

Trademark Clinic (Course 792-0)
California Western School of Law
Syllabus – Spring 2018 - REVISED
Thursday 10:45-12:45; Room ELC 202

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Summary:

The United States Patent and Trademark Office (USPTO) Trademark Clinic provides an opportunity for students to represent entrepreneurs before the USPTO who cannot afford counsel. In addition to the casework, students will attend a two-hour seminar once weekly. The seminar will involve discussions about the cases, as well as instruction on relevant law, procedure and evidence.

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 2-credit class, meaning that, in addition to attending class each week, the professor has determined that the assigned readings and your preparation for client matters or other assignments will require you to spend 264 minutes (or 4.40 hours) each week outside of class preparing for class, advising and representing clients, and for any other assignments. Student work will include: (1) all aspects of advising and representing clients; (2) assigned readings and materials; and (3) preparing for and attending weekly clinic seminars. **Students must log all casework hours worked, even after the 90-hour threshold is satisfied.**

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 supervision from the clinic supervising attorney, trademark clinic students will be admitted, under a temporary license, to practice before the USPTO. Through the clinic, students will be introduced to transactional trademark matters including administrative functions of docketing trademark matters, logging their time and conducting client intakes. Students will also be performing registerability searches, advising clients on mark registerability, and counseling individuals on other matters related to federal trademark matters. 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 work with real clients to complete multiple filings before the USPTO that allow the students to pull together issues 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 for students 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. Communicate with USPTO examiners during prosecution of trademark applications; and
5. Communicate the following to clients:
 - 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) TMEP, Trademark Manual for Examining Procedure 2017, available on the USPTO website: <https://tmep.uspto.gov/RDMS/TMEP/current> , and also as “Part VI” in *Gilson on Trademarks*
- 2) Anne Gilson LaLonde, *Gilson on Trademarks* (Matthew Bender): available through Lexis
- 3) David A Binder, Paul Bergman, Paul R Tremblay, Ian S. Weinstein, *Lawyers as Counselors: A Client-Centered Approach* (3rd ed. 2012)

At this time, there are no prerequisite for this course. However, students who have not previously, or are not concurrently taking Trademark Law may wish to use the Suggested Materials to supplement their learning so they are able to provide competent representation to their clients.

Students may also at times be required to use other resources available online, as provided via email, or through the clinic TWEN page.

Evaluation and Attendance:

The students’ final grade will be based on a number of evaluative tools. Students will be evaluated on their clinical performance as shown by client interviews and management, record keeping, client communication and correspondence, and number of filings.

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

There are 200 points possible, distributed as follows.

Client Communications & Management	60
Participation in class discussions & demonstrations	40
Docketing, time keeping & other record keeping	40
Completed Filings	40
Effective communication with Supervising Attorney & fellow clinic participants	20

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 1 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):

The “Required Readings” from the text resources are listed for each class so that students may read *in advance* of each class.

Week 1

READING:

- TMEP §§ 101-107
- ABA Model Rules of Professional Conduct 1.1, 1.2, 1.3, 1.6, 1.7, & 3.3
 - Available here:
 - https://www.law.cornell.edu/ethics/aba/current/ABA_CODE.HTM#Rule_1.1

Introduction to the Trademark Clinic
 Professional Responsibility
 Outline of the Nature of PTO Trademark Practice

Review of Clinic processes: documents & resources

- 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)

Week 2

READING:

- Binder: Chapter 2, Motivation; Chapter 3, Active Listening;
- Suggested Material:
 - INTA Trademark Basics: A Guide for Business – available here:
 - http://www.inta.org/Media/Documents/2012_TMBasicsBusiness.pdf; or
 - As a PDF document on the clinic TWEN page

Review of Clinic processes: client communication, files & docket

- Client Communications
- Docket
- Client Files
- Time Logs

Docket Call (assignment of clients & related documents)

- Transfer of existing docket cases to new student practitioners
- Initial Client Interview Form

- Engagement Letter

Week 3 – You must attempt contact with all of your assigned clients before this seminar meeting

READING:

- Gilson, Sections 1.02; 1.03 & 2.01
- Binder, Chapter 4, Forms of Questions
- Suggested Material:
 - USPTO Trademark Information Network: “Before You File” video [run time about 11 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

Review of Clinic processes: pre-filing procedures

- Defining the mark
- Descriptions of Goods and Services (USPTO’s ID Manual)
- Trademark searching (TESS)
- Trademark Registration Opinion Letter

Docket Call – All student practitioners on call. Docket must be updated to current status before start of seminar. (Systematic discussion of the status of new and existing cases, group discussion of client communications, planning, filings, prosecution, scenarios and problems encountered)

Week 4

READING:

- Gilson, Sections 2.03 (EXCLUDING 2.03(4)(c)(iv, v, & vi) and 2.03(4)(d)(iv & v)); 2.04 & 2.15
- TMEP § 800 (all) Application Requirements
- 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

Review of Clinic processes: filing procedures

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

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

Week 5 - Time log for weeks 1-4 Due at the start of this clinic seminar by email or hard copy

READING:

- Gilson, Sections 3.01; 3.02 (EXCLUDING 3.02(C)) & 3.03
- TMEP § 700 (all) Procedure for Examination

Review of Clinic processes: pre-filing procedures

- Trademark searching (TESS)
- Trademark Registration Opinion Letter

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

Week 6

READING:

- Binder, Chapter 5, Beginning Client Conferences; Chapter 11, Concluding Client Conferences
- TMEP §1200 (all) Substantive Examination of Applications
- USPTO announcements available on TWEN

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

Week 7 - Students must have submitted 1st Registerability Opinion letter by the start of this clinic seminar

READING:

- Gilson, Section 3.04
- TMEP §1600 (all) Registration and Post-Registration Procedures

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

Week 8

READING:

- Gilson, Sections 4.01 & 4.07
- TMEP § 900 (all) Use in Commerce
- Binder, Chapter 12, Gathering Information from Especially Difficult Clients

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 at the start of this clinic seminar by email or hard copy

READING:

- Gilson, Sections 4.05; 4.09 & 4.11
- TMEP §1400 (all) Classification and Identification of Goods and Services
- Binder, Chapter 13, Principles Underlying Effective Counseling

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

Week 10 - Students must have at least submitted 2nd Registerability Opinion letter by the start of this clinic seminar

READING:

- Gilson, Sections 7A.01; 7A.02; 7A.04 & 7A.17
- TMEP §§ 301, 303, 304, 308 & 310

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

Week 11

Review of Clinic processes: Wrapping up Representation of Clients

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

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

Week 12

Reflection on Clinic Experience

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

Week 13 – last week of courses – no class

The following course documents and procedures are due no later than Thursday April 12:

- Time logs for weeks 9-13 (and week 14 if you spent time to wind down matters during this time)
- Closing Memos
- Docket & Sharepoint Updates & Uploads
- Client communications & matters closed, or at a fit state to be dormant over semester break and resumed by new student practitioner next semester.

These are all course requirements that if not completed will have a direct impact on your grade for this course.

End of course