

USPTO TRADEMARK PROSECUTION CLINIC I and II

Fall 2026 /Course #

INSTRUCTOR:

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CLASSROOM COMPONENT:

Thursdays 2:30 – 4:30 p.m. at times may be virtual; RM TBD

A. ABOUT THE COURSE

The USPTO Trademark Prosecution Clinic I is a trademark law course for students who have completed either the Trademark and Unfair Competition law course or who are enrolled in or have completed the Trademark Law Simulation course. Trademark Prosecution Clinic II is a trademark law course for students who have completed Trademark Prosecution Clinic I. These Clinics are designed to give students practical experience in successful strategies to search, prepare, file, and prosecute a US Trademark Application with the United States Patent and Trademark Office.

Students will represent clients from various industries, primarily small business owners, and they will focus on trademark prosecution and counseling, including creating search strategies, employing legal and fact-based analysis, and giving advice to clients on successful trademark protection strategies both at the USPTO and in commerce.

The clinic has a classroom component that meets once each week for two (2) hours during the semester. During this classroom component students will receive a detailed overview of specific strategies and issues associated with their client's interests in protecting marks with the USPTO. The classroom component will equip students to approach searching, analyzing, drafting and filing US Trademark Applications, including counseling clients on what constitutes use in commerce which Congress may regulate, and/or bona fide intent to use a mark in commerce. We will be primarily reviewing the Trademark Manual of Examining Procedure (TMEP) as well applying specific cases to the analysis, such as the 13 Du Pont factors. **There will also be a mandatory clinic orientation, on [REDACTED] followed by a short meeting with our clinic in the lobby to chat for no more than thirty minutes. You have been provided with the clinic orientation manual and videos.**

In addition to the classroom component, students are expected to attend a Matters Meeting, the nature of which and day/time to be determined. During this time, students will present case updates, review communications and deliverables, and discuss intake and other clinic administration. While the classroom component functions more like a traditional law school class, the Matters Meeting offers students an opportunity to learn from each other regarding practical aspects of client representation.

B. LEARNING OBJECTIVES

Through in-class instruction and practical experience with real clients in various industries, students will:

1. Demonstrate an understanding of the issues associated with successful trademark prosecution and registration across a variety of industries;
2. Demonstrate an understanding of the statutory law and administrative guidance that underpin successful selection, prosecution, and protection of marks in US commerce;
3. Interview clients to gain an understanding of each client's specific needs and goals in mark selection, development, protection, and potential use of the mark(s) into the client's natural zone of expansion of trade.
4. Learn how to gather the correct information to and do a proper search and analysis to provide clients with valuable counseling in protecting their trademarks;
5. Counsel clients on protection of trademark rights, how to maintain and properly use a trademark, how to police unauthorized use, and how to develop brand goodwill for as long as the mark is in use in commerce;
6. Demonstrate a high degree of ethical and professional responsibility as counselors of individuals and entities seeking to protect their trademarks.

C. COURSE MATERIALS

1. The USPTO Website with a plethora a videos and handouts on trademark prosecution
<https://www.uspto.gov/trademarks/videos#type-trademark-basics>
2. The Trademark Manual of Examining Procedure online
<https://tmep.uspto.gov/RDMS/TMEP/current>
1. Version 12 of Trademark Law: An Open-Source Casebook by Barton Beebe
<https://www.tmcasbook.org/wp-content/uploads/2025/06/BeebeTMLaw-v12-digital-edition-1.pdf>
2. Subscribe to the TTABLOG <https://thettablog.blogspot.com/>

Supplemental reading materials may be provided to students at least one week prior to the start of classes and supplemental materials throughout the semester through Microsoft Teams and/or email.

D. CLASSROOM

There will be two components to this course, an in-person classroom component that focuses on substantive legal learning, and a Matters Meeting component that focuses on practical client representation. Clinic students are required to attend both the classroom and Matters Meeting components of this course. At times the sessions may be taught virtually via teams or zoom.

D. YOUR GRADE

THERE IS A PASS/FAIL OPTION ONLY FOR CLINIC II STUDENTS.

Your grade is based on a semester-long (summative) evaluation incorporating all aspects of the course. This will include attendance, class participation and the drafting assignments. The student pass/fail election is NOT available for this course.

This course offers is designed to provide feedback on student performance and competence. This includes student participation in class discussion and case rounds, individual meetings with faculty to discuss clinic work, and feedback from faculty on written work product, such as trademark applications, contracts, memoranda, and client emails. This course also provides summative assessment to evaluate overall performance at the end of the semester.

Your grade will be calculated based on the following:

Drafting Assignments both in and outside of class including Matter Memoranda	25%
Take Home Quizzes	15%
Client Interaction and Effectiveness, including File Management and Community Outreach	20%
Class Participation which includes Attendance	25%
Final Clinic Memorandum	15%

Community Outreach:

The Trademark Clinic collaborates with the SURESM Program at the C.T. Bauer College of Business and may time to time also advise students in local entrepreneurship programs affiliated with UH such as the Gordy Entrepreneur Lab at the Kinkaid School. The SURESM Program and others like it are education programs that serve aspiring local entrepreneurs, many from under-resourced communities in the Houston area. Students will be required to give a short presentation on a business law topic at a SURETM Program event expected to be held on a Monday evening late in the semester. Attendance at the SURETM Program event is mandatory unless a student has a Law Center class conflict. Students will receive additional details at orientation.

You might note that 45% of your grade depends upon you showing up and robustly participating in the class, managing your files, and effectively interacting with your client(s). This is because the Clinic is designed to TEACH YOU HOW TO PROSECUTE A TRADEMARK APPLICATION, AND EFFECTIVELY COUNSEL A CLIENT, NOT TO TRICK YOU.

Quizzes, and take-home assignments will be posted on Canvas, handed out in class, or emailed. Each quiz or take-home assignment is required to be turned in before the start of each Thursday's clinic unless otherwise noted. ALL assignments are mandatory and are not optional. If you fail to complete any assignment, your final grade will be deducted by at least 10%.

Your grade may also be raised (or lowered) from your calculated final grade based on the Professor's reasonable judgment of your efforts and class participation. The final grade distribution will be subject to any required grading protocols mandated by the Law Center, **including the mandatory curve.**

Please contact the Professor using her University of Houston email address.

Final Exam: None.

Matter Memoranda and Final Clinic Memorandum: As you are assigned new matters midway through the semester, you will be required to prepare and update, on a weekly basis, a Client Matter Memorandum ("Matter Memo"). Each Matter Memo will constitute the history of your matter from the initial client interview to the close of the matter or end of the semester, whichever comes first, and will detail your notes, investigations, correspondences, and analysis of each matter on a weekly basis. You will use the Matter Memos you create and maintain to help prepare for our matters meeting during class. You will also use these Matter Memos to prepare a Final Clinic Memorandum for the instructors to evaluate your handling of any matters during the semester. **The Final Clinic Memorandum is due at the beginning of the final class date.**

Client intake and work on Clinic matters: Students are required to complete 50 hours of clinic work per course credit during the semester, and as this is a two-credit course, that is 100 hours (**2cr = 100h**). Clinic work includes class attendance but does not include preparing for class, unless you are doing a specific assignment as indicated. You are responsible for all work on client matters in addition to class attendance and review of course materials to be prepared for class.

Successful trademark prosecution skills cannot be built or tested without substantial practice. Therefore, the grade should be tied to the demonstrated development of proficiency in navigating the subject matter. In the class we will tackle the most frequent types of registration issues through simulated and actual client fact patterns. Your demonstrated agility in these matters will be based on 1) In class participation in analysis and strategy development; 2) Take home assignments/quizzes/memoranda where you will outline issue and proposed strategies as outlined above.

From the outset the students should understand the whole purpose of assessments is to test their own ability to find the right answers using the materials available to them at the USPTO and in the online course book. This class is not about memory but rather about building proficiency through practice.

Class participation is crucial to your grade and your success because trademark prosecution skills cannot be absorbed without active trial and error which is best done in a group setting. Attendance will be enforced to the extent required by the school and ABA policy. As you know I teach the class for your benefit, so your failure to attend and participate will be your loss.

Consistent with the below Prohibition on Use of AI, your submitted work product in this course must be exclusively your own, with help from no other person or technological system; no artificial intelligence systems may be a part of your process to generate work product.

F. ATTORNEY-CLIENT COMMUNICATIONS AND ATTORNEY WORK PRODUCT

During class instruction, intake, and representation, students will serve as counsellors of creators, authors, and businesses where maturity and professional discretion are paramount to effective and ethical advocacy and representation. Students may not share privileged information regarding assigned cases without written consent of Professor King, *and* the affected client.

AI: A personal note about AI from Professor King:

Once you are a licensed attorney, you will find that AI is of almost no use to you in a trademark practice which you will discover is at times a subjective, contextual analysis especially for marks on the margin. Many times, in your practice you will encounter a mark that depending on how you approach the prosecution of it, will dictate the outcome of registrability. Therefore, use of AI is not only subject to the Law Center’s AI Prohibition, but it is also certain to cause you to be a very poor trademark lawyer in any circumstances other than aggregation of quantitative data, e.g. how many marks a particular owner has registered or how many marks in a particular international class of goods or services contain a specific word. If you want to be a great trademark lawyer, there is truly only one way to get there: Learn how to do it.

G. USE OF LARGE LANGUAGE MODEL PROCESSING AND OUTPUT (“AI”)

The software technology known as artificial intelligence has recently expanded its capability to generate text (AI Generated Text). Examples of the technology include what are known as “generative” large language models (LLMs), and a specific implementation what is well known in the general public is ChatGPT. These systems can generate text in response to prompts and/or input of other text/documents/code/images. The output, the AI Generated Text, appears to have human mimicking “intelligence” and is thus potentially usable as a substitute for written work product one might generate themselves. AI Generated Text can include computer code or programs as well as human language content. Certain programs and applications may use AI to process, compare, and “analyze” sets of data that may be useful for the preparation of certain work product while in the Clinic. However, because the efficacy of these programs often relies upon disclosing, copying, and “reading” certain human-prepared documents by a third-party, use of these tools is likely to negatively

impact client confidentiality and attorney work-product and communication privilege. Ethical conduct is paramount in a clinical setting, as such you are provisionally restricted from using any AI or program which you know relies on AI to upload documents, whether those documents are work-product or client documents, or to provide so-called “prompts” which are about or concerning any client matter in the Clinic.

Your continuing enrollment in this course is deemed to be a pledge by you under the Honor Code to not (1) prompt, generate, obtain, read, or use any AI Generated Text in relation to any activity in this course, or (2) knowingly upload, directly or indirectly, any work product or client document to any AI analytics system, whether for or on behalf of a client or for your own private use, without prior written consent from Professor King—**which is unlikely to be given as it risks the attorney-client privilege, and imperils your ability to develop core skills.**

H. OFFICE HOURS

I am typically available before or after class to respond to questions or provide clarification on the materials presented. Additional meetings are available by appointment Monday through Friday. Students are encouraged to communicate directly with me through provided email address eking@kinglaw.net if additional help or discussion is necessary, or via text to set up an appointment at 713-870-6285.

I. CAPS, Mental Health, and Wellness Resources

Counseling and Psychological Services (CAPS) can help students who are having difficulties managing stress, adjusting to the demand of a professional program, or feeling sad and hopeless. You can reach CAPS (www.uh.edu/caps) by calling (713) 743-5454 during and after business hours for routine appointments, or if you or someone you know is in crisis. No appointment is necessary for the “Let’s Talk” program, a drop-in consultation service at convenient locations and hours around campus (www.uh.edu/caps/outreach/lets_talk.html). Let’s Talk are daily, informal confidential consultations with CAPS therapists where no appointment or paperwork is needed.

The University of Houston has a number of resources to support students’ mental health and overall wellness, including CoogsCARE and the UH Go App. UH Counseling and Psychological Services (CAPS) offers 24/7 mental health support for all students, addressing various concerns like stress, college adjustment and sadness. CAPS provides individual and couples counseling, group therapy, workshops and connections to other support services on and off-campus. For assistance visit uh.edu/caps, call 713-743-5454, or visit a Let’s Talk location in-person or virtually.

Need Support Now? - If you or someone you know is struggling or in crisis, help is available. Call CAPS crisis support 24/7 at 713-743-5454, or the National Suicide and Crisis Lifeline: call or text 988, or chat 988lifeline.org.

Syllabus Changes

The order of classes and the time spent on any given subject may be altered to accommodate the specific cases presented by clients who come to the clinic for our help. In addition, there may be a shift in schedule, and some classes may by necessity be held on zoom or prerecorded.

Honor Code

The UHLC Honor Code applies to all aspects of this course. You are responsible for knowing all Honor Code provisions and for complying with the Honor Code. Please inquire if you have any questions regarding how the Honor Code's provisions apply to specific activities or situations related to this course. Your continuing enrollment in this course is deemed to be a pledge by you under the Honor Code to comply with the Honor Code in relation to this course and to comply with the instructions in the course syllabus.

Inclusion and Wellness

This is an inclusive learning space. At UHLC, we are committed to ensuring inclusive online and classroom learning spaces, where you'll be treated with respect and dignity, and where everyone is provided the equitable opportunity to participate, to contribute, and to succeed. In this course, all students are welcome regardless of socio-economic status, age, race, ethnicity, disability, religion, national origin, veteran's status, sex, sexual orientation, gender identity, gender expression, political affiliation, marital status and other diverse identities that we each bring to class. Our class is richer for his diversity.

Inclusive learning spaces facilitate the innovation and creative thought that enhance student success. This success arises from the participation, support, and understanding of you and your colleagues. I encourage you to speak up and to share your views, but also understand that you are doing so in a learning environment in which we're all expected to engage respectfully and with regard to the dignity of all others.

If you feel like your class performance is impacted in any way by your experiences inside or outside of class, please reach out to me. I want to be a resource for you. If you feel more comfortable speaking with someone besides me, the Office of Student Affairs (OSA) is an excellent resource.

Chosen Names and Preferred Pronouns

I want to address each of you in a manner that corresponds to your identity. Although mistakes happen, chosen names and preferred pronouns—including non-binary ones such as they|them|their—and honorifics, such as Rev., Mr. Ms. Mx. Dr., will be respected in my classroom. Please feel free to reach out to me at any time if you want to make me aware of your chosen name or preferred pronoun or if you have concerns about how I or your classmates address you. My pronouns are she/her. You may call me Elizabeth or Professor King.

Title IX/Sexual Misconduct

Per the UHS Sexual Misconduct Policy, your instructor is a “responsible employee” for reporting purposes under Title IX regulations and state law and must report incidents of sexual misconduct (sexual harassment, non-consensual sexual contact, sexual assault, sexual exploitation, sexual intimidation, intimate partner violence, or stalking) about which they become aware to the Title IX office. Please know there are places on campus where you can make a report in confidence. You can find more information about resources on the Title IX website at <https://uh.edu/equal-opportunity/title-ix-sexual-misconduct/resources/>.

Reasonable Academic Adjustments/Auxiliary Aids

The University of Houston is committed to providing an academic environment and educational programs that are accessible for its students. Any student with a disability who is experiencing barriers to learning, assessment or participation is encouraged to contact the Justin Dart, Jr. Student Accessibility Center (Dart Center) to learn more about academic accommodations and support that may be available to them. Students seeking academic accommodations will need to register with the Dart Center as soon as possible to ensure timely implementation of approved accommodations. Please contact the Dart Center by visiting the website: <https://uh.edu/accessibility/> calling (713) 743-5400, or emailing jdcenter@Central.UH.EDU.

The Student Health Center offers a Psychiatry Clinic for enrolled UH students. Call 713-743-5149 during clinic hours, Monday through Friday 8 a.m. - 4:30 p.m. to schedule an appointment. The A.D. Bruce Religion Center offers spiritual support and a variety of programs centered on well-being.

The Center for Student Advocacy and Community (CSAC) is where you can go if you need help but don't know where to start. CSAC is a “home away from home” and serves as a resource hub to help you get the resources needed to support academic and personal success. Through our Cougar Cupboard, all students can get up to 30 lbs of FREE groceries a week. Additionally, we provide 1:1 appointments to get you connected to on- and off-campus resources related to essential needs, safety and advocacy, and more. The Cougar Closet is a registered student organization advised by our office and offers free clothes to students so that all Coogs can feel good in their fit. We also host a series of cultural and community-based events that fosters social connection and helps the cougar community come closer together. Visit the CSAC homepage or follow us on Instagram: [@uh_CSAC](#) and [@uhcupbrd](#). YOU belong here.

Women and Gender Resource Center

The mission of the WGRC is to advance the University of Houston and promote the success of all students, faculty, and staff through educating, empowering, and supporting the UH community. The WGRC suite is open to you. Stop by the office for a study space, to take a break, grab a snack, or check out one of the WGRC programs or resources. Stop by Student Center South room B12 (Basement floor near Starbucks and down the hall from Creation Station) from 9 am to 5 pm Monday through Friday.

Use of Computers and Electronics

Out of respect for other students and the class environment, during class sessions computers are to be used only for note taking purposes. This prohibits computer use for Internet surfing, chat rooms, e-mail, or other uses not related to note taking for class. I reserve the right to treat violations of this policy as either a lack of preparation, a constructive lack of attendance, or, in appropriate circumstances, as a disruption of the class. In addition, during class please disable the speaker on your computer and refrain from displaying wallpaper, screen savers, or other material on your laptop computer screen that can reasonably be expected to offend or distract your classmates. Also, please ensure that all other noise making electronics, such as watches, cell phones, pagers, etc., are in a silent mode or powered off.

Recording of Class

Students may not record all or part of class, livestream all or part of class, or make/distribute screen captures, without advanced written consent of the instructor. If you have or think you may have a disability such that you need to record class-related activities, please contact the Justin Dart, Jr. Student Accessibility Center. If you have an accommodation to record class-related activities, those recordings may not be shared with any other student, whether in this course or not, or with any other person or on any other platform. Classes may be recorded by the instructor. Students may use instructor's recordings for their own studying and notetaking. Instructor's recordings are not authorized to be shared with anyone without the prior written approval of the instructor. Failure to comply with requirements regarding recordings will result in a disciplinary referral to the Dean of Students Office and may result in disciplinary action.

Disability Statement

The University of Houston Law Center strives to assure equal access and full participation by Nellums Goosby, Academic Records Coordinator in the Office of Student Services, in person in room 44A TU II, by e-mail at SNellums@central.uh.edu, or by phone at 713-743-2187. This voluntary self-identification allows the University to prepare any necessary and appropriate support services to facilitate your learning.

Religious Holy Day Statement

Section 51.911(b) of the Texas Education Code provides excused absences for religious holy days. A student who intends to observe a religious holy day should make that intention known in writing to the Professor prior to the absence. A student who is absent from classes for the observation of a religious holy day shall be allowed to take an examination or complete an assignment scheduled for that day within a reasonable time after the absence. A student who is excused from the class under this policy may not be penalized for the absence; however, the Professor may respond appropriately if the student fails to complete the assignment satisfactorily.

CLINIC CLASSROOM COMPONENT SCHEDULE (Subject to Change):

Week 1	<p>Continuation of work on trademark cases. Preparatory reading/viewing (to be done prior to class): https://www.uspto.gov/trademarks/basics/why-register-your-trademark</p> <p>ASSIGNMENT Watch: https://www.youtube.com/watch?v=9KuaPJReIWk (~100 minutes in total)</p> <p>Welcome; Client Communications; Ethics – Conflicts of Interest, Fiduciary Duty, and Introduction to Searching</p> <p>TASKS: 1. Interviewing prospective client; 2. Checking conflicts; 3. Executing engagement agreement</p> <p>Trademark Manual of Examining Procedure (TMEP) Sections 806; 806.01; 806.01(a); 806.01(b): https://tmep.uspto.gov/RDMS/TMEP/current#/result/TMEP-800d1e653.html?q=use%20in%20commerce&ccb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&results=compact&sort=relevance&cnt=10</p> <p>UH Legal Services Agreement UH Potential Client Intake Form</p> <p>Class strategy discussion: Prospective client presents with an idea for a trademark, and you need to educate the client on the benefits of federal registration and ascertain whether the client is using the mark in commerce which Congress can regulate.</p> <p>TAKE HOME ASSIGNMENT: (3.5 hours)</p> <p>Create USPTO User ID: https://my.uspto.gov/</p> <p>Read Section 1207 of the TMEP in its entirety: https://tmep.uspto.gov/RDMS/TMEP/current#/result/TMEP-1200d1e5036.html?q=likelihood%20of%20confusion&ccb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&results=compact&sort=relevance&cnt=10</p> <p>Read Ethics opinions from USPTO</p> <ul style="list-style-type: none">• Swyers (2017) - https://foiadocuments.uspto.gov/oed/0900_dis_2017-01-26.pdf• Home (2021) - https://foiadocuments.uspto.gov/oed/Final-Order-(D2021-10)-(Hom)-Redacted.pdf <p>Subscribe to The TTABlog</p> <p>Review: https://www.uspto.gov/trademarks/basics TMEP – Chapter 100</p>
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Week 2	<p>Continuation of work on trademark cases.</p> <p>Trademark Prep & Pros – Initial Client Discussions, asking the right questions, finding the full answers</p> <p><u>Cases to read ahead of class:</u></p> <ul style="list-style-type: none"> • <i>In re E.I. du Pont de Nemours & Co.</i>, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) – likelihood of confusion • <i>Abercrombie & Fitch Co. v. Hunting World, Inc.</i> 537 F.2d 4 (2d Cir. 1976) – Spectrum of distinctiveness
Week 3	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work):</p> <p>Reading on benefits of (Burger King) and limits to (Dawn Donut) federal trademark registration</p> <p>Cases to read ahead to discuss in class:</p> <p><i>Burger King of Florida, Inc., and Burger King Restaurants, Inc. v. Gene Hoots and Betty Hoots, d/b/a Burger King</i>, 403 F.2d 904 (7th Cir. 1968) – Priority, Federal trademark registration https://law.justia.com/cases/federal/appellate-courts/F2/403/904/125418/</p> <p><i>Dawn Donut Company v. Hart's Food Stores, Inc.</i>, 267 F.2d 358 (2d Cir. 1959) – territorial trademark rights https://law.justia.com/cases/federal/appellate-courts/F2/267/358/393936/</p> <p>Preparatory Additional Reading:</p> <p>TMEP Doctrine of Foreign Equivalent Sections:</p> <p>https://tmap.uspto.gov/RDMS/TMEP/current#/search?q=doctrine%20of%20foreign%20equivalents&ccb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&result_s=compact&sort=relevance&cnt=10</p> <p>TMEP Phonetic Equivalent Sections:</p>

	<p>https://tmep.uspto.gov/RDMS/TMEP/current#/search?q=phonetic%20equivalents&cb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&results=compact&sort=relevance&cnt=10</p>
Week 4	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work):</p> <p>TMEP – Chapter 700 (focus on sections 704 – 714) Principal vs. Supplemental Register Commencing Commerce</p> <p>https://tmep.uspto.gov/RDMS/TMEP/current#/result/TMEP-1200d1e6993.html?q=continuum%20&ccb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&results=compact&sort=relevance&cnt=10&index=1</p>
Week 5	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work):</p> <p>TAKE HOME ASSIGNMENT. WATCH 4 hours of Trademark Search Videos MANDATORY TO BE VIEWED BEFORE NEXT CLASS</p> <ol style="list-style-type: none"> 1. https://www.uspto.gov/learning-and-resources/uspto-videos/federal-trademark-searching-overview 2. https://www.uspto.gov/learning-and-resources/uspto-videos/federal-trademark-searching-getting-started-0 3. https://www.uspto.gov/learning-and-resources/uspto-videos/federal-trademark-searching-field-tag-searching-0 4. https://www.uspto.gov/learning-and-resources/uspto-videos/federal-trademark-searching-field-tag-searching-regular-0
Week 6	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work):</p> <p>SEARCHING USING https://tmsearch.uspto.gov/search/search-information</p> <p>Preparatory Reading:</p> <p>https://www.uspto.gov/sites/default/files/documents/TM-FederalTrademarkSearching-GettingStarted-handout.pdf</p> <p>https://www.uspto.gov/sites/default/files/documents/TM-FederalTrademarkSearching-FieldTags-handout.pdf</p>

	<p>https://www.uspto.gov/sites/default/files/documents/TM-FederalTrademarkSearching-RegularExpressions-handout.pdf</p> <p>Simulated searching of different marks and analysis:</p> <p>List of marks and goods TBD</p> <p>TAKE HOME QUIZ: Do a search on these three marks for the following goods: _____, _____, _____. Hand in your results as instructed prior to the start of week 7 class. (3 hours)</p>
Week 7	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work):</p> <p>TAKE HOME QUIZ: Craft IDs for the following clients: (2.00)</p> <p>Client who wants to _____.</p> <p>Client who wants to _____.</p> <p>Client who _____.</p> <p>Client who _____.</p>
Week 8	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work):</p> <p>Client Assignments; Retainer Agreements</p> <p>Drafting a US Trademark Application for Registration on the Principal Register: Client interview and advice; begin process, and first weekly matter memorandum (7.5 hours)</p>
Week 9	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work):</p> <p>Simulated Drafting a US Trademark Application Continued in class and at home</p> <p>7 hours including Matter Memorandum</p>

Week 10	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work): Draft a Response to Office Action (either real or simulated, TBD) and include evidence to be turned in before the start of class on Week 12. (7 hours)</p> <p>Weekly Matter Memorandum 1.00</p>
Week 11	<p>Continuation of work on trademark cases.</p> <p>Alternatively, (if no work): Potential Assignment: Draft a Response to Office Action amending the basis of the filing to Acquired Distinctiveness and refer to “evidence” in the Response that supports the Argument that the mark has acquired distinctiveness. (7 hours)</p> <p>Due at the beginning of class on Week 13.</p> <p>Weekly Matter Memorandum: 1.00</p>
Week 12	<p>Continuation of work on trademark cases.</p> <p>Alternatively, continuation of review and Draft a Response to Office Action designed to overcome the Refusal based on “secondary source significance” and claiming ownership of its prior registration. (7 hours)</p> <p>Due at the beginning of class on Week 14.</p> <p>Weekly Matter Memoranda 1.00</p>
Week 13	<p>A continuation of our work from the previous week on the logo Response to Office Action, and/or trademark clinic matters.</p> <p>Preparatory Reading:</p> <p>Read TMEP sections on trade dress</p> <p>https://tmeppatent.uspto.gov/RDMS/TMEP/current#/result/TMEP-1200d1e835.html?q=functional&ccb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&results=compact&sort=relevance&cnt=10</p> <p><i>Wal-Mart Stores, Inc. v. Samara Brothers, Inc.</i>, 529 U.S. 205 (2000)</p> <p>https://supreme.justia.com/cases/federal/us/529/205/</p>

	<p><i>Inwood Laboratories v. Ives Laboratories</i>, 456 U.S. 844 (1982)</p> <p>https://supreme.justia.com/cases/federal/us/456/844/</p> <p><i>Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.</i>, No. 11-3303 (2d Cir. 2013) https://law.justia.com/cases/federal/appellate-courts/ca2/11-3303/11-3303-2013-03-08.html</p> <p>Assignment: Draft Final Clinic Memorandum 8 hours</p>
Week 14	Conclusion of clinic; docketing discussion; wrap up and prepare file for next semester; Semester insights and discussion; Q & A

Summary of Weekly Schedule: Subject to Change

Week 1	<p>Welcome; Client Communications; Trademark Basics, Ethics – Conflicts of Interest, what you must and must not do; UH Legal Services Agreement, and Potential New Client form</p> <p>A continuation of our work from the previous semester: Trademark clinic matters</p> <p>Weekly Matter Memo assigned</p>
Week 2	<p>Client Counseling Discussion and Trademark Prep & Pros Highlights (Initial Client Discussions, asking the right questions, finding the full answers)</p> <p>Trademark Clinic matters</p> <p>Trademark Distinctiveness and Likelihood of Confusion</p> <p>Weekly Matter Memo assigned</p>
Week 3	<p>Likelihood of Confusion Cont'd; Trademark Prep & Pros (Continued) and Trademark Application Basics, Searching, common law and ways to save the client money</p> <p>Trademark Clinic matters</p> <p>Weekly Matter Memo assigned</p>
Week 4	<p>Descriptiveness and Misdescriptiveness</p> <p>Trademark Clinic matters</p> <p>Weekly Matter Memo assigned</p>
Week 5	<p>Geographic Descriptiveness</p> <p>Trademark Clinic matters</p> <p>Weekly Matter Memo assigned</p>

Week 6	<p>Searching using the Trademark Office Search System; Analyzing a search third-party search report; how to review the Trademark Design Code Manual and how to assess design mark (logo) similarity</p> <p>Trademark Clinic matters</p> <p>Combining this with S.A.M. (Sound, Appearance, Meaning) and how to assess likelihood of confusion before filing an application, including the doctrine of foreign equivalents, the doctrine of phonetic equivalents, and natural zone of expansion of trade</p> <p>Weekly Matter Memo assigned</p>
Week 7	<p>USPTO Trademark Manual of Identification of Goods and Services</p> <p>Trademark Clinic matters</p> <p>Recitations of Goods and Services and how to craft them</p> <p>Weekly Matter Memo assigned</p>
Week 8	<p>Drafting Trademark Applications, ROA's etc. Q & A</p> <p>Trademark Clinic matters</p> <p>Weekly Matter Memo assigned</p>
Week 9	<p>Trademark Applications continued, Trademark Clinic matters discussing Matter Memoranda</p> <p>Weekly Matter Memo assigned</p>
Week 10	<p>Trademark Applications continued and Introduction to Office Actions. How to craft a successful trademark application recitation of goods and services to avoid Refusals, and how to draft Response to Office Actions</p> <p>Trademark Clinic matters</p> <p>Weekly Matter Memo assigned</p>
Week 11	<p>Responding to Office Actions, Letters of Protest, Petitions, Requests for Reconsideration, Appeals Q&A:</p> <p>Trademark Clinic matters</p> <p>Weekly Matter Memo assigned</p>
Week 12	<p>Responding to Office Actions, Letters of Protest, Petitions, Requests for Reconsideration, Appeals Q&A:</p> <p>Trademark Clinic matters</p> <p>Weekly Matter Memo assigned</p>

Week 13	Non-Traditional Trademarks Overview Trademark Clinic matters Weekly Matter Memo assigned
Week 14	Wrap up, Q & A, Social Trademark Clinic matters Weekly Matter Memo assigned