



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF ENROLLMENT AND DISCIPLINE

MEMORANDUM TO: Law Schools Participating in the Law School Clinic Certification Pilot Patent Program

FROM: William R. Covey
Deputy General Counsel for Enrollment and Discipline and
Director of the Office of Enrollment and Discipline

DATE: June 15, 2012

SUBJECT: Information Regarding the Law School Clinic Certification Patent Pilot Program Request to Make Special

- The Law School Clinic Certification Pilot Program provides law students the opportunity to practice patent law before the USPTO. Each of the participating law school clinics provides services to their clients on a *pro bono* basis.
- The Law School Pilot Certification and Certification and Request to Make Special Program will permit each participating law school to designate up to two applications per academic semester to be advanced out of turn, with additional applications being awarded for advancement of examination on an *ad hoc* basis. Each school must certify that they provide all patent clinic clients with patentability searches and opinions prior to qualifying to receive the two applications advanced out of turn.
- Applications that are accorded special status under the Law School Clinic Certification Pilot Program's Certification and Request to Make Special Program will be placed on an examiner's special docket prior to the first Office action, and will have special status in any appeal to the BPAI and also in the patent publication process.
- Applications accorded special status under the Law School Pilot Request to Make Special Program, however, will be placed on the examiner's amended docket, rather than the examiner's special docket, after the first Office action (which may be an Office action containing only a restriction requirement).
- Continuing applications will not automatically be accorded special status based on papers filed with a request in a parent application. Each continuing application must on its own meet all requirements for special status and would count toward the allocation of applications that may be accorded special status under the Law School Pilot Request to Make Special Program.

Law School Clinic Certification Pilot Program
 Petition to Make Special Proposal
 June 15, 2012

- **Proposed Law School Pilot Request to Make Special Program—at-a-Glance**

Pilot Elements	Specifics of Pilot
Objective	Advance application out of turn for initial examination for student practitioners under the direction of a qualified law school clinical supervisor.
Application expedited during entire prosecution	No (Placed on Examiner’s Amended Docket).
Number Accepted in Pilot	64/year
Limitation on Schools	Up to two applications per academic semester to be advanced out of turn, with additional applications being awarded for advancement of examination on an <i>ad hoc</i> basis.
Proposed Requirements	
· Request	37 CFR 1.102(a) Request to Make Special
· Claims	The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims.
· Electronic Filing Requirement	The request to make special must be filed electronically.
· Request filing (timing)	The Request to Make Special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system.
· Law School Clinical Program Member	Law School must be member of the Law School Clinic Certification Pilot Program.
· Early publication required	The Request to Make Special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).
· Applications Eligible	The application must be a non-provisional utility application.
· Request Fee	None.
· Period for Response	As per standard examination procedures.
· Search	The Request to Make Special must be accompanied by a statement detailing that a pre-examination search was conducted and the results of the pre-examination search must be included on an Information Disclosure Statement or must have been submitted previously.