

2015

Institutionalizing the USPTO Law School Clinic Certification Program for Transactional Law Clinics

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Jennifer S. Fan, *Institutionalizing the USPTO Law School Clinic Certification Program for Transactional Law Clinics*, 19 LEWIS & CLARK L. REV. 327 (2015), <https://digitalcommons.law.uw.edu/faculty-articles/597>

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INSTITUTIONALIZING THE USPTO LAW SCHOOL CLINIC
CERTIFICATION PROGRAM FOR TRANSACTIONAL LAW
CLINICS

by
Jennifer S. Fan**

With 188 transactional law clinics nationwide and the United States Patent and Trademark Office (“USPTO”) Law School Clinic Certification Program (“Program”) recently established as a statutory program of the USPTO, this Article argues that every transactional clinic that works on trademark and patent applications should apply to become part of the Program. In satisfying the participation requirements of the Program, transactional law clinics will usher in a new, uniform way to educate aspiring intellectual property attorneys. As a result, law students will not only be “practice ready,” but also more effective attorneys once they are in practice. Participating in the Program benefits the clinic, law student, and client. The Article examines those benefits and the different models of organization that clinics should consider under the Program and discusses the benefits of participating in the Program. Then, it reviews the advantages and drawbacks of each model. Additionally, the Article explores alternative ways in which transactional law clinics can undertake trademark and patent projects if the clinic is not involved in the Program.

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INTRODUCTION

In 2008, the United States Patent & Trademark Office (the "USPTO") launched the Law School Clinic Certification Pilot Program (the "Pilot Program") with six schools, focused on patents or trademarks.¹ Two years later, in 2010, 10 additional law school clinics were selected for the trademark portion of the Pilot Program.² In 2012, the Pilot

¹ Press Release, USPTO, Students Given Opportunity to Practice Intellectual Property Law Before the USPTO through Law School Clinic Programs (Jul. 22, 2008), *available at* http://www.uspto.gov/news/pr/2008/08_28.jsp (describing opportunities available to law students through clinical programs).

² Press Release, USPTO, USPTO Expands Law School Clinic Certification Pilot Program (Feb. 27, 2014), *available at* <http://www.uspto.gov/news/pr/2014/14-02.jsp> (providing historical information on the Program).

Program expanded to include 11 law school clinics for the patent portion and nine for trademark.³ In 2014, 19 law school clinics were added to the program.⁴ More than 1,400 law school students have participated as of the end of the 2013–2014 academic year.⁵ According to the USPTO, 45 law schools were selected to participate in the Pilot Program.⁶ The active programs are divided as follows: 17 law schools in both the patent and trademark portions of the Program, 19 in trademark only, and 6 in patent only.⁷ As of December 2014,⁸ the Pilot Program became a permanent statutory program under H.R. 5108, a bill introduced by Rep. Hakeem S. Jeffries (D-N.Y.) in the U.S. House of Representatives on July 15, 2014 (the “Program”).⁹

The purpose of the Program is to give law students in the participating clinical program the opportunity to practice patent and/or trademark law before the USPTO under the supervision of a Law School Faculty Clinic Supervisor, as defined under the terms of the Program.¹⁰ On

³ *Id.*

⁴ *Law School Clinic Certification Pilot*, USPTO, http://www.uspto.gov/ip/boards/oed/practitioner/agents/law_school_pilot.jsp. Some law schools have both trademark and patent law clinics housed within one clinical program. Therefore, the number of law schools added in a particular year is less than the number of law school clinics added.

⁵ *USPTO Law School Clinic Certification Pilot Program Q&A—Current Status of the Program*, USPTO (Jul. 28, 2014), http://www.uspto.gov/ip/boards/oed/practitioner/agents/QA_Current_Status_of_the_Program.pdf [hereinafter *Pilot Program Q&A*].

⁶ *Id.*

⁷ *Law School Clinic Certification Pilot*, *supra* note 4 (listing participating schools). A map available on the USPTO website is reproduced *infra* as Appendix A.

⁸ See E-mail from William R. Covey, Deputy Gen. Counsel for Enrollment & Discipline & Dir. of the Office of Enrollment & Discipline (Dec. 17, 2014) (on file with author) (informing law schools participating in the Pilot Program of the signing of H.R. 5108).

⁹ H.R. 5108, 113th Cong. (2014). “An expanded clinical certification program will provide law students throughout the country with invaluable practical experience in the highly technical fields of patent and trademark law Our bipartisan legislation will help insure that the legal expertise exists for the next generation of inventors, tech entrepreneurs and small businesses in the technology and innovation sectors.” Press Release, U.S. Congressman Hakeem Jeffries, Reps. Hakeem Jeffries and Steve Chabot Introduce Bipartisan Legislation to Expand the USPTO Law School Clinic Certification Program (July 16, 2014) (internal quotation marks omitted), available at <http://jeffries.house.gov/media-center/press-releases/reps-hakeem-jeffries-and-steve-chabot-introduce-bipartisan-legislation>. The bill was passed in the House of Representatives on September 15, 2014 and the next day it was referred by the Senate to the Committee on the Judiciary. H.R. 5108, 113th Cong. (2014), available at <https://www.congress.gov/bill/113th-congress/house-bill/5108/all-actions>.

¹⁰ See *id.* The Law School Faculty Clinic Supervisor for both the patent and trademark portion of the Program must be in good standing and have at least three years of practice experience within the past five years before the USPTO. *Law School Clinic Certification Pilot Program Patent Clinic Requirements*, USPTO [hereinafter *Patent Clinic Requirements*], available at <http://www.lawupdates.com/pdf/postings/patent/>

behalf of a law clinic's clients, students conduct searches, give clients advice with respect to their intellectual property needs, draft and file patent and/or trademark applications, and represent clients before the USPTO. For example, students may have the opportunity to respond to Office Actions and communicate with patent examiners or trademark examining attorneys about applications filed by the law school clinic. While law schools who do not participate in the Program could have their students do work similar to what is described above, they would not have the benefits of expedited review and limited recognition to practice before the USPTO.

This Article argues that every law school that prepares trademark or patent applications should apply to the Program if it has appropriate resources in place to administer the program. Transactional law clinics typically handle a variety of legal issues on behalf of clients. Depending on the client base and focus of a certain clinic, intellectual property questions may arise frequently, particularly patent and trademark issues. The opportunity to work with the Program is beneficial to transactional law clinics, their students, and their clients for several reasons. In the case of transactional law clinics, being part of the Program burnishes the national reputation of the clinic in intellectual property ("IP"), increases the visibility of the clinic, and creates a closer relationship with the USPTO and other law school clinics that participate in the Program. Law students benefit from the Program because it standardizes how they are trained and gives them the opportunity to receive limited recognition to practice in the areas of trademark or patent law. For clients, the Program expedites the USPTO's review of their patent application under certain circumstances and leads to a quicker review generally for both patent and trademark applications. This Article acknowledges that there are also challenges associated with meeting the rigorous requirements of the Program, and that transactional law clinics may seek other ways to give students this type of experience.

Part I of this Article examines the different transactional clinic models that schools use to participate in the Program and the benefits of participating in the Program. Part II discusses the advantages and drawbacks of working with each model, which clinicians should consider when evaluating which model might work the best with the way their particular transactional law clinic is structured. Part III identifies integration challenges with doing trademark or patent work through the Program. Part IV provides a roadmap for how a law school clinic can put the mechanisms in place to practice trademark and patent law as part of the Program.¹¹ Finally, recognizing that not all transactional law clinics can par-

USPTO%E2%80%99s_Law_School_Clinic_Certification_Pilot_Program.pdf. See Requirement 2, *supra* Part I.B.

¹¹ In relation to Part IV, an example handbook that demonstrates how the roadmap can be actualized is available at <http://www.law.washington.edu/Clinics/Entrepreneurial/students/default.aspx?vw=skills>.

ticipate in the Program, Part V provides ways in which trademark and patent law work can be undertaken.

I. TRANSACTIONAL LAW CLINIC MODELS & MOTIVATIONS TO PARTICIPATE

A. *Four Models*

The transactional law clinics that participate in the Program fall into four general categories of substantive focus: 1) patent-only clinic; 2) trademark-only clinic; 3) IP-only clinic; or 4) transactional law clinic. Although the Program initially selected clinics from 45 law schools to participate in the Program, not all of them are currently participating in the program. The metrics in the following section are based on the 42 law schools currently participating in the Program as listed on the USPTO website.¹²

1. Patent-Only Clinics

Of the 23 law schools that currently do patent work¹³ through the Program, 6 work exclusively on patent applications, 1 of which has a separate Small Business and Trademark Clinic as well. ("Model 1").¹⁴

¹² See *Law School Clinic Certification Pilot*, *supra* note 4 (listing the 42 participating schools in the Program). The USPTO reports, however, that there are 45 law schools in the program. See *Pilot Program Q&A*, *supra* note 5. The author ascertained that the University of Maine School of Law, Michigan State University College of Law, and the University of Richmond School of Law, which were originally included in the 45 law schools, are not included in the participating schools list. Based on information available at the respective websites of University of Maine School of Law and University of Richmond School of Law, these two schools have suspended their programs. Based on e-mail correspondence from Michigan State University College of Law, its clinic is on hiatus and not currently participating in the Program. E-mail from Sean Pager, Assoc. Professor of Law & Assoc. Dir. of Intellectual Prop., Info. & Commc'ns Law Program, Mich. State Univ., to Farah Ali, Research Assistant, Univ. of Wash. Sch. of Law (Oct. 23, 2014) (on file with author).

¹³ Patent work is limited to utility patents under the Program. "Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof . . ." *General Information Concerning Patents: What Is a Patent?*, USPTO (Oct. 2014), http://www.uspto.gov/patents/resources/general_info_concerning_patents.jsp#heading-2 (emphasis omitted).

¹⁴ This information is current as of October 24, 2014 and does not include three law schools which are not currently participating in the Program: Michigan State University College of Law, University of Maine School of Law, and University of Richmond School of Law. See E-mail from Sean Pager, *supra* note 12. Based on information culled from the websites of all ABA-accredited law schools, the number of transactional law clinics is 188 as of August 1, 2014. The six schools that have only patent clinics are: Arizona State University Sandra Day O'Connor College of Law, North Carolina Central University School of Law, Southern Methodist University Dedman School of Law, The John Marshall Law School, University of Detroit Mercy School of Law, and Wayne State University Law School; Southern Methodist

2. Trademark-Only Clinics

Of the 36 law schools that currently do trademark work through the Program, 4 focus exclusively on trademark applications. ("Model 2").¹⁵

3. IP-Only Clinics

Ten law schools in the Program have IP only clinics that do trademark and patent applications along with other areas of IP law, such as copyright, trade secrets, and licensing. ("Model 3").¹⁶

4. Transactional Law Clinics

Not surprisingly, a number of the law schools participating in the Program are so-called hybrid clinics. In essence, hybrid clinics are clinics in which patents and trademark are but one aspect of IP law that the law students tackle; issues of corporate law, tax law, and employment law may be covered as well. ("Model 4"). Currently, 23 law schools fall in this category.¹⁷

University Dedman School of Law has a separate Small Business and Trademark Clinic.

¹⁵ This information is current as of October 24, 2014 and does not include three law schools which are not currently participating in the Program: Michigan State University College of Law, University of Maine School of Law, and University of Richmond School of Law. See E-mail from Sean Pager, *supra* note 12. The four law schools that fall into this category are: California Western School of Law, Howard University School of Law, South Texas College of Law, and University of Akron School of Law.

¹⁶ This information is current as of October 24, 2014. Categorizations are based on descriptions on the websites of the law schools participating in the Program and not on communications with any representatives from the law schools. The ten law schools are: American University Washington College of Law, Case Western Reserve University School of Law, Fordham University School of Law, Lincoln Law School of San Jose, Rutgers University School of Law–Newark, University of California at Los Angeles School of Law, University of Maryland Francis King Carey School of Law, University of San Francisco School of Law, Vanderbilt University Law School, and William Mitchell College of Law.

¹⁷ This information is current as of October 24, 2014. Categorizations are based on descriptions on the websites of the law schools participating in the Program and not on communications with any representatives from the law schools. The 23 law schools are: Brooklyn Law School, Indiana University Maurer School of Law, Lewis & Clark Law School, Loyola University Chicago School of Law, New York Law School, Northwestern University School of Law, Roger Williams University School of Law, Saint Louis University School of Law, Southern Methodist University Dedman School of Law, Texas A&M University School of Law, George Washington University Law School, Thomas Jefferson School of Law, University of Connecticut School of Law, University of Colorado Law School, University of Idaho College of Law, University of New Hampshire School of Law, University of North Carolina School of Law, University of Notre Dame Law School, University of Puerto Rico School of Law, University of Tennessee College of Law, University of Washington School of Law, West Virginia University College of Law, and Western New England University School of Law. Southern Methodist University Dedman School of Law has a separate patent clinic.

B. Benefits of Participating in the USPTO Program

There are several reasons why clinics participate in the Program. These reasons will be examined through the perspectives of clinics, law students, and clients. In order to better understand the benefits, it is important to understand the requirements of the Program as it articulates a roadmap of what the USPTO views as good practices in the areas of trademark and patent law. Some of the requirements of the trademark portion of the Program are as follows:

A. Law School Clinic

(1) In order to participate in the Trademark Law Program the law school must administer the program through the school's law clinic.

(2) The law clinic supervising attorney must be an individual who is a member in good standing of the highest court of any State, and have three or more years of experience practicing within the last five years before the agency.

(3) The law clinic supervising attorney will submit a signed agreement confirming adequate supervision of the students.

(4) The school will submit the clinic's written plan for transferring cases from outgoing students to the law clinic supervising attorney or the next responsible student. The law clinic supervising attorney agrees to assume responsibility for client applications where students are not available for assignment of the case file.

(5) The law clinic director will certify that each participating student lacks any conflict of interest for working on cases in the Trademark Law Program.

(6) The Law School Dean will certify that each student possesses good moral character by certifying that the student is in compliance with the school's ethics code.

....

(9) Each law clinic program will agree to comply with the Trademark Law Program administrative requirements as further defined upon acceptance into the program.

B. Client Services

(10) All individual inventors and small business clinic clients shall receive legal services on a pro bono basis.

(11) Each client receiving trademark legal services through the Trademark Law Program shall receive an advisory opinion relating to eligibility for registration.

(12) To promote affordable intellectual property legal services to individuals and small businesses, the USPTO encourages law schools participating in the trademark law school clinic certification program to engage with pro bono lawyer programs or other organizations that provide services on a pro bono basis. Exam-

ples of such organizations may include non-profit artist associations or non-profit small business support groups. Please explain the ability of the law school clinic to partner in either a direct or secondary capacity with regional programs.¹⁸

Some requirements of the patent portion of the Program are as follows:

A. Law School Clinic

(1) In order to participate in the Patent Law Program, the law school must administer the program through the school's law clinic.

(2) The law clinic supervising attorney must be a registered practitioner in good standing with the USPTO, and have three or more years of experience practicing within the last five years before the agency.

(3) The law clinic supervising attorney will submit a signed agreement confirming adequate supervision of the students.

(4) The school will submit the clinic's written plan for transferring cases from outgoing students to the law clinic supervising attorney or the next responsible student. The law clinic supervising attorney agrees to assume responsibility for client applications where students are not available for assignment of the case file.

(5) The law clinic director will certify that each participating student lacks any conflict of interest for working on cases in the Patent Law Program.

(6) The Law School Dean will certify that each student possesses good moral character by certifying that the student is in compliance with the school's ethics code.

....

(10) Each law clinic program will agree to comply with the Patent Law Program administrative requirements as set forth herein.

B. Client Services

(11) All individual inventors and small business clinic clients shall receive legal services on a pro bono basis.

(12) Each client receiving patent legal services through the Patent Law Program shall receive a patentability search and opinion for each proposed invention.

¹⁸ The trademark requirements were located on the USPTO website but are no longer accessible. *Law School Clinic Certification Pilot Program Trademark Clinic Requirements*, USPTO. On file with *Lewis & Clark Law Review* [hereinafter *Trademark Clinic Requirements*].

(13) The law school clinic shall certify that the clinic students counseled the patent client regarding the process for obtaining a patent.¹⁹

The requirements can generally be grouped as follows: administration of the program through the school's law clinic; standards for supervisors and supervisory efforts ("Requirement 1"); transition protocol ("Requirement 2"); no conflicts of interest ("Requirement 3"); good moral character ("Requirement 4"); compliance with Program administrative requirements ("Requirement 5"); legal services offered on a pro bono basis ("Requirement 6"); advisory opinion on trademarks and patentability search and opinion for each proposed invention ("Requirement 7"); engaging with community ("Requirement 8" (applies to trademarks only)); and counseling client regarding patent process ("Requirement 9" (applies to patents only)).

1. *Benefits to Clinic*

a. *Improved Reputation of Law School's IP Program*

First, the rigorous application process incentivizes the law clinic applicant to review the structure of its IP program on a law school-wide basis and the way experiential learning is incorporated into the IP portion of its clinic. A successful application also confirms the robust IP offerings of a clinic since that is one of the criteria to be accepted into the Program.²⁰ Accordingly, by having participating clinics in the Program, a law school can burnish its reputation as a leader in IP law. In a recent survey of participating law schools conducted by the UW School of Law Entrepreneurial Law Clinic ("ELC"), 33% of responding members of the law schools indicated that they had seen an improved national reputation in IP law.²¹

b. *Increased Visibility of Clinic*

Second, the visibility of each clinic affiliated with the USPTO through the Program increases on a number of fronts. When a clinic is

¹⁹ See *Patent Clinic Requirements*, *supra* note 10.

²⁰ The Selection Committee, which reviewed applications from law schools for the Trademark Law School Clinic Certification Program, has noted "exemplary aspects of the selected schools' programs such as strong IP curriculum supporting the students' hands-on learning." Letter from William R. Covey, Deputy Gen. Counsel for Enrollment & Discipline & Dir. of the Office of Enrollment & Discipline, USPTO, to Jennifer S. Fan (Jul. 27, 2012) (on file with author).

²¹ This information is reflected in the results of a survey on participating law schools' experiences with the Program. The survey was created by the UW School of Law ELC and sent via e-mail to the law clinics of various schools which currently participate in the Program. This particular statistic is based on 32 total responses to question six, which asked, "In what ways has your institution benefited from being with the USPTO Program?" Participants were allowed to select multiple answers. USPTO Patent and Trademark Law Programs Survey (Oct. 3, 2014) [hereinafter ELC Survey] (unpublished survey) (on file with author).

accepted into the Program, it is listed on the USPTO website.²² While the USPTO does not endorse one clinic over another, it provides email addresses to each law school participating in the Program, thereby giving more visibility to a law school's clinic on national and statewide levels.²³ The USPTO also directs individuals who are interested in patent or trademark assistance to reach out to the schools participating in the Program for further information.²⁴ The law school, law school administration, law students, prospective law students, and alumni are also other constituencies which become more aware of a clinic through its participation in the Program.²⁵

In addition, the number of attorneys from the local bar of a participating law school who are interested in doing pro bono work will increase, thereby raising the stature of a particular clinic within the legal community.²⁶ In particular, students are able to network with attorneys in fields of law that they are interested in which may lead to job prospects.

Having a connection with the USPTO also gives participating clinics a valuable community outreach tool. It affords clinics the chance to broaden their client base and get credibility within diverse new communities.²⁷ This is particularly important if the clinic is on soft money since one of the criteria typical of foundation grants is serving a community which is historically underrepresented.

In the survey conducted by the UW School of Law ELC, all responding members of law schools participating in the Program reported an increase in the visibility of their clinics, with 73% noting an increased visi-

²² *Law School Clinic Certification Pilot*, *supra* note 4.

²³ *Law School Clinic Certification, FAQs*, USPTO, http://www.uspto.gov/ip/boards/oed/practitioner/agents/law_school_pilot_faqs.jsp. See also *Law School Clinic Certification Pilot*, *supra* note 4 (listing e-mail addresses for clinics). In the case of the UW School of Law ELC, it went from receiving a few inquiries a month for trademark and patent help to approximately 25 inquiries per month from entrepreneurs located in Washington and out-of-state.

²⁴ *Law School Clinic Certification, FAQs*, *supra* note 23.

²⁵ In the author's experience, law students and prospective law students are interested in the ELC in part because of its ties to the USPTO. Additionally, alumni who work in the areas of trademark and patent law approached the ELC about getting involved in increasing numbers once the ELC was selected to participate in the Program.

²⁶ The ELC experienced a significant uptick in the number of pro bono attorneys on the patent and trademark side who were interested in mentoring students and taking on client work. Since the summer of 2012 when the ELC announced that it was selected to join the Program, the number of patent attorneys and trademark attorneys who participate in the ELC has increased dramatically.

²⁷ For example, in the case of the UW School of Law ELC, we do outreach to the African-American, Asian-American, Latino, Native, LGBTQ, disabled, and veteran communities. Since the ELC is able to promote its affiliation with the USPTO during informational sessions, it gives instant credibility and importance to the work that the ELC is doing on behalf of entrepreneurs. See discussion of Program *supra* Part I.B (Requirement 8 (applies to trademarks only) of community engagement).

bility with their law school specifically, 69% noting increased national visibility, and 67% reporting increased local visibility.²⁸

c. Closer Relationship with the USPTO & Participating Law School Clinics

Of the members of participating law schools who responded to the ELC survey, 70% also indicated a closer relationship with the USPTO as one of the benefits of participating in the Program.²⁹ This is reflective of the USPTO's practice of contacting each of its participating law school clinics in the Program on a regular basis. There is a mandatory conference call for all participants at the beginning of each academic year, which helps the clinics get a sense of the program direction and what is required of the clinics in the upcoming year. In the ELC survey, 58% of responding members of participating law schools indicated that they found these conference calls helpful.³⁰ The USPTO also frequently requests required data for the Program, such as the number of trademark or patent applications filed with the relevant filing information.³¹ Additionally, the USPTO sends representatives for site visits and invites clinic students (both current and past who are still in law school) and school faculty, deans, and directors to participate in a day with the USPTO in Alexandria.³² The USPTO visit includes speakers, roundtable discussions, attending a Trademark Trial & Appeal Board hearing, and faculty and student networking sessions.³³

²⁸ See ELC Survey, *supra* note 21, questions 4 and 5 (asking, respectively, "Do you believe that being in the USPTO has increased the visibility of your clinic?" and "If you responded 'yes' to the question above, in what ways has it increased your visibility?"). These statistics are based on a total of 33 responses.

²⁹ See *id.* question 6.

³⁰ See *id.* question 8 (asking participants to rate the statement "I find the USPTO conference calls helpful"). This statistic is based on a total of 26 responses, and it does not include responses from participants who had not attended a conference call. If all 188 transactional law clinics were involved in the Program, conference calls may need to be divided by regions to have a manageable number of participants. Alternatively, calls could be webcast (similar to continuing legal education seminars) with participants typing in their questions for the facilitator of the conference call.

³¹ This is a good metric to keep in mind generally for a clinic. It also presents an opportunity for clinic faculty to remind students of the "real time" nature of their projects and that they are accountable for keeping the work on track (as opposed to waiting until the end of the quarter or semester, which students often do).

³² E-mail from Jennifer A. Harchick, Staff Attorney, Office of Enrollment & Discipline, USPTO, to participating clinics (Mar. 13, 2014) (on file with author).

³³ *Id.* This past year, the USPTO had preliminary interviews for patent examiner positions for those attending the event who had an undergraduate degree in one of the following areas: Computer Engineering, Electrical Engineering, or Mechanical Engineering. *Id.* The interviews were only conducted in person; no telephone interviews were allowed. *Id.*

The USPTO also facilitates connection between the various clinics participating in the Program.³⁴ This is particularly helpful for those with a focus in IP as it gives the participating law schools an opportunity to build a community to discuss common issues that arise in their representation of clients.³⁵ For example, since October 2013, conference calls have been hosted by California Western School of Law, University of Notre Dame Law School, UW School of Law, and West Virginia University College of Law.³⁶ The next conference call, scheduled for March 2015, will be hosted by Lincoln Law School.³⁷ The conference call topics have included the appropriate balance within the curriculum between experiential and doctrinal learning and how best to achieve that balance, how to select clients to maximize student learning, practice management in the clinic setting, and best practices for electronic client files and records, among others. While attending conference calls is not mandatory, the conferences described above are an economical way to share best practices on a regular basis.

2. *Benefits to Students*

a. *"Practice Ready" Law Students & Standardized Training*

The extensive requirements of the Program are uniformly expected of all law schools participating in the Program in either patents or trademarks or both. Therefore, in order to meet this high bar, the law

³⁴ During the USPTO's Spring 2013 site visit with the UW School of Law ELC, we suggested that it would be helpful to connect the participating law schools in the Program and have conference calls on relevant issues for those participating in the Program. A few months later, this suggestion became a reality when the USPTO sent out an e-mail asking which schools wanted to host a conference call and suggested a number of topics which could potentially be covered. E-mail from James M. Silbermann, Staff Attorney, Office of Enrollment & Discipline, USPTO, to Participating Clinics (Sept. 11, 2013) (on file with author).

³⁵ Theoretically, clinics could reach out to other clinics to discuss issues, but based on the author's experience, this happens on a limited basis and with a small number of people. The conference calls for clinics participating in the Program draw a much larger audience and the conversation incorporates more viewpoints regarding best practices.

³⁶ The conference calls took place on October 22, 2013; January 9, 2014; March 17, 2014; and September 2, 2014. The USPTO would send reminder e-mails that included an outline of the areas to be covered provided by the host school. *See, e.g.*, E-mail from James M. Silbermann, Staff Attorney, Office of Enrollment & Discipline, USPTO, to Participating Clinics (Jan. 2, 2014) (on file with author) (reminding participating clinics of a conference call). On the day of the call, someone from the USPTO would stay on the line to ensure that the call was initiated. She would then leave the call and have the participating law schools talk amongst themselves about the issues described previously.

³⁷ The conference call scheduled for March 26, 2015 is on the topic of Pro Bono Clinics in the Modern Age: How to Function in the Cloud. *See* E-mail from James M. Silbermann, Staff Attorney, Office of Enrollment & Discipline, USPTO, to Participating Clinics (Mar. 3, 2015) (on file with author) (reminding participating clinics of a conference call).

clinics strive to create “practice ready” students in the areas of patent law and trademark law.

For example, Requirement 7 assumes that students are able to draft advisory opinions for trademarks and patentability search and opinion for each invention in the patent realm.³⁸ The reality is that most students have not had any experience drafting such documents and training must be included in the curriculum to ensure that the students can undertake such analyses successfully. Therefore, law school clinics must deliberate on what constitutes appropriate training so that students have the skills necessary to do a trademark analysis (including how to do a trademark search) and draft a trademark application. For example, given the breadth of legal issues—both IP and non-IP—covered in the UW School of Law ELC, reviewing trademarks in depth was not possible within the construct of the clinic. Therefore, in order to meet the requirements of the Program, all UW School of Law ELC students doing trademark work are required to take the Trademark Administration tutorial offered in the Graduate Program on Intellectual Property Law and Practice. The tutorial has been offered for a number of years and is typically taught by two practicing trademark attorneys, one of whom was a former Trademark Examiner at the USPTO.³⁹ Through this tutorial, the students learn the essentials of trademark prosecution and administrative practice. The students take the tutorial prior to working with the supervising attorney on trademark applications. Once completed, the students will then have a training session with the supervising attorney⁴⁰ on how to handle specific files and cases. All case files are maintained on a secure law school server accessible only by ELC and relevant Clinical Law Program staff. Students who work on trademark applications will be assigned a trademark supervising attorney who will manage the day-to-day aspects of the application, including working with the students on the trademark clearance searches, the knockout memo (results of preliminary search using available online resources that identifies any obvious conflicts with proposed mark), and the trademark application.⁴¹

On the patent side, in order to comply with Requirements 6,⁴² 7,⁴³ and 9,⁴⁴ the following patent services for clients are offered pro bono: 1) education about the patent process; 2) prior art searching and patentability analysis; 3) drafting and filing provisional patent applications; 4)

³⁸ See *supra* Part I.B.; *Trademark Clinic Requirements*, *supra* note 18, at 2.

³⁹ When the tutorial was offered in the fall of 2013, only one adjunct professor taught the class due to scheduling conflicts. The adjunct professor was a seasoned trademark attorney.

⁴⁰ See *supra* Part I.B.; *Trademark Clinic Requirements*, *supra* note 18, at 1.

⁴¹ Entrepreneurial Law Clinic, Univ. Wash. Sch. Law, ELC Handbook 9 (Sept. 2014) [hereinafter ELC Handbook] (unpublished manual) (on file with author).

⁴² See *supra* Part I.B.; *Patent Clinic Requirements*, *supra* note 10, at 1.

⁴³ *Id.*

⁴⁴ *Id.* at 2.

drafting and filing non-provisional patent applications; and 5) responding to Office Actions and related communications with examiner.⁴⁵ Meeting such requirements effectively standardizes the expectations of the types of legal analyses that clinics need to undertake to represent a clinic's client.

In order to ensure that students who participate in the patent portion of the Program are practice ready and able to meet Requirement 7,⁴⁶ the UW School of Law ELC requires significant practical experience in a law firm setting as well as course work before students are admitted to the patent portion of the Program.⁴⁷ More specifically, ELC students interested in representing clients in patent matters before the USPTO must be eligible for admission to the patent bar⁴⁸ and have satisfactorily completed a minimum set of intellectual property law coursework. The coursework may include IP Core, Patent Prosecution, and Advanced Patent Law.

The ELC Patent Supervising Attorney is responsible for overseeing each patent project and will match each student with a pro bono patent attorney. Students work under the supervision and guidance of the pro bono patent attorney and the ELC Patent Supervising Attorney. The ELC Patent Supervising Attorney conducts regular meetings with students to review work product and discuss projects. Additionally, the ELC Patent Supervising Attorney and Managing Director ensure that regular meetings occur between students and their assigned pro bono patent attorney.

⁴⁵ In its representation of a client during the initial quarter of representation, the ELC's scope of representation is limited to an audit memo, which includes a comprehensive business and legal analysis. The audit memo provides an analysis of the following: choice of entity, employee versus independent contractor classification, trademark, patent, copyright, trade secrets, tax, and business issues. For example, in the trademark analysis section in the audit memo, the ELC client team will let the client know whether a name would be likely to be registered or not, the fees associated with such registration, and the like. Similarly, on the patent side, the ELC client team looks into the viability of getting a patent on an entrepreneur's invention by doing a patentability search. If the client would like to continue to work with the clinic in subsequent quarters, it must reapply for the ELC's services for a discrete follow-up project, such as a trademark application or patent application. Assuming that the ELC takes on such a project, the prior representation is terminated and a new retainer agreement that covers only the discrete follow-up project is set forth under the section on the scope of representation.

⁴⁶ See *supra* Part I.B.; *Patent Clinic Requirements*, *supra* note 10, at 1.

⁴⁷ This requirement is not mandated by the USPTO, but the ELC believed that it was necessary given the complexity of the subject matter. Therefore, the ELC admits students to the Program on the patent side only if they have worked at a law firm doing patent prosecution during the summer prior to beginning the clinic and have subject-area expertise in areas in which the clinic anticipates it will receive requests to do patent prosecution work. Having substantial coursework in patent prosecution and passing the patent bar are also pluses.

⁴⁸ This requirement is mandated by the USPTO. See *How to Become Registered to Practice Before the USPTO in Patent Matters*, USPTO, <http://www.uspto.gov/ip/boards/oed/exam/grbpage.jsp>.

At a minimum, students engage in weekly meetings with either the ELC Patent Supervising Attorney or their assigned pro bono patent attorney.

The ELC Patent Supervising Attorney, Managing Director of the ELC, and the pro bono attorney train and supervise the students to work with clients on patent matters. The students educate clients about the patent process, learn about the client's potentially patentable innovation, and conduct prior art searches based on the information gathered at these client meetings.

Under the supervision of the pro bono patent attorney and the Patent ELC Supervising Attorney, students participate in all aspects of obtaining a patent, from the initial analysis of patentability, to drafting, editing, and filing provisional and non-provisional patent applications, as well as responding to communications from the USPTO. Also under the supervision of the pro bono patent attorney and the ELC Patent Supervising Attorney, students will counsel clients and respond to Office Actions.

Since the process for obtaining a trademark or patent often takes well beyond the time a student is in the clinic, transition protocol becomes particularly important and is required of Program participants under Requirement 2.⁴⁹ Students are instructed about what to include in the transition memo to ensure that the clinic has an exhaustive application file.⁵⁰ By writing transition memos, students are learning how to: 1) effectively memorialize important parts of the application and the work conducted to date; 2) digest complicated legal processes to its essence; and 3) communicate in a professional manner.

Students participating in the trademark portion of the Program must include the following information for each of the filed trademark applications in their transition memoranda: summary status and upcoming deadlines.⁵¹ In addition, the initial application form, Trademark Application and Registration Retrieval ("TARR")⁵² status, and the Trademark Status and Document Retrieval ("TSDR")⁵³ summary are included as at-

⁴⁹ See *supra* Part I.B.; *Patent Clinic Requirements*, *supra* note 10, at 1.

⁵⁰ See ELC Handbook, *supra* note 41, at 12, 16 (describing transition memos for trademarks and patents, respectively).

⁵¹ See *id.* at 12.

⁵² Since the user community raised concerns about the retirement of "old" TARR, the USPTO continues to service the links to "old" TARR for the time being. See *Retention of "Old" TARR*, USPTO (Jan. 25, 2012), http://www.uspto.gov/trademarks/notices/old_TARR.jsp.

⁵³ See *Frequently Asked Questions*, USPTO, <http://tsdr.uspto.gov/faqview> ("TSDR . . . is a web application that provides real-time access to the electronic file wrapper of U.S. Trademark applications and applications for Extensions of Protection, as well as U.S. Trademark Registrations. It also displays information contained in the USPTO records regarding International Registrations and applications for International Registration filed under the Madrid system through the U.S.A. To access TSDR, all that is necessary is entry of a U.S. application serial number, a U.S. or International Registration number, or a U.S. Reference Number.").

tachments to the memo.⁵⁴ The student who is leaving the clinic should also meet with the client to discuss the status of the application before her departure. On the administrative side, a student should be removed from the trademark application.

Students participating in the patent portion of the Program should also include summary status and upcoming deadlines in their transition memoranda.⁵⁵ The client file will include the initial application form and any Office Actions and responses to such Office Actions. Similar to students participating in the trademark portion of the Program, the student leaving the clinic who is assigned to the client should also meet with the client to discuss the status of the patent application before her departure.

Even if files are well maintained, however, the next student assigned to the client will still need to meet with her supervising attorney (who may be the Director of the Clinic, an adjunct professor, or a pro bono supervising attorney from the community) to discuss the status of the filing and what work the prior student completed to date. Similarly, such a person must oversee the transition process to ensure that: 1) clients are comfortable with the transition; 2) appropriate introductions are made; and 3) no changes have occurred since the completion of the transition memo. Also, while not directly related to the above, during the course of the client relationship, the Director of the Clinic helps to ensure that the client is responsive and that the students are explaining the process, next steps, actions undertaken, and fees as the client matter progresses.

In order to meet Requirement 5,⁵⁶ the Program in patents also requires a docketing system. Therefore, in the case of the UW School of Law ELC, a file and matter number is opened by the Patent Supervising Attorney for each new patent project (existing projects will already be docketed).⁵⁷

Overall, the standardization offered by the Program appears to facilitate the training process for many law clinics. In the survey conducted by UW School of Law ELC, 64% of responding members of law schools par-

⁵⁴ ELC Handbook, *supra* note 41, at 12.

⁵⁵ *Id.* at 16.

⁵⁶ See *supra* Part I.B.; *Patent Clinic Requirements*, *supra* note 10, at 1.

⁵⁷ The Patent Supervising Attorney for the ELC is the Director of Intellectual Property Management at UW CoMotion, which supports commercialization efforts of faculty and researchers throughout the UW. The UW School of Law ELC is able to have the file and matter number docketed into CoMotion's existing system for tracking all patent matters for the UW School of Law ELC. This system is used to keep track of actions and deadlines within a file (counseling, filing patent applications, responses, etc.). The Patent Supervising Attorney keeps a docket report of all matters (new and continuing) to ensure that work is being completed prior to any deadlines, students are assigned to appropriate projects based on technical background and experience, and that clients' needs are met as students transition in and out of the UW School of Law ELC. See *CoMotion*, U. WASH., (2014), <http://commotion.uw.edu>.

ticipating in the Program reported that they could not train their students as effectively without being a part of the program.⁵⁸

b. Students Receive Limited Recognition to Practice

In order to participate in the Program, students must qualify and apply for it so they may receive limited recognition to practice. To this end, the students complete Application Form PTO-158-LS, which also requires verification of Requirements 3⁵⁹ and 4⁶⁰ above, as well as verification that the law student has completed the first year of law school classes.⁶¹ They each receive a temporary practice number which allows them to draft and file trademark and patent applications, answer Office Actions, and communicate with patent examiners and trademark examining attorneys.⁶² All such work by the students is supervised by seasoned practitioners in the clinic setting who guide them through what could be their first trademark or patent application.⁶³ “[L]aw school students . . . practice patent and/or trademark law before the USPTO under the guidance of a Faculty Clinic Supervisor, who is a registered patent attorney or patent agent (Patent portion) or who is a licensed attorney in good standing with the highest court of a State (Trademark portion).”⁶⁴ In essence, when students are prosecuting the application before the USPTO, they are treated as attorneys. As a student in a participating clinic in the Program, there are opportunities to interact with the trademark and patent examiners about Office Actions via conference call, too.

A related benefit to students having the authority to practice before the USPTO is that it gives them a beneficial credential that will help them in their respective job searches. It also makes the students more competitive in the field in which they are interested in practicing.

The Manual of Patent Examining Procedure sets forth that for patent practice before the USPTO, patent examiners should not contact non-registered representatives of the practitioner of rec-

⁵⁸ See ELC Survey, *supra* note 21, question 8 (asking participants to “Please rate the following statements. . . I could train my students equally well without being part of the USPTO program” with answer choices ranging from Strongly Disagree to Strongly Agree). The statistic is based on a total of 33 responses and reflects the combined percentage of participants who chose Disagree or Strongly Disagree.

⁵⁹ See *supra* Part I.B.; *Patent Clinic Requirements*, *supra* note 10, at 1.

⁶⁰ *Id.*

⁶¹ USPTO, FORM PTO-158LS (Sept. 1, 2010), *available at* <http://www.uspto.gov/ip/boards/oed/pto158LS.pdf>.

⁶² See E-mail from William R. Covey, Deputy Gen. Counsel for Enrollment & Discipline & Dir. of the Office of Enrollment & Discipline (Dec. 8, 2014) (on file with author) (explaining the capacity in which students not participating in the Program may participate in Examiner interviews).

⁶³ Clinic students who are in the Program must complete an application to receive a Limited Recognition Number from the USPTO. On the patent side, however, if the student is already a registered practitioner before the USPTO (registered patent agent), she does not need to complete the application.

⁶⁴ *Pilot Program Q&A*, *supra* note 5, at 2.

ord, even if apparently authorized by the attorney or agent of record. . . . Moreover, [USPTO] employees are prohibited from oral or written communication with an unregistered person regarding an application unless it is one in which the person is an applicant. . . . In short, while it is possible that a non-participating clinic law student may listen in on a telephone interview with a patent examiner, [she or he] may not participate in the telephone interview . . . [and] does not have the benefits of a participating student to draft and file trademark and patent applications, to sign and file Office Actions once they issue and to communicate directly with patent examiners and trademark examining attorneys regarding the application.⁶⁵

In accordance with the Code of Federal Regulations, any such unrecognized participation may constitute an unauthorized practice of law before the USPTO.⁶⁶

3. Clients

a. *Expedited Review by the USPTO & Applications Reviewed More Quickly*

One of the biggest benefits of being part of the Program is that the patent applications of clients can be seen on an expedited basis.⁶⁷ Among those law schools responding to the ELC survey, 39% reported benefiting from this expedited basis for review.⁶⁸

Clinics in the Program on the patent side are allowed up to two Requests to Make Special from the USPTO per semester.⁶⁹ Practically, what this means is that the USPTO:

will permit each participating law school to designate up to two applications per academic semester to be advanced out of turn, with additional applications being awarded for advancement of examination on an *ad hoc* basis. Each school must certify that they provide all patent clinic clients with patentability searches and opinions prior to qualifying to receive the two applications advanced out of turn.⁷⁰

⁶⁵ See E-mail from William R. Covey, *supra* note 62.

⁶⁶ See *id.*

⁶⁷ See Memorandum from William R. Covey, Deputy Gen. Counsel for Enrollment & Discipline & Dir. of the Office of Enrollment & Discipline, to Law Schools Participating in the Law School Certification Pilot Patent Program 1 (June 15, 2012), available at http://www.uspto.gov/ip/boards/oed/practitioner/agents/Request_to_Make_Special_Memo.pdf.

⁶⁸ See ELC Survey, *supra* note 21, question 6.

⁶⁹ Memorandum from William R. Covey, *supra* note 67, at 2.

⁷⁰ *Id.* at 1. The Request to Make Special Program does not expedite the entire patent prosecution process; it only expedites a response to the initial Office Action. Also, in order to be eligible to make such a request, specific criteria set forth by the USPTO need to be met.

From fiscal year 2009 through the first quarter of fiscal year 2014, over 220 patent applications and 650 trademark applications were filed through the Program.⁷¹ Among the patent applications, 30 Requests to Make Special were filed during the 2012–2014 school years.⁷² Additionally, since the inception of the Request to Make Special program, 9 of 15 participating schools in the patent portion of the Program have utilized the Request to Make Special in at least one patent application.⁷³ Under the Request to Make Special program, the average time from the granting of the Request to office action is two months (compared to four months without the request).⁷⁴ In the trademark portion of the Program, there are certain examiners specifically assigned to work solely on Program applications.

Even without the expedited review, however, applications of law school clinic clients are, on average, seen more quickly. For example, the initial response by the USPTO for trademark applications submitted through the Program is six weeks,⁷⁵ compared to the national average of six to seven months.⁷⁶ On the patent side, it is four months,⁷⁷ compared to the national average of 24.6 months.⁷⁸

Lastly, many clients have not worked with lawyers before. Having the opportunity to see first-hand the value that lawyers bring to legal matters and their business as a whole is important to clients as they develop a more holistic strategy about their entrepreneurial endeavors.⁷⁹

b. Pro Bono Services

Under the terms of Requirement 6, legal services provided by the clinics must be done on a pro bono basis.⁸⁰ This requirement is tied to the general pro bono ethic within the legal profession that law schools

⁷¹ *Pilot Program Q&A*, *supra* note 5, at 2, 3.

⁷² William R. Covey, Deputy Gen. Counsel for Enrollment and Discipline, Law School Clinic Certification Pilot Program (Aug. 20, 2014).

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ E-mail from Signe Naeve, Dir., Univ. of Wash. Sch. of Law Graduate Program in IP, to Jennifer S. Fan (Aug. 11, 2014) (on file with author).

⁷⁶ *How Long Does It Take to Register a Trademark?*, USPTO (Jan. 12, 2005), <http://www.uspto.gov/main/faq/t250067.htm> (“However, the total time for an application to be processed may be anywhere from almost a year to several years, depending on the basis for filing, and the legal issues which may arise in the examination of the application.”).

⁷⁷ The ELC Patent Supervising Attorney noted that in the ELC’s experience the initial response from the USPTO was three months. E-mail from Jesse Kindra, Dir. of Intellectual Prop. Mgmt., CoMotion, to Jennifer S. Fan (Aug. 10, 2014) (on file with author).

⁷⁸ *How Long Does It Take for a Patent Application to Be Processed?*, USPTO, <http://www.uspto.gov/main/faq/index.html>.

⁷⁹ This is a benefit that all clinics provide whether they are part of the Program or not.

⁸⁰ See *supra* Part I.B.; *Patent Clinic Requirements*, *supra* note 10, at 2.

cultivate with various degrees of success.⁸¹ Since there is a dearth of free IP legal help, the Program is especially appealing to low-income clients.

II. ADVANTAGES AND DRAWBACKS OF THE FOUR MODELS

As law schools assess whether they would like to apply for the Program or perhaps revisit what structure might work best for qualifying for it within a particular clinic, the advantages and drawbacks identified below may be helpful in providing the structure for such a discussion.

A. *Advantages*

Model 1 is advantageous for students if they are only interested in patent prosecution.⁸² By focusing on the patentability search, explaining the various fees to clients, and drafting the patent application, Office Actions, and the like, students have the opportunity to hone their legal skills in their chosen area of interest. The legal work the student undertakes gives a compelling reason for law firms to hire her—she has practical experience and has been trained by a seasoned practitioner. The same holds true for Model 2 on the trademark side.⁸³

As indicated by the numbers in Section I.A., above, more schools are interested in Models 3 or 4: the IP-only, or hybrid approach. This is due, in part, to the fact that students then have the opportunity to get a holistic view of IP law in the case of Model 3 and a comprehensive perspective of IP law within a transactional law setting for Model 4. Since many clinics accept both second- and third-year law students, it is particularly helpful for second-year law students to participate in Models 3 or 4 if they are uncertain about which area of IP they would like to specialize in. Models 3 and 4 are also helpful to clients. Within such models, clients get the “big picture” and where IP fits within that construct. For example, although clients may initially come to a clinic intending to obtain a federal registration on their trademark, the comprehensive analysis undertaken by the clinic may illustrate that registering a trademark is not a good option or that other alternatives may better protect the client’s IP.

Additionally, assuming that the goals of a clinic experience are not only to develop students’ legal skills, but also to expose them to central values of the legal profession—competent representation; promotion of justice, fairness, and morality; to continue to improve the profession of

⁸¹ Although the Program mandates pro bono service, it does not specify what constitutes pro bono work; each law school clinic in the program can decide what type of client it wishes to accept.

⁸² The author is aware that patent prosecution does not fall under transactional practice and is therefore not the best match for a transactional clinic.

⁸³ The author is aware that drafting trademark applications does not fall under transactional practice and is therefore not the best match for a transactional clinic.

law; and to develop as a professional⁸⁴—then the experiences of students in Models 3 or 4 can help to accomplish these goals. For example, by getting a comprehensive overview of a client's IP needs (or in the case of Model 4, non-IP needs, too) and by reflecting upon their experiences and reviewing how clients are selected, students can develop as professionals and gain a better understanding of how to promote access to justice.

Lastly, Model 4 is structured more like how a law firm would be structured with specialists working together. Therefore, it hones collaboration and communication skills.

B. Drawbacks

The benefits of Model 1 can also have drawbacks. For example, a student interested in patent prosecution may not be drafting patent applications in her intended area of practice.⁸⁵ An additional challenge is that patent claims are drafted in a particular way depending on the subject area. For example, a student who intends to focus her career prosecuting patents in the life sciences area and has prior experience in that area would not be well suited for drafting patents in the software arena. This does not mean that she would not benefit from the process of drafting a patent application and having an examiner interview, but the student would need to keep in mind that she may not be able to draft applications in her intended area of practice.

Model 2 also has challenges. While doing trademark applications is helpful to those interested in trademark work, from a pedagogical standpoint it is limiting. One can argue that the student can be better served by looking at her client's IP goals more holistically. Furthermore, from a job prospect perspective, it is challenging to do solely trademark work, particularly early on in a young attorney's career. Therefore, cultivating other types of IP expertise, such as licensing, would help the student's marketability if she has not yet secured a job.

Model 3, which encompasses various areas of IP, can be challenging since (like Model 4) there is a great deal of substantive knowledge required to serve clients in a hybrid or transactional clinic. From a pedagogical perspective, however, it leads to a richness in discussion because it gives students the opportunity to explore other non-patent or trademark solutions. Additionally, giving students the opportunity to explore different areas of IP practice is helpful to them as they decide which area of IP law they are most interested in.

⁸⁴ See A.B.A. SECTION ON LEGAL EDUC. & ADMISSIONS TO THE BAR, LEGAL EDUCATION AND PROFESSIONAL DEVELOPMENT—AN EDUCATIONAL CONTINUUM 207–19 (1992).

⁸⁵ In this author's experience, low-income individuals typically do not have patent applications in the areas of life sciences or high technology where many patent law students end up practicing.

Similar to Model 3, what was previously described as a benefit of Model 4 can also be considered a drawback. In the case of Model 4, by covering a number of different areas, one could argue that it is difficult to cover every area well. Having only a basic understanding in multiple areas as opposed to a deeper understanding of one area may be challenging for a student as she heads into the job market, particularly if it is during a time when the economy is doing poorly and jobs for attorneys are scarce.

III. INTEGRATION CHALLENGES

Each participating law school integrates the Program differently within its particular infrastructure. The UW School of Law ELC is used as the case study to frame this discussion in the areas of staffing, funding, and meeting reporting obligations.⁸⁶

A. Staffing

Depending on the size of the Program and the type of model administered,⁸⁷ the staffing configuration may differ significantly. During the 2013–2014 academic year, the UW School of Law ELC had 22 students. Eight students participated in the trademark portion of the Program and two participated in the patent portion.

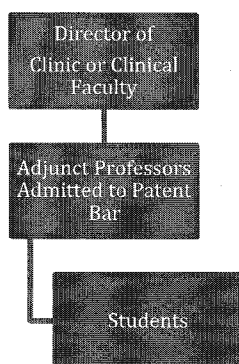
Allocating responsibilities and ensuring that all work is done is a significant time commitment. In order to staff the Program appropriately, the pedagogical goals of the clinic, client need, and student supervision need to be considered. Additionally, there are different ways to staff a clinic depending on the model that the law school implements.

⁸⁶ On a broader level, the ELC is part of a robust intellectual property community at the UW School of Law. The UW School of Law offers extensive IP course offerings for both J.D. and LL.M. students. One of the hallmarks of IP education at UW School of Law is its rich and rigorous curriculum. The UW School of Law believes that what distinguishes the good from the great lawyer is the ability to understand the link between legal doctrine and the practice of law. Thus, its goal is to take students deep into both the theory and practical application of IP law. The foundation forms in the IP Law Core class where students become grounded in patent, trade secret, trademark, and copyright law and explore their intersections. From there, students can study each area of IP law in greater depth in advanced courses as well as its application in industries, such as computer software or biotech. They can also learn the skills of an IP law practitioner by studying patent prosecution, license drafting, IP litigation, and participating in the ELC. Its IP Innovations course adds advanced specialized topics to the IP Law Core, often by bringing nationally renowned speakers into the classroom.

⁸⁷ See discussion *infra* on Models 1, 2, 3, and 4 in Sections I and II.

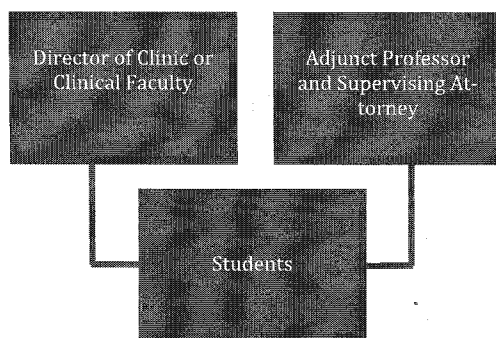
1. Model 1⁸⁸

In the case of Model 1, a patent-only clinic, an organizational chart may look like this:



2. Model 2⁸⁹

As one may expect, Model 2, a trademark-only clinic, is similar given that it only covers a specific type of law.⁹⁰



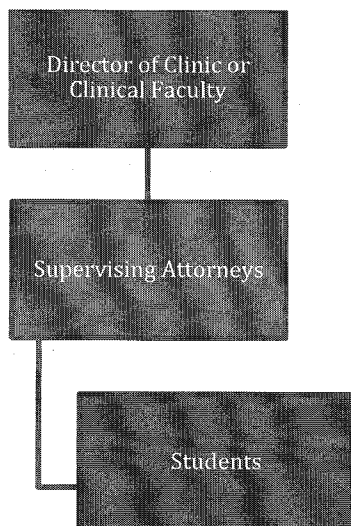
⁸⁸ Model 1 is based on information given by Eric C. Williams, Director of the Program for Entrepreneurship and Business Law, Director of the Business and Community Law Clinic, and Director of the Patent Procurement Clinic, as well as an Assistant (Clinical) Professor at Wayne State School of Law via telephone conference that took place on or about July 25, 2014. Law schools that do not participate in the Program are not precluded from using Models 1, 2, 3, and 4 to structure their clinics; however, the attendant benefits described in Part I.B., above will not apply to them if they are not part of the Program. There may not be active patent law practitioners in a law school that meet the requirements of the Program to be supervising attorneys; there also may be too many patent applications for just one supervising attorney to undertake. Therefore, patent attorneys admitted to practice before the USPTO must be recruited as adjunct faculty.

⁸⁹ Model 2 is based on information from Howard University School of Law. *Intellectual Property and Trademark Clinic*, How. U. SCH. L. (Aug. 20, 2014) <http://www.law.howard.edu/1445>.

⁹⁰ Model 1 may still be more complex in terms of staffing, however, if there are inventions in different areas of expertise (*e.g.*, life sciences versus computer science) that the clinic chooses to undertake.

3. Model 3⁹¹

Since Model 3, an IP-only clinic, involves more areas of law, there will typically be more attorneys in the Supervising Attorney role, depending on the areas of IP that the clinic intends to cover.



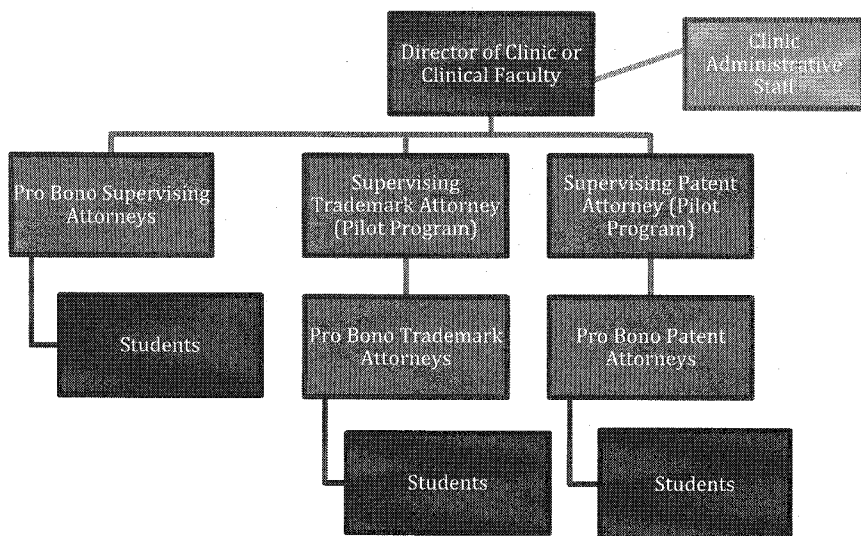
4. Model 4⁹²

Model 4, a transactional clinic covering both IP, corporate, and possibly tax issues, is the most complex of all from a staffing perspective. If pro bono attorneys are also included in the mix and the clinic is subject to admission to practice rules for their students as well, there are multiple layers of supervision and some students may have three supervising attorneys.⁹³

⁹¹ Model 3 is partially based on information provided on the website for Vanderbilt's Intellectual Property and the Arts Clinic. *Intellectual Property and the Arts Clinic*, VAND. L. SCH., <http://law.vanderbilt.edu/courses/132>.

⁹² The structure for Model 4 is based on the UW School of Law ELC. In the UW School of Law ELC, there is a Managing Director, Jennifer Fan, who reports to the Director of the Clinical Law Program. She oversees all aspects of the clinic and is part of the clinical faculty. There are also supervising attorneys for the trademark and patent portions of the Program who serve in other capacities within UW. The Supervising Attorney for the trademark portion of the Program, Signe Naeve, is a Lecturer in Law and serves as the Director of the IP LL.M. Program. The Supervising Attorney for the patent portion of the Program, Jesse Kindra, is an adjunct professor at the UW School of Law and directs the intellectual property management of CoMotion, which is the technology transfer arm of the university. The UW School of Law ELC also has someone serving in the role of trademark paralegal and research assistant, Anna Bakhmetyeva, who has responsibilities outside of the clinic. CoMotion has a patent paralegal who assists with patent-related matters as well. There is also support staff within the Clinical Law Program at the UW led by Harold Daniels.

⁹³ For example, in the UW School of Law ELC, students are placed on one of three tracks: corporate, IP, or tax. If a student is on the IP track and wants to be in the trademark clinic, she will have a general IP pro bono supervising attorney (who



As demonstrated by the models above, integrating the Program within an existing law school clinic focused on providing services outside trademark and patent applications poses significant challenges depending on the type of model used by the clinic. However, these challenges can be overcome, provided that there is institutional support and faculty and staff willing to take on additional responsibilities.

B. Funding

Law schools were able to fund clinics due to significant contributions from the Ford Foundation and, later, the Department of Education in the 1960s through 1990s during the “second wave” of clinical education.⁹⁴

may not have expertise in trademark or patent law), a trademark specific pro bono supervising attorney, and the Supervising Attorney of the trademark portion of the Program of the ELC (who oversees the trademark application process under the Program). In Washington State, students may be subject to Admission to Practice Rule 9. See WASH. ADMIS. PRACTICE R. 9.

⁹⁴ See Margaret Martin Barry et al., *Clinical Education for this Millennium: The Third Wave*, 7 CLINICAL L. REV. 1, 18–19 (2000) (reviewing the history of clinics). In particular, it describes the availability of external funding during the second wave, which was one of the factors that led to the explosion of clinics in the 1960s. *Id.* The Ford Foundation provided \$500,000 to fund clinics in 19 law schools through the National Council on Legal Clinics (“NCLC”) between 1959 and 1965. *Id.* An additional \$950,000 grant was made by the Ford Foundation in 1965, and the NCLC was renamed the Council on Legal Education for Professional Responsibility (“CLEPR”). *Id.* at 19. From 1968 to 1978, CLEPR provided \$7,000,000 in grant funding in the form of 209 grants to 107 ABA-approved law schools. *Id.* Law schools agreed to fund such clinics after the funding from the Ford Foundation ended. Then, in 1978, the Department of Education adopted the Title XI Law School Clinical Experience Program (later Title IX Law School Clinical Experience

Transactional law clinics were late arrivals to the clinical scene and first appeared in the late 1970s.⁹⁵ Early iterations of transactional law clinics were focused on community economic development and housing.⁹⁶ In recent years, there has been a more pronounced shift to clinics serving entrepreneurs and small businesses in the innovation economy.⁹⁷

In 1980, the cost of running clinics was reviewed in a joint report of the American Association of Law Schools and the American Bar Association.⁹⁸ “The 1980 report noted that variations in costs also may stem from the status of the faculty teaching the courses (which affect[s] their relative salaries), student/faculty ratios, the number of credit hours awarded, and, in externship programs, the extent to which there is a classroom component.”⁹⁹ Based on data collected in the late 1980s, lack of money was cited as the most frequent challenge for clinical faculty (47% of the time), with lack of stable funding coming in fourth (35% of the time).¹⁰⁰ The same financial challenges hold true for clinics today. In the 2013-14 Survey of Applied Legal Education conducted by the Center for the Study of Applied Legal Education, lack of hard money (64.1%) was cited as one of the major challenges to live-client clinics.¹⁰¹ Other resource-related reasons were cited as major challenges as well, including lack of physical/office space (37.2%) and lack of administrative/secretarial support (26.3%).¹⁰²

There are three methods that law schools employ today to address the cost question:¹⁰³

- 1) Encouraging clinical faculty to increase the typical 8:1¹⁰⁴ or 10:1 student faculty ratio;

Program) which helped to integrate beginning clinical programs into the law school curriculum throughout the U.S. by providing over \$87,000,000 to law schools operating clinics between 1978 and 1997. *Id.*

⁹⁵ Susan R. Jones & Jacqueline Lainez, *Enriching the Law School Curriculum: The Rise of Transactional Legal Clinics in U.S. Law Schools*, 43 WASH. U. J.L. & POL’Y 85, 92 (2013).

⁹⁶ *Id.* at 87.

⁹⁷ *Id.* at 87–88.

⁹⁸ ASS’N. OF AM. LAW SCHS.–A.B.A. COMM. ON GUIDELINES FOR CLINICAL LEGAL EDUC., CLINICAL LEGAL EDUCATION 11, 133–68 (1980).

⁹⁹ Barry et al., *supra* note 94, at 21.

¹⁰⁰ *Report of the Committee on the Future of the In-House Clinic*, 42 J. LEGAL EDUC. 508, 522 (1992).

¹⁰¹ DAVID A. SANTACROCE AND ROBERT R. KUEHN, CTR. FOR THE STUDY OF APPLIED LEGAL EDUC., THE 2013–14 SURVEY OF APPLIED LEGAL EDUCATION 14 (2014), available at http://www.csale.org/files/Report_on_2013-14_CSALE_Survey.pdf. Lack of hard money was rated the top concern; other demands on clinical faculty’s time came in second (47.4%). *Id.*

¹⁰² *Id.*

¹⁰³ See Barry et al., *supra* note 94, at 27–28 (discussing methods).

¹⁰⁴ See SANTACROCE & KUEHN, *supra* note 101, at 17, which lists 8:1 as the most frequent student-teacher ratio for the classroom component of live-client clinics (38.5%). A 6:1 ratio came in second (13.7%) and 10:1 was third (12.2%).

- 2) “[H]iring clinical faculty on a short-term basis with lower status and compensation”,¹⁰⁵ and
- 3) Increasing responsibilities of clinical faculty members to include teaching “clinical labs,”¹⁰⁶ or establishing “hybrid in-house/externship programs.”¹⁰⁷

In addition to employing one or more of the methods above,¹⁰⁸ if a clinic in the Program does not receive funds from the law school budget, it must seek funds from external sources such as foundations or private donors.¹⁰⁹ A clinic may also want to consider whether it would be possible to collaborate with outside counsel.¹¹⁰ Some clinics rely on “hard” money in which case they are allocated a budget by their law school and others are reliant on “soft” money or grants. If a clinic falls into the soft money category, being part of the Program would most likely help in fundraising endeavors, because it raises the stature of the clinic to a national level. Additionally, funders would favorably view the fact that clinic clients get expedited review for their patent applications and have a generally quicker review process by the USPTO.

When the following factors are in place it makes more sense to apply for the Program: a faculty member or adjunct able and willing to run the program, administrative support is available, there is support from the faculty for the Program and the general substantive areas of law covered by the Program, and financial support is procurable either in the form of soft or hard money.

¹⁰⁵ Barry et al., *supra* note 94, at 27.

¹⁰⁶ See *id.* at 28 (describing clinical labs as the lab component of a traditional, substantive course).

¹⁰⁷ See *id.* (defining the hybrid in-house/externship program as a partnership between a legal provider and the law school in which students enrolled in a clinic are supervised by both a full-time clinical faculty member and lawyers from outside the law school, such as public defenders from a public defender’s office). In the transactional context, the analogy would be a clinic partnering with local law firms or in-house counsel.

¹⁰⁸ In the case of the UW School of Law ELC, it employs all three methods. More specifically, the ELC had 22 students this year. There is one part-time clinical faculty member who serves as the principal point of contact for the ELC and teaches the seminar component of the clinic. The ELC also leverages its extensive pro bono network of attorneys, currently numbering over 60.

¹⁰⁹ The process of searching for a grant that fits within the parameters of what a clinic covers is time consuming, as is the grant writing. If a clinic receives a grant from a foundation or federal agency, it must keep careful records and have resources dedicated to providing information for both annual reports and requests for such information from the grantor.

¹¹⁰ See generally Alicia E. Plerhoples & Amanda M. Spratley, *Engaging Outside Counsel in Transactional Law Clinics*, 20 CLINICAL L. REV. 379 (2014) (discussing the different methods and objectives by which clinics engage in such collaboration).

C. *Meeting Reporting Obligations*

Having the appropriate staffing, as discussed above, is critical to ensure that the appropriate, required reporting obligations under the USPTO are met. For those clinics that are also grant funded, collecting such information serves the added objective of providing measurable metrics to grantors—a necessity to be competitive for grants. If a clinic is contemplating applying for a grant, projecting the number of trademark and patent applications the clinic can undertake during each school year during a multi-year grant will also strengthen a grant proposal.¹¹¹

IV. ROADMAP FOR BUNDLING USPTO PROGRAM WITHIN TRANSACTIONAL LAW CLINICS

First, it is imperative to have a primary person to oversee the clinic as a whole, especially in Models 3 or 4. The administrative underpinnings become increasingly complex once the Program and local admission to practice rules are layered on top of a clinic specializing in one or more areas. Thus, for both a good student and client experience, it is essential to identify a person who ensures that all aspects of the clinic run smoothly. Typically, the director of the clinic or clinical faculty member fulfills this role. It is important for pro bono attorneys, to the extent that they participate in a clinic, to have a consistent point of contact, especially since a clinic may rely on such attorneys to return in future years as a volunteer.¹¹² Appropriate staffing and guidelines are also critical to ensure appropriate expectations are set for pro bono attorneys as they work with students and train them.¹¹³

Second, depending on the type of model employed in the Program, adequate faculty and staff must ensure appropriate supervision, training, and administrative requirements. A handbook covering each of these areas is crucial.¹¹⁴ Third, students must have clear guidelines on the param-

¹¹¹ Since the UW School of Law ELC has been primarily funded through soft money in the past, we have applied for numerous grants and, in each case, having measurable metrics was critical to the success of any application.

¹¹² Of the UW School of Law ELC's more than 60 pro bono attorneys, more than half of them have been with the ELC for several years.

¹¹³ When recruiting pro bono attorneys, the ELC's Managing Director gives presentations both in large group settings and individually to outline the expectations of supervising attorneys in the clinic setting.

¹¹⁴ In the case of the UW School of Law ELC, there is a general all-clinic orientation that students must attend which covers conflicts of interest, professional responsibility, use of the Clinical Law Program facilities, and use of Amicus software, among other topics. Students are expected to familiarize themselves with the Clinic Handbook as well as the ELC Handbook, which details new client policies and procedures, expanding the scope of representation, trademark clinic requirements and procedures, patent clinic requirements and procedures, what M.B.A. students can expect in the ELC, and miscellaneous topics (including Amicus Attorney software, ethical responsibilities, conflicts, and document saving protocol, among other items). See generally ELC Handbook, *supra* note 41.

eters of the work they are undertaking through the Program. The scope of work should be made clear to the client when the student team explains the scope of the retainer agreement to the client. In the case of trademarks, the scope of representation can initially cover the trademark application process itself.¹¹⁵ Once the trademark is registered by the USPTO, a separate retainer agreement that covers a client's rights and obligations as a trademark owner can be executed.¹¹⁶ In the case of patents, separate retainer agreements can be used for provisional¹¹⁷ and

¹¹⁵ This language can be drafted as follows: "Scope and Duration of Representation. The Client understands that the Clinic will only represent it on a matter in which the Clinic agrees to act as the Client's attorney, which in this case is to analyze and prepare and file a U.S. trademark application for the mark "TRADEMARK NAME" with the U.S. Patent & Trademark Office ("USPTO"). This representation will continue only through the filing and processing of the above U.S. trademark application, including responding to Office Actions and other correspondence with the USPTO. The Clinic is not responsible for paying any fees including, but not limited to, the application filing fees (online applications \$275–\$325 per class depending on the degree of customization of the goods or services description for each trademark), statement of use fees (\$100 per class), extension fee for statement of use fees (\$150 per class), and renewal fees (\$400 per class). The scope of this representation does not include proceedings before the Trademark Trial and Appeal Board. The Clinic will not represent the Client, without further request and agreement, on any other matters which may arise while it is a client of the Clinic. If the Clinic does agree to represent the Client on a different matter, it will be asked to sign another Retainer Agreement. The Client understands that the reason it will sign a new Retainer Agreement is so that the Client will know exactly what the Clinic will be doing for it." *See id.* app. I.

¹¹⁶ The language in such a retainer agreement can be drafted as follows: "Scope and Duration of Representation. The Client understands that the Clinic will only represent it on a matter in which the Clinic agrees to act as the Client's attorney, which in this case is to advise the Client on the rights and obligations of a trademark owner, specifically the trademark maintenance deadlines and enforcement options and obligations for the mark [Name of Client Trademark]. This representation will continue only through the delivery of a short memorandum reviewing the trademark issues moving forward as a trademark owner. The scope of this representation does not include proceedings before the Trademark Trial and Appeal Board or any court or tribunal. The Clinic will not represent the Client, without further request and agreement, on any other matters that may arise while it is a client of the Clinic. If the Clinic does agree to represent the Client on a different matter, it will be asked to sign another retainer agreement. The Client understands that the reason it will sign a new retainer agreement is so that the Client will know exactly what the Clinic will be doing for it." *See id.* app. L.

¹¹⁷ Language for the provisional patent application may appear as follows: "Scope and Duration of Representation. The Client understands that the Clinic will only represent it on a matter in which the Clinic agrees to act as its attorney, which in this case is to analyze the Client's current invention and business plan, deliver a final audit memo reviewing the current invention and business plan, and potentially prepare and file a single U.S. provisional application for the Client's current invention. The U.S. provisional application may include: Specification, Drawings, Cover Sheet, Power of Attorney, and Inventor's Oath or Declaration. This representation will continue only through the delivery and filing of the above documents. The Clinic will not represent the Client, without further request and agreement, on any other matters which may arise while it is a client of the Clinic,

non-provisional¹¹⁸ patent applications if the clinic agrees to assist the client with such patent applications.

Fourth, quality infrastructure—both in subject area expertise and funding—is critical for a Program to be successfully incorporated into a law school's clinical curriculum. A law school participating in the Program must already have a robust IP curriculum in place. Additionally, there must be adequate funding for several years in order for the Program to become a permanent fixture in the clinic curriculum.

V. PATENT AND TRADEMARK WORK WITHOUT PARTICIPATION IN THE USPTO PROGRAM

Each clinic is at a different stage of its development and the Program is not for every law school. Many clinics provide representation on trademark or patent matters outside of the Program. The possible alternatives for legal services outside of the Program are outlined below.

A. *Patents*

In Models 1, 3, and 4, without being part of the Program, a clinic could analyze a client's invention, perform a prior art search, and potentially prepare and file a single U.S. provisional or non-provisional patent application for a client's current invention. The U.S. provisional or non-provisional patent application may include: Specification, Claims, Draw-

including, but not limited to, the process of preparing and filing a U.S. non-provisional application with the USPTO, responding to Office Actions, and other correspondence with the USPTO. The Clinic is not responsible for paying any USPTO fees including, but not limited to, the application filing fees, issuance fees, and maintenance fees. If the Clinic does agree to represent the Client on a different matter, it will be asked to sign another Retainer Agreement. The Client acknowledges that the reason it will sign a new Retainer Agreement is so that the Client understands the scope of the representation." *See id.* app. N.

¹¹⁸ For non-provisional patent applications, the language could be drafted as follows: "Scope and Duration of Representation. The Client understands that the Clinic will only represent it on a matter in which the Clinic agrees to act as its attorney, which in this case is to analyze the Client's current invention, perform a prior art search, and potentially prepare and file a single U.S. non-provisional application for the Client's current invention. The U.S. non-provisional application may include: Specification, Claims, Drawings, Cover Sheet, Power of Attorney, and Inventor's Oath or Declaration. This representation will continue only through the delivery and filing of the above documents. The Clinic will not represent the Client, without further request and agreement, on any other matters which may arise while it is a client of the Clinic, including, but not limited to, responding to Office Actions, and other correspondence with the USPTO. The Clinic is not responsible for paying any professional drawing drafting fees or USPTO fees including, but not limited to, application filing fees, search fees, examination fees, issuance fees, and maintenance fees. If the Clinic does agree to represent the Client on a different matter, it will be asked to sign another Retainer Agreement. The Client acknowledges that the reason it will sign a new Retainer Agreement is so that the Client understands the scope of the representation." *See id.* app. O.

ings, Cover Sheet, Power of Attorney, and Inventor's Oath or Declaration.¹¹⁹ At some point during the representation, the clinic should also specify what costs are involved in filing the patent (excluding legal fees). If a clinic agrees to draft a patent application for a client, the clinic could end their representation after drafting the application and have the client be responsible for the actual filing and responses to Office Actions.¹²⁰ In this way, no client matters are carried over from year to year, and the possibility of having to respond to an Office Action during the summer when most clinics are not operational does not need to be addressed.

Another consideration is that if, at the outset, there is some question as to when the inventor first disclosed the invention to someone, a client may benefit from having the clinic draft a disclosure timeline to determine if the one year bar has passed. Therefore, while the clinic may decide not to draft a patent application, it could still provide helpful advice to the client. As a policy, the clinic may also want to decide if it will assist a client who already filed a provisional patent application¹²¹ and now seeks assistance with a non-provisional patent application.¹²²

B. Trademarks

In Models 2, 3, and 4, a clinic could conduct the following type of work for a client without being part of the Program: schedule a meeting between the client and client team to discuss possible trademarks and the use or planned use of the trademarks; do a clearance search for the possible trademark and identify the classes for the possible trademarks; prepare a knockout memo for the client regarding clearance-search findings; and prepare a description of goods for the possible trademarks.¹²³ A clinic would need to ascertain the amount of clearance searches for trademarks the clinic could accomplish.¹²⁴ Lastly, similar to the patent

¹¹⁹ Provisional patent applications are not required to include claims and oaths or declarations. See *General Information Concerning Patents: What is a Patent?*, *supra* note 13.

¹²⁰ If the clinic is part of the Program, however, terminating the representation at this stage would not be possible. The Program requires that the clinic file the application for the client as well as respond to any Office Actions. Therefore, summer coverage is necessary. In the case of the UW School of Law ELC, it has summer interns, and the Managing Director, Supervising Attorneys, and paralegals are all on standby if Program-related client work arises during the summer.

¹²¹ A provisional application will become abandoned by the operation of law 12 months from its filing date. The 12-month pendency for a provisional application is not counted toward the 20-year term of a patent granted on a subsequently filed non-provisional application which claims benefit of the filing date of the provisional application. See *General Information Concerning Patents: What is a Patent?*, *supra* note 13.

¹²² Due to both pedagogical goals and resource limitations, the UW School of Law ELC does not accept clients who have already filed a non-provisional or provisional patent application.

¹²³ See ELC Handbook, *supra* note 41, app. H.

¹²⁴ During the 2013–2014 academic year, a few clients of the UW School of Law ELC had over a dozen possible trademarks that they wanted clearance searches done

section above, a clinic that is not in the Program could assist a client in drafting the application for a particular trademark, but have the client responsible for the actual filing and responses to Office Actions.¹²⁵

CONCLUSION

The Program gives participating law schools the unique opportunity to work with the USPTO, and affords law students an opportunity to not only gain valuable legal experience, but to develop a sense of professional identity within their intended area of practice in the future.¹²⁶ Additionally, if there are pro bono supervising attorneys that participate in the Program, the students will be exposed to different styles of lawyering. It also helps law firms with recruiting since staffing students on substantive client matters can give hiring attorneys a sense of what students are like in a client setting. Being selected as a Program participant and then being a member of the Program does not come without its challenges, however. Law schools in the Program must ensure that they have infrastructure in place for their successful participation. If the elements for the Program are not in place, there are other avenues of giving students the opportunity to practice in the areas of patent and trademark law.

In sum, the USPTO has provided law clinics in the Program with an opportunity to create a robust program that greatly enhances the learning opportunities and job prospects for students. It also gives participating law schools a way to further enhance their IP offerings and think about their IP curriculum more broadly.

for. The ELC complied with these clients' requests. Given its limited resources, however, on a going forward basis, the ELC will do clearance searches for no more than three trademarks.

¹²⁵ A clinic can also decide on whether it wants to represent a client on a matter where the trademark or patent application has already been filed.

¹²⁶ See generally WILLIAM M. SULLIVAN ET AL., EDUCATING LAWYERS: PREPARATION FOR THE PROFESSION OF LAW (Carnegie Found. for the Advancement of Teaching 2007).

Appendix A¹²⁷



¹²⁷ Produced by the United States Patent and Trademark Office; no copyright is claimed by the United States in this material.

