At least one JMLS faculty member is Patent Clinic Faculty Supervisor and accepts at least one inventor as client pro bono according to the Terms of Engagement (pages 2 & 3 below). At least some JMLS salary may be associated with this work. The Patent Clinic Faculty Supervisor(s) and the terms of engagement define the Patent Clinic. As the terms of engagement specify the only work done is work covered by a USPTO license (full license and temporary license) – no work requiring a law license is done. It is the responsibility of the law school to provide the Patent Clinic Faculty Supervisor. (JMLS Adj. Prof. Don Moyer is now the Patent Clinic Faculty Supervisor with responsibility for 10 inventors, collectively having 4 new applications to file and 14 matters already pending in the USPTO.)

Students in USPTO Temporary License Program can file applications and can do all other work which a USPTO licensed person can do. Students in USPTO Temporary License Program take Class 439. At least one Patent Clinic Faculty Supervisor is also USPTO Faculty Supervisor.

Some class 439 students may have their own license and thus may not want to participate in the USPTO Program. (Others – graduates of Class 439 for example – can also do Patent Clinic work.)

Class 239 students work on an application for a Clinic inventor, but do not file applications. Class 239 is minimum requirement for Class 439.

Graduates of class 296 (Innovation Law Mentoring) can inform inventors about practical issues related to establishing and preserving patent rights, but do not offer any legal advice.
Engagement Terms for Patent Work by the
John Marshall Law School
Patent Clinic

Please initial each page of this paper (bottom right) and sign one copy of this paper at 2) below and return it (all pages) to:

Intellectual Property Law Center
Attn: Patent Clinic
John Marshall Law School
315 S Plymouth Ct
Chicago IL 60604

1) **APPOINT**: I (the person signing in 2 below) understand and agree to these terms and hereby appoint the faculty supervisor named here

SAMPLE

JMLS Patent Clinic Faculty Supervisor

USPTO Registration #

to be responsible for all patent work in the USPTO for the project specified here: (identify the project)

SAMPLE

(Note 1: *The only work done is work covered by a USPTO license (full license and temporary license) – no work requiring a law license is done.*)

(Note 2: *A faculty member at the John Marshall Law School will undertake to find an appropriate new faculty supervisor if the faculty supervisor named above should be unavailable.*)

2) **SIGNATURE**: Dated signature of person having authority to make this appointment:

SAMPLE

______________________________  ______________________________
Printed Name                      Signature

______________________________  ______________________________
SAMPLE                          Date of Signature

3) **STUDENT WORK:** Students at John Marshall Law School will usually do at least some of the work specified in 1) above. They will be coached and closely supervised by the faculty supervisor.

4) **DISCLOSURE** We have an absolute duty to disclose information which we believe could have effect on patentability of the invention. Therefore, we must be very precise about any such information.

5) **PROSECUTION AFTER APPLICATION** It could be two years and more before an office action is received from the USPTO. When an office action is received, the faculty supervisor will evaluate the case with you and will pursue appropriate further prosecution. If an office action allows the case, then the issue fee is due.

6) **RESPONSIVENESS AND DEADLINES** Patent procedures have formal rules and precise deadlines. It is your responsibility to review documents and instruct the faculty supervisor promptly. It is your responsibility to promptly give the faculty supervisor all documents and information relevant to your patent rights. The faculty supervisor will tell you of deadlines when the faculty supervisor learns of them. If you will not be available for a time please instruct the faculty supervisor in advance. If your address changes please tell the faculty supervisor in advance.

7) **FEES:** There are no fees for Patent Clinic work. There are however fees payable to third parties – such as USPTO fees, drawing fees, searching fees – which are your responsibility.

8) **TERMINATION AND WITHDRAWAL:** You have the right to terminate representation by the faculty supervisor at any time. The faculty supervisor has the right to petition the USPTO to be allowed to withdraw from representing you, normally giving you enough time to find new representation.

9) **CONFIDENTIALITY AND CONFLICT OF INTEREST:** You should not share your trade secrets with anyone until you have established a confidential relationship. Also, be sure to check on any conflicts of interest. In these and other responsibilities everyone in the Patent Clinic having access to your trade secrets and/or doing the work specified in 1) above will be bound by the regulations set out in Title 37 of the Code of Federal Regulations, Part 10.

10) **SIGNATURE OF FACULTY SUPERVISOR NAMED IN 1) ABOVE:**

    SAMPLE

    ____________________________  ____________________________
    Signature                      Date of Signature