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SUMMARY KEYWORDS

trademark, application, trademark office, services, goods, applicants, provisional application, referred, mark, filing, claims, invention, patent, non provisional application, registration, trademark attorney, file, pitfalls, trademark application, inventor

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Hi, my name is Kirby Drake, and I'm with the law firm of CompTIA. LP. And here I am today to talk with you a little bit about the perils and pitfalls of do it yourself intellectual property or IP as as we refer to it. I think this is a topic that's been affecting the intellectual property world more and more these days, lots of economic considerations, as well as the proliferation of information that's available on the internet often causes people to to engage in Do It Yourself IP. So when I refer to do it yourself IP in this presentation, I'm referring to situations when an individual or company does it themselves. But it can also be a situation where a person or company uses an online legal solutions such as inventhelp, or legal zaim. But it can be in a third situation could be where that individual or company engages with an attorney who's not experienced in filing, patents or trademarks. So with this in mind, we're going to focus on some of the perils and pitfalls of do it yourself IP that can occur, particularly with trademarks and patents, and try to provide some tips for getting your clients or getting yourself on the right path before after you attempt to do it yourself or they attempt to do it themselves. So let's look at trademarks. First, I'm looking at slide two. For those that might not be that familiar with trademarks. A trademark can be almost anything that used to identify a product or service. It can include words, logos, shapes, colors, even smells, or cents and combinations of the same. A trademark can sometimes represent the most important asset that a business can can have. And if you have a good trademark, it can distinguish your business or your product or service from those provided by competitors. So it's critical to the success of a business to secure trademark

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protection.

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And what I mean by that is good trademark protection is despite the value that good trademark protection can can provide. Then there's many, many people that hold the belief that they can do it without the assistance of an attorney or some specialist and in in trademarks. I know it can be sometimes daunting to think about, you know, expenses that might be involved in hiring an attorney to handle trademark filing, when the forms seem on their face easy to fill out, and it can save you money. But there can be a lot of pitfalls and cutting corners and securing or maintaining trademark protection. Some of these are can include the failure to use adequately selected protectable and enforceable trademark failure to meet the trademark office requirements. Failure to adhere to what I refer to as a less is more principle and failure to complete or maintain registration. So looking at slide three, we'll focus first on the failure to adequately select an enforceable trademark. So when an individual or company attempts to file a trademark without the assistance of a trademark, or in some cases, when a attorney not experienced in trademark law, attempts to file on behalf their client issues can sometimes arise because either the attorney or the client, in those cases may not have done due diligence to confirm that the trademark is a good one. And when I say Good one, I mean capable of being protected and it's enforceable. A trademark is more likely to be enforceable when it's distinctive, and actually serves to distinguish the goods or services that are associated with the mark. And you want to distinguish from goods or services that are being provided by others. One of the common problems that we see when when people attempt to do it yourself, when it comes to trademark protection is that they tend to select a descriptive trademark that would be protected. And and sometimes it's helpful if you look at slide four, there's a sliding scale of what we refer to as what makes a good trademark. And this is a sliding scale that indicates the strength of a trademark. So on the far left, you'll have generic trademarks. These are the weakest form of trademarks, they're commonly you know a common name for a good or service. An example would be you know, if you were you know, if you're looking at gasoline gasoline is is considered to be a generic word, indicating the fuel that we may put in our cars or in other other items. And so everyone can use the word gasoline without any problem.

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This is also why you could print

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the

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picture of an apple

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on the side of a bag of apples and not have Apple computers asking you for for royalty on that first. So that's why Apple computers doesn't really sell real apples. And they can't, but they also can't force others to refer to actual apples as something else like crispy, crispy sweet for you.

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So the next

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category on the sliding scale are descriptive marks and are referred to as descriptive. earlier on, this is usually one that describes

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a quality

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or a characteristic of the good, or the services to be associated with the mark. And it's usually one of the hardest ones outside of a generic one, which I don't, I don't think there would be situations where

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you want to

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try to protect something that's generic, but descriptor ones can be very hard to obtain and enforce. Ultimately, it's just describing the

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product or the

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answer. So

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with but we don't want to give people the ability to get trademark protection for descriptive, descriptive marks

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because

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because then, you know, they could

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prohibit people from using words that they will traditionally use in conversation to describe other similar goods or services. So, as a as an example,

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you know, you might, you

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know, you might be reading an online review, and

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you'd say, you know,

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somebody uses the

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phrase, you know, Best Buy, to describe good products, you know, good you know, having a good price or you know, something that they've purchased, but you don't have to just hit a Best Buy store to buy these products that are referred to using that phrase. Generally, you know, companies that are named after their founders, like Ford motors is considered to be more of a descriptive trademark. This is because, you know, a man named you know, George Ford, he could also own a motor and he could call it you know, Ford Motor. And so, you know, the motor itself is is describing the, the product, and in this case, you know, Mr. Ford, who is not the the Ford that we think of with, you know, with Ford motors, you know, could be laying claim to that, that motor. So, so these are, these are generally marks that, that we see a lot with advertising people or marketing people within a company, and they get really excited about potentially using a descriptive mark, because, you know, a potential consumer would know exactly what was being referred to, and that mark is being used just merely by being presented with the mark. But, you know, there is a risk that if you proceed with that mark, the trademark office could find that it is too descriptive, and so you may not get registration for it. And so ultimately, you don't have protection to keep others from using that similar mark. There are limited options to address over deduction, based on descriptiveness such as having your trademark placed on the supplemental register, but it can also cost you time and money. You know, if if you do that when when you could have just found a slightly better trademark to use in the first place. So usually it's better to proceed with what's referred to on slide a slide four as either a suggestive and arbitrary or fanciful more suggestive trans trademarks can be made up or real words or even images, but you know, saying something about the company's products. So you know, so Microsoft, you know, produces software and so the inclusion of soft in in their name

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may provide

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some connection. Greyhound bus company took the name of a vast dog breed to suggest speed. And Timex watches have the word time in their name. So, so they're they're generally weaker, then an arbitrary trademark, but there can still be considered a strong mark that the trademark office might protect and give registration for arbitrary marks are not really as readily identified as being related to the good or service. It could be a word or image that already exists, but it has nothing to do with the business that uses it. So in case of Apple computers, this is this is a classic example, since you know iPhones and laptops and other tablets and things that that Apple Computer provides has nothing to do with fruit, or with cider. Other examples that might be good or Shell gas stations or camel cigarettes can also be ones and even on this slide, we've said penguin whenever refers to publishing of books. Finally, the strongest trademarks are considered to be fanciful trademarks. They're sometimes called coin trademarks. And these are just

completely made up words. And a couple of examples are Exxon, Kodak, Pepsi, Clorox Xerox. And so, you know, so there's, you know, they don't have a clear association with any particular vendor service, and haven't really necessarily been associated with a good or service prior to their use. So, um, so these are, these are ones that are desirable, but sometimes, you know, take a little bit more more work in the, in the marketing and advertising department to come up with in the first place. And you have to make sure that it's going to be a map be something that actually, you know, hopefully can build up some name or notoriety over time. You know, and in the case of Kodak, for example, when George Eastman founded that company, he was founding it for camera and film. And, you know, and, and the story is that he selected that name, ultimately, because he just liked, he liked the way the hard K and Kodak sounded, and so on. So that, you know, there doesn't have to be a specific, specific reason why, why you why you pick a certain trademark, especially in a fanciful or coined trademark sense, but you know, but those those, as shown on the sliding scale are, are typically the best ones and are the ones most likely to be registered

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by the trademark office.

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So going back to slide three, another pitfall in the failure to adequately select and enforceable trademark comes comes in the in the examination process or in the search process at the trademark office. So when the trademark office gets a trademark application, they're going to do a search. And they have to see if there are any existing marks that could present a potential bar to registration because of what's referred to as likelihood of confusion. And in these scenarios, the mark may not be protectable. And in in the most serious situations that could be infringing on another mark, especially if if if the applicant seeking protection on that, on that Mark has already using the mark out in commerce related to similar goods or services. And so in those cases, if it is infringing, then it may cause the applicant to withdraw its application and then ultimately after rebrand the goods or the services, in view of the marks that are found. So the best way to address this is to try to carry out a good search prior to ever filing a trademark application. This will help you to to best estimate what what the trademark office is likely to do. In considering use and registration of the mark. There's a couple of different types of searches that can be done. Probably the simplest search is what we sometimes refer to as a knockout search. And it can be done through the through the Trademark Office website, which is uspto.gov. And they have a system on there. If you look for it, it's called test t s s, which is the trademark electronic search system. And this allows you to do simple searches for marks that are registered with the USPTO can also help you to focus your search on different classes of goods and services. You can search for different owners of marks to see what registrations they have as well. And that contain contains a database of marks that are still active as well as marks that have been applied for in

the past may have been registered but are no longer active. And we'll we'll talk about those a little bit more later on in this presentation. There also are some search engines that are often free services that are outside of the trademark office such as trademarkia or trademark engine.com. And those can give you resources to be able to search for for different trademarks. If you do need a more extensive search in such as if you were going to build an entire business around a certain mark, you may want to have more of a stronger search done, which usually involves engaging a third party search service such as core search or Thomson coffee mark. And then sometimes, although not required, you may want to get an attorney opinion you know as to the likelihood of confusion based on the search results that are identified through those search services. If the if the mark that that is being proposed is identical or sufficiently similar to an existing mark, and the goods or services that it seized

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with

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are the same or similar Then there could be a risk of likelihood of confusion. This could cause the denial of a registration. But it also could expose, expose the applicant to liability for a trademark infringement if it's using that mark. So there's there's really, unfortunately, there's not a bright line rule as to what constitutes likelihood of confusion. It is a question of fact that depends on the assessment of each mark, and the degree of similarity of the relevant goods or services. So doing a search, particularly with a unexperienced trademark attorney at the outset, can really be a good financial investment, it can help to avoid major legal and other business costs down the road, particularly, particularly avoiding a rebranding campaign, that would be probably the worst case scenario for most, most businesses. So turning to the the second point under trademarks, looking at slide five is failure to meet trademark office requirements. This is another pitfall that can occur when, when you don't really fully appreciate what the requirements are. And some of the most common mistakes that we see are related to identifying the proper owner of a trademark, knowing when to file an intent to use, as opposed to a use based application and accurately describing the goods and services associated with the mark. So first, the trademark application has to correctly state who owns the trademark rights. If a company's identified as the owner of the trademark, the company needs to be legally formed and registered. Otherwise, there could be an argument that the trademark registration was made to a non existent party. And this can make the trademark unenforceable. Second, if you're not yet using your client is not yet using the trademark in connection with the goods and services in the marketplace, which is sometimes referred to as the use in commerce, or interstate commerce. But they still want to proceed with with filing a trademark, they can file an intent to use application which is sometimes referred to as an IT EU application. And this may allow for protection to be evaluated. So a search can go

ahead and be conducted and the the applicant gets its place in line at the trademark office. But it still gives that applicant time to get the mark actually out in commerce and the marketplace. So, um, we see this happen a lot with, you know, with people who don't necessarily appreciate that there are two different types of applications that can be filed. And in some cases, you know, you may file a use based application, when you don't actually have used that would qualify, you know, for for registration. And then you have to switch to an attempt to use filing, which sometimes can be done during the examination process, but then in a worst case scenario, may require an A new new filing, when when you could have filed that intent to use application at the outset. There's also risks that what you think is is actually used may not qualify as us. And, and and that that can lead to some issues with the trademark office requirements and ultimately can lead to higher costs in the in the trademark application process, including sometimes additional filing fees or fees that have to be paid that wouldn't have otherwise been paid if, if, if the requirements have been met. There's also a risk of intervening rights. And so if, if you've messed up your application or you need to refile, then you may not have rights, you know, continuing on from that initial application. And, and so somebody could get in front of you in line at the trademark office and maybe reduce or even eliminate the protection that you're seeking to obtain. Third, third point under this, this heading is that you need to have an accurate identification of the goods or services that are associated with the trademark. The trademark office is really helpful in this in this respect, and they do provide a list of pre approved descriptions for goods and services in there what's referred to as the ID manual, and you can find that on the Trademark Office website. Trademark attorneys are trained to consult this list as as assistants to help identify proper goods and services that could be associated with a trademark. And then even if they can't find a pre approved description that that aligns with the with the trademark issue then usually, trademark attorneys have sufficient experience to suggest descriptions that are most likely to be approved because not every description has to come from the pre approved list but

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that you need to know what the parameters are for for things that would be improved, be approved and With Do It Yourself trademark applications most most often, we see that there is an improper description of the goods and services. And this can lead to rejections of trademark applications during the examination process and can increase the cost to obtain registration. Another another thing that does come up under this description of goods and services is that there's there's this tendency sometimes in Do It Yourself applications to exaggerate the goods and services beyond what the mark is actually going to be used. used on. And so, we generally say that the goods and services section of a trademark application has to describe how the mark is or will be used in commerce. And some applicants think this is an invitation to list every potential product, good service that they can think of ever being associated with the mark. But if the mark is registered for goods and services that are not actually associated with the mark, then in the worst case scenario, you could be viewed as

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having committed

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fraud on the trademark office. And it could lead to notification of the trademark registration, its entirety. And so as trademark attorneys were generally trained to scrub the description of the goods and services. And before the registration happens, we'll drop any goods and services that are not actually being used, or not actually being connected with the mark. And this can minimize the likelihood of there being any question as to whether there's fraud on the trademark office or enforceability. So, you know, for, for example, if you were, you were filing your trademark application related to, you know, clothing and things, and you listed, you know, hats, hats, shirts, and jackets, but you know, your time of registration, you're only using the mark on hats and jackets, then you may consider dropping shirts prior to registration, because you're not using it on shirts. That doesn't mean that you can't file an additional obligation at a later time if you start selling shirts. But you just don't want that to be included as part of your description of goods and services at the registration

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for the reasons that I've mentioned before.

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On the other hand, there there is an issue where some goods and services may actually be used in commerce, and,

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and they get omitted from

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the goods and services description. And, and this can be problematic because

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generally speaking, with limited exceptions, the trademark office does not allow a description of goods and services to be expanded after an application as filed. So you can file as additional

applications, as I mentioned, needed to cover additional goods and services. But you know, but if you know that it's going to be used with certain goods and services, it's better cost the in a more cost effective and efficient to try to go ahead and include

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those goods

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or services in your initial application. And don't expect that you're going to be able to add them at a later time without filing another application. So the bottom line is, is that time should be taken to confirm the use or potential use of each item identified in the description of goods and services. And this may ensure the survival of the trademark registration for for as long as you want, as long as you're using the mark. So turning to slide six, another another point under trademarks is, is that I think a lot of people fail to when they're doing Do It Yourself IP, they fail to adhere to this less is more principle. And, and what I mean by that is when it comes to trademarks is that there's many applicants that make the mistake of filing for protection on the most detailed version of their trademark. So, you know, they may have a full color logo, it's got the business name, it's got the slogan, maybe it's got the address, it's got other information around it, and they think, well, the most detailed version is what's most likely to be approved for registration. Or they say, Well, I want to get as many things into my registration as possible. So they're maximizing that initial filing fee. However, the most detailed version of the trademark without separately protecting some of these other aspects could dramatically limit the breadth of the registration.

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So

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it could affect your ability to enforce the trademark later. For example, if you got a registration and you were trying to prove

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infringement

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of that, that full color logo

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with the business name and slogan, then the the owner of that trademark would have to show that the competitor used a confusingly similar name and logo and slogan all together. While this might be possible to prove in some cases It's less likely that a competitive is all three components together. On the other hand, if the applicant or the editor is able to protect the business name alone, without a particular claim to a font or color, or claiming this logo or slogan or claiming the logo separately, then they could show possibly that a competitor is using a confusingly similar name in the case of the business name, even if a dramatically different logo is being used. So definitely want to consider filing separate applications for name, logo and slogan. But a trademark attorney can

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can advise

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as to the likelihood of getting getting protection on one or more of those things, and whether they whether there are times when it's appropriate to

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combine them together

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to maximize protection. It's also important on note on this is this this can also be helpful especially when you're thinking about colors, and and with logos is that while your company name may or may not change over time, it's possible that your logo may change or you may utilize different colors in connection with your your name or your logo or your slogan. And so by by taking some care to try to protect the broadest version

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of those

things, then then you may have protection that can last you a lot longer and withstand those those changes that often occur in businesses. Moving on to slide seven, this is related to the the registration process itself. And I think in many cases do it yourself. Trademark applicants are not often aware what has to be done to take your application from the application process to registration. And some of the online services that are often utilized for these types of filings don't always give applicants enough information to ensure compliance. For example, in the past, seen one online service that would send trademark applicants a letter telling them it's time to file a trademark a Statement of Use in connection with an intent to use application. And it said, the letter stated because you filed your trademark on an intent to use basis, you now need to file a Statement of Use to complete the registration process. This must be done within six months of your original filing date. However, in actuality, there's no time limitation for submission of Statement of Use following the filing of an intent to use application. Rather, that Statement of Use or request for Extension has to be filed within six months after the application has been allowed. So it's not after the the initial filing. So while that online services letter confirmed that extensions of time are available to file the Statement of Use unwary applicants might be led to believe that use may be something that has to be more eminent than the trademark office requires and mistakes can be made. There's other instances where do it yourself trademark applicants may believe that they have a registered trademark just by filing a trademark application. So if you have this belief, then if the trademark office issues or rejection of the application, you know, such an applicant might not choose to respond to the reduction within the time limit. And this could result in abandonment of the application such that they have to refile the application, pay another filing fee in order to hopefully get the registration. But even once the registration has been given out, awarded, then do it yourself trademark owners still have to appreciate that there are requirements that have to be met to continue and maintain your trademark registration. So a trademark registration in you know, in the most basic sense never expires. But but it only expires if you cannot show continuous use in commerce or you fail to renew the trademark. So trademarks in the US generally have to be renewed every 10 years and other countries have other other requirements for renewals. But if the application, the right the registration is not ready, then it's going to be canceled. And then there's there's a an affidavit that has to be filed. It's sometimes referred to as a section eight affidavit that's filed between the fifth and sixth year of the first registration term. And then and then after that you file it every 10th year to maintain the registration. So this is a very common pitfall with with trademark owners. But if they work with a an attorney to obtain or or maintain their trademark registrations, these deadlines would be docketed. And then the trademark owner would likely receive reminders from the attorney when deadlines are coming up so that they can know when to take out And what actions are needed. There are some online services that provide trademark owners with unsolicited reminders of renewal deadlines, but these are new reminders are not always accurate, and sometimes can look like advertisements, causing some trademark owners to disregard them, which I will say on those, you know, sometimes there are, they are advertisements and, and you

do want to be careful about that, because they will sometimes offer offer their services at a fee that is much higher than what you would even have to pay if you did engage a trademark attorney to help you with the renewal requirements. So, so you need to read those things carefully, and maybe consult with an attorney if you're not already before, you know, before taking these actions, but ultimately failing to renew a trademark registration when you actually have had the continued use in commerce. You

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know, it's not always a fatal

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thing. But it can be costly to have to revive your application and you know, possibly have to pay new filing fees and go through the application process, when you didn't have to do that you do if you just needed to do a renewal. So as you can see, there's there's many perils and pitfalls that can happen and do it yourself trademark

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filings, but

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there are a lot of other things that that could be discussed here, including opposition's following trademark publication, changes in ownership following registration, and submission of proper specimens with the trademark application. Say the cost of consulting a trademark attorney to file or maintain a trademark can be minimal in comparison to the cost that can arise in attempting to salvage an application containing serious errors, reviving a trademark registration that's lapse or fighting an infringement lawsuit. So now we're going to move on to patents. And on slide a, I've listed a lot of a lot of different services that are that are out there that services are references that are available that you some people will utilize to kind of learn more about patents and sometimes try to engage in the patent process. Probably unless you've had no access to media, including television, print radio, your internet, you've probably seen at least one advertisement about these types of services, such as invent help or losing that purport to enable an average person to generate their own legal documents and their cost. And then sometimes they in the patent context, they do promote their services to assist inventors to obtain patent protection. But this can be can be a potential pitfall for the unwary. So, at this point, I will, I'm just going to identify a couple of the

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pitfalls

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that we see in in do it yourself, patent protection. And those include misconceptions about provisional patent applications. How having an improperly written patent application can be worse than no patent application

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at all,

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and mixing marketing, commercialization and patent protection. So looking at slide nine, talk first about misconceptions about provisional patent applications. Some inventors, you know do attempt to use online services or go out at themselves in the patent office, particularly when they file a provisional patent applications, which a provisional patent application is considered a placeholder or less formal application to by the inventor time, up to one year after their filing date, to work on the invention and file a non provisional or formal application that can be considered by the patent office. So the low cost of filing without engaging an attorney can be enticing. You know, the filing fee is only, you know, like $140 at this point. And some online solutions, like LegalZoom might only charge you know, couple of $100 in preparation fees, which may be much less than the average patent attorney but there can be pitfalls that result in engaging in this this type of application process. Some applicants are led to believe either through the things that they read or things that are told them that filing a provisional patent application equals having patent protection. For example, at one time, at least one of these online services promoted that an inventor could obtain a provisional patent. But there's no such thing as a provisional patent, only a provisional patent application. The applicant must file a non provisional application within one year of filing that provisional application, or else the provisional application will expire and no patent will ever issue based on that provisional Unfortunately, unwary applicants may file a provisional application on their own or use a service and think that they have a patent to enforce, or that it protects them just merely by filing. But all they have is an application that has not been examined for whether it's patentable, and it's only good for a limited time again up to one year. This leads to another pitfall, their failure to appreciate the need to convert the provisional application to a non provisional application within one year after filing. So again, if it's not converted to a non provisional application, then the provisional application will expire, they mentioned will no longer be able to refer be referred to as

patent pending, and the inventor will have little recourse to revive that application and attempt to gain protection. The patent office does not send any reminders about this conversion deadline. And even if an applicant does know of the deadline, he or she may not always appreciate what needs to be done in order to properly convert the provisional application. In contrast, if the inventor engages a patent attorney or an agent to file the provisional obligation, or at least assist in the conversion process, that attorney or agent will typically docket and record the appropriate deadlines associated with that application and provide at least one reminder in advance at the deadline. And so the patent attorney and agent also will provide advice if needed as to what should be done to properly convert the provisional obligation, more specifically how to draft the claims, which are an important part of a non provisional application, how to meet formal drawing requirements and the effects of adding significant amounts of description or figures that were not previously contained in the provisional application. So using the services of a patent attorney or agent will advise the inventor as to what needs to be done and the deadline for doing so. If an attorney is approached by a person wishing to convert a do it yourself provisional application, it's really important always to ask questions about when was the application filed, and the level of detail or lack thereof that may be contained in the application. This may help the patent attorney or the agent or someone referring, you know, an attorney referring an inventor to a patent attorney or agent to ensure that any non provisional application is filed on time, and hopefully can still benefit from the priority filing date associated with the provisional application filing. This ties in with another pitfall that can arise with respect to both provisional and non provisional patent applications. And I refer to that as the danger of having an improperly written patent description. And this is covered some on slide 10. of presentation. So another pitfall of using online services or trying to do it yourself Is that an improperly written patent application can be almost as bad as never having fallen application in the first place. Well, there are many factors that contribute to a patent application being considered improperly written. As that might be referred to the failure to describe the invention in sufficient detail. The failure to claim the invention properly and over describing the prior art are just a few. If a provisional application does not describe the invention, and how to make the invention in sufficient detail, and then more details are added to the non provisional application that more fully describe the invention. It is possible that the non provisional application may not get the benefit or the full benefit of the provisional application filing date. This can be a significant pitfall because the main benefit of filing a provisional application is getting an early filing date to be able to claim priority to later when you file your non provisional obligation. If the inventor loses the benefit of that early filing date, then the inventor may not you know may have wasted his or her time and filing a provisional application at all. And this can be a problem with a do it yourself non provisional patent application. If the invention is only described at a very high level in the parent and the patent application, then the full scope of the invention may not be contained there. So when the patent office later examines the application, the details that might otherwise help to distinguish the invention from the prior art may not be contained in the application, and new matter cannot be added without filing an entirely new application. If you need to add something even sometimes

they figure to the application once

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it's been

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filed as a non provisional application. So the lack of sufficient detail can often Doom the success of a patent application even if it's not a fatal flaw in the application. You may have to file an additional application to include the details that are relevant to patentability. And that could cause you to lose the benefit of the either the filing date of the non provisional application and or the priority filing date of any provisional

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application at one spot.

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Another area where pitfalls arise concerning the claims that are contained in non provisional application. The patent claims are essentially the property boundaries for the for the patent, they legally define what is and what is not the invention. So sometimes referred to as the metes and bounds of an invention like, like the property lines, that might be defined in a in a deed, the patent office examines the claims of the patent application to find the scope of protection for an invention can be unwise for an applicant to try to draft his or her own claims, when they're not trained to do so, as they may not always draft claims that result in a valid patent with a worthwhile scope of protection. So So this, this could mean that they've they've drafted a claim so narrowly, that maybe it only covers their their specific invention, and allow someone to easily design around the invention, or is it such a broad scope of protection potentially, that they receive rejections that they may not have otherwise intended

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to

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entertain when when filing the application. So it's broader scope than than even what they were necessarily intending to claim. So applicants are generally encouraged to engage a patent

attorney or an agent, if only just to prepare the claims that are associated with a non provisional application, and then help to negotiate the claim scope during the examination process. patent attorneys and agents are registered to practice at the patent office, they've been trained and approved to draft claims, and they understand the practices and procedures of the patent office and ultimately having a good set of claims in a patent application. And ultimately, the issue patent is what makes the issue patent valuable, as there's only infringement when all of the limitations of a patent claim are met. So it's not just based on what's described in your application or in your issued patent. So the claims are too narrow than the claims could be easy for a potential infringer to design around. But if the claims are too broad, then then they might be susceptible to invalidation later through the courts, or through processes available in the patent office, such as re examination, post grant review and recordings review. And there's information about that on on the Patent Office website, regardless whether you're filing a provisional or nonprovisional patent application. The final point on on slide 10, is that there's this common tendency to describe the prior art, which is a term that we use to refer to references that describe what has been done in the past. And applicants will often try to describe the prior art in a lot of detail in their applications, particularly including what I would refer to as positive descriptive comments about the prior art. But these comments can often backfire when when they're in front of the patent office, because the patent office is going to look at the application as a whole. And and if you've put your views and or admissions about the prior art in your application, then you may have provided the patent examiner with the support that he or she needs to reject the claims even without having to perform any sort of search. So better preventive approach is to keep the priority or background section which is typically what we refer to it as in a patent application. to a minimum, you can always disclose those references and in fact you are under an obligation to disclose those references to the trademark examiner but you can use what's referred to as an information disclosure statement to do so. And this puts the references in front of the examiner without without you having to characterize as reference references and creating comments that the examiner can can specifically use in the examination process. Essentially, the patent application should merely describe what is lacking in the prior art and frame the discussion in the context of what the invention describe their adds or improves upon when compared to the prior. This may make it less likely that the examiner rejects the claims using statements from the inventors and patent application.

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So my final final point

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when it comes to to patents is is just a general reference on slide 11 and this is related to mark commercializing inventions, often clients do not look to their patent attorneys or agents for

assistance in marketing or commercializing an invention. Because, you know, typically those are conversations that are best on have with marketing or business professionals. But the danger is when clients, individuals or companies try to approach an online service for assistance on these topics, while also possibly utilizing the online service to evaluate their potential for patent protection. Both areas can be fraught with problems, both in terms of the effectiveness of the protection, if any that could come along, as well as the cost inventhelp is probably the most common online service purporting to offer services to assist inventors to market and commercialize their inventions. Service also provides means for inventors to have their inventions evaluated, and possibly file for patent protection. However, companies and inventor individuals looking at these services should be aware that the costs associated with them, often upwards of $10,000 for their minimum package, and sometimes the lack of meaningful results, which may be no patent protection,

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or even no one interested in the invention, despite their investment, the investment in it may counsel against use of such services when there are other people out there that may or may be more familiar with the technology area of the invention or may have specific contacts within within an industry. There have been countless complaints about inventhelp through the Better Business Bureau over the years, and many of these complaints, if you if you're interested are and the attempts to resolve the complaints are available online. But if you look at those complaints, then then I think you you'll see many of the perils and pitfalls of utilizing these services or trying to do it yourself. That can be apparent in in those those complaints. So if if an individual or company is considering whether to engage in a do it yourself patent protection, I think of the analogy, there was a commercial from a long time ago where there's a man sitting at a table with a butter knife, and he has a surgeon on the phone, and his surgeon is telling him how to perform the surgery. And the man is sitting there with his butter knife and he says to the surgeon, shouldn't you be doing this? I think that's a wise question for sure. preparing an application for a patent on your end is a lot like trying to do surgery on yourself, you're going to make mistakes, it's not a good idea, and normally the most extreme of circumstances should it be attempted.

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Further, while services such as Legal Zoom, or infinite help, may have been created with noble intentions to allow the public essential documents without substantial inconvenience or high fees. Using those services to pursue patent protection can be risky. But the largest pitfall is that an inventor loses his or her patent protection, or the potential for patent protection by using these services or going into going at it on their own. And this could be a loss of money far greater than the cost of engaging a patent attorney or an assistant of Patent Agent to assist in the process. So in conclusion, it can be risky to bet the fortune or the future of what can be a business's vital

assets, its patents and trademarks. By using you do it yourself IP and intent to save money in the short run. And hopefully with this information, even if you do not practice in the area of intellectual property, you can steer people in the right direction to consult an IP attorney before putting these valuable assets at risk. And with that, I thank you for your time and my if you have any questions or need more information, my contact information is found on slide 12

49:01

this presentation Thank you