

# IP CONSIDERATIONS: A PERSPECTIVE ON U.S. PATENT LAW, TRENDS, AND STRATEGIES

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# Types of Intellectual Property

- Trade Secrets
- Copyrights
- Trademarks
- Patents

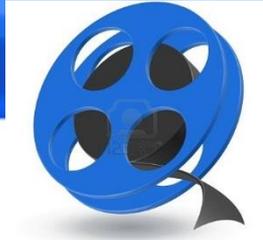


# Trade Secrets

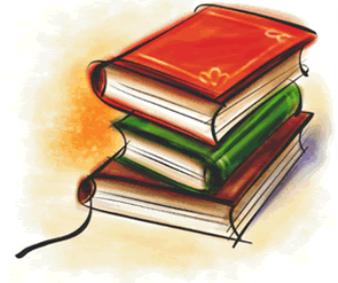
- Secrets that provide competitive advantage
- For so long as it is **kept a secret**.
  - Can last longer than a patent as long as it is a secret.
  - Once the secret is out, anyone can use it.
    - People can reverse engineer your product!
- Examples:
  - Coca-Cola secret formula;
  - Includes: sales methods, distribution methods, consumer profiles, advertising strategies, lists of suppliers and clients, and manufacturing processes

TOP  
SECRET





# Copyrights



- **Original** works of authorship **fixed** in any tangible medium
- Term examples:
  - Author's Life + 70 years
  - 120 years from date of creation (work for hire)



# Trademarks



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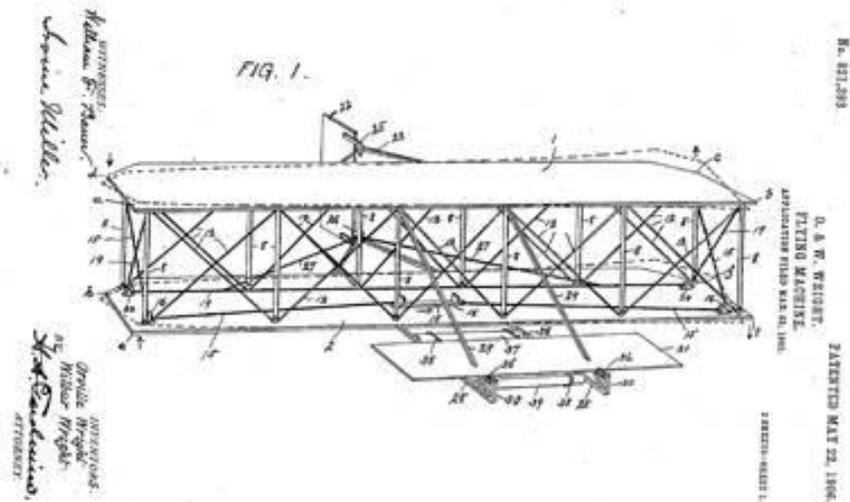
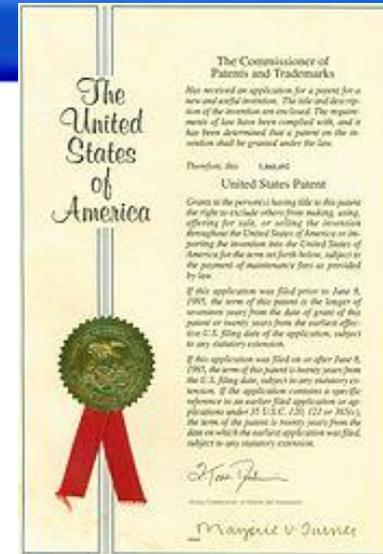
## TM

- **Source Identifiers:**
  - Word, name, symbol, device, sound...to identify the source of the goods and distinguish products
- Branding! Stuff for sale!
- Can last forever with continued use



# Patents

- Inventions
- Right to **EXCLUDE!**
  - Exclude others from making, using, selling, offering for sale, importing....
  - NOT a right to make, use or sell yourself.
  - Jurisdictional -U.S. patents are only enforceable in the U.S.
- In exchange for:
  - Disclosing your invention (and not keeping it a secret all for yourself)
  - Releasing your invention to the public **AFTER** the patent expires



# How Do You Get a Patent?

- Invent, file an application, and convince gov't to grant
- Assignment
- License

# Common Application Types for U.S.

- **Provisional Utility Application**
  - Establishes a filing date for the subject matter included in the application.
  - Allows “Patent Pending” to be placed on product.
  - Expires after 1 year
    - Either convert to utility application within 12 months or file utility application claiming priority to the provisional.
- **Non-provisional Utility Application**
  - Term = 20 years from filing date
  - Includes Divisional Applications, Continuation Applications, and Continuation-In-Part Applications.
- **Patent Cooperation Treaty Application**
  - International application designating the U.S.
  - Must nationalize
- **Design Application**
  - Term = 14 years from issue date
  - The visual ornamental characteristics embodied in, or applied to, an article of manufacture

# Utility\*\* Hurdles to Convince U.S. Gov't

- 1. Patentable Subject Matter
  - Process, machine, manufacture, composition of matter...
- 2. Utility
  - Invention must be useful for some purpose
- 3. Enablement
  - The application must include a clear and concise description of the invention to enable others to make and use the same.
- 4. Novelty
  - Invention must be NEW
- 5. Non-Obvious
  - Invention can NOT be obvious in light of the prior art.



\*\* Comprise 90% of USPTO Filings

# CONGRATULATIONS!



# Utility Patent Contents

- Drawings
- Description
- **CLAIMS!**
  - The description and drawings are provided to support the claims.
  - **The elements of the claims define what is protected.**

# Claims and Infringement

- To see if something is infringing a patent you compare the **device** (used by company A) to the patent **claims** (owned by company B).
  - Do **NOT** compare the **product** to the **product**.
  - The device must include **ALL of the elements of the claim!**



# Strategies for Avoiding Infringement

## Company desires to make, use, sell...

- **Conduct Search**
  - issued patents/publications
  - Shelves of Walmart?
    - Majority of inventions that are patented never even come to market.
- **Analyze claims** for possible infringement
  - Does the product include each and every element of the claim?
  - Review prosecution history.
- Get **opinions of** non-infringement/invalidity by patent counsel.
- Benefits:
  - Minimize risks for costly patent infringement defense.
  - Shield against a finding of willful infringement (avoiding higher damages in infringement case).
  - Helps Company decide whether they should move forward with development or market of a product (or design around).

# Trending Now: Patent Reform

*Leahy-Smith America Invents Act (“AIA”)*

Sept. 16, 2011





**What changed?**

# \*\*\*First to File (Disclose)\*\*\*

- Effective March 16, 2013
- 12-month grace period for public disclosures by inventor
  - Caveat: may jeopardize foreign rights



# Assignee Applicants

- Employers may file applications w/out inventor signatures so long as:
  - Inventor assigned to employer
  - Inventor under obligation to assign to employer
- Minimizes paperwork
- Allows employers to file applications after employee leaves

# Prioritized Examination (Track One)

- \$4,000 fee (\$2,000 for small entity)
- Limited to 3 independent claims
- No Extensions of Time
- Final disposition within 12 months
  - Attractive for venture capitalist funding
  - Attractive for small business and individual inventors

# Pre-issuance Submissions of Prior Art

- Any 3rd party may submit written prior art in a pending application of another (e.g., a competitor)
  - Need to include concise description of the asserted relevance of each prior art document submitted
  - before (1) the later of (i) 6 months after the date of publication or (ii) the date of a first Office action on the merits rejecting any claims, or (2) before the date of a notice of allowance, if earlier
  - first 3 prior art references are free
  - up to 10 prior art references for \$180

# Post-AIA Filing Strategies

- **Consult patent attorney early on**
- “File early and often”
  - Ideally before prototype built
  - Can’t rely on notebooks anymore (first-to-file patent system)
- Patentability studies still useful
  - Consider conducting after filing provisional
- File serial provisionals as invention is tweaked/improved/developed
- Non-publication request in view of trade secrets for US only
- Look to claim pre-AIA priority to limit prior art that can be cited against you
- PCT applications to buy time for foreign but still get application on file in U.S.

# Corporate Considerations

- Streamline invention disclosure process
  - educate inventors
  - establish IP committee
  - consider using reward programs to generate quality v. quantity
- Docket publications
- Vigorous exit interviews

# Other Strategies to Save Time & \$\$\$

- Patent Prosecution Highway (PPH) speeds up the examination process for corresponding applications filed in participating intellectual property offices
- Petition to make special
  - The applicant's age or health (no fee);
  - Enhance quality of the environment;
  - Contribute to the development or conservation of energy resources; or
  - Contribute to countering terrorism

## PPH Partners

The USPTO has PPH arrangements with the following intellectual property offices:

	Australia (IPAU)
	Austrian Patent Office (APO)
	Canada (CIPO)
	Denmark (DKPTO)
	European Patent Office (EPO)
	Finland (NBPR)
	Germany (DPMA)
	Hungary (HPO)
	Japan (JPO)
	Korea (KIPO)
	Russia (ROSPATENT)
	Singapore (IPOS)
	Spanish Patent and Trademark Office (SPTO)
	United Kingdom (UKIPO)

# Thank You

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