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Report on the Law School Clinic Certification Program



Prepared by:
The Office of Enrollment and Discipline of the
United States Patent and Trademark Office

REPORT ON THE LAW SCHOOL CLINIC CERTIFICATION PROGRAM

**THE OFFICE OF ENROLLMENT AND DISCIPLINE OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

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SUMMARY

As required by the USPTO Law School Clinic Certification Program Act (P.L. 113-227¹), the Office of Enrollment and Discipline (“OED”) of the USPTO is pleased to submit this report on behalf of the Director of the USPTO. This report fulfills the requirements of the act by describing the number of law schools and law students participating in the Program, the work done through the Program, the benefits of the Program, and any recommendations for modifications to the Program.

The United States Patent and Trademark Office began the Law School Clinic Certification Program (“Program”) to allow law school students to practice patent and/or trademark law under supervision before the USPTO on a *pro bono* basis for clients that qualify for assistance from one of the participating law schools’ clinics.

The Program began as a pilot program in the Fall Semester of 2008 with six participating law school clinics. The Program expanded in 2010, 2012, and 2014. Currently, 45 law school clinics participate in the Program, 18 clinics participate in both the Patent and Trademark portions of the Program, 20 clinics participate only in the Trademark portion of the Program, and 7 clinics participate only in the Patent portion of the Program. In June 2016, the Program again opened for expansion and will accept applications from law school clinics through June 30, 2017.

As evident from the map on the following page, the Program has grown significantly since it began with only six schools in 2008.

¹ An act to establish the Law School Clinic Certification Program of the United States Patent and Trademark Office, and for other purposes, Pub. L. No. 113-227, 128 Stat. 2114 (2014). U.S. Rep. Hakeem Jeffries (NY-08) and Rep. Steve Chabot (R-OH) sponsored the bipartisan bill.



LAW SCHOOL

CLINIC CERTIFICATION PROGRAM



PATENT AND TRADEMARK PROGRAMS

- 1 Arizona State University Sandra Day O'Connor College of Law – Tempe, Arizona
- 2 Baylor Law School – Waco, Texas
- 3 Fordham University School of Law – New York, New York
- 4 Indiana University Maurer School of Law – Bloomington, Indiana
- 5 Lincoln Law School of San Jose – San Jose, California
- 6 Mitchell Hamline School of Law – Saint Paul, Minnesota
- 7 North Carolina Central University School of Law – Durham, North Carolina
- 8 South Texas College of Law – Houston, Texas
- 9 Southern Methodist University Dedman School of Law – Dallas, Texas
- 10 Texas A&M University School of Law – Fort Worth, Texas
- 11 The John Marshall Law School – Chicago, Illinois
- 12 Thomas Jefferson School of Law – San Diego, California
- 13 University of California, Los Angeles School of Law – Los Angeles, California
- 14 University of Connecticut School of Law – Hartford, Connecticut
- 15 University of Maryland School of Law – Baltimore, Maryland
- 16 University of Notre Dame Law School – Notre Dame, Indiana
- 17 University of Puerto Rico School of Law – San Juan, Puerto Rico
- 18 University of Washington School of Law – Seattle, Washington

PATENT PROGRAM ONLY

- 19 University of Arizona, James E. Rogers College of Law – Tucson, Arizona
- 20 Brooklyn Law School – Brooklyn, New York
- 21 Case Western Reserve University School of Law – Cleveland, Ohio
- 22 New York Law School – New York, New York
- 23 University of Colorado Law School – Boulder, Colorado
- 24 University of Detroit Mercy School of Law – Detroit, Michigan
- 25 Wayne State University Law School – Detroit, Michigan

TRADEMARK PROGRAM ONLY

- 26 American University, Washington College of Law – Washington, D.C.
- 27 California Western School of Law – San Diego, California
- 28 Howard University School of Law – Washington, D.C.
- 29 Lewis & Clark College School of Law – Portland, Oregon
- 30 Michigan State University College of Law – East Lansing, Michigan
- 31 Northwestern Pritzker School of Law – Chicago, Illinois
- 32 Roger Williams University School of Law – Bristol, Rhode Island
- 33 Rutgers Law School – Newark, New Jersey
- 34 Saint Louis University School of Law – Saint Louis, Missouri
- 35 The George Washington University School of Law – Washington, D.C.
- 36 University of Akron School of Law – Akron, Ohio
- 37 University of Idaho College of Law – Moscow, Idaho
- 38 University of New Hampshire School of Law – Concord, New Hampshire
- 39 University of North Carolina at Chapel Hill School of Law – Chapel Hill, North Carolina
- 40 University of Richmond School of Law – Richmond, Virginia
- 41 University of San Francisco School of Law – San Francisco, California
- 42 University of Tennessee College of Law – Knoxville, Tennessee
- 43 Vanderbilt Law School – Nashville, Tennessee
- 44 Western New England University School of Law – Springfield, Massachusetts
- 45 West Virginia University School of Law – Morgantown, West Virginia

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On December 16, 2014, Public Law No. 113-227 removed the “pilot” status and established the Program for ten years. The USPTO published a final rule implementing Public Law No. 113-227 and establishing regulations and procedures for application to, and participation in, the Law School Clinic Certification Program. The final rule was published on May 27, 2016, and became effective on June 27, 2016.²



Congressman Hakeem Jeffries speaking with law school students and faculty at the 2015 annual visit to the USPTO

I. INTRODUCTION

The Law School Clinic Certification Program allows law school students to practice patent and trademark law before the USPTO under the strict guidance of a Faculty Clinic Supervisor. A Faculty Clinic Supervisor is a registered patent attorney or patent agent who has practiced before the USPTO in patent matters (Patent program), or is a licensed attorney in good standing with the highest court of a State who has practiced before the USPTO in trademark matters (Trademark program).

² USPTO Law School Clinic Certification Program, 81 F.R. 33591 (June 27, 2016) (to be codified at 37 C.F.R. pt. 11).

All students applying for the Patent or Trademark programs must have the requisite legal qualifications, and must be of good moral character and reputation. To qualify to practice in the Patent program, each student must also have the required scientific and technical qualifications for registration. After finding each student qualified, the USPTO grants the law student practitioners limited recognition to practice before the USPTO. Students in either the Patent or Trademark program are permitted to, among other things, draft and file patent or trademark applications with the USPTO, respond to USPTO communications, and communicate with patent examiners and trademark examining attorneys.

The USPTO accepts law schools into the Program that demonstrate they maintain strong clinical programs. Overall, the schools must possess exemplary intellectual property curricula supporting a participating student's hands-on learning in the clinic; a commitment to networking and effective outreach in the community; comprehensive intellectual property ("IP") *pro bono* services; and excellent case management systems. Each law school clinic must meet and maintain the requirements for participation in the Program in order for clinic students to practice before the USPTO.

Participating in the Program gives real-world experience to clinic students while providing IP *pro bono* services to the community. Thus, the Program provides tangible benefits not only for students, schools, and the USPTO, but also for entrepreneurs and inventors seeking legal representation. The students become better equipped with the knowledge and skills necessary to handle the challenges of intellectual property law that are essential in today's innovation economy, while helping to ensure that American businesses and entrepreneurs have access to the resources they need to succeed.

II. DISCUSSION

A. Overview of Program

In order to participate in the Program and for the clinic students to practice before the USPTO, each law school clinic must meet and maintain the requirements for USPTO certification. All schools accredited by the American Bar Association are eligible for participation in the Program and are examined for acceptance using identical criteria set forth by the USPTO.

Each law school's Faculty Clinic Supervisor must certify that the law school clinic and participating law school clinic students will abide by the requirements promulgated by the USPTO. The Law School Dean, or one authorized to act for the Dean, must also certify that each participating law school clinic student has completed their first year of law school or the equivalent, is in compliance with the law school's ethics code, and has had no moral character issues prior to attending law school or while in attendance. The Faculty Clinic Supervisor must ensure that a conflict of interest check is performed for each participating law school clinic student and each client or potential client of the clinic.

The participating law school clinic students have the opportunity to practice in patent and/or trademark law by prosecuting patent applications and/or trademark applications before the USPTO under the guidance of the Faculty Clinic Supervisor. The law school clinic students in a patent clinic have the opportunity to participate in one or more patent activities including: counseling clients regarding patent matters, performing patentability searches and drafting patentability opinions for a client's invention, and drafting and filing of patent applications, responses to Office Actions and other documents in patent applications. Trademark clinic students have the opportunity to participate in one or more trademark activities including: counseling clients regarding trademark matters, performing registerability searches and drafting registerability opinions for a client's trademark, and drafting and filing of trademark applications, responses to Office Actions and other documents in trademark

applications. Matters before either the Patent Trial and Appeal Board or the Trademark Trial and Appeal Board are not included in the Program, but participating clinics may be and have been permitted to participate in these proceedings on a case-by-case basis.

The Faculty Clinic Supervisor is responsible for instructing, mentoring, overseeing and supervising all participating law school clinic students and is responsible for all applications and documents submitted to the USPTO through the clinic. The Faculty Clinic Supervisor for a patent clinic must, at a minimum, be a registered patent practitioner in good standing with OED and possess at least three (3) years of experience in prosecuting patent applications before the USPTO within the last five (5) years. The Faculty Clinic Supervisor for a trademark clinic must, at a minimum, be a licensed attorney in good standing with the highest court of a State and in active status, and possess at least three (3) years of experience in prosecuting trademark applications before the USPTO within the last five (5) years.

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

B. Program Statistics

Since its inception in the Fall Semester of 2008, the number of participating law schools and law school clinic students has expanded significantly and the number of patent and trademark applications filed has increased. As displayed in the following chart, to date, more than 2,700 law school clinic students have participated in the Program, more than 540 patent applications have been filed, and more than 2,000

trademark applications have been filed.

<i>Year</i>	<i>Number of Participating Schools</i>	<i>Number of Participating Students</i>	<i>Number of Patent Applications Filed (FY)</i>	<i>Number of Trademark Applications Filed (FY)</i>
<i>*2009</i>	6	122	21	74
<i>2010</i>	16	148	17	71
<i>2011</i>	16	232	29	83
<i>2012</i>	29	294	18	101
<i>2013</i>	29	390	108	209
<i>2014</i>	46	480	113	407
<i>2015</i>	45	571	113	543
<i>2016</i>	45	535	126	515
<i>Total</i>		<i>2772</i>	545	2003

Commencing January 2017,³ law school clinics are required to report biannually to OED the following information: the number of law students participating in each of the patent and trademark practice areas of the school's clinic; the number of faculty participating in each of the patent and trademark practice areas of the school's clinic; the number of persons to whom the school's clinic provided assistance in any given patent or trademark matter but with whom no practitioner-client relationship had formed; the number of client representations undertaken for each of the patent and trademark practice areas of the school's clinic; the identity and number of

³ Previously, law school clinics were required to report quarterly to OED the number of applications filed by each clinic. The new reporting requirements were established by the final rule, which became effective June 27, 2016. The USPTO will begin collecting the newly required data in January 2017 in order to give clinics sufficient notice of the new requirements as well as ample time to put systems in place to collect the additional data.

applications and responses filed in each of the patent and/or trademark practice areas of the school's clinic; the number of patents issued, or trademarks registered, to clients of the clinic; and all other information specified by the OED Director.

C. Benefits of Program

The goal of the Program is to give students the opportunity to gain experience practicing before the USPTO, while providing IP *pro bono* legal services to under-resourced companies, small businesses, and individuals with innovative ideas. In doing so, there are significant benefits to participation in the Program not only for the clinic students, schools and the USPTO, but also for the clients whom these clinics serve.



Law schools students, professors, and USPTO speakers in attendance at the 2016 annual visit to the USPTO

1. *Benefits to the Clinic Students*

The clinic students who participate in the Program gain invaluable real-world experience that will better prepare them to be "practice-ready" attorneys upon graduation. Specifically, under the supervision of the Faculty Clinic Supervisor, participating clinic students are introduced to the patent and trademark system first-hand and are able to perform the following activities involved in obtaining a patent or trademark: communicating with and counseling clinic clients regarding patent and trademark matters; conducting patent and trademark searches and providing opinions on patentability or registrability; drafting and filing patent and trademark applications; responses to communications from the USPTO, and other documents; and communicating with patent examiners and trademark examining attorneys. As discussed further below, clinic students may also benefit from expedited review of

the applications they file with the USPTO on behalf of their clients, which makes it more likely that the students will receive substantive examination of the applications they file within the same school year.

The Program allows clinic students to practice in a law firm-type setting and gives them a unique opportunity to be treated as practitioners for purposes of practicing before the USPTO. Students admitted into the Program are granted limited recognition and assigned temporary practice numbers for use while they are participating in the law school clinic. The limited recognition numbers permit the students to file patent and/or trademark applications, respond to USPTO communications, sign documents, and communicate with patent examiners and trademark examining attorneys just like registered practitioners. Students in IP clinics at schools not participating in the USPTO Program are not granted limited recognition to practice before the USPTO while in law school, so this is a significant benefit to participating clinic students.

One of the Program requirements for participating law school clinics is a protocol for a seamless transfer of cases from outgoing law school clinic students to incoming law school clinic students from semester to semester, through the continued supervision of the Faculty Clinic Supervisor. It is critical for clients and for the USPTO that there is no disruption in the USPTO conducting its business. Accordingly, clinic students are required to learn and execute this transition protocol as if working in a law firm. Each clinic's process may vary slightly, but generally students will learn case management skills, including how to track and properly document their work, analyze and summarize the work they have completed in a transition memorandum, and communicate effectively with their colleagues and supervisors.

By treating clinic students like practitioners, the Program challenges students and provides them with an opportunity to put their classroom skills to practice. The Program allows clinic students to develop and improve their legal skills, judgement, and professional values. Clinic students begin to realize the type of practitioner they

want to become and learn how to handle legal problems that may arise as a practitioner. Clinic students also gain invaluable communication skills by learning how to interact with clients, including proper demeanor, what questions to ask, how to work with various personalities, and how to counsel clients. Furthermore, clinic students learn about legal ethics and issues that commonly arise in practice.

Because of this unique exposure to the practice of intellectual property law, clinic students also become more valuable and marketable to future employers in the IP legal community. In a competitive area of the law that is rapidly growing, clinic students become equipped with interesting and relevant experiences to reference in job interviews and to demonstrate their qualifications. They are able to discuss the challenges of working in the IP law field and establish their understanding of practicing as a lawyer in a law firm-type setting. Ideally, participation in the Program will ultimately inspire these clinic students to pursue careers in IP law, such as in private practice, or even at the USPTO.

2. Benefits to the School

There are also significant benefits to the schools that participate in the Program. Specifically, schools that are part of the Program benefit from recognition of the school's IP program by the USPTO, ongoing interaction with the USPTO, and greater exposure and publicity for the school and the IP clinic.



Roundtable discussions with attendees of the 2016 annual law school clinic visit to the USPTO

The Program requires participating schools to meet specific requirements and to maintain strong clinical programs to remain a participant of the Program. The USPTO

does not require or encourage one particular law clinic structure over another. However, the USPTO does expect that each accepted law school will have a strong IP program, including a variety of foundational and advanced IP courses, a carefully structured IP clinic, and an emphasis on experiential, hands-on learning. Accordingly, once accepted into the Program, law schools gain valuable credibility from being recognized as one of the exemplary and prestigious schools meeting the USPTO's eligibility criteria. In light of the ABA's adoption of new accreditation standards requiring more "experiential learning" opportunities for students, the Program may also be particularly beneficial for schools seeking to meet these new requirements.

Law schools with clinics participating in the USPTO Program also benefit from being affiliated with the USPTO and from greater exposure for the school and the IP clinic. All participating law schools are listed on the USPTO's website, along with the clinic's email address, the IP practice area of the clinic, and the geographic area of the clinic (from which the law school may accept clients), for the benefit of the public. If a member of the public seeking legal representation for their IP matter(s) contacts the USPTO for assistance, they may be referred to the clinics participating in the Program.

Furthermore, since the Program began, the USPTO has been making frequent site visits to participating law schools throughout the country. The purpose of these visits is to keep the lines of communication open between the participating schools and the USPTO, discuss employment opportunities at the USPTO with students, discuss the clinic students' experiences, and encourage participation in the Program from current law school students. During the visits, USPTO representatives meet with law school deans, meet and discuss the operation of the clinic with the supervisors and clinic directors, meet the students currently enrolled in the clinic to learn about their experiences, and talk with law students interested in IP law about the benefits of participating in the clinic and career opportunities at the USPTO.

The USPTO also annually invites clinic faculty and students from participating schools to the USPTO for a day of speakers and roundtable discussions regarding career

opportunities at the USPTO, ethics before the USPTO, and other interesting topics. The event has also included a live Trademark Trial and Appeal Board and/or Patent Trial and Appeal Board hearing for the attendees to observe, as well as faculty and student networking sessions.



Deputy General Counsel and OED Director Will Covey speaking with attendees of the 2016 annual visit to the USPTO

Participating schools further benefit from their affiliation with the Program by being associated with the other participating law schools and clinics. Specifically, the USPTO organizes networking teleconferences for the clinic faculty at the participating law schools. One of the participating law schools typically volunteers to host the conference and selects a topic for discussion. The conferences are optional and serve as an efficient way for clinic faculty to share common issues and best practices among the clinics. Aside from the scheduled teleconferences organized by the USPTO, clinic faculty at participating schools often contact one another for general questions, advice, or support regarding the management of a law school clinic. As the Program continues to expand, this is particularly beneficial for schools new to the clinic program and/or for clinic faculty new to the clinic setting.

3. *Benefits to the Clients*

In addition to the participating schools and students, the Program provides significant tangible benefits to the communities these clinics serve by making IP *pro bono* services more readily available to small businesses and individual inventors seeking protection of their intellectual property. In doing so, the clinics in the Program provide IP legal services to a community that might not otherwise be able to obtain representation due to financial constraints. In turn, the Program helps strengthen small businesses and innovation-based entrepreneurship, both of which are part of the key building blocks of economic growth.

The law school clinics participating in the Program are required to provide their patent and/or trademark services on a *pro bono* basis. Each individual clinic decides whether to establish income thresholds and other requirements for accepting clients.

Once becoming a client of one of the participating law school clinics, the client not only benefits from IP *pro bono* services, but may also benefit from expedited review of his/her applications by the USPTO. For trademark applications, the USPTO has trademark examining attorneys who volunteer to be specifically assigned to work on the law school clinic applications in addition to their regular applications. This is beneficial for the students as well as the clients because the examining attorneys are familiar with the Program and historically have processed the applications quicker than an average trademark application. For patent applications, the Request to Make Special Program, which began in the fall semester of 2012, permits each participating law school to designate a predetermined number of applications per academic year to be advanced out of turn, with additional applications being awarded for advancement of examination on an *ad hoc* basis. As seen in the chart below, the Request to Make Special Program benefits the clinic students and their clients as the applications are examined significantly quicker than the average patent application.

<i>School Year</i>	<i>Number of Requests to Make Special Filed</i>	<i>Average time from filing to first Office Action for those Applications that received an Office Action within School Year</i>	<i>Average time from Request granted to first Office Action</i>
<i>2013-2014</i>	10	4 months	60 days
<i>2014-2015</i>	15	7 months	40 days
<i>2015-2016</i>	13	5 months	54 days

* According to the USPTO Patents Dashboard, as viewed on December 14, 2016, the average number of months from the standard patent application filing date to the date a first Office Action is mailed by the USPTO is 15.9 months. See <http://www.uspto.gov/dashboards/patents/main.dashxml>.

4. Benefits to the USPTO

One of the main goals of the USPTO is to promote stronger and more effective IP protection for U.S. innovators and entrepreneurs within the United States and around the world. Well-educated and well-trained patent and trademark practitioners are critical to the USPTO's mission of fostering innovation and economic growth by strengthening protection for novel ideas and inventions and encouraging the dissemination of new technologies.



Roundtable discussions with attendees of the 2016 annual law school clinic visit to the USPTO

Accordingly, the Program benefits the USPTO by better preparing participating law school clinic students for representing others in patent and/or trademark matters

before the Office upon graduation. By providing clinic students with the opportunity to practice in all aspects of obtaining a patent or trademark, the clinic students gain invaluable experience in law school that will help them become more knowledgeable, skilled, and effective practitioners. Having experienced and well-educated practitioners to provide competent representation to U.S. innovators, entrepreneurs, and small businesses is vital to the USPTO carrying out its key mission.

Another one of the USPTO's priorities has been to address the current backlog of patent applications. It is critical that patent examiners be able to speed up their examination process while ensuring that patent quality is maintained. When applications are filed *pro se*, they may contain errors and often slow down the examination process because the examiners have to take more time to analyze the application and work with the *pro se* inventor. By providing *pro bono* legal assistance to individuals and/or small businesses who might otherwise file their patent applications with the USPTO *pro se*, the Program benefits the USPTO by filing better quality applications, which promotes more efficient prosecution.

Additionally, the Leahy-Smith America Invents Act directs the USPTO to "work with and support intellectual property law associations across the country in the establishment of *pro bono* programs designed to assist financially under-resourced independent inventors and small businesses." In response to this directive, the USPTO established the Patent Pro Bono Program, which is administered by the Federal Circuit Bar Association, and is actively working with regional organizations to establish *pro bono* programs throughout the country. While the Law School Clinic Certification Program is not affiliated with the Patent Pro Bono Program, the USPTO strongly encourages participating law school clinics to engage with these programs throughout the country. This may include assistance to the *pro bono* programs or as a secondary program serving those inventors and small businesses that do not meet certain requirements of the AIA *pro bono* programs. The law school clinics may also consider partnering or coordinating with the AIA *pro bono* program in the school's region.

Through the synergy between both of these programs, the USPTO continues to strive towards a seamless integration of legal systems providing competent legal representation to small businesses and individual innovators seeking protection of their intellectual property.

D. Recommendations of Director

The legislation that established the Program requires that the USPTO include in its Report to Congress any recommendations of the Director for modifications to the Program.

At this time, the USPTO Director has no recommendations for modifications to the Program. With the steady growth of the Program, the USPTO has made changes and improvements as necessary, and the USPTO will continue to review, analyze, and make adjustments to the Program to ensure that it remains as valuable and efficient as possible for the participating law schools, students, and clinic clients, as well as the USPTO.

III. CONCLUSION

Through the Law School Clinic Certification Program, more than 2,700 law school clinic students have been able to practice patent and/or trademark law before the USPTO under the guidance of a Faculty Clinic Supervisor. Not only has this provided superior legal training and invaluable experience to these students, but by providing their IP services to the public *pro bono*, this has also increased access to legal representation for the public.

Specifically, by expanding education about patents, trademarks, and the patents and trademarks system at the law school level, independent inventors and entrepreneurs that have otherwise not been able to obtain quality legal services, have been afforded access to the competent legal representation necessary to succeed and compete in today's economy.