Jay Lyman: Good morning everyone. Can you folks hear me? All right. I wanted to let everyone know we’re going to start here in a second. Welcome, great to be here this morning. I think we are ready to go. Good morning everyone. My name is Jay Lyman, I'm a librarian at The Seattle Public Library, and I just am here to welcome you to this event. We are going to talk about intellectual property and trademark, you will be hearing from some experts. And, I just want to keep my comments really brief so we can dive into the content here this morning. I just, really briefly, if you haven't already explored some of the other things that The Seattle Public Library has to offer to support you and your small business or your business idea, we are here to support you in lots and lots of different ways. So, check back in with us. I just also want to express my gratitude to all of the partners here today, the University of Washington, the USPTO, and thank you all for being here. I'm going to turn things over to Professor Fan with the University of Washington Entrepreneurial Law Clinic. Professor Fan, thank you for being here, and take it away.

Jennifer Fan: Thanks so much, Jay. Thanks to the USPTO and to the Seattle Public Library for helping to host this great event. I have the pleasure of introducing Steve Koziol, who is an assistant regional director of the Silicon Valley regional office of the United States Patent and Trademark Office which serves the Western region. Mr. Koziol joined in 2007 as a patent examiner and has managed teams of examiners in computer graphics and digital imaging fields. Prior to joining the Silicon Valley regional office, Mr. Koziol worked in the Rocky Mountain regional office in Denver, Colorado where he led the design and implementation of various IP outreach and education programs. He is also focused on the development of patent specific programs within the USPTO, including the Post Grants Outcome program, America Invents Act, First Inventor to File Implementation, American Intellectual Property Law Association Partnering Up Patents, and patent operation cost and fee modeling. Mr. Koziol received his Bachelor of Science degree in electrical engineering from Bradley University. So, I will let Steve take it away. Thank you.

Steve Koziol: Okay. Fantastic. Thank you, Jennifer, and thank you Jay. Appreciate the opportunity to be with you this morning and to have this discussion about you know, hopefully what should be a good topic for this group from what I understand: intellectual property. I will, in the next hour or so with this group, be giving an overview of the different types of intellectual property, what they cover, what they don't cover. And hopefully, you will come through this with a better understanding of maybe what you or your business has that can be protected with intellectual property, a better understanding of what type of intellectual property might be best suited for you and your business, depending on where you are. And, towards the end of our time together today, I will turn things over to my colleague, Grant, who will talk a little bit more about how you can go about getting help getting that type of intellectual property that you may need to protect, whether that is through local pro bono resources or other resources that the U.S. Patent and Trademark
Office is able to provide. So, hopefully, this will be the next hour and a half to two hours, kind of a nuts-and-bolts everything you need to know about intellectual property, at least at a high level, and then how you can go about securing free and publicly available resources to help you navigate the intellectual property landscape. So, that is what we are looking to cover throughout the day. If you do have questions, we would like to use the Q&A feature of the WebEx. So, for the purposes of today's call, if you use the Q&A and post your question to all panelists -- you can direct the message privately to any one of us, but if you use all panelists feature in the Q&A, that will ensure that it goes to all of us and that we don't inadvertently miss the question.

Another note on the Q&A. As I understand it, this event today is being recorded and will be made available for future viewings. So, if you do have a matter that is perhaps sensitive to your particular needs, do be mindful of what you may inadvertently disclose through the Q&A process. So, we will try to keep the questions general. And then, if there are more specific questions, we can look into having a one-on-one conversation at a later date.

So, hopefully, that is all for housekeeping. I do encourage all of you to ask whatever questions you have in the chat. There is going to be a lot of subject matter that we are going to cover here today. So, hopefully, this will spark some good questions. I will pause maybe 2-3 times over the course of my presentation to see what questions have come in so you don't feel that you need to wait towards the end to ask any questions that you may have.

With that, I think we will go ahead and get started. Like Jennifer said, my name is Steve Koziol. I work out of the San Jose office of the United States Patent and Trademark Office. We are one of four regional offices that serve the United States, in addition to our office in Alexandria, Virginia, which is our headquarters, and I will just talk a little bit about what the U.S. Patent and Trademark Office is. We are the federal agency that reviews patent applications, reviews trademarks and actually grants patent applications and registers incoming trademarks. The agency has an overall goal of fostering innovation and economic growth through the creation of stable, predictable, and high-quality intellectual property: in particular, patents and trademarks.

Just to give you a brief look at who we are, and the type of numbers that we see, typically, we will get over 600,000 patent applications in any given year. And about half of those we’ll wind up issuing as patents in any given year. And those numbers hold roughly, those ratios hold roughly, for trademarks as well. We will get almost 500,000 trademark applications per year, and a little bit over half of those are successfully registered as marks. And I will talk a little bit about what that means, what is the difference between, you know, just a trademark application, and a registered trademark and the like. So, that is a brief overview of our agency, and what we do.
So, why are we talking about intellectual property? And why are we talking about patents in particular? So, I just want to take the next slide or so to just kind of orient us to the importance of intellectual property and the importance of patents in particular in the economy today. And I find this chart particularly interesting. About two summers ago, our agency, the USPTO, issued its 10 millionth United States patent. 10 million U.S. patents. And I find it interesting to track the growth of that patent issuance over time. And, to look specifically at maybe the last 20 or so years at just the exponential growth in the issuance of patents in the United States in that time. You can see that almost half of all of the United States patents that have ever been issued, going back to the very first numbered patent, have been issued within roughly the last 20 to 25 years or so. So, that tells you, or that should give you a sense of, the importance of intellectual property and of patents in particular in competing and remaining competitive in the current economy.

And, I’ve mentioned the economy a number of times. There was an interesting study that came out a number of years ago, or at least interesting if you're in the IP space, that looked at the impacts of intellectual property-intensive industries on the U.S. economy as a whole. And these are a few select findings that I thought were interesting, and that I thought kind of reinforced why it is that we are talking about intellectual property and patents in particular, and why you should be thinking about the role the intellectual property and patents can have on your company, on your business, and on your success. And, if you look at those industries that have -- that are considered intellectual property intensive, meaning that the industry is backed by strong patent rights, by strong trademark and branding rights, by strong copyright protection, that is almost 40% -- those industries, those IP intensive industries account for nearly 40% of overall U.S. gross domestic product.

And when you look at the quality of jobs that are created in those IP intensive industries, what you will see is that the typical wage earner earns 46% higher pay relative to those non-IP intensive industries, those industries where there is not that backbone of strong intellectual property supporting the work being done there. So, this tells you that IP is a value creator. IP creates real, tangible value, and is also correlated to industries that create a higher rate of real, tangible value, not only for the economy as a whole: for the shareholders, and for the people working at these companies. So, hopefully, that gives a little bit of insight into why we are talking about intellectual property, why it’s important, and why we are here this morning. And, with that said, I want to give it a little bit to what is going to be the bulk of my remarks today. And we will spend a little bit of time looking at precisely what we mean by intellectual property. What are the different types of intellectual property? What do they cover? What don't they cover? And how might you go about getting protection for them?

So, there is a lot of information on this chart, and we are happy to share the slides with folks after the fact. So, don't feel that you need to write everything down or furiously take screen captures of each slide. We are
happy to share this content with all of you. But, at a high level, this is everything that we talk about when we discuss intellectual property. So, I will just spend a few seconds kind of moving left to right across this chart, covering at a high level the different types of intellectual property and what they cover. I think the most common type of intellectual property is what we call the utility patents. This is for those of you who may be new to the patent system or the IP system. If you have ever seen Shark Tank or you have heard the question, you know, “Is a patented? Do you have a patent on that?” What they are asking is about what we would call a utility patent. These are the typical patents for what we would consider inventions: any type of new machine, any type of chemical composition, any type of process as well, a method for more efficiently operating a machine, or any improvements on existing machines, existing compositions, existing methods or processes. All of this falls into this bucket of utility patents, so, everything from the battery in your mobile phones to the chemical composition of the screen in the phone, all the way through the process of managing battery life in the phone. Those are all examples of things that would fall under this utility patent bucket.

And at the heart of the patent system, and the utility patents in particular, is a quid pro quo that I will talk about in a few slides. But basically, a patent, a utility patent, is you, as the inventor, writing an instruction manual that tells anyone who can read it how to make and use your invention. You are essentially giving away, and explaining to the world, what it is you invented and how to make that invention. And in exchange for that, the government offers a 20-year period of exclusivity. And I will talk a little bit about what that means and try to dispel a few myths around what you can really do with the patent and what levels of protection it really provides, but at a high level this is the utility patent system.

Complementary to that is something called a design patent. This is not quite as commonly understood to most people that are new to the IP system, but design patents can be extremely valuable, depending on what it is that you have to protect. So, a design patent -- in contrast to a utility patent -- a design patent covers merely the ornamental design of a physical object. So, it covers the look and feel of an object. A way to think about this is a utility patent can cover what the object does, its function. Whereas the design patent covers the look and feel. To go to the mobile phone example again, the exact way that the edges of the phone are contoured and the exact ratio of height to width on the phone itself, those merely ornamental features of a product are protectable through a design patent.

A classic example is -- think of a Coca-Cola bottle. Let's say the method of manufacturing a Coca-Cola bottle could be protected by a utility patent. The composition of the glass or whatever plastic material could be new and shatter resistant and that could be worthy of a utility patent. But the actual shape of the bottle, that iconic, you know, classic Coke bottle shape, is something that can be protected through a design patent. So, I will come back to the Coke bottle example a few other times. But if you rely upon the visual distinctiveness of a product that you are looking to sell, and that visual distinctiveness can be easily copied, a
design patent is going to be all that protects you from somebody attempting to sell a confusingly similar designed product.

I will spend just a few seconds talking about plant patents. They are not nearly as common as utility or design patents. But plant patents, if you do have a new way of reproducing any type of flowering plant or tree or other hybrid plants, roses are particularly popular, if you have come up with a new strain of a rose petal or a new type of other fruit tree or other type of flowering plant, there is protection available for that as well through the design patent route. If you're interested, we can talk more about that off-line. But that is about all I will say today on plant patents.

Copyright. Hopefully most people are somewhat familiar with copyrights. But again, pivoting away from patents for inventions or patents for designs, copyrights protect original works of authorship. So, everything from the written word to recorded music, film, photography. Even dance and choreography can be protected through copyrights. Software as well can be protected through copyright, as a written work. And copyrights last the life of the author plus 70 years, for most instances. So, you could just compare the timing of that relative to the 20 years that you will get for something that can be protected through a patent, a utility patent in particular.

So, going back to our Coke bottle example, there may not be anything -- X was simply copywritten on the bottle itself. But, if you were to create, say, a commercial advertising the bottle, everything from the video recording of the commercial itself, if there is a particular script that you have hired someone to write, you know, the text of the script is something that advertises the product, that is something that would be protectable through copyright.

So, moving on, trade secrets is another popular form of intellectual property, and it is one of the more unique forms of intellectual property, insofar as every other form of IP that we have talked about so far, from utility patents through copyrights, you either have to file an application, or do something to actually record that intellectual property right: you go to the USPTO, you file a patent application, and that is how you, you know, formally register that intellectual property right.

Trade secrets are different insofar as there is no federal agency that tracks who is keeping a trade secret or who isn’t, there is nowhere that you go to register a trade secret. A trade secret is something that you, and you only as the owner of the trade secret, identify and protect, and it is an incredibly broad category. But it is broadly defined as anything that you intend to keep confidential, and that gives you or your business an advantage in the way that you do what you do. So, this is everything going back to our Coke bottle example, from the recipe for Coke, the Kentucky fried chicken, the famous seven herbs and spices, that would be another example of a trade secret.
But they can also be business processes as well. If you have a particular manufacturing method, a particular way of more effectively getting more yield out of a particular item that you are manufacturing, that business process can be subject to a trade secret as well. So, again, think about anything that gives your business a competitive advantage, up to and including sensitive contact information, or sensitive user data that you may be gathering. All of those things can be protectable through a trade secret.

And again, a trade secret is only valuable to you if you go through the process of keeping it secret. That means restricting who has access to what information, particularly information that you want to keep secret. You know, you want to lock that down as best as you can and make sure that access is offered on an as-needed basis. It comes down to the strength of your nondisclosure agreements with your employees. And certainly, those are not necessarily bulletproof, or not necessarily a guarantee of the preservation of your trade secret, but they are often better than not having a nondisclosure agreement in place. It goes to just the general carefulness with which you treat sensitive information in your company. And, the more restrictive you are, the better chances you have of preserving those trade secrets that you may be sitting on.

And last but not least, I will mention trademarks. So, trademarks are most commonly understood as your brand. Those words or symbols, slogans, logos, anything that you are using to distinguish your particular brand. And what it does -- a trademark really serves as what we would call a source identifier. In the eyes of the consumer, the trademark serves to identify the source of a particular good or service that you are providing. So, going back to our Coke bottle example, there are probably a number of trademarks on any given Coke bottle, from the text itself, Coca-Cola, to the stylized version of the text, the particular scripts that they use. Even the color scheme, the iconic red and white color scheme that is often associated on the Coke bottle. Those would all be examples of trademarks that serve as that source identifier so that when the consumer looks at your product, there is that instant recognition that I know where this is coming from, I know a Coke tastes like a Coke, regardless of where I am. It creates that recognition in the eye of the consumer. And we will talk a little bit more about what makes a strong trademark or relatively weak trademark. But the mark, as long as you continue to use that mark in commerce, meaning you are associating the particular trademark with the good or the service that you are offering, you know, it can last indefinitely. There are renewals that you have to pay to keep the mark in use and you have to demonstrate that you are continuing to use the mark, but the mark will remain enforceable as long as you are continuing to use that mark in commerce.

So, with that, I think this might be a good time to pause and see what questions we are getting online. And really, the rest of my presentation will just be getting into a little more detail on each of these types of intellectual property. So, this really is the scope of my remarks today. So, questions from the audience?
Jay Lyman: We do have some really good questions here, Steve. I think this is, this is an excellent example because I think, you know, at least for myself and other folks that I have worked with, like it is kind of, well, we have this whole set of different types of protections. Which one -- which is the best for me to use? Like, where do we start down that path? And I think this question may be as an example of that. So, this person has a service-based business teaching skills and techniques. She is worried about protecting her ideas like curriculums or her application of different techniques that she uses. Is that protectable? And should she worry about protecting that? And there is a follow-up just sort of clarifying. She wants to protect it from being copied by and used by another facilitator, whether that is one of her clients or somebody who has come to her workshops and programs. So, your thoughts: what path should she kind of follow for that?

Steve Koziol: Yeah. Really good question. And thank you for raising that. And this is something we can talk off-line as well if you want to get into specifics about what you may have. But, at least at a high level, when you're talking about a particular teaching curriculum, that is something that I would look to copyright, at least initially, to see how that may be able to help. That is going to protect you know, the written word, that you have developed in the form of a curriculum and how that is applied. The only downside there to copyright is that it protects the exact letter of the word as you record it.

So, in other words, it can be relatively easy for people to design around your curriculum if you rely exclusively on copyrights. But then that comes down to the details of you know, well maybe, maybe it has to be a certain way, and if so, copyright can be very effective at protecting that.

Another thing to think about if you are offering a particular teaching service is what is your brand identity? You know, how are -- do you have a slogan, a logo, a color scheme? Something that uniquely identifies your particular curriculum with a brand. And that can be a very effective differentiator for you as well. If you have a trademark, a word mark, a slogan, or a combination of those that uniquely identify you as the source of a particular type of curriculum, that can be very valuable to you in distinguishing yourself from others that may be trying to offer a similar type of teaching experience or curriculum. So, I would think some combination of trademark and copyright as well could be valuable there. And perhaps, even, there may be some trade secrets that you can be sitting on, depending on how you collect information from your students or your participants in the curriculum, and how you process that information, and turn it into something of value for the students. That may be something that only you know or only the people that you train know, and that can be a very effective trade secret potentially that distinguishes what you are doing from other facilitators in your area.

So, again, happy to have the discussion off-line if there are more specifics you would like to get into. But at a high level, that might be one approach to the type of intellectual property that you may have with your teaching business.
Jennifer Fan: I had a question I wanted to ask, which is when should inventors be reaching out to the USPTO headquarters versus one of the regional offices? Are there differences in services that the two different offices provide?

Steve Korziol: Yeah. Great question, Jennifer. And you know, the regional offices were created under 10 years ago. And actually, I believe tomorrow is the fifth anniversary of the regional office in San Jose. But they were created to bring the services and resources of headquarters into the community that are particularly active in intellectual property. So, we have IP regional offices in every time zone, across the continental U.S. And you know, we are here to connect -- we on the West Coast specifically -- are here to connect with those on the West Coast to understand what questions they have, what needs they have, with respect to navigating intellectual property of the patent and trademark systems in particular and to get them connected, to get our West Coast constituents connected to the people that are going to be able to answer their questions. So, as an initial -- “who do I talk to when I need to talk to the PTO?” I would encourage you to reach out to us directly in the San Jose office. We will be a great primary point of contact for you.

If we are not able to get you the help you need, we will serve as your facilitator to connect you with the group at headquarters or with a pro bono clinic or with someone either at headquarters or locally that can get you the help you need. So, we are happy to serve as that initial point of contact, and make sure that we are getting you the resources that you need to get your questions answered.

And one thing I would note, too: if you are going to file an application, a patent application, trade application, that does need to go through headquarters or preferably through our electronic filing system. The one thing the regional offices cannot do for you is accept a physical copy of your trademark or patent application and file it on your behalf. So, that still needs to be done through headquarters or electronically.

Jay Lyman: Steve, hopefully this one is not jumping ahead too far. I'm guessing it's probably right in the next kind of thing that we think about. Now we have gone to the process of filing it, you know, filing and let's say it is accepted and all that, what do we need to do to kind of enforce it? Do we need to be constantly monitoring, that nobody is using any one of these? What does that look like?

Steve Korziol: Yeah. And that is a great point, too. The USPTO as I mentioned initially, we accept incoming applications for patents, for trademarks. We will examine the patent and we will issue the patent and trademark.

What we won't do is enforce the patent or trademark on your behalf. That is something that is up to you as the individual rights owner. There is no federal agency that directly and proactively enforces your
intellectual property for you. It really is up to you, as the individual, as a trademark owner, as the copyright owner, to monitor the marketplace, whether that is an e-commerce platform, where there may be potentially infringing products, or physical brick-and-mortar hardware and physical stores where you may see potentially infringing products. So, it is up to you as the rights owner to work with your attorney to monitor the marketplace, and to make sure that there are no infringing products or potentially infringing products, and it is up to you as the individual rights owner to, again, work through your attorney to either send an appropriate cease-and-desist letter or to take the potential infringer to court in order to receive an injunction to get that infringing product off of store shelves or off e-commerce platforms.

**Jay Lyman:** Thank you. Yes, excellent.

**Steve Korziol:** Okay. I’ll take about maybe 20 more minutes or so and just go through a few other examples, and hopefully drive the point home here a little bit more. Kind of just to bring that previous chart home, look at something like a mobile phone, and just think about the different types of intellectual property that you will see in there. Maybe I need to refresh this particular slide and come up with a more modern example, but the point still stands. Everything that is related to the branding of this phone, in this case, Nokia or the M8 for the Windows software by Microsoft Windows, those kind of all fall into the example of trademarks that you would see here. And then all the way down the line, there is probably any number of patents on everything from the hardware itself to the chemical compositions of the screen on the back, down to the antenna and all the methods for processing data, managing the battery, and processing the graphics on the phone. All of those are protectable through patents. There is probably any number of copyrights here as well, everything from the software itself down to the instruction manual on how to use the phone. And designs as well, from the shape, the layout of the buttons on the phone, the dimensionality of the buttons on the phone. All of that can be protected through design patents as well.

So, with that, I want to give a few examples of trademarks. And kind of talk just briefly about what makes a good trademark, versus a so-so trademark. And, as I mentioned before, think of a trademark really as a source identifier. The trademark indicates the source of a particular good or service that you are offering. As soon as you see the McDonald's arches, you know what you are getting when you walk into the McDonald's. So, that is what a trademark really covers. It is a way to use words, symbols, logos, or combinations thereof to identify the source of a particular product or service that you are offering.

And, one thing I will mention here, too, is that you may have noticed some products that you will pick up, you will see a name, you will see a slogan, you will see something, and it will have the letters TM next to that logo, next to that slogan, next to that name. Whereas others, you will see that little R with the circle around it, and there is a distinction there, and I will take just 30 seconds to talk about that because I think it matters. So, a question that we often get is, when can I start using the TM next to my logo, or my slogan, or
my you know, particular brand name that I want to associate with the product? The answer for most people is, you can start using it today. There is no need to register a trademark in order to start using the letters TM next to the particular mark that you have. The TM is what we refer to as a common-law trademark. It indicates to the consumer that you are the brand owner, that you are claiming rights to that particular brand, common law rights to that particular brand. And it is something that anyone on this call can presumably start using today in association with a particular mark that they are using in commerce. However, there are benefits to taking that mark and registering it with the U.S. Patent and Trademark Office. And as you can see, the R here on the slide -- only when you register a mark with the USPTO are you able to use that R with the circle symbol around. That designates a federally registered trademark. It is an indication that that mark has gone through review by someone at the U.S. Patent and Trademark Office. They have checked similarly registered marks to make sure that there was nothing quite like it that would cause confusion in the eyes of the consumer, and, that your mark kind of has that stamp of approval from the USPTO, that it is unique to your particular product.

There are some other advantages to that as well. I mentioned unregistered marks, right, those that use the TM are seen as common law trademarks, and the scope of enforceability is typically limited to those areas where you are actually selling your product. Whereas a registered trademark, the R with a circle around it, that gives you protection across the U.S. It gives you the ability to record that mark with Customs, and Customs will then search imports across ports of entry into the U.S. for marks that may be trying to copy what you have registered. And it also can serve as the basis for bringing legal action in a federal court, not just a local court, not just a District Court, but federal court action, only with a registered mark.

So, there are a number of advantages to registering your mark. And I would encourage you, particularly if you are looking at selling on a nationwide e-commerce platform, or if you are looking at establishing or getting your product into multiple brick-and-mortar stores across the country, to consider getting a federal registration for your trademark. Conversely, if you know that you are only going to be a very local business, a local restaurant or a local service supplier in your region, and you have no interest in establishing a nationwide presence or even a multistate presence, then maybe a federally registered mark may not be as applicable to your business needs.

These are just some examples of types of trademarks that I have alluded to before. They can cover everything from the text itself, which we would call a word mark, to what we would call a special form mark which is a stylized version of text that can include color, all the way through composite marks, the bottom left-hand corner that shows a combination of text, stylized text, color, and images as well. Just a number of examples of trademark and a few additional examples.
And, I think this will be the last thing I say about trademarks, is to just plant the seed in your head that there are varying degrees of strength in trademarks. And typically, those marks that we are looking at here, marks that we would call either arbitrary, suggestive, or fanciful, tend to be much stronger than other types of marks. What do we mean by that? Xerox. Xerox was not a word until the Xerox Corporation created it. They created a word out of whole cloth, like Microsoft or Cisco, that hadn't ever really been used before. That unique, what we would call fanciful, type of word is something that is particularly strong.

But also, there are marks that are what we would call arbitrary, a mark that is a real word but does not convey any particular association with the good or service being sold. So, Apple is a classic example there: Apple is a word, but no one had really used Apple to refer to a computer or phone company before. So, it is that arbitrary linkage between a word that exists, like Apple, Blackberry, Gap, that has nothing to do with a good or service being sold, it is that linkage that can make for a very strong mark.

And likewise, kind of the flip side of that, is what makes for a weak mark. This often trips people up because a lot of times, people that are new to the trademark system or that are trying to register a mark, they tend to lean towards what they would call a mark that is merely descriptive. A word, a design, that merely describes the particular good or service that you are trying to sell. So, if you are selling a potpourri and it smells like apple pie and you attempt to register the mark for apple pie potpourri, that is going to be seen as a relatively weak mark. It is not distinctive; it simply describes what it is you are selling.

Likewise, for generic marks as well. If you are providing an online legal service, and you attempt to trademark lawyers.com. Well, that is a very generic descriptor there. There is nothing really unique that would uniquely identify you as the source of that good so, if you are able to get those types of marks, those merely descriptive or those generic marks registered, they may not offer the same caliber of protection as a mark that is, like we saw previously, either fanciful, arbitrary or suggestive. So, just a few things there to keep in mind when you are in the process of selecting a mark: try to avoid those that are merely descriptive, avoid marks that are merely generic, and focus on something that is going to be a little bit more arbitrary or fanciful or unique as an identifier.

**Jay Lyman:** Thank you, Steve. There is a question, there are a lot of questions coming in the chat. So, thank you all for asking those amazing questions. On trademark, before we move on to trade secrets, there is a question -- we have the examples of the different types of marks, some that were designed and some that were names. Does one in the process need to apply for each individually? In the example of Coca-Cola, is the word mark a separate filing from the design mark and such?

**Steve Koziol:** Yes. Short answer there is yes. Each of these that we are looking at here today would likely be the result of separate trademark applications. So, an application for the word mark itself is that text, just
the word Coca-Cola would be a separate trademark application. Likewise, the specialized font and combination of color that may go into that font. Each of these would be separate trademark applications. So, there is a tension there. Each application has a filing fee associated with it. So, you may have 500 different stylized versions that you would love to protect, but each of those is going to come with a corresponding filing fee, and, if you are working with an attorney, the corresponding attorney's fee to file and prosecute those applications. So, it really does force you to prioritize, “Okay, which marks are essential to my business, to the products that I am selling, to the service that I am offering?” And you do have to have that, that prioritization on the marks that you think are going to have the greatest impact on creating the brand identity, the visual distinctiveness that you are looking to create with your product or your services.

**Jay Lyman:** Excellent. Thank you. We have got a lot coming in, so we are answering some of them in the chat. So, look for answers there. But also, we probably will just save some for the end where we can dive a little deeper, too.

**Steve Koziol:** Okay. Great. I will probably take about 10 or so more minutes before opening it back up to Q&A and then turning it over to Grant.

So, I did want to briefly talk a little bit more about trade secrets. I know we alluded to previously the recipe itself for Coca-Cola, for KFC. One interesting question we tend to get is, “Wait a minute, how can Coca-Cola keep a trade secret when they are manufacturing the actual soft drink all over the world in various bottling plants and facilities, and distributing it across hundreds of countries? How can that be secret? Somebody at the factory has to know the recipe, you know, how to make a soft drink?” And that is probably more than we can thoroughly answer today. But, suffice it to say that when Coca-Cola delivers the raw materials to any given manufacturing facility, or bottling facility, it comes with strict instructions about the ratios of how much of this particular, whether it is sugar or whatever else. It is just raw materials coming in with specific instructions on ratios for combining when to introduce carbonation and how much to introduce. And it is done so in a way that is particularly difficult to reverse engineer. So it is more like just assembling Legos at that point than it is precisely mixing raw ingredients that would reveal you know, the actual content of the ingredients. So, if you have something that is going to be protected to trade secrets, that you may want to manufacture at some point, think about delivering a box of spices or other material that is either unlabeled or labeled only with the minimum information that is required to be on that label for FDA or other regulations, rather than the exact ratio of the individual ingredients.

So, that can be a way to protect yourself there, when you are taking a trade secret and looking at broader distribution, broader manufacturing. And as I alluded to before, a trade secret is really any commercially viable proprietary information that you are gathering for your business. And again, the easiest way to lose a trade secret is to not be diligent with you, your employees, your company, to not be diligent about who you
are sharing what information with. So, it really is on you as the originator of the trade secret and as someone who is trying to preserve a trade secret to keep a close watch on who has access to what information in your company.

Last thing I will say on trade secrets is that they do not protect you against reverse engineering. If someone else would be able to take your product, your food item, whatever it is that you have that is protected through trade secrets, and if they are able to reverse-engineer it and figure out your trade secrets simply by reverse engineering, there is no legal recourse that you have at that point. Reverse-engineering is fair game when it comes to figuring out trade secrets. So, that is part of the calculus that you have to go through as the potential owner of a trade secret. You know, that is often the dividing line between deciding, “Should I protect something through a patent? Or should I protect it as a trade secret?” If it can be easily reverse-engineered, trade secret is not going to do you much good. In that case, that is where patent protection comes into play. And a patent is really the only way to protect yourself against that type of reverse-engineering. So, oftentimes, that is the tipping point between the decision to keep something as a patent, versus a trade secret.

Okay. I will just spend a few seconds on copyrights. As I said, this protects any original work of authorship: literary works, music, video. And the key to copyright protection is that whatever it is that you are trying to protect -- words, images, sound -- it must be what we call fixed in a tangible form of expression. So, in other words, if you have a great idea for a novel, and it is only floating around in your head, that is not copyrightable until you actually sit down, type out that novel, and save it in some form that we would call a fixed medium of expression. That can -- just saving it on a disk drive -- that is the distinction there, you have to find a way to affix that which you are trying to copyright in a tangible form of expression for it to be, for the copyright to go into effect. Likewise with photography, you cannot just frame or envision a frame that you would like to photograph. You actually have to record the photograph, again, in a fixed medium of expression and at that point, the copyrights would take effect.

So, these are just a number of examples of works that can be protected through copyrights. I think we talked about most of these previously, so I won't spend too much time on that.

Again, as I alluded to in the beginning, copyrights last the life of the author plus 70 years. And depending on who applies for the copyright or who the right is assigned to, there are some exceptions to that that we can talk about individually. The benefit of the copyright is it gives you as the right owner the ability to reproduce that work, and specifically to authorize others to display a work. You think about stock photography or stock video images, it is the copyright that allows the owner of those photos of those videos to restrict who has access, or who has the ability to reproduce the image or the video.
Last thing that I will cover today in the next 2 minutes or so, is just talk a little bit more about the patent right. What the patent covers, what it does not cover. And one thing that I did not mention about all of these forms of intellectual property that we have talked about so far, is that everything that I have said so far refers to intellectual property rights here in the United States. And the lesson there is that all IP is territorial. Each country administers its own intellectual property regime, whether that is patents, trademarks, copyrights, trade secrets. There is no such thing as a worldwide patent. There is no such thing as a worldwide trademark. All intellectual property is territorial. So, what does that mean for you? If you have a product, and you know, you decide that you need a patent, a lot of people start by saying, well, great. There is 160, 170, whatever number of countries, that's how many patents I need. And then you look at what that would cost to go through each individual country's patent system, to hire a local patent attorney in each country to help you navigate each country's patent system. The cost would be prohibitive, even for some of the largest companies in the world today. So, again, you need to prioritize. If you have a product that you think needs to be protected through a patent, you need to prioritize where you are going to get that patent protection.

What you need to be thinking about is one, where am I going to sell this? What countries am I going to derive significant and meaningful revenue by selling this product or by offering the service? And that may only be a handful of countries. Maybe that is the U.S., Canada, Europe, South East Asia and parts of China and Japan. So, that drastically narrows the field of countries that you need to be thinking about in obtaining patent protection. So, again, think about where are you going to be deriving significant revenue, and remembering that it is the patent that enables you to prevent knockoffs, and to prevent others from copying your product, your invention, that you have claimed in the patent. So, think about the countries you are going to be selling in.

And, two, think about where you are going to be manufacturing. That is another key component to where you should be getting patent protection. If you are going to be selling in just the U.S. and Canada and Mexico, let's say, but you are manufacturing in Southeast Asia, you really need to look into patent protection in the countries in Southeast Asia that you are you know, where you are going to be manufacturing this. Because, if somebody at the facility where you are manufacturing sees your product, sees the design of it, and you don't have a patent on that in that country, you don't have the ability to stop someone from copying that design, manufacturing it, and ripping you off and ripping off a potential source of revenue for you. So, again, those are really crucial in deciding where you should be thinking about patent protection. “Where am I going to be selling? And where am I going to be manufacturing?” And all throughout that process, we do encourage you to work with a registered patent attorney to assist you in preparing your patent application. To assist you in developing your strategy about where you may need to file a patent application, and to assist you in navigating the various worldwide jurisdictions. To make sure that you get the scope of patent protection that is going to be useful to you and your company. We get that question a lot, “can I do this myself?” There is no law, at least in the United States, there is no law that would require you to use an
attorney to file a patent application. However, we strongly recommend, the USPTO strongly recommends working with a registered United States patent attorney whenever filing a patent application in the United States. And, that I think provides a pretty good segue to some of what Grant is going to talk about it what resources there may be available to you to work with a patent attorney, either at low cost or no cost, and some of the other USPTO and pro bono resources that may be able to assist you in actually preparing a patent application, filing a patent application and navigating through the USPTO in filing and obtaining your intellectual property rights.

So, with that, I think I will end my remarks here, and see if there are any additional questions I can get to before turning it over to Grant to talk about some pro bono resources.

Jay Lyman: There are some fantastic questions coming in. Thank you. You have been answering some of them also, as we went. So, I'm glad we saved some of these for the end. Let's see. I wanted to go back to one of the questions. Oh. I think you covered this but just want to make sure we know the difference between when we are searching for existing patents, trademarks, and copyrights. What is the best process, the best place we can search for each of those?

Steve Korziol: That's a great question because it gives me a chance to do a shameless plug for our office. We offer a monthly patent search workshop online. We teach you how to use some of the most sophisticated tools to do a patent search. These are the same tools the patent examiners will use when they do a search. And I will send the link to Jay for those who may be interested in registering. But otherwise, you could always go to USPTO.gov and click the events link to take a look at all of the upcoming training events that we have, and you are never more than a month away from at most, from our upcoming patent search workshop. And similarly, we offer trademark filing and search workshops as well that help you navigate the trademark searching. There is, as I understand it, one of the very next if not the very next series in this online course will be from a trademark expert from the USPTO who is going to focus exclusively on trademark searching and some tips and tricks for trademark filing. So, stay tuned for that as well.

Jay Lyman: That is on October 28th. If you have not signed up already, same time, same station. 10 AM-12 on October 28. Please sign up if you have not already for that one.

Steve Korziol: Excellent.

Jay Lyman: Let's see. Do we have time for other questions?

Steve Korziol: Sure.
Jay Lyman: Let's see. Here is one, this person has a name but not yet a logo. They are asking, should I go ahead and file for that trademark now? And add a logo plus name later? Maybe like process. Is it better to do all of that all once? Or you know, kind of think about it, like, you know, I could see there is a cost aspect to this as well maybe.

Steve Korziol: Right. It is difficult to answer you know, what is best for you and your individual situation. You know, what we often tell people is that if you are using a mark in commerce today and you know that that is a mark that you want to really continue to associate with your brand, with a particular product, it is on store shelves or on an e-commerce platform today, that is a pretty good sign that it may be ready for registering with the USPTO. If it is more in the hypothetical phase or there is still some design going on, or you are not sure the extent to which you want a particular mark or symbol or slogan to represent your brand, then it is ultimately up to you to see if that is going to be cost-effective for you to file today, or to wait until you are more comfortable financially to go through the expense of registering that particular mark. So, ultimately, that is a business decision that you need to make.

You know, one thing that I did not mention today that Jason will talk about more in the next lecture is that there is a type of trademark known as an intent-to-use mark. So, that is something that you are not currently using in commerce, you are not currently associating with any particular product, but you have an intent to use that mark in some point in the near future. So, if you're interested in learning more about navigating that, I would recommend checking into the next session where our trademark expert will get into a little bit more detail and help you navigate the distinction between a mark and an intent-to-use mark.

Jay Lyman: Thank you. That's great, that's perfect. Jennifer, are there any questions you have seen that we haven't answered and think that we should address before we move to the next section?

Jennifer Fan: I think the only one that I saw was, does one have the choice of a patent versus a trade secret? I guess that goes more to the IP strategy portion of Steve's remarks. But Steve, if you want to talk a little bit about that?

Steve Korziol: Yeah, absolutely. And it really is up to you. And like I said, some factors to keep in mind are costs. In many instances, a trade secret -- I don't want to say it costs nothing to protect, because there is often some type of software that you will purchase to restrict who has access to what systems within your company, there is the cost of time and diligence that you go through to keep something secret, there is the cost of the nondisclosure agreements that you work with your attorney to draft for each of your employees. So, there is certainly a cost to protecting the trade secret. But often it pales in comparison to working with the patent attorney to actually file a patent application. So, cost certainly is a factor.
But, like I said, so is reverse-engineering. How easily copiable is what you are trying to sell? How easily reverse-engineered or how easy would it be to copy the product that you are selling? And, if anyone within a weekend of tinkering could reverse-engineer your product to figure out how to manufacture it themselves, then, again, the trade secret really is not going to help you. A trade secret will not be able to prevent someone from copying that product. So, if you have something that can be copied easily, you really need to think about patent protection in order to prevent someone else from copying that and attempting to sell. So, that is -- yes, it is your choice, but that is a key factor to keep in mind.

And the last thing I will say on that is, remember I said at the very beginning, patents expire. Patents expire after 20 years. Again, the patent document itself is you writing an instruction manual essentially on how to make and use that which you have invented and in exchange for that, you get a 20-year period of exclusivity. After the 20 years are up, essentially, your idea goes into the public domain at that point. And you have no ability to protect it. Whereas a trade secret, in theory, lasts as long as you effectively keep it secret. If Coca-Cola had patented the recipe -- assuming it would've been patent eligible -- but if Coca-Cola had patented the recipe for Coke, 150 years ago, you know, that patent would've been long expired, and Coke would be generic at this point. So, that is a trade-off as well. If you are able to effectively keep something secret, and you think it is not easily reverse-engineered, you know, that tips the scales in favor of trade secret. But ultimately, that is a conversation that we encourage you to have with a patent attorney or with an IP attorney that can help you best identify what you have and strategize ways to protect what you have. It's a good question.

**Jennifer Fan:** Great. Thank you so much, Steve. I know that there are a few more questions in the Q&A, so hopefully we can answer them at the end, but I do want to make sure that Grant has enough time for his presentation. So, I will go ahead and introduce him now.

We are fortunate to have Grant Corboy from the Office of Enrollment and Discipline, where he has been as a patent attorney since 2016, join us today. And I also personally have the pleasure of working with Grant on the Washington Pro Bono Patent Network which the University of Washington School of Law established I think maybe a year after Grant had gotten to the OED. As a member of the patent pro bono team, Mr. Corboy is making sure that all inventors have access to the patent system including those who are financially under-resourced. In addition to his patent responsibilities, he serves as a staff attorney investigating discipline and enrollment matters. He was a primary patent examiner for the USPTO and prior to joining the USPTO in 2010, he worked for 15 years in industry as a design engineer, a project manager, and government contracts manager with DuPont and Lockheed Martin. He is a member of the Maryland Bar and is registered to practice before the USPTO and graduated Cum Laude from the Baltimore University School of Law and received a Bachelor of Science in mechanical engineering and his Master of Science in structural
engineering from the University of Delaware. Thank you, Grant, for being with us here today and I will turn it over to you.

Grant Corboy: Can you hear me? Great. Let me share my screen. Okay. Thanks everybody. Again, as Jennifer mentioned, my name is Grant Corboy with the United States Patent and Trademark Office in the Office of Enrollment and Discipline, and I am the patent pro bono team administrator. So, let's get right into it, and let me see what I can do here. There it is. So, the Patent Pro Bono Network. What is it? It assists financially under-resourced independent inventors and small businesses by matching them with attorneys that provide their services free of charge to help prepare, file and prosecute patent applications. Prosecute is a funny word for arguing with the office for the reason why you should get a patent application. So, why do we do what we do here at the office? Well, the easy answer is, it is actually statutorily prescribed. One of the most significant changes to the patent system came about in 2011, with the America Invents Act. Really, in a nutshell, what that act did was, it made us in parity with the rest of the world. The rest of the world said, the first to invent is the first to file. So, the AIA changed it so now we are a first to file system so that essentially means when you file is when the USPTO and the law considers when you actually have invented the application. So, there is a bunch of other changes in the America Invents Act. But, later on in the statute, section 32 actually directs the USPTO director to work with and support intellectual property law associations across the country in the establishment of pro bono programs. That is the key word there: “in the establishment of pro bono programs.” Because as you will see later, the real work that is being done is by Jennifer Fan and the University of Washington and the regional programs that do the work. The USPTO really just encourages the formation and tries to establish this network throughout the United States so everybody has access to free patent prosecution assistance.

Also, it is memorialized to some extent in our strategic plan. The USPTO strategic plan calls for us to enhance the assistance we provide independent inventors and small businesses. I cannot think of anything that enhances that more than assistance in providing free legal assistance to people who cannot afford it. So, that has really helped individual inventors and small businesses.

Also, I mentioned before, really the engines that do the work are the regional programs. We have 21 independently operated regional programs throughout the United States that their entire focus is to work with and match people that qualify that are under-resourced inventors and small businesses with volunteers to help prepare, file, and prosecute their patent applications with the USPTO.

So, here is a map of the United States. And this shows the coverage that we have. In 2011 with the passage of America Invents Act, there was one state that was providing free patent prosecution assistance and that was Minnesota Legal Corps. By 2015, we had complete nationwide coverage. And we do that through what we call the regional program model. That regional program model, you will see for instance, you have one
state such as Washington State that has the Washington Pro Bono Patent Network that is operated by the University Washington School of Law. And that covers the residents of the state of Washington. We will have some other programs to get nationwide coverage such as Pro Bono Patent which is in Denver, Colorado, and that will cover Montana, Wyoming, Utah, Colorado and New Mexico. So, through this model, we were able to get coverage in all 50 states, including the District of Columbia. I am also happy to announce that just this past summer, we are able to expand coverage to include Puerto Rico.

The regional programs may cover individual or multiple states, as I said before. But they are operated by three types of organizations. One is a nonprofit organization. When we were going out looking to establish these programs, we noticed that some people were already doing this work, and they’re volunteer lawyers for the arts organizations. There were organizations for creative artists that were already providing trademark and copyright assistance, and we have since encouraged them to expand their portfolio to include patents. And, the great benefit of having them help with the program is that if you are a creative type, if you are an artist, you cannot only get patent assistance, they will also help you with filing a trademark or filing a copyright registration.

Also, universities and like I said before, we have the Washington Patent Pro Bono Network that is operated by the University of Washington. We have about six other universities throughout the United States that provides the same type of assistance to their regions. And then lastly are bar associations. We have one Bar Association, the Michigan bar, that covers Michiganders. They provide the assistance free patent prosecution assistance and match the inventors in the state of Michigan with those people that need it. It is important to note that the regional programs are truly independent. The USPTO provides guidelines but they follow their own policies and procedures. So, in general, and we will talk about the recommendations that the USPTO puts forth, but it really is important to contact your local regional program to see if there's any additional requirements, or if there are any changes to the USPTO guidelines for operating their program.

Like I said, these regional programs are the engines that do the work. They’re responsible for the screening, of the match, the recruiting of volunteers, and the tracking thereafter. So, they are doing the work and the bulk of their work is screening the applicants. There are generally three things they check for. One is income. The second is knowledge of the patent system. Last is an actual invention, not just an idea. I’ll talk more about that in the upcoming slide. But I do want to take a second to just talk about the importance of income. That is, without a doubt, the most important aspect of what the regional programs do. The attorneys that are volunteering their time free of charge want to make sure that the person that they are helping out cannot afford legal services. So, in essence, the regional programs are certifying to the volunteers that you, the patent applicants, are in need of legal assistance and could not afford it otherwise. So, a great deal of their time is spent making sure that you meet the income requirements of the program.
So, regarding income, we have got the gross household income. Again, regional program dependent, but usually it is limited to 300% of the federal poverty guidelines. To give you an idea, a single person can have an income up to $38,280. Again, the key word here is household. So, if you have additional dependents in your household, that number goes up. So, and I tell everybody this, if you have a question, I always encourage people to apply to the program. Because, sometimes, you know, you think you don't qualify, but there are some circumstances, if you provide that information to the regional programs, they are the best situated or circumstanced to tell you whether you qualify for free patent prosecution assistance.

The next item that the regional programs check is knowledge of the patent system. Some programs do that by checking to see if you had filed a provisional application. The thought process being that if you filed a provisional application with the office, you at least know how to write an application, you have paid the USPTO fees, you have an idea of how the system works. But most of the programs including the Washington Pro Bono Patent Network require you to complete a certificate training course. And here are the links for the certificate training course. I will let you know; it takes usually about an hour or an hour and a half to complete. And it gives an overview, much as Steve just did, of the patent system and the patent prosecution process from what you should do prior to filing, to filing a provisional application, to filing a utility application, to responses that the offices provide to those applications, to allowances and the abandonment and those types of things. The reason we do that is because, when you are then matched hopefully later with a patent attorney, you then have the ability to interact better because you understand, “I just got the drawings that the patent attorney is requesting that I provide. I understand because if I can't describe it in words I need to show exactly, what are the elements of my invention.” So, it really does help you interact with your attorney. I will say that the course is approximately an hour. There are 6 segments. There are questions on it. And at the end, you have a certificate and you will put your name in the certificate. And then you could save it to a PDF or just hit screen-print and save it. And then a lot of times the regional programs will ask you to certify that you have taken the course, and then you have that certificate as proof that you have taken and passed the course.

Lastly is, you have to have an invention, not just an idea. For instance, you cannot say, I want a new fuel that is going to improve fuel efficiency. That is an idea. If you actually have a chemical formulation, for a fuel that actually produces higher miles per gallon or something to that effect, then that is an actual invention. And so, I'm going to take some time here because a lot of the comments that we get in the Pro Bono inbox say, “Hey, not quite got my prototype and I want to finish my prototype prior to filing.” The prototype is great. Prototype absolutely is a reduction of practice, shows that you have an invention, but it is not always necessary. Sometimes you can have it detailed drawings. If the drawings are sufficient to show somebody else how to make, use, or practice your invention, then the drawings are sufficient. Or you could on paper be able to describe your invention with such particularity that if I provide the paper to somebody else, they would be up to make, use, or practice the invention. So, if you are able to do that, then you meet the
requirements for having an invention and you should consider applying to the program. I do want to mention here that even though the attorney provides their services free of charge, the USPTO does still require fees. We don't waive the fees, we are required to actually charge fees. But what we have done as we have actually reduced the fees by 75%. We will talk about micro-entity status a little bit later. So, we have reduced the fees significantly. But you, the applicant, are still responsible for those fees.

Lastly, and as we are talking about fees, it is important to mention that many of the regional programs do charge an application fee anywhere between $25 and $150. The reason they do that is, there are administrators at these regional programs that are responsible for screening your application, certifying that you make the financial requirements, that it is not an incomplete application, that you do have all the information you need for screening. And that takes time and effort, and a lot of these programs are small, independently operated mom-and-pop type of organizations, nonprofits. So, that is why they do charge a fee and I do know for the Washington Pro Bono Patent Network it is about $50.

So, just to also note, there are three requirements but in addition to those requirements, some other programs require additional things. Some might require you to file a provisional application to gain access to the program. Others might require you to do a prior art search. Prior art is a funny word for just going online and figuring out other similar-type inventions. And now, is my opportunity to give a shameless plug to The Seattle Public Library, the Patent and Trademark Resource Centers are great resources for if you have an idea or you have an invention, and you want to see if somebody else has, you know, a similar invention. If you can go to the Patent and Trademark Resource Centers, they will help you search your invention to see what else is out there. And again, even if the regional programs don't require you to do a prior art search, I do recommend it, because it is always nice to know what similar inventions are. You might find out that “Oh, my gosh, it is already out there.” It might save you time when you do a prior art search.

I also might want to mention a lot of times we get people that are so excited about their invention and they go and file a provisional application, which is great. And then, the provisional application is valid for 12 months in general, with certain exceptions. So, it is valid for 12 months and you have to file -- if you want the benefit of that date -- you have to file a non-provisional application within the tendency of that provisional application, or within 12 months. So, sometimes, we have individuals who filed a provisional application and then they wait eight months, nine months, 10 months to apply to the patent pro bono program. Then, by the time you apply to the program, they screen your application, you then are selected by an attorney, an attorney would have to understand your invention, file an application. It might be already too close for them to be able to do that. So, if you have an upcoming deadline, the takeaway here is, as soon as you file the provisional application, if that is something you have done, please apply to the patent pro bono program as soon as possible so that we can make sure that you're not going to run into any expiration of the patent provisional application before being matched and getting placed with an attorney.
So, I mentioned that unfortunately, the USPTO cannot waive its fees. But we do offer 75% reduction in fees. And anybody who qualifies for the patent pro bono program, which we’ll say for the Washington program is 300% of the federal poverty guidelines, must necessarily qualify for micro-entity status. So, I'm just going to go through these really quickly so you understand what micro-entity status entails and you will see sort of why it falls -- why pro bono falls within the micro-entity status. So, the first is, you qualify as a small entity. So, for those of you that are applying as a business, that means you have less than 500 employees. Okay?

The second one is that you are a named inventor on no more than four previously filed non-provisional patent applications. And the reason is, if you're a prolific filer or you are a filer or who has filed a bunch of applications for the office, then, you should then qualify for small, which is a little bit less, I think 50% reduction in USPTO fees. But, if you are a first-time filer or have less than four, the USPTO wants to give you the opportunity to have that 75% reduction in USPTO fees.

So, next is median household income. Three times the median household income to give you a sense. That is over $150,000. So, as we said before, for a single person, the pro bono requirement for three times the federal poverty guidelines was $38,200 some odd. So, that is well below the median household income. So, you necessarily would qualify for micro-entity status.

And lastly, if you're a venture who would qualify, but you have assigned your right to your invention or are under an obligation to assign your ownership interest to a large organization or large company, well, the large company can afford to pay a greater fee. So, therefore, you are not qualifying for micro entity status.

But again, we just wanted to go through this with you because you understand that while we cannot waive our fees, we have reduced them by 75%. And for those fees, everybody from the patent pro bono program should qualify for micro-entity status.

So, matching with the patent practitioner. How does the matching process work? So, assume you qualify for a patent pro bono assistance. How it works is generally, the regional program will send your name along with a brief description of your invention out as an email to volunteers for that region that have said that they want to volunteer to provide free assistance. Sometimes it is email, sometimes there is a website that is restricted access only to the volunteers. So, the long and the short of it is, that the regional volunteers there are responsible for selecting your application. And there is no guarantee, unfortunately, that a practitioner will choose to work on your invention. There are several reasons for that. For instance -- and we can go back to my example on the chemical fuel that increases fuel efficiency, the additive that increases fuel efficiency - - well, that is a chemical engineering type application. So, if a regional program has three or four chemical
engineers who are attorneys, and they are already assigned and working other applications, then the electrical engineer that is an attorney would not be really qualified or feel comfortable in doing a chemical art for your application. Also, if you are doing a regenerative brake for an automobile and the attorney already is working as an attorney for like a large automotive industry, because he is working for another client that deals in automobiles, that attorney might not want to pick up your application because there would be a conflict because of the work he is doing for his other client. So, there are several reasons, but what is important here is that you follow up with the regional programs periodically. If you get the letter that says you have been qualified, and they are trying to match you, if you have not heard from them in a month, please contact them to verify your status and see how things are going. Obviously, we don't want you to inundate them, they are very busy. But if you have been qualified and approved, we encourage you to reach out to them. You really have to be a champion for your invention.

Also note, that as we started with AIA and first to file, because we are first to file, after a period of time, if no practitioner has selected your application, the programs then will send you a letter to disengage from you and let you know that unfortunately, an attorney has not selected you, and they will provide a list of resources -- and we will talk about when later in this presentation -- but they will provide a list of resources that you can reach out to in hope of getting assistance to prepare and file your patent application.

It is important as an inventor to be an active participant in your patent application. You really have to be a champion and advocate for your invention. So, when working with your attorney, make sure you are able to describe your invention. I mentioned it earlier, with The Seattle Public Library, it is tremendous to be aware of similar inventions or solutions to the problem. For instance, if you know that there is something out there in the marketplace that is very similar to yours, but you added this feature, well, telling the attorney, “Hey, this is very similar to this, but I added this feature and it makes it work better,” that clues the attorney so that he or she knows that they are going to focus on that feature because that is what distinguishes your invention from everything else that is out there.

I will also say, it is very important to be responsive to the practitioner’s request. These practitioners are very busy. They are very expensive. I think their standard hourly rate on average is $375 per hour. So, they are usually very busy not only with your applications but with the other applications that are on their docket. So, if they have a question for you, the only thing I can ask you to do is be responsive to it and get back to them as soon as possible with an answer to the question.

Also, the inventor should be aware that the practitioners may require you to sign an engagement letter or retainer agreement. An engagement letter is a legal word for contract, and it is just a contract that sets the terms of your engagement or the representation. So, it’s going to have information such as the scope of the services provided, any ancillary fees, for instance, we will talk about this later. But the patent attorneys are
attorneys that draft words and letters and claims and specifications. They are not drafters. So, occasionally, they are going to need drawings generated to finish out your application. Well, those fees might be borne by the attorney. But in general, they are borne by you, the inventor. So, an engagement letter would say, “Hey, any additional drawings that need to be created will be borne at your cost, at your expense.” Also, those engagement letters are going to have the reasons that the practitioner may withdraw, failure to cooperate or any of those other reasons. It is important because it provides both the attorney and you with the expectations for your representation.

And lastly here, avoid verbal agreements. I don't think that is a problem here, because to my knowledge, all the attorneys in the program are using written engagement letters.

So, it is also important to understand that the scope of services that are provided may be limited to just a portion of the patent process. There are many reasons for that; depending on the art that you are submitting or the area of your invention, it can sometimes take anywhere between 18 and 24 months for the office to issue an action and get it through to an allowance. Because of that timeframe, sometimes attorneys have time right now so, they say, “Hey, I am willing to volunteer because I have the ability to prepare and file a patent application. But I really don't know if I am going to be available 18 months or 24 months down the line.” So, they might limit their scope of services to just simply preparing and filing the patent application, or maybe a response to a USPTO communication. But the important thing here is -- and this goes back to the engagement letter -- is the terms are an agreement between you and the attorney. So, if the attorney is only able to prepare and file your patent application, but you really need somebody that stays on for the duration of it, then you don't agree to the engagement. You say thank you very much, then you go back to the regional program and let them know, “Hey, I really need somebody that is sort of a cradle-to-grave, that is not only preparing filing, but also, the response to the office actions as well.”

So, again, as I mentioned before, you are responsible for all USPTO fees. You, the inventor. You also may need to pay ancillary drawing fees. Because you are responsible for the fees, you know, first of all, don't ask the patent practitioner to pay those fees. The practitioners may ask for your credit card number. That credit card number will be used to pay the USPTO fees. And again, always be an advocate. If you're not sure of anything, make sure you ask questions of your attorney.

So, all that is good. But now, how do I get the free patent prosecution assistance? Well, we do that by applying directly to the regional program. So, to find the regional program that serves you, go to www.USPTO.gov/probonopatents. That is our web page. That is the webpage for the USPTO that has all information about the patent pro bono program. And, you know, I recommend going on it and we have got videos of people that have gone through the program, videos from attorneys, frequently asked questions. So, it is a great resource. But, in the middle of that page is a map of the United States. It is as simple as clicking
on your state on the map that will say you are leaving the USPTO office and then it will teleport you or jump you or link you to the regional program. And there you can fill out a client intake form that will have a list of all the requirements for filing a patent application and acceptance into the program. That is the way to do it.

Also, if you have a question in general, please send your questions to the pro bono mailbox at probono@USPTO.gov. I will say that sometimes we do get questions, for instance, “Can you tell me the status of my patent application or my application to the pro bono program?” That does not come to us. The applications go to the regional programs. So, we would not be able to answer that at probono@USPTO.gov. If you have general questions on the program that services you, I had a question the other day about somebody who was blind and needed assistance, “How do we go about doing that?” Those are the questions that should come into our mailbox. We can point you in the direction of that assistance.

Another option is the law school clinic certification program. That is another resource that provides pro bono assistance with the added benefit of not only do they provide patent prosecution assistance, but they also can help with trademarks as well. These are students under the guidance and supervision of an approved faculty clinic supervisor. One of the questions I get all the time is, “Well, I am concerned about the clinic certification program because it is a student providing the assistance and I am not getting the same assistance as if I went through a pro bono patent attorney.” So, it is important to understand that these programs are certified by the USPTO, and all of the students report directly to a faculty clinic supervisor, and that supervisor has practical experience. They are actually someone who has filed trademark applications or filed patent applications. So, you get the same quality delivery of services in the law school program as the patent pro bono program. Similarly, what they are doing is they are providing their services pro bono or free of charge to the inventors and applicants. You are still responsible just as in the patent pro bono program for all the USPTO filings, fees and costs. In order to learn more about the program, please visit that link. USPTO.gov/lawschoolclinic.

I will say, and this is important, when you get on to that page, there is a table with four columns. The first is the name of the institution that is providing the free patent, trademark, or both, assistance. The next is the email address of who you would email if you are trying to get free legal assistance. The next is the practice area. So, you will see on the following page, that some of the schools do trademark only, some do patent only, others do patent and trademark programs. The last column on that page is a geographic area. For instance, the University of Washington School of Law has both the patent pro bono program and the law school certification program. Under the law school clinic certification program, the region they cover is only Washington State but, if for some reason, you apply to that program and they don't have a resource available to help you, you can, for instance, apply to the University of Miami. The University of Miami has a program that, even though it is in Miami, they cover all the United States. So, it is important to look on that map to give you a sense. There are more than 60 law school clinic certification programs throughout the United
States. About half of them do both patents and trademarks, 22 do trademarks only, and there are 6 that only do patents. I don't know how much time I have left but at this point, I will turn it over to answer any questions we have on the patent pro bono program with the remaining time.

Jay Lyman: Wow. There is a lot of information there. That is amazing. We're getting some comments in the chat, too, saying the same thing, like how incredible and awesome this is that there’s all this help and assistance and I mean, wow. Really amazing stuff. One question. I don't know if this is a good question for you, Grant, or Steve, or for Professor Fan. But there was a question that going back to the patent idea, when you are searching, how do you avoid getting influenced by other searches for your own patent idea? Is there some strategy there? That is a question that came up.

Steve Korziol: Sure. I am happy to jump in and take a first crack at that. Great question. And it really points to the idea that searching is very much an art. Patent searching in particular is very much an art. And I think, in many ways, we are conditioned to think of anything that we can think of as being at our fingertips as being a Google search, or choose your favorite search engine. You type in a few words and you can summon just about anything that you are looking for. I would like to disabuse you of that when you are thinking about patent searching because that is very much not the case; patents are written in often a dense legalese. Every word in a patent document is often chosen very carefully. And it can be chosen to illuminate as much or to obfuscate what the actual invention really is.

So, something to think about, you know, as you are planning a patent search: you need to go into it with a clear understanding of what is novel about your invention. What have you done that either has not been done before, or has not been done in quite the same way, or with quite the same efficacy as what you are doing? And then, you need to think, not only about how you made that happen, but think about how someone else might have approached that. Are there different paths that you could have taken to get the same result? Likewise, think about the words that you are using to describe what it is that you have done, and especially think about how many different synonyms you can come up with. Don't assume that the language that you are using to describe your invention is the only way that your invention could be described. You really need to get creative. Think about all the various synonyms for what it is that you are doing.

And the last thing I will say is, it does not hurt to read, maybe not cover to cover, but at least skim a number of patent applications and published patents that are in a similar field of endeavor to your invention. You know, regardless of what that invention is. You know, look at how your competitors describe their inventions. Look at how people in your technology area, how many drawings do they include? How many flowcharts do they include? What type of language do they use when they are describing their invention? Use that to inform the synonyms that you are using and the overall breadth of the patent search that you are doing.
The last thing I will say about that, as a former patent examiner myself: whenever I would pick up a brand-new patent application, you read it, you understand the technology, you look up the drawings and the specification, but most of my time as a patent examiner was spent searching. The bulk of my job as a patent examiner, and Grant’s job when he was an examiner, is spent doing that patent search. Seeing if something has been done before. So, that is something that I hope you keep in mind as well is that we are not talking about a 5-to-10-minute Google search. For your invention, it is really something that you need to deliberately and systemically approach, and it is something that you need to kind of start immersing yourself in, in some of the published patent literature in your field of endeavor, to start that process. So, I will open that up to Jennifer, Grant, or anyone else who may want to chime in.

**Jennifer Fan:** I thought that was a great response. Unless Grant wanted to add anything else.

**Grant Corboy:** I just keep giving shameless plugs to the Patent and Trademark Resource Centers. I know for the programs that require prior art search as a condition preceding getting accepted into the patent pro bono program, we send them over to the Patent and Trademark Resource Centers. Because the librarians there can help them actually formulate their searches and actually help them look through the applications on the patents that helps with the terms that Steve was talking about. They can formulate good searches on their idea of the invention.

**Jennifer Fan:** So, with that, I know we are a little bit over time and I just want to be respectful of everyone's time. So, thank you everyone for joining us. And special thank you for Grant and Steve in their presentations. Thank you for Ken Takata who’s behind-the-scenes. He's a regional outreach officer at the Silicon Valley regional office. And also, to the technical support provided by the USPTO. Thank you so much. Jay, I will leave it to you if you have anything else you want to add before we end.

**Jay Lyman:** I want to also say thank you to you, Jennifer, and to everyone that you just mentioned as well. And everyone that has helped put this all together. And also, shameless plug for upcoming programs. We have the trademark workshop I want to remind folks of on the 28th. And then, we still had some room at some of our IP consults coming up, too. So, anybody that is registered will get an email and I will have links to a lot of the stuff we talked about. So, look for that probably later today or tomorrow. So, thank you all for being here.

**Jennifer Fan:** Thank you.

**Steve Korzoi:** Thank you for having us. We really appreciate it