

Uncle Sam Wants You! A Call to Pro Bono Service for Patent Practitioners



DANIEL OVANEZIAN
Lowenstein Sandler LLP

“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

TO ALL PATENT ATTORNEYS OUT THERE who have stayed on the sidelines and watched other attorneys perform *pro bono* work because you felt uncomfortable volunteering in areas outside your expertise and knowledge, we have news for you. Patent *pro bono* opportunities have arrived in California and we are calling upon you to come join us in service to the cause.

A provision in the America Invents Act (AIA) mandates that the United States Patent and Trademark Office (USPTO) “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.”¹ The practical application of the AIA’s mandate to establish patent *pro bono* programs across the country has been spearheaded by John Calvert, Senior Advisor of the Office of Innovation Development at the USPTO, who also wrote the above provision for the AIA. Initially, a regional *pro bono* pilot program was set up in Minnesota in 2011. Then, in 2012, three additional programs were established in Colo-



BENJAMIN A. KIMES
Lowenstein Sandler LLP

rado, Washington, D.C and California. Regional patent *pro bono* programs have since been implemented in an additional sixteen states.² An original goal was to have the entire country covered by regional patent *pro bono* programs by the end of June 2014.³ The USPTO now anticipates that all 50 states will have a patent *pro bono* program by the end of 2015.⁴

Each of the regional patent *pro bono* programs operates in a slightly different way. However, each program performs the same basic function of matching low-income inventors with patent attorneys who will counsel the low-income inventors and assist them in the patent process. Common *pro bono* services provided by patent attorneys paired with low-income inventors include helping to identify potentially patentable subject matter, drafting and filing patent applications, and prosecuting patent applications. As with other *pro bono* legal work, all attorney fees are waived for the regional patent *pro bono* programs. However, inventors are required to pay any fees charged by the USPTO and also a small administration fee to the patent *pro bono* regional administration agency.

With California being the most populous of the states and having a thriving technology sector, a large percentage of the patent applications filed with the USPTO originate from California.⁵ Accordingly, it is no surprise that California was considered to be an ideal state for early expansion of a patent *pro bono* program. Additionally, a large percentage of the *pro se* applicants for patent applications originate from California. The California Inventors Assistance Program

(CIAP), the regional patent *pro bono* program for California, had an initial public launch in October of 2012 and is now the largest and most active regional patent *pro bono* program in the US. The USPTO selected California Lawyers for The Arts (CLA) to be the statewide administrator for CIAP because CLA is at present one of only two entities certified by the State Bar of California to provide lawyer referral services throughout the entire State of California. Additionally, “CLA has been serving the creative arts and innovation community since 1974, so it is already well accustomed to dealing with intellectual creators.”⁶ In its first year of operation, CLA considered over 200 applicants to CIAP. Approximately 40 of the approximately 200 applicants satisfied screening criteria and were placed with patent attorneys. To date, the CIAP has processed almost 500 low-income inventors seeking assistance and has placed 92 low-income inventors with patent attorneys. Response to the program from the inventor community has been overwhelmingly positive. Additionally, attorneys participating in the program have found it to be both worthwhile and fulfilling.

Through the CIAP, under-resourced inventors are able to obtain the *pro bono* legal services needed to guide them through the patent application process. Presently, CIAP requires that low-income inventors pay an administrative fee of \$125 after successful placement with a patent attorney. Inventors are also required to have some knowledge of the patent system. Inventors are provided basic training and education on the patent system via an online course that concludes with a quiz on the patent system prior to being referred to an attorney. After a financial screening, under resourced inventors that meet certain financial and other guidelines are referred to patent attorneys participating in the CIAP. Presently, to meet the financial guidelines, an inventor must complete a multi-page *pro bono* application form and show an IRS 1040 adjusted gross income of less than 300% of the poverty level. Selected applicants receive *pro bono* legal services valued at \$2500–\$15,000 at no cost, with the value of the provided services depending on the nature of assistance that is needed.⁷

The number of low-income inventors who have been seeking referrals to patent attorneys has been steadily increasing as public knowledge of the CIAP increases. To meet such increased demand, it is important that additional patent attorneys from solos to those associated with law firms and corporate legal departments join the CIAP as service providers. Only California licensed attorneys may register as service providers with CLA. However, participation is not limited to just California licensed patent attorneys. Patent attorneys without a California bar license, patent agents, foreign patent attorneys, and attorneys without a USPTO registration number may also participate in the CIAP under the supervision of a California licensed patent attorney. In order to participate in the CIAP, a law firm or corporation must have at least one attorney with an active California Bar license. This individual may act as the point of contact for that company or law firm. The law firm or corporation must also employ or partner with at least one patent practitioner. For example, non-registered attorneys

and/or foreign patent attorneys may participate by performing prior art searches, providing initial counseling, and so on. Accordingly, law firms and corporations with presences outside of California may provide services through the CIAP so long as the corporation or law firm has a physical office in California and one California licensed attorney who will interface with CLA.

Notably, the CIAP has addressed issues that had traditionally acted as roadblocks to patent attorneys providing *pro bono* patent legal services. In particular, obtaining a patent application typically takes two to four years. Some patent attorneys may be reluctant to commit to providing *pro bono* legal services for a low-income inventor for this extended period. Additionally, the docketing and tracking of important dates such as bar dates, foreign filing deadlines, deadlines to respond to communications from the USPTO, and so forth is a burden that patent attorneys have been reluctant to take on for *pro bono* clients. Some corporations might also be reluctant to take on patent *pro bono* work because of a fear that they might expose themselves to liability by taking on a *pro bono* case for an invention related to technology that the corporation develops. All of these concerns have been addressed by the CIAP.

The CIAP allows 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. For example, an attorney is able to enter into a limited engagement with an inventor to draft and file a patent application for that inventor. The attorney can then withdraw his representation of the inventor after filing the patent application. The patent attorney might also engage with a low-income inventor just for the purpose of filing a response to an Office Action, after which the patent attorney may withdraw his representation. This form of limited representation has received a stamp of approval from the USPTO so long as the limited scope of representation is set forth at the beginning of the representation and the client gives informed consent.⁸ For example, patent attorneys should specify whether they will perform a patentability search, specify that they will not perform foreign filing, will not track due dates, will not be responding to Office Actions, and so forth. Accordingly, attorneys do not need to worry that they will be responsible for a *pro bono* client for the entire pendency of a patent application, nor do attorneys need to worry about the liability associated with tracking of due dates for the *pro bono* clients.

For corporations that are interested in participating but are not comfortable with advising patent *pro bono* clients or filing documents (e.g., Office Action responses and patent applications), CLA will assist by pairing the corporations with law firms or outside patent attorneys. The corporation and outside patent attorney will then jointly represent a low-income inventor.

For corporations that participate in the CIAP, CLA extends basic malpractice insurance. Law firms that participate are covered by their own malpractice insurance policies.

California Lawyers for the Arts additionally provides a subject-based filter on referrals. Accordingly, corporations may specify that they do not want to receive any referrals in particular technical fields (e.g., such as the fields associated with any of their technologies). This ensures that no referral will ever be sent to a corporation that might pose a conflict with that corporation's own innovations. Service providers may additionally specify areas of technical specialty that are preferred for referrals.

How does the referral process work? California licensed patent attorneys sign up with CLA (for themselves or for an institution such as a law firm or corporation) to provide *pro bono* patent services. CLA then periodically sends out lists of available patent *pro bono* matters that need referrals. Once a patent attorney indicates interest in a matter to CLA, CLA will place that matter on hold. Additionally, CLA will provide the patent attorney with additional information about the matter and client to enable the patent attorney to perform a conflict check. CLA will wait to receive an update from the attorney as to whether they are able to represent the client. Following confirmation of such from the attorney, CLA will put the patent attorney into contact with the client. At this point the patent attorney is expected to provide at a minimum a thirty-minute consultation with the inventor. If, after this thirty-minute consultation, the patent attorney determines for any reason that he or she is not a good fit for the inventor, he or she returns the referral back to CLA.

The Advisory Committee for the CIAP is presently made up of attorneys from CLA, representatives from the USPTO, and attorneys from corporations and law firms. The Advisory Committee is in the process of generating an orientation packet for new patent attorneys who wish to be service providers. This will include sample engagement letters, termination letters, and other information that will help attorneys to immediately start providing *pro bono* services. Additionally, participant law firms and corporations are available to provide assistance to other corporations, law firms and solo patent attorneys who are interested in joining CIAP. Those interested in providing *pro bono* patent services may also review the publication, *Patent Law Pro Bono: A Best Practices Handbook*⁹, which describes the first patent *pro bono* pilot program developed in Minnesota.

There is a continued need for more patent attorneys to provide their legal services to low-income inventors and small businesses via the CIAP. Additionally, the CIAP enables patent attorneys to provide *pro bono* legal services in their field of expertise. Accordingly, the CIAP provides an ideal opportunity to patent attorneys to provide *pro bono* legal services. The CIAP offers patent attorneys the ability to join an existing patent *pro bono* program—one that has been carefully set up and tested for success, and that is in need of skilled and committed attorneys looking to boost America's innovation and small business economy. ◀◀

For more information about joining the CIAP as a service provider, please contact CLA at www.calawyersforthearts.org or 510-990-6033.

The views expressed in this article are personal to the authors and do not necessarily reflect the views of the authors' firm, the State Bar of California, or any colleagues, organization, or client.

© 2014 Daniel Ovanezian & Benjamin A. Kimes.

Daniel Ovanezian is a partner in the Palo Alto, California office of Lowenstein Sandler LLP, specializing in the intellectual property law.

Benjamin Kimes is counsel in the Palo Alto, California office of Lowenstein Sandler and a member of the board of directors for California Lawyers for The Arts. Benjamin specializes in intellectual property law.

Endnotes

1. Leahy-Smith America Invents Act, H.R. 1249, 112th Cong. § 32 (2011).
2. *Pro Bono*, [uspto.gov](http://www.uspto.gov), available at <http://www.uspto.gov/inventors/proseprobono>, last accessed May 26, 2014.
3. John Calvert, *Pushing Ahead with the Pro Bono Assistance Program*, 12 J. MARSHALL REV. INTEL. PROP. L. 286, 287 (2013).
4. *Pro Bono*, *supra* note 2.
5. See United States Patent and Trademark Office Performance and Accountability Report Fiscal Year 2013 at 193-94 (available at <http://www.uspto.gov/about/stratplan/ar/USPTOFY2013PAR.pdf>). 36,814 patents were issued to Californians in fiscal year 2013 out of 140,073 patents issued that fiscal year to residents of the United States. Californians filed 77,273 patent applications in fiscal year 2012 out of 282,466 patent applications filed by residents of the United States that fiscal year. No other state even comes close to these numbers.
6. Stuart Meyer & Robert Pimm, *USPTO Pro Bono Program Eases "Game of Kings" Patent Concerns*, Daily Journal at (Aug. 15, 2013) (available at <http://www.dailyjournal.com> (login with username and password; then search 'USPTO Pro Bono')).
7. Independent inventors can gain access to the CIAP through the PTO's website ([uspto.gov](http://www.uspto.gov)), which includes a page that provides guidance to independent inventors. Independent inventors can also gain access by calling CLA at 888-775-8995 or by visiting CLA on the web at calawyersforthearts.org.
8. See 37 C.F.R. § 11.102(c) ("A practitioner may limit the scope of the representation if the limitation is reasonable under the circumstances and the client gives informed consent.").
9. Amy M. Salmela & Mark R. Privratsky, *Patent Law Pro Bono: A Best Practices Handbook*, 4 CYBARIS® INTEL. PROP. L. REV. 1 (2012).