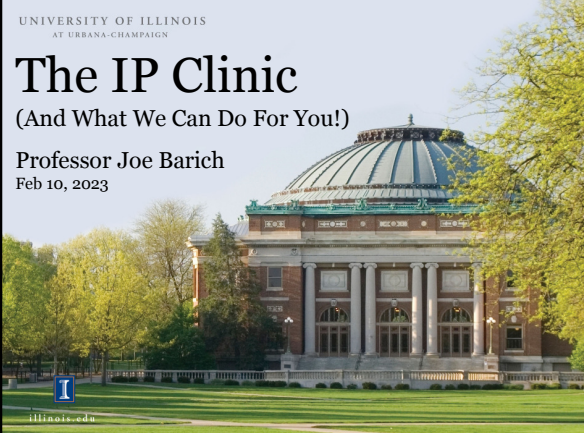


UNIVERSITY OF ILLINOIS
AT URBANA-CHAMPAIGN

The IP Clinic

(And What We Can Do For You!)

Professor Joe Barich
Feb 10, 2023



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Today

- Intro
- Patent Basics
- Trademark Basics
- The IP (Intellectual Property) Clinic
 - Patent Track
 - Trademark Track
- Working With The IP Clinic



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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
 - 2019-2023 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 ☺



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Academics

- Adjunct Professor, U. of Illinois College of Law
 - Taught Patent Prosecution since 2005 (19th year!)
 - Founded IP Clinic in 2008
- 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
 - Campus Award for Undergrad Teaching Excellence
 - Department Head Teaching Award x2
 - Alpha Pi Mu & Gamma Epsilon Excellence in Teaching Award
 - List of Teachers Ranked as Excellent/Outstanding
- Guest Lecturer for Notre Dame Executive MBA on IP since 2014
- Senior Lecturer, U. of Wisconsin, Masters of Engineering Management Program –
 - Taught Engineering Law since summer 2018



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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



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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




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- Patent Basics
- Trademark Basics
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What is a Patent?


- Legal right to exclude others from practicing your invention
 - After March 15, 2013, patent is awarded to the first to file their patent application, not the first to invent
 - Excluded: Make, Use, Sell, Offer for Sale, or Import
 - Not a right for you to use, make, sell, etc.
- 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



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Novelty (PTO) ≠ Infringement (Sales)


<div style="border: 1px solid black; padding: 2px; width: fit-content; margin: 0 auto;">Inventor #1</div> <div style="border: 1px solid black; padding: 10px; width: fit-content; margin: 10px auto;">CAR</div> <div style="border: 1px solid green; padding: 2px; width: fit-content; margin: 10px auto;">Patent #1</div> <div style="border: 1px solid black; padding: 5px; width: fit-content; margin: 10px auto;">Can't sell a car with a radio in it without infringing Patent #2</div>	<p>- Novelty-</p> <p>- Infringement-</p>	<div style="border: 1px solid black; padding: 2px; width: fit-content; margin: 0 auto;">Inventor #2</div> <div style="border: 1px solid black; padding: 10px; width: fit-content; margin: 10px auto;">CAR + RADIO</div> <div style="border: 1px solid green; padding: 2px; width: fit-content; margin: 10px auto;">Patent #2</div> <div style="border: 1px solid black; padding: 5px; width: fit-content; margin: 10px auto;">Can't sell a car with a radio in it without infringing Patent #1 (can't sell ANY car without infringing Patent #1)</div>
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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



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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.”



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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.”



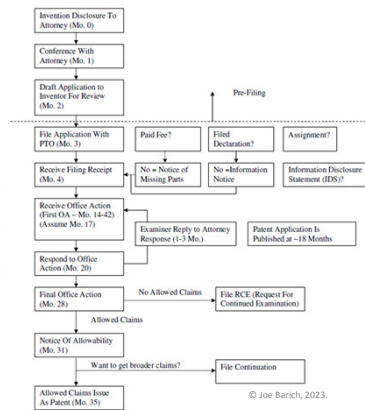
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Warning! - BAR DATES!

- U.S. has One Year Grace Period from date of first disclosure **OR** 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



The Patenting Process



Requirements For Patentability

- Statutory Subject Matter
 - 35 U.S.C. § 101
 - An invention/machine/system, not just an idea
 - No abstract algorithms or principles of science
- Novelty
 - 35 U.S.C. § 102
 - 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

- U.S. Pat. App. No. 2012/0238319 “System and Method For Combined Alarm Detection and Emergency Signaling”
- U.S. Pat. App. No. 2012/0010844 “Sensors, Systems, and Methods For Measuring Fluid Perturbation”
 - 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 or “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 - TM
 - 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



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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



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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



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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



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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



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- Trademark Basics
- **The IP Clinic**
 - Patent Track
 - Trademark Track
- Working With The IP Clinic



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What is the IP Clinic?

- TEC/College of Law Joint Effort – 16th 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
 - Want to make a meaningful contribution



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IP Clinic Value (As of 2022)

- 60 patent applications
 - Typical cost \$10,000-\$12,000
 - Total = \$600K - \$720K
- 305+ trademark strategy and applications
 - Typical cost \$2,000-\$2,500
 - Total = \$610K - \$763K
- Total value provided to University ecosystem by IP Clinic = \$1,210,000-\$1,483,000 (~\$1.3 million)
- This year – ~\$130,000 in value
 - 3 patent applications
 - 45 TM applications



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What is the Patent Track?

- Law students draft patent applications 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



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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



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Would the Law Students in the Patent Track please introduce themselves?



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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



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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
 - Trademarks are NOT like a domain name registry
 - PTO can reject your 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
- Check corporate name or name of product
 - Check corporate state registry (available?)
 - Check domain name availability (available?)



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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



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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



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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



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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



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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
 - Fri, April 28, 1pm, Law School Room F
 - See www.joebarich.com/ip-clinic.html
- PTO fee – as low as \$364 for Micro Entity



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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



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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



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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)
 - Fri, April 28, 1pm, Law School Room F
 - See www.joebarich.com/ip-clinic.html
- PTO fee – could be as low as \$250, likely \$350




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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 or trademark infringement, just novelty/registrability
 - 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

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OTM/IP Clinic Agreement

- Patent Track Only
- Only OTM (Not IP Clinic) can make rights determination for the University
- 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**



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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



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Questions?
Thank You!

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