

IP Clinic Patent And Trademark Filing Presentation

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Overview

- Your Patent Application
- How To File With The PTO

- Your Trademark Application
- How To File With The PTO

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Thank You!

- Thanks for participating in the IP Clinic!
- All inventors and companies should have now received their patent and trademark apps
- A hearty Thank-You to our Law Students!
Karla Bayas
Pia Hunter
Jani Mikel
Harrison Rose
Abigail Van Hook
- Thank you to TEC!

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Patent: Where Do You Go From Here?

- Must work with OTM to get filing clearance
 - Eric Ives (eives@illinois.edu) or Lisa Dhar (ldhar10@illinois.edu)
- Send your patent application to Nick Lenzen (draftsman) to have the figures rendered in compliance with PTO rules
- Once you have OTM clearance and formal drawings, file your application with the PTO
- Can file without formal drawings if time is pressing – remember bar dates!

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Warning! - BAR DATES!

- Remember! - U.S. has One Year Grace Period from date of first disclosure/commercialization
- Many Foreign Countries = 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
- If you have a date issue, tell the OTM and draftsman

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Nick Lenzen – Patent Draftsman

- Nick is a well-known professional draftsman who works with many firms in the Chicago area
- For the law students – When the partner says “Get this done”, then it’s time to call Nick
- Nick has graciously agreed to donate \$1,000 of his time for each patent application
- The IP Clinic, TEC, and Inventors thank Nick for donating his services!
- Nick will take the drawings prepared by the law students and render the drawings in accordance with the PTO’s arcane formal rules

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Working With Nick

- Working with Nick is strictly voluntary
- Please e-mail your patent application to Nick at nlenzen@lenzenip.com - (630) 422-1027
- Include your phone # and reply e-mail as well as any bar date information if applicable
- Nick will draft your drawings and return them to you in about 30 days
- Due date to get drawings to Nick is June 30th

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Proceeding to File The App - 1

- Once you have filing clearance and drawings, it's time to file at the PTO!
- First, make sure that your patent application includes absolutely everything that you want in it.
- You are typically not able to add or change your description after you file (but claims can change)
- Next, finalize inventorship – Make your best efforts to determine who should be listed as an inventor
 - Fraudulent inventorship may render your patent unenforceable

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Proceeding To File The App - 2

- Scan everything to .pdf
 - Drawings may be separate .pdf file
- Have a credit card handy
- We will review how to file electronically because the PTO has a surcharge for paper filing
- Go To: www.uspto.gov to follow along with demonstration
 - www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012

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Proceeding To File The App - 3

- Micro Entity Statement
 - Complete and save if applicable
 - Otherwise, small entity
- PTO EFS System Demo
 - Enter Information
 - Upload Application and Drawings
 - Upload Micro Entity Statement
 - Enter Fee Information
 - Submit and Pay - \$400 as a Micro Entity

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Filing Your Patent App -4

- Once submitted, the PTO will then ask if you would like to pay now and give you the opportunity to pay by credit card
 - If you pay the wrong fee, the PTO still accepts your patent application, but sends you a Notice of Missing Parts making you pay the correct fee plus a surcharge
- The PTO will then give you the opportunity to download an electronic filing acknowledgement
 - Recommended that you both print and download the filing acknowledgement

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Items You May File Later

- Declaration – Official Oath of Inventors
- Assignment – Transfers rights to your company
- Information Disclosure Statement (IDS)
 - Must disclose any prior art references that are known to be material to patentability

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What if I screw it up?

- As long as you include the specification, and drawings, you will get a filing date
- You may receive a Notice of Missing Parts if there is a problem with the Declaration or Fee
- It is recommended that you get your own attorney
- Also recommended to use a permanent address

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After Filing

- Congratulations! You are now Patent Pending!
- You should receive an official Filing Receipt in about 1-2 months
- Good luck in your entrepreneurial endeavors!

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Questions About Your Patent App - 1

- Can you represent yourself as “Patent Pending”?
 - Yes, as soon as you actually file with the PTO
- Will you get a patent if you file with the PTO?
 - No guarantees, you must go through the process and will start out being rejected
 - About 70% of applications issue as patents
- Can the law students continue helping you?
 - No, per IP Clinic agreement with University, you will need your own lawyer
 - Mention on the survey if you would prefer to be able to keep working with the IP Clinic so I can lobby the University

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Questions About Your Patent App -2

- Does having a patent app mean that you don't infringe others?
 - No, novelty/patentability determination is distinct from infringement determination
 - Neither PTO nor the IP Clinic examine for infringement

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Patent: Final Thoughts

- Be conscious of your Bar Dates, if any
- Be sure to get OTM clearance before filing
- Work with Nick – it's a great perk
- Remember to include your complete specification, drawings, and claims
- You are going to need a lawyer in about 18 months to respond to the PTO's rejection
- All feedback is welcome – joebarich@barichip.com
- **Good Luck!**

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Trademark: Where Do You Go From Here?

- Don't have to get OTM permission to file
- No Bar Dates, but best to file quickly because the trademark goes to the first to register when there is no prior use
- Remember that TMs are registered by class and the fee (typically \$275) is charged for each class you want to register in
 - You need not register for all classes right now and can register for more classes later
 - However, if someone else files earlier, you may be out of luck

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Filing Your TM App - 1

- Have .obj file sent by Law Student handy
- Have a credit card handy
- We will review how to file electronically because the PTO has a surcharge for paper filing
- Go To: www.uspto.gov to follow along with demonstration

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Filing Your TM App - 2

- PTO TEAS System Demo
 - Typically TEAS RF (\$275), can use TEAS+ (\$225) only if standard description (not you)
 - Upload .obj file
 - Click continue and repeatedly verify information
 - Click “Sign Directly” and Validate

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Filing Your TM App -3

- Once validated, the PTO will then ask if you would like to pay now and give you the opportunity to pay by credit card
 - You must pay the fee for the PTO to accept your TM application
- The PTO will then e-mail you an electronic filing acknowledgement

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What if I screw it up?

- Not as much to screw up, but it would be likely that you would have to refile (plus another fee)
- For intent-to-use applications, assuming that your TM application is allowed, you will have to file a statement of actual use before your TM becomes enforceable
- Also, the PTO may reject your application
- It is recommended that you get your own attorney
- Also recommended to use a permanent address

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After Filing

- You can start marking your goods/services with “TM” immediately
- You can only mark with ® once your trademark is issued
- You should hear back from the PTO in about 4-5 months
- Good luck in your entrepreneurial endeavors!

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Questions About Your TM App - 1

- Can you represent yourself as “TM Pending”?
 - Typically, you would not do so because you would assert that you already have common law TM rights
 - You can start using “TM” immediately
- Will you get a TM if you file with the PTO?
 - No guarantees, you must go through the process
 - About 70% of TM apps initially rejected
 - About 60% of TM apps finally allowed
- Can the law students continue helping you?
 - No, per IP Clinic agreement with University, you will need your own lawyer
 - Mention on the survey if you would prefer to be able to keep working with the IP Clinic so I can lobby the University

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Questions About Your TM App -2

- If the PTO grants your TM, does it mean that you are definitely free from infringing another's TM?
 - No - Although the PTO will perform the same consumer confusion analysis that would be performed in infringement were alleged, a later court may disagree with the PTO

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TM: Final Thoughts

- You can start marking with TM immediately
- You can file in a smaller number of classes initially to hold fees down
- You will likely need a lawyer in a few months
- All feedback is welcome - joebarich@barichip.com
- **Good Luck!**

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Thanks Again For
Participating in the IP Clinic!

Questions?

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