University of Massachusetts Amherst

From the SelectedWorks of Paulina Borrego

Spring May 22, 2018

Patents and Trademarks Primer - Massachusetts Library Conference

Paulina Borrego

Available at: https://works.bepress.com/paulina_borrego/20/
Patents and Trademarks, Oh My!
A Patent and Trademark Primer

Paulina Borrego
Science & Engineering Librarian
PTRC Librarian
University of Massachusetts Amherst

Massachusetts Library Association
Conference
Tuesday 22 May 2018
Framingham, MA
UMass Amherst Libraries Patent & Trademark Resource Center (PTRC)

Paulina Borrego
Science & Engineering Librarian
Patent & Trademark Resource Center Librarian
Patent & Trademark Resource Centers
UMass Amherst Libraries
Science & Engineering Library
Patent & Trademark Resource Center
Copyright

Patents

Trademarks

Trade Secrets
What is a U.S. Patent?

- A limited time property right ...
- The right to exclude others ...
- Rights are granted in exchange ...
Utility Patents

- Machine
- Process
- Article of Manufacture
- Composition of Matter

- Novel
- Useful
- Not Obvious

Design Patents

Ornamental design for an article of manufacture

Plant Patents

Asexual reproduction of any distinct and new variety of plant*
On September 16, 2011, President Barack Obama signed the Smith-Leahy America Invents Act into law at Thomas Jefferson High School in Arlington, Virginia. The America Invents Act is the broadest, most sweeping reform to the patent system since at least the Patent Act of 1952.
# USPTO Patent Application Fees

**Effective January 14, 2017**

## Patent Fees

The fees subject to reduction upon establishment of small entity status (37 CFR 1.27) or micro entity status (37 CFR 1.29) are shown in separate columns. The $400/$200 non-electronic filing fee (fee codes 1090/2090/3090 or 1690/2690/3690) must be paid in addition to the filing, search and examination fees, in each original nonprovisional utility application filed in paper with the USPTO. The only way to avoid payment of the non-electronic filing fee is by filing your nonprovisional utility application via EFS-Web. The non-electronic filing fee does not apply to reissue, design, plant, or provisional applications.

### Patent Application Filing Fees

<table>
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<tr>
<th>Fee Code</th>
<th>37 CFR</th>
<th>Description</th>
<th>Fee</th>
<th>Small Entity Fee</th>
<th>Micro Entity Fee</th>
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Patent Search Tools
Patent Searching – points to consider:

Much of patent searching depends on a number of factors to consider:

• how authoritative do you want the search to be
• how up to date do you want the information to be
• how much time do you have to spend on this search
• your comfort level with using a computer and search systems
• the invention – is it innovative technology or does it require searching patents prior to 1975
• your knowledge of U.S. patent classification and the recent change from USPC to CPC (you will need to search both systems)
• do you need to search just patents or also patent applications
Anatomy of a U.S. Utility Patent

**Source**: Contains the name the patent.

**Document number**: The prefix 'US' indicates that this is a U.S. patent.

**Title of the invention**: A brief description of the invention.

**Assignee/Owner**: The party who owns the patent.

**Application number and date**: The application number and the date of filing.

**U.S. Patent Classification**: A code system used to classify inventions.

**Field of search**: Classification codes used to search for similar inventions.

**Drawing**: A visual representation of the invention.

**Terse**: Twenty years from the date of application. After the patent has expired, the invention enters the public domain. In addition, patent owners must pay a maintenance fee at 3.5% and 11% years after issuance or else the patent will expire.

The USPTO publishes unexamined patent applications 18 months after the earliest filing date. Prior to 2005, applications were kept secret until a patent issued.

**Specification**: A written description of the invention that includes the claims. The specification must describe the invention in sufficient detail so that anyone of ordinary skill in the same technical field can understand it.

**Claims**: Paragraphs located at the end of the specification that define the scope of protection on a patent. The phrases "invention" or "what is claimed" precedes the numbered claims. The claims define the legal boundaries of the invention in the way a property deed defines the physical boundaries of an area of land.

**Types of U.S. patents**:

1. **Utility**: for products and useful:
   - Products (tools, shoes, toys, etc.)
   - Compositions (chemical compounds, alloys, etc.)
   - Machines
   - Processes
2. **Design patent**: Protects new and original:
   - Ornamental designs for articles of manufacture
3. **Plant patent**: Protects new and distinct:
   - Varieties of ornamental plants
   (Reproduced by means other than seeds, such as grafting, budding, etc.)
USPTO Patent Full-Text and Image Database (PatFT)

Inventors are encouraged to search the USPTO’s patent database to see if a patent has already been filed or granted that is similar to your patent. Patents may be searched in the USPTO Patent Full-Text and Image Database (PatFT). The USPTO houses full text for patents issued from 1976 to the present and PDF images for all patents from 1790 to the present.

1. Searching Full Text Patents (Since 1976)
   Customize a search on all or a selected group of elements (fields) of a patent.
   - Quick Search
   - Advanced Search
   - Patent Number Search

2. Searching PDF Image Patents (Since 1790)
   Searches are limited to patent numbers and/or classification codes for pre-1976 patents.
   - View Patent Full-Page Images
   - How to View Patent Images

   Search for Full-Text and Image versions of patent applications. Customize searches on all fields of a patent application in the AppFT for Full-Text searches.
   - Quick Search
   - Advanced Search
   - Publication Number Search

   Searches are limited to patent numbers and/or classification codes for Full-Page images.
Patent Resources

• Local Patent & Trademark Resource Centers (PTRC) - in MA: UMass Amherst Libraries and Boston Public Library

• Inventors Assistance Center USPTO (United States Patent & Trademark Office)

• Patent Pro Bono program for independent inventors and small businesses USPTO (United States Patent & Trademark Office)

• Patent Pro Bono program for independent inventors and small businesses USPTO (United States Patent & Trademark Office) – Certificate Training Course (40 minute Adobe presentation)

• Pro Se Assistance Program USPTO (United States Patent & Trademark Office) / UMass Amherst Patent Virtual Assistance Pilot Program for Pro Se Inventors

• Law School Clinic Certification Program USPTO (United States Patent & Trademark Office)

• Videos USPTO (United States Patent & Trademark Office / YouTube Channel)
Trademarks

It is estimated that you encounter over 1500 TRADemarks in the course of a normal day. When you visit a grocery store or this exhibit, that number is shattered.

Some of these trademarks include: Subaru, Honda, Toyota, BMW, Mercedes-Benz, Ford, Chevrolet, Audi, Porsche, Aston Martin, Bentley, Rolls-Royce, Porsche, Prada, Gucci, Louis Vuitton, Armani, Versace, Dolce & Gabbana, Gucci, Versace, Dolce & Gabbana, and many more.

These trademarks represent a significant portion of the world's most recognizable brands.
# USPTO Trademark Fees

<table>
<thead>
<tr>
<th>Trademark application forms (select one to start)</th>
<th>TEAS Plus form</th>
<th>TEAS Reduced Fee form</th>
<th>TEAS Regular form</th>
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<td>Filing fee per class of goods/services</td>
<td>$225</td>
<td>$275</td>
<td>$400</td>
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<td>E-mail address required for USPTO application-related correspondence?</td>
<td>Yes</td>
<td>Yes</td>
<td>No</td>
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<tr>
<td>Additional submissions, like responses to Office actions, must be filed online?</td>
<td>Yes</td>
<td>Yes</td>
<td>No</td>
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<tr>
<td>Goods/services listing must be selected from the USPTO Trademark Identification (ID) Manual?</td>
<td>Yes</td>
<td>No</td>
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<tr>
<td>Full Filing fee paid upfront (per class for all classes listed on the application)?</td>
<td>Yes</td>
<td>No</td>
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<td>Certain statements regarding the mark be provided in the application as filed, if applicable (e.g., translation statement, claim of ownership, color claim and description)?</td>
<td>Yes - see TMED 5819.01</td>
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[https://www.uspto.gov/trademarks-application-process/filing-online](https://www.uspto.gov/trademarks-application-process/filing-online)
Term Limits for Patents and Trademarks
Welcome to the Trademark Electronic Search System (TESS). This search engine allows you to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registration due to a likelihood of confusion refusal.

**WARNING:** Before conducting your search, you must understand the following: (1) what the database includes; (2) how to construct a complete search; and (3) how to interpret the search results. Click TESS TIPS for detailed information on these and other important search topics.

**Select A Search Option**
- **Basic Trademark Search (New User)**: This option cannot be used to search design marks.
- **Word and/or Design Mark Search (Structured)**: This option is used to search word and/or design marks. NOTE: You must first use the Design Search Code Manual to look up the relevant Design Codes.
- **Word and/or Design Mark Search (Free Form)**: This option allows you to construct word and/or design searches using Boolean logic and multiple search fields. NOTE: You must first use the Design Search Code Manual to look up the relevant Design Codes.

**Additional Search Options**
- **Browse Dictionary (Browse Dictionary)**: This option browse all fields in the database unless you limit to a particular field. Results are returned in a dictionary-style (alphabetic) format.
- **Search OSG Publication Date or Registration Date (Search OSG)**: This option searches the Official Gazette for marks published or registered on a particular date.
**TESS = Trademark Electronic Search System**

![Trademark Electronic Search System](image)

**Search Term:**

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<th>Field:</th>
<th>Shake Shack</th>
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<tbody>
<tr>
<td>Result Must Contain:</td>
<td>Combined Word Mark (SL,TL,MP,TL)</td>
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<tr>
<td>All Search Terms (AND)</td>
<td>▼</td>
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**Search Results:**

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**Word Mark:** SHAKE SHACK

- **IC:** 043, US 100, 1111 G & S: Restaurant services, FIRST USE: 20150909, FIRST USE IN COMMERCE: 20150909
- **Design Search Code:** 08.05.01 - Hamburger sandwiches
- **Filing Date:** February 13, 2017
- **Current Basis:** 1A

**Owner:** SSE IP, LLC LIMITED LIABILITY COMPANY DELAWARE 24 Union Square East New York NEW YORK

**Attorney of Record:** David M. Kelly

**Description of Mark:** The color(s) green and black is/are claimed as a feature of the mark. The mark consists of a stylized image of a hamburger - SHACK in black uppercase letters.
# TABLE OF CATEGORIES

**01** Celestial bodies, natural phenomena, geographical maps
- This category includes objects that appear in the sky, including clouds, stars, moons, sun, planets and constellations. Additional categories for countries and continents are also in 01.

**02** Human beings
- This category includes representations of men, women and children regardless of the activity they are engaged in or how they are portrayed.

**03** Animals
- This category includes real animals, except mythological animals. Animals found here include mammals, birds, lizards, birds, fish, bees, etc.

**04** Supernatural beings, mythological or legendary beings, fantastic beings or unidentified beings
- This category includes beings such as devils, angels, leprechauns, witches, and super heroes. Designs that are part human and part animal or geometric figures that represent humans or animals are also in category 04.

**05** Plants
- This category includes almost every type of plant such as flowers, trees, leaves, vegetables, and fruits. Also, decorations made from plants.

**06** Scenery
- This category includes mountains, lakes, waterfalls, beaches, forests and deserts. Also, desert scenery and urban scenery such as parks, playgrounds, and houses.

**07** Dwellings, buildings, monuments, stadiums, fountains, structural works and building materials
- This category includes almost any structure that is built by man. All dwellings from apartments to skyscrapers are in 07. Interior and exterior decorations.

**08** Foodstuff
- This category includes goods that are edible such as meat, dairy products, sandwiches, and baked goods. It does not include food-related items such as textiles, clothing, handwear, footwear and sewing accessories.

**09** Others
- This category includes miscellaneous items that do not fit into any other category.

---

**PLANTS**

**05:01:01** Evergreens and other trees or bushes of triangular or conical shape
- _Example_: Xmas trees decorated with ornaments are coded in 05:01:04.

**05:01:02** Trees or bushes with a generally rounded shape, including deciduous trees
- _Example_: A large tree with branches in a circular pattern is coded in 05:01:02.
Find all the Trademarks for items of clothing having some type of fox design
<table>
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<tr>
<th>Serial Number</th>
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Word Mark: BLAC FOX TAILS
Goods and Services: IC 025: US 022:639: G & S: Baseball caps and hats; Hooded pullovers; Hooded sweatshirts; Hoodies; Long-sleeved shirts; Short-sleeve shirts; Short-sleeve shirts; Socks; Sweatpants; Sweatshirts; T-shirts; Tank tops; Underwear; Hooded sweatshirts
Mark Drawing Code: (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code: 03 91 11 - Foxes
Serial Number: 87307304
Filing Date: March 3, 2017
Current Basis: 1B
Original Filing Basis: 1B
Published for Opposition: July 4, 2017
Owner: (APPLICANT) Eric Belizaire DBA Blac Fox Tails INDIVIDUAL UNITED STATES 1379 Blue Hill Ave Mattapan MASSACHUSETTS 02126
Attorney of Record: Loleta Darden
Description of Mark: Color is not claimed as a feature of the mark. The mark consists of a black fox sitting on its hind haunches with white eyes, a white nose, and a white tip tail extending away from its body with the words "BLAC FOX TAILS" underneath the tail of the fox.
Type of Mark: TRADEMARK
Register: PRINCIPAL
Live/Dead Indicator: LIVE
Trademark Resources

- Local Patent & Trademark Resource Centers (PTRC) - in MA: UMass Amherst Libraries and Boston Public Library
- Trademark Assistance Center USPTO (United States Patent & Trademark Office)
- Videos USPTO (United States Patent & Trademark Office / YouTube Channel) Also in Spanish
- Pro Se Assistance Program USPTO (United States Patent & Trademark Office)
- Law School Clinic Certification Program USPTO (United States Patent & Trademark Office)
Marijuana Trademarks

Though cannabis is legal for recreational or medicinal use in 29 states, it remains illegal under federal law.

As a result, the U.S. Patent and Trademark Office will not register trademarks for marijuana retailers or for products that contain cannabis.
Available for programs

Presentations (selected) (5)

- **A Patent Primer for Researchers: What you need to know**
  University of Massachusetts Lowell (2018)
  Presentation to University of Massachusetts Lowell graduate students and faculty. Presented on Wednesday, April 18, 2018.
  [Download]

- **Patents of Northfield Massachusetts Inventors**
  Northfield Senior Center (2017)
  Presentation on Patents of Northfield inventors given at the Northfield Senior Center on 29 May, 2017.
  [Download]

- **World of Plant Patents**
  Amherst Garden Club (2016)
  Plant Patent presentation for the Amherst Garden Club on 28 September 2016 at the Petersham Public Library in Massachusetts.
  [Download]

Patent Coloring Books (5)

- **Summertime Fun Patents Coloring Book**
  (2018)
  Coloring book containing a selected page from ten different U.S. patents or patent applications pertaining to the theme of Summertime.
  [Download]

- **Valentine's Day Patents Coloring Book**
  (2018)
  Coloring book containing a selected page from ten different U.S. patents or patent applications pertaining to the theme of Valentine’s Day.
  [Download]

- **Spooky Halloween Patents Coloring Book**
  (2017)
  Coloring book containing a selected page from thirteen different U.S. patents or patent applications pertaining to the theme of Halloween.
  [Download]
Thank-you
Questions and comments welcome

Paulina Borrego
UMass Amherst Science & Engineering Librarian
Patent & Trademark Resource Center Librarian
pborrego@library.umass.edu

U.S. Plant Patent 550 / October 13th 1942 / Rose Plant