

IP Clinic Patent And Trademark Filing Presentation

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Overview

- Your Trademark Application
- How To File With The PTO

- Your Patent Application
- How To File With The PTO

- Presentation available at:
 - www.joebarich.com/ip-clinic.html

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Thank You!

- 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!
 - Trademark Track -

Fizza Alam	Rong Fu	Prithvi Vijayamohan
RaeAnn Bell	Yunan Shi	Raven Yang
Edwin Eboigbe	Rajan Tiwary	
 - Patent Track -

Tiffany Hu	Mariam Khan
Edward Jin	Chris Truong
- Note: Surveys Needed for their grades!
- Thank you to TEC!

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Trademark

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Trademark: Where Do You Go From Here?

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

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What if I screw it up?

- Not much to screw up, but it would be likely that you would have to refile (plus another fee)
- For intent-to-use applications, assuming that your TM application is allowed, you will have to file a statement of actual use later for your TM to become enforceable
- Also, the PTO may reject your application
 - Can respond to rejection (attorney recommended)
- Also recommended to use a permanent address

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Filing Your TM App - 1

- Have .obj file sent 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
- Go To: www.uspto.gov to follow along with demonstration

- MUST have already created a USPTO account
 - TM-> Apply online -> Initial Application Forms
 - > Start Application -> Log In

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Filing Your TM App - 2

- PTO TEAS System Demo –
 - Ask your law student if you need help
 - Trademarks->Apply Online->Initial App Forms
 - “Start your application in TEAS” and Login
 - No attorney is filing the TM application
 - Upload .obj file
 - Check info and click continue through pages
 - Read and Click Declaration
 - Sign /Your Name/ and date
 - Click “Important Notice”
 - Click “Pay/Submit”

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Filing Your TM App -3

- Once validated, the PTO will then ask if you would like to pay now and give you the opportunity to pay by credit card
 - You must pay the fee for the PTO to accept your TM application
 - Typically TEAS (\$350) - can use TEAS+ (\$250) only if standard description
- The PTO will then send an electronic filing acknowledgement to the e-mail you indicated

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After Filing

- You can start marking your goods/services with “TM” immediately – even before filing
- You can only mark with ® once your trademark is issued – **not just application filed**
- You should hear back from the PTO in about 8-10 months (PTO is backed up)
- Good luck in your entrepreneurial endeavors!

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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 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
- Can the law students continue helping you?
 - No, per University requirements for the IP Clinic, you will need your own lawyer
 - List of attorneys is available at TEC

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Questions About Your TM App -2

- If the PTO grants 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 if infringement were alleged, a later court may disagree with the PTO

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TM: Final Thoughts

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

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Patents

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Patent: Where Do You Go From Here?

- Must work with OTM to get filing clearance
 - Eric Ives (eives@illinois.edu)
- Special Bonus – Nick Lenzen (professional draftsman) will render your figures 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 and then later filing foreign app claiming priority to U.S. app
- If you have a date issue, tell the OTM and draftsman ASAP!

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Nick Lenzen – Patent Draftsman

- Nick is a well-known professional draftsman who works with many firms in the Chicago area
- For the law students – When the partner says “Get this done”, then it’s time to call Nick
- 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!
- Nick will take the drawings prepared by the law students and render the drawings in accordance with the PTO’s arcane formal rules

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Working With Nick

- Working with Nick is strictly voluntary
- Please e-mail your patent application to Nick at drawings@lenzenip.com - (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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Proceeding 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

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Proceeding To File The App - 2

- Specification in Word .docx format + .pdf backup
- Figures in .pdf format
 - Text and Drawings and should be in separate files
 - No spaces in file names
- 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
- PTO Filing Forms (including Micro Entity)
 - www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012

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Proceeding To File The App - 3

- Determine Entity Status – Small/Micro Entity
 - Small = 60% off PTO fees, Micro = 80%
 - Small – fewer than 500 employees and no obligation to license
 - Micro - All inventors and company earned less than \$223,740 and 4 or fewer applications
 - Need to file Micro Entity Certification Form – SB15A
 - <https://www.uspto.gov/sites/default/files/documents/sb0015a.pdf>

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Proceeding To File The App - 4

- PTO EFS System Demo (www.uspto.gov)
 - Patents->Filing online->Open Patent Center
 - Log in at upper right (can proceed without logging in, but you will not be able to see submission)
 - New Submission-> Utility Nonprovisional
 - Web ADS – Enter Information
 - Upload Application (.docx) and Drawings
 - Upload Micro Entity Statement (if applicable)
 - Uploaded files must NOT have spaces in the name
 - Enter Fee Information (3 fees must be paid)
 - \$364 as a Micro Entity
 - Submit and Pay

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Filing Your Patent App -4

- 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

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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 Declaration or Fee
- It is recommended that you get your own attorney
- Also recommended to use a permanent address – the PTO examination process will likely take about 3 years

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After Filing

- Congratulations! You are now Patent Pending!
- You should receive an official Filing Receipt in about 1-2 months
- Good luck in your entrepreneurial endeavors!

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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 will likely (99%+) start out being rejected
 - About 70% of applications issue as patents
- Can the law students continue helping you?
 - No, per University requirements for the IP Clinic, you will need your own lawyer
 - List of attorneys is available at TEC

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Questions About Your Patent App -2

- Does having a patent app mean that you don't infringe others?
 - No, novelty/patentability determination is distinct from infringement determination
 - Reminder: Neither PTO nor the IP Clinic examine for infringement

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Patent: Final Thoughts

- Be conscious 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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IP Clinic: Wrap Up

- Please remember to complete your law student's feedback survey - **it is needed for their grade!**
 - Please e-mail to joebarich@barichip.com no later than 5pm TODAY! – or complete in paper now!
 - Only ONE (1) survey for each patent or trademark
 - Note – if the law student completed two trademarks for your company, please fill out two surveys
 - Only ONE person at the company should complete the survey
- 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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