The IP Clinic
(And What We Can Do For You!)

Professor Joe Barich
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Today

• About Me
• 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
• About 20 years as a Patent Attorney
  – Founded Barich IP Law Group in 2013
  – 4-time Illinois Rising Star on the Super Lawyers list
  – Patent Buddy® List of Top Patent Prosecutors (top 2%)
  – Involved in the prosecution of more than 1200 patents and numerous trademarks in the US and abroad
• Adjunct Professor, College of Law
  – Patent Prosecution, Founded IP Clinic
• Lecturer in College of Engineering
  – Engineering Law
  – Startups: Incorporation, Funding, Contracts, and IP
• Guest Lecturer for Notre Dame Executive MBA on IP
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
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
The Patenting Process

Invention Disclosure To Attorney (Mo. 0)

Conference With Attorney (Mo. 1)

Draft Application to Inventor For Review (Mo. 2)

Pre-Filing

File Application With PTO (Mo. 3)

Paid Fee?

No = Notice of Missing Parts

No = Information Notice

Yes = Information Disclosure Statement (IDS)?

Assignment?

Filed Declaration?

Receive Filing Receipt (Mo. 4)

Receive Office Action (First OA - Mo. 14-42) (Assume Mo. 17)

Examiner Reply to Attorney Response (1-3 Mo.)

Patent Application Is Published at ~18 Months

Respond to Office Action (Mo. 20)

No Allowed Claims

File RCE (Request For Continued Examination)

Final Office Action (Mo. 28)

Allowed Claims

Notice Of Allowability (Mo. 31)

Want to get broader claims?

File Continuation

Allowed Claims Issue As Patent (Mo. 35)
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 Application

  – IP Clinic drafted patent application from 2011
  – Available at www.joebarich.com
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 - 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
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
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What is the IP Clinic?

• TEC/College of Law Joint Effort – 11th year
• Patent Track
  – You can get a Patent Application prepared for you!
  – But - Only if your company has an invention
• Trademark Track
  – You can get a Trademark application prepared for you and advice with regard to trademark strategy
  – All companies use trademarks
• The IP Clinic was previously the Patent Clinic
  – Patent Track of IP Clinic operates the same as the Patent Clinic did for 7 years
  – Trademark Track is in its 4th year of availability
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• Working With The IP Clinic
What is the Patent Track?

• Law students draft a patent application for selected inventors for free
  – 47 patent applications drafted over previous years
  – Typically costs about 10K-12K to draft a patent application, so about $500K of value provided to university community to date ($750K counting TM)

• 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
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
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 $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
  – 90+ companies assisted previous years
  – Typically costs about $2-3K to search, advise, and prepare a trademark application, so about $250K of value provided to university community to date

• Companies file prepared trademark applications themselves (we show how) and pay fee

• No need for OTM permission
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
- 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 IP Clinic please introduce themselves?
• Patent Basics
• Trademark Basics
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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 9.6+ 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 Participation and Consent Form

• 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 27th, 1-3pm, Room H of Law School
  - Check joebarich.com for details
- 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 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
  – 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 27th, 1-3pm, Room H of Law School
  – Check joebarich.com for details
• PTO fee – could be as low as $225, likely $275
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
  – Also, we don’t examine for 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 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 for more info
Questions?
Thank You!

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