The John Marshall Law School Patent Clinic has been certified by the United States Patent and Trademark Office (USPTO) in its school clinical certification pilot program. Through this law school clinical certification pilot program, the USPTO's Director of Office Enrollment and Discipline grants students enrolled in the patent clinic courses limited recognition to practice before the USPTO.

Patent Clinic offers pro bono patent work for appropriate inventors and is supported by the patent practitioners, staff from the Center for Intellectual Property Law, and students from the John Marshall Law School. Patent work includes all patent work which can be done by a person registered before the USPTO. This includes work such as drafting patent applications, responding to office actions, and etc. Work requiring a law license, such as litigation and licensing may be included, depending on the engagement. Please note that patent work of the Patent Clinic is currently free of charge to inventors but they are responsible for any out-of-pocket costs to third parties, including costs such as searching costs, drawing costs, filing costs, and similar costs.

The following sections outline the general scope, procedures, and associated risks of the patent work performed by the Patent Clinic. The Patent Clinic, although it’s free of charge, may not be suitable for everyone. Therefore, please read the following sections completely before submitting your invention disclosures to the Patent Clinic.
Submission and Review Thereof

1. **General**

Submission of disclosure and other information to the Patent Clinic does not guarantee that the Patent Clinic will provide any services or will undertake the requested patent work. Any rejected submission will be destroyed or returned to inventors based on inventors’ instructions. If the requester wishes to have the submitted material returned, please include a self-stamped return envelope in the submission.

In general, patent work for the Patent Clinic is planned early in July for each fall semester and late November for each spring semester. The Patent Clinic reviews each submission by performing a preliminary patentability search before accepting the submission. You will be notified promptly if the Patent Clinic will accept the submission.

With the implementation of the America Invents Act on March 16, 2013, however, the Patent Clinic is implementing the following program to assist inventors to avail themselves to the coverage of the new law.

2. **Provisional Program**

Briefly, with the implementation of the America Invents Act, the patent filing system of the United States is now a first-inventor-to-file (FITF) system for applications filed on or after March 16, 2013 with no claim to prior filed application on or before March 15, 2013. The FITF system may also apply to applications filed on or after March 16, 2013 that include matters that were not previously disclosed in applications filed on or before March 15, 2013.

As such, with the limited resources available to the Patent Clinic, the Patent Clinic is implementing an Provisional Program in which the inventors complete a detailed questionnaire (Attachment 1) designed and prepared by the Patent Clinic. The Patent Clinic will not review the completed questionnaire for accuracy or completeness; rather it is the inventors’ responsibility to ensure each question is answered completely and thoroughly.
Once the questionnaire is completed, the Patent Clinic will assist the inventor with the filing of a **provisional patent application**. The inventors will be responsible for the filing fee.

Once the provisional patent application is filed, the Patent Clinic will begin the evaluation of the invention as discussed in paragraphs under the section heading “**General**”. If the invention is selected by the Patent Clinic to perform the patent work, a nonprovisional patent application will be filed claiming the priority to the provisional patent application filed during the Provisional Program.

3. **Nonprovisional Program**

If inventors do not wish to participate in the Provisional Program described in the section above, the Patent Clinic will proceed with the Nonprovisional Program, which does not involve the filing of a provisional patent application. Patent Clinic will evaluate the invention as discussed in paragraphs under the section heading “**General**”. If the invention is selected by the Patent Clinic to perform the patent work, a nonprovisional patent application will be filed. The inventors will be responsible for the filing fee.

4. Differences between the two programs

The differences between the Provisional Program and the Nonprovisional Program are illustrated below:

<table>
<thead>
<tr>
<th>Differences</th>
<th>Provisional Program</th>
<th>Nonprovisional Program</th>
</tr>
</thead>
<tbody>
<tr>
<td>Patent Clinic time evaluating, searching, etc. before accepting the submission before filing of a Provisional Patent Application</td>
<td>None</td>
<td>Not applicable</td>
</tr>
<tr>
<td>Inventor time in completing the questionnaire before filing the Provisional Patent Application</td>
<td>Depends on inventor</td>
<td>Not applicable</td>
</tr>
<tr>
<td>Cost of filing the Provisional Patent Application</td>
<td>Provisional filing fee paid for by inventor</td>
<td>Not applicable</td>
</tr>
</tbody>
</table>
5. Submitting your answers to the questionnaire below.

Please follow the instructions carefully as it is important to answer all of the questions in the questionnaire completely and thoroughly. **If you wish to participate in the Provisional Program, in particular, your answers to the questions provide the basis for your provisional patent application and support for the nonprovisional patent application at a later time.**

a. Please answer the questions on separate sheets.

b. Please use plain English and explain your answers. For example, please assume the reader has no understanding whatsoever about your invention. As such, please describe your invention as simple as possible by providing details to each part and element of your invention. The details may include information such as shapes, sizes, color, weight, etc.

c. Please also describe in detail how different pieces of your invention fit together.

For example, please avoid statements such as “the base and tower can be combined
together…” Instead, a statement such as “For example, a L-shaped bolt of 2” long may be coupled between the base and the tower at the distal end of the base…”

d. Please also describe how would someone use the invention as if you would have used the invention.

Your answers will only be seen by a person, or persons, licensed by the USPTO and thus required by federal regulations (37 CFR Part 10) to keep the information secret and, if not licensed by the USPTO, having signed an agreement to abide by all the terms of 37 CFR Part 10.
Send this information by regular mail to:

Attn: Patent Clinic

Center for Intellectual Property Law

The John Marshall Law School

315 S Plymouth Ct

Chicago, IL 60604

Please alert us by email at patentclinic@jmls.edu when you mail this information so that we can take care that it does not go astray. We will send you a return email to acknowledge our receipt.
Information we need:

A. Your invention

1. Your name and contact information.

2. What is the date of conception of your invention? The date of conception is when you realize that you have conceived the necessary information for all parts or elements of your invention.

3. Have you recorded or documented your invention in any notes or journals? If you do, please state the earliest date that you have on your notes or journals that show you have conceived the invention.

4. When did you reduce it to practice? This means at what point in time (in terms of a date) did you put the parts you conceived above in questions #2 and 3 together as the invention you have conceived?

5. Have you ever made your invention known to the public in any way, such as telling your neighbors, your family members, your friends without asking them sign a Non-Disclosure Agreement (NDA)?

6. Have you ever offered the invention for sale? If yes, when was that?

7. What is your invention? Please feel free to take pictures or draw sketches of your invention from different angles. Please also label the different parts of your invention to help us understand your invention better.
8. What were the circumstances in which you conceived the invention? In other words, what led you to develop your invention? For example, was it because you tried to solve a problem that has bothered you for a long time? Or was it an idea that just came to you?

9. What are the parts of the invention? For example, if your invention were a bicycle, the parts include a handle, a body frame, two wheels, a seat, a set of pedals, a set of gears, a set of breaks, and a chain. Please feel free to take pictures from different angles (such as close-up, overview shots, etc.) or draw sketches of your invention from different angles. Please also label the different parts of your invention to help us understand your invention better.

10. What parts may not be essential to your invention? Using the bicycle example above in question #9, a gear shifting control would be nice addition to have, but it’s not essential. Similarly, a set bicycle lights or reflectors may be good for safety measures, but they are not essential to a bicycle invention. So, please describe what parts are not essential to your invention and why they are not essential.

11. What parts of your invention are essential? And why they are essential? Please take photos of these essential parts too.

12. Did you combine another part known in other technology to this your invention? Did you make any modification in order for the part to work in your invention? If yes, please explain in detail.

13. How do these parts of your invention achieve the intended results? For example, using the bicycle example again, when answering this question, one may explain that the intended
results of the set of gears, the set of pedals, and a chain are: to transfer a user’s pedaling motion to the second wheel and to propel the bicycle forward.

B. Existing technology

14. Can you identify any known technology that is relevant and close to your invention? For example, please describe how, in any way, are the parts of your invention different from any known existing related technology?

15. Why are the parts of your invention different?

C. Compare and Contrast between your invention and the existing technology

16. Why and how your invention is an improvement over the existing technology? Did you skip a step or eliminate a part that was required by the existing technology? Did you modify any part that is currently in the existing technology? Please explain if you answer “yes” to any of the above sub-questions.

17. How else is your invention superior to the existing technology?

18. What was unexpected discovery, if any, as you develop your invention?

19. What parts of the invention can be changed?

20. What connections between parts can be changed?

21. What parts can be left out?

22. What connections can be left out?

23. If you were asked to design around your invention or making an inferior version of your invention, how and what you would change your invention?
D. Financial questions

24. Why is your invention appropriate for free work?

25. Do you qualify for the small entity filing status according to USPTO’s rules?

26. Do you qualify the micro-entity filing status according to USPTO’s rules (see the rules here at http://www.uspto.gov/aia_implementation/faqs_fees.jsp#heading-4?)