When, Why, What of IP for Inventors and Entrepreneurs

Nicholas McFall
USPTO – Texas Regional Office
When, Why, What of IP for Inventors and Entrepreneurs

Agenda

• What is Intellectual Property?
• IP Strategy as a Business Strategy.
• Resources for Small Business Owners, Entrepreneurs, and Independent Inventors.
What do you think is Intellectual Property?
What is Intellectual Property (IP)?

1. Trademarks
2. Copyrights
3. Trade Secrets
4. Patents
Trademarks
EXAMPLES OF TRADEMARKS

✓ Trademarks can be **WORDS**  ✓ Trademarks can be **DESIGNS**

**STARBUCKS**

**NIKE**

**TARGET**
Things Protected by Copyrights

- Songs
- Books
- Movies
- Sculptures

Software 
Source 
Code
Trade Secrets
WHAT IS A TRADE SECRET?
What Is A Patent?

- The grant of a property right to an inventor (USPTO)

✔ The right to exclude others from:
  ✔ Making,
  ✔ Using,
  ✔ Offering for sale, or
  ✔ Selling or Importing the invention in the United States

✘ What is granted is NOT the right to make, use, offer for sale, sell or import, but
  ✔ The right to exclude others from making, using, offering for sale, selling or importing the invention.
3 TYPES OF PATENTS

Utility patents
- Protects how an invention works, functions or is made for 20 years from filing date
  ✓ Process
  ✓ Machine
  ✓ Article of Manufacture
  ✓ Composition of Matter

Design patents
- Protects the way a product or article looks, the ornamental expression for 15 years from the date of grant

Plant patents
- Protects newly invented strains of asexually reproducing flowering plants, fruit trees, and other hybrid plants for 20 years from filing date
One day in 1905, Frank Epperson, an 11-year old, mixed some soda water powder and water and left the mixture on the back porch overnight with the stirring stick still in it.

The temperature dropped to a record low that night and the next day Frank had a stick of frozen soda water to show his friends at school. Later he began a business producing "Epsicles" in seven fruit flavors. The brand name "Epsicles" was later changed to Popsicle® brand.
Wright Brothers Flying Machine

Patent # 821,393 (1906)
Design Patents: Video Game System
Plant Patents

July 28, 1953
P. ECKE
Poinsettia Plant
Filed May 13, 1952
Plant Pat. 1,207
Software Patents

Apple’s Method and apparatus for automatic software replacement [a.k.a. automatic software updates]

Microsoft’s Time based hardware button for application launch [a.k.a double-clicking]
The Path to a Patent

NEW IDEA?

PROVISIONAL APPLICATION (OPTIONAL)

TWENTY YEARS

NON-PROVISIONAL APPLICATION (UTILITY)

ONE YEAR!

PATENT!
What are the risks of disclosure?

- What can I say before filing?
- When do I know I’ve said too much?
- Disclosure vs. Sale
  - Crowdfunding Campaigns
- Can’t I just keep it secret?

Examples of Public Disclosure:
- displaying your invention at a trade show,
- posting your invention on the Internet
- offering to sell your invention
- a description of your invention in a newspaper or journal article, or
- publicly demonstrating your invention.
Provisional Utility Applications

• Simplified filing requirements

• Items required:

  1. Specification - CLEARLY DESCRIBED - in compliance with 35 USC 112, Paragraph (a)
     • enabled, written description, best mode
  2. Drawings (needed in almost all cases)
  3. Filing fee
  4. Cover Sheet identifying Provisional Application
What is patentable?

- NEW, NONOBVIOUS, USEFUL, & CLEARLY DESCRIBED
- Method of using
- Chemical Composition
- Improvements thereof
- Method of making
- Product
Patent "Claims"

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

What information should a patent application claim?

- Too Specific
- Invention
- Too Broad/General

Not valuable
Not patentable
A Housing

...with an opening...

to receive a memory storage device

...wherein the storage device is an optical disc.
Thank You!

Nicholas McFall
Assistant to the Regional Outreach Officer and Primary Examiner
USPTO – Texas Regional Office
nicholas.mcfall@uspto.gov