



At Sidebar

by Anne Shea Gaza

The USPTO Patent Pro Bono Program: Creating New Opportunities for Helping Local Communities

Not only was the passage of the Leahy-Smith America

Invents Act (AIA)¹ in September 2011 a game changer for patent practice in the United States, it heralded the beginning of a new era in patent pro bono services. Section 32 of the AIA directs the U.S. Patent and Trademark Office (USPTO) to “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.” The revolutionary patent pro bono programs that have developed in the wake of the AIA are helping to level the playing field for all financially under-resourced entrepreneurs by providing eligible inventors and small businesses throughout the nation equal access to the patent system.

Brief History of the Patent Pro Bono Program

It has long been recognized that “[a] great idea is a great idea regardless of it[s] source[,] and independent inventors by their creative nature have an abundance of great ideas.”² As such, the “number one goal at the USPTO [has been] to keep America at the forefront of technological innovation[,] and helping independent inventors get their innovations from the drawing board to the marketplace is a big part of that plan.”³ Before the AIA, the USPTO had endeavored for years to promote the creation of pro bono programs, but those endeavors resulted in little sustainable success.⁴ It was only with the passage of the AIA that consistent, nationwide progress became possible in creating pro bono programs that are focused on obtaining patent protection. According to Jennifer McDowell, Pro Bono Coordinator of the USPTO Pro Bono Program, within three years of the AIA’s passage, the USPTO successfully partnered with intellectual property law practitioners and associations across the country to create patent pro bono programs covering fewer than 20 states.

As focus on the patent system, particularly patent reform, has continued, the ever-present need to incentivize and protect new inventions has not been lost. To further encourage innovation and

improve the patent system, President Barack Obama issued various executive actions in early 2014.⁵ One such action called upon members of the patent bar to provide individual inventors and small businesses legal assistance in navigating the patent system so that the mandate of the AIA pro bono program could be expanded to cover every state in the country.

To accomplish the congressional mandate set forth in the AIA and respond to the President’s call to action, the USPTO formed a patent pro bono team headed by McDowell. With an initial goal of expanding coverage to every state by mid-2014,⁶ the USPTO now anticipates that patent pro bono services will be available in all 50 states by the end of 2015.⁷ With coverage already expanded to 45 states and the District of Columbia, the USPTO is well on its way to meeting its goal.⁸

How the Patent Pro Bono Program Works

“The cost of hiring a patent attorney to properly write and prosecute a patent application is the main barrier to getting a patent for many inventors and small businesses.”⁹ Pro bono efforts in this area, however, have historically been difficult to initiate due to (1) a lack of administrative support, (2) the absence of liability coverage (particularly for in-house counsel), and (3) concerns about the duration and scope of the representations. Through patent pro bono programs, financially limited inventors and small businesses are now able to obtain assistance navigating the patent process, while volunteer attorneys have the administrative support needed to screen and facilitate engagement with potential clients.

Prospective clients apply for assistance through either the national clearinghouse administered by the Federal Circuit Bar Association or a regional patent pro bono program. The national clearinghouse serves as an omnibus point of contact, responsible for collecting applications for inventors and small businesses and transferring those requests to the appropriate regional program.¹⁰ The regional programs adopt more of a grassroots approach and focus

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on local attorneys providing assistance to local inventors and small businesses looking to innovate.¹¹ This local approach provides for more flexibility in tailoring a particular patent pro bono program to the needs of the particular inventor community being served and the legal community providing assistance.

Typically staffed with nonattorney administrators, individual eligibility requirements for each program vary, and small administrative fees may be charged by the program.¹² With respect to eligibility, the patent pro bono programs generally require that prospective clients reside in the servicing state, meet financial eligibility requirements, demonstrate some minimal knowledge of the patent system, and have actual inventions (versus ideas) that are potentially patentable.¹³ Once an eligible client has been identified, the program administrator matches the client with a volunteer attorney.¹⁴

With the support regional programs provide by screening potential clients and matching eligible clients with volunteer attorneys, the administrative obstacles to providing patent prosecution assistance by private practitioners are largely overcome. Those obstacles have stymied pro bono efforts in the past. Another area of concern for volunteer attorneys is the length and scope of the pro bono representation. In that regard, it is not uncommon for the prosecution of a patent application to take several years before the USPTO examiner issues a final decision on patentability. The administrative screening and matching process can also address these concerns.

What specific services an individual volunteer attorney may agree to provide, or the regional program may deem appropriate to provide, are determined by the individual attorney within the scope of the overall regional program. Typically, however, services are generally limited to the filing or prosecution of a nonprovisional application and may continue through allowance or final rejection. Subject-based screening mechanisms may be implemented to prevent potential conflicts with a volunteer attorney's existing clients or with activities undertaken by an in-house counsel, and can also funnel pro bono clients with a potential invention in a particular subject area to a volunteer attorney with experience in that area.

The last hurdle is professional liability coverage to protect the volunteer attorney. For private practitioners, professional liability coverage for pro bono work is typically covered by their existing insurance plan. In-house counsel, however, rarely have professional liability coverage for pro bono work. Regional patent pro bono programs that provide professional liability coverage to their participating corporate attorneys increase exponentially the number of potential volunteers.¹⁵ According to McDowell, currently fewer than half of the patent pro bono programs have insurance coverage for participating in-house counsel. The Pro Bono Advisory Council, a group of well-established patent practitioners and pro bono administrators who have committed to providing support and guidance to patent pro bono programs across the country, has formed a subcommittee to address the issue of professional liability coverage for patent pro bono programs.¹⁶

Representative Types of Patent Pro Bono Programs

The first patent pro bono program was sponsored by LegalCORPS¹⁷ in Minnesota in 2011. According to McDowell, volunteer participation in patent pro bono programs vary widely, with some of the more established programs having more than 100 volunteer attorneys.¹⁸ One largely untapped resource for these programs is in-house corporate counsel registered to practice before the USPTO.

Through a patent pro bono program, corporate attorneys registered to practice before the USPTO now have a way to perform pro bono work within their field. For corporate attorneys registered to practice before the USPTO but in a position that does not call upon those skills on a daily basis, the patent pro bono program gives them a vehicle through which they can develop experience in an area they may wish to remain engaged.¹⁹

In 2015, LegalCORPS in Minnesota also led the way for the first hybrid pairing of a patent pro bono program with a law school participating in the USPTO Law School Clinic Certification Pilot Program.²⁰ With this hybrid program, patent prosecution services were expanded to Iowa, North Dakota, South Dakota, and Wisconsin through a partnership between the USPTO Patent Pro Bono Program, LegalCORPS, and William Mitchell College of Law.²¹ While law students participating in USPTO certified intellectual property clinics, such as the one at William Mitchell College of Law, can practice before the USPTO under the supervision of a professor, every step is a new experience, not just to the inventor but to the law student assisting the inventor as well.²² Under the hybrid model, however, experienced patent practitioners are paired with law students to work jointly with an eligible client. Thus, the hybrid programs have the added benefit of pairing a law student with a practicing lawyer to provide the maximum benefit to all participants; the inventor is advised by an experienced patent prosecutor, the student is mentored by a seasoned patent prosecutor while gaining invaluable experience about the process, and the volunteer attorney is able to take on a case while sharing the workload with an eager student volunteer.²³

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As efforts continue in 2015 to complete the expansion of patent pro bono programs nationwide, the USPTO's Patent Pro Bono Program hopes to add additional programs, particularly for densely populated areas or where a regional program covers more than one state. One of the focuses of the additional programs is to encourage still more patent professionals (both in private practice and in-house) to undertake patent pro bono work while bringing the benefits of the hybrid approach to law students at schools that are not part of the USPTO's Law School Clinic Certification Pilot Program. With appropriate engagement and confidentiality agreements, law students at these schools can be paired with volunteer attorneys registered to practice before the USPTO to experience substantive patent prosecution through a patent pro bono program.

Discussions are already underway in two states to develop this type of secondary hybrid program. The USPTO is evaluating several law schools in Illinois that are not part of the USPTO's Law School Clinic Certification Pilot Program, but under this contemplated hybrid arrangement, these law schools would have their law students partner with registered volunteer patent attorneys to provide those students exposure to the patent prosecution process. An opportunity in Delaware would pair law students with local patent prosecutors in the Delaware legal community. Grant Corboy of the USPTO Patent Pro Bono team notes that "with the support of attorneys from large corporations and local law firms partnering with academia to provide pro bono assistance, the hybrid programs have boundless potential to assist the inventive community." If successfully launched, the Delaware program would be the second such program breaking away from the existing regional hub approach to provide more direct service by local practitioners and law students to local inventors and small businesses.

Conclusion

While the endless cries for patent reform continue to spark debate throughout the country, small businesses and independent inventors continue to strive for innovation protection notwithstanding financial hardships, technological delays, and global competition. The USPTO's and the patent bar's focus on a collaborative approach to supporting this heretofore underserved community makes the patent system more accessible to the American public.²⁴ In the words of David Kappos, former director of the USPTO, "[t]he Patent Pro Bono Program showcases American ingenuity at its best—leveraging an immense reserve of legal talent in an arbitrage that brings needed skills to those who can't otherwise access them, to serve inventors, innovation and economic growth."²⁵ While the original mandate of the AIA and President Obama's call to action will soon be accomplished, the USPTO's Patent Pro Bono Program and regional programs throughout the nation continue to strive for equal access to the patent system. ©

Endnotes

¹Leahy-Smith America Invents Act, H.R. 1249, 112th Cong. §32 (2011).

²Jeff Look, *Inventors Gather at the USPTO to Share Ideas*, INVENTORS EYE, November 2010 (comments from the keynote speech given by USPTO Director David Kappos at the 15th Annual Independent

Inventors Conference), available at www.uspto.gov/inventors/independent/eye/201011/conference.jsp (last accessed Feb. 23, 2015).

³*Id.*

⁴*Id.*

⁵See www.whitehouse.gov/the-press-office/2014/02/20/fact-sheet-executive-actions-answering-president-s-call-strengthen-our-patent-system; www.uspto.gov/patent/initiatives/uspto-led-executive-actions-high-tech-patent-issues#heading-8 (last accessed Feb. 23, 2015).

⁶John Calvert, *Pushing Ahead With the Pro Bono Assistance Program*, 12 J. MARSHALL REV. INTELL. PROP. L. 286, 287 (2013).

⁷Kathleen Lynch, *Patent Pro Bono Program Grows: My Interview With Jennifer McDowell, Coordinator of the U.S. Patent Pro Bono Program*, Dec. 16, 2014, available at <http://kliplaw.com/blog/2014/12/16/patent-pro-bono-program-grows-my-interview-with-jennifer-mcdowell-coordinator-of-the-us-patent-pro-bono-program> (last accessed Feb. 23, 2015).

⁸See, e.g., *Pro Bono*, uspto.gov, available at www.uspto.gov/inventors/proseprobono (last accessed Feb. 23, 2015).

⁹*Pro Bono*, uspto.gov, available at web.archive.org/web/20141227015657/http://www.uspto.gov/inventors/proseprobono/ProBono_Transcript.docx (last accessed Dec. 27, 2014).

¹⁰For a few states, the national clearinghouse also serves the role

As efforts continue in 2015 to complete the expansion of patent pro bono programs nationwide, the USPTO's Patent Pro Bono Program hopes to add additional programs, particularly for densely populated areas or where a regional program covers more than one state.

of a regional program in matching eligible clients with volunteer attorneys. See www.fedcirbar.org/olc/pub/LVFC/cpages/misc/pto.jsp (last accessed Feb. 23, 2015).

¹¹As McDowell recently remarked, "[l]ocal innovation supports the local economy and these programs will help ensure that inventors have access to patent counsel, which is so critical to the success of their businesses." Jennifer McDowell and Amy Salmela, *Tri-State Patent Pro Bono Program to Launch in New York, New Jersey, and Connecticut*, ABA Center for Pro Bono Exchange, Feb. 10, 2015 (noting "[t]he patent bar has truly heeded President Obama's call to action on this initiative"), available at <https://centerforprobono.wordpress.com/> (last accessed Feb. 23, 2015).

¹²Eligible clients are required to pay all USPTO fees but receive all legal assistance, within the agreed upon scope of representation, free of charge.

¹³Michelle K. Lee, *Patent Pro Bono Expansion to Benefit Inventors Nationwide*, Dec. 30, 2014, available at www.mbda.gov/node/2965 (last accessed Feb. 23, 2015).

¹⁴*Id.*

¹⁵Robert O. Lindefield, *Public Service Remains the Ultimate Form of Giving Back*, ABA LANDSLIDE, July/August 2014 (noting that "[f]or some time, legal pro bono in the area of intellectual property has evaded many practitioners because of concerns about profes-

sional liability and time commitment”). See also Daniel Ovanezian and Benjamin A. Kimes, *Uncle Sam Wants You! A Call to Pro Bono Service for Patent Practitioners*, *NEW MATTER*, 39:3 (discussing the California Inventors Assistance Program (CIAP), the regional patent pro bono program for California, for whom the California Lawyers for the Arts provides statewide administration, including basic malpractice insurance for corporations that participate in CIAP).

¹⁶See Jennifer McDowell, Ashley Essick, and Daniel Ovanezian, *An Update On USPTO's Patent Pro Bono Initiative*, Feb. 2, 2015, available at www.law360.com/articles/616894/an-update-on-uspto-patent-pro-bono-initiative (last accessed Feb. 24, 2015).

¹⁷See www.legalcorps.org. Since it opened its doors, the Minnesota patent pro bono program has helped at least 15 Minnesota inventors secure patents, and many more Minnesota inventors have received assistance through the program with the drafting and filing of patent applications that are currently pending before the USPTO. Jennifer McDowell and Amy Salmela, *Tri-State Patent Pro Bono Program To Launch in New York, New Jersey, and Connecticut*, ABA Center for Pro Bono Exchange, Feb. 10, 2015, available at centerforprobono.wordpress.com/ (last accessed Feb. 23, 2015). ABA regional patent pro bono programs like Minnesota's LegalCORPS demonstrate the tangible benefit legal practitioners can have on their local community through pro bono efforts focused on patent protection and innovation.

¹⁸Data provided by Bob Pimm, executive director of the California Inventors Assistance Program.

¹⁹Grant Corboy, a former contracts manager with Lockheed Martin and a registered patent attorney, remarked that “volunteering to provide pro bono patent prosecution services was not an option prior to the AIA.”

²⁰See www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1#heading-2.

²¹See www.legalcorps.org/inventors/inventors-iowa-north-dakota-south-dakota-wisconsin (last accessed Feb. 23, 2015).

²²See Section Focus, *A Cooperative Clinic/Corporate Patent Pro Bono Project*, ABA LANDSLIDE, at 7, September/October 2014.

²³*Id.*

²⁴In an era where we need all the innovation we can get, and where every new innovation is cause for celebration regardless of its source, the USPTO's Patent Pro Bono Program shines light on the good that can come from partnerships between the private and public sector in service of the little guy with a big idea.” David J. Kappos, *What's good for U.S. Business? Protect the little guys with big ideas*, *FORTUNE*, Jan. 13, 2015, available at <http://fortune.com/2015/01/13/whats-good-for-u-s-business-protect-the-little-guys-with-big-ideas/> (last accessed Feb. 23, 2015).

²⁵*Id.*

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Dr. J. Clay Smith Jr. In 2001–02, the FBA elected its first Hispanic national president, Russell A. Del Toro of Puerto Rico. In 2009–10, the FBA was led by its first American Indian national president, Lawrence Baca. In general, the FBA has maintained a strong presence in Indian country, as the FBA Indian Law Section has hundreds of members, and its Annual Indian Law Conference draws 500 to 600 attendees every year. This national gathering is the foremost-recognized conference on Indian law in the country.

The FBA's commitment to diversity has been particularly prominent in recent years. In 2014, for instance, the FBA launched the Women in the Law Conference as a premier national event. Also, the recent national conventions have featured panel presentations on topics from same-sex marriage to race and the law. This very edition of *The Federal Lawyer* itself, focusing on diversity and the law, is a testament to FBA's firm commitment to promoting diversity and

inclusivity within the legal profession.

But more can be done. If you are interested in promoting diversity, I encourage you to become involved in the association. There are so many ways to help—such as through your local chapter, a section or division, or by submitting an article to *The Federal Lawyer*. If you are passionate about a particular topic, I urge you to submit a convention panel proposal for the 2016 convention. By virtue of its national scope and local connections, there is room for everyone in the FBA. By building a more diverse FBA, we will ensure the success of the association and the legal profession far into the future. At the same time, we serve our profession, our communities, and our nation. ☺



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