Fundamentals of U.S. Patent and Trademarks – Searching and Procurement

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Agenda

- U.S. Patent Procurement
- Patent Searching
- U.S. Trademark Procurement
- Trademark Searching
- Overlapping Universes of IP
- Case Studies (time permitting)
U.S. Patent Procurement

- USPTO’s Patent Process Overview
- www.uspto.gov/patents-getting-started/patent-process-overview
U.S. Patent Procurement – how long will it take?

www.uspto.gov/dashboards/patents/main.dashxml
U.S. Patent Procurement – How much will it cost?
U.S. Patent Procurement – a financial timeline

- **Preparation**
  - Your Time
  - Attorney Time

- **Filing**
  - Filing Fee - $75/$150/$300
  - Search Fee - $165/$330/$660
  - Examination Fee – $190/$380/$760
  - **Total** – $430/$860/$1720

- **Examination**
  - Your Time
  - Attorney Time
  - First RCE - $325/$650/$1,300
  - Second RCE - $475/$950/$1,900

- **Issuance**
  - Issue Fee - $250/$500/$1,000

- **Maintenance**
  - @ 3.5 years - $400/$800/$1,600
  - @ 7.5 years - $900/$1,800/$3,600
  - @ 11.5 years - $1,850/$3,700/$7,400

- **Fees for a U.S. non-provisional patent application without extras fees for claims or pages**
- **Micro Entity/Small Entity/Large Entity**
Patent Searching

- Types of Searches
  - Patentability
  - Validity
  - Infringement
  - Clearance
  - State of the Art

- Tools and Techniques
  - USPTO’s Seven Step Search Strategy
  - USPTO Search Example
Types of Prior Art Searches – Patentability Search

- To determine if an invention is patentable / claim scope
- Look for prior art disclosing the invention or something similar
- Any “public domain” knowledge
Types of Prior Art Searches – Validity Search

- To determine the validity of an issued patent
- Look for prior art documents that would invalidate one or more claims in the issued patent
Types of Prior Art Searches – Validity Search (example)

What is claimed is:
1. An apparatus, comprising:
a vehicle ("ego-vehicle") configured to be autonomously navigated in a peloton along a roadway, wherein the peloton comprises the ego-vehicle and at least one additional vehicle, wherein the ego-vehicle comprises:
a vehicle navigation system which is configured to:
   based on a comparison of driving ranges of each of the ego-vehicle and the at least one additional vehicle, determine a particular configuration of the peloton, which comprises a particular peloton position in which the ego-vehicle is navigated relative to the at least one additional vehicle, which reduces a difference of the relative driving ranges of the ego-vehicle and the at least one additional vehicle; and
generate a set of control commands which cause the vehicle to be navigated in the peloton at the particular peloton position, according to the particular configuration of the peloton.

Related U.S. Application Data

Provisional application No. 62/232,853, filed on Sep. 25, 2015.
Types of Prior Art Searches – Infringement Search

- To determine whether a patent claim would be infringed
- Compare a proposed product or service to non-expired U.S. patents

September 25, 2015
+ 20 years
+ 0 days
= September 25, 2035
Types of Prior Art Searches – Clearance Search

- To determine if an action is a “safe” practice of the prior art ("safe" = reduced risk of patent infringement liability)
- Try to find that the invention has been “dedicated to the public”

**Scope**

- Expired or Lapsed Patents
- Abandoned Published Patent Applications
Types of Prior Art Searches – State of the Art Search

- To determine the “lay of the land” in a technical space
- Look at the broad, general inventive concept without specific implementation details
USPTO’s 7-Step Search Strategy

1. Brainstorm Terms
2. Find Cooperative Patent Classification (CPC)
3. Verify CPC
4. Retrieve Issued U.S. Patents with CPC, Review and Narrow Results
5. Review Each Relevant Patent in Depth including References Cited by the Examiner and the Applicant
6. Retrieve U.S. Patent Applications with CPC, Review and Narrow Results
7. Broaden Your Search

USPTO Search Example – Step 1

- Invention: Umbrella with a new rib design to eliminate collapsing or inverting due to winds

Step 1: Brainstorm Terms
- Umbrella
- Rib
- Parasol
- Sunshade
- Wind-resistant
USPTO Search Example – Step 2

Step 2: Find CPC

- www.uspto.gov
- Search for “CPC scheme umbrella”
- Scan results for the best match: “A45B 25/22 Devices for increasing the resistance of umbrellas to wind”
- HINT: Adjust indentation level
- HINT: Use CTRL+F
USPTO Search Example – Step 3

Step 3: Verify Relevancy of CPC

- **A45B 25/20**
  - Devices for increasing the resistance of umbrellas to wind

- **A45B 25/22**
  - . Windows in covers

- **A45B 25/24**
  - . Protective coverings for umbrellas when closed

- **A45B 25/26**
  - . Ventilated coverings

- **A45B 25/28**
  - . Drip receptacles for umbrellas; Attaching devices therefor

- **A45B 25/30**
  - . Name-plates; Badges; Labelling or marking devices; Means for attaching same (attached to the umbrella stick A45B 9/06)

- **A45B 27/00**
  - Ladies’ or like fans

- **A45B 27/02**
  - . with mechanical hand-drive

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**A45B 25/22**

*Devices for increasing the resistance of umbrellas to wind*

**Definition statement**

*This place covers:*

[Diagram of umbrellas]
USPTO Search Example – Step 4

Step 4: Retrieve Issued U.S. Patents with CPC

- www.uspto.gov/patent
- Use PatFT tool
- Search String: CPC/A45B25/22

❖ HINT: No spaces
USPTO Search Example – Step 4 (continued)

Step 4 (cont.): Review and Narrow Results of >100 patents, including U.S. Patent No. 10,092,069

- **HINT**: Click “Images” Button
- **HINT**: Click “Full Pages” Button
USPTO Search Example – Steps 5 & 6

Step 5: Review Each Relevant Patent in Depth including References Cited during Examination

- **HINT:** List of the references cited by the Examiner and the Applicant starts on the front page of the patent

Step 6: Retrieve U.S. Patent Applications with CPC, Review and Narrow Results

- Use AppFT tool
- Example: CPC/A45B25/22
USPTO Search – Step 7

Step 7: Broaden Your Search

- Consider inventor(s) and assignees of relevant patents.
USPTO Search – Step 7

Step 7: Broaden Your Search

- **Keyword Searching**
  - **HINT:** Use OR between synonyms
  - **HINT:** Place phrases and terms of art in quotation marks
  - **HINT:** Use truncation symbols ($)

- **Other sources:**
  - Search the Espacenet patent database @ http://worldwide.espacenet.com
  - Search Non-Patent Literature Disclosures
Trademark Procurement

- USPTO’s Trademark Process
- www.uspto.gov/trademarks-getting-started/trademark-process

TM → ®
Trademark Procurement - flowcharts

1(a) Basis
Use-in-Commerce

1(b) Basis
Intent-to-Use

Follow 1(a) timeline, then...

1. Application filed
   - About 3 months

2. USPTO reviews application
   - About 1 month

3a. USPTO approves and publishes trademark
   - About 3 months

3b. USPTO issues letter (office action)
   - Within 6 months

4a. You submit timely and complete response
   - About 1-2 months

4b. You do not respond and application abandons

5a. USPTO approves and publishes trademark
   - About 3 months

5b. USPTO issues final letter (office action)
   - Within 6 months

6a. You file an appeal and/or submit timely and complete response
   - About 1-2 months

6b. You do not file appeal or fix issues and application abandons

7a. USPTO approves and publishes trademark
   - About 3 months

7b. TTAB processes your appeal
   - Every 6-8 months

8. USPTO registers your trademark
   - Every 10 yrs.

9. You file Section 8 declaration
   - Every 5-6 yrs.

10. You file Section 8 declaration and Section 9 renewal

Trademark Procurement – a financial timeline

- **Preparation**
  - Your Time
  - Attorney Time
  - Search Fees?

- **Filing**
  - Filing Fee - $400/class (or $275/class if electronic filing)

- **Examination**
  - Your Time
  - Attorney Time
  - Statement of Use - $100/class
  - Extension of Time - $125/class

- **Maintenance**
  - §8 Affidavit between 5th & 6th years - $125/class
  - §§8 and 9 Affidavit every ten years - $425/class

= $
Trademark Searching

- www.uspto.gov/trademark
- Exact mark
- Part(s) of the mark
  - HINT: Try sounds-like searching
- Combine part(s) of the mark with an International Classification (IC) (Find @ www.wipo.int/classifications/nice/en/)
- Combine part(s) of the mark with goods or services
- Other sources: common law use (search online)
Possible Overlapping Universes of Intellectual Property in the United States

Function

Utility Patents

E.g. Software

Design Patents

E.g. User interface

Copyrights

E.g. Logo

Trademarks

Trade Dress

Brand

Appearance

Possible Overlapping Universes of Intellectual Property in the United States

E.g. Software

E.g. User interface

E.g. Logo
Case Study #1 – Beatbots LLC

- Founded by a CMU graduate student, Marek Michalowski
- Website: http://beatbots.net/

Products and Services
- Robots
- Software
- Apparel
- More?

Intellectual Property
- Utility Patents (search at www.uspto.gov)
- Design Patents (search at www.uspto.gov)
- Trademarks (search at www.uspto.gov)
- Copyrights (search at www.copyright.gov)
- More?
Beatbots’s Brand

- Trademarks
  - Registered U.S. trademark BEATBOTS in International Classes 9 (electrical and scientific apparatus), 25 (apparel), and 28 (games and playthings)
  - Unregistered marks?
- Copyrights?
- Trade Dress?
Beatbots’s Blennie

- A wobbling robot that exhibits vestibulo-ocular reflex
- [http://beatbots.net/blennie](http://beatbots.net/blennie)
- Intellectual Property
  - Utility Patent: U.S. Patent No. 9,358,475, which claims priority to a provisional patent application
- Trademarks?
- Copyright?
- Trade Dress?
Beatbots’s Ploomi

- A glowing, touch-sensitive, interactive robotic character
- http://beatbots.net/ploomi
- Intellectual Property
  - Utility Patent: U.S. Patent No. 9,421,688, which claims priority to a provisional patent application
- Trademarks?
- Copyright?
- Trade Dress?
Beatbots’s metrognōm

- A metronome and a metrognome
- http://beatbots.net/metrognom
- Intellectual Property
  - Trademarks?
  - Copyright Registration Nos. VAu001149651 (color drawing), VAu001149660 (line drawing), VAu001149726 (sculpture)
- Trade Dress?
Case Study #2: Uber Technologies Inc.

- Provider of a mobile application that allows users to request transportation services and automatically sends the closest available Uber driver to the user
- Founded in 2009
- Currently available in over 60 countries
- www.uber.com
Uber’s Intellectual Property

- Issued U.S. Utility Patents
- Issued U.S. Design Patents
- Issued foreign patents (Canada and Europe)
- Pending U.S. and foreign patent applications
- Registered U.S. Trademarks, including:
  - UBER
  - UBEREATS
  - UBERRUSH
  - UBERX
  - EVERYONE’S PRIVATE DRIVER
  - UBERCAB
(12) United States Patent
Amin et al.  (10) Patent No.: US 9,230,292 B2
(45) Date of Patent: Jan. 5, 2016

(54) PROVIDING ON-DEMAND SERVICES THROUGH USE OF PORTABLE COMPUTING DEVICES

(71) Applicant: Uber Technologies, Inc., San Francisco, CA (US)

(72) Inventors: Shalin Amin, San Francisco, CA (US); Mina Redhakrishnan, San Francisco, CA (US); Paul-Phillip Holden, San Francisco, CA (US); Curtis Chambers, San Francisco, CA (US)

(73) Assignee: Uber Technologies, Inc., San Francisco, CA (US)

(1) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 248 days.

(21) Appl. No.: 13/672,634
(22) Filed: Nov. 8, 2012

(65) Prior Publication Data

(51) Int. Cl.
G06F 3/0484(2013.01); G06Q 30/06(2012.09); G06Q 30/06(2012.09); G06Q 0/00(2006.01); H04L 29/08(2006.01); H04W 4/02(2009.09)

(52) U.S. Cl.
CPC G06Q 30/06(2013.01); G06F 3/0484(2013.01); G06Q 30/06(2013.01); G06Q 0/00(2013.01); H04L 29/08(2006.01); H04W 4/02(2013.01)

(58) Field of Classification Search
None

See application file for complete search history.

(56) References Cited

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ABSTRACT
A method for requesting an on-demand service on a computing device is provided. One or more processors determine the current location of the computing device. A multistate selection feature of a plurality of service options for providing the on-demand service is presented on the display of the computing device. The multistate selection feature enables a user to select a service option that is available within a region that includes the current location to provide the on-demand service. In response to the user selecting one of the plurality of service options, a summary user interface is presented on the display to provide region-specific information about the on-demand service based on the selected service option.

18 Claims, 15 Drawing Sheets

FIG. 2
Independent Claim 1 in U.S. Patent No. 9,230,292

What is claimed is:

1. A method for providing information about an on-demand service on a computing device, the method being performed by one or more processors and comprising:
   
   determining, via a global positioning system (GPS) component of the computing device, a current location of the computing device;
   
   providing, on a display of the computing device, a multistate selection feature that is operative by a user to select one of multiple states, each of the multiple states being associated with a corresponding transport service option that is available for request by a user operating the computing device at the current location of the computing device, wherein the transport service option that is associated with each state includes a fare or unit cost which is different than a fare or unit cost of the transport service option associated with each of the other states of the multiple states;
   
   receiving, in connection with the multistate selection feature, a user input to select one of the multiple states;
   
   in response to receiving the user input, corresponding to the selected state, providing, on the display, a user interface to provide service-specific information that is specific to the transport service option associated with the selected state, the service-specific information including location-specific information that is based on the current location of the computing device and a location of one or more service providers of the transport service option associated with the selected state, and cost information about the fare or unit cost of the transport service option associated with the selected state; and
   
   wherein the multistate selection feature includes (i) a track, and (ii) a sliding feature that can be moved amongst multiple positions along the track by the user input to select any one of the multiple states; and
   
   wherein the sliding feature includes a graphic indicator that is dynamically changed to represent the transport service option of the selected state as the sliding feature is moved amongst the multiple positions.
**Computing Device Display Screen with Graphical User Interface**

Inventors: Richard Gary Hansen, San Francisco, CA (US); Evan Peter Strobl, San Francisco, CA (US)

Assignee: Uber Technologies, Inc., San Francisco, CA (US)

**Claim**

The ornamental design for a computing device display screen with a graphical user interface, as shown and described.

**Description**

Fig. 1 is an enlarged front view of a computing device display screen with graphical user interface, under a first embodiment, and Fig. 2 is a front view of a computing device display screen with graphical user interface, under a second embodiment. The broken lines showing portions of a computing device display screen in Fig. 2 represent environmental subject matter that forms no part of the claimed design. The broken line within the solid line perimeter of the design in Fig. 2 represents a portion of the computing device display screen with graphical user interface that forms no part of the claimed design.

1 Claim, 2 Drawing Sheets

**FIG. 2**
Description:

The [device name] is designed to provide [functionality]. The [key component] is intended to [specific function].

Claim:

1. A [device name] comprising:
   - [component 1]
   - [component 2]
   - [component 3]

2. The apparatus of claim 1 wherein:
   - [additional detail]
   - [additional detail]

3. A [device name] comprising:
   - [component 1]
   - [component 2]
   - [component 3]

Reference Documents:

- [Reference 1]
- [Reference 2]
- [Reference 3]

Other Publications:

- [Publication 1]
- [Publication 2]
- [Publication 3]
Overlapping Universes of Uber’s Intellectual Property

Function

Utility Patents

Design Patents

Copyrights

Trademarks

Trade Dress

Brand

Appearance
THANK YOU!

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