



USPTO

Law School

CLINIC CERTIFICATION PROGRAM

**Law School Application Packet
2020-2022 Expansion**

UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto

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I. History

The United States Patent and Trademark Office (USPTO) began the Law School Clinic Certification Program (Program) in 2008 to allow law school students to practice patent and trademark law before the USPTO under the guidance of a faculty clinic supervisor. Law school clinics participating in the Program provide their services *pro bono* to the public.

On December 16, 2014, the Program was established by law for 10 years (Public Law No. 113-227). Further to the enacted legislation, a final rulemaking regarding the Program was published on May 27, 2016 (81 F.R. 33591). Rules regarding requirements for admission to the Program are found at 37 C.F.R. § 11.16 and rules regarding requirements for participation in the Program are found at 37 C.F.R. § 11.17.

The Program began in the fall semester of 2008 with six participating law school clinics. The Program has subsequently expanded with 59 law school clinics participating: 30 clinics participating in both the patent and trademark portions, 24 clinics participating only in the trademark portion, and 6 clinics participating only in the patent portion. A current listing of the participating law school clinics in the Program and additional information about the Program may be found on the USPTO's website at: <http://www.uspto.gov/lawschoolclinic>.

II. Overview

To participate in the Program and for the law school clinic students to practice before the USPTO, each law school clinic must meet and maintain the requirements for USPTO certification. All United States law schools accredited by the American Bar Association (ABA) are eligible for participation in the Program and will be examined for acceptance using identical criteria set forth herein.

Each law school clinic that wishes to have its students practice patent and/or trademark law before the USPTO must agree to the rules, requirements, and procedures of the Program as set forth by the USPTO. This includes having the law school's faculty clinic supervisor certify that the law school clinic and participating law school clinic students will abide by the terms and requirements set forth by the USPTO. Also, the law school dean, or one authorized to act for the dean, must certify that each participating law school student has completed his/her first year of law school or the equivalent, is in compliance with the law school's ethics code, and is of good moral character and reputation.

The participating law school clinic students will have the opportunity to practice in patent and/or trademark law by prosecuting patent applications and/or trademark applications before the USPTO under the guidance of the faculty clinic supervisor.

The faculty clinic supervisor for a patent clinic must, at a minimum, be a registered patent practitioner in good standing with the Office of Enrollment and Discipline (OED) of the USPTO and possess at least three years of experience in prosecuting patent applications before the USPTO within the last five years. The faculty clinic supervisor for a trademark clinic must, at a minimum, be a licensed attorney in good standing with the highest court of any state and in active status, and possess at least three years of experience in prosecuting trademark applications before the USPTO within the last five years. The faculty clinic supervisor is responsible for instructing, mentoring, overseeing, and supervising all participating law school students in the clinic and is responsible for all applications and documents submitted to the USPTO through the clinic. The faculty clinic supervisor must ensure that a conflict of interest check is performed for each participating law school clinic student and each client or potential client of the clinic.

The law school clinic, through the faculty clinic supervisor, must provide seamless representation of patent and/or trademark applicants, notwithstanding the law school clinic students' semester schedule. A law school clinic student's class, examination, or matriculation schedule cannot impede the business practices of the USPTO or the representation of patent and/or trademark applicants before the USPTO. It is the responsibility of the faculty clinic supervisor to ensure that applications are timely filed, that USPTO inquiries are timely responded to, and that no gap in client representation occurs.

III. Program Expansion

The Program is expanding and accepting additional qualified law school clinics for participation in the Program. During the expansion, law school clinics may submit an application for the patent portion and/or the trademark portion of the Program. Applications from interested law school clinics will be examined for admission into the Program as they are received.

In order to be considered, law schools are asked to review the materials in this application packet and submit a complete application with the requested information and documents.

Upon notification of a law school clinic's acceptance and entry into the Program, the law school will be asked to submit additional materials, including a faculty supervisor agreement for each approved faculty clinic supervisor and clinic student applications for the participating clinic students for review by the OED Director. Once accepted into the Program, the OED Director will review student applications and will grant approval for limited recognition for each qualified law school clinic student to practice before the USPTO in patent and/or trademark law while participating in the accepted law school clinic.

All law school clinic students who want to participate in the patent portion and/or the trademark portion of the Program must have the requisite legal qualifications, and be of good moral character and reputation. To qualify to practice in the patent portion of the Program, each law school clinic student must have the required scientific and technical qualifications for registration. See, e.g., General Requirements Bulletin at pages 4-8, available on the USPTO's website (www.uspto.gov) at https://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf

IV. Program Requirements

The following are Program requirements regarding clinic participation, law school dean's certifications, faculty clinic supervisor(s), and law school clinic students.

Part A. Clinic Participation

- All law school clinics that are part of a United States law school accredited by the ABA are eligible for participation in the Program. See 37 C.F.R. § 11.16(a).
- Each participating law school clinic must provide their legal services *pro bono* to the public. See 37 C.F.R. §§ 11.16(a) and 11.17(a).
- Each participating law school clinic must establish a protocol for providing seamless representation of clients and establish a system for transferring cases from semester to semester, e.g., when the clinic students are either unavailable, have completed the semester, or have graduated.

- One important factor in the selection of the law school clinics to participate in the Program is a protocol for a seamless transfer by the law school clinic establishing and executing a system for transferring cases from outgoing law school clinic students to the faculty clinic supervisor and then back to incoming law school clinic students from semester to semester.
- The USPTO needs to ensure that there is no disruption in conducting USPTO business. Therefore, a sufficient case transfer protocol is vital to a successful clinic application.
- Each law school clinic participating in the patent portion of the Program must:
 - File all patent applications and other documents therein electronically via the USPTO electronic filing system. If the USPTO electronic filing system is not operational, patent applications and documents therein may be filed by paper.
 - Establish one customer number. Each semester, the faculty clinic supervisor and all clinic students granted limited recognition numbers will be listed under the customer number. The customer number must be updated each semester to reflect the law school students currently participating in the clinic.
 - Ensure that each participating law school clinic student who receives limited recognition and who may file a patent application or other document with the USPTO obtains a MyUSPTO.gov account.
 - Conduct a patentability search, provide the client with the results, and counsel the client as to the results for each proposed invention prior to filing a nonprovisional patent application therefor. Counseling the client means communicating to the client adequate information and explanation to enable the client to provide informed consent to the proposed course of action.
 - It is permissible for law school clinics participating in the patent portion of the Program to file a provisional patent application with the USPTO for a client's proposed invention prior to providing the client with a patentability search and counsel as to the results, if the

faculty clinic supervisor determines that this is a best practice to protect the client's rights in the proposed invention.

- The law school clinic must keep the client informed of any relevant information obtained in the process of preparing and filing the provisional patent application.
 - Upon filing the provisional patent application, the law school clinic must then provide the client with a patentability search, provide the client with the results, and counsel the client as to the results for each proposed invention as soon as possible after the filing of the provisional patent application, but generally within ninety days from the filing of the provisional application.
- Each law school clinic participating in the trademark portion of the Program must:
 - File all trademark applications and other documents electronically via the USPTO Trademark Electronic Application System (TEAS). The trademark clinic must conduct all written communications in trademark applications with the USPTO electronically.
 - Ensure that the faculty clinic supervisor is listed as the attorney of record in all trademark applications filed in the Program.
 - Use the USPTO assigned tracking code on each trademark application and document filed by the clinic in the Program.
 - Ensure that each participating law school clinic student who receives limited recognition and who may file a trademark application or other document with the USPTO obtains a MyUSPTO.gov account.
 - Conduct a registerability search, provide the client with the results, and counsel the client as to the results for each proposed trademark prior to filing a trademark application therefor. Counseling the client means communicating to the client adequate information and explanation to enable the client to provide informed consent to the proposed course of action.

- Matters before the Patent Trial and Appeal Board (PTAB) or the Trademark Trial and Appeal Board (TTAB) are not included in the Program, but may be requested to be in the Program. The requests will be considered on a case-by-case basis, decided by the Chief Judge of the respective Board.
- Each law school participating in the Program must follow all USPTO and Program rules (*see* 37 C.F.R. §§ 11.16 and 11.17), regulations, and procedures.

Part B. Law School Dean's Certifications

- The law school dean, or one authorized to act for the dean, must certify that each participating law school clinic student is matriculated in the law school and is in good standing with the law school.
- Specifically, the law school dean, or one authorized to act for the dean, must certify as to the following regarding each participating law school clinic student in the Program:
 - 1st year of law school completed – certify that each participating law school clinic student has successfully completed his/her first year of law school, or the equivalent.
 - Ethics code/moral character – certify that each participating law school clinic student is in compliance with the law school's ethics code. The law school dean, or one authorized to act for the dean, must attest to each participating law school clinic student's good moral character by certifying that the student is in compliance with the law school's ethics code. The USPTO reserves the right to review the requirements and may discontinue the law school clinic's eligibility if discrepancies are discovered.
 - Conflict of interest – certify that the school has a process that ensures that no conflicts exist in the representation of clinic clients. This is a continuing obligation throughout participation in the Program.
- The law school, through the law school dean, or one authorized to act for the dean, maintains a duty to update OED as to each participating law school clinic student's status should it change during the student's participation in the clinic in the Program.

- The dean's certifications are required any time new students are added to the clinic for participation therein.

Part C. Faculty Clinic Supervisor(s)

Requirements

- Faculty clinic supervisor(s) for patents must, at a minimum, be a registered patent attorney or patent agent in good standing with OED of the USPTO and possess at least three years of experience in prosecuting patent applications before the USPTO within the last five years. *See* 37 C.F.R. §§ 11.16(c)(1)(i) and 11.16(c)(1)(ii).
- Faculty clinic supervisor(s) for trademarks must, at a minimum, be a licensed attorney in good standing with the highest court of any state and possess at least three years of experience in prosecuting trademark applications before the USPTO within the last five years. *See* 37 C.F.R. §§ 11.16(c)(2)(i) and 11.16(c)(2)(ii).

Responsibilities

- Faculty clinic supervisor(s) must ensure that a conflict of interest check is performed for each participating law school clinic student and each client or potential client of the clinic. *See* 37 C.F.R. § 11.16(c)(3)(i).
- Faculty clinic supervisor(s) are responsible for instructing, mentoring, overseeing, and supervising all law school clinic students participating in the clinic. *See* 37 C.F.R. § 11.16(c)(3)(ii).
- Faculty clinic supervisor(s) are responsible for the content and timeliness of all applications and documents submitted to the USPTO through the clinic. *See* 37 C.F.R. § 11.16(c)(3)(iii).
- Faculty clinic supervisor(s) are responsible for all oral communications by the participating law school clinic students to the USPTO and clinic clients. *See* 37 C.F.R. § 11.16(c)(3)(iv).

- Faculty clinic supervisor(s) are responsible for ensuring that there is no gap in representation of clinic clients in the relevant practice area during student turnover, school schedule variations, inter-semester transitions, or other disruptions. *See* 37 C.F.R. § 11.16(c)(3)(v).
- Faculty clinic supervisor(s) must discuss, review, and approve all documents signed by participating law school clinic students from the participating law school clinic prior to submission to the USPTO. Participation in the Program requires that all submissions to the USPTO be reviewed and approved by a faculty clinic supervisor(s) prior to filing with the USPTO.
- Faculty clinic supervisor(s) are attorney of record on all patent and trademark applications filed with the USPTO through the clinic.
- Faculty clinic supervisor(s) must read and be familiar with the USPTO ethics rules (*see*, 37 C.F.R. § 11.101 *et seq.*); the relevant sections of the USPTO's procedural rules; and the USPTO's Program rules, requirements, and procedures. Faculty clinic supervisor(s) must ensure that participating law school clinic students do the same.
- Faculty clinic supervisor(s) must maintain a written record of all documents submitted to the USPTO through the clinic/Program by law school clinic student(s).
- Faculty clinic supervisor(s) must comply with the USPTO's reporting requirements for the Program. *See* 37 C.F.R. § 11.17(b).

Participation and Change in Faculty Clinic Supervisor(s)

- Faculty clinic supervisor(s) must be approved by OED prior to commencing as a faculty clinic supervisor.
- In the event a faculty clinic supervisor leaves a clinic, that faculty clinic supervisor remains responsible for all pending applications filed by the clinic until that faculty clinic supervisor properly withdraws from the clinic's pending applications.
 - It is best practice to have a new faculty clinic supervisor approved by OED prior to the current faculty clinic supervisor withdrawing from the clinic's

applications in order to prevent any gap in faculty clinic supervisors.

- NOTE: Any gap in faculty clinic supervisors will result in the clinic being suspended from the Program until a new faculty clinic supervisor is approved by OED. See 37 C.F.R. §§ 11.17(c)(1)(i) and 11.17(c)(2).

Part D. Law School Clinic Students

Requirements

- Each participating law school clinic student must be enrolled in the participating law school. See 37 C.F.R. §§ 11.16(d)(2)(i) and 11.16(d)(3)(i).
- Each participating law school clinic student must be enrolled in the law school clinic that is participating in the Program. See 37 C.F.R. §§ 11.16(d)(2)(ii) and 11.16(d)(3)(ii).
- Each participating law school clinic student must have successfully completed his/her first year of law school, or the equivalent. See 37 C.F.R. §§ 11.16(d)(2)(iii) and 11.16(d)(3)(iii).
- Each participating law school clinic student must have read the USPTO Rules of Professional Conduct and the relevant rules of practice and procedure for patent matters. See 37 C.F.R. §§ 11.16(d)(2)(iv) and 11.16(d)(3)(iv).
- Each participating law school clinic student will be supervised by the faculty clinic supervisor(s). See 37 C.F.R. §§ 11.16(d)(2)(v) and 11.16(d)(3)(v).
- Each participating law school clinic student must be of good moral character, in compliance with the law school's ethics code. The USPTO reserves the right to review the requirements and may discontinue the participation of any law school clinic student in the Program if discrepancies are discovered. See 37 C.F.R. §§ 11.16(d)(2)(vi) and 11.16(d)(3)(vi).
- Each participating law school clinic student may neither ask for nor receive any fee or compensation of any kind for legal services from a clinic client on whose behalf service is rendered. See 37 C.F.R. §§ 11.16(d)(2)(vii) and 11.16(d)(3)(vii).

- Each participating law school clinic student in the patent portion of the Program 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 USPTO in patent cases. See General Requirements Bulletin on pages 4-8, *see also*, 37 C.F.R. § 11.16(d)(2)(viii).

Student Applications and Limited Recognition

- Each semester, law school clinic students who are designated by the law school to participate in the law school's clinic will be required to complete and submit a student application to OED for review.
- Qualified law school clinic students will be granted limited recognition to practice before the USPTO under supervision of the faculty clinic supervisor while enrolled in the clinic.
- When receiving limited recognition to practice before the USPTO, in either patent application and/or trademark application matters, the law school clinic students will be treated as attorneys for purposes of filing and prosecuting applications before the USPTO in the Program.
 - For example, when completing any online forms, the student would select "attorney" rather than "agent" where applicable on an electronic form.
 - As a further example, in the case of a trademark application and filing of a Power of Attorney to represent the applicant, the law school clinic student would be named as the secondary power of attorney, *i.e.*, "Other Appointed Attorney," and the faculty clinic supervisor would be the primary power of attorney as the "Attorney of Record."
- Approved participating law school clinic students will be granted limited recognition to perform only the following activities:
 - Patent activities – counseling clients regarding patent matters, conducting patentability searches and preparing patentability opinions for clinic clients, and drafting and filing of patent applications, responses to office actions, and other documents in patent applications.

- Trademark activities – counseling clients regarding trademark matters, conducting registerability searches and preparing registerability opinions for clinic clients, and drafting and filing of trademark applications, responses to office actions, and other documents in trademark applications.

V. Application Deadline

Law school clinics wishing to be considered for participation in the Program must submit a complete application with all the requested information and documents in this application packet to OED. Providing the requested information and supporting documents to OED is voluntary, but failure to submit the requested information and supporting documents may adversely impact the law school's consideration for participation in the Program.

Applications will be accepted on a rolling basis until **December 31, 2022**. Applications from interested law school clinics will be examined for admission into the Program as they are received.

Complete applications and requested materials should be sent to:

**Mail Stop OED
Office of Enrollment and Discipline
United States Patent and Trademark Office
ATTN: Law School Clinic Certification Program
P.O. BOX 1450
Alexandria, Virginia 22313-1450**

Questions regarding the Program, requirements, or the application may be directed to OED staff attorneys:

Jennifer Harchick, Emily Sprague, Gerard Taylor, Kim Weinreich, Charlema Grant

Email: lawschoolinformation@USPTO.GOV

Phone: 571-272-4097

VI. Application Review Process

OED may request additional information throughout the application process from law school clinics submitting applications. The law school clinics should timely respond to any OED inquiry by any imposed deadline. Failure to timely respond to an OED inquiry may delay the law school's acceptance into the Program or result in the refusal of the law school's admission to the Program.

VII. Notification and Acceptance into the Program

Law school clinics selected for participation in the Program will be notified after review of the application and any supplemental materials submitted in support of the application.

After a law school clinic has been accepted into the Program and has begun participation in the Program, each semester, the law school clinic will be asked to provide a list of participating law school clinic students and a student application with supporting documentation for each participating law school clinic student. Further, as stated herein, the law school dean, or one authorized to act for the dean, will be asked to attest to each law school clinic student's eligibility, good standing, and moral character. *See Section IV., Part B, supra.*

VIII. After Acceptance into the Program

Renewal

After commencing participation in the Program, each participating law school desiring to continue in the Program shall, biennially from a date assigned to the law school by the OED Director, submit a renewal application to OED in accordance with criteria set forth by the OED Director. *See 37 C.F.R. § 11.16(b)(2).*

Reporting Requirements

Each law school participating in the Program shall, on a semi-annual basis, provide OED with a report regarding its clinic activity during the reporting period, which shall include:

- (1) The number of law students participating in each of the patent and trademark practice areas of the school's clinic;
- (2) The number of faculty participating in each of the patent and trademark practice areas of the school's clinic;
- (3) The number of persons to whom the school's clinic provided assistance in any given patent or trademark matter but with whom no practitioner-client relationship had formed;
- (4) The number of client representations undertaken for each of the patent and trademark practice areas of the school's clinic;
- (5) The identity and number of applications and responses filed in each of the patent and/or trademark practice areas of the school's clinic;
- (6) The number of patents issued, or trademarks registered, to clients of the clinic; and
- (7) All other information specified by the OED Director.

See 37 C.F.R. § 11.17(b).

Training Webinar

Each year, all clinic directors and faculty clinic supervisors are required to participate in a mandatory training webinar. This webinar provides clinic directors and faculty clinic supervisors with important information on the Program including, but not limited to, new and updated requirements, policies, and procedures; Program statistics; Program reminders; and substantive information regarding clinics, supervisors, students, student applications, and participation in the Program.

Visits to Law Schools

OED representatives visit law school clinics in the Program on a periodic basis as part of its outreach to the participating schools and to promote open communication between the participating schools and the USPTO. During the visits, OED representatives meet

with law school deans, clinic directors, and faculty clinic supervisors to discuss the operation of the clinic and the Program; meet with clinic students to discuss their clinical experiences and opportunities at the USPTO; and meet with non-clinic students to discuss the benefits of participating in their law school's clinic and opportunities at the USPTO.

IX. USPTO Employees

Current USPTO employees are not eligible to participate in the USPTO Program. The law school dean, clinic director, and/or the faculty clinic supervisor(s) should inform students in advance that USPTO employees are not eligible to participate in this Program.

*** Former USPTO employees should note that all Post Employment statutes and regulations apply, including 18 U.S.C. § 207.

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APPLICATION

INSTRUCTIONS: OED will evaluate submissions of law schools having a patent clinic and/or a trademark clinic or developing a patent clinic and/or a trademark clinic as part of an existing entrepreneurial, business, or intellectual property clinic, that wish to participate in the Program. In order to evaluate each law school's clinic to determine acceptance into the Program, OED requests that interested law schools provide the requested information and documents to allow OED to evaluate the law school clinic for consideration in the Program. The information may be provided in any format chosen by the school. The requested information and supporting documents are detailed below followed by sample format(s) for submitting the information.

*****For law schools applying for participation in both the patent portion and the trademark portion of the Program, please complete a SEPARATE application for each of the patent clinic and the trademark clinic.*****

(1) General Information

OED requests the following information regarding the law school, intellectual property curriculum, law school clinic, law school dean, law school clinic director, and faculty clinic supervisor(s).

Part A. Law School

Please provide OED with the contact information for the law school.

<p><u>Law School</u></p> <p>Law School Name: _____</p> <p>Address: _____ _____</p> <p>City, State, Zip: _____</p> <p>URL (Web-site) address: _____</p> <p>ABA accreditation and date: _____</p>

Part B. Intellectual Property Curriculum

Please describe, in detail, the types of intellectual property classes offered by the law school and any prerequisite courses required for a law school student's participation in the law school clinic. Please include course catalogs, course descriptions, faculty biographies, and any other relevant information. Please use a separate sheet, if necessary.

<p><u>Intellectual Property Curriculum</u></p> <p>Patent Classes Offered: _____</p> <p>Trademark Classes Offered: _____</p> <p>Other Intellectual Property Classes Offered: _____ _____</p> <p>Clinic Prerequisites (if any): _____</p>

Part C. Law School Clinic

Please provide OED with the following information for the law school clinic. Please provide any relevant brochures or other written materials explaining the clinic or proposed clinic. Please use a separate sheet, if necessary.

<p><u>Law School Clinic</u></p> <p>Title of Clinic: _____</p> <p>Type of Clinic: <u>Patent Clinic or Trademark Clinic</u> _____</p> <p>Semester(s) Clinic Offered (Fall / Spring / Summer): _____</p> <p>Clinic Credit Hours Available Per Semester: _____</p> <p>Hours Per Week Required for Clinical Practice: _____</p> <p>Number of Semesters Students are Permitted to Participate: _____</p> <p>Clinic Mailing Address: _____ _____</p> <p>City, State, Zip: _____</p> <p>Office Phone: _____</p> <p>E-mail: _____</p>
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Part D. Law School Dean

Please provide OED with the contact information and any other relevant information for the law school dean. Please have the law school dean read, sign, and date the certification set forth below.

<p><u>Law School Dean</u></p> <p>Dean Name: _____</p> <p>Address: _____ _____</p> <p>City, State, Zip: _____</p> <p>Phone: _____</p> <p>E-mail: _____</p> <p>I agree to the USPTO requirements for participation in the Program. I will certify, or one designated to act on my behalf will certify, that: (1) each participating law school clinic student has successfully completed his/her first year of law school or the equivalent; (2) each participating law school clinic student is in compliance with the law school's ethics code and is of good moral character and reputation; (3) the school has a process that ensures that no conflicts exist in the representation of clinic clients; and (4) each law school clinic student meeting these requirements will submit the required student application form each semester that such students are participating in the clinic.</p> <p>Signature: _____ Date: _____</p>
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Part F. Faculty Clinic Supervisor(s)

Please provide OED with the following information and certification for each proposed faculty clinic supervisor. Please provide a curriculum vitae and other relevant information for each proposed faculty clinic supervisor.

Faculty Clinic Supervisor(s)

(One for each proposed faculty clinic supervisor)

Name: _____

Address: _____

City, State, Zip: _____

Phone: _____

E-mail: _____

State Bar Membership: _____

State Bar License Number: _____

USPTO Registration Number (**Patents only**): _____

Faculty Clinic Supervisor(s) (CONT'D)

(One for each proposed faculty clinic supervisor)

For patent clinic:

- I possess at least three years of experience in prosecuting patent applications before the USPTO within the last five years. **(Patent clinic)**

For trademark clinic:

- I possess at least three years of experience in prosecuting trademark applications before the USPTO within the last five years. **(Trademark clinic)**

Name: _____

Signature: _____

Date: _____

Faculty Clinic Supervisor(s) (CONT'D)

(One for each proposed faculty clinic supervisor)

As faculty clinic supervisor, I agree to the requirements for participation in the USPTO Program and to the following:

INITIAL

- A. Faculty clinic supervisor will submit a signed agreement confirming adequate supervision of the law school clinic students, as set forth herein. _____
- B. Faculty clinic supervisor must ensure that a conflict of interest check is performed for each law school clinic student and each client or potential client of the clinic. _____
- C. Faculty clinic supervisor is responsible for instructing, mentoring, overseeing, and supervising all participating law school clinic students in the Program. _____
- D. Faculty clinic supervisor is responsible for the content and timeliness of all applications and documents submitted to the USPTO by the clinic. _____
- E. Faculty clinic supervisor is responsible for all oral and written communications by participating law school clinic students to the USPTO and clinic clients. _____
- F. Faculty clinic supervisor shall discuss, review, and approve all documents signed by law school clinic students from the participating law school clinic prior to submission to the USPTO; participation in the Program requires that all submissions to the USPTO be reviewed and approved by a faculty clinic supervisor(s) prior to filing with the USPTO. _____
- G. Faculty clinic supervisor agrees to be an attorney of record on all patent and/or trademark applications filed in the USPTO. _____
- H. Faculty clinic supervisor must read and be familiar with the USPTO ethics rules (see 37 C.F.R. § 11.101 et seq.); the relevant sections of the USPTO's procedural rules; and the USPTO's Program rules (see 37 C.F.R. §§ 11.16 and 11.17), requirements, and procedures and ensure that law school clinic students do the same. _____
- I. Faculty clinic supervisor must maintain a written record of all documents submitted to the USPTO by law school clinic students. _____
- J. Upon request, faculty clinic supervisor(s) must submit a list biannually to OED of the reporting requirements set forth in 37 C.F.R. §§ 11.17(b). _____

Name: _____

Signature: _____

Date: _____

(2) Requirements For All Law School Clinics

OED requests the following information and supporting documentation from each law school clinic. Please address each of the following requests in order and specifically refer to each of the lettered paragraphs. (Please note that if the law school is establishing a clinic for this Program, address each question as how each process, procedure, etc. will be implemented in the law school's proposed clinic.)

- A. Provide proof of ABA accreditation.
- B. Describe how individual inventors and small business clinic clients shall receive services on a *pro bono* basis.

NOTE: Law school clinics are required to provide their patent and/or trademark legal services on a *pro bono* basis. The clinic may require clients to pay all required government fees.

- C. Describe the client base that the clinic serves or will serve.
- D. Describe any type of public outreach by the clinic, including outreach performed in order to obtain clients and serve the public by providing patent and/or trademark legal services to individuals and small businesses.
- E. Explain the ability of the law school clinic to partner in either a direct or secondary capacity with AIA *pro bono* regional programs.
(<http://www.uspto.gov/inventors/proseprobono/>)

NOTE: The AIA directs the USPTO to "work with and support intellectual property law associations across the country in the establishment of *pro bono* programs." The USPTO has actively worked with regional organizations to establish *pro bono* programs throughout the country. Law school clinics are encouraged to engage with these programs. This engagement can be, for example, assistance to the *pro bono* programs or as a secondary program serving those inventors and small businesses that do not meet certain requirements of the AIA *pro bono* programs. The law school clinic may explore partnering or coordinating with the AIA *pro bono* program in the school's region.

- F. Explain when the clinic will be ready to commence entry in the Program (*i.e.*, fall 2020 semester, spring 2021 semester). Clinics must provide OED with the academic semester when the law school will be ready to commence participation in the Program.
- G. Demonstrate that the law school currently has an established law school clinic serving clients in either an intellectual property law or entrepreneurship/business law clinic providing pro bono legal services or explain how such a clinic will be established and ready to accept students and clients by the date provided in subparagraph F, above.
- H. Describe the format and structure of the clinic including, but not limited to, any classroom/coursework portion and the clinical portion thereof.
- I. Provide a listing of any patent and/or trademark applications currently being prosecuted by the law school clinic.

For patent applications, please include the application number, filing date, title of the invention, inventor's name, and examiner's name.

For trademark applications, please include the application number, filing date, mark, owner's name, and examiner's name.

- J. Describe in detail the law school clinic's case transfer protocol, *i.e.*, the clinic's written plan for transferring cases from outgoing students to the faculty clinic supervisor and/or the next responsible clinic student(s).

NOTE: The law school clinic's faculty clinic supervisor agrees to assume responsibility for all client applications, including where clinic students are not available for assignment of the case file.

- K. Confirm that each law school clinic will comply with all Program rules, regulations, and procedures.
- L. Provide any additional information and documents that the law school wishes to be considered.

(3) Additional Requirements for Patent Clinics (PATENT CLINICS ONLY)

For the patent portion of the Program, OED requests the following information and supporting documentation from each law school clinic. Please address each of the following requests in order and specifically refer to each of the lettered paragraphs. (Please note that if the law school is establishing a clinic for this Program, address each question as how each process, procedure, etc. will be implemented in the law school's proposed clinic.)

- A. Demonstrate that the clinic has a faculty clinic supervisor(s) who is a registered patent practitioner, *i.e.*, one who is authorized to practice before the USPTO in patent matters. The clinic must also demonstrate that the faculty clinic supervisor(s) has at least three years of experience in prosecuting patent applications before the USPTO within the last five years.
- B. Describe how the law school clinic students shall counsel the patent clients regarding the process for obtaining a patent.
- C. Describe how each client receiving patent legal services through the patent clinic shall receive a patentability search and counsel regarding the results of the search for each proposed invention prior to filing a nonprovisional patent application.

It is permissible for law school clinics participating in the patent portion of the Program to file a provisional patent application with the USPTO for a client's proposed invention prior to providing the client with a patentability search and counsel as to the results, if the faculty clinic supervisor determines that this is a best practice to protect the client's rights in the proposed invention. The law school clinic must keep the client informed of any relevant information obtained in the process of preparing and filing the provisional patent application. Upon filing the provisional patent application, the law school clinic must then provide the client with a patentability search, provide the client with the results, and counsel the client as to the results for each proposed invention as soon as possible after the filing of the provisional patent application, but generally within 90 days from the filing of the provisional application.

D. By initialing each subparagraph below, the law school clinic confirms the requirement set forth in each subparagraph:

INITIAL

- The faculty clinic supervisor shall be the attorney of record on all patent applications filed by the law school clinic. _____

NOTE: Clinic students cannot be the primary attorney of record in patent applications. Clinic students may only be the secondary attorneys in patent applications.

- The law school clinic agrees to file patent applications and other documents within the USPTO electronically via the USPTO electronic filing system. If the USPTO electronic filing system is not operational, patent applications and documents therein may be filed by paper. _____

- The law school clinic will establish one customer number. _____

Each semester, the faculty clinic supervisor and all participating law school clinic students granted limited recognition numbers will be listed under the clinic's customer number. The clinic's customer number must be updated each semester to reflect the law school clinic students participating in the clinic in the Program. The faculty clinic supervisor must always be listed on the clinic's customer number when clinic students are listed thereon.

- Each participating law school clinic student who receives limited recognition and who may file a patent application or other document with the USPTO will obtain a MyUSPTO.gov account. _____

- Each patent clinic will conduct a patentability search, provide the client with the results, and counsel the client as to the results for each proposed invention prior to filing a nonprovisional patent application therefor. _____

Name: _____

Date: _____

Signature: _____

(4) Additional Requirements for Trademark Clinics (TRADEMARK CLINICS ONLY)

For the trademark portion of the Program, OED requests the following information and supporting documentation from each law school clinic. Please address each of the following requests in order and specifically refer to each of the lettered paragraphs. (Please note that if the law school is establishing a clinic for this Program, address each question as how each process, procedure, etc. will be implemented in the law school's proposed clinic.)

- A. Demonstrate that the law school clinic has a faculty clinic supervisor who is a member in good standing of the highest court of any state. The clinic must also demonstrate that the faculty clinic supervisor(s) has at least three years of experience in prosecuting trademark applications before the USPTO within the last five years.
- B. Describe how the law school clinic students shall counsel the trademark clients regarding the process for obtaining a trademark registration.
- C. Describe how each client receiving trademark legal services through the trademark clinic shall receive a registerability search and counsel regarding the results of the search for each proposed trademark prior to filing a trademark application.

D. By initialing each subparagraph below, the law school clinic confirms the requirement set forth in each subparagraph:

INITIAL

- The faculty clinic supervisor shall be the attorney of record on all trademark applications filed by the law school clinic. _____

NOTE: Clinic students cannot be the attorney of record in trademark applications. Clinic students may only be the "Other Appointed Attorneys" in trademark applications.

- The law school clinic agrees to file trademark applications and documents therein electronically using either the TEAS or TEAS Plus System. _____

- Confirm that the law school clinic will use a USPTO-assigned school tracking code on each trademark application and document filed by the clinic in the Program. _____

Upon acceptance into the Program, each law school clinic will be assigned a school-specific tracking code.

- Confirm that each participating law school clinic student who receives limited recognition and who may file a trademark application or other document with the USPTO will obtain a MyUSPTO.gov account. _____

- Confirm that each trademark clinic will conduct a registerability search, provide the client with the results, and counsel the client as to the results for each proposed trademark prior to filing a trademark application therefor. _____

Name: _____

Date: _____

Signature: _____

******* End of Application *******