

I ILLINOIS LAW

2021
IP Clinic Patent And Trademark Filing
Presentation

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IP Clinic Director

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Thanks!

- 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!
 - 32 Trademark apps and 2 Patent apps prepared
- Patent Track
 - Rob Arbulu
 - Yongli Yang
- Trademark Track
 - Vera Glonina
 - Daniel Jang
 - Matthew Pham
 - Jake Ritthamel
 - Namisha Saini
 - Angela Taylor-Vanderpool
- Thank you to TEC!

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Overview

- Filing Your Patent Application
- Filing Your Trademark Application
- IP Clinic: Wrap Up

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Filing Your Patent App

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Patent: Pre-filing Tasks

- Must work with OTM to get filing clearance
 - Eric Ives (eives@illinois.edu)
 - IP Clinic required to provide copy of your app to OTM
- (Optional) 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 (always recommended to have an attorney)
- 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 OR commercialization
- Many Foreign Countries = No Grace Period – disclose OR commercialize before filing and you blew it
- Foreign rights can be preserved by filing an application in the U.S. before disclosure or commercialization and then later filing foreign app claiming priority to U.S. app
- If you have a date issue, tell the OTM and draftsman

Nick Lenzen – Patent Draftsman

- Nick is a well-known professional draftsman who works with many firms in the Chicago area and is highly recommended
- Nick will take the drawings prepared by the law students and render the drawings in accordance with the PTO's arcane formal rules
- Nick has graciously agreed to donate \$1,000 of his time for each patent application to prepare formal drawings
- The IP Clinic, TEC, and Inventors thank Nick for donating his services!

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Working With Nick

- Working with Nick is strictly voluntary
- Please contact Nick at nlenzen@lenzenip.com or (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 15 days
- Due date to get drawings to Nick is June 30th

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Preparing to File The App - 1

- Once you have filing clearance and drawings, it's time to file at the PTO! (attorney always recommended)
- 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, but innocent mistakes may be corrected

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Preparing To File The App - 2

- Determine Entity Status – Small/Micro Entity
 - Small - half off PTO fees, Micro = 75%
 - Small - fewer than 500 employees and no obligation to license
 - Micro - All inventors and company earned less than \$206,109 and 4 or fewer applications
- Need to file Micro Entity Certification Form
- PTO Filing Forms (including Micro Entity)
 - www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012

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Preparing To File The App - 3

- Save app, drawings, and Micro Statement to .pdf
 - Drawings and text should be in separate .pdf files
 - Files can NOT have a space in their names
 - It is possible to upload a .docx, but not recommended
- 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
 - Use Chrome – Other browsers may have issues
 - A PTO account is not required, but it is recommended so that you can check the status of your application

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Filing The Patent App - 1

- PTO EFS System Demo (www.uspto.gov)
 - New App->Utility->Nonprovisional
- Complete Web-based ADS (Application Data Sheet)
 - Recommended to use a permanent address – the PTO examination process will likely take about 3 years
- Upload App, Drawings, and Micro Statement
- Fee- Must include Filing+Search+Exam

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Filing The Patent App - 2

- 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
- Congratulations! You are now Patent Pending!

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After Filing

- You should receive an official Filing Receipt from the PTO in about 1-2 months
- Virtually all (99%+) patent applications are initially rejected by the PTO
 - Typically at about 16-18 months from filing, but it can vary
 - The rejection is called an Office Action
 - You will need an attorney to respond to the Office Action
 - It will likely require several Office Actions and attorney responses to secure the issuance of your patent – and there is no guarantee, although about 70% of patent applications do issue as patents
- Good luck in your patenting and entrepreneurial endeavors!

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Items You May File Later

- Declaration – Official Oath of Inventors under penalty of perjury (fine and imprisonment)
- Assignment – Transfers rights to your company
- Information Disclosure Statement (IDS)
 - Must disclose any known prior art references that are 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 for those materials
- You may receive a Notice of Missing Parts if there is a problem with the Fee
- It is recommended that you get your own attorney if a difficulty arises

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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 you 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 to possibly expand the IP Clinic’s services

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Questions About Your Patent App -2

- Does having a pending patent application mean that you don’t infringe others?
 - No, novelty/patentability determination for your patent application is independent from infringement determination for your product
 - Reminder: Neither PTO nor the IP Clinic examine for infringement

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Patent: Final Thoughts

- Be aware of your Bar Dates, if any
- Be sure to get OTM clearance before filing
- Working with Nick is 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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Filing Your Trademark App

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Trademark: Pre-filing Tasks

- 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 \$350 TEAS or \$250 for TEAS+) is charged for each class you want to register in
- You need not register for all classes right now and you can register for more classes later
- However, if someone else files earlier, you may be out of luck

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Preparing To File The App - 1

- Have .obj file sent to you by Law Student handy
- Have a credit card handy
- We will review how to file electronically
 - Paper filing of TM applications is no longer allowed
- **MUST** create a USPTO account
 - Required for TM applications

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Filing the TM App - 1

- Go To: www.uspto.gov to follow along with the demonstration
 - TM-> Apply Online -> Initial Application Forms
 - > Start Application
- #1 – Choose TEAS+ or TEAS Standard
- #2 – “No” for Attorney filing
- #3 – Upload .obj provided by law student

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Filing the TM App - 2

- Confirm and click through
- Declarations and Signature
- Verify and Pay/Submit
 - Must immediately pay by credit card
- The PTO will then e-mail you an electronic filing acknowledgement

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After Filing - 1

- You can start marking your goods/services with “TM” immediately – even before filing
 - But! Can only mark with ® once your trademark is issued
- You should hear back from the PTO in about 4-5 months
 - Chance of rejection varies
 - The rejection is still called an Office Action.
 - You will need an attorney to respond to the Office Action
 - It may require several Office Actions and attorney responses to secure the issuance of your trademark – and there is no guarantee

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After Filing - 2

- If allowed, your TM application will be published for opposition (opposition is rare). If no opposition, your TM application will issue as a TM
- Note: For intent-to-use applications, assuming that your TM application is allowed, you will have to file a statement of actual use once use commences before your TM will issue
- Good luck in your trademark and entrepreneurial endeavors!

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What if I screw it up?

- Not as much to screw up, but most likely case is that you would just have to refile (and pay another fee)
- Note: The PTO occasionally updates the trademark filing system, which renders saved applications unable to be used
 - Recommended that you file your trademark application in the next few months

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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 instead 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

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Questions About Your TM App -2

- If the PTO grants/issues 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
- 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 to possibly expand the IP Clinic’s services

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Trademark: Final Thoughts

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

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IP Clinic: Wrap Up

- Please remember to complete your law student's feedback survey - it counts toward their grade!
 - Please e-mail to joebarich@barichip.com no later than 5pm TODAY!
 - Only ONE (1) survey for each patent or trademark
 - Only ONE person at the company should complete the survey
 - Note - if the law student completed two trademark apps for your company, please fill out two surveys
 - Note - if you received both a patent app and a trademark app, then we need two surveys - one survey for each
- Final THANKS to the TEC, Law Students, and You!

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Thanks Again For
Participating in the IP Clinic!

Questions?

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Thank You!

Joe Barich

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Professional Website: BarichIP.com

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