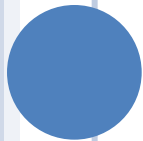




PATENTING BASICS



DAMON KALI, ESQ.

- B.A. Biochemistry from University of Arizona with minors in Math and Physics
- M.P.H. from San Jose State University
- J.D. from Santa Clara University
- 10 years as a working engineer. Process control systems, video distribution systems



FIRM

- Founded in 2006
- Computer & Software, Semiconductor Manufacturing, Telecommunications, and Mechanical
- Patent Prosecution, Opinions, Litigation Support, Trademarks, and Copyrights
- Electronic Office Paradigm



DISCLAIMER

Does not reflect the opinion or position of the USPTO
or any person employed or affiliated with the
USPTO



OUTLINE

- Definitions
 - Novel Element/Claims
- Timeline
- Types
 - Provisional Patent Applications
 - Non-Provisional Patents
 - Design Patents
- Foreign Filing
- Costs



DEFINITION: INVENTION

- Solve a problem
- Improve on a solution (better, faster, cheaper)
- Compete in a market (offer an alternative)
- Access a market (create an opportunity)
- Inventors like to tinker – fun!
- Result Oriented

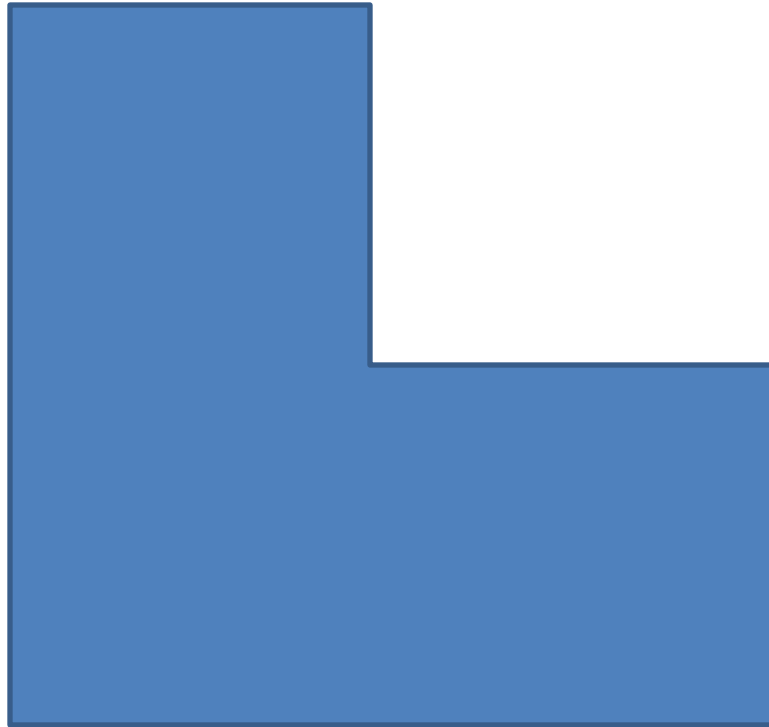


DEFINITION: PATENT

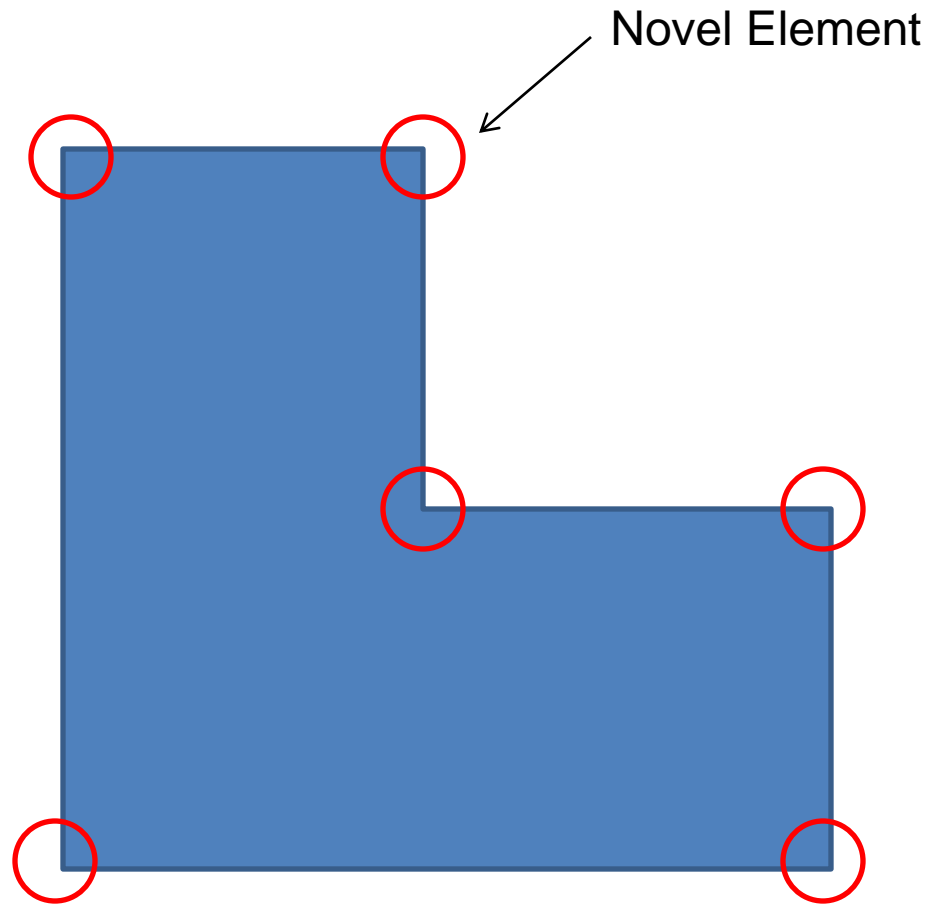
- Right to *exclude* others from making, using, selling, offering to sell, or importing. Does **NOT** confer the right to practice or use.
- Protect Invention through exclusion
- Protect a Market Share through exclusion
- Exploit a Market Opportunity through exclusion
- Intangible Property Right



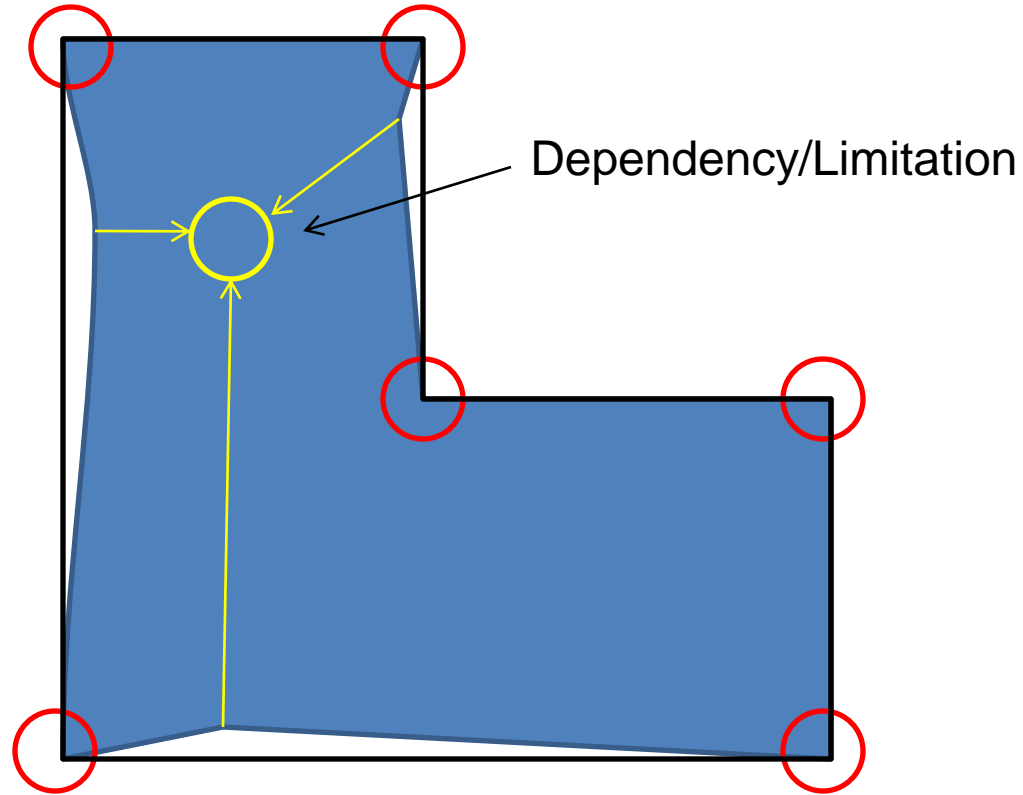
CLAIM: REAL ESTATE METAPHOR



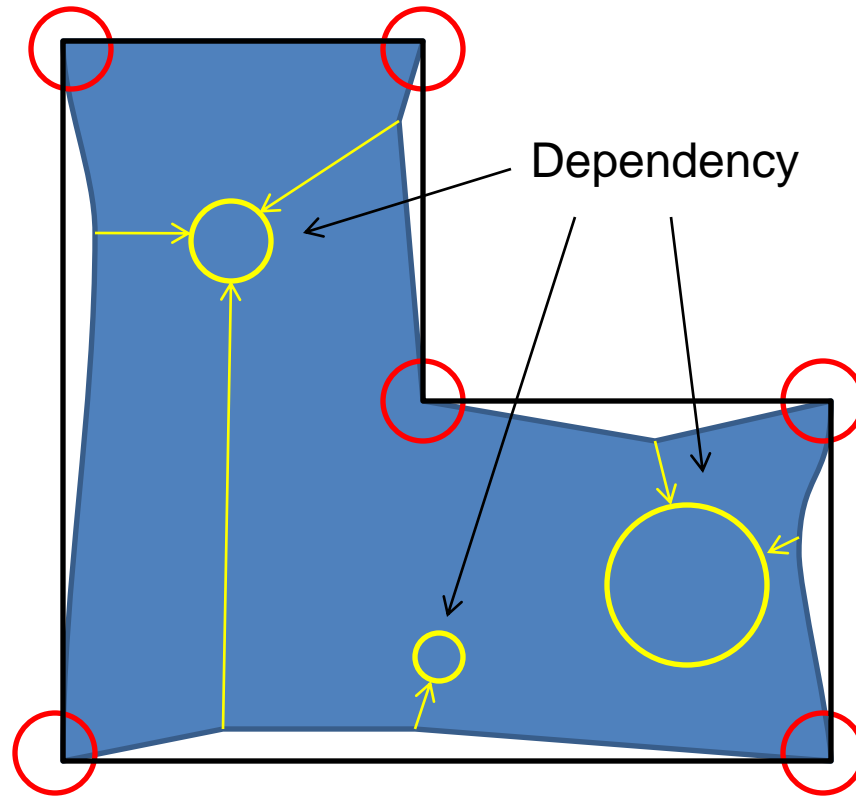
CLAIM: REAL ESTATE METAPHOR



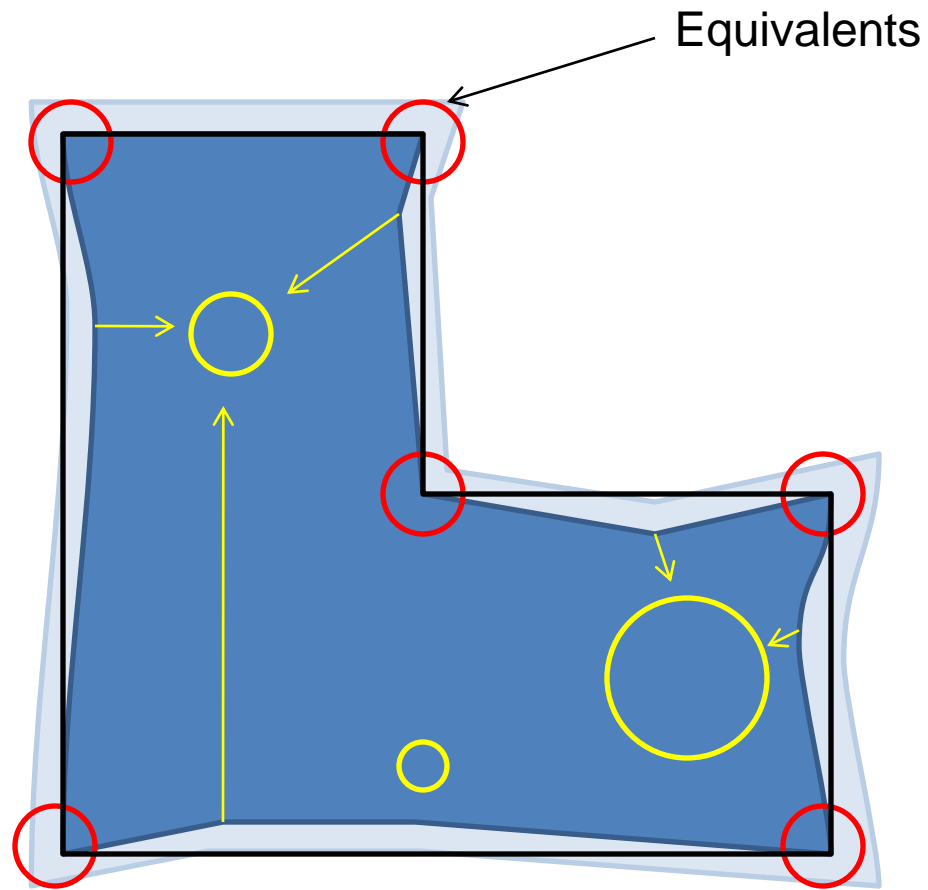
CLAIM: REAL ESTATE METAPHOR



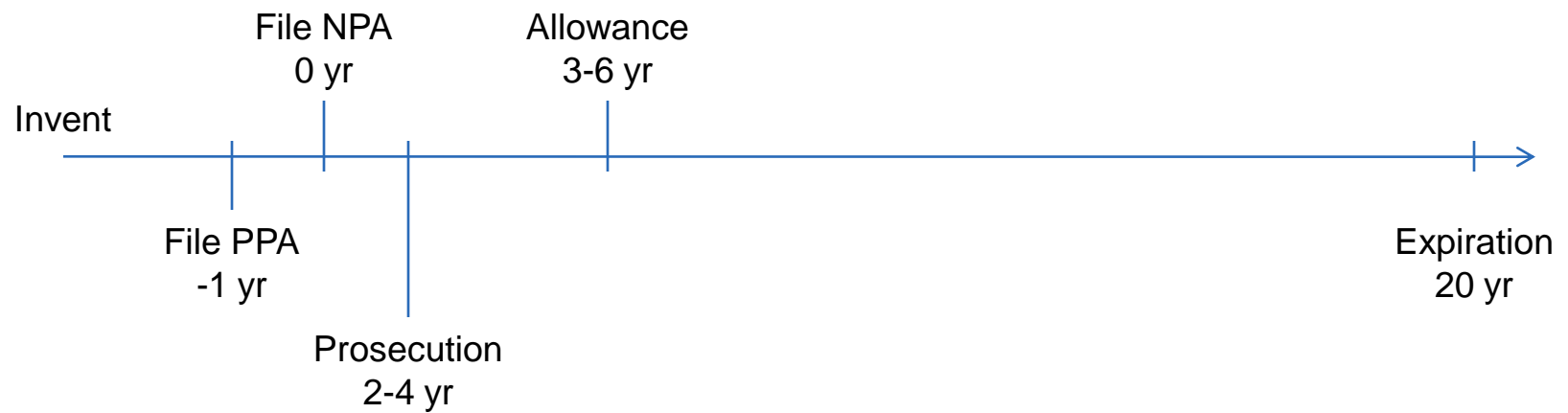
CLAIM: REAL ESTATE METAPHOR



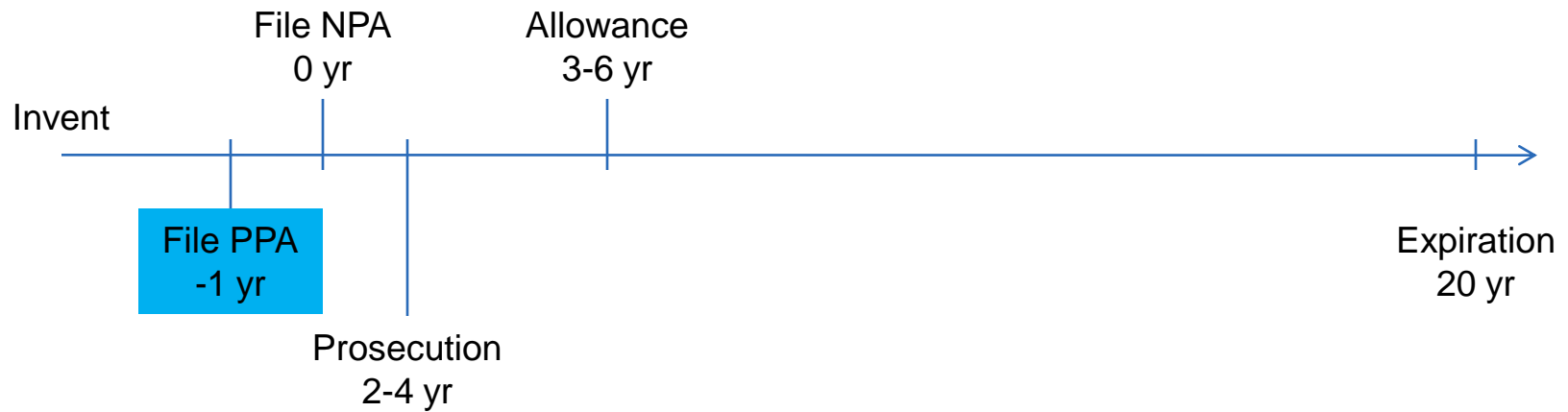
CLAIM: REAL ESTATE METAPHOR



TIMELINE



TYPE: PROVISIONAL PATENT APPLICATION



TYPE: PROVISIONAL PATENT APPLICATION

○ Key Elements:

- A provisional patent is not examined
- The term of the provisional patent is one year
- If you do not file a non-provisional patent application on the subject matter of the provisional patent within the term of the provisional patent, you lose the right to file a non-provisional application on that subject matter **FOREVER.**
- The term of the provisional patent is one year.
- The scope of the provisional patent is strictly limited to what is disclosed in the provisional patent



TYPE: PROVISIONAL PATENT APPLICATION

○ Advantages:

- No special format required
- Establishes a date of constructive reduction to practice
- Extends coverage by 1 year
- Low filing fees
- You may mark your product with, “Patent Pending”



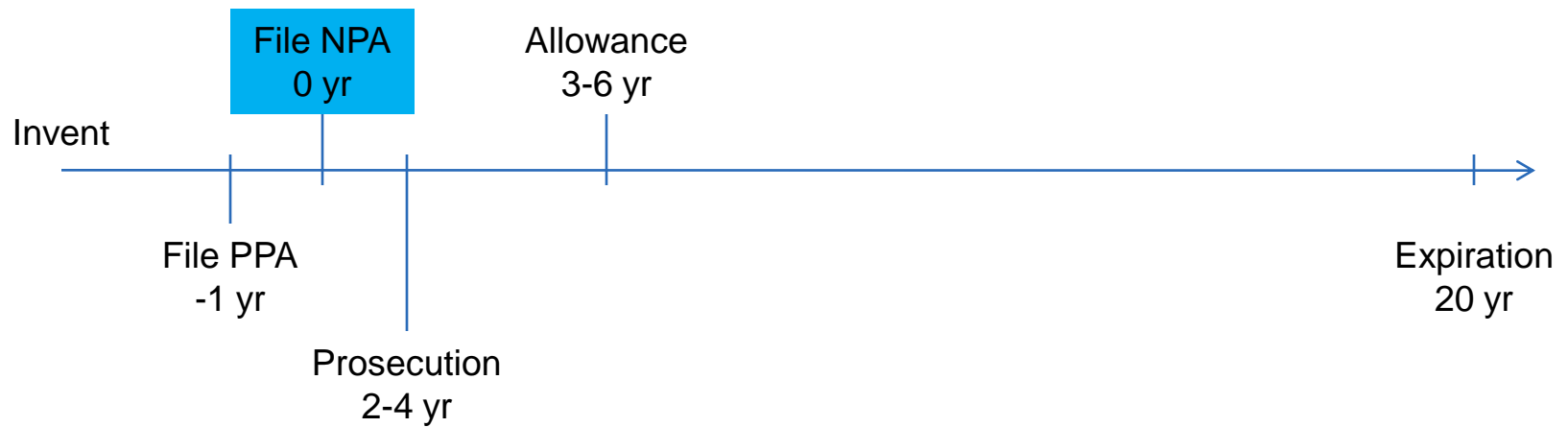
TYPE: PROVISIONAL PATENT APPLICATION

○ Disadvantages:

- Limited scope due to inadequate disclosure
- Limited duration
- Loss of rights possible
- May cost more in the long run
- 18 month publication is based on provisional filing date
- Foreign filing may be affected



TYPE: NON-PROVISIONAL PATENT



TYPE: NON-PROVISIONAL PATENT

○ Key Elements:

- A non-provisional patent undergoes an examination by the USPTO
- The term of the provisional patent is 20 years from the date of filing
- A non-provisional patent must comply with certain formalities
- The scope of the non-provisional patent may be broadly construed and capture equivalents with some limitations
- Maintenance Fees are due at 3½, 7½, and 11½ years



TYPE: NON-PROVISIONAL PATENT

- Key Elements:

- A non-provisional patent is enforced solely by the holder of the patent
- A non-provisional patent grants a right to exclude, NOT to use



TYPE: NON-PROVISIONAL PATENT

○ Advantages:

- Establishes a date of constructive reduction to practice
- Coverage is lengthy (20 years from filing)
- Patent term Adjustment (PTA) available
- May avoid 18 month publication if not foreign filing
- You may mark your product with, “Patent Pending”
- Getting a non-provisional patent entitles holder full patent rights



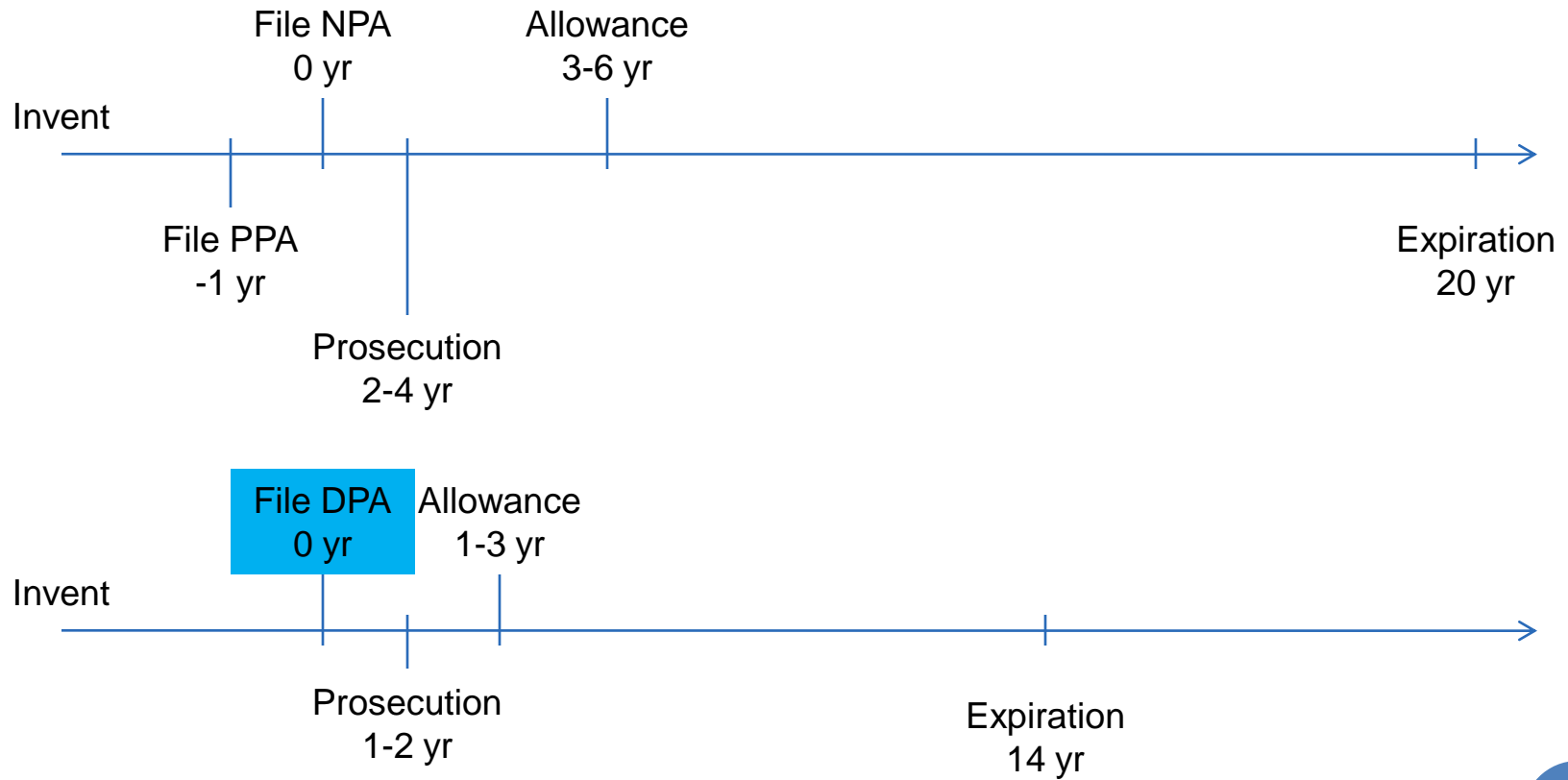
TYPE: NON-PROVISIONAL PATENT

○ Disadvantages:

- Special format required
- Prosecution may extend for several years
- May limit scope during prosecution
- Relatively high filing fees
- Patent holder required to enforce patent
- Maintenance Fees are due at 3½, 7½, and 11½ years



TYPE: DESIGN PATENT



TYPE: DESIGN PATENT

○ Key Elements:

- A design patent undergoes an examination by the USPTO
- The term of the provisional patent is 14 years from the date of **grant**
- A design patent must comply with certain formalities
- The scope of the non-provisional patent may be broadly construed and capture equivalents with some limitations
- Design patents protect ornamental aspects of your invention **NOT** useful aspects



TYPE: DESIGN PATENT

○ Advantages:

- Establishes a date of constructive reduction to practice
- Coverage is reasonably lengthy (14 years from filing)
- Prosecution is typically fast
- Fees are typically lower
- You may mark your product with, “Patent Pending”
- Infringement includes an “obvious to the ordinary observer” standard
- Provides ability to stop copycat reproductions through the US Customs Office
- Photographs may be utilized with some restrictions



TYPE: DESIGN PATENT

- Disadvantages:
 - Special format required
 - Does not protect any utility aspects of the invention



FOREIGN FILING

- PCT/Taiwan
 - 12 Months
 - ~1.5 – 2.5k
- National Phase
 - 18 Months
 - Up to 8k per Application plus annuities
 - File where you manufacture and sell



COSTS: NON-PROVISIONAL

- Original Filing
 - Specification ~8.5 to 10.0k
 - Drawings ~.5k
 - Fees ~1.0k
- Prosecution
 - Amendment ~3.0 to 6.0k
 - Appeal ~ 5.0 to 10.0k
- Allowance
 - Fees ~1.5k
- Total – 14.5k to 22.5k



LAST THOUGHTS

- Provisional Applications
 - Don't draft them yourself
 - Understand the limitations
- The more novel elements you have, the better chance you'll have of getting something useful
- This takes a long time... don't get in a hurry
- All your claims will be rejected on a First Action



Thank You

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