

Intellectual Property for Technology Transfer Professionals

FLC National Meeting

Orlando, Florida

April 23, 2019

Instructor: Gail Poulos

Registered Patent Agent, USDA Agricultural Research Service



- 25 years as Patent Agent with the USDA-ARS-Office of Technology Transfer
- Former Biotechnology Patent Examiner for U.S. Patent and Trademark Office

Instructor: Jim Kasischke

Head Patent Attorney/Main T2 Attorney, Naval Undersea Warfare Center Division Newport



- FLC Legal Issues Committee Chair since 2011
- Over 25 years with Navy Office of General Counsel, earning IP Attorney Achievement Award and DOD George Linsteadt Technology Transfer Award

Course Objectives

- Learn about basic types of IP protection
 - Patents from invention disclosure to post-issuance proceedings
 - Trademarks
 - Copyright
 - Trade Secrets
- Learn about protecting rights in Government inventions
- Learn about data rights and export control

Sign-in Procedures

- Sign in this morning and afternoon to verify that you completed the course.
- We will pass around the sign-in sheet.

Course Materials

- Your materials include:
 - Course book and handouts
 - Notebook
- Don't have materials? Check in at registration to pick them up.

Add/Drop

- Not the course for you? You can add/drop until 9:45 am.
- Trade in your books at the registration desk.
- Be sure to sign in to your new course.

Evaluate the Course

- Your feedback is our most useful tool!
- Evaluation form in your books.
- Hand it in at registration.

Credit

- You can still register for continuing education credit at eu.montana.edu/flc.
- You'll receive “credit” for completing this course in the form of an online badge you can share with your social networks. Look for an email from Credly for your badge.

PRACTICE TIPS

Pitfalls in Technology Transfer: Training Opportunities for Your Scientists

- Nomenclature
 - **Invention disclosure \neq patent application**
 - **Patent application \neq Patent**
- **Incomplete invention disclosures**
 - 1 paragraph wonders
 - Not answering the questions asked
- Receiving data & docs piecemeal
- Not using the **docket number**

Pitfalls . . . (Cont.)

- **Inventors** not reporting inventions
 - Because the **CRADA** partner, the contractor, cooperator, or the other government agency is “taking care of it”
- Government **inventors** executing assignments to other entities
- Confusing statements of intent to assign with **assignments**, declarations, & powers of attorney

Pitfalls . . . (Cont.)

- **Inventors** wanting to add supervisors and funders as listed **inventors**
- **Inventors** wanting to rearrange list of contributors on **invention disclosures, patent applications** or **patents**
- **Inventors** disclose features but not how the invention works

How You Can Help

- Be proactive
- Educate and inform
- Monitor Invention Disclosures; check for completeness



Call the Patent Attorney/Agent!

- IF, before a **patent application** is filed, your **inventor** is:
 - Presenting or publishing
 - Disclosing the invention at a trade show or other public meeting
 - Transferring materials or collaborating without a written agreement
 - Generating an RFP or contract



WHAT IS INTELLECTUAL PROPERTY?

Intellectual Property

- Formal definition
 - **Intellectual property** is an intangible or proprietary asset such as a patent, copyright, trademark or trade secret
- My definition
 - **Intellectual property** is a protectable development of the mind

Examples of Intellectual Property Protection

- **Trade secrets**
- **Patents**
- **Copyrights**
- **Trademarks**

WHAT'S THE VALUE OF IP?

Value of **IP**

- Protect the product or process being sold
- Protect name or goodwill of company
- License or sell **IP** to others
- Allows protection for investment in product by blocking competitors from entering marketplace
- Enhance value of company for investors or sale
- Intangible internal values – proof of productivity, effect on competitors

Steps to Protecting **IP**

- Identify your **IP**
- Make sure that you and your employees are not inadvertently disclosing your **IP**
- Evaluate your **IP** for an appropriate level of protection: **Trade Secret, Patent, Trademark, Copyright**

Steps to Protecting **IP**

- Questions and/or Comments

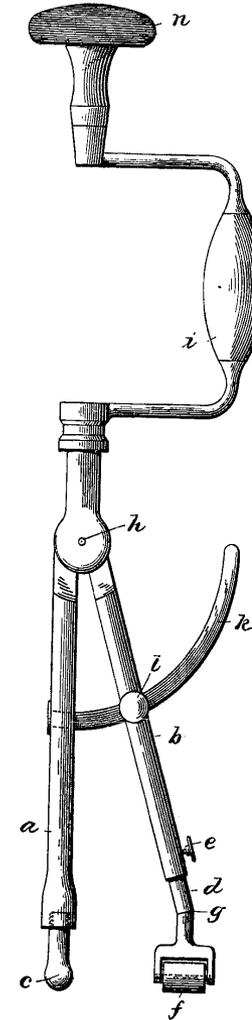
THE PATENT PROCESS IN-DEPTH

What Is an **Invention**?

- An **invention** can be a machine, a circuit, a process, a business method, or a composition of matter.
- An **invention** can't be a bare mathematical formula or a scientific discovery, unless these are related to the physical world.
- **Invention** must be novel and non-obvious. Basically, this means that it must be new and, even if new, somewhat beyond existing experience. An invention isn't novel if it was on sale, in use or published more than a year before filing.

Patent Life Cycle

- **Invention** and Documentation
- Review by an Invention Board/Patent Committee
- **Application** preparation
- Filing
- **Prosecution**
- **Issuance**
- Licensing and **enforcement**
- **Maintenance**



Invention Disclosure

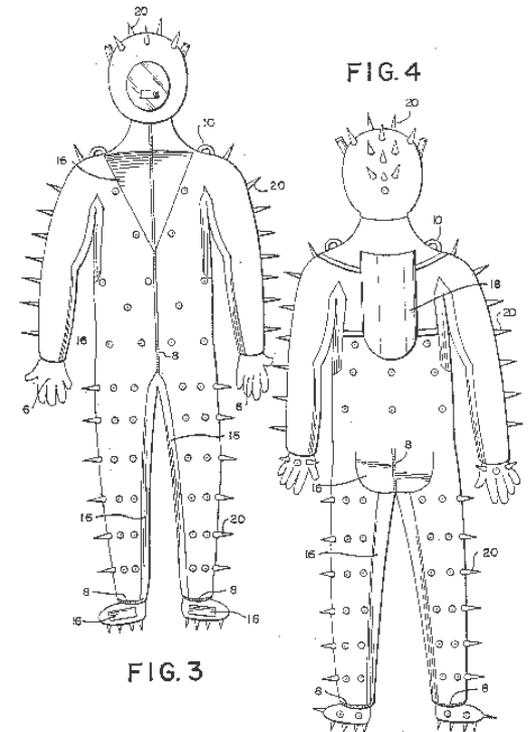
- Describe new product/process, elements & operation in words, drawings, photos, flow charts, etc.
- Completely describe problem being solved – no missing parts or magic steps
- Differentiate from preexisting technology (prior art)
- Identify the core elements; at least one element has to be new or different from what came before

Invention Disclosure (Cont.)

Include copies of manuscripts, publications, handouts, presentations, posters, user's manuals, excerpts from lab notebooks, flow charts, screenshots, gels, micrographs, relevant websites, etc.

But don't worry too much about neatness and format

U.S. Patent May 30, 1989 Sheet 2 of 4 4,833,729



Invention Disclosure – Insider Tips

- **Disclosure** should provide enough information on the invention so that the invention board/Patent Committee can make a determination on how to proceed
 - Why is this **invention** important to the organization?
 - Does this satisfy a long-felt need?

Who Is an **Inventor**?

- An **inventor** is anyone who contributes to conception of a process, machine, manufacture, composition of matter, or a new and useful improvement thereof that is the subject matter of at least a part of one claim of the **patent application**.

Joint Inventors

- Two or more persons who collaborate to produce the invention through aggregate efforts
 - 1) they don't have to physically work together or at the same time
 - 2) they don't have to make the same type or amount of contribution, or
 - 3) they don't have to make a contribution to the subject matter of every claim of the patent
- They must be aware of each other's work

Inventorship

- Authorship ≠ **inventorship**
- Contributions deemed equal
- A legal determination
- Errors—correctable if no deceptive intent
 - No true **inventor** named
 - **Non Joinder**: Not listed & should have been
 - **Misjoinder**: Erroneously listed

Not an **Inventor**

- Reduce To Practice by exercising ordinary skill in the art
- A technician who simply performs experiments or assembles the invention
- Supervisors or department managers (without more)
- Contributing an obvious element to the invention or general knowledge
- Only contribution is participation in consultations about the invention before or after conception of the invention

Still Not an **Inventor**

- Thinking of the result to be obtained, but not the details of how to achieve it
- Supplying a known component or starting material
- Suggestions or improvement, but doesn't work to fit the suggestion or improvement into the invention

Ownership – What happens if the inventors have different employers?

- If the inventors have different employers, invention ownership should be resolved before filing a patent application.
- If one inventor is a Govt. employee and another is a contractor, the contract must be consulted concerning invention ownership. The contractor may have the right to full ownership.
- Various agreements deal with this: assignment, research agreements, license, inter-institutional agreement (IIA).

What happens if the **inventor** thinks he/she owns the **invention**?

- If the inventor was hired to invent, presumption is that the employer owns the invention.
- If the invention doesn't relate to the nature of the employment, then the inventor can retain rights in the invention.
- There is a Government regulation settling this for Government employees.

Invention – Old Law

The law before the **America Invents Act (AIA)** was very concerned with the timing of an invention because the patent was awarded to the first inventor to invent. Invention involves a two-step process:

- (1) **Conception** of the idea or subject matter of the patent claims; and
- (2) **Reduction to practice** where the invention is actually made.



Invention – New Law (2006)

Under the **America Invents Act (AIA)** the **patent** is awarded to the first **inventor** to file at the U.S. Patent Office.

- (1) There is a process for determining if one **inventor** derived the invention from another.
- (2) Fewer disputes arise from this process.



Laboratory Notebooks

- **Invention** should be recorded in a lab notebook
 - Describe **invention**
 - Show date **invention** was made
 - Dates of **conception**
 - Date of **reduction to practice**
 - Sign & date entries
 - Witnesses attest to operability of **invention**
 - Make frequent entries as work progresses
 - Still of use even under **AIA**

Invention Disclosure Review Committee

- An **invention** disclosure review committee reviews invention disclosure to determine if the invention is worth patenting.
- Quality of **invention**, readiness level, tech transfer value, and defensive value are weighed into decision.
- If the committee declines to file a **patent application** on a Government disclosure, the disclosure may be returned to the inventor.
- Decision can be priority, go/no go, or combination.

Review Committee Considerations:

- Is the **invention** patentable?
- Does the technology have a market?
- Will the **claims** be enforceable?
- Does the technology have commercial potential?

Market

- Is there a widespread need for technology?
- Is the market large enough to warrant a patent?
- Is it a niche market that requires patent protection?
- Is regulatory approval needed?

Enforceable

- Does the **invention** leave a footprint?
- Is the process the only process to make the product, i.e. **Product-by Process Claims**?
- Methods of making, method of using, use of markers in methods of making
- Weakest-method claims that can be done behind closed doors with no unique product

Commercial Application

- Is there a high potential for return on investment?
- Is there potential for profits?
- What is the lifetime of the technology ?

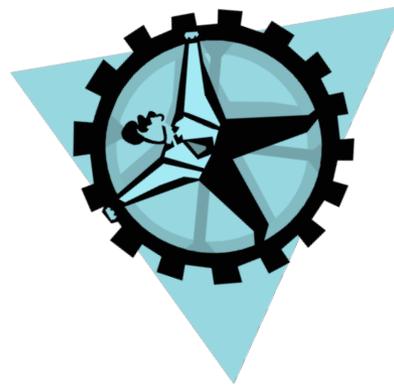
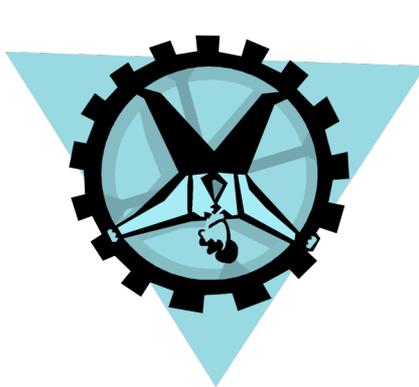
FILING A PATENT APPLICATION

Filing a **Patent Application**

- Why do I need to know this?
 - To ensure your patent counsel has prepared a patent application that you can license and can be enforced
 - To ensure the invention is described with broad enough scope
 - To ensure the proposed/patented claims are of sufficient scope to market and license the invention

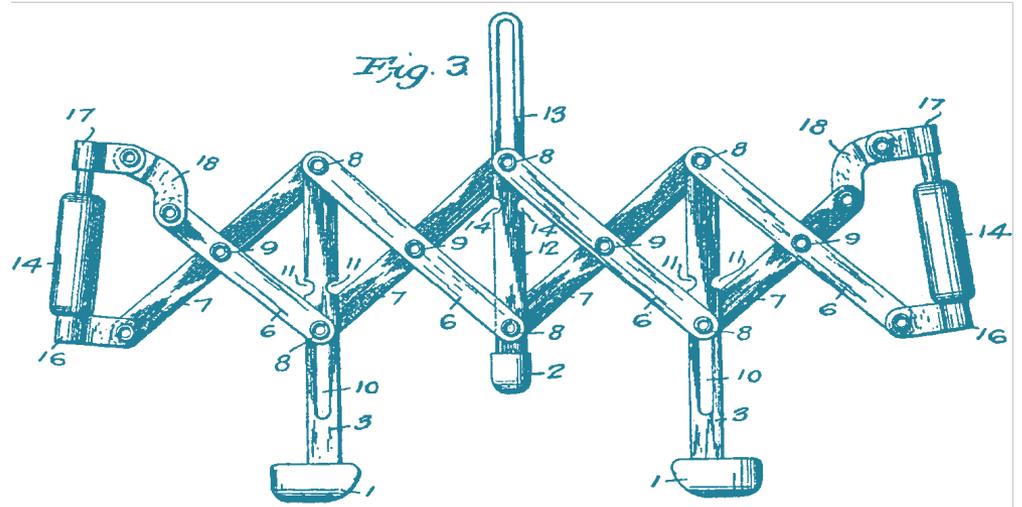
Application Preparation

- **Prior art** search
- **Patentability** analysis
- Assigning a patent attorney/agent
- **Inventor** participation



Application Filing

- Type of application
 - Domestic
 - Utility (+ Provisional), Design, or Plant
 - Foreign
- Fees
- Attorney costs



Two Types of **Utility Applications**

- **Provisional**
 - Not examined
 - Expires 1 year from filing
 - To obtain a priority date and first-to-file date under the AIA
 - Use with caution – must be enabling for claims later filed in nonprovisional application
- **Nonprovisional (Regular)**
 - Full **examination**
 - Potential to **issue** into a **patent**

Provisional Patent Applications— Effect of an Inadequate Provisional Application

NEW RAILHEAD MANUFACTURING, L.L.C.

Plaintiff-Appellant

v.

VERMEER MANUFACTURING COMPANY

Defendant-Appellee

and

EARTH TOOL COMPANY, L.L.C.

Why File a **Provisional Application**?

- Publication, public use, or on sale bar date coming up and no time to file a formal **application**.
- **Invention** will be disclosed outside the organization and want protection.
- Initial filing to test the marketing waters. No plan to follow up if no licensing interest.

First-to-File Under the AIA

- Date of Enactment: March 16, 2013
- Hybrid First-to-File (First Inventor to File)
- One-Year Grace Period
- File Early
 - **Provisional Application**
- **Foreign Practice** has First-to-File

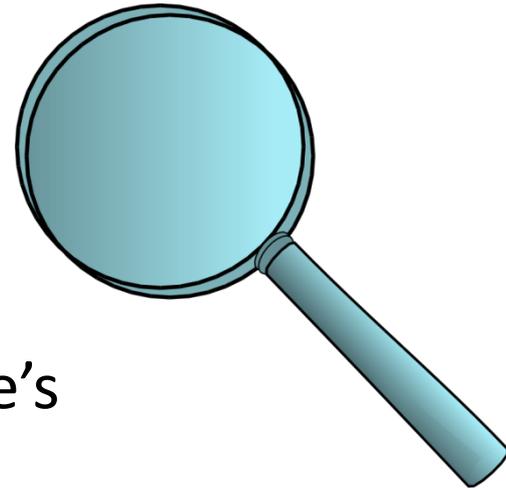
Nonprovisional **Utility Patent** **Application** Types

- Original (Parent)
- **Continuation**: Subject matter is same as original application
- **Continuation-in-part**: New matter has been added
- **Divisional** (Child): Two or more separate inventions identified in original application

PREPARING AN APPLICATION

Prior Art Search

- Patents, published patent applications, articles, websites, brochures, everything! Everywhere!
 - Is **invention** novel and non-obvious?
 - Does technology infringe someone else's patent?
- Databases
 - USPTO, WIPO, commercial
 - Other foreign patent office web databases



U.S. Patentability Searches

- Use search engine (e.g., Google patents) to start a search
- Use the results to do a keyword search of U.S. Patent & Trademark Office website at www.uspto.gov
- Fine-tune or expand the results of the search engine and keyword searches with a classification search at www.uspto.gov
- In the mechanical art, filed pictures are very helpful.

Prior Art

- **Inventor, Patent attorney/agent**, and every other person who is substantively involved in the preparation and prosecution of the application has a duty to disclose relevant **prior art-37 C.F.R 1.56**
- An **Information Disclosure Statement (IDS)** lists prior art
- **Information Disclosure Statement** can include office actions from related cases
- **Prior art** can be submitted by third parties after **patent application** publication.

35 U.S.C. 102 — **Novelty**

- 35 U.S.C. 102(a)(1) precludes a **patent** if a **claimed invention** was, before the **effective filing date** of the claimed invention:
 - patented
 - described in a printed publication
 - in public use
 - on sale or
 - otherwise available to the public

AIA 35 U.S.C. 102 — **Novelty** — Exceptions

- 102(b)(1)(A): A grace period (one year or less before the filing date) disclosure of the inventor's work (i.e., inventor, joint inventor, or someone who obtained the subject matter from the inventor) is not prior art to the inventor
- 102(b)(1)(B): A disclosure of the inventor's work by the inventor shields the inventor from the prior art effect of a third party's subsequent grace period disclosure

AIA 35 U.S.C. 103 – **Non-obviousness**

Can't obtain a **patent** if:

- The differences between **claimed invention** and the **prior art** are such that the **claimed invention** as a whole would have been obvious before the effective filing date of the **claimed invention** to a person having ordinary skill in the art to which the claimed invention pertains
- This adds a little higher hurdle than 102 **Novelty**

Patent Application Parts

- Title
- Statement of government interest
- Cross-reference to priority applications
- **Background of the invention**
- Brief summary of the invention
- Detailed description of the invention
- Claims
- Drawings
- Abstract

35 U.S.C. § 112 — **Specification**

- **Patent application** must include a full and complete detailed **written description** of the **claimed invention** sufficient to enable one of ordinary skill in the art to make, use and practice the **claimed invention**
- Without undue experimentation, but not a recipe or how-to manual
- Describe in detail every part, feature, advantage and function of the invention
- State preferences for size, range, material, shape or arrangement of parts, then include alternatives and variations

35 U.S.C. § 112 – **Best Mode** Under AIA

- Failure to disclose the **best mode** shall not be a basis on which any **claim** of a **patent** may be canceled or held invalid or otherwise unenforceable
- Lack of **best mode** disclosure is no longer a defense for infringement (for suits filed after 9/16/11)
- **Best mode** disclosure still required

Claims

- **Claims** – Cover the bounds of the Invention
 - Special language & formatting
 - Broad, intermediate & narrow
 - Independent & dependent (3 Independent and 20 total.)
- New Case Law & Impact
 - KSR (obviousness)
 - In re Bilski (business methods)
 - Mayo (treatment methods)
 - Myriad (DNA)

Patent Application Filing and Prosecution

Patent Application Filing Paperwork

- **Application Data Sheet** – priority docs listing required
- **Oath/declaration** by the inventors
- **Substitute statement** – if inventor can't/won't sign
- Non-publication request (Only if no foreign filing)
- Special Request for Color Drawings (black and white is usual)
- **Power of attorney** gives right to represent before PTO
- **Assignment** – *Stanford v. Roche* wording (“do hereby assign” vs. “agree to assign”)
- **Information Disclosure Statement (IDS)**
- Can file an incomplete application without some parts

Timelines

- Publication
 - 18 months from priority date
 - Certification of Non-publication
- Examination
 - Approximately 1-2 years
 - Petition to make special
 - Based on Patent Cooperation Treaty search-if PCT filed
- Issuance
 - Approximately 3-5 years (if application is made special, much sooner)
- **Filing Foreign Application**
 - 1 year from **priority date**

Applications Published

- About 18 months after filing date or filing date of the priority application, whichever is earliest
- Becomes **prior art** that can be used against all applications not claiming priority to the published application
- Possible to request non-publication if not filing foreign

Patent Application Prosecution

Filing of patent application in USPTO

1-3 Years Passes



Prior art is searched by USPTO



U.S. **Patent Examiner** issues office action or not

3 Months Passes



Patent attorney/agent responds

2-3 Months Pass



Examiner allows or issues another office action

2-4 Months Pass



Patent Application Issues as Patent

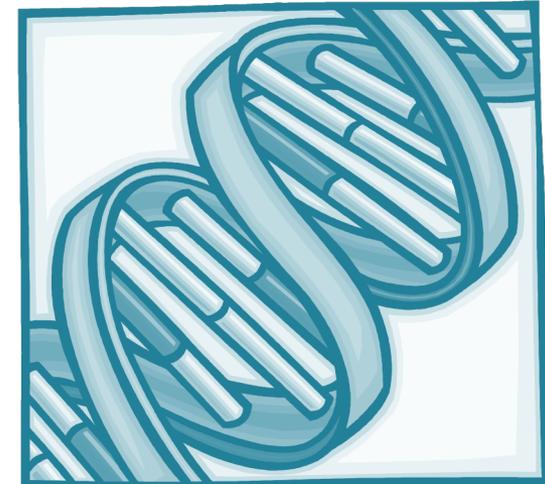
Actions and Responses

- **Office Actions**

- **Restriction** requirements
- Objections
- Missing parts
- Deadlines/extensions
- Rejections

- **Responses**

- Interviews with U.S. Patent Examiner
- **Amendments**, additions and/or cancellation of claims
- **Appeals & declarations**



Office Actions (OAs)

- Usually 2 OAs, a 1st OA on the merits and a final OA on the merits
 - Can make big changes to the claims in response to the 1st OA
 - Changes are limited in response to the final OA
 - Examiner can issue non-final OAs, but this is an admission of a legal error or something on his behalf that caused a new rejection
- **Rejection** of claims—Examiners rely on the statutes and case law to reject claims on the merits
- **Objection** to specification and/or claims— Examiner objects to formalities
- Interviews are good to further prosecution of the application

Responses to OAs

- Interview **examiner** with **inventor** to explain invention
- **Amend** claims
- Add claims as long as no “**new matter**” (added claims must find support in the specification as of filing date of the application)
- Cancel **claims**
- Argue the references used to reject in light of the claims
- Prepare **declarations** from experts
- **Appeal**

Restriction Requirement

- When **examiner** believes **claims** directed to more than one independent and distinct invention
- **Response**—accept or traverse, but must elect a group of claims to have examined even if restriction is contested
- Non-elected **claims** can be examined in a **continuation** or **divisional application** filed later, but while **parent application** still pending

Rejections

- Usually made on basis of 35 U.S.C. Sections 101 (**statutory subject matter**), 102 (**novelty**) and 103 (**obviousness**), but also on Section 112 (**specification**), **prior art** and **case law** pertaining to interpretation of those sections
- Section 112 pertains to **written description** of **invention**, and manner and process of making and using it, best mode for carrying out the **invention**, and means for **claims**



Rejections — 35 U.S.C. 101 – Patentable Subject Matter

- This is a **non-statutory subject matter rejection**. The examiner is saying that the **claimed invention** isn't an **invention**. **Several recent cases have revitalized this rejection.**
- Often this happens when the **claims** are trying to **claim** every use of a discovery instead of specific uses.
- Generally, can be cured by indicating the real application of the science or technology in the environment. The **patent attorney/agent** needs to make sure that this is in the **specification**.

Rejections — 35 U.S.C. 102 – Novelty

- The **examiner** is saying that the **claimed invention** is exactly the same as one piece of the **prior art**. The **prior art** does not need to be in the same field as the **invention**.
- **Applicant** may have improperly distinguished the **prior art** or missed material in the pre-filing.
- Sometimes a junior **examiner** mistakenly issues this **rejection** by misreading the **prior art** or failing to consider the **applicant's** entire **invention**.
- Can be cured by argument or **amendment** if sufficient details and limitations in the **specification** of the **application**.

Rejections — 35 U.S.C. 103 – Obviousness

- The **examiner** is saying that the **invention** would be **obvious** to **one of ordinary skill** in the art based on one or more pieces of **prior art**. The **prior art** must be technically related to the invention.
- This **rejection** is hard to avoid before filing.
- **Patent attorney/agent** should check details of the **rejection** to confirm that the **examiner's** statements are accurate.
- There are various arguments against this, but the attorney/agent may need to cancel claims or incorporate additional details (limitations) into the claims.

35 U.S.C. 103 – **Non-obviousness** – Arguments

- The **invention** must not be **obvious** to **one of ordinary skill in the art** – **prior art** should be easy to combine.
- To establish a ***prima facie* case of obviousness**
 - There must be some suggestion or motivation to modify or combine the **prior art** (KSR-Examiner's Guidelines)
 - There must be a reasonable expectation of success
 - The **prior art** must teach or suggest all the **claim** limitations

Declarations

- Written personal statement setting forth facts
- Used to disqualify a disclosure as **prior art** that is made by the **inventor** or a **joint inventor**
- Used to overcome **rejections** by removing references from the prior art
- Done under 37 C.F.R. 1.130



Easy Stuff to Correct

- **Objections** – typos, informalities, failure to follow claiming rules, drawing problems
- Missing parts
- Late **responses** in most cases
- **Double patenting**

Final Office Actions

- If an **application** is not allowed after responding to Final **OA**, **application** will go **abandoned** unless—
 - Request for Continued **Examination** is filed,
 - A **continuation** is filed
 - An **appeal** to the **USPTO Patent Trial and Appeal Board (PTAB)** is filed, or
 - An **after-final** consideration is requested

Appeals

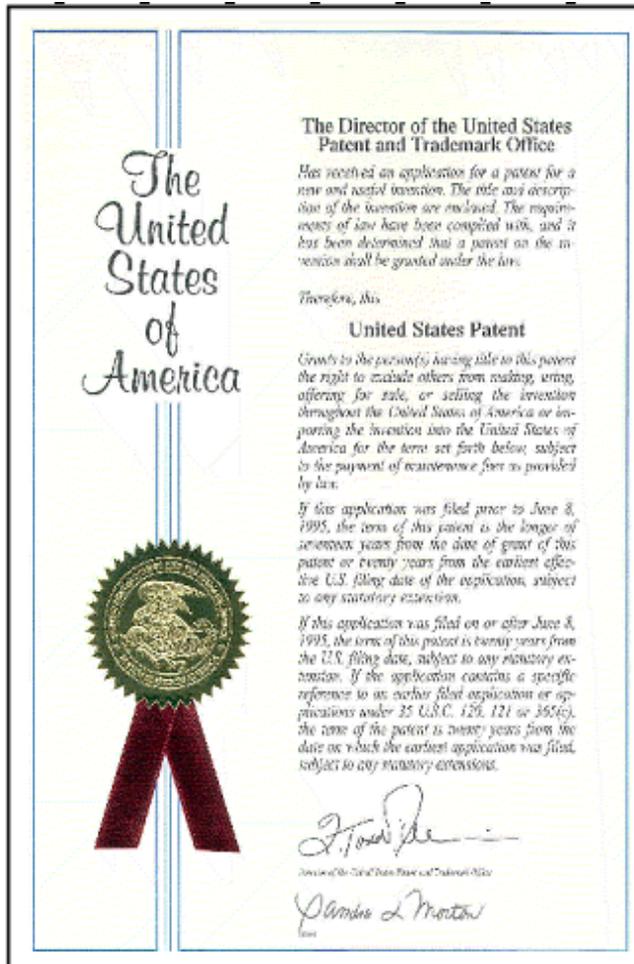
- An **applicant** can appeal after any one or more **claims** have been rejected twice, even if the second rejection is not a **Final OA**
- The appeal is to **Administrative Patent Judges** on the USPTO Patent Trial and Appeal Board
- An **appeal brief** that contains legal and factual argument is required
- **Appeal brief** must be prepared by an attorney

Patent Issuance

- Receive a **Notice of Allowance**
- Notice of Allowability (D-10) - Security
- Double-check public release authorization if not already published
- Check **patent term adjustment**
- Pay fees
- Receive a **Patent Certificate**

The patent is printed and publicly available everywhere!

Example



- Term: 20 years calculated from the date of filing the patent application
- Example: Application filed 1 April 2005; term expires 1 April 2025, but patent not awarded until 1 April 2008
- Patent term extended by delay in USPTO over 3 years. Other extensions are available

FOREIGN PATENT PROTECTION

Foreign Patents

- **Patentability** based on **absolute novelty**
- **Applicant** need not be **inventor**
- **Foreign applications** must be filed within 1 year of U.S. **provisional/patent application** filing date to receive **priority date**
- Type of protection
 - Bundle of rights may be different from U.S. patents

Foreign Applications

- Filing Options
 - Individual countries
 - Regional treaties
 - International-PCT
- **PCT National Stage** Deadlines
 - 30 months after filing date of **priority application**
- Cost
 - Entering **national stage** in **PCT**
 - Annual payment while pending
 - Depends on search authority chosen

Patent Prosecution Highway and the PCT

- U.S. application can benefit from International Search under PCT
- U.S. application can be allowed if
 - Applicant requests accelerated examination
 - Must have positive search report
 - At least one claim must have been found to be novel, have inventive step and industrial applicability
 - Request must be filed before substantive examination
 - Must file request for participation in PCT-Patent Prosecution Highway Pilot Program

Foreign Patent Office Databases

- Patents and patent applications
 - WIPO international patent applications
www.wipo.int
 - European patents and patent applications
www.epo.org
 - Japanese patents www.jpo.go.jp
 - Canadian patents www.cipo.gc.ca
 - Australian patents www.ipaustralia.gov.au

POST-ISSUANCE

Further USPTO Procedures

- Supplemental examination (only for patents enforceable after 9/15/12)
- **Post-grant review** (only for apps filed after 3/15/13)
- Covered Business Method challenge (only for certain business method patents)
- Reissue (all issued patents)
- Inter-partes review (all issued patents)
- Derivation proceedings (only for apps filed after 3/15/13)
- Reexamination (all issued patents)
- Litigation (all issued patents)

Challenge to Patent After Issuance

- Post-Grant Review
 - Effective date September 16, 2012, only for cases filed after March 16, 2013
 - Within 9 months of patent issuance by third party
 - Standard for initiation
 - Whether information presented is more likely than not to show a claim is unpatentable; or
 - Raises a novel or unsettled legal question that is important to other patents or patent applications
 - Grounds for challenge, such as patents, printed publications, prior use, prior sale, publically available, lack of written description, lack of enablement, etc.
 - Requester is stopped from later challenging validity of claim or claims on any ground raised or reasonably should have been raised

Challenge to Patent After Issuance (Cont.)

- Ex Parte Reexamination (not a challenge)
 - Patent owner or third party
 - Patent or printed publication raises new question of patentability
 - Preparation for litigation

Challenge to Patent After Issuance (Cont.)

- Inter Partes Reexamination until Sept. 15, 2012
- Replaced with Inter Partes Review
 - Requested by other than patent owner
 - Based on patent or printed publication
 - Information in request shows there is a reasonable likelihood that requestor would prevail on at least one claim
- Business Method Review
 - Party charged with Infringement
 - For AIA, the review may only begin nine months after issuance of patent
 - For pre-AIA, the review can begin right after patent grant
 - For AIA, review can be on any grounds
 - Pre-AIA, limited prior art shall apply

Recommendations

- File Early and Often
 - 1st provisional
 - Before publication at 18 months—second provisional with follow-on material
 - If U.S. only—another follow-on provisional before 30 months

Patent Maintenance

- Patent Certificate of Correction - Typos
- Maintenance Fees Due
 - 3.5 Years After Issuance (\$1,600)
 - 7.5 Years After Issuance (\$3,600)
 - 11.5 Years After Issuance (\$7,400)

Criteria for Payment:

Licensed/Not Licensed

Agency Regulations

Inequitable Conduct

- Can inoculate a patent against inequitable conduct by use of supplemental exam
- Requires clear & convincing evidence of at least a threshold level of evidence that applicant both:
 - 1) made affirmative misrepresentation of material fact, failed to disclose material information or submitted false material information; and
 - 2) act was intended to deceive the PTO

Patent Opinions

- Freedom to Operate/Infringement Opinions
 - Not common for federal government because use is considered necessary
 - Disclose known related patents
 - Search prior unexpired patents related to product/process made based on licensed patents

Patent Opinions (Cont.)

Freedom to Operate (Cont.)

- Construe all limitations of independent claims of most relevant patents from above based on extrinsic evidence
 - Claims
 - Specification
 - File Wrapper
 - Recent Court Decisions

Patent Opinions (Cont.)

Freedom to Operate (Cont.)

- Compare elements of product and/or steps of process to be manufactured/used by licensee to most relevant patent claims
 - Literal construction
 - Doctrine of Equivalents
- Cost
 - Approximately \$15-25K depending on number of products/processes of licensee, complexity of technology, extent of search, number of relevant patents

Patent Opinions (Cont.)

- Validity study needed if infringement appears plausible
 - Extensive search of all related PA with respect to possible infringed patents
 - Cost of patent search approximately \$3-10K
 - Cost of non-patent search approximately \$3-15K
 - Includes statutory bars & other relevant info such as government contracts, inequitable conduct

Patent Opinions (Cont.)

Validity Study (Cont.)

- If infringement appears plausible
 - Analysis of PA & relevant material with respect to possible infringed patents
 - Base on claim construction
 - Other info to render patent unenforceable
 - Ownership & inventorship issues
 - Cost approximately \$5-10K
- Formal written opinion if requested
 - Cost approximately \$3-6K

Awards & Incentives

- Agency award programs for filing and issuance
- Royalty-based award
 - 20% to inventor, up to \$150K
 - First \$2000 immediately to inventor
 - Award not direct payment - No conflict for inventor to accept under 18 U.S.C. § 209



TRADEMARK

Value of IP 2x

- Protect the product or process being sold
- Protect name or goodwill of company
- License or sell IP to others
- Allows protection for investment in product by blocking competitors from entering marketplace
- Enhance value of company for investors or sale
- Intangible internal values – proof of productivity, effect on competitors

Trademark Value

The largest source of intangible value in a company is its trademark, “Intangible” means the worth of an asset that you can't touch--unlike, say, a piece of equipment, a building or even a pile of cash.

Good will=Brand recognition and reputation.

Trademark Definition

First Time

- Any **nonfunctional** sign or designation that acts as an exclusive source-**identifier** for a **product or *goods* or for a business or a *service*.**
- Trademarks prevent consumer confusion.
- Assumes sales

Trademark Designation Symbols

TM **®**

Trademarks

- **Rights immediately accrue** when used in association with goods or services in commerce
 - Public Use in commerce [™]
 - State registration—intrastate commerce [™]
 - to notice the public that a trademark is being reserved for use [™]
 - Federal registration—interstate commerce [®]
- **Protection lasts indefinitely**
 - If properly used
 - If renewed

Trademark Use

- To avoid genericism, always use trademark as a Proper adjective -- **SCOTCH** brand tape.
- Must police trademark use to avoid trademark dilution
- Must consider international presence when deciding where to seek protection and where to enforce

Trademark State Registration

- Provides protection in-state only
- Filing requirements specific to state

The Lanham Act Federal Registration

- “The owner of a trademark **used in commerce** may request registration of its trademark on the principal register ... by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement.”



The Lanham Act -- Government

- “No trademark ... shall be refused registration on the principal register on account of its nature unless it—
- (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

The Lanham Act -- Government

- “No trademark ... shall be refused registration on the principal register on account of its nature unless it—
- (c) Consists of or comprises the name, signature, or portrait of a deceased President of the **United States during the life of his widow, if any, except by the written consent of the widow.** Unintentional sexism

Traditional Types of Trademarks

– Word mark

- *Standard Character—its vanilla*

A standard character mark is one where the mark has word(s), letter(s), and/or number(s) with no design element and no claim to any particular font, style, size. For example, U.S. Trademark Reg. No. 1,228,409 is the registration for the mark “TIFANNY”.

Trademarks

- Provide protection for words or symbols or combination used by manufacturer or merchant to identify source of goods or services

Int. Cl.: 14

Prior U.S. Cl.: 28

United States Patent and Trademark Office

Reg. No. 1,228,409

Registered Feb. 22, 1983

TRADEMARK
Principal Register

TIFFANY

Tiffany & Company (New York corporation)
727 5th Ave.
New York, N.Y. 10022

For: DECORATIVE ART OBJECTS MADE IN WHOLE OR IN PART OF PRECIOUS OR SEMI-PRECIOUS METALS—NAMELY, FIGURINES, BOXES, BOWLS, TRAYS, AND FLOWERS, JEWELRY, SEMI-PRECIOUS STONES, AND NATURAL AND CULTURED PEARLS, in CLASS 14 (U.S. Cl. 28).

First use 1868; in commerce 1868.
Owner of U.S. Reg. Nos. 132,262, 133,063 and 139,646.

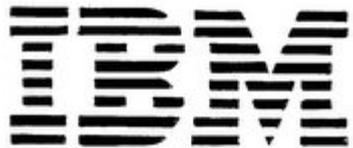
Ser. No. 304,915, filed Apr. 9, 1981.

DAVID E. BUCHER, Examining Attorney

Traditional Types of Trademarks

– *Special Form marks*

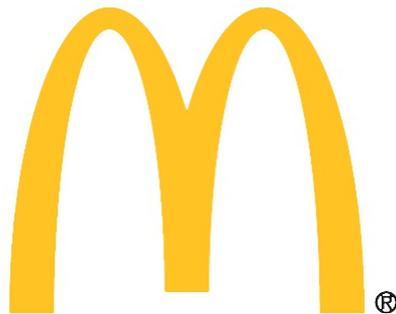
- ***Stylized lettering or a special font***

The IBM logo consists of the letters 'IBM' in a bold, black, sans-serif font. Each letter is composed of eight horizontal bars of equal thickness, creating a striped effect.The Coca-Cola logo is the word 'Coca-Cola' written in a red, cursive script font. The letters are highly stylized with elegant curves and flourishes.

Traditional Types of Trademarks

– *Special Form marks*

• **Logo**



Traditional Types of Trademarks

--Special Form marks

– **Logo with Text**



Multiple Registrations

Nike owns:

[U.S. Trademark Reg. No. 978,952](#) on the standard characters “NIKE” for athletic shoes,

[U.S. Trademark Reg. No. 1,232,243](#) on the “swoosh” logo alone for athletic shoes

[U.S. Trademark Reg. No. 1,325,938](#) on combination of the word NIKE with the “swoosh” logo for athletic shoes

Multiple Registrations

So why :

Inherently the vanilla word mark provides broad protection when used in commerce in association with goods or services. Why obtain additional marks?

Multiple Registrations

- The marks are different and recognized as such by the Trademark office.
- Serve different marketing purposes for the company.
- Each contributing to the intangible good will of the company.
- Broadens coverage.

Trademark Distinctiveness—the inherent strength of an individual mark

- **Fanciful** (EXXON made up word, for petroleum products)
- Arbitrary (APPLE for computers)
- Suggestive (AIRBUS for airplanes)
- Descriptive (IPHONE for cellular phones)
 - Can only be protected if it acquires “**secondary meaning**” through exclusive use and consumer recognition as a single source of origin
- **Generic** (CLOCK for timepieces)
 - Can NEVER be protected or can lose protection had.

Trademark Federal Registration

- Description of goods/services offered
- Can apply based on actual use in commerce or a bona fide intent to use
 - Applicant must eventually prove use in order to obtain a federal registration
 - Date of first use in commerce
 - Date of first use in interstate commerce
- Allege or show distinctiveness
 - Evidence
 - Public recognition
 - How long in use

Trademark Search

- USPTO trademark files (uspto.gov)
- Search engine – the Internet
- SEC files (EDGAR)
- Search beyond exact match, e.g., cognates, wildcards
- Begin or narrow by searching description of good/service
- USPTO logo search/Assignee search available
- Search thoroughly and BEFORE selling product or putting up website or other web presence

Trademark Examination

- Confusingly similar?
- Descriptive of underlying good/service?

Trademark Infringement

- Trademark infringement is the **unauthorized use** of a trademark or service mark **on or in connection with goods and/or services** in a manner that is likely to cause confusion, deception, or mistake about the source of the goods and/or services.

Trademark Infringement-considerations

- Strength of senior user mark
- Similarity of the marks
- Similarity of product or services
- Evidence of actual confusion
- Sophistication of the buyer
- Evidence of bad faith

Trade Names

- Trade names are used to identify names under which an organization does business
- Trade names not federally registered unless also used as a mark

Can you sell a Trademark ?

Can you sell the Trademark ?

Yes

Trademark Definition

2x

- *Any* nonfunctional sign or designation that acts as an **exclusive source-identifier** for a product or *goods* or for a business or a *service*.

If you sell the mark you sell the business because the goods and the mark are inseparable.

Can you license a Trademark ?

Can you license a Trademark ?

Yes

Condition of licensing Trademark

- Policing

licensing Trademark –considerations

- **Policing**

- Are you exercising control over the mark

- Appearance of mark
- Quality of the goods
- Exceeding scope of license

Non conventional – Trademark

Sound?

Trademark Definition --

3x

- Any nonfunctional sign or designation that acts as an exclusive source-identifier for a product or *goods* or for a business or a *service*.

Sound



United States Patent Office916,522
Registered July 13, 1971**PRINCIPAL REGISTER**
Service Mark

Ser. No. 349,496, filed Jan. 23, 1970

**THE MARK COMPRISES
THE MUSICAL NOTES
G, E, C PLAYED ON
CHIMES**

National Broadcasting Company, Inc (Delaware corporation)
30 Rockefeller Plaza
New York, N.Y. 10020

For: BROADCASTING OF TELEVISION PROGRAMS, in CLASS 104 (INT. CL. 38).
First use at least as early as Sept. 9, 1961; in commerce at least as early as Sept. 9, 1961.
The mark comprises a sequence of chime-like musical notes which in the key of C sound the notes G, E, C, the "G" being the one just below middle C, the "E" the one just above middle C, and the "C" being middle C, thereby to identify applicant's broadcasting service.
Owner of Reg. No. 523,616.





Sound



Sweet Georgia Brown

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent and Trademark Office

Reg. No. 1,700,895

Registered July 14, 1992

**SERVICE MARK
PRINCIPAL REGISTER**

SENSORY MARK—NO DRAWING

INTERNATIONAL BROADCASTING CORPORATION (MINNESOTA CORPORATION)
5101 IDS CENTER
MINNEAPOLIS, MN 55402

FOR: ENTERTAINMENT SERVICES IN THE NATURE OF BASKETBALL EXHIBITIONS, IN CLASS 41 (U.S. CL. 107).

FIRST USE 12-0-1948; IN COMMERCE 12-0-1948.

THE MARK CONSISTS OF THE MELODY "SWEET GEORGIA BROWN".

SER. NO. 74-158,626, FILED 4-19-1991.

BLANCA I. SANTIAGO, EXAMINING ATTORNEY

TM Sound Source

- <https://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>

Non conventional – Trademark

Non conventional – Trademark

Color?

Non conventional – Color

Color can function as a mark if it is used in the manner of a trademark or service mark and if it is perceived by the purchasing public to identify and distinguish the goods or services on or in connection with which it is used and to indicate their source.

Non conventional – Color



Color

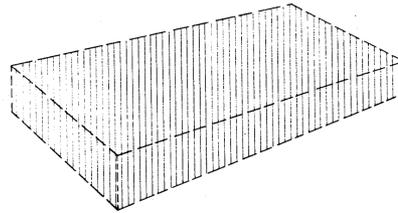
Int. Cl.: 17

Prior U.S. Cl.: 12

Reg. No. 1,439,132

United States Patent and Trademark Office Registered May 12, 1987

**TRADEMARK
PRINCIPAL REGISTER**



OWENS-CORNING FIBERGLAS CORPORATION
(DELAWARE CORPORATION)
FIBERGLASS TOWER
TOLEDO, OH 43659

FOR: FIBROUS GLASS RESIDENTIAL INSULATION, IN CLASS 17 (U.S. CL. 12).
FIRST USE 0-0-1956; IN COMMERCE 0-0-1956.

THE DRAWING IS LINED TO INDICATE THE COLOR PINK.
SEC. 2(F).

SER. NO. 247,707, FILED 1-25-1980.

ROBERT PEVERADA, EXAMINING ATTORNEY

Non conventional – Trademark

Scents, flavors, product shapes, and even online motion marks can function as Trademarks

Non conventional – Trademark



Can you register the color orange in this instance for toy guns ?

Trademark Definition

4x

- **Any nonfunctional** sign or designation that acts as an exclusive source-identifier for a product or *goods* or for a business or a *service*.

Non conventional – Trademark



Federal law requires toy or imitation guns like these to have an orange tip to let people know they are fake. Orange in this instance is functional.

Trademark

END



Can you register the color orange in this instance? No

COPYRIGHT

17 USC §102 Copyright subject matter

© Provides individuals and companies with legal protection for a wide variety of works of original authorship fixed in a tangible form of expression.

- Literary
- Musical
- Dramatic
- Pantomimes
- Choreographic
- Motion Pictures
- Pictorial, graphic and sculptural
 - characters
- Audiovisual
- Sound recording
- Architectural works
- Computer databases and software

Copyright Not Available for . . .

- Titles, names, short phrases, and slogans
- Familiar symbols or designs
- Mere variations of typographic ornamentation, lettering, or coloring
- Mere listing of ingredients/contents
- Ideas, procedures, methods . . . (patent subject matter)
- Works consisting entirely of information that is common property, not original authorship (e.g., facts)

17 USC §102 Copyright subject matter

In no case does © protection extend to any **idea**, procedure, process, system, method of operation, concept, principle or discovery.

Feuding families and
lovers – one from each
feuding family

Copyright Notice

- **copyright © 2002 John Doe**

Serves to provide notice to the world of the author's intent to protect his or her rights.

Copyrights and Registration (not)

- Copyright registration ---Not required
- Fix material in tangible form, publish, notice
- Copyright is secured automatically when a work is created
- Copyright is secured on the date the work is published or registered in unpublished form
- Copyright registration is necessary to gain additional benefits – statutory damages, import protection -- procedural advantages when taking infringement action

17 USC §106 The exclusive rights

The rights given by ©

- To reproduce
- Prepare derivative works
- Distribute copies
- To perform publicly
- To display publicly
- Publicly by audio transmission

Copyright (Cont.)

- Copyright protection
 - Occurs upon creation
 - Lasts for the life of the author plus 70 years
 - For “work for hire,” lasts 95 years from publication or 120 years from creation, whichever expires first
- Copyright ownership resides with
 - Author
 - Employer when work for hire

Copyright Infringement

- Requires copying –access

Example:

1. You write a book in 2000 **titled** *Fifty Shades of Grey* *about paint products belonging to paint manufactures world wide*
2. I write a book in 2001 **titled** *Fifty Shades of Grey* *about paint products* and I developed my book independently, without any copying, then there is no copyright infringement.

17 USC §105 Copyright US Gov. Works

No copyright protection is available for works created by federal government employees performing federal government work

- But issues will arise –all of your scientists publish.
- All of the publishers want the copyright.
- All will send you a form to sign :

Publisher wants the copyright

- I (author) own copyright, and I am assigning copyright in my article to Publishers XYZ .

Sign here

You will push back

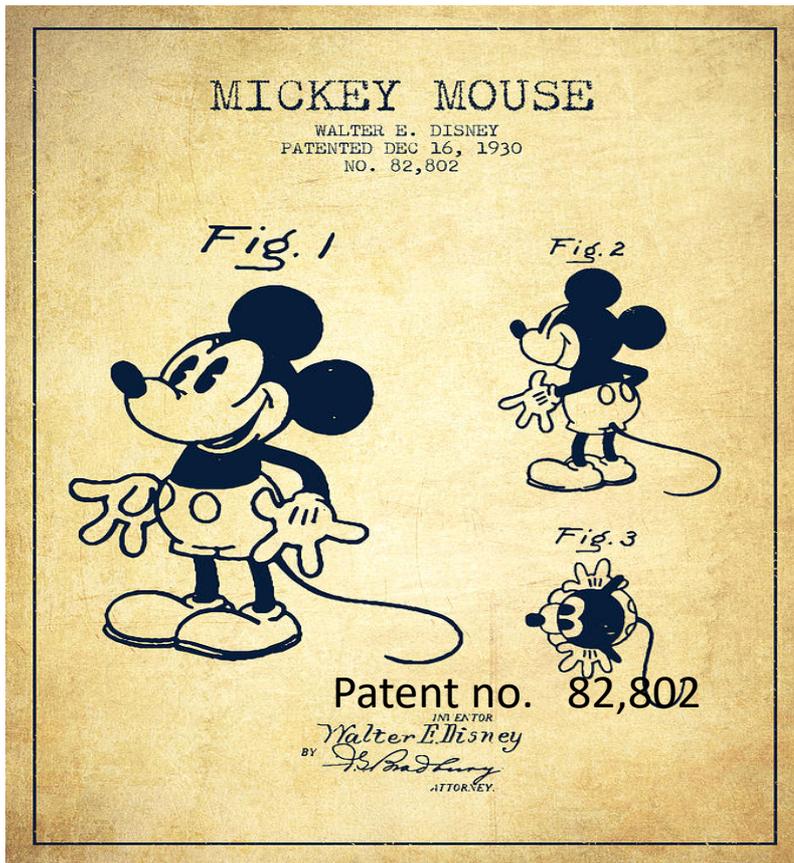
“Portions of this book were written and prepared by officers and/or employees of the U.S. Government as part of their official duties and are not copyrightable.”

17 USC §102 Copyright subject matter

^{2x} © Provides individuals and companies with legal protection for a wide variety of works of “authorship” fixed in a tangible form of expression.

- Literary
- Musical
- Dramatic
- Pantomimes
- Choreographic
- Motion Pictures
- Pictorial, graphic and sculptural
 - characters
- Audiovisual
- Sound recording
- Architectural works
- Computer databases and software

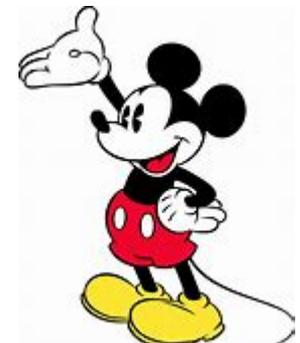
The intersection of Copyright Trademark & Patent Law



TM Reg No.
5027809



Copyright
Registration No.
??



Fair Use

Fair use



Q. I am giving a lecture soon on trademarks and copyrights and in one slide I want to just touch on the overlap of three intellectual properties. Can you send me a copy or just give me the copyright registration Number for this mickey mouse or a mickey mouse very similar ?

Fair use

ANSW.

Please follow the link below and fill out the form:

- <http://disneypermissions.force.com/WelcomeIntakePage>

17 USC §107 Fair USE

- The fair use of a copyrighted work, including such use by reproduction in [copies](#) or [phonorecords](#) or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

Fair Use

Response:

Was not really looking for permission. Pretty sure I do not need your permission. I am displaying for purposes of scholarship.

RIGHTS IN GOVERNMENT INVENTIONS

Ownership

- Ownership follows inventorship (Inventor -> Employer)
- Unless:
 - An agreement states otherwise
 - Cooperative Research & Development Agreement (CRADA)
 - Law states otherwise
 - FAR Part 27, Bayh-Dole Act, Executive Order 10096, patent law

Key Definitions

- Invention
 - Any invention or discovery which is or may be patentable or otherwise protectable under Title 35 of the United States Code
- Subject Invention
 - Any invention of the contractor made in the performance of work under [the] contract
- Made
 - (1) When used in relation to any invention other than a plant variety, means the conception or first actual reduction to practice of the invention; or (2) when used in relation to a plant variety, means that the contractor has at least tentatively determined that the variety has been reproduced with recognized characteristics

Contractor's Patent Rights Under FAR 52.227-11 and DFARS 252.227-7038

- Contractor may retain the entire right, title, and interest throughout the world to each subject invention; with respect to any subject invention in which the contractor retains title, the federal government shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world
- Based on recent regulation changes this includes joint inventions (It wasn't clear before)

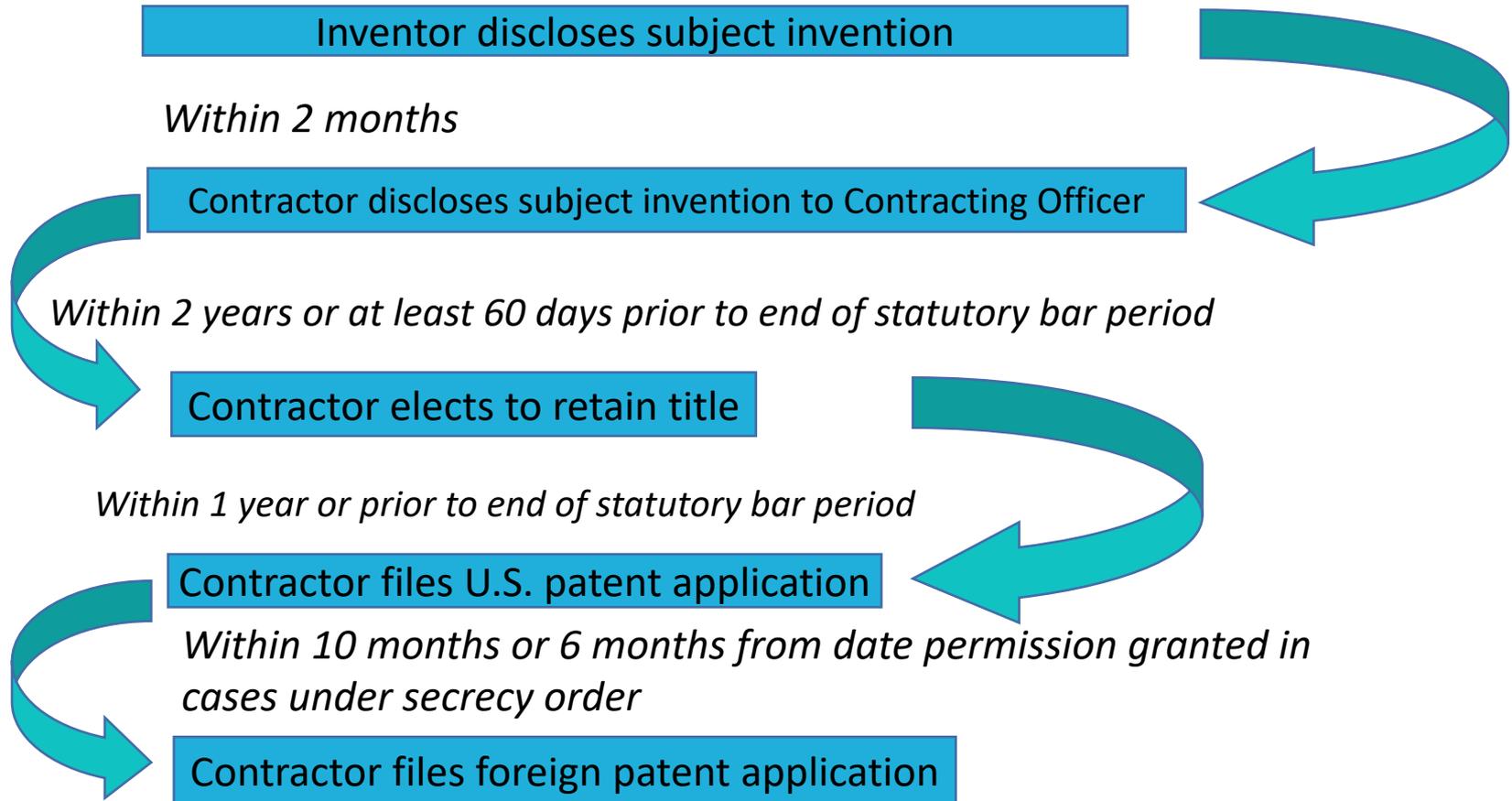
Contractor's Patent Rights Under FAR 52.227-11 and DFARS 252.227-7038 (Cont.)

- With respect to any subject invention to which the government takes title, the contractor shall retain a revocable, nonexclusive, royalty-free license throughout the world, except if the contractor fails to disclose the subject invention to the Contracting Officer within the specified time
- Contractor's license may be revoked or modified to extent necessary to achieve practical application of subject invention - requires written notice - contractor allowed 30 days to show cause why license should not be revoked

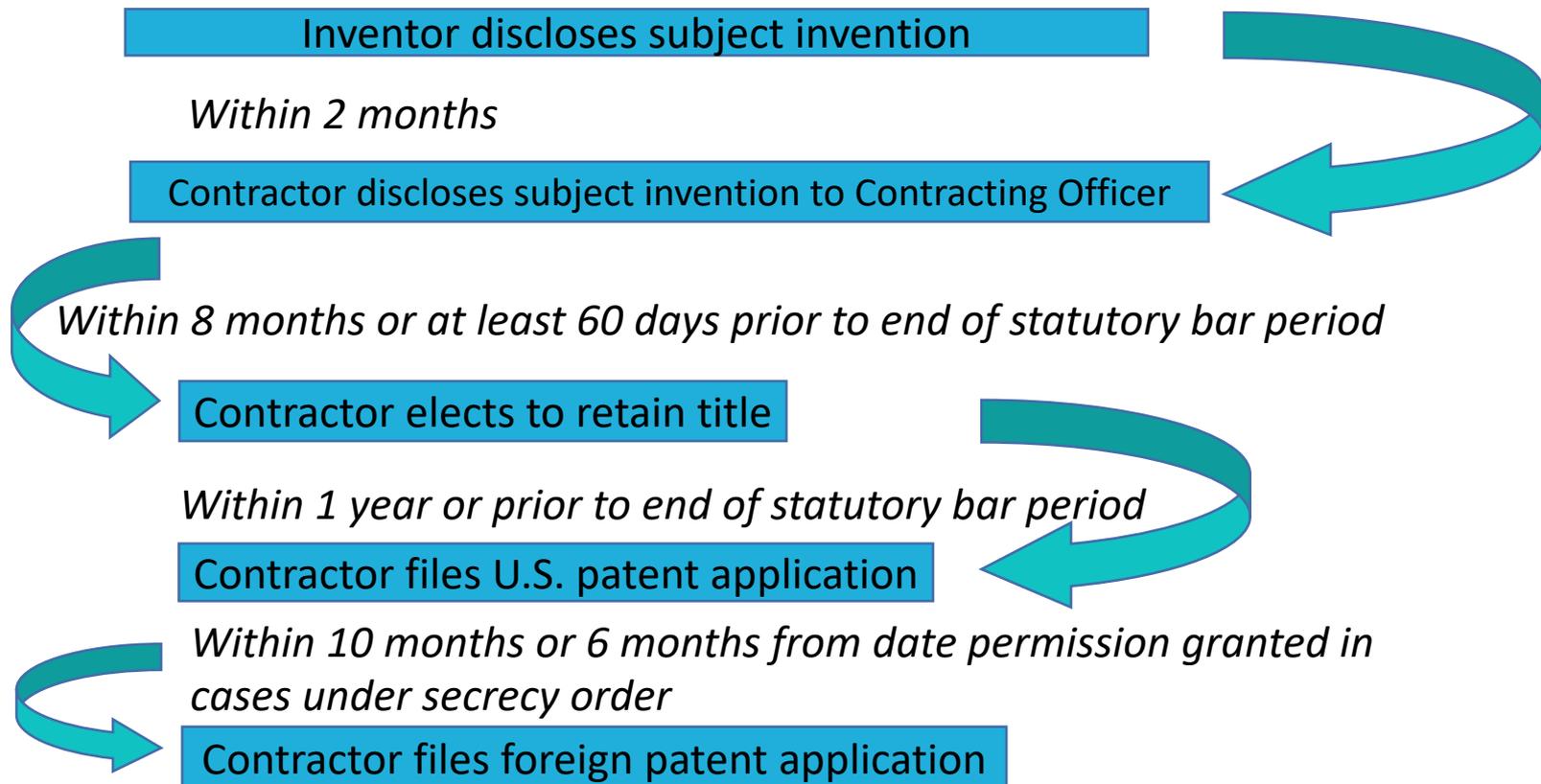
Action Contractor Must Take to Protect Government's Interest

- Execute or have executed all instruments necessary for government to obtain title or obtain patent protection
- Require, by written agreement, its technical employees to disclose promptly in writing all subject inventions
- Notify federal agency of any decision not to continue patent prosecution, pay maintenance fees, or defend reexamination 30 days prior to expiration of response period
- Include within specification of U.S. patent application on subject invention the following statement: "This invention was made with Government support under (identify contract) awarded by (identify federal agency). The Government has certain rights in this invention"

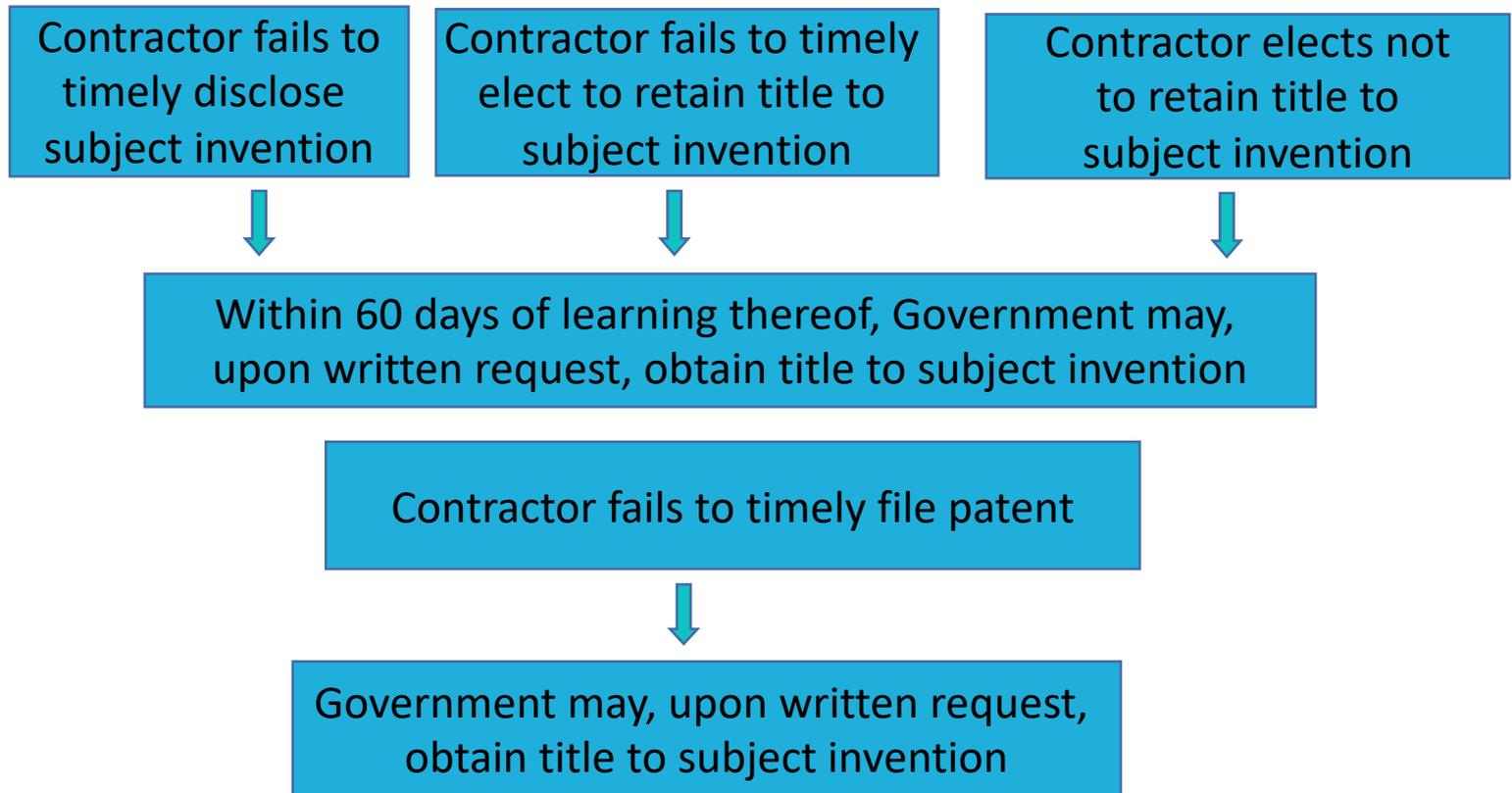
Timeline - FAR 52.227-11



Timeline - DFARS 252.227-7038



What If?



Subcontracts

- Subcontractor shall retain all rights as if subcontractor were contractor
- Contractor shall not, as part of consideration for awarding subcontract, obtain rights in subcontractor's inventions

Preference for U.S. Industry

- Contractor agrees that neither it, nor any **assignee**, will grant any person exclusive right to use or sell subject invention unless such person agrees to manufacture substantially in U.S.
- Waivers may be obtained

March-in Rights

- Federal agency has right to require contractor, an assignee or exclusive licensee to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to responsible applicants if
 - Contractor or assignee has not achieved practical application of invention
 - Health & safety needs not satisfied by contractor or assignee
 - Public use specified by public regulations is not satisfied by contractor or assignee
- This bothers contractors a lot but is extremely rarely used

TRADE SECRETS

18 USC 1905 – The Trade Secrets Act

Whoever, being an officer or employee of the United States or of any department or agency thereof, ... discloses, or makes known in any manner or to any extent not authorized by law any information coming to him in the course of his employment ... which information concerns or relates to the trade secrets ...; shall be fined under this title, or imprisoned not more than one year, or both; and shall be removed from office or employment.

Two Types in Federal Law

- Technical information – includes software, invention disclosures, dimensions in drawings, manufacturing techniques
- Business proprietary information – includes costs, wage rates, marketing plans, patent licensing business plans, and CRADA statements of work

Business Proprietary Information

- This information cannot be disclosed to a third party without permission from the providing party unless there is statutory permission.
- No clear statutory permission for this type of information, so permission must be obtained.
- Be very careful with CRADA statements of work and other business plans.

Technical Information

- Can be released to third parties with contractual protection.
- Protection generally follows the source rule. The party that pays for the data gets ownership.
- This is the basis for contract data rights provisions.

Data Rights

Definitions in DFAR 252.227-7013: Rights in Technical Data--Noncommercial Items
(June 2013)

Technical data

- Recorded information of a scientific or technical nature (including computer software documentation)
- Does not include computer software or financial/management products

Government purpose rights

Right to—

- (i) Use, modify, reproduce, release, perform, display, or disclose technical data within the Government without restriction; and
- (ii) Release or disclose technical data outside the Government and authorize persons to whom release or disclosure has been made to use, modify, reproduce, release, perform, display, or disclose that data for United States government purposes

Data Rights (Cont.)

Limited rights

- Right to use, modify, reproduce, release, perform, display, or disclose technical data, in whole or in part, within the Government
- Government may not, without the written permission of the party asserting limited rights, release or disclose the technical data outside the Government, use the technical data for manufacture, or authorize the technical data to be used by another party, with certain exceptions

Unlimited rights

- Right to use, modify, reproduce, perform, display, release, or disclose technical data in whole or in part, in any manner, and for any purpose whatsoever, and to have or authorize others to do so

Data Rights Exceptions for SBIR-STTR Program

- Small business concern retains rights to data in performance of award for not less than five years after completion of project
- Agencies are required to protect SBIR data rights developed from Phases I, II and III, including rights of subcontractors
- Agencies cannot condition Phase III award on giving up SBIR data rights—negotiations after award, by separate agreement, without pressure is permissible

Data Rights Exceptions for SBIR-STTR Program (Cont.)

- SBIR data rights continue to be protected from date of delivery of last deliverable under award
- Any SBIR data protected and referenced under a subsequent SBIR award remains protected under protection period of subsequent award

Government Trade Secret Info

- Not related to security or classification
- This can be computer software, unpublished inventions, information developed under a CRADA
- Government can license this information as an invention license or a software license
- Sometimes use a nondisclosure agreement from the Govt to an outside party to protect an invention. This type of agreement has never been legally enforced

EXPORT CONTROL

EXPORT CONTROL

The entire purpose is to protect the US and its war fighter, to keep technology that could be used against us out of the hands of our enemies.

What is an Export

- The shipment or transmission of items out of the United States

Or

- The release of controlled technology and/or information to a non-U.S. person regardless of where the export takes place. –Deemed Export
 - Does not apply to permanent resident aliens

Who Controls? Answ: Commerce Dept. --Export Administration Regulations (EAR)

- There are lists that must be reviewed to determine if something is export controlled
- EAR Controlled by Commerce includes things that may be have a dual use (good and evil), like supercomputers and milling machines.

Who Controls? Answ: or the State Dept. the International Traffic in Arms Regulations (ITAR).

- There are lists that must be reviewed to determine if something is export controlled
- ITAR controlled by the State Dept. includes weapons and defense-related goods –Tanks
- guns over caliber .50 and **flame throwers** specifically designed or modified for military application, for example

Elon Musk made headlines by selling
20,000 Boring Company branded
“flame throwers” in a matter of days



Compliance With Export Control

- Key in determining whether an export license is needed from the Department of Commerce, Bureau of Industry and Security (BIS) is knowing whether the item you intend to export has a specific Export Control Classification Number (ECCN)

Export Administration Regulations (EAR) Controlled by the Commerce Department--10 Broad Categories

- Nuclear
- **Chemicals, Microbes and Toxins**
- Materials Processing
- Electronics
- Computers
- Telecommunications
- Laser and Sensor
- Navigation and Avionics
- Marine

Export Administration Regulations (EAR) Controlled by the Commerce Department--10 Broad Categories-- Commerce Control List (CCL)

- <https://www.bis.doc.gov/index.php/regulations/commerce-control-list-ccl>
- 15 CFR parts 300 to 799
- BIS (202) 482 4811

10 Broad Categories –and in such commodities are listed that may have an ECCN --Export Control Classification Number

- If your item falls under U.S. Department of Commerce jurisdiction and is not listed on the CCL, 15 CFR parts 300 to 799 it is designated as EAR99. EAR99 items generally consist of low-technology consumer goods and do not require a license **in many situations**

But never ship anything to an embargoed country without checking further -can you get a license?

- **Crimea REGION OF UKRAINE,**
- **CUBA**
15 CFR parts 300 to 799
- **IRAN**
- **NORTH KOREA**
- **SUDAN and**
- **SYRIA**
 - **Maybe medical supplies and certain food staples are ok**

More lists

- BIG Chart called the Commerce Country Chart
 - Country list –all countries listed
 - Reasons for Control List
 - AT-Anti-terrorism (1,2)
 - CB- Chemical and Biological Weapons (1,2,3)
 - CC -Crime Control (1,2,3)
 - SS -Short Supply
 - Etcetera

Some items that are listed w/ ECCN numbers —examples

- 1B003 Tools dies Molds for super plastic forming etc.
 - 1B003b. Aircraft or aerospace engines –can ship to Canada without a license but not too Afghanistan for instance.
- 1C351 Human and Animal Pathogens
 - 1C351.a.39 Rabies Virus -- requires a license to send to all countries –never to Embargoed countries

Applying for License

SNAP R **Simplified** Network Application Process

<https://www.bis.doc.gov/index.php/licensing/simplified-network-application-process-redesign-snap-r>

- Register designated folks in your agency/company/ university who can access site
 - Simplified is over exaggeration

Checking status of license

- Once license is filed you will get “Z number”
- Check status by linking onto another data base:

“Stela” System for Tracking Export License Applications

Export Control Good News

- Most of the items you will export are EAR99—
not subject to license
- Commerce Dept. generally does not control
“Fundamental Research” or “Basic Research”
- How to Protect your scientist?
 - Follow regs.
 - Material Transfer Agreements

MTA language

- Recipient shall not transfer the Material...to a third party without the express written consent of ARS. ..
- The Material shall remain the property of ARS and shall not be used for commercial or profit making purposes without an appropriate license or other permission from ARS.
-

Contact Information

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Naval Undersea Warfare Center, Newport

Tel: 401-832-4230

Email: james.kasischke@navy.mil

Thank you.

You deserve
a pat on the
back!

United States Patent (19) **Patent Number: 4,608,967**
Piro (45) **Date of Patent: Sep. 2, 1986**

[54] **PAT ON THE BACK APPARATUS** 5,679,102 7/1973 Perrine 224/265
 5,850,002 12/1974 Matsumoto 128/62 R
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[58] **Field of Search** 128/24.2, 24 R, 24 A,
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[57] **ABSTRACT**
 A self-congratulatory apparatus having a simulated human torso carried on a pivoting, strap suspended torso-shoulder supported member. The hand is manually swingable into and out of contact with the user's back to give an amusing or an important pat-on-the-back.

4 Claims, 1 Drawing Figures

