

Inventors' Network

Volume 7

of the Capital Area [INCA]

Issue 8

Our meeting (on the 3rd Monday) is 16 Aug 99: 5:30 Networking, 6:30 Presentation 7:15 Bsns

AUGUST PROGRAM:

On August 16 we will hear International Lecturer and Professional Coach, **Fontelle Gilbert**, who happens also to be Ray's wife. While on staff at Prince George's Community college, Fontelle developed a faculty and course-content for Career planning courses for college students and adults. She currently lectures government and professional organizations on "Planning the rest of your life" -- to prepare a life style and habit-of-thought that offers a rewarding retirement.

Fontelle's 40-minute program for inventors (and their "significant others") will assist in self-recognition of personal strengths that characterize successful inventors and innovators. Her stories feature "how to enjoy and use these inherent, built-in, personal traits. Members and their friends will probably want to know about what great persons inventors tend to be. --- *when we know how to understand them.*

IMPORTANT NOTES FROM JUNE:

At the conclusion of our joint USPTO - INCA Saturday Seminar, Mr Todd Dickinson stopped in to talk with us. He established a first-name comfort.

One special merit for this comfort was that he was then the "**acting**" Assistant Secretary of Commerce and Commissioner of Patents and Trademarks. Now Congress has officially declared him to have that title.

He seemed comfortable with the independent inventors (who represent 24% of PTO business with American inventors.) I sensed that many in the Saturday Seminar became comfortable with him.

Mr Dickinson had some very good news to share:

(1) Two million patents issued since 1976 are on the internet with text and images for anyone to examine or download.

(2) All trademarks, approximately 1 million, including registered and pending are on the internet.

(3) "Patent Pending" time is being shortened. Three portions of pending time are in focus:

(A) The time between allowance and issue has been reduced significantly when the USPTO took a risk that inventors would offer issue-fee for allowed patents. [Mr Nick Godici justified the streamlining by showing how extremely few inventors abandon their patents after allowance.]

(B) The time for actual USPTO examination has been separated between "cycle time" as driven by PTO actions and others, such as the applicant's prosecution time usage. "Cycle time" means the elapsed time an application has been underway within time control of the USPTO.

(C) Movement is underway to let patent applications be applied-for electronically. This modernization is expected to overcome some of the PTO's immense paper-handling problems.

Commissioner Dickinson anticipates that the PTO will contribute no greater than 12 months in the process of getting a US patent. G R E A T G O A L

ECONOMIC CHALLENGE:

Our Mr. Allen Wood, one of the volunteer INCA Saturday Seminar committee, stood up to speak of an apparent inequity of fees within the “small entity” category. He noted that entities of 1-15 persons pay the same “small entity” fee schedule as firms of up to 499 persons. [Fees for small entities are ½ those of large entities (having 500 or more people)].

Mr Dickinson spoke to this issue in a business man’s framework. Since the USPTO pays all its expenses from user fees, any change in fee structure must be enough to pay for the total USPTO services. Within this caveat, he suggested that individuals or groups who wished to propose a change in fee structure might perform the appropriate economic studies toward enhancing equity. He offered open availability of all internal data except “the secretly-held applications”.

Allen might have started a cycle wherein a small group of economic-oriented inventor-managers can initiate a pro-active role by independent inventors toward enhancing affordability of patent property for firms having no more than 15 persons.

INCA ACTION:

A small block of time in our August meeting will be made open for patent fee strategies. INCA members are invited to volunteer for design, execution and presentation of such an economic study. A chairman will be appointed as an At-Large Director to the INCA board.

NEW PRODUCTS WANTED:

Custom Coils of St Kitts makes miniature magnetics. They want to expand their product line to do custom manufacturing that is related to coils, toroids, transformers and related products. They are open to licensing arrangements, partnerships and joint ventures. Call Roy Littlejohn at 202 966 2987.

July PROGRAM Highlights:

Jerry Porter showed a video of how his market partner, Pat Coffee presented a kitchen-safety “Turkey Baster” to approximately 100 potential producers. Pat’s presentation revealed the benefits and good features of the unique and patented baster. Pat’s manner made the use of this baster seem most logical and beneficial to good cooking practices.

However, Jerry’s July marketing story was a lot like Frampton’s June marketing story. In both cases it was necessary to establish a viable person-to-person contact with an inside decision maker. One of Jerry’s other business associates came to learn through a Wall Street Journal article that he was acquainted with a decision-maker inside the Tupperware organization.

Prior to discovering the inside friend, Jerry was getting some calls from one holder of a video tape. This firm

wanted to talk with the inventor about the prototype, but offered no indication of a corporate willingness to take a license. Shortly thereafter, a near-similar baster came on the market from that firm. When invited to take a license, they invited Jerry to sue if he wanted to.

Jerry and his team-partners recognized that patent suits were very expensive to all parties, so they accepted the relative success of being copied, and pursued the business of obtaining an honest licensee. Then, a Tupperware person called to invite the inventor, Jerry, to visit corporate headquarters and answer questions from their staff. He describes the day as harrowing, because there seemed to be a wide range of response about the device and about its salient features.

Rewardingly, a license document was offered. His business team analyzed it, revised it, and ended with almost \$10,000 invested in professional fees for working out a license that was equitable to both sides, and with clearly expressed conditions for long-term execution of the license. When the infringing firm called upon Tupperware for sublicensing, they were refused. The infringing product is now very difficult to find in retail channels.

STATUS Roundup

Ephraim Lior volunteered for a planned 5-minute slot to summarize the status of his “Desk Free” computer location arrangement. He had an effective prototype, with which he demonstrated “space utility” for full size computer components that did not clutter desk or floor surfaces of an office. Ephraim (lior@erols) holds more than 200 patents, and is likely to appreciate your feedback about marketing and possible contacts.

Chuck Popenoe announced a significant inquiry about an additional sales market for his indicator bolt. We hope Chuck’s new challenges will be only “higher production quantities”.

Guests, **John Merrill** and his wife had called from Cross Junction Va after finding Raoul’s INCA website. John called, wrote your editor a letter and visited to “get acquainted” with how an inventor’s organization works. He told of his efforts to make an intellectual property from a full-size child-and-adult toy that he has fabricated on his campground. He expressed a need for INCA-like groups closer to widely-distributed inventors like him.

Frampton Ellis spoke of the need for individual and other small entity inventors to pay attention to anticipated legislative actions, particularly draft H.R. 1907. He spoke of the priority that is appropriate when national patent law is regularly up for change. He encouraged each individual to be knowledgeable and to use his personal power with volunteer actions and calls to their senators and congresspersons.

Then on July 30, Joanne Hayes-Rines of Boston reported to her e-mail contacts that House actions were being set up to push through the H.R. 1907 content under “suspension of rules” with another number, (H.R. 2654). Rep Don Manzullo (R-IL) and Bob Rines, with others, blocked that action.

Independent inventors need to be especially grateful to Bob Rines, who is sufficiently knowledgeable and respected to have been a 1993 candidate for USPTO commissioner.

Rines and Manzulla prevailed on chairman Henry Hyde to charter them, in cooperation with others, to a last

minute rewrite that would have a less severe impact on independent inventors.
The bill was rewritten and, on Wednesday was passed, including these very positive parts:

- 1) The PTO can keep all its funds.
- 2) You are guaranteed at least a 17 year patent term if you abide by the time limits set for responses. If the PTO delays, you get time back.
- 3) The title, “Dealing with the fraudulent invention marketing companies” recognizes a problem and specifically addresses it, adding teeth to consumer protection laws already on the books.
- 4) The 18 month publishing of patent applications applies ONLY to those who file abroad and the costs of publication will be paid for by those whose applications are published.

Rep. Dana Rohrabacher is encouraging the Senate to adopt the same bill that the House adopted.
“I want to make sure that we will firmly stand behind the text of this bill in the event of contrary action by the Senate. --- ,
But I am confident that the other noble body of this Congress will accept the House efforts in patent reform and will move our version of the bill forward without delay”.

If the Senate adopts the exact language of H.R. 1907, then that is the bill that the President will sign.

STILL THERE IS DANGER: If the Senate adopts a different bill, then the two bills will go to Conference Committee and **what comes out of that Committee could be “everything we don’t want”.**

PROGRAM FOR Sept 20 has Dr Arthur Molella of the Smithsonian’s Lemelson center. His comments will include how his center came to be included within the Smithsonian institution and how it is bringing the idea of invention to school children. As many inventors know, Mr Lemelson acquired a noticeable fortune from licensing to National and International industries.
Dr. Molella is the senior person within the Lemelson center and is ready to discuss inventor issues.

PROGRAM FOR Oct 18 has Dr. Richard Rozek, Vice President of National Economic Research Associates (NERA). His professional background includes teaching both macro economics and micro economics. He recently visited Argentina to discuss macro-economics of a new patent system for them. Dr Rozek’s firm, NERA, specializes in helping courts determine the value of a patent. His stories about valuation of intellectual property is expected to be responsive to inventor’s on-going need to know what their properties should be worth in the micro-economics of business.

COMING EVENTS: Sept 22-23 SMALL BUSINESS INNOVATION RESEARCH & DEVELOPMENT WORKSHOP [HTTP://www..SOTECH.STATE.VA.US/OIT](http://www..SOTECH.STATE.VA.US/OIT) at George Mason University, Patriot Center, Fairfax Va. Fee \$70
Banquet \$40
Phone Dr. K.C.Das (804) 371 2795 kcdas.dit@state.va.us Lunches 2 @ \$30 ea

These two-day events introduce inventors and small businesses to the Federal “Small Business Innovation Research” SBIR and the Federal “Small Business Technology Transfer (STTR) programs. Their combined

budget for this year is \$1.2B.

These programs offer an environment toward commercialization of a small business' inventive "high tech" products. They introduce the small business person to a structure wherein funding of up to \$100,000 may be awarded for feasibility research of 6-months for SBIR and 12 months for STTR. The feasibility work includes more detail planning for a phase II 2-year investment of up to \$750,000 for SBIR and \$500,000 for STTR..

These programs are a result of Congressional attention to expanding the invention base on which Federal R&D resources are committed. They are structured to meet federal requirements for research grants. Full instruction is available for each agency's offerings and is becoming available earlier than usual through internet service. Direct contact with an internal sponsor is possible. One-on-one interviews are available during this workshop.

Project topics are offered from most major Federal agencies. Proposals can maintain a proprietary status. When an agency accepts a proposal, their administrative staff oversees the processes for research that have been proposed.

A successful proposal generating firm has an advantage of using funds for their program's research purposes, yet not being required to pay back those funds.

INVENTOR'S SEMINAR on Morning of 18 August: : Some of our most-serious inventors might like to be part of a small INCA party to a feedback program for PTO examiners. The two-hour program will feature three famous inventors. Call Ray to reserve one of the invitational INCA seats. (703) 971 9216

NATIONAL NEW PRODUCTS SEARCH, sponsored by United Inventors Association of USA [Joanne Hayes-Rines Editor] starts in August 1999 [NOW]. Corporate sponsors include Wall Street Financial Group, Tri-Star Products, Haystack Toys, AZ Tech, Inc Household Products (of Black & Decker)]. Products sought include medical and computer-related technologies, toys, household products, outdoor sports, personal fitness, assistive devices etc. Full particulars on <http://www.inventorsdigest.com> click on 1999 NEW PRODUCT SEARCH.

Joanne's advice includes:

Make a professional-quality presentation:

Complete the Submission Form and type a cover letter with:

Name of your invention and its patent status: Issued or Pending.

Description of the invention, the problem it solves, and how it is better than existing products on the market.

Your name, address & phone number. Include fax number and e-mail if you have them.

Complete materials for a presentation packet. Attach your name on each.

Your printer service may be very helpful in designing the package, including photographs.

For contact with Household Products (203 926 3015) talk to Craig DuBois for their non-disclosure form.

For contact with Haystack Toys (314 983 9219) or e-mail toyhunt@haystacktoys.com for their special application forms.

**Send letter and submission form only to the companies whose business matches your invention.
[Hold total cover letter content to one page.]**

Joanne reminds us that we only have one chance to make a FIRST impression. Make it good!

Worried about fraud? Michael Neustel, a registered patent attorney has founded the National Inventor Fraud Center Inc (NIFC). His website is www.inventorfraud.com.

Lessons from last Hammacher contest of Inventions:

The \$5,000 and four \$1,000 rewards are for a few winners, but remaining players receive terrific publicity for their product. If you are planning to play this competition in 2000, now is not too soon to structure your presentation and its backup.

Full instructions are available to be downloaded from www.hammacher.com. [11 pages]

They seek products that uniquely solve an existing problem of the general household consumer. A patent must be issued. A prototype must be available. Categories sought are

(1) Recreation, (2) Personal Care, (3) Useful around Home & Garden and (4) Personal Electronics.

Judges will look for (1) Originality of concept, (2) Ingenuity of bringing the concept to design, (3) Benefit to user, (4) Safety and (5) Production feasibility.

Their entry form in 1999 competition was available for on-line entry, or for download and mail-in. It included

- (1) product description (8 lines)
- (2) problem background (that your product solves)
- (3) product benefit (how product solved the problem of (2))
- (4) product innovation (Why is this product unique as compared to others on the market?)
- (5) product function (How does your product operate or how used?)
--Documents, videos and photos enhance the entry--
- (6) product construction (What is your invention to be constructed of?)

Note, a well-written patent will have defined 1 - 5, and a completed prototype and pre-production study will have defined 6.

It continued with "Product Specifications"

- (7) Dimensions - height, width, length, depth, diameter, weight
(This is the language of design application)
- (8) Power Source (watts, recharging time, battery life etc.)
- (9) Installation (Assembly, Demands professionals, Do-it-yourself,
Easy--Moderate--Difficult)
- (10) Maintenance (List special maintenance or care required)

It concludes with inventor's acknowledgment that

- (11) This product will compete with many.
- (12) The product probably will be manufactured by a 3rd party
A 3rd party supplier is fully authorized to offer this product for sale.
- (13) Hammacher is free to continue viewing products which are very similar to this one.
- (14) I am free to enforce my acquired protectible rights against an infringer. [I suspect this may need to work both ways in potential infringement cases, and the merchant does not want to be involved].

(15) Merchant does not promise to offer this for sale.

(16) Product has not yet been sold in the marketplace, or has been available only through cited channels, with cited number of units sold into these channels.

In their 1999 competition, entry forms were accepted between 1 Feb and 17 May. Hi quality preparation takes longer than most new-comers to the field might appreciate. Early next year they may announce again with the following address:

SEARCH for INVENTION
-c/o Hammacher Schlemmer
303 West Erie Street
Chicago Il 60610-3601
www.hammacher.com.

More Educational News: USPTO is partnering with BIO to offer a 2-day program (Aug 24 & 25) for \$70 at Crystal Forum 1999 Jeff Davis hwy.

The program includes biotech policy, appeals & interferences, design issues and tours of the Technology Center. Commissioner Dickinson will present a luncheon speech. Panels of Supervisory Patent Examiners will deal with current topics.

Announcement is more complete on www.uspto.gov To register by phone, call 703 308 1234 R

Keep Watch on <http://www.uspto.gov>: Don Kelley anticipates that the Independent Inventor Resource will be on-line during the next week. This new PTO service is to place patents and trademarks in the context of business. Don says he would like for INCA members to examine the beta test and tell him how well it meets an inventor's business needs.. (703) 308 0975

Mac Woodward (804) 973 3708 reports that the **Independent Inventors Foundation** is getting its corporate State and National charters. The new foundation's sponsors have an incubator desk in the AMVEST building in Charlottesville. Mr Anthony Hamilton Little will be seeking out responsible patrons for first-year "jump-start" operating costs. Mac's vision is to provide a safe, business-ground on which independent inventors can deal responsively to the invention needs of American businesses.

“ **A concept is expressed and refined with concept explanation and value additions.**
Commercialization and directive-focus follow.
Protection strategies for intellectual property considered
Business formation (with a balance of talent) is discussed
Marketing with definition and segmentation outlined
Financing converts aforementioned considerations into economic terms and marshals:
Deal Structure evaluation
Likely Investor demands
Program requirements and recommended posture.

A growing, evolving concept is summarized. Moderator / Mentor(s) suggest direction & offer advice. Audience reaction is noted. "Beta test" records reactions. Division of the audience into groups of fewer than 30 offers a close relationship to presenters, moderators, mentors and recorders.

General Eisenhower set a standard for creative approaches as he demanded that "completed staff work" include multiple options for executive decision, wherein the options were expected to include unconventional and creatively resourceful approaches that would

result in a “win-win” condition for cooperating parties. While he was President, “winning” meant sound economics that were visible and Nationally viable.

INVENTOR TECHNOLOGY:

-about broad, independent claims:

Convention in writing and in examining claims is to expect the first claim to be the most broad.

It will have the fewest number of elements.

It will use the most-broad terms for each element.

It will be considered an independent claim because it does not depend on a prior claim.

Clarity in claim-writing will express a claim title prior to use of the usual word “comprising”.

Then the component major parts or means are listed (and numbered). The claim is made complete with a “wherein” expressions that link each of the listed components to the other components or means with terms such as “connects to” or “communicates with”.

Many writers want to be sure that a reader of their claim will understand “what the aforementioned components and means do” or what functions are to be achieved from the apparatus’ and/or method’s structural description.

A “whereby” expression may be added to the end of a claim. It may include functional language as a means of enhancing communication, but the whereby expression cannot add structural property to a claim. It merely recites an objective.

About more-specific dependent claims:

One claim-writing strategy would write as broad as possible initial, independent claim, and let a series of claims, each dependent on the first one, further define specifics relating to a component or means of the first claim. Examiners may call these specifics a limitation, and explain that the independent claim, when read against an earlier patent (prior art)

A dependent second claim might be:

2. a

described claim’s disclosure. which is the components of a claim immediately after the introduction that concludes cite limiting aspects of each element that further describe the unique character of each element.

[If the examiner finds prior art that seems to anticipate all elements of a most-broad claim, further definition is simple by combining supportive claims into the language of the most-broad one.]

-about narrow, dependent claims:

Supporting broader claims with multiple narrower claims strengthens specificity of the invention.

-about multiple sketches, with defined parts:

-about background

-about best embodiment

Should the examiner cite prior art that seems to covers the most broad claim, a substitute claim (with its own new number) can be expressed from combined elements within the dependent claims or from within drawings, specifications and cited references.

Reality in writing and examining claims is that almost anything can be awarded a patent as its definition is narrowed in depth to include greater and greater depth of unique features--- The importance of this condition is that an extremely narrow patent may offer very little property value. Of course, if that narrow product is an item with a new, broad, “faddish” market appeal, even a narrow patent may limit some threat of competition within a narrow market.

A format for claims will include a name for the claim, a list of elements such as items, methods, or steps, and how these elements

cooperatively interact with one another to provide a working whole.

Conclusion: Claims for a breakthrough technology or a new use for a known product can be very broad, with few dependent claims. Licensees may be the ones who add their proprietary style to their products through multiple dependent claims. Conversely, a claim set for mature technology tends to be narrow, with many dependent claims.

[A viable broad claim is usually much more valuable than a lot of narrow ones.]

Words of Claims: The writer gets to select the words within his claim, but

A same word must mean the same thing where ever it is found in the application or in communication with the examiner.

In a second and subsequent use of a word, it may be described as “the” or “said” word.

There are more examples in Pressman’s “write it yourself”. However, skill comes in the doing. However, an initial set of claims is vital to be assured that drawings and specifications are sufficient for anyone to do a viable set of claims.

INCA ACTIONS: ECONOMIC (supporting Aug Newsletter)

One fundamental is to draw a uniform data base for this kind of study to a manageable size, with criteria for bringing alternatives forward to the PTO in a package from a common basis of information.