

**California Western School of Law  
Student Trademark Clinic**

**ENGAGEMENT LETTER**

Client:

Date:

We are very pleased that you have requested California Western School of Law Trademark clinic to represent you with respect to certain trademark matters. It is our understanding that we will be responsible solely for those matters which have been expressly delegated to us, namely, new matters you authorize. This letter sets forth the terms of our engagement as to all such matters, whether past, present or future.

**A. SCOPE OF WORK**

Pursuant to our review of your submitted information, the CWSL Trademark Clinic ("the Clinic") has agreed to represent you in connection with the following matter(s):

- Electronically filing an application for federally registered marks.
- Electronically responding to office actions, and other online procedural steps associated with obtaining a registration (use-based application), allowance (intent-to-use (itu) application) or abandonment.

The purpose of the Student Trademark Clinic is to give actual pro bono trademark prosecution experience to students under a supervising attorney. Usually, this means that, subject to your instructions, the student with the supervising clinical supervising attorney will determine the overall strategy for a given case, and then supervise student in the implementation of that strategy.

As needed, however, other attorneys and non-attorney professionals may be involved with your matters and may confer among themselves about your matters in order to permit your work to be efficiently handled.

The Trademark Clinic is not set up to represent clients in litigation, cease and desist matters and other matters known as inter parte proceedings before the US Trademark Office. You should also be aware that there some matters, such as section 1a use-based applications and ITU applications under Section 1b require further actions and payment of fees in the months and years after registration and allowance, which the Clinic will not docket nor service. These additional fees are associated with extensions of time or additional recurring but renewal or use filings that will be required to preserve the mark. The responsibility for docketing and payment for a post allowance ITU application is solely yours. We advise you that you may want to retain the services of an attorney or annuity service.

## **B. AUTHORITY TO BIND**

Client hereby designates \_\_\_\_\_ (“Designated Representative”) as the individual who has the legal power and authority to bind Client.

Client hereby authorizes the Clinic to rely upon the acts and direction of its Designated Representative as the binding acts and direction of the Client.

Upon the termination or withdrawal of the Designated Representative's legal power and authority to bind Client, the Designated Representative shall provide written notice to the Clinic of such termination or withdrawal. The Clinic is entitled to rely upon its Designated Representative's legal power and authority to bind Client until actual receipt of such written notice.

## **C. CLIENT RESPONSIBILITIES**

Please note that under the trademark laws it is necessary to file declarations of use and incontestability between the fifth and sixth year after registration and to renew the registration every ten years. The Clinic will not docket nor provide any such post-registration services. You must maintain your registrations yourself or obtain professional counsel or an annuity service to assist you when later necessary.

## **D. APPLICABLE USPTO FEES OR COSTS**

There is no charge or fee for the legal services provided by the Clinic. The only fee you will incur is the filing fee charged by the USPTO upon our submission of an application for registration. Please note that this fee is nonrefundable and will not be returned to you in the event that your application does not mature into a registration. It must be borne in mind that as long as a mark is being used in commerce, it may be renewed indefinitely and thus may have a lifetime of many decades. Only you have the responsibility of maintaining your registrations.

Be mindful that there is never any guarantee that a registration will be granted. Also please note that the USPTO charges a filing fee for every mark applied for and for every class of goods or services identified in an application. Thus, in some cases you may incur more than one filing fee and be required to pay additional fees during the trademark prosecution to obtain full coverage of your goods and/or services in additional classes. It may also occur that an application may be divided during prosecution, thereby incurring additional fees.

The USPTO currently charges between \$295 and \$325 for filing an application per class, depending on the type of application submitted. Be advised that the USPTO may change its fees without notice to you from time to time. In the event that an appeal is filed from an Examiner's decision to the Trademark Trial and Appeals Board, additional appeal filing fees will be due at that time. The Clinic will not undertake any action with will incur additional out-of-pocket fees without your preapproval.

## **E. CLIENT COSTS**

After reviewing the information you have provided us, we have determined that you will incur costs of \$\_\_\_\_\_ in connection with the application process. These

costs must be advanced or be charged directly to your credit card account by the USPTO. The Clinic will supply you with a form that will be used to make the payment the required by credit card. The Clinic will notify you when your application is submitted to the USPTO and will keep you apprised of any developments in connection with the prosecution of your application.

We do not charge professional fees but require all out-of-pocket costs, to be advanced by you or paid directly or indirectly by you. Out-of-pocket costs may include Trademark Office filing fees, trademark illustrator's fees, photocopies, postage, messenger services, and the like. The USPTO has a Credit Card Authorization Form that will be used to process all transactions. The Clinic does not engage in any billing, or advance of fees.

## **F. LIMITATIONS ON CLINIC WORK**

It must be borne in mind that the engagement of services of the Clinic is limited to specific electronic trademark prosecution tasks and excludes litigation or pre-litigation counseling. If you have received litigation demands or anticipate that you will be in a dispute with another party, you must handle the matter yourself or employ the services of a practicing attorney outside the Clinic.

The primary purpose of the Clinic is to provide an educational experience for students representing clients under supervision of an attorney and may result in some delay. Therefore so if time is of the essence, then you should consider using the professional services of an outside attorney or handling the matter yourself. No representations are made concerning the time frames during which any action will be made or completed.

No representation or warranty is made concerning the registrability, fitness, or commercial viability of any related business or the legal or commercial effect of the mark will or will not have on the success of that business.

No opinion will be rendered concerning the availability of a mark for use in commerce notwithstanding that the US Trademark Register might be searched to see if an identical mark for the same goods or services is registered to another or the subject of a previously filed application.

All risks arising from adoption, use or exploitation of the mark in any way is entirely assumed by you and is not assumed by or included in any responsibility or obligation of the Clinic.

## **G. NOTICE REGARDING CHANGES**

Because it is important that we be able to contact you at all times in order to consult with you regarding your intellectual property matters, we require that you inform us, in writing, of any changes in the name, address, telephone number, state of incorporation or other relevant changes regarding you or your business. Whenever we need your instructions or authorization in order to proceed with legal work on your behalf, we will contact you at the latest business address we have received from you. If we cannot reach you at that address, we cannot properly represent you, and you hereby

authorize us to withdraw as your attorneys and to permit your application to become abandoned.

#### **F. LEGAL ADVICE**

As you may expect, it is very difficult to predict the outcome of legal matters. Therefore, nothing in this Agreement and nothing in our statements to you should be construed as a promise or guarantee as to the outcome of your intellectual property matters. Our comments about such should be construed only as expressions of our professional judgment and not as predictions or guarantees of any particular result.

In particular, in filing a trademark application, there is no guarantee that the application will be allowed so that a registration will result. The corresponding cost estimate for filing a trademark application does not include the later expense of maintaining any resulting registration.

#### **G. TERMINATION OF RELATIONSHIP**

The attorney-client relationship is one of mutual trust, confidence and respect. Thus, you retain the right to discharge us as your counsel at any time for any reason. Likewise, we retain the right to cease representing you, for any reason, after giving you reasonable notice of our decision to withdraw. You agree to sign all paperwork necessary to effect our withdrawal.

#### **H. ARBITRATION**

Should a dispute ever arise over our services or fees, you hereby agree with us to resolve all issues through binding arbitration before the American Arbitration Association in San Diego County, California, and in accordance with their rules. You should be aware of your right to also preliminarily mediate the matter before the San Diego County Bar Association in an effort to reach an amicable resolution. The prevailing party in any such arbitration, or in any legal proceeding brought to enforce any arbitration or interpret any provision of this Agreement, will be awarded reasonable attorney's fees and costs incurred in that arbitration or proceeding.

Before signing this Agreement, you should recognize your right to seek independent counsel of your choice with respect to the terms of this Agreement.

By signing this Engagement Letter, you signify your understanding that the legal work provided by the Clinic will be performed by students of California Western School of Law working under the supervision of an attorney licensed in California. Included is a copy of this letter for your review, signature, and return to the Clinic in a postage-paid envelope or fax to (619) 696-9999. If any of the information in this letter is not consistent with your understanding of our agreement, please contact the Director of the Clinic before signing the letter. Otherwise, please sign the enclosed copy of this letter and return it to the Clinic. If you have any questions, please contact the Clinic at your convenience.

California Western Law School Trademark Clinic

---

Student Practitioner Signature

---

Supervising Attorney

I have read this letter and consent to the terms and conditions stated herein.

---

(Client name)

---

Designated Representative (if applicable)

Date: \_\_\_\_\_

---

**Please send the executed Engagement Letter to Prof. Eric Morton, [emorton@cwsj.edu](mailto:emorton@cwsj.edu), or fax with a cover sheet to (619) 696-9999. Thank you.**

---