



# Approaching the “Patent Cliff”

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# Continued Implementation of Leahy-Smith America Invents Act (AIA)

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## Changes taking effect in 2013

- First-inventor-to-file (effective **March 16**)
- Repeal Statutory Invention Registration (SIR)
- New derivation proceedings
  - ✓ Will not prevent first filer from obtaining a patent even if first filer's invention is an obvious extension of information derived from another
  - ✓ Monitor recently issued patents to determine need to file derivation proceedings
  - ✓ Use provisional patent application to avoid derivation proceedings (and reduce cost)
- New Post-Grant Review (PGR)
  - ✓ Request PGR within 9 months if new patent blocks your product(s)
- New fee schedule (effective **March 4**)



# New Fee Schedule

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## What is a “Micro Entity”?

- **Qualifies as Small Entity**
  - ✓ Has not assigned, granted, conveyed, or licensed (except to Federal agency), and under no obligation to assign, grant, convey, or license, any rights in the invention
  - ✓ Person/Individual
  - ✓ Small Business < 50 employees
  - ✓ Nonprofit Organization
- **Has not been named as inventor on more than four previously filed patent applications**
- **Has gross income below designated level**
  - ✓ Without having transferred ownership interest in the application to an entity with gross income exceeding such designated level
- **Eligible for 75% reduction in fees**
  - ✓ Provisional application filing fee = \$65
  - ✓ Non-provisional (utility) filing, search and exam fees = \$400



# First Inventor to File (FITF)

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## New “Rules of Thumb”

- In general, he who files first wins
- Race to the patent office
- Avoid gaps between conception and disclosure
- Make sure applications are complete and accurate, and that no subject matter is missing
- Don't forget that “disclosures” include presentations, demos, website and social network postings





# Old Rules Still Apply

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Invention must not be...

- Abstract idea, scientific principle
- Human being, naturally occurring article
- Perpetual motion or atomic energy machine
- Process or business method not tied to machine

Invention must be...

- Useful – described in clear and definite terms for one of ordinary skill in the art to make and use the invention
- Novel – different from what is already known (patented, published, disclosed, on sale)
- Unobvious – considered unobvious by one skilled in the art



# Court Rulings on Obviousness

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Federal courts have held that a patent's subject matter can be proved obvious if there existed at the time of invention a **known problem** (including the problem motivating the patentee) for which there was an **obvious solution** encompassed by the patent's claims, and that **common sense** and **ordinary creativity** of a person having ordinary skill in the art are part of obviousness.



# Provisional Patent Application

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- Establishes FITF (“reduces invention to practice”)
- PPA is NOT examined by USPTO
- Utility patent application must be filed within one year to claim PPA’s filing date (priority)
- Allows applicant to use “Patent Pending”
- PPA must contain...
  - ✓ Detailed description (must include ALL subject matter)
  - ✓ Drawings (if necessary to understand the invention)
  - ✓ Claim is NOT required
  - ✓ Cover sheet
  - ✓ Fee and fee transmittal form

# Introduction to ProvisionalBuilder®

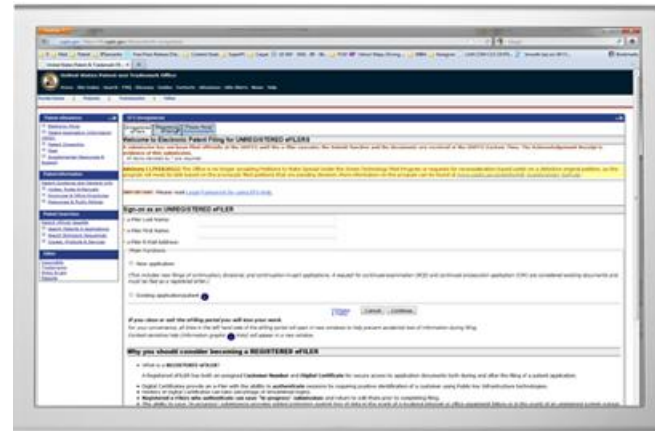
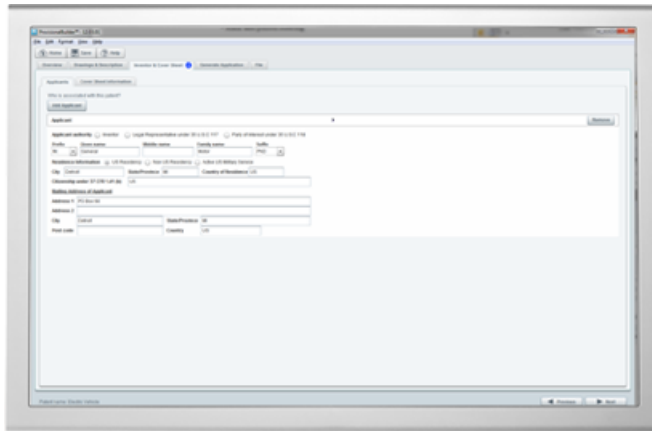
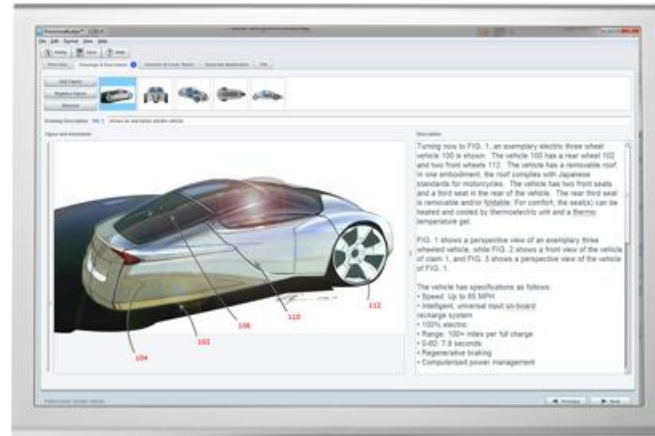
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- ✓ Comprehensive software solution which facilitates disclosure and filing of provisional patent applications
- ✓ Produces robust, error-free provisional applications
  - Real-time search engine
  - Real-time drawing verification
  - Integrated cover sheet
  - Ready-to-file format
- ✓ Speeds process
- ✓ Reduces cost
- ✓ Allows inventor to quickly and inexpensively establish IP ownership by becoming “first inventor to file”



# Introduction to ProvisionalBuilder®

ProvisionalBuilder runs on the Inventor's laptop  
(Microsoft Windows or Mac OS X)





# ProvisionalBuilder<sup>®</sup> Features

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## **Specification (Description and Drawings)**

The inventor specifies the invention with the built-in word processor and labels significant parts of imported drawings with reference numbers.



## **Online Reference Search**

ProvisionalBuilder searches, finds and displays in real-time issued patents and/or published applications while writing and editing the invention specification to show how others have described similar subject matter.



## **Inventorship and Cover Sheet**

This function allows the inventor to enter “inventorship” information and create a cover sheet that is required by the USPTO for filing a provisional patent application.



# ProvisionalBuilder<sup>®</sup> Features

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## **Verify and Generate Application**

ProvisionalBuilder checks to ensure that there are no errors or omissions in the description or drawing annotation so that applications are filed absolutely error-free. If all is in order, a ready-to-file application in PDF format is generated. There is also an option to option to export the application to Microsoft Word for subsequent editing.



## **File Application**

This function files the provisional patent application electronically with the USPTO's Electronic Filing System (EFS). [“EFS-Web utilizes standard Web-based screens and prompts to enable you to submit patent application documents in PDF format directly to the USPTO within minutes.”] Alternatively, the application can be printed and filed using US Postal Service Express Mail.



<http://www.powerpatent.com/provisional-builder>

- Video Tutorials
- User Manual And Specifications

# Community References

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“ProvisionalBuilder® offers **intuitive usability** to the novice inventor, while the documentation and help videos do a great job explaining the provisional patenting process. We’re proud to have helped guide its entry into the inventor community and know **first-time patent filers will find it to be a useful and valuable tool.**”

*Mark Reyland*

*Executive Director, United Inventors Association of America*



“ProvisionalBuilder® software’s ability to **quickly access patent databases** and bring up a detailed patent is really helpful to me as an inventor.”

*Robin Faulkner*

*President, Danbury Inventors Group*

# Customer References



“I recently used ProvisionalBuilder to file our system and method provisional patent application. **It made the task of filing easy.** The software helped break up the content into manageable, structured segments and provided helpful hints along the way. Its database of awarded patents made researching other patents a cinch. And, the ability to export the document into PDF and Word formats came in handy as I was able to send the document to my peers for review. **I highly recommend this software – it is like having an attorney on staff.”**

*Jay Sigonahalli*

*Co-Founder and CTO, Internet start-up in Redwood City, CA*



“I read the ProvisionalBuilder user manual and immediately started work on my provisional application. **I was able to put together a very solid application in a matter of days without the benefit of extensive knowledge of patent writing.** I was able to learn from the various patented products’ descriptions, since they are in my patent’s domain, and then easily highlight what differentiates the look and function of my unique product from other products. **I couldn’t be happier with your product and will be starting another provisional patent application very soon.”**

*Michael Palladino*

*Founder and Owner, Basic Innovations Group in Newport Beach, CA*



# Read more about it...

[http://www.powerpatent.com/update/download/Brochure\\_Mar6\\_2012.pdf](http://www.powerpatent.com/update/download/Brochure_Mar6_2012.pdf)

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ProvisionalBuilder™ is a software tool from PowerPatent Inc. that is designed to help you draft and submit provisional patent applications to the United States Patent and Trademark Office (USPTO). ProvisionalBuilder streamlines the process of drafting your application and conforms to the required USPTO format. This makes conversion to the eventual utility patent application a snap.

Designed by a team of legal, software, user experience, and Web design professionals, ProvisionalBuilder is easy to use and thorough. Benefits include:

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ProvisionalBuilder uses "how-to" guides that prompt the user to construct the application correctly. This easy-to-follow, approach guides anyone, even those with no patent experience, through the application process.

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Based on your description, ProvisionalBuilder quickly locates examples of how others have described similar subject matter in patents or published patent applications.

#### Easy Annotation of Drawings

You can import drawings from your favorite graphic software programs and use ProvisionalBuilder to label important parts of these drawings with reference numbers. Using these reference numbers, you then can describe the operation of the invention using reference numbers in the description sections of the drawings.

#### Easy Editing

Your patent application can be edited with ProvisionalBuilder's built-in word processor. If you prefer to edit using Microsoft Word, the application can be exported to Microsoft Word or Rich Text (RTF) formats for editing. You also can export PDF files to send to others reviewing the draft application.

#### Extensive Help System

The software includes a detailed manual, Frequently-Asked-Questions, video guides and a "quick-start" guide to help you draft your application. Even if you have never seen a patent application, ProvisionalBuilder guides you step-by-step through the application, with plain-English explanations.

#### Extensive Diagnostics and Error Checking

ProvisionalBuilder checks your application, helps you catch common errors or omissions, and gives you peace of mind when you file.

#### On-line Patent Filing

ProvisionalBuilder generates a complete, professional-looking patent application document that can be electronically filed with the USPTO. Alternatively, you can print the application and express mail the application to the USPTO.

#### Confidential Access

ProvisionalBuilder stores all patent information locally on your computer. A personal password can be chosen to protect this information.

#### System Requirements

\* Microsoft Windows™  
\* Mac OS X

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