

Trademark Clinic (Course 792-0)
California Western School of Law
Syllabus – Spring & Summer 2021
Mondays 5:30-8:15

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Summary

The United States Patent and Trademark Office (USPTO) Trademark Clinic provides an opportunity for students to represent entrepreneurs and small businesses who may not otherwise be able to afford counsel before the USPTO. In conjunction with the casework, students will attend a three-hour seminar once weekly. The seminar will involve discussions about active cases, occasional work time as well as instruction on relevant law, and procedure.

Time Commitment

The American Bar Association standards for accrediting law schools contain a formula for calculating the amount of work that constitutes one credit hour. This is a 3-credit class. Therefore, in addition to attending class each week, your assigned readings, preparation for client matters, and other duties will require you to spend approximately 432 minutes (or 7.2 hours) outside of class on these tasks each week. Student work will include: (1) all aspects of advising and representing clients; (2) assigned readings and materials; (3) maintaining client files & docket; and (4) preparing for and attending weekly clinic seminars. **Students must accurately log all time worked.**

Clinical Learning Objectives

In the simulated format of a small law office, this clinic will introduce students to a range of issues integral to trademark practice before the USPTO. Subject to oversight from the clinic's supervising attorney, trademark clinic students will be admitted, under a provisional license, to practice before the USPTO. Students will be introduced to prosecution of trademark applications including preparation and filing of applications and other documents through the USPTO TEAS online system, as well as administrative functions of docketing trademark matters, time keeping, and conducting client intake interviews. Students will also be performing registrability searches, counseling clients on mark registrability and other matters related to trademarks registration and use. Over the semester, students will develop practical skills such as drafting, counseling, interviewing, researching, problem solving, and case management. By the close of the trimester each student will have worked with clients to complete multiple filings before the USPTO, allowing the student to apply the material they have studied.

In the clinic, we will explore the following skills briefly or on a fairly basic level:

- Active listening, information gathering and counseling skills;
- Preventive and proactive problem solving; and
- Interviewing to facilitate effective decision making and positive client relationships.

The following matters will be the focus of the course. These concepts or procedures will be studied in depth to facilitate a more advanced state of understanding:

1. Evaluate potential trademarks for substantive issues;
2. Conduct trademark searches;
3. Prepare & submit trademark filings to the USPTO;
4. Effective communication with USPTO examiners during prosecution of trademark applications; and
5. Effective communication with clients regarding:
 - a. Legal language associated with federal trademarks;
 - b. The federal trademark application and registration process;
 - c. Significance of communications from the USPTO; and
 - d. Benefits and obligations of federal trademark ownership

Required Text and Resources

1. *Gilson on Trademarks: A Practitioner's Guide*, available with Lexis access by searching the title, or here:
 - a. <https://advance.lexis.com/api/permalink/bf4e7661-86ef-42c0-928b-60f07df6c057/?context=1000516>
2. David A Binder, Paul Bergman, Paul R Tremblay, Ian S. Weinstein, *Lawyers as Counselors: A Client-Centered Approach* (3rd ed. 2012)
3. USPTO *Trademark Manual for Examining Procedure* (TMEP)) available here:
 - a. <https://tmepl.uspto.gov/RDMS/TMEP/current>
4. Trademark Prosecution and Practice Before the USPTO. A Casebook for Students And Practice Guide for Attorneys. By Dana Robinson

Students may also at times be required to use other resources available online, as provided via email or other means.

Evaluation and Attendance

Each student's final grade will be based their clinical performance in time management, record keeping, client communication, and filings. **A USPTO filing deadline missed due to the fault of a student may result in immediate withdrawal from the Clinic with a grade of "F".**

A closing client memorandum summarizing the work done, the current status and future tasks to be undertaken for each client is required as a precondition to obtain credit for the clinical course.

There are 300 points possible, distributed as follows.

Client Communications & Management	70
Participation in class discussions & demonstrations	60
Docketing, time keeping & other record keeping	55
Complete & Competent Filings	70
Effective communication with Supervising Attorney & fellow clinic participants	45

Professor Hedayati also reserves the discretion to award classroom participation points ("Push Points") in accordance with CWSL's policies.

Attendance at clinic seminars is mandatory. Only one absence is allowed without special advanced permission. **Students exceeding the allowed absence will be subject to withdrawal from the**

course with a grade of “F”. Students may be allowed to remain in the course in exceptional circumstances and with permission of the instructor and either the Vice Dean or Dean of Students.

Class Schedule (subject to change)

Students DO NOT need to read any sections in TMEP or the suggested readings regarding §44(d) [applications based on a foreign application], §44(e) [applications based on a foreign registration], or §66(a) [request for extension of protection through the Madrid Protocol], or paper filings unless otherwise specified in class. These matters are generally outside of the scope of the clinic.

Start of Course –

READING:

- Robinson, Introduction.
- Gilson: §1.02, Trademark Terminology; §4.01, Federal Registration Attributes and Relationship to Common Law Rights; §15.11, Electronic Filing and Other Online Services of the USPTO
- Binder: Chapter 1, Client Centered Lawyering, Chapter 2 Motivation
- USPTO Rules of Professional Conduct 11.101-.04; 11.106; 11.201 & 11.303
 - Available in the *Manual of Patent Examining Procedure* (MPEP) by searching the USPTO website, or here:
https://mpep.uspto.gov/RDMS/MPEP/current#/current/ar_d1fd14_2a7b4_1a7.html
- Video on how to set up USPTO account available by searching the USPTO website, or here:
 - **The step by step instructions start at 7:24 and end at 23:40.** But you are welcome to watch the whole video as well
<https://youtu.be/TwGA9NFibGY>

REVIEW OF CLINIC PROCESSES: DOCUMENTS & RESOURCES:

- Introduction to Trademark Clinic
- Professional Responsibility
- Outline of the nature of USPTO trademark practice
- Use of USPTO online trademark resources:
 - Examination Manual (TMEP)
 - Review of trademark files online (TSDR)
 - File History Record of a Typical PTO Trademark Case
 - Trademark Electronic Application System (TEAS)
 - Creation of USPTO account

Week 2

READING:

- Robinson, Genericness.
- Gilson: § 15.11, Electronic Filing and Other Online Services of the USPTO; §16.01, Applications for Registration on the Principal Register Based on Use; §17.01, Applications for Registration on the Principal Register Based on Intent to Use a Trademark; §20.01, Applications for Registration on the Supplemental Register
- Binder: Chapter 4, Forms of Questions

Review of Clinic processes: client communication, files & docket

- Use of Clinic resources
- Client Communications
- Transfer of existing docket cases to new student practitioners
 - 'Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative' Form
- Time Logs
- Docket Call (Systematic discussion of the status of new and existing cases, group discussion of client communications, planning, filings, prosecution, scenarios and problems encountered)

Week 3 - You must attempt contact with all of your assigned clients before 3:55 Thursday

READING:

- Robinson, Descriptiveness.
- Gilson: §22.02, Application Drawing Pages; Drafting Guide; §23.02, Specimens of Use; Drafting Guide; §18.01, Intent-to-Use Follow-Up Forms

Review of Clinic processes: pre-filing procedures

- Defining the mark
- Descriptions of Goods and Services, classes (USPTO's ID Manual)
- Trademark searching (TESS)
- Intake of new clients
- Engagement letter
- Registration Letter & Info sheet

Docket Call – All student practitioners on call. Docket must be updated to current status before start of seminar each week.

Week 4

READING:

- Robinson, Deceptively Misdescriptive Marks.
- Binder: Chapter 5, Interviewing: Getting Started

Suggested Material:

- USPTO TMIN: "Searching" video [run time about 13 minutes] available here:
 - <https://www.uspto.gov/trademarks-getting-started/process-overview/trademark-information-network#heading-3>; or
 - by searching the USPTO website for the 'Trademark Information Network' videos

Docket Call - All student practitioners on call. Docket must be updated to current status before start of seminar each week.

Week 5 - Time log for weeks 1-4 due by email before 3:55pm Thursday

READING:

- Robinson, Acquired Distinctiveness.
- Gilson: §1.03, Trademark Functions and Rational for Protection
- Binder: Chapter 9, Interviewing: Concluding Stages of Initial Meetings

Suggested Material:

- TMEP: §1200, Substantive Examination of Applications §§1201-1201.02(c), Ownership of Mark; §1202, Use of Subject Matter as Trademark

Review of Clinic processes: filing procedures

- Trademark Registration Opinion Letter
- New Application
- Intent to Use forms: Statement of Use & Request for Extension of Time to Prove Use
- Payment Procedure
- Notification of Filing Letter

Docket Call - All student practitioners on call. Docket must be updated to current status before start of seminar each week.

Week 6 - Students must have submitted 1st Registrability Opinion letter before 3:55pm Thursday

READING:

- Robinson, Supplemental Registration
- Gilson: §3.08, Absolute Statutory Bars to Federal Registration; §3.09; Qualified Statutory Bars to Federal Registration
- Binder: Chapter 12, Counseling: An Overview

Docket Call – All student practitioners on call. Docket must be updated to current status before start of seminar.

Week 7

READING:

- Robinson, Geographic Significance.
- Gilson: §3.01, Trademark Selection, Searching and Clearance

Docket Call – All student practitioners on call. Docket must be updated to current status before start of seminar.

Week 8

READING:

- Robinson, Trade Dress.
- Gilson: §2.03, Descriptive Matter

Docket Call – All student practitioners on call. Docket must be updated to current status before start of seminar.

Week 9 - Time log for weeks 5-8 due & Students must have at least submitted 2nd Registrability Opinion before 3:55pm Thursday

READING:

- Robinson, Likelihood of Confusion.
- Binder: Chapter 14, Counseling: Exploring Consequences; Chapter 15, Counseling: Final Decision Making

Docket Call - All student practitioners on call. Docket must be updated to current status before start of seminar.

Week 10

READING:

- Robinson, Fraud, Bona Fide Intent and Abandonment.
- Gilson: §3.02, Establishing Rights Through Actual and Intended Use; §4.01, Federal Registration Attributes and Relationship to Common Law Rights Use

Docket Call - All student practitioners on call. Docket must be updated to current status before start of seminar.

Week 11 - Students must have at least submitted 3rd Registrability Opinion letter before 3:55pm Thursday

READING:

- Gilson: §23.02, Specimens of Use Drafting Guide

Docket Call – All student practitioners on call. Docket must be updated to current status before start of seminar.

Week 12

READING:

- Gilson: §7A.01, Trademark Issues on the Internet; §7A.17, Hashtags, Emoticons and Emojis

Docket Call – All student practitioners on call. Docket must be updated to current status before start of seminar.

Review of Clinic processes: Wrapping up Representation of Clients

- Termination of Representation & change of correspondence information
- Continuation of Representation & passing on to new student practitioner

Week 13

Winding down of representations, reflection on clinic experience & selection of clients for next semester. **Attendance is mandatory.**

All course documents and procedures are due no later than 12:00pm noon Thursday, April 9th, including:

- Time logs for weeks 9-13 (and week 14 If you spent time to wind down matters during this time)
- Closing Memos
- File uploads of emails, filings, etc
- Client communications & matters closed, or in an appropriate state to be dormant over semester break and resumed by new student practitioner next semester.

These are all course requirements that have a direct impact on your grade for this course.