

The 411 on Patenting It Yourself

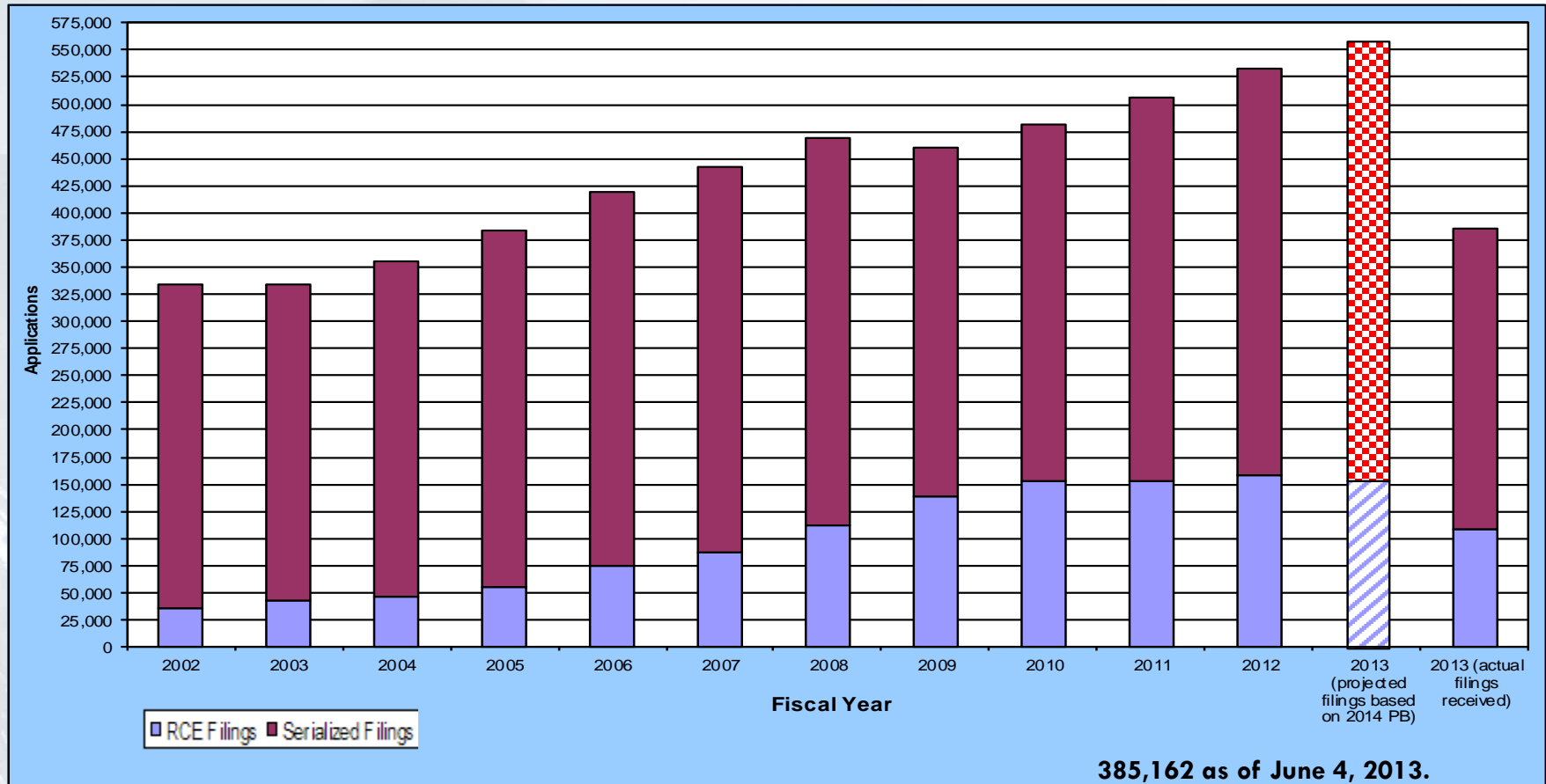
NCET2 Webinar



Elizabeth Dougherty
Director of Inventor Education,
Outreach, and Recognition
July 31, 2013



Total Serialized and RCE Filings FY 2002 – FY 2013 (through June 4)

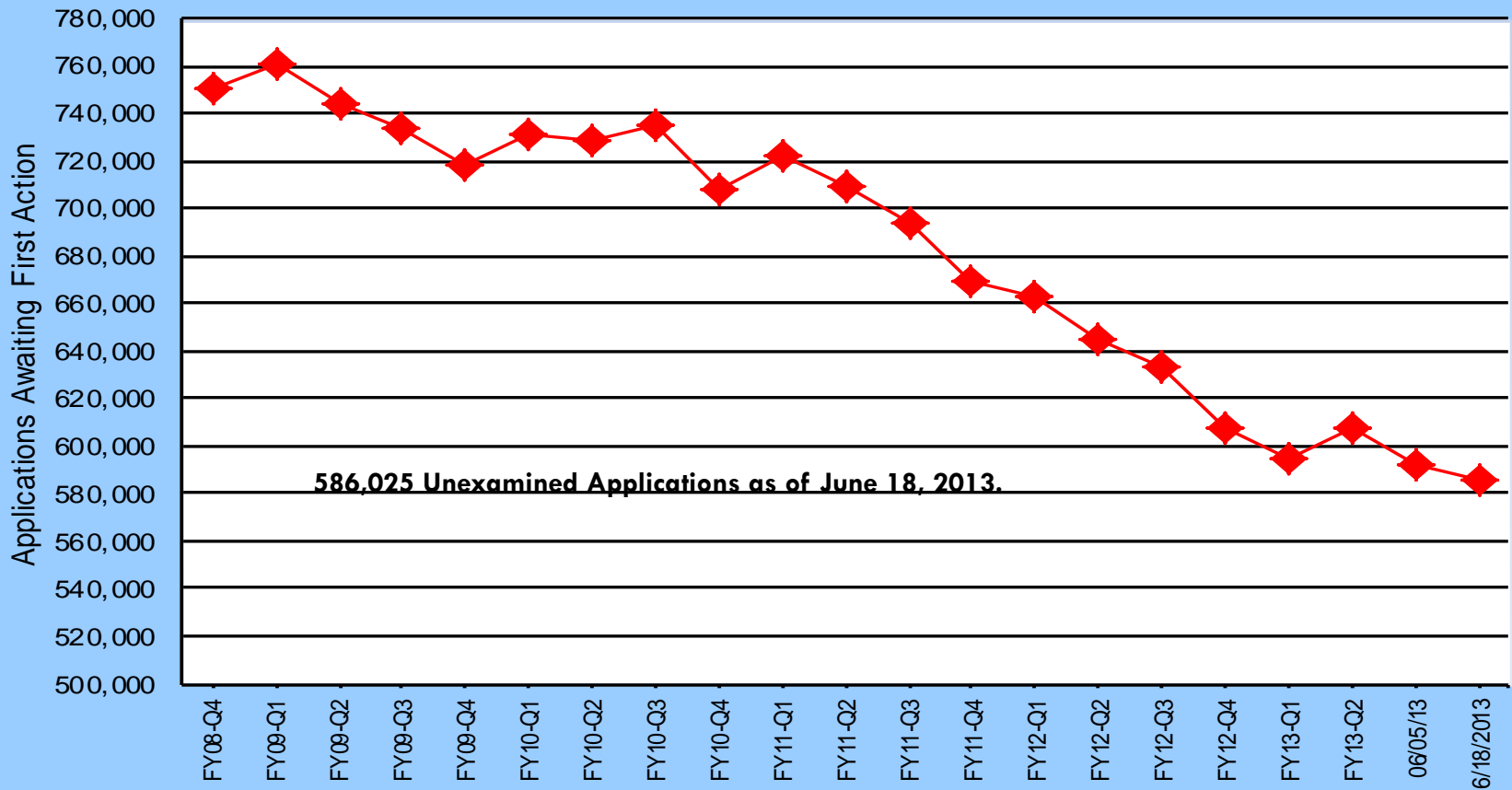


FY 2013 Target based on FY 14 President's Budget model (5% Projected Growth over FY 2012). Serialized filings in FY 2013 are projected to grow 7.2% over FY 2012. RCE filings are projected to have negative growth of -0.8%, compared to FY 2012.

FY 2012 Results: 5.2% total UPR growth rate over FY 2011. Serialized filings grew 6% over FY 2011. RCE filings grew 3.3% over FY 2011.



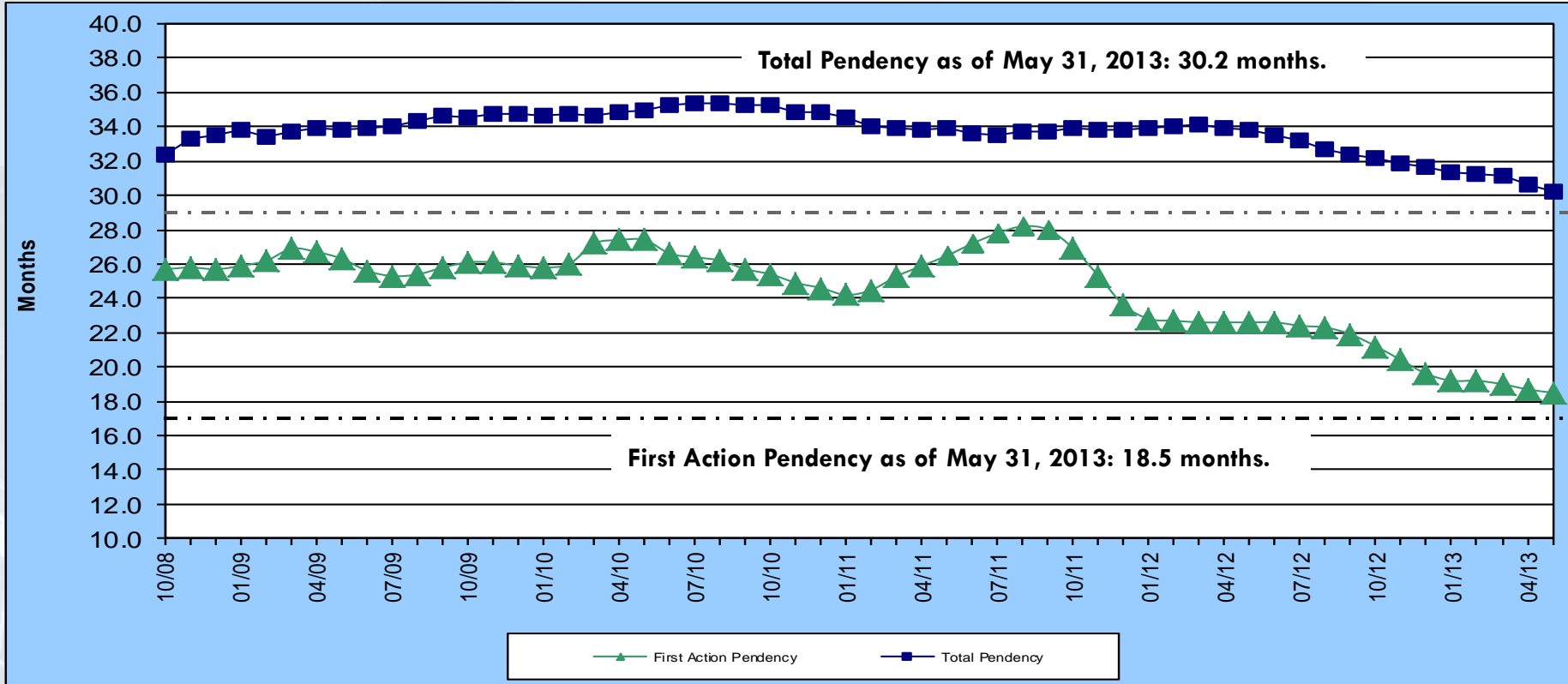
Unexamined Patent Application Backlog FY 2009 – FY 2013 (through June 18th)



End of Fiscal Year 2012 backlog was 608,283.



First Action Pendency and Total Pendency FY 2009 – FY 2013 (through May)

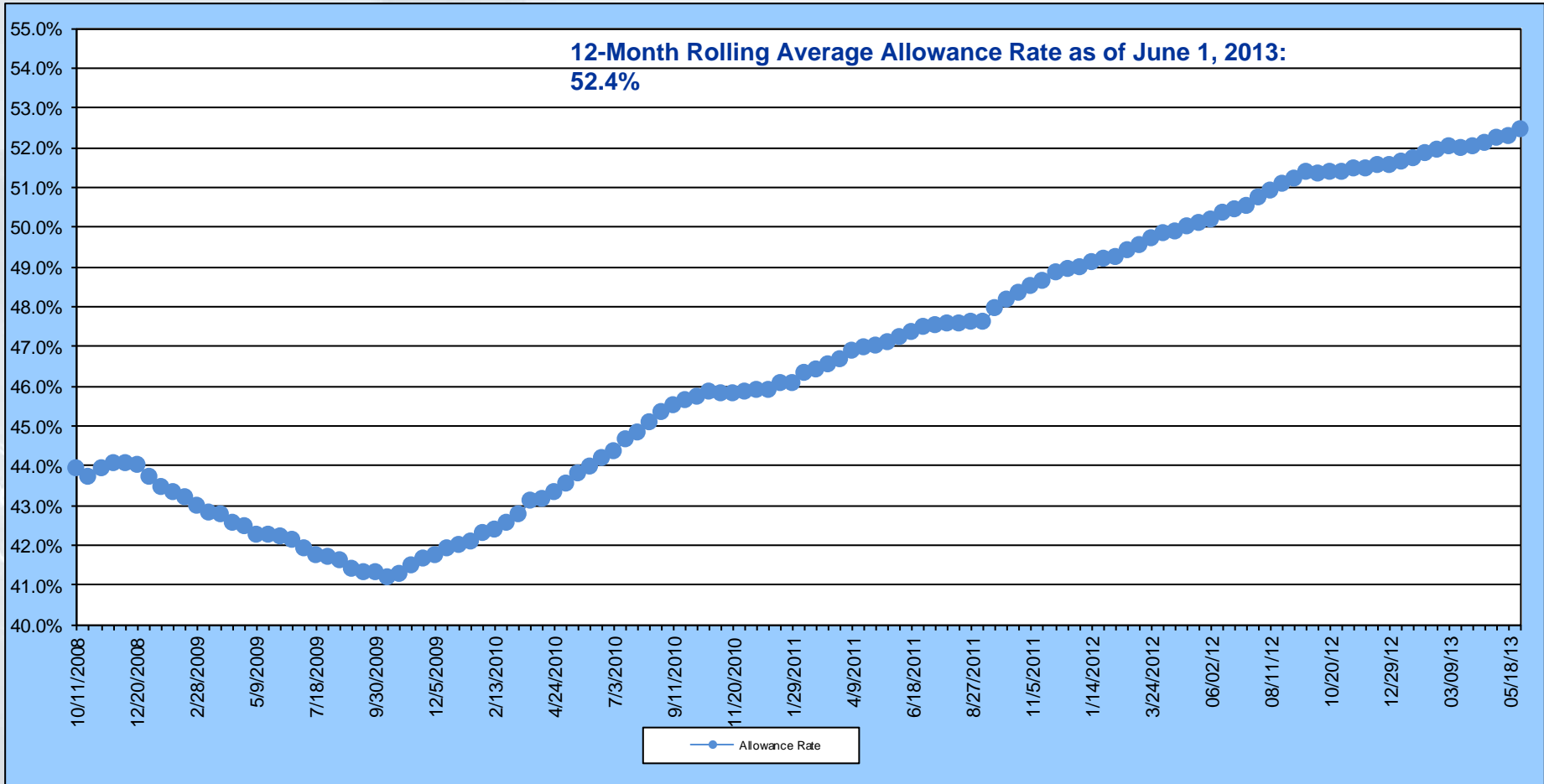


Average Total Pendency FY 2012 Target: 34.7 months. Actual result: 32.4 months.
Average First Action Pendency FY 2012 Target: 22.5 months. Actual result: 21.9 months.
FY 2013 Targets:
 - - - - - Average First Action Pendency: 17.3 months.
 - . - . - Average Total Pendency: 29.6 Months.



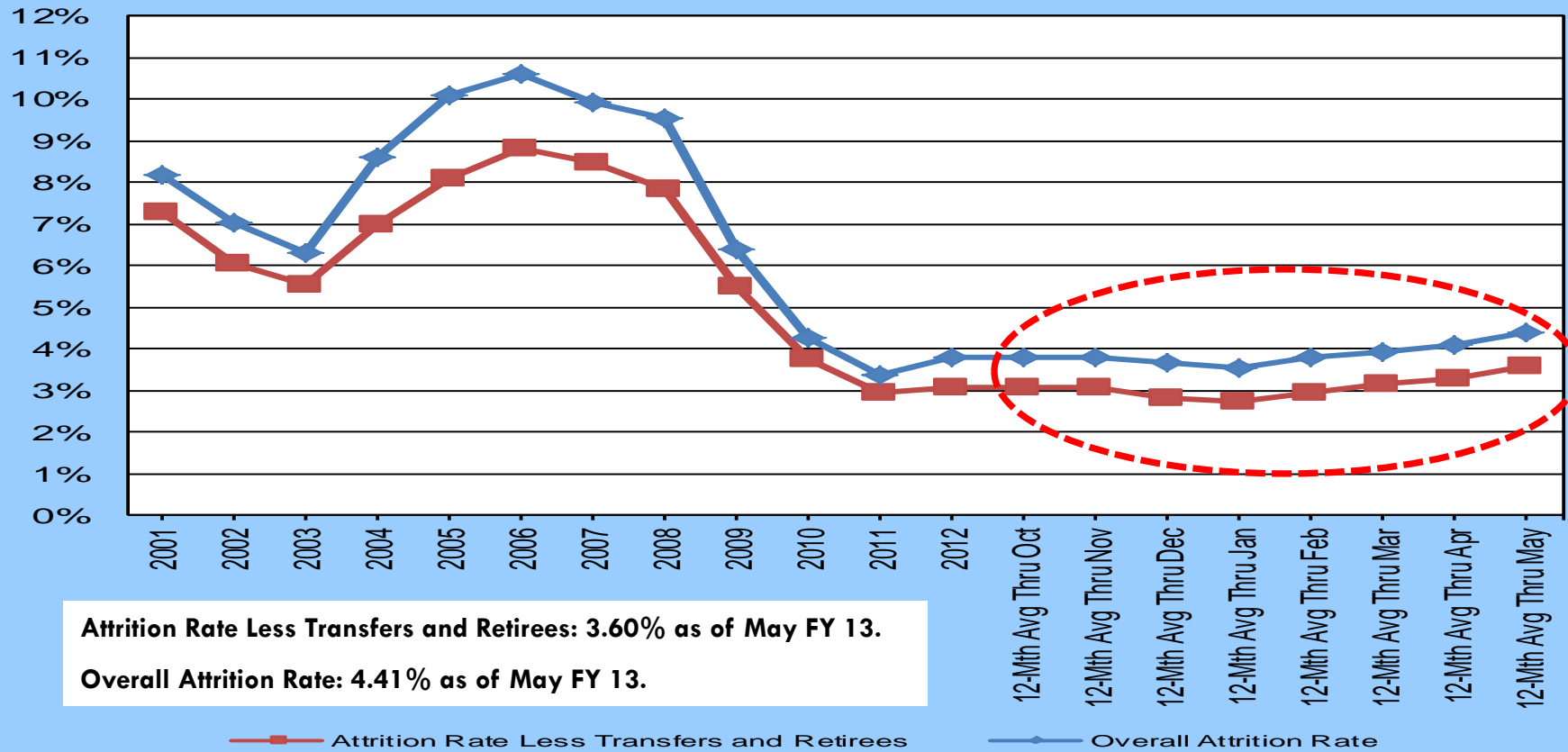
12-Month Rolling Average Allowance Rate, by Bi-Week

FY 2009 – FY 2013 (through June 1)





12-Month Rolling Average UPR Examiner Attrition Rate Less Transfers and Retirees and Overall Attrition Rate FY 2001 – FY2013 (through May)



The oval represents when monthly data begins.



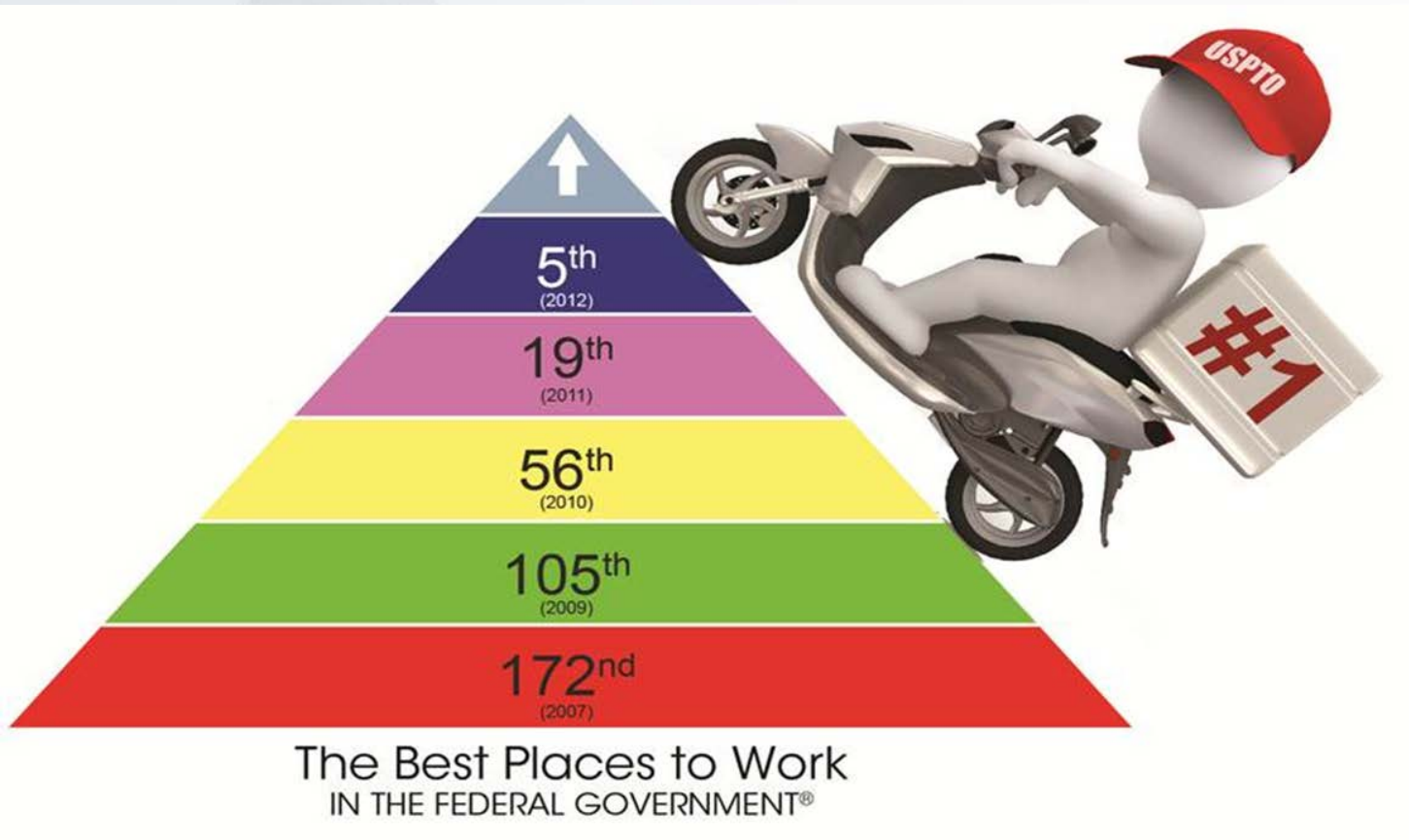
Patent Staffing

- **9,582 total Patents Employees (as of 6/1/13)**
- **7,861 UPRD Patent Examiners on Board (as of 6/18/13)**
- **3,762 Patent Employees Hoteling full time (as of 6/7/13)**





Best Places to Work in the Federal Government®



Patent Examination Overview





Technology Centers

- **1600 Biotechnology and Organic Chemistry**
- **1700 Chemical Engineering/Inorganic Chemistry**
- **2100 Electrical, Data Processing, Computers**
- **2600 Electrical, Communications**
- **2800 Semiconductors, Circuits, Optics**
- **2900 Designs**
- **3600 Mechanical: Construction, Transportation**
- **3700 Mechanical: Games, Guns, and Tools**



Role of the Patent Examiner

- **To safeguard the public interest with respect to intellectual property**
- **To provide direct service and assistance to customers of the office (e.g., applicants and their attorneys or agents, public searchers)**
- **To assist inventors in obtaining patents on new and useful inventions in a timely manner, thereby serving the public through the disclosure of new technologies.**



Duties of the Patent Examiner

- **Locate the most relevant prior art**
- **Determine the patentability of the claimed invention under the conditions for patentability defined by Title 35 of the United States Code**
- **Determine if the application meets other formal requirements established by the Office**
- **Clearly communicate the results of the examination to the applicant**



Patentability Determinations Made by Examiners

- **Utility (35 USC 101):** The claimed invention must be useful.
- **Novelty (35 USC 102):** The claimed invention must not have been done before.
- **Non-obviousness (35 USC 103):** The claimed invention must not only be different from the prior art, the differences between the claimed invention and the prior art can't be obvious.
- **Enablement/written description (35 USC 112(a)):** The specification must adequately describe the invention.
- **Definiteness (35 USC 112(b)):** The claims must be clear.
- **Double patenting (judicially created doctrine):** Only one patent per different invention, unless a TD is filed.



Pre-Examination Processing

Application undergoes Pre-Exam Processing

Examination Processing

Classification determines home for examination

Initial Review

First Action

Applicant Response

Second Action

Applicant Response

Advisory Action

Applicant Appeal Brief

Examiner's Answer

Board of Patent Appeals and Interferences

Post-Examination Processing

Notice of Allowance Sent

Applicant Response Issue Fee Paid

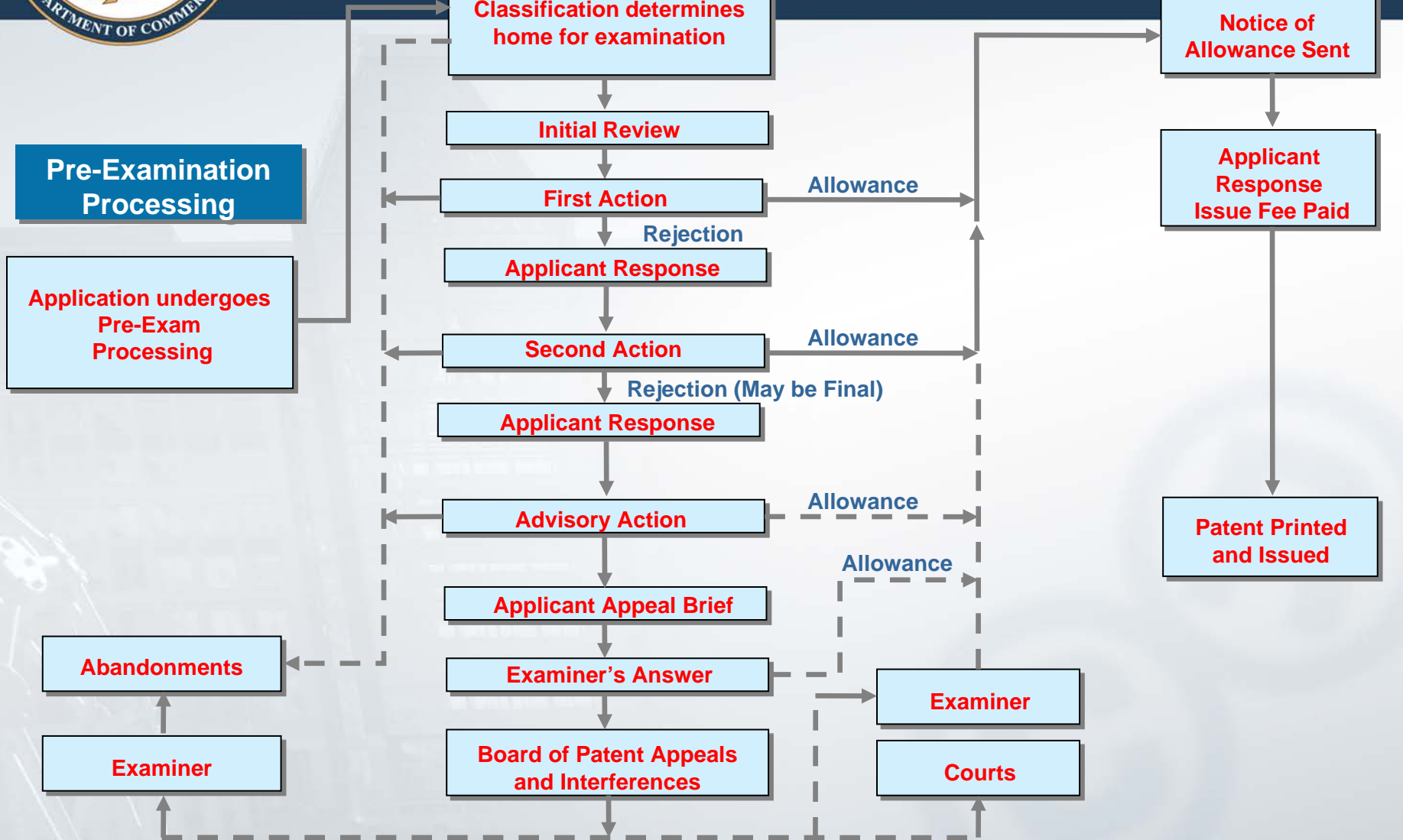
Patent Printed and Issued

Abandonments

Examiner

Examiner

Courts





The Goal – U.S. Patent Grant

The
United
States
of
America



The Director of the United States Patent and Trademark Office

Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.

Therefore, this

United States Patent

Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America for the term set forth below, subject to the payment of maintenance fees as provided by law.

If this application was filed prior to June 8, 1995, the term of this patent is the longer of seventeen years from the date of grant of this patent or twenty years from the earliest effective U.S. filing date of the application, subject to any statutory extension.

If this application was filed on or after June 8, 1995, the term of this patent is twenty years from the U.S. filing date, subject to any statutory extension. If the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121 or 365(c), the term of the patent is twenty years from the date on which the earliest application was filed, subject to any statutory extensions.

Director of the United States Patent and Trademark Office

Ole M. Pearson

Acting

Patent Initiatives for Applicants



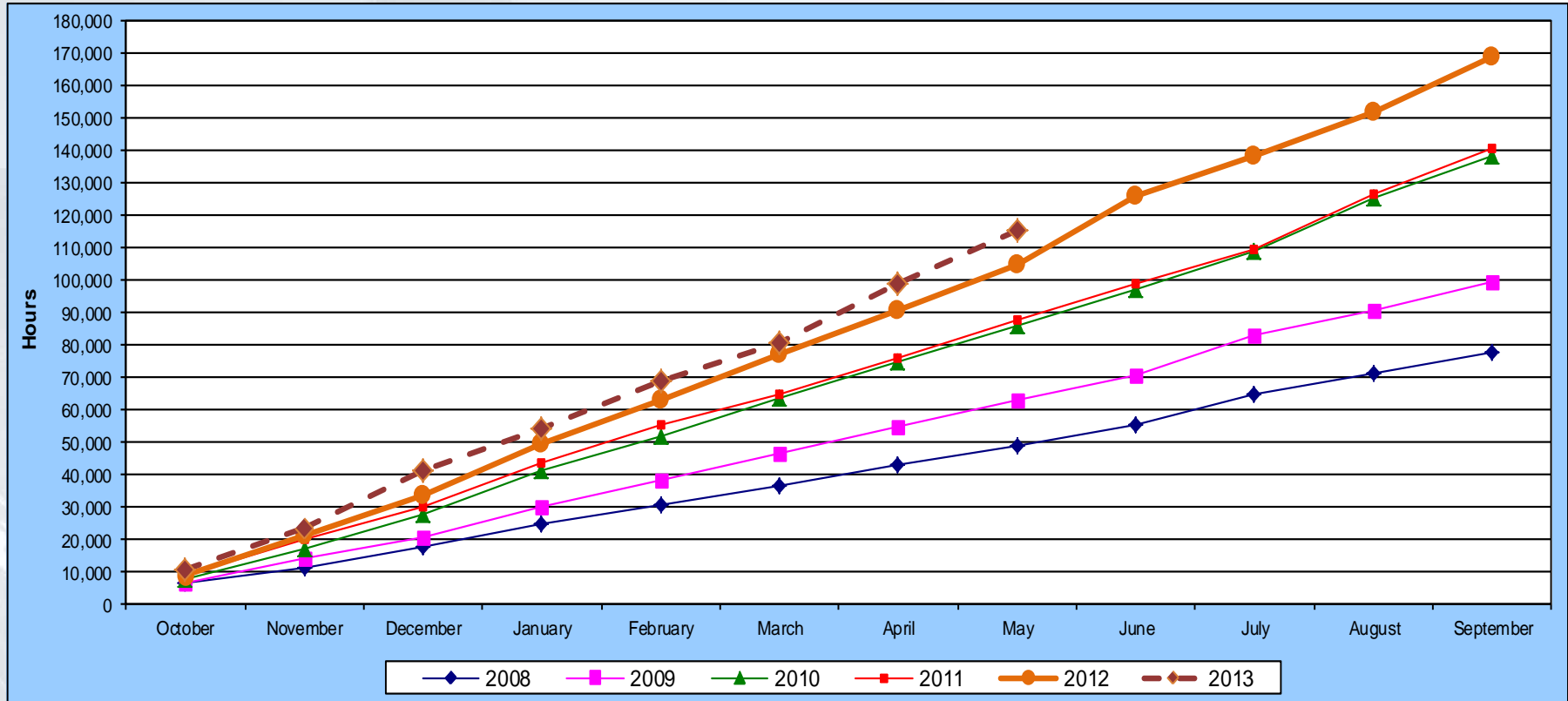


Micro Entity Discount

- Entitled to a 75% discount on fees for “filing, searching, examining, issuing, appealing, and maintaining” patent applications/patents
- 2 ways to be eligible:
 - Limited income and limited number of patent filings; or
 - Employment or assignment to institution of higher education
- Must certify micro entity eligibility before paying a fee in the micro entity amount
- 1,485 UPR applications have claimed micro entity status as of May 24, 2013



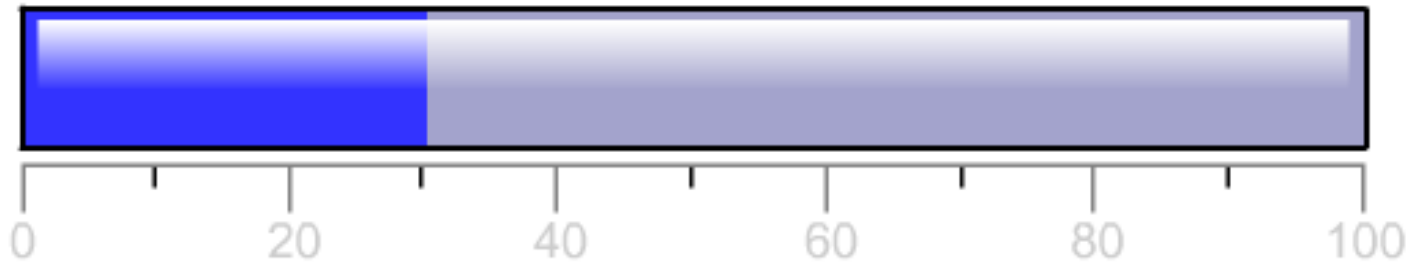
Interview Time FY 2008 – FY 2013 (through May)



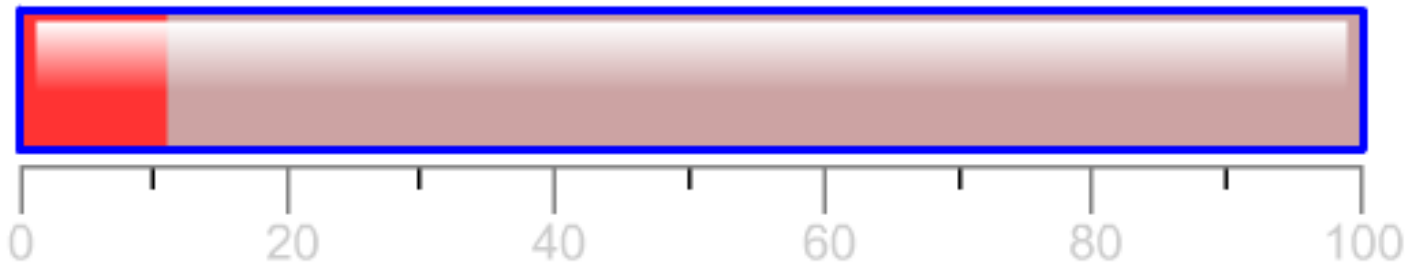
115,498 hours in FY 2013, compared with 104,818 hours in FY 2012, over the same period.



First Action Interview Pilot



FAIP First Action allowance rate = 30.2%



First Action allowance rate in new, non-continuing applications = 11.0%

March 2013



First Action Interview Pilot Program

Application Requirements:

- **Must be a non-reissue, non-provisional utility application under 35 USC 111(a) or national stage application under 35 USC 371**
- **Must contain three or fewer independent claims and twenty or fewer total claims**
- **Must not contain any multiple dependent claims**
- **Must claim only a single invention**
- **Must not have a first Office action on the merits as of the date Applicant requests participation in program**



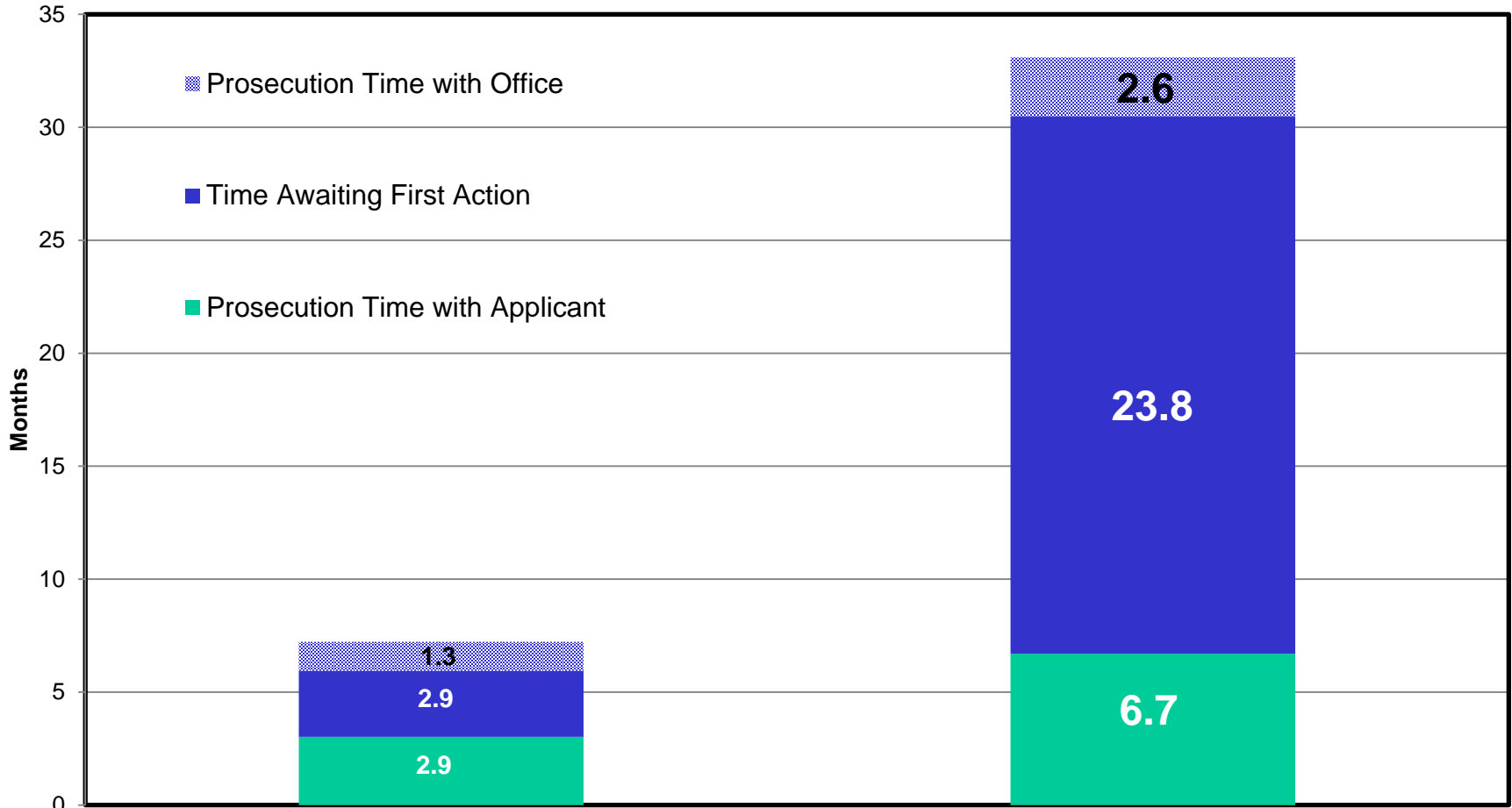
Prioritized Examination (Track One)

- Available for utility, plant, and continuing patent applications and requests for continued examination
 - Not available for international, design, reissue, or provisional applications or in reexamination proceedings
- Requirements:
 - no more than 4 independent claims, 30 total claims, and no multiple dependent claims; and
 - electronically file (utility application); and
 - pay fee

Fee Prior to March 19, 2013	Current Fees
\$ 4,800/\$2,400	\$ 4,000/\$2,000/\$1,000



Prioritized Examination (Track One) Total Pendency vs. Traditional Total Pendency



Track One Terminal Disposals FY 2012

Terminal Disposals FY 2012



Prioritized Examination (Track One) Statistics (through May 16, 2013)

Petitions Filed	% of Decided Petitions Granted	Average Days from Petition grant to first Office action	Average Days from Petition Grant to Final Disposition
10,085	94%	59	176

First Action Completed	Final Dispositions	Allowances	Percent of Petitions From Small Entities	Number of Micro Entity Applications
7,004	4,749	2,354	45%	18



Track One Statistics (through June 5, 2013)

3/8/2013

Petitions Received	October	November	December	January	February	March	April	May	June	July	August	September	Total
FY 11												855	855
FY 12	390	302	285	292	371	442	457	516	436	470	517	559	5,037
FY 13	505	512	576	504	469	1,031	400	503	47				4,547

Percent of Petitions From Small Entities	Number of Micro Entity Applications	Average Days to Petition Decision	% of Decided Petitions Granted	Track One Requests Filed After RCE
46%	36	48.7	94%	594

First Actions Completed	Average Days from Petition Grant to First Office action	Final Rejections	Issues	Number of Abandonments	Number of Allowances	Average Days From Petition Grant to Allowance	Average Days From Petition Grant to Final Disposition
7,344	60.3	2,518	2,129	99	2,472	145	178

Oldest Track One Application Still in Prosecution (days from petition grant)	Oldest Track One Application Without a First Action (days)
580	226

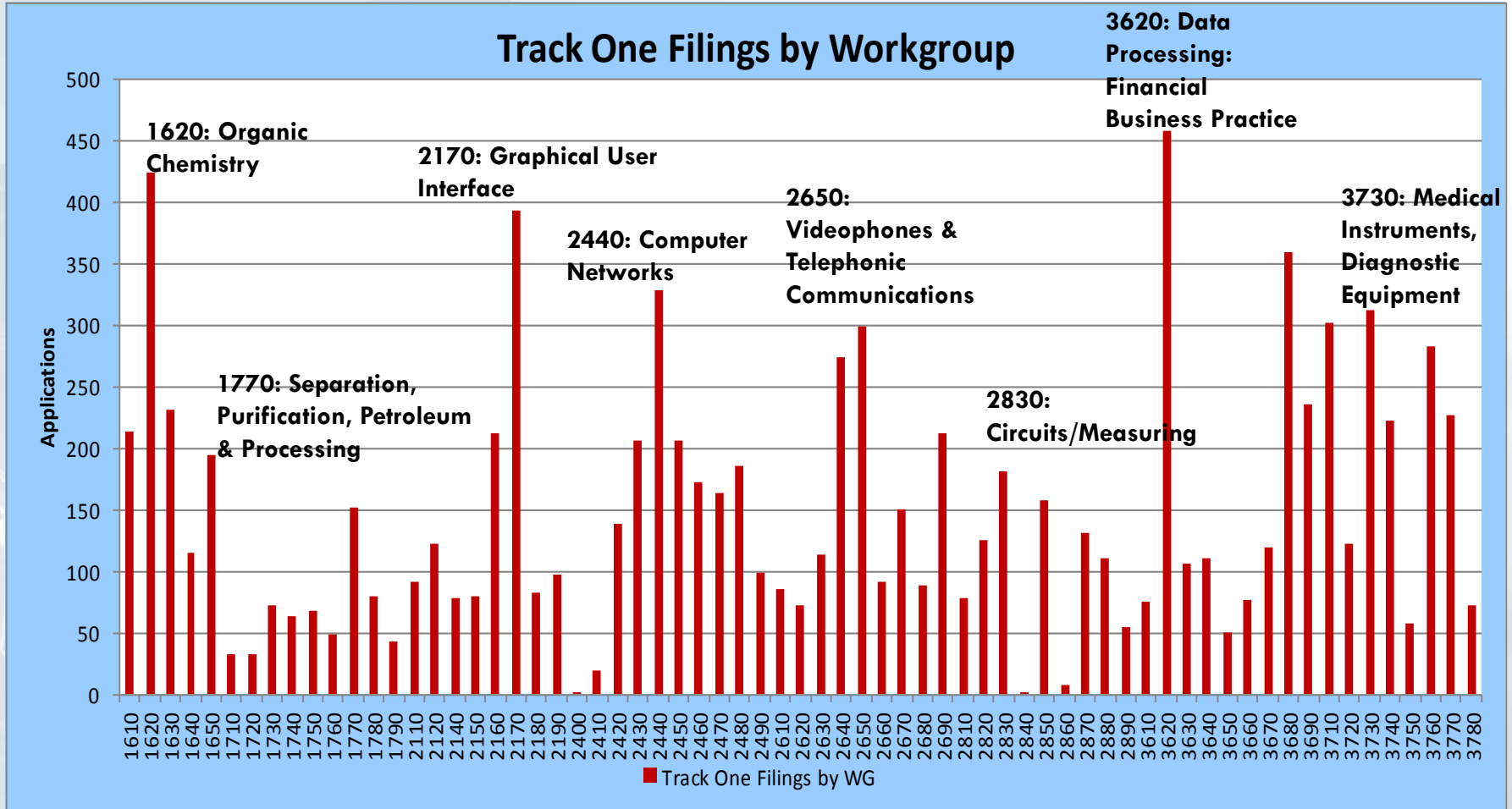
13252902

13624369

First Patent Issued on January 10, 2012 from a September 30, 2011 Prioritized Examination filing



Prioritized Examination (Track One) Filings by Workgroup





Patent Prosecution Highway (PPH)

•What is PPH?

- **When claims are determined to be allowable in the Office of First Filing or earlier examination, a corresponding application with corresponding claims filed in another PPH office is fast-tracked for examination**

•What is the purpose of PPH?

- **Second office can leverage the search and examination results of the first thereby avoiding duplication of work and expediting the examination process**



Patent Prosecution Highway (PPH)

- **Benefits of PPH**
 - **Provides a useful tool to expedite prosecutions of claims toward patentability**
 - **Decreases costs of prosecution**
 - **Provides quicker patentability determinations**
 - **May be particularly attractive to rapidly evolving industries**



Patent Prosecution Highway (PPH)

- **Current U.S. PPH Programs**

Australia

Austria

Canada

China

Norway

Denmark

Russia

Finland

Germany

Hungary

Iceland

Israel

Japan

Korea

Mexico

Columbia

Czech Republic

Nordic Patent Inst.

EPO

Singapore

Spain

Sweden

Taiwan

United Kingdom



Ombudsman

- Enhances the USPTO's ability to assist applicants or their representatives with issues that arise during patent application prosecution.



Contact an Ombudsman by:

<http://www.uspto.gov/patents/ombudsman.jsp>



Patent Ombudsman Program

- **AIA requires a Patent Ombudsman Program to provide patent filing support and services to small business and independent inventors**
- **Resource for applicants that facilitates complaint-handling when applications have stalled in the examination process**
- **Tracks complaints to ensure each is handled expeditiously**



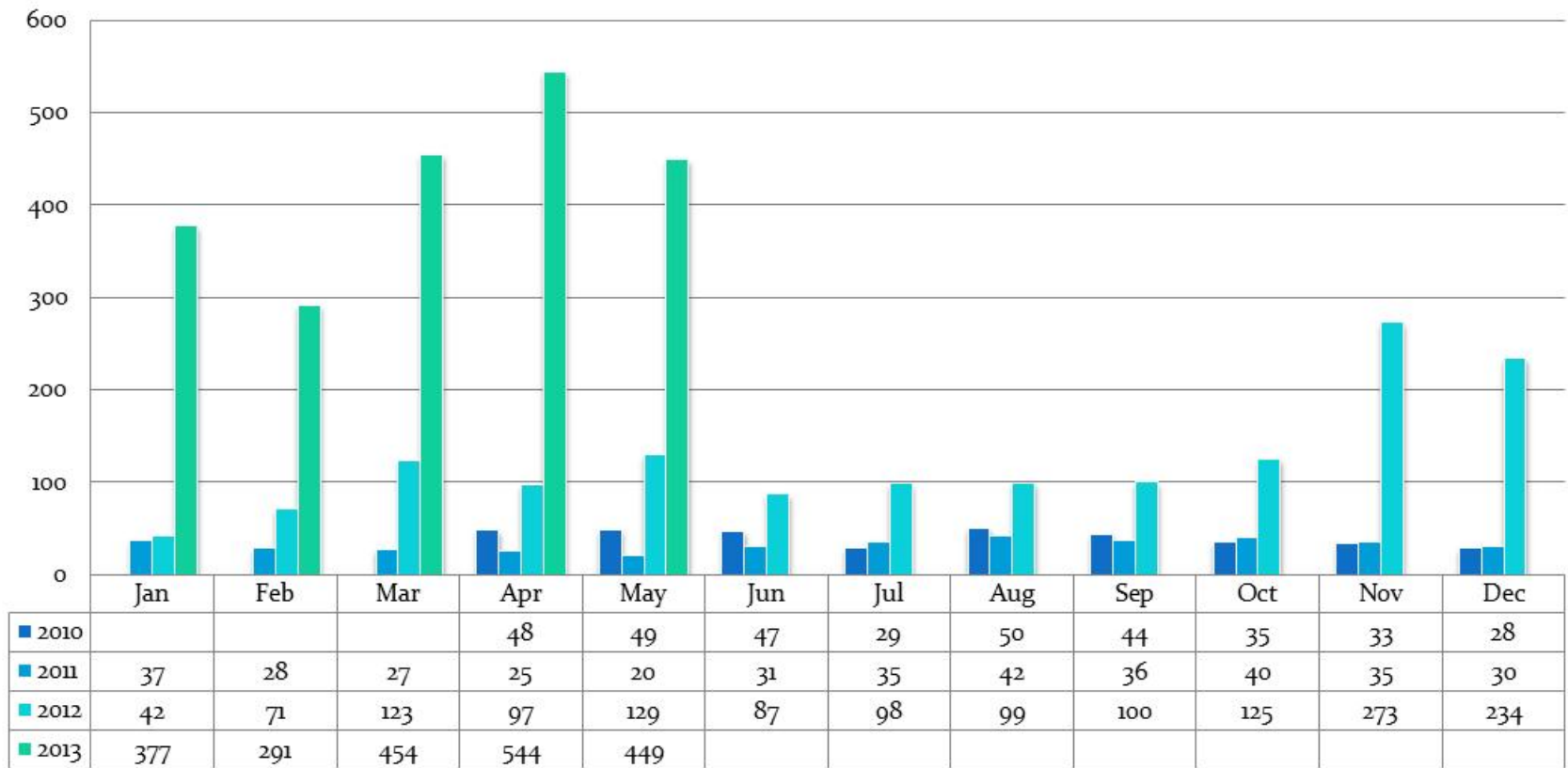
Patent Ombudsman Program

- **1579 inquiries received in FY 2012**
- **Inquiries related to:**
 - **After Final**
 - **Customer Service**
 - **Petitions**
 - **Certificates of Correction**
 - **Application Prosecution Concerns**



Ombudsman Year in Review

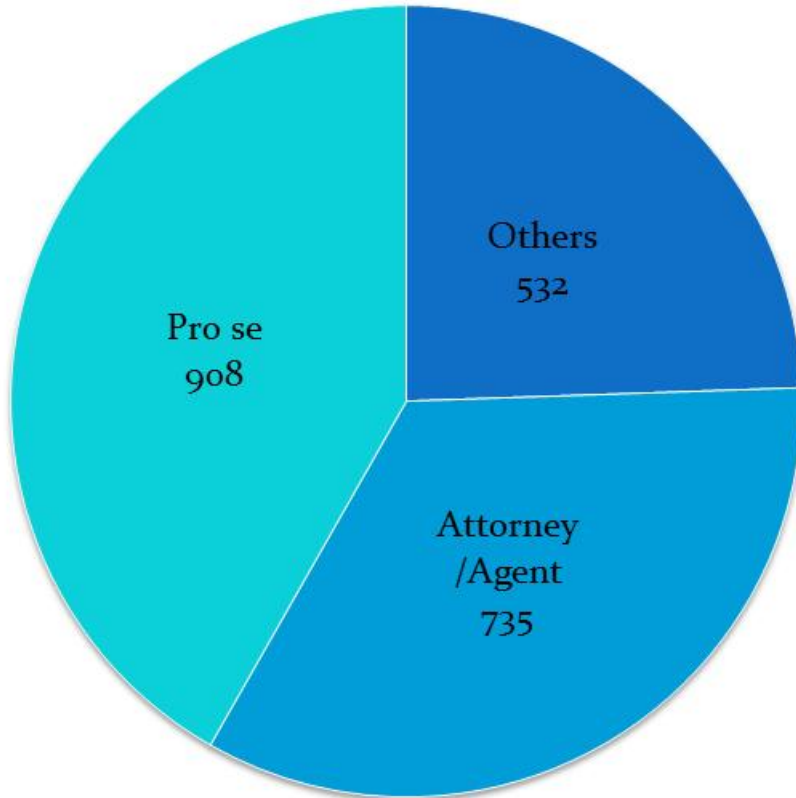
Inquiries by Month



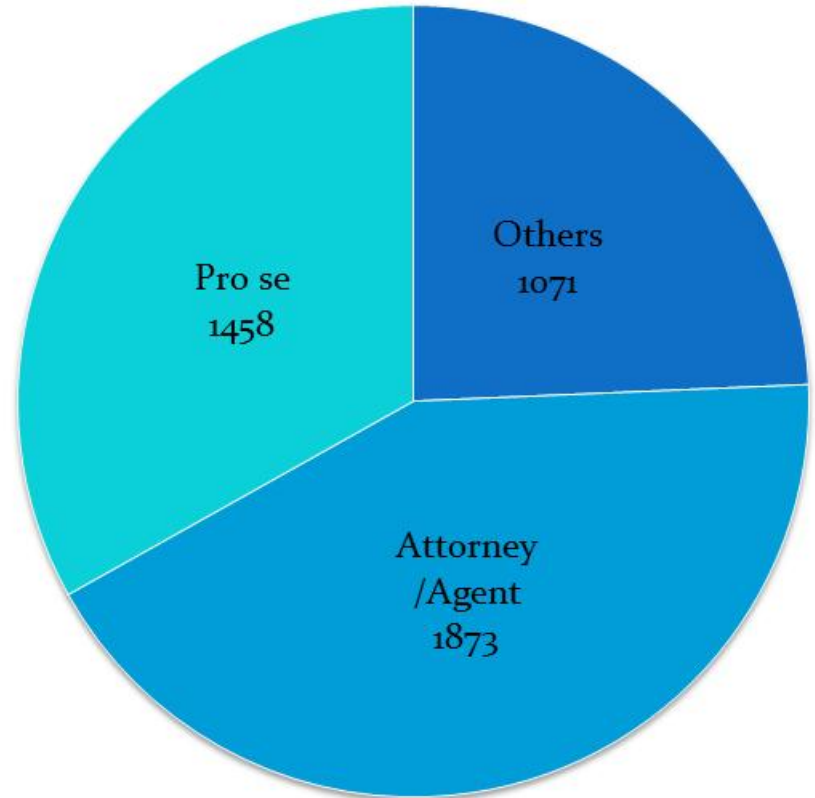


Ombudsman Inquiries by Type

2013 to Date



Program Total



Useful Tools





www.uspto.gov

First Office
Action Estimator

IP
Assessment
Tool

Data
Visualization
Center

The screenshot shows the uspto.gov homepage with several red arrows pointing to specific features:

- Patent Search:** An arrow points to the search bar at the top right, which includes fields for "search for patents" and "search for trademarks".
- Inventor's Assistance:** An arrow points to the "INVENTORS" link in the top navigation bar.
- AIA Micro site:** An arrow points to the "America Invents Act" banner, which includes a "Your guide" link.
- First Office Action Estimator:** An arrow points to the "Read Official-Looking Solicitations Carefully" section, which features a graphic of books titled "Misleading", "Right information", "Irrelevant", "Unimportant", "Unrelated", "Unhelpful", "Unusable", and "Unavailable".
- IP Assessment Tool:** An arrow points to the "IP Awareness Assessment Tool" section, which is described as "Education for business and inventors".
- Data Visualization Center:** An arrow points to the "Data Visualization Center" section, which is described as "Study the information differently".

Other visible elements on the page include a "Now Hiring" section, "One of the Best Places to Work" (#5 ranked), "USPTO Track One" (prioritized patent examination), "The Director's Forum", "Data Visualization Center", "Independent Inventors", "Patent Trial and Appeal Board (PTAB)", and "Systems Status". A "POPULAR LINKS" section includes Patent Search, Patent Filing (EFS-Web), Patent Check Application Status (PAIR), Patent Online Services, Patent Cushman, Trademark Search (TESS), Trademarks Check Status Documents (TSDR), Trademark Basics, Official Gazette for Trademarks, Forms, Fees, Manual (MPEP and TMEP), and DOJ RESOURCES (BusinessUSA, SelectUSA, FD&ys.gov). A "USPTO NEW 8" section lists various updates and announcements. A "subscription center" is located at the bottom right, and a footer contains contact information and a copyright notice.

Patent Search

Inventor's
Assistance

AIA Micro site



IP Assessment Tool

uspto.gov

The United States Patent and Trademark Office
an agency of the Department of Commerce

ipAwarenessAssessment

Beta II

uspto NIST

A business and inventors IP evaluation tool

IP Awareness Assessment

The IP Awareness Assessment, developed under the joint efforts of United States Patent and Trademark Office (USPTO) and National Institute of Standards and Technology/Manufacturing Extension Partnership (NIST/MEP), allows you to assess your intellectual property awareness. Following the completion of the assessment, you will receive a customized training material. [Learn more](#)

Feedback

Your **feedback** and comments are crucial for improving the IP Awareness Assessment.

Inventor Assistance Program

Important Notice

Please note that any information provided here does not constitute legal advice, but is intended to increase your IP awareness. When filing an application for obtaining specific IP rights, it is recommended that you obtain professional legal assistance. The IP Awareness Assessment contains links to external websites. USPTO does not maintain those external sites and is not responsible for the material found therein.

Welcome to the Intellectual Property Awareness Assessment Tool. The IP Assessment includes the below five general categories, that are included in all assessments.

- IP Strategies & Best Practices
- International IP Rights
- IP Asset Tracking
- Licensing Technology to Others
- Using Technology of Others

There are five additional categories that all can take or, which may be customized through a Pre-assessment. These five categories include:

- Copyrights
- Design Patents
- Trademarks
- Trade Secrets
- Utility Patents

Not all businesses have all categories of IP Assets so they have an opportunity to opt out of certain categories by using the customizer or Pre-assessment or may opt to take the full assessment of ten categories containing 62 questions.

The full assessment requires about 20-30 minutes to complete. The customizer or Pre-assessment can reduce the required time by 10-15 minutes.

[» enter the IP Awareness Assessment](#)

Before starting the assessment, please note:

- Save the link for this page as a favorite/bookmark on your browser.
- In the "Internet Options" of your browser, deselect/uncheck history on exit. This will allow you to return and resume your assessment session in case you cannot finish it in one sitting. This will also allow you to access your training materials and assessment results at your convenience.
- As you are answering the assessment questions, choose the answer that best applies to your business or circumstances as an independent inventor or individual. Where applicable, choose all the responses that apply to your situation.
- Responses or data collected in the assessment are not stored or used by the USPTO or NIST MEP.



Useful Tools

uspto.gov

The United States Patent and Trademark Office
an agency of the Department of Commerce

search for patents | search for trademarks
Search our site

PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

[Home Page](#) » [INVENTORS](#)

- Patents for Inventors
- Trademarks for Inventors
- Inventors Assistance
- Education and Information
- Scam Prevention
- Pro Se and Pro Bono
- Current Events
- State Resources
- InventorMail Newsletter

BusinessUSA 100

Inventors Resources

The Office of Innovation Development

The Office of Innovation Development oversees the USPTO's efforts to assist independent inventors, small business owners and university-affiliated inventors. The office also works closely with other officials and agencies throughout the government in support of the administration's efforts to promote small business, entrepreneurship, and job creation. The Office of Innovation Development designs and implements outreach programs intended to reach a wide range of groups, including independent inventors, women, small business owners, minorities, and other underserved communities.



Patents for Inventors
Tools, FAQs, Downloads



Trademarks for Inventors
Tools, FAQs



Inventors Assistance
Local Assistance, Customer Service



Education and Information
Online Chat Transcripts, Inventor News



Scam Prevention
Published Complaints



Pro Se - Pro Bono



Current Events
Conferences, Conventions



State Resources
State Contact Info



Inventors Eye
Bimonthly newsletter

Is the inventor site for me? 

Complaints 

FAQs 

Contact Us 



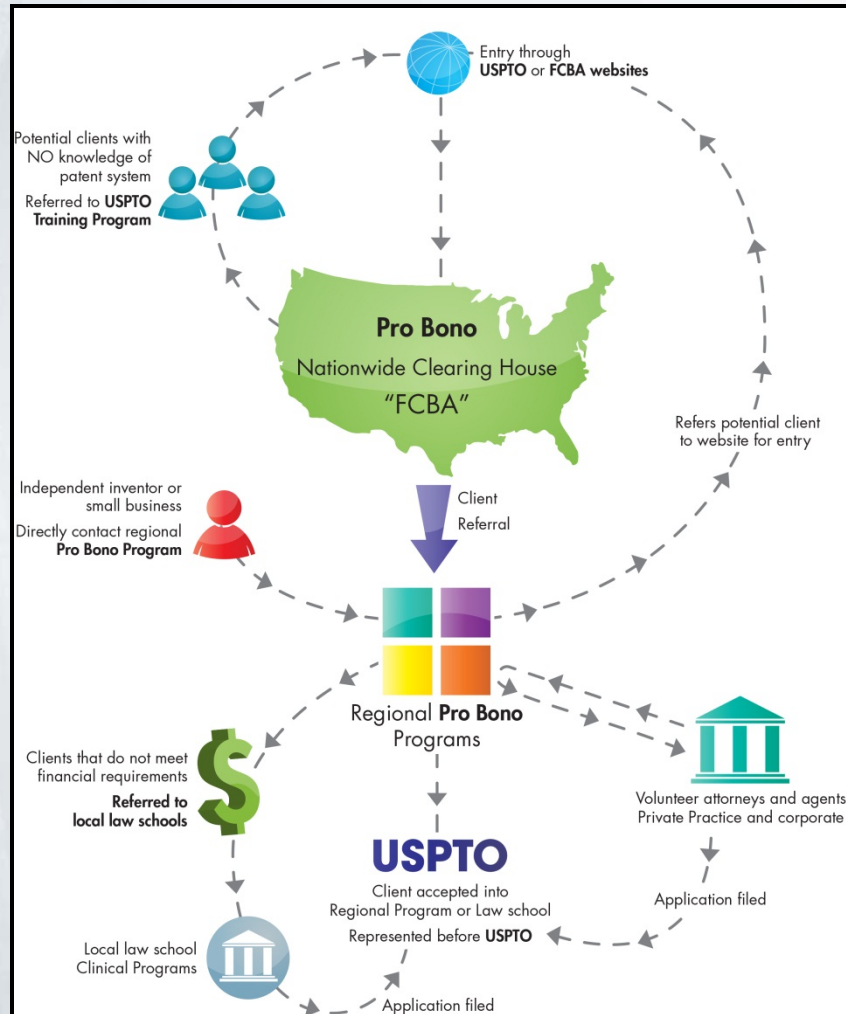
- Accessibility
- Patent Policy
- Patents of Add
- Search
- Small Business Resources
- Information Quality Guidelines

- Federal Activities Directory
- Department of Commerce
- Department of Justice
- Department of State
- Department of Education
- Department of Health and Human Services
- Department of Labor
- Department of Energy
- Department of Agriculture
- Department of Transportation
- Department of Housing and Urban Development
- Department of the Interior
- Department of Veterans Affairs
- Department of Defense
- Department of Homeland Security
- Department of the Treasury
- Department of the Environment
- Department of the Navy
- Department of the Air Force
- Department of the Coast Guard
- Department of the Marine Corps
- Department of the Army
- Department of the Air Force
- Department of the Navy
- Department of the Coast Guard
- Department of the Marine Corps
- Department of the Army

- Strategic Planning
- Department of Commerce
- Department of Justice
- Department of State
- Department of Education
- Department of Health and Human Services
- Department of Labor
- Department of Energy
- Department of Agriculture
- Department of Transportation
- Department of Housing and Urban Development
- Department of the Interior
- Department of Veterans Affairs
- Department of Defense
- Department of Homeland Security
- Department of the Treasury
- Department of the Environment
- Department of the Navy
- Department of the Air Force
- Department of the Coast Guard
- Department of the Marine Corps
- Department of the Army



Pro Bono Program





Pro Bono Program

- **Minnesota, Colorado, California, Washington DC, and Texas programs are currently up and running.**
- **Upcoming programs (dates listed are subject to change):**
 - **Massachusetts/VT/New Hampshire/Maine/Northeast NY – last quarter 2013**
 - **New York City metropolitan area – 4th quarter 2013**
 - **Eastern PA/Southern New Jersey/Delaware – summer 2013**
 - **Eastern Ohio/Western PA/West Virginia/Northern Kentucky – early fall 2013**
 - **Michigan/Western Ohio/Eastern Indiana – 4th quarter 2013**
 - **Northern Illinois/Western Indiana/Wisconsin – 4th quarter 2013**
 - **North Carolina/Eastern Tennessee/Southern Virginia – 1st quarter 2014**
 - **Georgia/South Carolina/Central Tennessee – 1st quarter 2014**
 - **Washington state/Northern Idaho/Western Montana – 1st quarter 2014**
 - **Utah/Western Colorado/Western Wyoming/Southern Idaho – late 2014**
 - **Florida – late 2014**
 - **Additional areas of country 2nd/3rd quarter 2014**



Satellite Office Program

Dallas-Fort Worth

- Temporary Space Open
- 4 PTAB Judges

Denver

- Byron G. Rogers Building
- Temporary space Open
- 5 PTAB Judges

Detroit

- 72 patent examiners
- 10 PTAB Judges

Silicon Valley

- Temporary Space Open
- Michelle Lee, Director
- 4 PTAB Judges



Contact Us

- Office of Innovation Development
www.uspto.gov/inventors
571.272.8877
independentinventor@uspto.gov

THANK YOU!

