

**United States Patent and Trademark Office  
The Office of General Counsel**

**Law School Clinical Certification Pilot Program**



**Fall 2008 – Spring 2010**



# **PETITION PACKET**

---

## **TABLE OF CONTENTS**

---

I.	Introduction .....	1
II.	Petition Deadline / Criteria for Acceptance .....	2
III.	Part 1 – Patent Program Petition.....	3
IV.	Part 1 – Trademark Program Petition.....	4
V.	Part 2 – Law Student Participation.....	5
VI.	Part 3 – Petition: Information Required.....	6
VII.	Part 3 – Petition: Patent Clinic Information .....	7
VIII.	Part 3 – Petition: Trademark Clinic Information.....	8
IX.	Part 4 – Section A: Law School Dean .....	9
X.	Part 5 – Required Submissions.....	10
	I.    Conflict of Interest Check .....	11
	II.   Intellectual Property Case List.....	12
	III.  Case Transfer Protocol.....	13
XI.	Part 6 – Appeals .....	14
XII.	Notes for Students .....	15



## USPTO LAW SCHOOL CLINIC PILOT PROGRAM CHECKLIST

---

The U.S. Patent and Trademark Office will begin a pilot Law School Clinical Certification Program allowing law students to practice Intellectual Property law before the agency under the strict guidance of a Law School Clinical Faculty Supervisor.

A limited number of law schools will be selected for the pilot program. The pilot will consist of both a patent program and a trademark program. In order to be considered law schools are asked to complete the application and submit the required information. After each school has been notified of their acceptance into the pilot program, they will be asked to submit the applications of the participating students for review by the Director of Enrollment and Discipline. The OED Director will grant approval for limited recognition of the Law Student Attorneys after finding each student qualified. All students for the patent and the trademark programs must have the requisite legal qualifications, and be of good moral character and reputation. To qualify to practice in the patent program each student must also qualify by having the required scientific and technical qualifications for registration.

Petition checklist: (Trademark or Patent as applicable)

\_\_\_ Information requested on pages 3 - 14

\_\_\_ Proof of ABA Law School Accreditation

\_\_\_ Proof of Law School Faculty Clinic Supervisor's membership in good standing with the bar of the highest court, in which licensed to practice, and in active practice status. (Trademark Program)

\_\_\_ Proof of Law School Faculty Clinic Supervisor's Registration before the USPTO, Registration No. (For Patent Program)

\_\_\_ List of any current cases being prosecuted by students before the USPTO, not part of this pilot program



## **USPTO LAW SCHOOL CLINIC PILOT PROGRAM**

---

Law Schools wishing to apply to be considered for the USPTO Law School Clinic Pilot Program must submit the Application-Petition Packet containing all required information to the USPTO by May 30, 2008:

**MAILSTOP OED  
USPTO  
ATTN: Law School Pilot Program  
PO BOX 1450  
Alexandria, VA 22313-1450**

---

Questions regarding the pilot program, requirements, or the application may be directed to OED:

Melinda DeAtley

Staff Attorney, OED

Email: [Melinda.DeAtley@uspto.gov](mailto:Melinda.DeAtley@uspto.gov)

Phone: 571-272-4097



# USPTO – Law School Pilot Program

---

The U.S. Patent and Trademark Office (USPTO or Office) through its Office of General Counsel (OGC) is launching a two year pilot program during which time three to five law school clinical programs with an Intellectual Property (IP) specialization will be selected to participate. Each IP Law School Clinical program must meet and maintain the requirements for USPTO certification in order for student practitioners to practice before the Office. Additionally, in order to qualify, the law school clinical program must meet the American Bar Association (ABA) standards and must be an accredited law school.

Each IP Law School Clinic that wishes to have its students practice IP law before the USPTO must agree to the terms set forth by the USPTO with the Law School Faculty Clinic Supervisor (Clinic Supervisor) certifying that the clinical program and students will abide by the terms set forth by the USPTO. Also, the Law School Dean must certify to each participating law student's good standing and that the student is in compliance with the school's ethics code. The law student clinic practitioners will have the opportunity to practice in either a patent law program or trademark law program by prosecuting either a patent application or a trademark application before the USPTO under the guidance of the Clinic Supervisor. The student practitioner choosing patents will have the opportunity to participate in one or more the following patent activities: drafting and filing of patent applications; responding to Office Actions; drafting and filing briefs and reply briefs in appeals to the Board of Patent Appeals and Interferences (BPAI) from final rejections. The student clinic practitioner choosing trademarks will have the opportunity to participate in one or more of the following trademark activities: drafting and filing of trademark applications; responding to Office Actions; drafting and filing briefs and reply briefs in appeals to the Trademark Trial and Appeal Board (TTAB) from final refusals.

The Clinic Supervisor for the patent program must be a registered practitioner in good standing with the Office of Enrollment and Discipline (OED). The Clinic Supervisor for the trademark program must be a licensed attorney in good standing with the bar of the highest court in a state and in active status. The Law School Clinic Program must address within the petition process the provision of seamless representation of the patent or trademark applicant over an unspecified time-frame notwithstanding the law student clinic practitioner's semester schedule which may not encompass the same. A student's class, examination, or matriculation schedule cannot impede the business practices of the USPTO and the representation of a patent or trademark applicant before the Office.



# USPTO – Law School Pilot Program

---

---

## Petition Deadline

Intellectual Property Law School Clinic programs wishing to be considered for this pilot program must submit to the Office of Enrollment and Discipline (OED) the requested information described in the petition packet. The provision of the information is voluntary but failure to submit the requested information may adversely impact the law school's consideration for the pilot program. Petitions will be accepted on a rolling basis beginning March 10, 2008 and ending April 7, 2008. *Schools will be chosen and notified of their being selected by April 30, 2008.*

## KEY CRITERIA FOR ACCEPTANCE IN THE PILOT PROGRAM

The USPTO wishes to establish a Law School Pilot Program that does not disrupt the business of the Office. Therefore one key criteria in the selection of the law schools to participate in the USPTO pilot program is the school's creation of a seamless protocol establishing and executing a system for transferring cases from student clinic practitioners to the Faculty Clinic Supervisor when the student is either unavailable, completes the semester, or graduates. The Faculty Clinic Supervisor is asked to submit along with the petition a description of the case transfer protocol that will be followed by the clinic program.

## REQUESTED INFORMATION PETITION / APPLICATION

On the following pages are sets of requested information. OED requests that each Law School Clinical Program voluntarily provide the requested information in order to be considered for the USPTO Law School Pilot Program. In the pages that follow, the information requested is detailed followed by the sample formats for submitting the information.



# USPTO – Law School Pilot Program

---

## Part I. Law School Clinic Program Certification Petition

*This portion pertains to the Law School Clinic Program Faculty Supervisor. In order to participate in the USPTO Law School Pilot Program, the Clinic Program Faculty Supervisor must sign and submit with the petition an agreement to the following terms: (Please find below the sample format)*

### **Patent Program: Faculty Clinic Supervisor**

In signing and submitting this petition to the USPTO, the undersigned agrees to the following:

- All law school students from the participating institution will be supervised by the undersigned and the undersigned assumes full responsibility for all documents submitted by student clinical practitioner with the USPTO
- All law school student clinic practitioners from the participating institution will be supervised by the undersigned and the undersigned assumes full responsibility for all oral communications by student clinic practitioners with the USPTO
- All documents signed by student clinic practitioners shall be discussed, reviewed, and approved by the undersigned prior to submission to the USPTO
- Each document signed by a student clinic practitioner will include the Clinical Faculty Supervisor's name, signature, registration number, and telephone number. (Student clinic practitioners will be granted limited recognition by the OED Director to act on behalf of their clients. However, participation in the program requires that all submissions to the USPTO be reviewed and approved by the Clinical Supervisor prior to filing with the USPTO. This review will be demonstrated by the document containing the name, signature, and phone number of the supervisor. Nonetheless, the student clinic practitioner will be required to also sign the application along with listing their assigned limited recognition number.)
- The Faculty Clinic Supervisor attests that he or she, along with the student clinic practitioner, will read and be familiar with the USPTO ethics rules and the relevant sections of the Office's procedural rules.

\_\_\_\_\_  
Clinical Faculty Supervisor (Print Name)

\_\_\_\_\_  
Date

\_\_\_\_\_  
Clinical Faculty Supervisor (Signature)

\_\_\_\_\_  
USPTO Registration Number



# USPTO – Law School Pilot Program

---

---

## Part I. Law School Clinic Program Certification Petition

*This portion pertains to the Law School Clinic Program Faculty Supervisor. In order to participate in the USPTO Law School Pilot Program, the Clinic Program Faculty Supervisor must sign and submit with the petition an agreement to the following terms: (Please find below the sample format)*

### **Trademark Program: Faculty Clinic Supervisor**

In signing and submitting this petition to the USPTO, the undersigned agrees to the following:

- All law school students from the participating institution will be supervised by the undersigned and the undersigned assumes full responsibility for all documents submitted by student clinic practitioner with the USPTO
- All law school student clinic practitioners from the participating institution will be supervised by the undersigned and the undersigned assumes full responsibility for all oral communications by student clinic practitioners with the USPTO
- All documents signed by student clinic practitioners shall be discussed, reviewed, and approved by the undersigned prior to submission to the USPTO
- Each document signed by a student clinic practitioner will include the Clinical Faculty Supervisor's name, signature, State Bar Membership In Good Standing, State Bar License Number (where available) and telephone number. (Student clinic practitioners will be granted limited recognition by the OED Director to act on behalf of their clients. However, participation in the program requires that all submissions to the USPTO be reviewed and approved by the Clinical Supervisor prior to filing with the USPTO. This review will be demonstrated by the document containing the name, signature, and phone number of the supervisor. Nonetheless, the student clinic practitioner will be required to also sign the application along with listing their assigned limited recognition number.)
- The Clinical Supervisor attests that he or she, along with the student clinic practitioner, will read and be familiar with the USPTO ethics rules and the relevant sections of the Office's procedural rules.

\_\_\_\_\_  
Clinical Faculty Supervisor (Print Name)

\_\_\_\_\_  
Date

\_\_\_\_\_  
Clinical Faculty Supervisor (Signature)

\_\_\_\_\_  
State Bar Membership In Good Standing

\_\_\_\_\_  
State Bar License Number



# **USPTO – Law School Pilot Program**

The following is for informational purposes and the information is requested and voluntary.

## **Part II. Student Participation Requiring Law School Dean's Verification of Matriculation and Good Standing**

Each participating student clinic practitioner must be a matriculating student at the law school and be in good standing. Each participating law student must have completed his or her first year of law school. Further, the student must be enrolled in the IP law clinic program.

For the student clinic practitioner participating in the pilot program for patents, each student practitioner must meet the technical qualifications set forth by the USPTO in the General Requirements Bulletin with regard to the qualifications for registration to practice before the Office in patent cases.\* For example, the student must establish to the satisfaction of the OED Director that he or she (i) possesses good moral character and reputation; (ii) possess the legal, scientific, and technical qualifications necessary for him or her to render applications valuable service; and (iii) is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office. The OED Director recognizes, of course, that the student clinic practitioner will also draw competency from the oversight of the Clinical Supervisor. The Law School Dean may attest to the law student's good moral character by certifying that the student is in compliance with the school's ethics code, and has had no moral character issues prior to attending law school or while in attendance. The USPTO reserves the right to review the requirements and may discontinue the clinic program's eligibility if discrepancies are discovered.

The law school maintains a duty to update each law student's status should it change during the student's participation in the clinical program.

Limited Recognition for Clinic Student Practitioners: limited recognition will authorize student clinic practitioners to perform only the following activities:

- i. Patent Activities – drafting and filing of patent applications; responses to Office Actions; drafting and filing briefs and reply briefs in appeals to the Board of Patent Appeals and Interferences from final rejections
- ii. Trademark Activities – drafting and filing of trademark applications; responses to Office Actions; drafting and filing briefs and reply briefs in appeals to the Trademark Trial and Appeal Board from final refusals.

\* The General Requirements Bulletin may be found at [www.uspto.gov/web/offices/dcom/gcounsel/oed.htm](http://www.uspto.gov/web/offices/dcom/gcounsel/oed.htm).



# USPTO – Law School Pilot Program

---

---

## Part III. Petition

OED requests the contact information for each law school school along with information regarding the IP classes that the school offers to law students. **The following is a sample format.**

### **Part A. September 2008 – June 2010**

**Law School Name:** \_\_\_\_\_

**Address:** \_\_\_\_\_  
\_\_\_\_\_

**City, State, Zip:** \_\_\_\_\_

**URL (web-site) Address:** \_\_\_\_\_

### **Part B. Intellectual Property Curriculum Associated with Clinic Program**

Patent Classes: \_\_\_\_\_

Trademark Classes: \_\_\_\_\_

Other Intellectual Property Topics: \_\_\_\_\_  
\_\_\_\_\_

Semester(s) Clinic Offered (Fall / Spring / Summer): \_\_\_\_\_

Clinic Credit Hours Available Per Semester: \_\_\_\_\_

Hours Per Week Required for Clinical Practice: \_\_\_\_\_





# USPTO – Law School Pilot Program

OED requests the following law school clinic contact information.

OED requests the Trademark Clinic Faculty Supervisor provide the following information.

**This is a sample format.**

## **C. Clinic Program Certification Petition**

**Title of Program:** Trademark Clinic Program

**Mailing Address:** \_\_\_\_\_

**Address:** \_\_\_\_\_

**City, State, Zip:** \_\_\_\_\_

**Office Phone:** \_\_\_\_\_

**E-mail:** \_\_\_\_\_

**Faculty Clinic Supervisor:** \_\_\_\_\_

**Address:** \_\_\_\_\_

**Address:** \_\_\_\_\_

**City, State, Zip:** \_\_\_\_\_

**Office Phone:** \_\_\_\_\_

**Mobile Phone:** \_\_\_\_\_

**E-mail:** \_\_\_\_\_

**State Bar Membership:** \_\_\_\_\_

**State Bar License Number:**

**I agree to the above petition requirements for participation in the USPTO pilot program and agree to provide the required supervision as detailed above:**

**Signature:** \_\_\_\_\_

**Date:** \_\_\_\_\_















