

UNIVERSITY OF ILLINOIS
AT URBANA-CHAMPAIGN

Patent Clinic
Startup Presentation


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- About me
- What is a Patent?
- How does the Patenting process work?
- Why apply for a Patent?
- What can the Patent Clinic do for you?




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Joe Barich

- Adjunct Professor, CoL, 8th year teaching
- About 14 years experience at a large patent specialty law firm, now a Shareholder
- Involved in the prosecution of more than 800 patents in the US and abroad
- *Illinois Rising Star* on the *Super Lawyers* list – 2008, 2009, 2010, 2012
- *Patent Buddy*® List of Top Patent Prosecutors (top 2%) in the areas of "Computer, Electrical, Software, and Business Methods".



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What is a Patent?

- Legal right to exclude others from practicing your invention
 - Not a right to use or make
 - Not a right to sell
- Does not guarantee that you are not infringing other patents
- A sword, not a shield - does not “protect”, except as deterrent
- In the Constitution itself – Art 1, Sec. 8, Clause 8



What is a Patent Application? 1

- Formal document filed with the Patent and Trademark Office (PTO) in an attempt to obtain a patent for an invention
- Highly detailed and technical legal document
- Typically about 40 pages long



What is a Patent Application? 2

- Includes
 - Description/specification (your invention)
 - Claims (the legal protection that you want for your invention)
- “A written description sufficient to enable one of ordinary skill in the art to practice the invention without undue experimentation and showing the inventor’s best mode.”



What is a Patent Application? 3

- Filing = “Patent Pending”
- 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.”



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Warning! - BAR DATES!

- Patent Dos’s and D’oh! article
- U.S. has One Year Grace Period from date of first disclosure/commercialization
- Foreign = No Grace Period – disclose/commercialize before filing and you blew it
- Foreign rights can be preserved by filing an application in the U.S. before disclosure and then later filing foreign app claiming priority to U.S. app
- Disclosures in confidence (to attorney, under agreement of confidentiality), without commercialization, are typically OK



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The Patenting Process

- See chart in your materials



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Requirements For Patentability

- Statutory Subject Matter
 - 35 U.S.C. § 101
 - “Anything under the sun made by man.”
 - No abstract algorithms or principles of science
- Novelty
 - 35 U.S.C. § 102
 - No single Prior Art references teaches all claim limitations
- Non-Obviousness
 - 35 U.S.C. § 103
 - Generally, the claim limitations are not found in 2 or more Prior Art references or in the knowledge of one of ordinary skill in the art



What is Prior Art?

- Many classifications under §102(a)-(g).
- Most commonly cited by PTO:
- 102(b) : Patent/publication published more than 1 year before your priority date (our filing date)
 - PTO is alleging that your invention was already publicly known to the public
- 102(e): Issued/published patent based on an application that was filed before your priority date
 - PTO is alleging that the other party invented first



What does a business do with a patent?

- Enforceable from date of issuance to 20 years from priority date
- Often the primary asset of a start-up company
 - Most of the value of the company is in their IP
 - Can boost corporate valuation
- Use as leverage for a joint venture or tech swap
- Injunction to bar competitors from your market
- Sue infringers for money
 - reasonable royalty/lost profits



Two Samples

- U.S. Pat. App. No. 6,293,874 “User-Operated Amusement Apparatus For Kicking The User’s Buttocks”
- U.S. Pat. App. No. 2012/0010844 “Sensors, Systems, and Methods for Measuring Fluid Perturbation”



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What is the Patent Clinic?

- TEC/College of Law Joint Effort
- Law students draft a patent application for selected inventors for free (typical cost 10K-12K)
- Inventors file patent application themselves (we show how) and pay fee
- Inventors will have to obtain OTM permission before filing



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Who will be writing my patent application?

- Law students in their 3L (final) year
- Have taken Patent Law and Patent Prosecution and earned a B+ or better (tough professor – Me!)
- Most have law firm experience
- Will be expected to draft patent applications professionally in the fall, typically without additional instruction
- Law students – Introduce yourselves!



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How Does the Patent Clinic Work? 1

- Inventor (may be Cozad or Lemelson participant) has an innovation (or may not be sure they have an innovation)
- Agrees to participate in Patent Clinic and signs the release
- Turns over business plan/description of innovation to the Patent Clinic for evaluation



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How Does the Patent Clinic Work? 2

- Patent Clinic performs novelty search
 - Searches 8+ million issued patents and other references
- Conflict check
 - We can't work for you if we are already patenting the same thing for someone else
- Select 7 innovations from those that survive novelty search and conflict check to be drafted as patent applications



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How Does the Patent Clinic Work? 3

- Patent Clinic works with inventor to draft patent application
- Patent Clinic interviews inventor and collects needed documents/figures
- Inventor must be available and help out!
- Patent Clinic Drafts patent application
 - Law students draft – Prof. Barich reviews



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How Does the Patent Clinic Work? 4

- Completed Patent Application given to inventor and OTM
- Inventor **MUST** work out rights with OTM **BEFORE FILING**
- Inventor files in their own name
- Presentation on how to file your patent application with the PTO
 - April 27, Noon-1:30pm, Room F at Law School
- PTO fee – as low as \$530



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Participation and Consent Form

- Good law students - not experts
- No guarantees – the PTO may not allow your patent – we are only writing the application
- We work for the University, not you
- You won't put us or our firms out of business by asserting a conflict of interest
- You won't sue the U of I
- See Form for details and/or consult a lawyer



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OTM/Patent Clinic Agreement

- Only OTM (Not Patent Clinic) can make rights determination
- Participation in Patent Clinic does not impact rights
- If OTM asserts rights, standard revenue sharing terms apply
- Copies of app given to both inventor and OTM
- **MUST CLEAR RIGHTS WITH OTM BEFORE FILING**



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Patent Drawing Drafting

- Nick Lenzen – Patent Drawing Draftsman
- LenzenIP - lenzenip.com
- Will draft formal patent drawings for all seven companies in the Patent Clinic
- PTO typically requires drawings to be formalized before issuance of the patent, and it usually costs \$1,000-\$2,000
- Now, your patent can look professional even at filing – and filed drawings->published drawings
- An additional benefit to your company



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Graphic Design Assistance

- Kristin Borden – Professional Graphic Designer
- Of the seven companies selected for the Patent Clinic, Kristin will choose 2 to work with
- Each company get 25 hours of design assistance
- Kristin will work with you to develop your design priorities and then allocate her time accordingly
 - Logo Design
 - Branding Development
 - Advertising/Brochure Design and Layout
 - Web Presence Establishment



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Why should I participate in the Patent Clinic?

- Patent Application = respect & value for your venture
 - Preference to serious entrepreneurs
- Learn about patents
- Maybe get your own patent
- Business plan “Intellectual Property” section?
- “Patent Pending” looks good on a resume



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Thanks!

Questions?