



IEEE Power Electronics Society
Santa Clara Valley Chapter

A guide to the U.S. Patent system,
what every engineer needs to know

David Pressman
22 January 2009

Biography

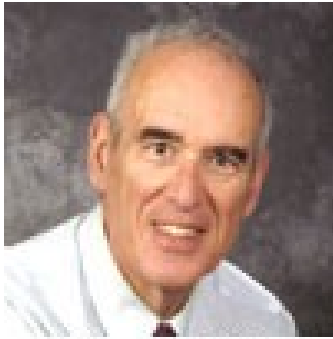
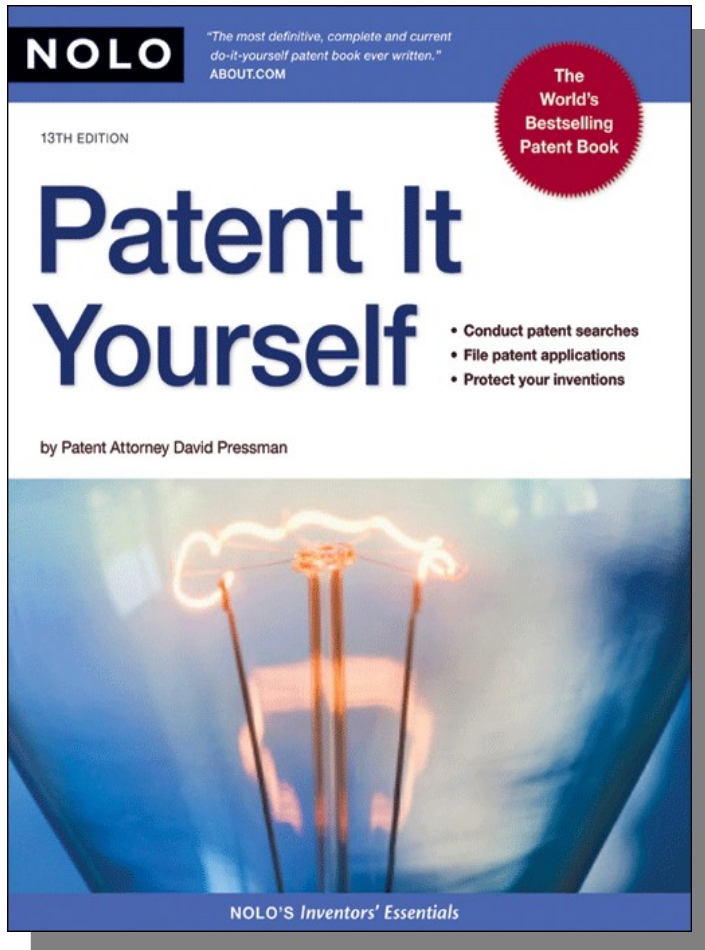


Photo: Zac Wittmer

- David Pressman
 - San Francisco Patent Attorney
 - 40+ years of experience
 - Patent examiner
- Penn State University (BSEE)
- George Washington University Law School (JD)
- University instructor
- Columnist
- Best selling author

Books

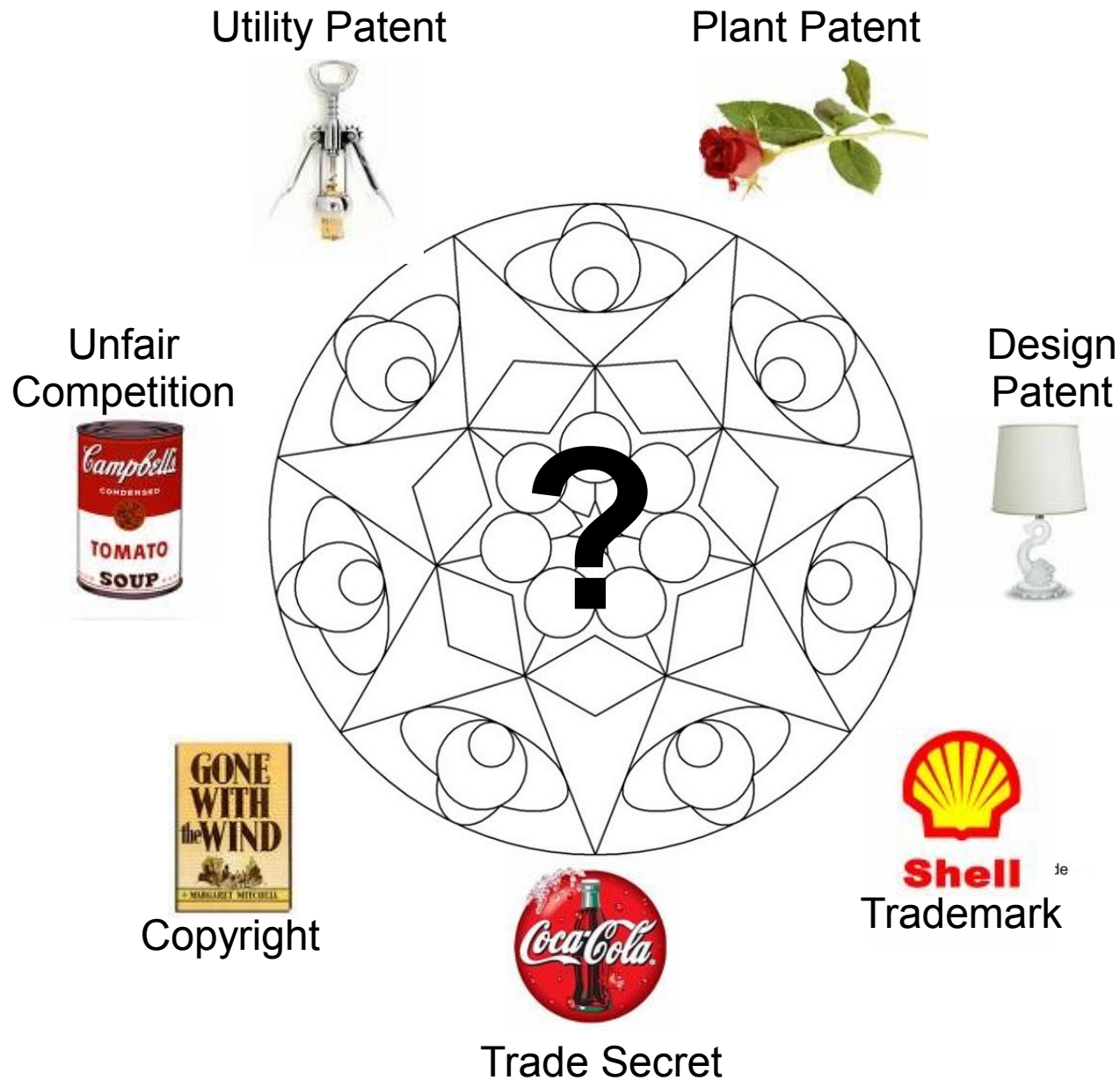


- Nolo Press
- 592 Pages
- 13th edition
- Other Titles by David
 - Patent pending in 24 hours
 - The Inventor's Notebook
 - How to Make Patent Drawings
 - Nolo's Patents for Beginners

Agenda

- Intro to Patents and IP
 - Types of Patents
 - Requirements
 - Deadlines and Durations
 - Common Misconceptions
 - Patent Fees
 - Offensive Rights
- Invention
 - Documentation
 - The PPA
 - Is it Patentable?
 - Selling the Invention
 - Drawings
 - Ownership and Licensing

The Intellectual Property Mandala



What's the Difference

| What's the Difference: Utility Patents, Design Patents, Copyright, Trade Secret and Trademark | | | |
|--|--|---|---|
| If, after reviewing this guide, you conclude that a patent isn't for you, don't give up; there may be other forms of legal protection for your idea—including copyright, design patent, trade secret, or trademark law. The chart below provides a comparison. You can find more information about each form of protection (and how to acquire it) at the Nolo website, www.nolo.com . | | | |
| | What's Protected? | Examples | Protection lasts for: |
| Utility Patent | Inventions, including machines, compositions, processes, articles of manufacture, and improvements on inventions | iPod, chemical fertilizer, process of manipulating genetic traits in mice, ironing board | 20 years from the date of filing regular patent application |
| Design Patent | Ornamental (non functional) designs for useful objects | Unique shape of electric guitar, design for floor lamp | 14 years |
| Copyright | Books, photos, music, recordings, fine art, graphic images, videos, films, architecture, computer programs | <i>The DaVinci Code</i> , (book and movie), Andy Warhol prints, Michael Jackson's <i>Thriller</i> (music recording, artwork and video), architectural plans for Trump Tower, Microsoft Windows operating system | The life of the author plus 70 years (or for some works, 95 years from first publication) |
| Trade Secret | Formulas, methods, devices or compilations of facts or any information which is confidential and gives a business an advantage | Coca-Cola formula, survey methods used by professional pollster, buying habits of ethnic groups, new invention for which patent application has not been filed | As long as information remains confidential and functions as a trade secret |
| Trademark | Words, symbols, logos, designs, slogans or devices that identify and distinguish products or services | Coca-Cola name and distinctive "wave" logo, Good Housekeeping seal, Pillsbury doughboy character | As long as business continuously uses trademark in connection with goods or services |

RESAM

- **R**ecord conception, building and testing, if possible – consider PPA but note disadvantages
- **E**valuate commercial potential
- **S**earch patentability
- **A**pplication: file in PTO
- **M**arket it to a suitable manufacture

The USPTO



- Who they are
- What they do
- Patent examiners
- <http://uspto.gov/>
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Patents from 1790 through 1975 are searchable only by Issue Date, Patent Number, and Current US Classification.

When searching for specific numbers in the Patent Number field, patent numbers must be seven characters in length, excluding commas, which are optional.

Done

Invention Disclosure

Sheet 1 of 1

Inventor(s): Irma Inventor

Address(es): 1919 Chestnut St., Philadelphia, PA 19103

Title of Invention: Self-Adjusting Can Opener

To record **Conception**, describe: 1. Circumstances of conception, 2. Purposes and advantages of invention, 3. Description, 4. Sketches, 5. Operation, 6. Ramifications, 7. Possible novel features, and 8. Closest known prior art. To record **Building and Testing**, describe: 1. Any previous disclosure of conception, 2. Construction, 3. Ramifications, 4. Operation and Tests, and 5. Test results. Include sketches and photos, where possible. Continue on additional identical copies of this sheet if necessary; inventors and witnesses should sign all sheets.

1. I thought of this can opener while at my friend Roberta's wedding last Sunday. I saw the caterer having trouble opening small and large cans with several openers. Thinking there was a better way, I recalled my Majestic KY3 sewing machine clamp and how it was adjustable and thought to modify the left arm to accommodate a can opener head.
2. My can opener will work with all sizes of cans and is actually cheaper than the most common existing one, the UR4 made by Ideal Co. of Racine, WI.
3. My can opener comprises a sliding clamp 10, a pincer groove 12, (etc.) as shown in the following sketch:

4. Sketch:



5. Instead of sliding clamp 10, I can use a special notch as follows:



6. I believe that the combination of sliding clamp 10 and pincer groove 12 is a new one for can openers. Also I believe that it may be novel to provide a frammls head with my whatsit.
7. The Acme KZ122 can opener, mfgd. by Acme Kitchenwares of Berkeley, CA and p. 417 of "Kitchen Tools & Their Uses" (Ready Publishers, Phila. 1981) show the closest can openers to my invention. In addition to the devices already mentioned.

Inventor(s): Irma Inventor

Date: 199X Jul 16

Date: / /

The above confidential information is Witnessed and Understood:

Griselda Hammelfarb

Date: 199X Jul 17

Neonore Zimla

Date: 199X Jul 10

Patentability Mountain

The Four Legal Requirements for Getting a Utility Patent



Is it unobvious?

(Does the novelty produce any new and unexpected results?)

Does it have any novelty?

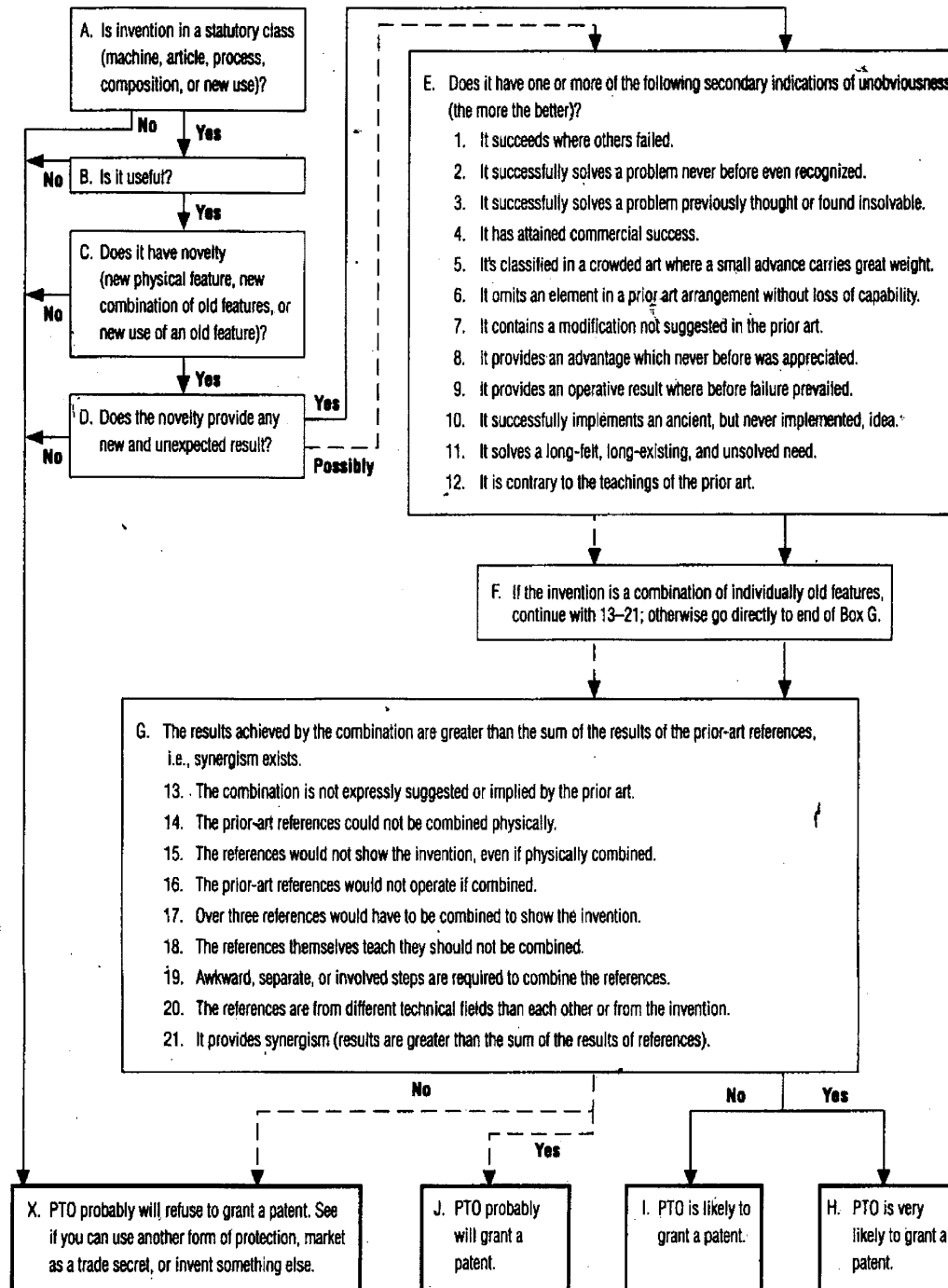
(Is there a new physical feature, a new combination of separate old features, or new use of an old feature?)

Is it useful?

Is it in a statutory class?

(Process, machine, manufacture, composition, new use?)

Patentability Flowchart



Parts of a Patent Application

Patent Application of _____
for _____
TITLE: _____

CROSS-REFERENCE TO RELATED APPLICATIONS _____
FEDERALLY SPONSORED RESEARCH _____
SEQUENCE LISTING OR PROGRAM _____
BACKGROUND OF THE INVENTION—FIELD
This invention generally relates to _____, specifically to _____

BACKGROUND—PRIOR ART
Previously _____

SUMMARY
In accordance with one embodiment, _____

DRAWINGS—FIGURES
Fig 1 is _____

DRAWINGS—REFERENCE NUMERALS
to _____

DETAILED DESCRIPTION—FIRST EMBODIMENT—FIGS. _____
OPERATION—FIRST EMBODIMENT—FIGS. _____
DESCRIPTION—ALTERNATIVE EMBODIMENT—FIGS. _____
OPERATION—ALTERNATIVE EMBODIMENT—FIGS. _____

CONCLUSION, RAMIFICATIONS, AND SCOPE
Accordingly the reader will see that, according to one embodiment of the invention, I have provided _____
While the above description contains many specificities, these should not be construed as limitations on the scope of any embodiment, but as exemplifications of the presently preferred embodiments thereof. Many other ramifications and variations are possible within the teachings of the various embodiments. For example, _____
Thus the scope of the invention should be determined by the appended claims and their legal equivalents, and not by the examples given.

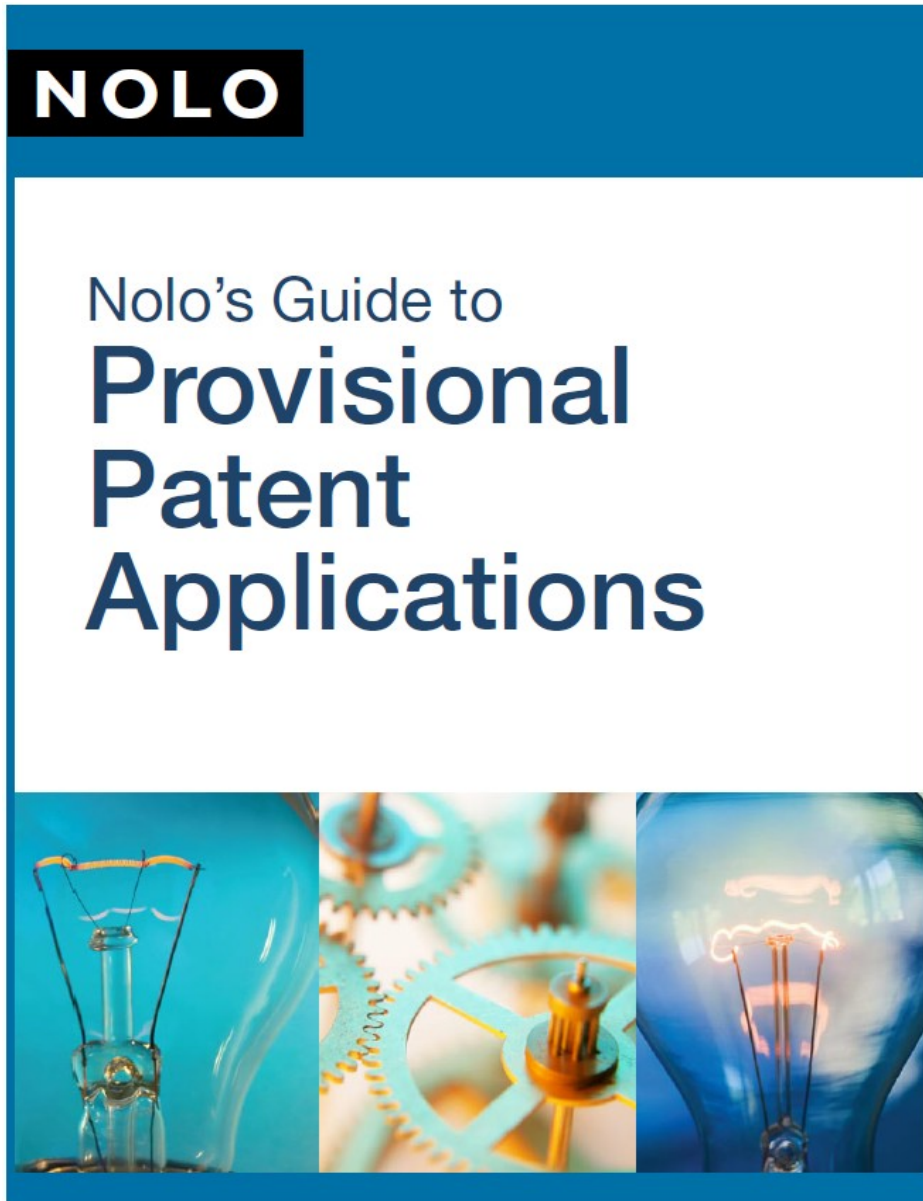
_____ page break _____

CLAIMS:
1. _____
_____ page break _____

SEQUENCE LISTING:
_____ page break _____

ABSTRACT: _____

A Few Words About Provisional Patent Applications



- A relatively simple document – often 5 to 10 pages
- A Provisional Patent Application will NOT, by itself, get you a patent
- Allows you to use “Patent Pending”

Preparing a Patent Application



T. A. EDISON.
Electric-Lights.

Patented April 22, 1879.

Fig. 1.

Fig. 2.

Inventor
Thomas A. Edison
Samuel H. Gorrell

- Witnesses
 Chas. McLean
 Geo. Tindley

Fig. 2.

Witnesses

Charles A. Edison
Levi H. Correll

Inventor

Charles A. Edison
Levi H. Correll

Ways to Profit From Your Invention

Use a contingent-fee (not an up-front fee) Invention broker to find a manufacturer/distributor

Use the contingent-fee invention broker to sell or license the invention to the manufacturer/distributor

Find manufacturer/distributor yourself

Sell or license the invention to the manufacturer/distributor yourself

Have a product made for you by manufacturer

Have product distributed for you

Make product yourself

Distribute product yourself

