The IP Clinic
(And What We Can Do For You!)
Professor Joe Barich
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Today

• Intro
• Patent Basics
• Trademark Basics
• The IP (Intellectual Property) Clinic
  – Patent Track
  – Trademark Track
• Working With The IP Clinic
About Joe Barich

- University of Illinois ECE grad – 94 BS, 96 MS
- More than 20 years as a Patent/Trademark Attorney
  - 15 years at large Chicago IP-specialty firm
  - Founded Barich IP Law Group in 2013
  - 2019-2021 Illinois SuperLawyer (top 5% of practicing attorneys) and 4 time Illinois Rising Star on the Super Lawyers list
  - Patent Buddy® List of Top Patent Prosecutors (top 2%) in the areas of "Computer, Electrical, Software, and Business Methods"
  - Prosecuted 1700+ patents, 500+ trademarks, and numerous copyrights in the US and internationally
  - Totally humble and never sarcastic
Academics

• Adjunct Professor, U. of Illinois College of Law
  – Taught Patent Prosecution since 2005 (15th year!)
  – Founded IP Clinic in 2008
  – Taught Intro to IP

• Lecturer - U of I College of Engineering
  – Engineering Law since 2010 (mostly undergrad)
  – TEC class! - Startups: Incorporation, Funding, Contracts, and IP since 2014 (great for entrepreneurs!)

• Awards
  – List of Teachers Ranked as Excellent/Outstanding
  – Alpha Pi Mu & Gamma Epsilon Excellence in Teaching Award
  – Department Head Teaching Award

• Guest Lecturer for Notre Dame Executive MBA on IP since 2014
• Senior Lecturer, U. of Wisconsin, Masters of Engineering Management Program –
  – Teach Engineering Law since summer 2018
Intellectual Property (IP) Rights - 1

• “Big 3”
• Patents - (P)
  – Functionality
  – How something works
• Copyrights - ©
  – Expression
  – What something looks like, sounds like, etc.
• Trademarks – TM, ®
  – Origin of goods in trade
  – What company a product comes from
• Can have (P), ©, and TM/® in same product
• Many other IP rights
IP Rights - 2

• Patents, Copyrights, and Trademarks operate very differently
  – Rules for one typically do not apply to the others
  – Term “IP” is a very loose grouping

• Massive misunderstanding and confusion
  – Most businesses do not understand IP rights
  – Popular press often gets it wrong
  – But! Estimate of value of IP held by SP500 is in excess of $4 trillion

• IP can be a powerful asset for a startup company
• Patent Basics
• Trademark Basics
• The IP Clinic
  – Patent Track
  – Trademark Track
• Working With The IP Clinic
What is a Patent?

• Legal right to exclude others from practicing your invention
  – Excluded: Make, Use, Sell, Offer for Sale, or Import
  – Not a right for you to use, make, or sell
• Corollary: Getting your patent does not mean that your product is free from infringing the patent of another
  – Only examined for novelty, not infringement
  – Car + radio example
• After March 15, 2013, patent is awarded to the first to file their patent application, not the first to invent
Novelty (PTO) ≠ Infringement (Sales)

Can’t sell a car with a radio in it without infringing Patent #2

Can’t sell a car with a radio in it without infringing Patent #1 (can’t sell ANY car without infringing Patent #1)
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, includes drawings
• Very easy for non-lawyers to make uncorrectable errors and lose their rights
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

• As soon as filed = “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.”
Warning! - BAR DATES!

• U.S. has One Year Grace Period from date of first disclosure/commercialization
  – Must file within the year or rights are permanently lost
• Foreign = Often 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 within one year
• Disclosures in confidence (to attorney, under agreement of confidentiality), without commercialization, are typically OK
Requirements For Patentability

• Statutory Subject Matter
  – An invention/machine/system, not just an idea
  – No abstract algorithms or principles of science

• Novelty
  – No single Prior Art reference 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
Sample Applications


  – IP Clinic drafted patent applications
  – Available at www.joebarich.com/ip-clinic.html
What does a business do with a patent?

- Enforceable from date of issuance to 20 years from effective filing/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
- Bar competitors from your market
  - #1 Use - Preserve your market share
- Sue infringers for money/injunction
- Use as leverage for a joint venture or tech swap
• Patent Basics
• **Trademark Basics**
• The IP Clinic
  – Patent Track
  – Trademark Track
• Working With The IP Clinic
What Is A Trademark?

• An identifier that identifies the origin of goods or services in commerce
  – Typically a word or logo
  – Trademark lasts as long as it is used
    • Can last forever
• Two Types of Trademarks
  – Unregistered, common-law trademarks - ™
  – Federally registered trademarks – ®
• Infringement Standard– Consumer confusion
  – If a consumer would think that goods from a second company actually originated from the company owning the trademark, then there may be infringement
Common Law TM

• Has some serious limitations
  – State law – not uniform nationwide
  – Limited in geographic area
  – Must have consumer association
  – Must prove actual damages
  – No registration process, so you can’t be sure that a court will enforce your TM
  – Tough to enforce on internet sales
Registered Trademarks

• Must be registered with the Patent and Trademark Office (PTO)
  – Provides registration so you can be reasonably sure of your mark’s enforceability before suing
  – Federal law, not state law
  – Can file Intent-To-Use application

• Only mark that can use ®

• Geographic exclusivity is the entire US

• Can use the same mark in different fields of goods without confusion

• Can still last forever if used

• Can get statutory damages – like registered ©
  – No longer need to prove actual damages
Registering A Trademark

• File TM application with PTO
  – Word/Phrase or Logo Mark
  – One or more classes of goods – pay per class
• Application goes to Examiner
  – Examiner searches mark
  – Office Action if rejected – typically due to potential consumer confusion with other registered marks
  – Otherwise, mark is allowed
• Mark is published for opposition
  – Companies monitor new marks and file oppositions if they regard the new mark as too close to their own
  – If opposition, then lawsuit or abandon
• Mark is registered on Principal Register
  – Mark can now be enforced
What does a business do with a TM?

- TMs are used to identify your goods/company
  - You want to create a strong and identifiable brand for the consumer – and then be able to defend your brand
- Once you start marketing, you don’t want to have to change your name
  - Cumulative effect of advertising
- Can enforce against counterfeiters
  - Block them from market
  - Seize and destroy their goods
  - Sue for statutory damages
- Enforceable forever if continually used
• Patent Basics
• Trademark Basics
• **The IP Clinic**
  – Patent Track
  – Trademark Track
• Working With The IP Clinic
What is the IP Clinic?

• TEC/College of Law Joint Effort – 14th year!
  – We thank TEC for sponsorship!

• Patent Track
  – You can get a Patent Application prepared for you!
  – But - Only if your company has an invention

• Trademark Track
  – You can get advice with regard to trademark strategy and a Trademark application prepared for you!
  – All companies use trademarks

• Both tracks – companies are independently chosen by law students
IP Clinic Value

• 57 patent applications
  – Typical cost $10,000-$12,000
  – Total = $570K - $684K

• 230+ trademark strategy and applications
  – Typical cost $2,000-$2,500
  – Total = $460K - $575K

• Total value provided to University ecosystem by IP Clinic = $1,030K-$1,259K (~$1.1 million)

• This year –
  – 2 patent applications ($20,000-$24,000)
  – 30 TM applications ($60,000-$75,000)
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• Trademark Basics
• The IP Clinic
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What is the Patent Track?

- Law students draft a patent application for selected inventors for free
- Inventors file drafted patent app themselves (we show how in a presentation) and pay fee
- Inventors will have to obtain OTM (University Office of Technology Management) clearance before filing
  - Must sign OTM agreement
  - Must sign IP Clinic Agreement
Who writes the patent applications?

- Law students in their 3L (final) year
- Have taken Patent Law and Patent Prosecution and earned a B+ or better (tough professor – Me!)
- Have already drafted at least one full patent application
- Often have law firm experience
- Will be expected to draft patent applications professionally in the fall, typically without additional instruction
Would the Law Students in the Patent Track please introduce themselves?
Patent Drawing Drafting

• Nick Lenzen – Patent Drawing Draftsman
• LenzenIP - lenzenip.com
• Will draft formal patent drawings for all patent applications drafted by the IP Clinic
• PTO typically requires drawings to be formalized before issuance of the patent, and it usually costs about $500-$1,000
• Now, your patent can look professional even at filing – and filed drawings typically become published drawings
• An additional benefit to your company
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What is the Trademark Track?

- Law students assist companies in choosing their trademark and prepare a trademark application for free
- Companies file prepared trademark applications themselves (we show how) and pay fee
- No need for OTM permission
  - Must still sign IP Clinic Agreement
Trademark Track Work

• Entrepreneurs erroneously think trademark searching is a straightforward text search
  – It’s not enough that your exact proposed mark is not in use
  – PTO can reject mark based on the legal principles of consumer confusion and/or descriptiveness
  – Law students provide insight into your odds of success and can research alternative marks
  – Trademarks are NOT like a domain name registry

• Review corporate name or name of product
  – Check corporate state registry (available?)
  – Check domain name availability (available?)
Who prepares the TM apps?

- Law students in their 2L or 3L years
- Background in Trademark Law
- Often have law firm experience or will be working at a law firm in a few months
- Often will be expected to prepare trademark applications professionally in the summer or after graduation, typically without additional instruction
- Using a lawyer greatly increases your odds – 2013 study – 83% chance of success with lawyer, 46% greater than without a lawyer
Would the Law Students in the Trademark Track please introduce themselves?
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IP Clinic - Patent Track

• Inventor (for example, Cozad participant) has an innovation (or may not be sure they have an innovation)

• Agrees to participate in IP Clinic – Indicate agreement on TEC form

• Turns over business plan/description of innovation to the IP Clinic for evaluation
  – The more detailed the better
  – All disclosures to IP Clinic are in confidence
Patent Track -2

• IP Clinic performs novelty search
  – Search 10+ million issued patents and other references
  – Searches are for internal IP Clinic use only
• Law students rank and select innovations (one each) to be drafted as patent applications
• We will have more inventions than law students, so what can you do to increase your odds?
  – Better disclosure
  – Be farther along the development chain – Funding? Incorporated? Grants? Website already set up?
  – Be readily available
Patent Track -3

- IP Clinic contacts inventor to obtain additional information and signed OTM and IP Clinic forms
- IP Clinic works with inventor to draft patent application
- IP Clinic interviews inventor and collects needed documents/figures
- **Inventor must be available and help out!**
- IP Clinic Drafts patent application
  - Law students draft – Prof. Barich reviews
Patent Track -4

• Completed Patent Application given to both inventor and OTM
• Inventor MUST receive clearance letter from OTM before filing
  – Advise OTM if timing is an issue
• Inventor files in their own name
• Presentation on how to file your Patent/TM application with the PTO
  – Friday, April 30, noon-1pm, via Zoom
  – See www.joebarich.com/ip-clinic.html
• PTO fee – as low as $430 for Micro Entity
Trademark Track -1

• All companies have brands/marks/corporate or product names that they can use trademark information with regard to

• Company agrees to participate in IP Clinic and signs IP Clinic Participation and Consent Form

• Each law student is assigned 5 companies to assist
  – We will service as many companies as we can
Trademark Track -2

- Law students meet with companies to discuss their current marks and strategy
  - Search their names/marks and discuss results with companies
  - Help formulate trademark procurement strategy
    - NOT trademark clearance/ non-infringement guarantee
  - Select at least one mark per company and prepare a federal trademark application
    - Prof Barich reviews applications
  - Again, companies MUST make themselves available and work with the law student or they may be dropped from the clinic
Trademark Track -3

• No need to work out rights with OTM
• Company files TM in their own name
• Presentation on how to file your trademark application with the PTO (same as patent presentation)
  – Friday, April 30, noon-1pm, via Zoom
  – See www.joebarich.com/ip-clinic.html
• PTO fee – could be as low as $250, likely $350
IP Clinic Participation and Consent Form

• Good law students - not legal experts
• No guarantees
  – The PTO may not allow your patent or trademark
    • We are only writing the application
    – We don’t consider patent infringement, just novelty
    – No guarantees that your mark will be free from infringing another’s mark
• Our client is 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
OTM/IP Clinic Agreement

• Patent Track Only
• Only OTM (Not IP Clinic) can make rights determination
• Participation in IP Clinic does not impact rights
• If OTM asserts rights, standard revenue sharing terms apply
• Copies of completed application are given to both inventor and OTM
• **INVENTORS MUST CLEAR RIGHTS WITH OTM ON THEIR OWN BEFORE FILING**
Why be in the IP Clinic?

• Patent or Trademark Application = respect & value for your venture
  – Preference to serious entrepreneurs
• Learn about patents and trademarks
• Maybe get your own patent or TM
  – Seriously, how cool is that!
• Business plan “Intellectual Property” section?
• “Patent Pending” looks good on a resume
• Not required to actually file the patent or trademark application, but we prefer to work with people who are more serious
  • See www.joebarich.com/ip-clinic.html for more info
Questions?
Thank You!

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