

2021 IP Clinic FAQ

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

What is the IP Clinic?

The IP Clinic is a joint effort between the Technology Entrepreneur Center (TEC) and Professor Joe Barich at the University of Illinois College of Law (COL). The IP Clinic includes a Patent Track and a Trademark Track. In the Patent Track a number of inventors (including especially participants in the Cozad Competition) 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. In the Trademark Track, a number of companies will receive trademark advising and will have at least one trademark application prepared for them at no cost.

Relationship between the IP Clinic and the Office of Technology Management (OTM) (Patent Track Only)

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://otm.illinois.edu/> Consequently, it is the policy of the IP 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 situation, 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 IP 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 IP Clinic.

Once the IP Clinic has completed drafting the patent application, the patent application is provided to both the OTM and the inventor. However, the IP 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 IP Clinic and OTM are distinct organizations and the inventor must receive clearance from the OTM before filing the patent application.

IP Clinic

Acknowledgements And Disclaimers

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

1.0 GENERAL PROVISIONS OF THE IP CLINIC

You must work with the staff of the IP 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 or trademark application.

Please be aware that the IP Clinic will NOT be performing the actual filing of the patent or trademark 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 or that of your attorney and not the responsibility of the IP Clinic. You are not required to actually file your patent or trademark application to participate in the IP Clinic, but we prefer to work with those who seem more interested in doing so.

2.0 PATENT TRACK

It is anticipated that not all business plans/invention disclosures submitted to the IP 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 not be selected for drafting by law students, 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 IP 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 IP Clinic will perform a search, the IP Clinic does not guarantee that it will find all references relevant to your innovation, or if a reference is found, the IP Clinic does not guarantee that it will appreciate its significance.

Further, if the IP 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 IP Clinic declines to draft your patent application, you are invited and encouraged to consult with an independent patent attorney.

Conversely, if the IP 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 IP Clinic prepares the patent application, the IP 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 IP Clinic.

Additionally, patent applications that set forth inventions in the technological areas in which the IP Clinic's staff have expertise will be favored. For example, if your invention concerns a

pharmaceutical and none of the IP Clinic's staff have a pharmaceutical background, then the IP Clinic will not be able to write a patent application for you.

The patent applications based on your invention disclosures will typically 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 IP Clinic. (However, if you seek experienced professional counsel, please be advised that an average cost for drafting the patent application would be around \$10,000.00-\$12,000.00.) It is expected that the law students at the IP Clinic will deliver competent, satisfactory work similar to that delivered by a first-year associate in a law firm. If you require work by an experienced practitioner, then you are not a good match for the IP Clinic and should seek out a patent attorney on your own.

3.0 TRADEMARK TRACK

It is anticipated that not all companies applying for the Trademark Track will be selected for participation. For example, we may not have enough law students to prepare trademark applications for all of the companies.

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

Further, if the IP Clinic declines to draft your trademark application for any reason, declining to draft the trademark application does not constitute an opinion or warranty that your mark is non-trademarkable. If the IP Clinic declines to draft your trademark application, you are invited and encouraged to consult with an independent trademark attorney.

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

The trademark advising will be performed and the trademark applications will be prepared by second- or third-year law students that have some experience with Trademark Law. However, the law students do not have enough experience to be considered experienced counsel.

Consequently, if you desire your trademark application to be drafted by experienced counsel or the trademark advice of experienced counsel, do not submit your company/mark to the IP Clinic. It is expected that the law students at the IP Clinic will deliver competent, satisfactory work similar to that delivered by a first-year associate in a law firm. If you require work by an experienced practitioner, then you are not a good match for the IP Clinic and should seek out a trademark attorney on your own.

4.0 THE UNIVERSITY IS THE IP 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 IP Clinic, the client is the University of Illinois College of Law (COL), and not any individual/corporate participant in the IP Clinic or group of participants in the IP 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/corporate participant or group of participants is the client of the IP 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 IP Clinic.

Further, please be aware that the only activity that the IP Clinic will perform for you in the Patent Track is preparing the patent application and then only if your invention is selected at the sole discretion of the IP Clinic. No patent infringement analysis or product clearance is performed. Similarly, the only activity that the IP Clinic will perform for you in the Trademark Track is preparing the trademark application and then only if your company is selected at the sole discretion of the IP Clinic. No trademark infringement analysis or clearance is performed. Regardless of Track, none of the IP Clinic, Professor Barich, or the law students working in the IP Clinic are providing you with legal advice and no attorney-client relationship is formed. Additionally, regardless of Track, the IP 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. You should obtain legal counsel to provide you with legal advice.

5.0 CONFLICTS OF INTEREST

This section in general is so that participation in the IP Clinic does not impair the ability of the law students or Professor Barich to represent their own clients or their firm's clients in the future.

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 IP Clinic would adversely affect the relationship with another client, then the potential participant would not be eligible to participate in the IP Clinic. However, this is unlikely to occur.

With regard to section (b), if it is believed that performing work for a potential participant in the IP 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 lawyers own interests, unless the client consents after disclosure. Even though you are not a client and the IP 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 IP Clinic. Further, you agree to refrain from seeking to disqualify from such representation Professor Barich, the law students working in the IP 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 IP 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 attempted to be asserted based on the employment of paralegals and summer law students. Consequently, there is a low, but possible chance that the above situation may be asserted 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) consent and agree to consent to later representation of an adverse party by any of: Professor Barich, the law students working in the IP Clinic, and/or 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 IP Clinic, and/or 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.

...

(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 IP 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 you as set forth under IRPC 1.10(e) any of Professor Barich or the law students working in the IP 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 IP Clinic, or their law firms, to represent present clients and/or future clients

6.0 Agreement Not To Sue The University Of Illinois

Finally, the IP Clinic is being paid for by the University of Illinois to draft patent and trademark applications for the participants in the IP Clinic at no charge to the participants in the IP Clinic. Consequently, it would be incredibly ungrateful for participants in the IP Clinic to turn around and sue the University of Illinois for infringement of patent(s) or trademark(s) resulting from patent or trademark applications either drafted in the IP Clinic or claiming priority to patent applications drafted in the IP 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 or trademark infringement based on any patent or trademark derived from or claiming priority to a patent or trademark application prepared by the IP Clinic. You agree that this agreement runs with the patent and/or trademark, so even if the patent or trademark 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.

7.0 Miscellaneous Provisions

7.1 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.

7.2 Governing Law

This Agreement shall be governed by and construed solely in accordance with the laws of the State of Illinois without regard to conflict of laws principles. The federal and/or state courts located in the State of Illinois, City of Chicago shall have the sole subject matter and personal jurisdiction to adjudicate any dispute arising out of, relating to, or concerning this Agreement.

7.3 Entire Agreement

This Agreement constitutes the entire agreement and understanding of the parties with respect to the subject matter of this Agreement and supersedes all prior discussions, representations, understandings, and agreements, whether oral or written with respect to such subject matter.

IP Clinic Participation and Consent Agreement (Both Patent and Trademark Tracks)

The present IP 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 a (we are) 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) (Patent Track) or all persons having an ownership interest in the company (Trademark Track).
- 3) I have read and understood “The IP Clinic FAQ” and “IP 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 IP Clinic, Professor Barich, or any law student participating in the IP Clinic.

Company Name: _____

Print Name

Signature

**Acknowledgement of Relationship Between OTM and The IP Clinic
(Patent Track Only)**

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 IP Clinic to have a patent application drafted for our invention, but we recognize that the IP 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 IP 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 IP 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 IP 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 IP Clinic. We agree to allow the IP 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.

Company Name: _____

Inventor 1: _____
Signature Date

Printed Name

Inventor 2: _____
Signature Date

Printed Name

(Please add any additional inventors on an attached sheet)