 1 Reports for startup

Reports for startup and ongoing businesses, including market research, competitive analysis, and financial projections.

  - 1. Business plan template
  - 2. Market research report
  - 3. Financial projections
  - 4. Business plan checklist
  - 5. Business plan examples

### 2 Guidance for founders and entrepreneurs

Guidance for founders and entrepreneurs, including advice on business planning, marketing, and legal issues.

  - 1. Business plan template
  - 2. Market research report
  - 3. Financial projections
  - 4. Business plan checklist
  - 5. Business plan examples

### 3 Statistics and company information

Statistics and company information, including data on business performance, market trends, and industry outlook.

  - 1. Business plan template
  - 2. Market research report
  - 3. Financial projections
  - 4. Business plan checklist
  - 5. Business plan examples

### 4 Education and information

Education and information, including articles, videos, and webinars on business topics.

  - 1. Business plan template
  - 2. Market research report
  - 3. Financial projections
  - 4. Business plan checklist
  - 5. Business plan examples
- ## Business plan template
- ### 1 Business plan template

Business plan template, including a comprehensive guide to writing a business plan.

  - 1. Business plan template
  - 2. Market research report
  - 3. Financial projections
  - 4. Business plan checklist
  - 5. Business plan examples

### 2 Business plan examples

Business plan examples, including sample business plans for various industries.

  - 1. Business plan template
  - 2. Market research report
  - 3. Financial projections
  - 4. Business plan checklist
  - 5. Business plan examples

### 3 Business plan checklist

Business plan checklist, including a list of items to check off when writing a business plan.

  - 1. Business plan template
  - 2. Market research report
  - 3. Financial projections
  - 4. Business plan checklist
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### 4 Business plan examples

Business plan examples, including sample business plans for various industries.

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# Inventor and entrepreneur resources by state

Resources and assistance in your state for filing for a patent or registering a trademark

- Free patent and trademark legal assistance
- Learn to search inventions and trademarks
- Attend events in your region
- Network with inventor and entrepreneur organizations in your state
- Accessible via [uspto.gov](http://uspto.gov) homepage
  - New to IP? Find help in your area



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>> Elizabeth Dougherty: That state page will directly link to resources in your area, which includes our Patent and Trademark Resource Centers.

# Patent and Trademark Resource Centers (PTRC)

Nationwide network of public, state, and academic libraries that are designated by the USPTO to disseminate patent and trademark information and to support intellectual property needs of the public.

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



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>> Elizabeth Dougherty: We have over 80 Patent and Trademark Resource Centers, located at libraries across the nation. They have a librarian or more than one librarian who is trained in patent and trademark searching. These Resource Centers often offer in-person training and consultations and can help you establish a high-quality patent or trademark search, based upon your idea.



# Pro Se Assistance Program

- Hours of Operation
  - 8:30 a.m. – 5 p.m. (ET), Monday – Friday
- Email
  - [innovationdevelopment@uspto.gov](mailto:innovationdevelopment@uspto.gov)
- Phone
  - 866-757-3848
  - Webpage  
<https://www.uspto.gov/ProSePatents>



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>> Elizabeth Dougherty: We do have a pro se assistance program, which helps those applicants that are filing without the assistance of a patent attorney or agent.

## Free legal assistance

- Patent Pro Bono Program
- Law School Clinic Certification Program

*Applicant(s) must pay for all USPTO fees*



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>> Elizabeth Dougherty: As I mentioned, these things are free, and we also have the opportunity for people to take advantage of free legal assistance.

# Patent Pro Bono Program

## **File and prosecute patent**

**applications:** The program matches financially under-resourced inventors and small businesses with registered patent attorneys.

- 22 regional programs across the country provide matching services.



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>> Elizabeth Dougherty: As a result of the 2011 America Invents Act, we have instituted, in collaboration with partners across the nation, pro bono programs which are covering all of the 50 states, where inventors who are financially under-resourced and meet certain criteria may take advantage of pro bono legal assistance. One can find those on our state resource pages. Because these resources are limited, people have to meet certain criteria, one of which is falling under a certain income cap and having some skin in the game (either through a provisional patent application or having taken a course on our website). And they also have to have more than a mere idea; they have to have an invention that they can bring to the marketplace.



>> Elizabeth Dougherty: A corollary to our patent pro bono program is our law school clinical certification programs, where we have law school students supervised by a registered patent attorney or patent agent that are able to offer reduced cost or free legal services. So, if one is not able to take advantage of a pro bono program in their area, one may be able to apply to and receive assistance from a law school clinic certification program in your area.



# Thank you!

**Elizabeth Dougherty**

Eastern Regional Outreach  
Director

[Elizabeth.dougherty@uspto.gov](mailto:Elizabeth.dougherty@uspto.gov)

571.272.8600

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

>> Elizabeth Dougherty: With that, I know I could talk to you all day about patents, but I don't want to be disrespectful of my colleague Craig, and I am going to turn it over to him to talk to you about the joys of trademarking.

UNITED STATES  
PATENT AND TRADEMARK OFFICE



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# Protecting your trademark in the United States

Craig Morris, managing attorney for  
Trademark Educational Outreach

February 5, 2020

Images used in this presentation are for educational purposes only.



>> Craig Morris: Thanks very much, Liz. Whether you're the largest company in the world or the smallest in the nanotechnology field, one thing is constant: If you hope to take your product to market, to commercialize, you're going to need a trademark. We often say trademarks are the key to commercialization.

## Discussion topics

1. Definitions/types of marks
2. Benefits of federal registration
3. Selecting a mark
4. Filing and registration
5. How to find help



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>> Craig Morris: Here are the five topics that I'm going to be covering. The first is the most basic.



# Discussion topics

## Definitions/types of marks

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[No text for this slide]

## What is a trademark or service mark?

A trademark/service mark is any word, symbol, design, or combination of those that serves to:

1. **Identify** the source of goods/services; and
2. **Distinguish** them from the goods/services of another party.



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>> Craig Morris: What is in fact a trademark or a service mark? It's a word, symbol, design, or combination of those, that identify the source of goods or services and distinguish them from the goods or services of another party.

# Definitions

## **TRADEMARK** for goods/products

- Also seen as “trademark” or “TRADE-MARK”

## **SERVICE MARK** for services

## **Symbols** <sup>TM</sup> <sup>SM</sup> ®

- Not required, but help put public “on notice” of claimed rights



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>> Craig Morris: So, a trademark is for goods or products, and a service mark (as the name suggests) is for services. You've probably seen the symbols <sup>TM</sup>, <sup>SM</sup>, and ®. Those symbols are not required but they do put the public “on notice” as to rights that are being claimed.

The <sup>TM</sup> and <sup>SM</sup> symbols can be used at any time. You could leave today and start using the trademark symbol (<sup>TM</sup>) or the service mark symbol (<sup>SM</sup>), because you are entitled to do so. The only thing that you are not to do is to use the ® symbol, which always means that you have applied to seek federal registration and were successful.

# Types of marks

## Word mark (and slogan)

COCA-COLA

## Special form mark



## Composite mark



## Design mark



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>> Craig Morris: These are the basic types of marks:

- A word mark and, parenthetically, a slogan, because a slogan is simply a longer form of a word mark.
- Now, that wording could be presented in a special form. With "Coca-Cola," you almost recognize it is Coca-Cola by the way the lettering swoops together.
- The third type is what we call a composite mark, consisting of those wordings and a design element.
- Sometimes, your mark may consist simply of designs, so it's a design mark.

Those are the basic types of marks, but there are other types of marks, as well.

## Types of marks

- Configuration (shape)
- Sound
- Color
- Scent
- Motion
- Hologram

In sum, anything that functions as a **source identifier**.



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>> Craig Morris: Here's a list of the other types of marks: configuration, sound, color, scent, motion, and hologram. The basic thing tying all of these together is that they serve the function of being a source identifier, because that, fundamentally, is what a trademark is. It is a source identifier.

## Different purposes, different results

- Domain name  $\neq$  Trademark registration
- Business name  $\neq$  Trademark registration



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>> Craig Morris: Sometimes, someone will say, "You know, I don't think that I need a trademark, because I have my domain name registered." A domain name is important in today's business environment, but it does not give the same rights as a trademark registration.

Similarly, to do business in any state, you do need to have that name registered with the state office but that does not give the same rights as a registered trademark.

# Discussion topics

## Benefits of federal registration

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>> Craig Morris: What are the benefits of federal registration? Before understanding the benefits of federal registration, you need to understand that there are rights coming from the common law.

## Common law trademark

- Trademark that is **used** in commerce in connection with specified goods and services, but **not registered**
- Rights are limited to geographic area (based on use in that area).
- Symbols: <sup>TM</sup> <sup>SM</sup> (optional)
- Note: U.S. is a first-to-use country, while most countries are first-to-file countries.



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>> Craig Morris: Any trademark that is used in commerce in connection with specific goods or services will give what we call common law rights. Those are rights in the common law, but they are not registered. Common law rights are different from federal registration rights, because they are limited to the geographic area in which the mark is being used.

Even under the common law, you are able to use the <sup>TM</sup> and <sup>SM</sup> symbols, but you never use the ® symbol, because that indicates that you have successfully registered the mark at the USPTO.

The United States is a first-to-use country in terms of giving common law rights, while most other countries are first-to-file countries.



## Federally registered trademark

- Legal presumption that registrant owns the mark in all 50 states and U.S. territories (but **not** other countries)
- Legal presumption of right to use the mark
- Public notice of ownership of mark
- Permits use of federal registration symbol: ®



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>> Craig Morris: What's the distinction between the common law and the federally registered trademark? The federal registration gives the legal presumption that you are the owner in all 50 states and U.S. territories. But always remember that it is only within the federal system. It does not give you rights in any other country.

## Federally registered trademark

- Automatic listing in the USPTO database
- Right to bring legal action concerning mark in federal court
- Use as a basis for foreign filing (e.g., under the Madrid Protocol)
- Recordation with U.S. Customs and Border Protection, to help prevent importation of infringing products



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>> Craig Morris: Some other points are listed there. The last point is sometimes very important, depending on the nature of your business: If you're aware of counterfeit goods coming into the country, it may be very helpful to have your U.S. trademark registration also recorded with U.S. Customs and Border Protection. That is the only way that they are able to keep counterfeit goods coming in. There must be a U.S. trademark registration recorded with U.S. Customs and Border Protection.

# Discussion topics

## Selecting a mark

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>> Craig Morris: Once you're aware that a federally registered mark is what you're ultimately interested in, it's important to consider important topics when looking at selecting a mark.

## Mark selection challenges

- Not every mark is registrable.
- Not every mark is enforceable.
- Even if a mark is registered, another party may be able to assert superior common law rights.



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>> Craig Morris: First, you need to be aware that there are certain challenges: Not every mark is registrable, not every mark is enforceable, and always remember that even if a mark is registered, someone may claim superior rights based on common law (that claim being based on the fact that the mark was used first).

# Likelihood of confusion

Confusion as to **source**:

1. Are the marks confusingly similar?

- Look alike? Sound alike? Have similar meanings? Create similar commercial impressions?

and

2. Are the goods and/or services related?

- Encountered in the same channels of trade?  
Complementary?



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>> Craig Morris: When you are adopting a mark, one thing to be aware of is that you need to be sure that you are avoiding the likelihood of confusion. What is that? It is confusion as to source of the goods or services. We look at two very specific things: First, are the marks confusingly similar? They could be similar in sound, look alike, have similar meanings, or create similar commercial impressions. Second (many people forget about the second part of the test), are the goods or services somehow related? How could they be related? For example, they could be encountered in the same channels of trade or could be complementary goods or services, by being used together in some manner. The important point is that identical trademarks can actually co-exist in the marketplace, because the goods or services simply are not related.

# Suggestions for searching

On your own:

- USPTO database
  - TESS (Trademark Electronic Search System)
  - [www.uspto.gov/SearchTrademarks](http://www.uspto.gov/SearchTrademarks)
- The internet
  - Only option for searching for common law use



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>> Craig Morris: How do you avoid the possibility of a likelihood of confusion? You have to do a trademark search. One option is that you do this on your own. First, by using the USPTO database: that is the Trademark Electronic Search System, or TESS, for short. It's important to note what TESS shows you: It only shows you marks that are federally registered or applied for, contrasted with a search through the internet. Why would you be searching in the internet? It's because that is the only way to find common law use. Common law use based on use alone, not a registration, will never show up in a search of the USPTO database. To do a complete search, you need to also see what marks may be out there, and you are going to do that the same way you would search for many things today: through the internet. That's where you're trying to do a search by yourself.

## Suggestions for searching

Hire a private trademark attorney or search firm:

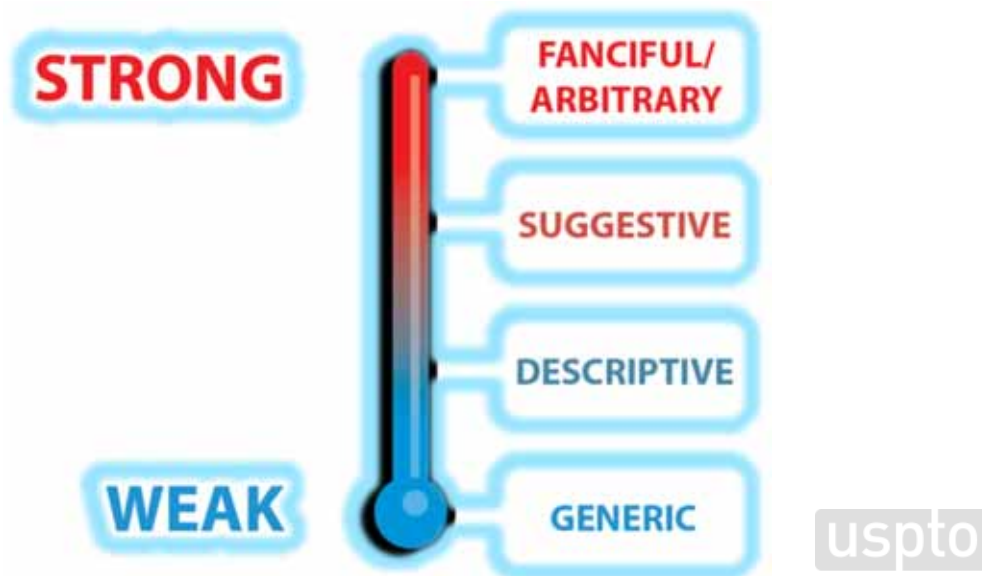
- Full clearance search
  - TESS (Trademark Electronic Search System)
  - State trademark databases
  - Business name registries
  - Foreign trademark databases
  - The internet



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>> Craig Morris: But there are other options. You could hire a private trademark attorney or a search firm, because, as listed here, they're going to do a much broader search, what we would call a full clearance search that gives you a much better sense of whether there is a possible problem with the mark you want to use.

# Strength of mark



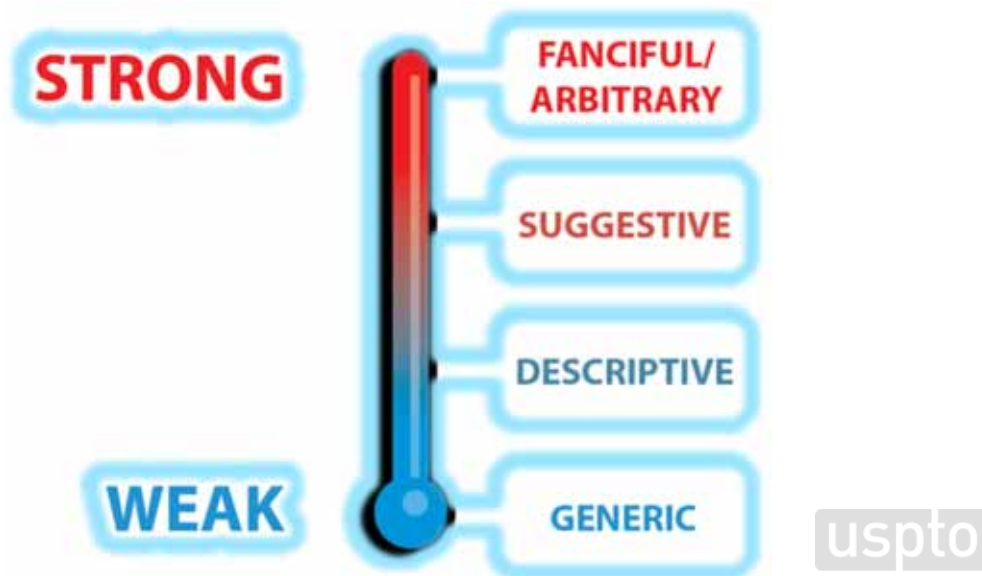
>> Craig Morris: In addition to avoiding a likelihood of confusion, you want to make sure that you're adopting a strong mark. Some marks are strong, and other marks are weak. If you have the opportunity to adopt a strong mark, you certainly want to do so.

The strongest marks are marks that are either fanciful or arbitrary. A fanciful mark is something like "Xerox" or "Kodak," words that never existed in our language until someone created the mark to serve the function of being a source identifier, a source identifier being a trademark. Because they were specifically created for that purpose, they are as strong as possible. An arbitrary mark is something like "apple" or "computers." It's obviously a real word, but the relationship between the mark and the good is totally arbitrary, so it is also considered to be a very strong mark.

A suggestive mark, which is slightly less strong but still acceptable, might be something like "Coppertone" for a sun tan lotion that suggests if you use that lotion, your skin will turn a beautiful copper tone.



# Strength of mark



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>> Craig Morris: Going down the spectrum, some of you get descriptive, and now you're in trouble. A descriptive mark is a mark that, on its face, describes a characteristic, a quality, a function of the goods or services. Descriptive marks are difficult to register. They are difficult to protect, but not impossible. But because they are more problematic, you should always try to be at least suggestive and, even better, be fanciful or arbitrary.

The absolute worst would be at the bottom: if you were adopt a mark that would be considered generic, that is, the actual name for the goods or services. If you were coming up with a new dairy-based beverage, for example, you really couldn't say, my trademark is "milk." "Milk" is simply generic for that product. A generic wording is never registrable as a mark.

# Discussion topics

## Filing and registration

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>> Craig Morris: Once you've adopted a mark that, you believe, won't likely lead to confusion and it will be a strong mark, we hope you will file to seek federal registration. How are you going to do this?

# Filing for federal registration

- Trademark Electronic Application System (TEAS)
  - [www.uspto.gov/TEAS](http://www.uspto.gov/TEAS)
- Basis for initial filing may be:
  - Use in commerce (interstate or between the U.S. and another country)
  - Intent to use (bona fide intent to use in the future)
  - Foreign application
  - Foreign registration



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>> Craig Morris: You would do so through the Trademark Electronic Application System, or TEAS, for short. As of February 15, 2020, you will only have the option of filing through TEAS, because electronic filing is going to become mandatory.

The basis for initial filing may be one of several different options, which are listed here. The most common is "use in commerce" (interstate or between the U.S. and another country). You're also able to file based on "intent to use": You did not use the mark yet, but you do plan to do so in the future. That allows you to file based on "intent to use." You will have to show "actual use" at a later point, in order to move that from "intent to use" to "actual use" to then permit registration. That, at least, allows you to file under that basis.

## Caution: misleading notices

All application data becomes **public information**

Be aware of misleading notices and offers,  
particularly for fees **not** required by the USPTO

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



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>> Craig Morris: One more thing to be aware of: As soon as you file your applications, you're going to start receiving misleading notices. Why is this? It's because all the information within your application becomes public information. Many of the notices that you receive will say that fees are required. Well, these are fees that are not required by the USPTO, but because these notices often look official, some using wording such as "Patent and Trademark Office," based in Washington D.C. We are actually based in Alexandria, Virginia. But if you receive something from the U.S. Patent Trademark Office saying you are required to pay certain fees, it is understandable that sometimes you are misled. So, we have a whole webpage devoted to these solicitations. If there is any question whether something is in fact from the USPTO, we always encourage you: please, check first, call the USPTO, ask, "Is this legitimate?" Unfortunately, because we have no connection with these operations, if you pay money to one of them, we, unfortunately, will not be able to help get your money back.

## Registration responsibilities

- The mission of the USPTO is to register any mark that is eligible for registration.
- NOTE: The USPTO has no enforcement powers.
- It is the right and responsibility of the owner of any registration to enforce its rights.



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>> Craig Morris: As Liz said earlier, the goal of the USPTO is to move things to registration. But with that, always remember that although the mission of the USPTO is to register any mark that is eligible for registration, the USPTO is not an enforcement agency. We have no enforcement powers, and it is your responsibility, as the owners of registration, to enforce your rights.

## Registration responsibilities

- Registration is a sword, not a shield.
- May use registration certificate to support a “cease and desist” letter.



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>> Craig Morris: One way to think of this is that the registration is a sword, not a shield. Just because have you the registration does not mean that someone else will not try to use a similar mark to infringe on your registration. You can use a registration certificate to support a cease-and-desist letter, and it is going to be your responsibility to send that out.

# Post-registration requirements

- Between fifth and sixth years after the registration date, **must** do new filing (Section 8 declaration) to show continued use of mark in commerce.
- May combine with optional filing (Section 15 declaration), if qualify, to claim incontestability.
- Between ninth and tenth years, must do new filing (Combined Section 8 and 9) to show continued use **and** request renewal, with same requirement every ten years.
- USPTO emails reminder notices.



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>> Craig Morris: Once a mark is registered, there are post-registration requirements. Unlike a patent or a copyright that is only good for a set number of years, a trademark actually can last forever on our register, as long as you take the steps to keep the registration alive. Between the fifth and sixth year after registration, you must do another filing to show that you are still using the mark in commerce.

You could also combine that filing (second bullet) with what is known as a Section 15 declaration to claim that the mark is incontestable – that no one is able to challenge the validity of that mark.

Between the ninth and tenth years, you have to do yet another filing, called combined Section 8 and 9, showing that you are still using the mark and you request renewal, and then every ten years, with the same requirement.

To help you with this, we do e-mail reminder notices the first date of the fifth year period and the first day of the ninth period, reminding you that another filing is due to keep your registration alive. So, it's very important to keep your e-mail address current with the USPTO.

# Discussion topics

How to find help

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>> Craig Morris: Finally, how can you find help?



## USPTO resources

- USPTO.gov website
- “Basic Facts About Trademarks” booklet
  - [www.uspto.gov/TrademarkBasicsPDF](http://www.uspto.gov/TrademarkBasicsPDF)
- “Basic Facts About Trademarks” videos
- “Trademark Information Network” (TMIN) videos
- “TEAS Nuts-and-Bolts” videos
  - [www.uspto.gov/TMvideos](http://www.uspto.gov/TMvideos)



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>> Craig Morris: Obviously, the main way to find help today is through the USPTO website. On our website, we have a “Basic Facts About Trademarks” booklet. Maybe you don't want to read a booklet and you're able to watch videos: We have our “Basic Facts About Trademarks” video series, we also have our TMIN video series, and we have “TEAS Nuts-and-Bolts” videos, which will walk you through all the steps of the application.

## Legal resources

The best resource may be an experienced trademark attorney.

The USPTO does **not**:

- Provide legal advice
- Enforce legal rights
- Recommend specific private attorneys



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>> Craig Morris: But sometimes, remember that your best resource may be an experienced trademark attorney, with a footnote that if you are not domiciled in the United States as of August of last year, you are actually now required to use a U.S. attorney.

Finally, noting what the USPTO does not do: We are not able to provide legal advice, we are not able to enforce legal rights, and we are not able to recommend specific private attorneys for you to use.

## USPTO contact

Trademark Assistance Center

Phone: 1-800-786-9199

Email: [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

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



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>> Craig Morris: Finally, our Trademark Assistance Center (either by phone or by e-mail): If you want to see more of what the Trademark Assistance Center is able to do to help you, they have a webpage, as noted here.

That concludes the actual presentation, but I think we have time for some questions.



>> Lisa Friedersdorf: Yes, so we do have a couple of minutes for questions. So, I encourage our listeners and our watchers to type those questions in. To get things started, I would like to ask a few questions. You mentioned that when you are filing utility, design, or plant patents in the U.S., that covers the United States. Is there any relationship between the U.S. and other international patent systems? Is there any collaboration or shared information?

>> Elizabeth Dougherty: That's a great question, Lisa. As I mentioned earlier, and I will repeat, there is no worldwide patent. But one can protect your intellectual property across the globe. There are intellectual property offices in virtually every country, and we collaborate with a number of them, because as our world becomes more global, we do work to harmonize patent laws, trademark laws, intellectual property laws, in general, as we're able to do so. There are several vehicles for collaboration, one of which is the Patent Cooperation Treaty, which assists individuals in filing applications in countries across the globe.



>> Elizabeth Dougherty: There are also other collaborative efforts, one of which I would certainly encourage people to visit our website to learn more about, and that is the Patent Prosecution Highways. These are initiatives between countries, which allow for expedited examination when similar applications are filed in more than one country and the country may take advantage of the search and examination work that is being done by another country.

Talking about resources that are related to international filing, we do have an Office of International Patent Cooperation within the USPTO, and they do have resources available to take direct one-on-one questions.

I would also make mention, anecdotally, of what we hear from our stakeholders about determining where to file abroad. Oftentimes, our stakeholders have made the recommendation that they look to where they plan to manufacture their products, where they plan to sell their products, where their competitors are located. These, oftentimes, are the first locations in which they seek to protect, on an international basis, in a country outside of the U.S. That's just anecdotal information we've heard from stakeholders, but this is a gray area of the law with some complexity, where having a good registered patent attorney or agent could really come in handy.



>> Lisa Friedersdorf: That's great advice. Craig, I want to ask you a question: I found the discussion about the strengths and weaknesses of trademarks really fascinating. And your examples, I think, were very helpful. You mentioned that there can be the same trademarks in different market sectors. How separate do they have to be in order for them not to be considered an overlap?

>> Craig Morris: Remember that the keyword here is "related." So they can be different, yet if they are somehow related, that could be a problem. To highlight the notion of identical marks when there's not a problem: "Dove" for a bar of soap, and "Dove" for an ice cream bar. There is an identical trademark "Dove," yet, clearly, soap and ice cream are different enough that there's no likelihood of confusion.



>> Lisa Friedersdorf: Two entirely different companies.

>> Craig Morris: Two entirely different companies but identical trademarks. But the public is not confused as to the source of the goods. But handbags and clothing items, for example, are clearly different items, yet we're accustomed to designers creating both. So, if a similar mark is used in those fields, then there's a problem. Think when you go into a store, are you used to seeing those goods sold in the same channels of trade? Plus, it's not a big box store, where we sell absolutely everything. So, you use your own experience to think, well, I've seen these goods sold in similar markets, so if I were to encounter a similar trademark, I might be confused.



>> Lisa Friedersdorf: Elizabeth, you mentioned that when you file an application, you can claim "patent pending." Is there any protection associated with that phrase?

>> Elizabeth Dougherty: Not specifically. It goes to what Craig was referencing. You are putting the public on notice by using that term, and that term can be used anytime you have an application pending within the office, and that's whether it's a provisional patent application or a non-provisional patent application. Now, once the prosecution has concluded and you no longer have an application pending (meaning your application has gone abandoned or you have had a patent issued), in the case where a patent has issued, you do see an indication of the U.S. patent number, where you no longer have an application pending. To use the term "patent pending" would be misleading and could cause actual complications.

So, that term, "patent pending," should only be used when there is a pending application of some type, and it does serve that notice function, but one cannot use it, to use Craig's terms, as this word. It's only once those rights are conveyed with an issued U.S. patent that one really has the opportunity to enforce the right, because that is only then that the right has been offered. Now, protection goes back to the earliest time of filing. So, one does have



that time period where the term “patent pending” was used.



>> Craig Morris: For trademarks, it's a little different. You can use the <sup>TM</sup> or <sup>SM</sup> symbol, regardless of whether you have or have not filed an application, and regardless of whether the USPTO ultimately grants. If we refused, it doesn't mean that you can't use the <sup>TM</sup> designation. It is still your trademark. But you're never allowed to use the ® symbol if refused.

>> Lisa Friedersdorf: And how long does it take, typically, in both cases, from the application stage to issuance?

>> Craig Morris: On the trademark side, remember that there are two possible filing bases: "already using" or "intend to use." A file based on "already using" takes about a year. With "intend to use," you are actually controlling the time frame, because you still have to show actual use. So, we have no way of knowing that. But you have the right to request extensions. So, from the time you file and go through all of your extensions, it ends up maybe being about four years, which is helpful because you may still be trying to get your financing, for example, but you have your rights based when you filed that application.



>> Elizabeth Dougherty: In the case of patents, what we call first office action pendency, meaning the time period from when you are filing an application to it being picked up for the first time by a U.S. patent examiner, we are currently running at about 15 to 16 months. That's an average, because it depends upon the technology in which you are filing. If you are filing in an area in which there is a high level of filings, it could be a longer period of time. If you are filing in an area where there are less applications being filed, it could be less. So I caution people that it's an average. Now, our total pendency – meaning the time from filing to a final determination by the agency – is currently running at about 24 months, or two years.

One can actually check where we're at, because we do like to be transparent with our stakeholders and with the public, in general. On our website, we have a number of dashboards: with the patents, trademarks, and some of our other business units, as well. On those dashboards (we use the term "dashboards," because it does look like a series of dials like the dashboard of your car), we put forth, on a regular basis, where we are at with respect to things like our first-office action pendency and our total pendency, because we like to keep the public aware of where we are at with our processing times.



>> Lisa Friedersdorf: I think we've reached the end of our time here, so I first want to thank our guests: Thank you so much for your time today. I learned a lot. I hope that it was very useful to those of you who tuned in today, as well.

I want to just point out that this type of information-sharing is exactly why we started the Nanotechnology Entrepreneurship Network, and we encourage folks who are interested to keep an eye on [nano.gov](http://nano.gov) for more information about events that are related to this network. We also have a mailing list where we're sharing announcements. If you would like to be included on that distribution list, please send an e-mail to [nen@nnco.nano.gov](mailto:nen@nnco.nano.gov).

And thanks again for tuning in. I look forward to working with you, as we continue to grow this entrepreneurship community. Thank you.