

## 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 25 years as a Patent/Trademark Attorney
  - 15 years at large Chicago IP-specialty firm
  - Founded Barich IP Law Group in 2013
  - 2019-2025 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
  - 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
- 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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### 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)

<p>Inventor #1</p> <div style="border: 1px solid black; padding: 5px; width: 60px; margin: 10px auto;">CAR</div> <p>Patent #1</p>	<p>- Novelty-</p>	<p>Inventor #2</p> <div style="border: 1px solid black; padding: 5px; width: 60px; margin: 10px auto;">CAR + RADIO</div> <p>Patent #2</p>
<p>Can't sell a car with a radio in it without infringing Patent #2</p>	<p>- Infringement-</p>	<p>Can't sell a car with a radio in it without infringing Patent #1 (can't sell ANY car without infringing Patent #1)</p>

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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

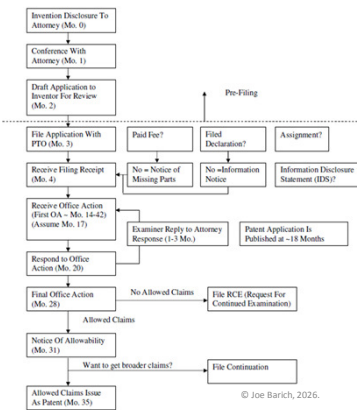


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## The Patenting Process



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## 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



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## 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](http://www.joebarich.com/ip-clinic.html)



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## 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



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## 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 - <sup>TM</sup>
  - 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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## What is the IP Clinic?

- TEC/College of Law Joint Effort – 19<sup>th</sup> 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 2025)

- 70 patent applications
  - Typical cost \$10,000-\$12,000
  - Total = \$700K - \$840K
- 430+ trademark strategy and applications
  - Typical cost \$2,000-\$2,500
  - Total = \$860K - \$1,075K
- Total value provided to University ecosystem by IP Clinic = \$1,560,000-\$1,915,000 (~\$1.75 million)
- This year:
  - 30 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
- Unfortunately, no Patent Track this year - all eligible law students are already occupied



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## What is the Trademark Track?

- Law students assist companies in choosing their trademark and prepare a trademark application for free
- Law students walk companies through the filing process and the company pays the 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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## Trademark Track -1

- All companies have brands/marks/corporate or product names that they can use trademark information with regard to
- Indicate on TEC Cozad form
- 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
    - Company gets Trademark Application Preview
  - 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

- Companies wanting IP Clinic assistance to file their trademark application must attend the Filing Presentation
  - Fri, May 1<sup>st</sup>, 1pm, @ Law School
  - See [www.joebarich.com/ip-clinic.html](http://www.joebarich.com/ip-clinic.html)
- I will review and law students will walk company through filing their application
  - Company must pay USPTO fee – \$350 or \$550
- Company can file later on its own using Trademark Application Preview provided by IP Clinic



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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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## 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?
- 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](http://www.joebarich.com/ip-clinic.html) for more info



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Questions?  
Thank You!

**Joe Barich**

Academic Website: [JoeBarich.com](http://JoeBarich.com)

Professional Website: [BarichIP.com](http://BarichIP.com)

Barich IP Law Group

312-620-2471

joebarich@barichip.com



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