

An Update On USPTO's Patent Pro Bono Initiative

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"Without question, my greatest satisfactions in life, apart from my family, have come from the services I have rendered to individuals and families and, on a larger scale, to my community. They have not come from the financial successes I fortunately have been able to enjoy, but from knowing that my energies and possible creativity have been of benefit to others." —Alan V. Lowenstein

The introduction of the Leahy-Smith America Invents Act brought many changes to the U.S. patent system, including conversion to a first-inventor-file system to harmonize U.S. patent law with that of other industrialized countries. Another equally important provision in the AIA mandates that the U.S. Patent and Trademark Office "work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses." In February 2014, President Obama issued an executive action calling on the USPTO to expand the existing patent pro bono programs to all 50 states. [1]



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Independent inventors and small businesses sometimes struggle with how to file and prosecute a patent application to protect their invention, due, for example, to unfamiliarity with the patent system. Furthermore, independent and pro se inventors face a unique set of challenges, such as a lack of resources, which may unnecessarily place burdens on them.

Given this background, the USPTO has formed a team to bring patent legal assistance to residents in each state in the union. The team works closely with intellectual property law associations and other nonprofits to establish a nationwide Patent Pro Bono Program that includes regional patent pro bono programs for financially under-resourced inventors and small businesses.

The nationwide implementation of the Patent Pro Bono Program is far-reaching and ambitious, but especially necessary at this particular point in time.

The USPTO has always been committed to strengthening the patent system and fostering innovation. There is little doubt that intellectual property is the foundation upon which the knowledge economy is built. In that regard, the USPTO has numerous pilots, projects and initiatives designed to improve patent quality and reduce the patent application backlog and pendency. These efforts have led to positive changes already and have made the entire system better.

But with the Patent Pro Bono Program, the USPTO focuses on a unique way to improve the patent process for under-resourced inventors — by providing the opportunity for them to obtain counsel to assist in the filing and prosecution of their patent applications. This initiative promotes fairness and equal access. Just as importantly, it stimulates solid economic growth by increasing the accessibility to the patent system for everyone. The underlying inventions, which may have not otherwise been developed into products, now stand a better chance of being commercialized or licensed to bring additional real dollars into the economy.

Regional programs, which may cover just one or multiple states, are at the center of the USPTO's patent pro bono initiatives. These regional programs take into account the needs of the local community in setting the criteria for admittance into each program. The regional programs decide the standards for inventor participation in the program, perform the intake function, screen potential clients, screen potential volunteer patent attorneys, and attempt to match the client with the volunteer attorney. In addition, many regional programs offer educational outreach to inventors relating to the patent process, as well as training to volunteer attorneys.

Initially, the first regional patent pro bono program was set up in Minnesota in 2011. Then, in 2012, three additional programs were established in Colorado, Washington, D.C., and California. Consistent with the regional approach, the California program currently covers the states of California, Alaska, Hawaii, Nevada, Arizona, Idaho, Montana, Oregon and Washington. Likewise, the D.C. program has recently expanded to cover Maryland, Virginia, Delaware and West Virginia. The Colorado program has also expanded to cover Wyoming, Utah and New Mexico. States covered by a regional program based in another state are not foreclosed from implementing their own statewide regional program in the future. The current goal of the USPTO is to expand coverage of the Patent Pro Bono Program to all 50 states by later this year.

New programs are launching and expanding frequently. For example, the Michigan program launched on Nov. 18, 2014, and the Georgia program opened its doors in late 2014 and will host an official kick-off event in Atlanta on Feb. 17, 2015. Similarly, the New York program expanded its coverage to include Connecticut and New Jersey in 2014, and its expansion will be highlighted on Feb. 10, 2015, at an event in New York City. The first program in the Midwest has now begun, covering Missouri, Nebraska, Kansas, Oklahoma and Arkansas. That program's launch event will take place on Feb. 19, 2015, in St. Louis. Massachusetts added four Northeastern states to its coverage in 2014 (Vermont, New Hampshire, Rhode Island and Maine), as did the Minnesota program, in conjunction with the William Mitchell School of Law (now covering Wisconsin, Iowa, North Dakota and South Dakota). These expansions will also be highlighted at events in the coming months.

Only five states do not currently have pro bono coverage. Much progress is being made towards program implementation in these remaining states (Florida, Alabama, Mississippi, Illinois and Indiana).

Inventors have two ways to apply for pro bono assistance. First, they may apply directly to their regional program. This is the preferred method because it reduces the amount of time for the regional program to receive the inventor's request for assistance. The USPTO strongly urges inventors to utilize the

USPTO's website to find which program covers them, and then utilize the hyperlink provided on the website to access the regional program directly. The USPTO's pro bono Web address is <http://www.uspto.gov/inventors/proseprobono/>.

Alternatively, inventors may request assistance by applying through an online portal known as the National Clearinghouse, which is operated by the Federal Circuit Bar Association. [2] The National Clearinghouse operates to connect inventors with the regional patent pro bono programs by forwarding the inventor's application for pro bono assistance to the appropriate regional program. The USPTO's website also contains a link to the National Clearinghouse, or it can be accessed through the Federal Circuit Bar Association's website, at <http://www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp>.

The following Table 1 details the nationwide implementation of the USPTO's Patent Pro Bono program, providing up-to-date details on regional programs covering each state:

<u>State</u>	<u>Program</u>	<u>Contact</u>
Alaska	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
Arizona	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
Arkansas	Gateway VMS	http://www.patentprobono.com
California	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
Colorado	Mi Casa Resource Center	http://www.micasaresourcecenter.org/business-development/pro-bono-patent-program/
Connecticut	Volunteer Lawyers for the Arts	http://vlany.org/legalservices/patent_program.php
Delaware	Federal Circuit Bar Association	http://www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp
District of Columbia	Federal Circuit Bar Association	http://www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp
Georgia	Georgia Lawyers for the Arts	http://glarts.org/patents/
Hawaii	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
Idaho	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
Iowa	Legal Corps and William Mitchell College of Law	http://legalcorps.org/inventors/inventors
Kansas	Gateway VMS	http://www.patentprobono.com
Kentucky	Case Western Reserve University School of Law, Spangenberg Center for Law, Technology & the Arts	http://law.case.edu/Academics/AcademicCenters/LTA/IPVentureClinic.aspx
Louisiana	Center for Innovation	https://www.thecenterforinnovation.org/texas-aia-uspto-pro-bono-patent-assistance-program
Maine	Arts & Business Council	http://www.artsandbusinesscouncil.org/programs/volunteer-lawyers-for-the-arts.html
Maryland	Federal Circuit Bar Association	http://www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp
Massachusetts	Arts & Business Council	http://www.artsandbusinesscouncil.org/programs/volunteer-lawyers-for-the-arts.html
Michigan	State Bar of Michigan	http://www.michbar.org/programs/ATJ/home.cfm
Minnesota	Legal Corps	http://legalcorps.org/inventors/inventors
Missouri	Gateway VMS	http://www.patentprobono.com
Montana	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
Nebraska	Gateway VMS	http://www.patentprobono.com
Nevada	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
New Hampshire	Arts & Business Council	http://www.artsandbusinesscouncil.org/programs/volunteer-lawyers-for-the-arts.html
New Jersey	Volunteer Lawyers for the Arts	http://vlany.org/legalservices/patent_program.php
New Mexico	Mi Casa Resource Center	http://www.micasaresourcecenter.org/business-development/pro-bono-patent-program/
New York	Volunteer Lawyers for the Arts	http://vlany.org/legalservices/patent_program.php
North Carolina	North Carolina Bar Association	http://www.ncbar.org/public-resources/nc-leap
North Dakota	Legal Corps and William	http://legalcorps.org/inventors/inventors

	Mitchell College of Law	
Ohio	Case Western Reserve University School of Law, Spangenberg Center for Law, Technology & the Arts	http://law.case.edu/Academics/AcademicCenters/LTA/IPVentureClinic.aspx
Oklahoma	Gateway VMS	http://www.patentprobono.com
Oregon	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
Pennsylvania	Philadelphia Volunteer Lawyers for the Arts, a program of the Arts + Business Council of Greater Philadelphia	http://www.artsandbusinessphila.org/pvla/patentprobono.asp
Rhode Island	Arts & Business Council	http://www.artsandbusinesscouncil.org/programs/volunteer-lawyers-for-the-arts.html
South Carolina	North Carolina Bar Association	http://www.ncbar.org/public-resources/nc-leap
South Dakota	Legal Corps and William Mitchell College of Law	http://legalcorps.org/inventors/inventors
Tennessee	North Carolina Bar Association	http://www.ncbar.org/public-resources/nc-leap
Texas	Center for Innovation	https://www.thecenterforinnovation.org/texas-aia-uspto-pro-bono-patent-assistance-program
Utah	Mi Casa Resource Center	http://www.micasaresourcecenter.org/business-development/pro-bono-patent-program/
Vermont	Arts & Business Council	http://www.artsandbusinesscouncil.org/programs/volunteer-lawyers-for-the-arts.html
Virginia	Federal Circuit Bar Association	http://www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp
Washington	California Lawyers for the Arts	http://www.calawyersforthearts.org/CIAP
West Virginia	Federal Circuit Bar Association	http://www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp
Wisconsin	Legal Corps and William Mitchell College of Law	http://legalcorps.org/inventors/inventors
Wyoming	Mi Casa Resource Center	http://www.micasaresourcecenter.org/business-development/pro-bono-patent-program/

TABLE 1

With all of these organizations operating the various regional programs in slightly different ways, the nuances of each program may vary, but the overarching goal remains the same: to assist inventors who would otherwise file their patent applications without attorney representation. Common services provided by volunteer patent attorneys paired with low-income inventors include helping to identify potentially patentable subject matter, drafting and filing patent applications, and prosecuting patent applications. Many regional programs permit only limited scope representation, so that volunteer attorneys can better manage their time commitment to suit their needs, consistent with their current caseload. Moreover, many regional programs provide sample engagement letters, termination letters, and other information that will help attorneys to immediately start providing pro bono services.

Both the USPTO and the regional programs themselves have been publicizing the existence of the regional programs to inventors and patent attorneys alike. As public knowledge of the Patent Pro Bono Program increases, the number of low income inventors who have been seeking referrals to patent attorneys has steadily increased. To meet such increased demand, it is important that additional patent practitioners from solos to those associated with law firms and corporate legal departments join as service providers. President Obama's executive action specifically "is calling on members of the patent bar to participate in the program." The Patent Pro Bono Program enables patent attorneys to meet that call and provide pro bono legal services in their field of expertise.

At the same time as opportunities for participation in the Patent Pro Bono program have increased, other hurdles are being reduced. For instance, the USPTO's ethics rules allow patent attorneys to take on a limited representation of a low income inventor for a particular issue, without having to represent the low income inventor for the duration of the patent process.[3] For example, a patent attorney is

able to enter a limited engagement with an inventor to draft and file a patent application for that inventor. The patent attorney can then withdraw his or her representation of the inventor once the patent application has been filed. Some regional pro bono programs provide basic malpractice insurance which helps encourage participation from corporate lawyers and solo practitioners. For those regional programs without malpractice insurance, law firm lawyers may generally find coverage under their firm's own malpractice insurance policies.

In terms of participation by corporate counsel in the Patent Pro Bono program, the Patent Pro Bono program provides a convenient and straightforward option for in-house patent attorneys and agents to participate in pro bono service. Companies can participate by taking on matters directly, or by working in collaboration with outside counsel to represent inventors. In-house counsel do not even have to be registered with the USPTO if their company partners with a participating law firm with a registered patent attorney.

Because the topic of malpractice insurance coverage is of critical concern to all but has not been uniformly addressed by each of the regional programs, the USPTO has urged the Pro Bono Advisory Council to take up consideration of the topic. The PBAC is a group of well-established patent practitioners and pro bono administrators who have committed to provide support and guidance to Patent Pro Bono Programs across the country. The PBAC has now formed a subcommittee to address malpractice insurance in the coming months. In addition, other PBAC subcommittees recently formed include metrics, best practices, outreach, and governance.

The Corporate Pro Bono Challenge initiative was launched by the Corporate Pro Bono (CPBO) organization in 2006. The CPBO was founded in 2000 to work with corporate legal departments to provide pro bono service by their in-house counsel. In 2006, at the urging of chief legal officers, the CPBO launched the Corporate Pro Bono Challenge initiative. The Corporate Pro Bono Challenge initiative is a simple, voluntary statement of commitment to pro bono service by legal departments, their lawyers and staff. The Patent Pro Bono Program provides an ideal opportunity for corporations to sign onto the Corporate Pro Bono Challenge initiative and offers its patent practitioners with pro bono work within their field of expertise. The CPBO has published a list of companies that have signed on to the initiative, which includes many large corporations with a presence throughout the country.[4]

For more information about the USPTO's patent pro bono initiative and future announcements regarding regional program implementations, please visit <http://www.uspto.gov/inventors/proseprobono/>.

Those interested in providing pro bono patent services may also review the publication, Patent Law Pro Bono: A Best Practices Handbook[5] which describes the first patent pro bono pilot program developed in Minnesota.

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[1] Executive Action issued February 20, 2014, <http://www.whitehouse.gov/the-press-office/2014/02/20/fact-sheet-executive-actions-answering-president-s-call-strengthen-our-p>.

[2] <http://www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp>

[3] See, e.g., 37 CFR 11.102(c) (“A practitioner may limit the scope of representation if the limitation is reasonable under the circumstances and the client gives informed consent.”)

[4] <http://www.cpbo.org/cpbo-challenge/list-of-challenge-signatories/>

[5] Patent Law Pro Bono: A Best Practices Handbook, 2012, Amy M. Salmela, Mark R. Privratsky