



AMERICAN UNIVERSITY

W A S H I N G T O N , D C

Clinical Program

February 16, 2016

William R. Covey
Deputy General Counsel for Enrollment and Discipline
Director of the Office of Enrollment and Discipline

Dear Mr. Covey:

This letter provides comments on behalf of the Glushko-Samuelsan Intellectual Property Law Clinic at American University Washington College of Law (“Clinic”) in response to the U.S. Patent and Trademark Office (“USPTO”) request for public comment on its proposed rules removing the “pilot” status of the USPTO’s existing Law School Clinic Certification Program (“the Program”) and incorporating the requirements and procedures developed during the pilot.¹ Student attorneys in our Clinic participate in both individual client matters and policy matters advocating change in the law. Individual matters involve advising creative artists, non-profit organizations, small inventors and entrepreneurs, scholars, traditional communities, and others who otherwise would not have access to high-quality intellectual property law services, as well as representing them before various agencies. The Clinic employs the methodology of American University Washington College of Law’s nationally acclaimed Clinical Program. Our students take primary responsibility for every stage of the cases and other matters to which they are assigned, under the close supervision of an experienced team of full-time faculty members. Given our model of student ownership of the cases, our Clinic petitioned for the creation of this program in 2006 and has been fortunate enough to participate in the pilot version of the Program since it was established in 2008. We commend the USPTO for creation of the program and all the work that has gone into administering it during the pilot phase. Based on our many years of involvement, we recognize that the pilot has accomplished a number of important goals including providing students with valuable practice experience in the IP field as well as providing quality pro bono services for those who lack the financial resources to pay for legal representation in this area. We write to note some reservations with some of the metrics-based reporting requirements, including some that were not present in the pilot version of the Program, such as those in § 11.17(b)(3), § 11.17(b)(4), § 11.17(b)(5), and § 11.17(b)(6). While we understand the need for the USPTO to monitor law school eligibility and participation closely given that the Program is open to all accredited law schools, we

¹ USPTO Law School Clinic Certification Program, 80 Fed. Reg. 78155 (December 16, 2015).

believe that it is crucial that the central goal of developing better lawyers through student practice is not lost in some of the new metrics proposed in the rules presumably for law school clinic assessment for continuation in the Program.

The Reporting Requirements of the Proposed Rules May Not Advance the Underlying Goals of the Program Allowing Student Practice

In announcing the proposed rules, the USPTO notes that the Program allows “student practitioners [to] gain valuable experience drafting, filing, and prosecuting patent and trademark applications that would otherwise be unavailable to students while in law school.”² Another stated program goal is to “facilitate[s] the provision of pro bono services to trademark and patent applicants who lack the financial resources to pay for legal representation.”³

Our Clinic agrees with these fundamental goals and argued for the creation of a student practice rule at the USPTO based on them. These goals lie at the heart of the pedagogy and rationale used by clinical faculty establishing law student practice rules in federal and state courts across the country. We suggested that, among other goals, a USPTO student practice program should provide competent legal representation to individuals and entities that otherwise would not obtain quality legal services in the intellectual property space and improve the quality of legal education of law students.⁴ Advocates for student practice rules have noted that clients welcome student representation because students provide some guidance and support where there otherwise would be none.⁵ Law schools, students, and the bar have welcomed student practice because it bridges the gap between theory and practice and increases students’ abilities to experience practice early in their careers.⁶ Under the proposed rules, the USPTO sets some reporting requirements for participating in the Program that were not present in the pilot version. These reporting requirements are not only burdensome for faculty, but the focus exclusively on quantitative measures may even unintentionally serve to undercut the Program’s asserted goals.

In the experience of our clinic students, these new reporting requirements of the proposed rules fail to reflect important considerations such as the fact that it may not always be in the client’s interest to obtain IP rights with the USPTO, and the fact that quality representation of a client may involve complicated research and multiple consultations extending the representations. Additionally, many intellectual property clinics include areas of practice outside of trademark and patent so clinic students may not have any Program-eligible

² *Id.* at 78155.

³ *Id.*

⁴ See Memorandum from Josh Sarnoff, Glushko-Samuels Intellectual Property Law Clinic, to James Toupin and John Whealan, USPTO (October 31, 2006) (on file with Clinic).

⁵ See Wallace J. Mlyniec & Haley D. Etchison, *Conceptualizing Student Practice for the 21st Century: Educational and Ethical Considerations in Modernizing the District of Columbia Student Practice Rules*, 28 Geo. J.L. & Ethics 207 (2015).

⁶ *Id.*

clients in a given semester. In such respects, qualitative rather than quantitative assessment measures might better reflect the underlying goals of the Program.

One of the primary goals of the Program is the provision of quality pro bono services to those who cannot afford them. Many of these clients are nonprofit organizations, small businesses, and other small entities. Additionally, many of these clients have no previous exposure to intellectual property. These clients often have marks, trade names, or inventions that are not eligible for federal registration, realize after consultation that federal registration does not convey the benefits they are seeking, or are unable or do not wish to pay the costs associated with registration after assessing the costs and benefits with clinic student attorneys. Accordingly there are times when registration may clearly not be in the best interest of the client.

For example, two current student attorneys from the Clinic recently worked on trademark issues with a local start-up working out of an incubator. Working with the clients, the student attorneys assessed their needs carefully, weighing whether they would even need a trademark at all. After long discussions, the student attorneys and the client agreed to file applications for two trademarks for different classes. After being counseled on their options, many clients who have consulted the clinic have decided it was not in their best interest to register a trademark. In this case, it was in the best interest of the client to register their marks.

Quality IP representation can take a long time for some clients, and this is especially so in pro bono practice with clients of limited means and start-up ventures. One such client came to the clinic last year for trademark consultation and was interested in three potential trademarks for his new business. The clinic students worked with him to determine the likelihood of success for these three marks, eventually advising him that three of his potential marks would be difficult to register and one was likely to succeed. The mark that the client was most interested in was the mark, which they determined to be unregistrable. The client's business was not up and running yet, so the client decided to take some time to think through his options while further developing his business plan. The client came back to the clinic this year, and two of our student attorneys took him on as a client. While his business was still in the early stages, he decided that he was ready to proceed with his desired mark, regardless of the anticipated problems. After much consideration, the client decided it was worth it to him to have a concrete answer regarding the possibilities in registering the mark. The student attorneys filed his trademark application in the fall almost a year after he first came to the clinic.

Under the reporting requirements of the proposed rules, the USPTO appears to be looking to numbers client consultations, representations and registrations in order to assess a clinic's performance in the Program. These measures do not always promote the best interest of clients. The proposed rules state that, a law school that does not meet each of the requirements and criteria for participation in the Program as set forth in § 11.16, § 11.17, or as otherwise established by the OED Director may be removed from the Program. Since it is not clear if law schools participating in the Program would be penalized by the OED director under various provisions such as § 11.17(c)(1)(ii) and § 11.17(d)(1)(ii), these requirements could be construed to

provide a disincentive for the type of representation and counseling undertaken in the examples outlined above.

Conclusion

With the interest of both the education of law students participating in the Program and the provision of quality pro bono services in mind, we request that the USPTO reconsider some of its numeric reporting requirements in the proposed rules. We believe that putting the focus more on quality legal education and quality representation rather than quantity of client interactions and USPTO filings would better advance the important goals of the Program.

Sincerely,



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