

# The Patent Clinic FAQ

Here are some quick answers to Frequently Asked Questions. For more detailed responses, please refer to the Patent Clinic Acknowledgments and Disclaimers.

## **What is the Patent Clinic?**

The Patent Clinic is a joint effort between the Technology Entrepreneur Center (TEC) and the University of Illinois College of Law (COL) in which a number of inventors (including especially participants in the Cozad or Lemelson Competitions) may have a patent application written for them at no cost if their business plan includes a novel and potentially patentable device, system, or method.

The Patent Clinic was jointly developed by the TEC, and Joe Barich, an Adjunct Professor at the COL who teaches Patent Prosecution and who is also a Shareholder in McAndrews, Held & Malloy (MHM), a patent specialty IP firm in Chicago.

## **What is a patent application?**

A patent application is a formal document to be filed with the Patent and Trademark Office (PTO) in an attempt to obtain a patent for an innovation. A typical patent application is about 40 pages long and includes a highly detailed and legal description of the innovation as well as a claim for legal protection. Once the patent application has been filed with the PTO, you are officially “Patent Pending” and can represent yourself as that status to others. Someone who has filed a patent application with the PTO is said to be “prosecuting a patent” and the process is often called “patent prosecution.” Having your patent application drafted typically costs \$8,000.00-\$12,000.00, so you can see that the Patent Clinic is providing you with significant financial benefit.

### **How does the Patent Clinic work?**

Let's say that a participant in Cozad has come up with something that might be a new invention – or maybe they are not sure whether it is new or not. The participant has described their innovation in their business plan and decides that they would like to have their innovation considered by the Patent Clinic to see if it will be one of the innovations selected by the Patent Clinic to be drafted into a patent application.

Consequently, the participant reads and signs the attached forms and provides their business plan to the Patent Clinic.

The Patent Clinic reviews their business plan and contacts the participant if they have any questions. If the innovation seems to constitute patentable subject matter, the Patent Clinic then proceeds to perform a search of the 8+ million issued U.S. patents to attempt to determine whether someone has already patented the idea. Those innovations that are already patented are excluded from participation in the Patent Clinic.

The remaining innovations are then submitted to a conflict check to confirm that neither Professor Barich nor the law students participating in the Patent Clinic are currently already writing similar patent applications for others. Innovations that fail the conflict check are excluded from participation, but no innovations were thus excluded in the previous three years and it is not deemed likely to occur.

The remaining innovations form a pool from which several will be selected to be drafted as patent applications by the law students under the guidance of Professor Barich.

The law student drafting the patent application will be in contact with the inventors to obtain more information and/or drawings and flowcharts if necessary. Rough drafts will also be provided to the inventors for review. The inventors must work with the law student by making themselves available and reviewing drafts promptly.

Once the patent application has been drafted, it will be returned to the participants and the participants will be shown how to file the patent applications with the PTO. Please be aware that the PTO charges a fee for the filing of a patent application. The current basic fee is \$530. The participant, not the Patent Clinic, will perform the actual filing of the patent application and pay the fee.

## **Relationship between the Patent Clinic and the Office of Technology Management (OTM)**

In certain situations, the University of Illinois may be entitled to own your innovation (for example, if you are a grad student and your innovation pertains to work done as part of a research grant.) Further details may be found at <http://uillinois.edu/trustees/rules.cfm#art3>. Consequently, it is the policy of the Patent Clinic and the University that the technology is reviewed by the University's OTM and an ownership decision is made before the technology may be filed as a patent. In the typical situations, the OTM determines that the University has no rights in the innovation and the inventor is free to file their patent application with the PTO. However, **THE INVENTOR MUST RECEIVE CLEARANCE FROM OTM BEFORE FILING THEIR PATENT APPLICATION.** On the other hand, if the OTM determines that the University has rights, then the OTM may proceed to file the patent application themselves, but the OTM's standard terms – including those relating to revenue sharing – would still apply.

Preferably, once the Patent Clinic has indicated that the inventor's idea is selected for participation, the inventor would then proceed to disclose their innovation to the OTM and initiate the clearance process. That is, the OTM's clearance process can proceed in parallel with the drafting of the patent application by the Patent Clinic.

Once the Patent Clinic has completed drafting the patent application, the patent application is provided to both the OTM and the inventor. However, the Patent Clinic providing the patent application to the inventor is not an indication that the inventor has received a clearance or is free to file the application with the PTO. Instead, the Patent Clinic and OTM are distinct organizations and the inventor must receive clearance from the OTM before filing the patent application.

### **What about the law students?**

All law students drafting patent applications for the Patent Clinic are in their third and final year of law school and are scheduled to graduate in May. In addition to the general law school curriculum, all of the law students have previously completed a specialized course in Patent Law and have also completed a specialized course in Patent Prosecution wherein they drafted a complete patent application. Additionally, only students earning a grade of B+ or better in Patent Prosecution are invited to participate in the Patent Clinic.

Most (if not all) of the law students previously worked at a law firm during the summer after their second year in law school and performed patent prosecution work that was paid for by clients. Further, once the law students graduate in a few months, they will typically begin working at a law firm full time and performing patent prosecution work for paying clients without additional formal training.

### **What about this Professor Barich guy?**

Joe Barich has been drafting patent applications for about 14 years and has drafted several hundred in his career. He has also been teaching patent prosecution inside his firm for several years. On the academic side, he has taught Patent Prosecution at the University of Illinois College of Law since the spring of 2005.

He has also named one of the *Illinois Rising Stars* on the *Super Lawyers* list for 2008, 2009, 2010, and 2012 and appears on the *Patent Buddy*® List of Top Patent Prosecutors (representing the top 2% of Patent Prosecutors) in the areas of "Computer, Electrical, Software, and Business Methods". What can I say? He's a heck of a guy! You should probably buy him lunch.

# Patent Clinic

## Acknowledgements And Disclaimers

As a potential participant in the Patent Clinic, you acknowledge and agree to the following:

### **1.0 GENERAL PROVISIONS OF THE PATENT CLINIC**

It is anticipated that not all business plans/invention disclosures submitted to the Patent Clinic will be selected for drafting as a patent application. For example, 1) some invention disclosures may already represent patented subject matter, 2) some invention disclosures may be rejected by a conflict check, and 3) we may not have enough law students to write patent applications for all of the inventions.

If your invention disclosure does not include sufficient information to allow the Patent Clinic staff to make a patentability determination, additional information may be requested from you. However, if you fail to provide the additional information on time, your invention disclosure will be removed from the pool of potential patent applications.

Although the Patent Clinic will perform a search, the Patent Clinic does not guarantee that it will find all references relevant to your innovation, or if a reference is found, the Patent Clinic does not guarantee that it will appreciate its significance.

Further, if the Patent Clinic declines to draft a patent application based on your invention disclosure for any reason, declining to draft the patent application does not constitute an opinion or warranty that your invention is non-patentable. As mentioned above, it is anticipated that there will be more invention disclosures than available staff to write patent applications. If the Patent Clinic declines to draft your patent application, you are invited and encouraged to consult with an independent patent attorney.

Conversely, if the Patent Clinic proceeds to draft your patent application or take any other action, it does not constitute an opinion or warranty that your invention is patentable or that a patent will eventually be obtained from the Patent and Trademark Office (PTO) or that the patent will be valid and enforceable if issued by the PTO. Not all patent applications filed with the PTO issue as patent applications and not all issued patents are valid and enforceable. Further, although the Patent Clinic prepares the patent application, the Patent Clinic does not file or prosecute the patent application with the PTO. Further, participants are advised to consult with their attorneys before filing the patent application with the PTO or even before beginning work with the Patent Clinic.

Additionally, patent applications that set forth inventions in the technological areas in which the Patent Clinic's staff have expertise will be favored. For example, if your invention concerns a pharmaceutical and none of the Patent Clinic's staff have a pharmaceutical background, then the Patent Clinic will not be able to write a patent application for you.

**Further, you must work with the staff of the Patent Clinic. Failure to make yourself available for interviews or failure to provide requested supplemental material may result in the termination of the drafting of your patent application.**

Finally, please be aware that the Patent Clinic will NOT be performing the actual filing of the patent application with the PTO on your behalf. You will receive detailed

instructions on the filing procedure, but the completion of the filing procedure and the payment of any fees due to the PTO are completely your responsibility and not the responsibility of the Patent Clinic.

Below please find a non-limiting list of your responsibilities:

1. Provide a comprehensive invention disclosure
2. Supplement the invention disclosure if requested
3. Be available for inventor interview(s)
4. Review a draft of the patent application
5. (Optional and outside the scope of the Patent Clinic)  
File drafted patent application with the PTO

## **2.0 QUALITY OF THE WORK PERFORMED BY THE PATENT CLINIC**

The patent applications based on your invention disclosures will be drafted by third-year law students that have completed a course in Patent Law and a course in Patent Prosecution. Although the law students have written a complete patent application as part of their Patent Prosecution course and have typically completed additional patent prosecution work in the course of a summer employment with a law firm, the law students do not have enough experience to be considered experienced counsel.

Consequently, if you desire your patent application to be drafted by experienced counsel, do not submit your invention disclosure to the Patent Clinic. (However, if you seek experienced professional counsel, please be advised that an average cost for drafting the patent application would be around \$8,000.00-\$12,000.00.) It is expected that the law students at the Patent Clinic will deliver competent, satisfactory work similar to that delivered by a first-year associate in a law firm. If you require excellent work by an experienced practitioner, then you are not a good match for the Patent Clinic and should seek out a patent attorney on your own.

## **3.0 THE UNIVERSITY IS THE PATENT CLINIC'S CLIENT?**

Simply put, the client is the person or entity who pays the bills. For example, it is common for a patent attorney to work with a company and draft patent applications based on ideas developed by inventors employed by the company. In this situation, although the patent attorney works closely with the inventors, it is the company that pays the patent attorney's bills (and not the inventors themselves) that are the patent attorney's clients.

Similarly, in the case of the Patent Clinic, the client is the University of Illinois College of Law (COL), and not any individual participant in the Patent Clinic or group of participants in the Patent Clinic. If you desire to have individual representation (your own lawyer) then you are advised to seek out and employ an attorney on your own. More specifically, no individual participant or group of participants is the client of the Patent Clinic, the client of the Professor Barich, or the client of any law student or other person performing work for, though, or in conjunction with the Patent Clinic.

Further, please be aware that the only activity that the Patent Clinic will perform for you is preparing the patent application and then only if your business plan is selected at the sole discretion of the Patent Clinic. The Patent Clinic does not have any other responsibility towards you, such as the responsibility of advising you as to dates, PTO

practices, or whether or not to take certain courses of action. None of the Patent Clinic, Professor Barich, or the law students working in the Patent Clinic are providing you with legal advice and no attorney-client relationship is formed. You should obtain legal counsel to provide you with legal advice.

#### **4.0 CONFLICTS OF INTEREST**

Conflict of interest stems from the principle that having a single lawyer representing both sides of a lawsuit is innately unfair. Consequently, the lawyer would be barred from representing one (or possibly both) of the parties.

Additionally, it would also seem unfair if a lawyer initially represents Party A in a lawsuit for several months and then drops Party A and switches to representing Party B in the same lawsuit. In this situation the Courts give Party A the option of barring the lawyer from representing Party B. That is, the lawyer can represent Party B, but only if Party A agrees.

Further, a conflict of interest for one lawyer may sometimes be “imputed” to the other lawyers in the firm. That is, if one lawyer in a firm has a conflict of interest that would bar him from representing a client, then the conflict of interest may sometimes also apply to the other lawyers in the same firm.

The Illinois Rules of Professional Conduct (IRPC) codify the conflict of interest rules for lawyers licensed to practice in Illinois. More specifically, Rule 1.7 reads as follows:

##### **Rule 1.7. Conflict of Interest: General Rule**

**(a)** A lawyer shall not represent a client if the representation of that client will be directly adverse to another client, unless:

(1) the lawyer reasonably believes the representation will not adversely affect the relationship with the other client; and

(2) each client consents after disclosure.

**(b)** A lawyer shall not represent a client if the representation of that client may be materially limited by the lawyer's responsibilities to another client or to a third person, or by the lawyer's own interests, unless:

(1) the lawyer reasonably believes the representation will not be adversely affected; and

(2) the client consents after disclosure.

With regard to section (a), if it is believed that performing work for a potential participant in the Patent Clinic would adversely affect the relationship with another client, then the potential participant would not be eligible to participate in the Patent Clinic. However, this is unlikely.

With regard to section (b), if it is believed that performing work for a potential participant in the Patent Clinic would be materially limited by responsibilities to another client, but it is reasonably believed that the representation of the potential participant would not be adversely affected, then the potential participant can still participate if the potential participant consents to the arrangement after disclosure.

Although you are not a client as outlined above, it is possible that you may be treated as a client in some situations. Consequently, it is possible that the situation

outlined in section (b) may arise. Consequently, you agree and accept the following IRPC 1.7 Consent:

You have been advised of the requirements of IRPC 1.7 preventing a lawyer from representing a client if the representation of that client may be materially limited by the lawyer's responsibilities to another client of a third person, or the lawyer's own interests, unless the client consents after disclosure. Even though you are not a client and the Patent Clinic is not currently aware of any such situation, if such conflict arises, then you shall be informed and you agree to either (1) provide an appropriate consent, or (2) withdraw from the Patent Clinic. Further, you agree to refrain from seeking to disqualify from such representation Professor Barich, the law students working in the Patent Clinic and any law firms with which they are associated.

The IRPC 1.9 further codifies the conflict of interest rules with regard to former clients:

**Rule 1.9. Conflict of Interest: Former Client**

(a) A lawyer who has formerly represented a client in a matter shall not thereafter:

(1) represent another person in the same or a substantially related matter in which that person's interests are materially adverse to the interests of the former client, unless the former client consents after disclosure; or

(2) use information relating to the representation to the disadvantage of the former client, unless:

(A) such use is permitted by Rule 1.6; or

(B) the information has become generally known.

With regard to section (a), consider the following hypothetical scenario. Student A participates in the Patent Clinic and has a patent drafted by Attorney or by Law Student. Student A's innovation is wildly popular and forms the basis of a successful company. However, at some point Student A's company decides to sue a company that is represented by Attorney or Law Student (who has now passed the bar and is a practicing attorney) or by a firm in which Attorney/Law Student practices. Further, Student A's company is asserting that the company represented by Attorney/Law Student is infringing the patent that Attorney/Law Student drafted for Student A. Additionally, Student A's company is attempting to have Attorney/Law Student (and their firm) disqualified so that Attorney/Law Student is not able to represent their client.

Because the practice of patent law is highly specialized, the number of patent law firms is not infinite. A conservative estimate of first-rate patent litigation firms would probably put the number at less than 50 in the country while adding second-rank firms would probably only raise the number to around 100. Additionally, conflicts of interest are asserted regularly in the patent arena as a strategic move to disqualify a client's preferred counsel and force them to accept less experienced counsel. Conflicts of interest have even been asserted based on the employment of paralegals and summer law students. Consequently, there is a low, but significant chance that the above situation may arise at some time. Thus, you agree and accept the following IRPC 1.9 Consent:

You have been advised of the requirements of IRPC 1.9 preventing a lawyer who has formerly represented a client from later representing another person in the same or substantially related matter in which that person's interests are materially adverse to the interests of the former client unless the client consents after disclosure. Thus, in the event that such a situation arises, You 1) agree to consent to later representation of an adverse party by any of Professor Barich, the law students working in the Patent Clinic and any law firms with which they are associated, and 2) also agree to refrain from seeking to disqualify from representing any party any of Professor Barich, the law students working in the Patent Clinic and any law firms with which they are associated.

Finally, IRPC 1.10 further codifies the conflict of interest rules with regard to imputing disqualification of one attorney to the other attorneys in their firm. The relevant parts of IRPC 1.10 state:

**Rule 1.10. Imputed Disqualification: General Rule**

(a) No lawyer associated with a firm shall represent a client when the lawyer knows or reasonably should know that another lawyer associated with that firm would be prohibited from doing so by Rules 1.7, 1.8(c) or 1.9, except as permitted by Rules 1.10(b), (c), or (d), or by Rule 1.11 or Rule 1.12.

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(d) A disqualification prescribed by Rule 1.10 may be waived by the affected client under the conditions stated in Rule 1.7.

(e) For purposes of Rule 1.10, Rule 1.11, and Rule 1.12, a lawyer in a firm will be deemed to have been screened from any participation in a matter if:

- (1) the lawyer has been isolated from confidences, secrets, and material knowledge concerning the matter;
- (2) the lawyer has been isolated from all contact with the client or any agent, officer, or employee of the client and any witness for or against the client;
- (3) the lawyer and the firm have been precluded from discussing the matter with each other; and
- (4) the firm has taken affirmative steps to accomplish the foregoing.

Section (d) states that the affected client may waive the disqualification. Thus, you agree and accept the following IRPC 1.10 Consent:

You have been advised of the requirements of IRPC 1.10 preventing a lawyer associated with a firm from representing a client when the lawyer knows or reasonably should know that another lawyer associated with that firm would be prohibited from doing so by the IRPC, unless such disqualification is waived. Consequently, you agree to waive such disqualification and further agree to refrain from seeking to disqualify of any attorney at any firm that also employs any of Professor Barich or the law students working in the Patent Clinic. Further, you have been advised of the requirements of IRPC 1.10(d) regarding screening of an attorney. Thus, if your waiver and/or consent is not enforceable for any reason or screening is otherwise ordered by a Court, then you agree to allow to be screened from participating in an action involving Student as set

forth under IRPC 1.10(e) any of Professor Barich or the law students working in the Patent Clinic. Further, you represent and warrant that the communication of information with regard to the above is reasonably sufficient to permit you to appreciate the significance of the matter in question. Further, you agree that all waivers and consents by you in this section shall be perpetual and non-revocable. You agree not to impact, interrupt, or object in any way to the ability Professor Barich and/or the law students working the Patent Clinic, or their law firms, to represent present clients and/or future clients

#### **5.0 Agreement Not To Sue The University Of Illinois**

Finally, the Patent Clinic is being paid for by the COL to draft patent applications for the participants in the Patent Clinic at no charge to the participants in the Patent Clinic. Consequently, it would be incredibly ungrateful for participants in the Patent Clinic to turn around and sue the University of Illinois for infringement of patent(s) resulting from patent applications drafted in the Patent Clinic or claiming priority to patent applications drafted in the Patent Clinic.

Consequently, you agree and acknowledge that you will not sue or threaten to sue the University of Illinois, its employees or contractors, related companies, and affiliates for patent infringement based on any patent derived from or claiming priority to a patent application prepared by the Patent Clinic. This agreement runs with the patent, so even if the patent is sold or your right to sue is passed to any other entity, said other entity shall still be barred from threatening to sue and/or suing.

#### **6.0 Severability**

If any part of this Acknowledgement and Disclaimers is declared invalid or unenforceable by a court of competent jurisdiction, it shall not affect the validity or enforceability of the remainder of this document.

# Patent Clinic Participation and Consent Agreement

The present Patent Clinic Participation and Consent Agreement (hereinafter “Agreement”) is entered into between the Student(s) named below and the University of Illinois at Urbana-Champaign, College Of Law. Student(s) represents and agrees as follows:

- 1) I am (we are) a student(s) at the University of Illinois at Urbana-Champaign.
- 2) This form is being submitted with my signature and the signature of all co-inventors (if any).
- 3) I have read and understood “The Patent Clinic FAQ” and “Patent Clinic Acknowledgements And Disclaimers” and agree to be bound by them.
- 4) I have been advised to seek the counsel of an attorney.
- 5) I agree that no attorney-client relationship has been established or will be established between me and any of the Patent Clinic, Professor Barich, or any law student participating in the Patent Clinic.

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Print Name

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Signature

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Print Name

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Signature

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Print Name

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Signature

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Print Name

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Signature

## Acknowledgement of Relationship Between OTM and The Patent Clinic

We, the undersigned inventors, hereby certify and/or agree to the following:

- 1) To the best of our present knowledge, the inventors listed below represent all of the inventors of our invention.
- 2) We desire to participate in the Patent Clinic to have a patent application drafted for our invention, but we recognize that the Patent Clinic does not have the authority to grant any rights or waivers on behalf of the University. Instead, all clearances and permissions to use the invention or to file the resulting patent application must be received from the Office of Technology Management (OTM). More specifically, even though the Patent Clinic drafts a patent application for us, we agree that we don't have any rights in the patent application until approved by OTM.
- 3) We acknowledge that participation in the Patent Clinic is not a factor in the OTM's determination of whether it has rights or whether or not to assert its rights. That is, participation in the Patent Clinic does not make it any more or less likely that the University will assert rights in our invention. However, based on our specific factual situation, the OTM may determine that the University has rights and that the University wishes to assert those rights, in which case we will not be able to file our patent application, but the OTM may proceed to file our patent application instead. The OTM's standard terms would then apply, including those terms with regard to revenue sharing.
- 4) Conversely, if the OTM determines that the University does not have rights or that the University does not wish to assert its rights, then the OTM will provide us with a written clearance and we may proceed to file our patent application on our own.
- 5) To assist in the clearance process, the OTM has requested that our patent application be provided to them once it is drafted by the Patent Clinic. We agree to allow the Patent Clinic to provide our patent application to the OTM. If the OTM later determines that the University has rights in the invention and that the University wishes to assert those rights, then we agree to allow the OTM to use the patent application for its own purposes, including filing all or part of the patent application with the Patent and Trademark Office.

Inventor 1: \_\_\_\_\_  
Signature Date

\_\_\_\_\_  
Printed Name

Inventor 2: \_\_\_\_\_  
Signature Date

\_\_\_\_\_  
Printed Name

(Please add any additional inventors on an attached sheet)