

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



An overview of the Patent Pro Bono Program

Patent Pro Bono Team

Office of Enrollment and Discipline

United States Patent and Trademark Office

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PATENT AND TRADEMARK OFFICE



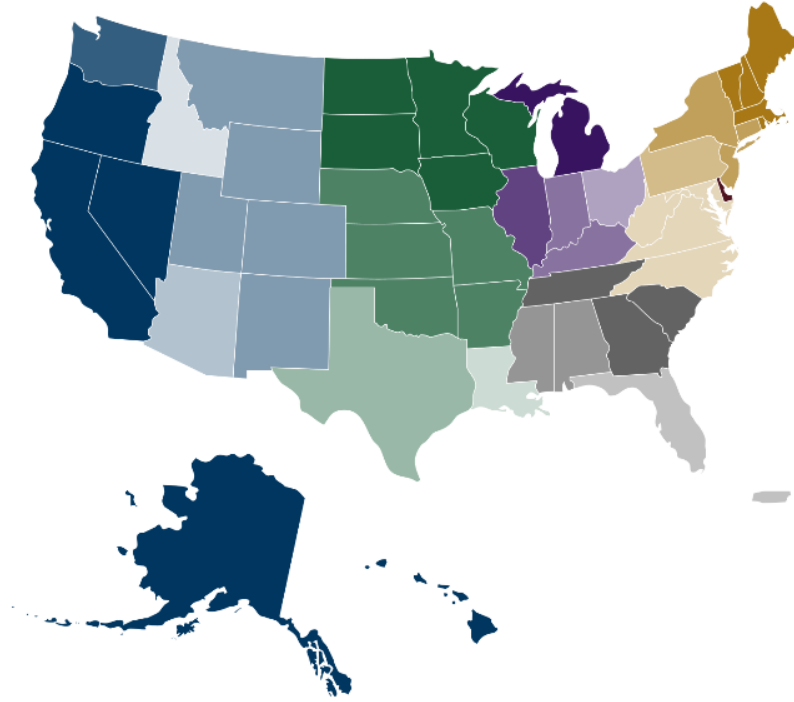
Patent Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses
 - Section 32 of AIA – The USPTO’s Director shall 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
 - USPTO 2019 – 2022 Strategic Plan calls for the USPTO to enhance “the assistance we provide to independent inventors and small businesses”
- 22 regional programs work to match financially under-resourced inventors and small businesses with volunteer practitioners to file and prosecute patent applications

Benefits to USPTO and inventors

- Impact for USPTO
 - Increased participation in the patent system
 - Increases patent application filings
 - Improved patent quality
 - Supplements pro se (filing on your own) assistance efforts
- Impact for inventors
 - Opportunity to work with experienced patent practitioners
 - Over \$26.5M in donated legal services provided to inventors from 2015 to present

Current nationwide coverage



- | | | |
|---|--|---|
| ■ Washington Pro Bono Patent Network | ■ St. Louis U. Pro Bono Patent Program | ■ New England Program |
| ■ Idaho Patent Pro Bono | ■ Texas Accountants and Lawyers for the Arts | ■ New York Tri State Program |
| ■ California Inventors Assistance Program | ■ Louisiana Invents | ■ Delaware Program |
| ■ ProBoPat | ■ Chicago-Kent Patent Hub | ■ Federal Circuit Bar Assn. |
| ■ Arizona Public Patent Program | ■ PatentConnect for Hoosiers | ■ Philadelphia Volunteer Lawyers for the Arts |
| ■ LegalCorps | ■ Ohio Invents | ■ Georgia PATENTS |
| ■ Pro Bono Patent Project | ■ BBVLP Patent Program | ■ Patent Pro Bono FL |

Regional patent pro bono programs

- Regional programs may cover individual or multiple states
- Regional programs are operated by
 - Nonprofit organizations focusing on copyright and trademark (e.g., lawyers for the arts)
 - Universities
 - Bar associations
- Regional programs follow general guidelines but are independent of the USPTO and set their own policies and procedures
- Regional programs are responsible for screening and matching patent pro bono applicants
 - Ensure applicants meet requirements for pro bono assistance
 - Screen for
 - Income
 - Knowledge of the patent system
 - An actual invention (more than an idea)

General criteria for inventors

- **Gross household income:**
 - Regional program dependent, but usually limited to 300% of the federal poverty guidelines .
 - A single person could have an income of up to \$38,280 ([see federal poverty guidelines](#)).
 - The limit increases with additional dependents.
- **Demonstrate knowledge of the patent system:**
 - Have at least a provisional application on file with the USPTO or have completed a [certificate training course](#) (also available in [Spanish](#)).
- **Have an invention: more than an idea**
 - To demonstrate that there is an invention one should be able to describe the invention so that someone could make and use the invention
- **Responsible for all USPTO fees**
 - Micro-entity status provides a 75% reduction in USPTO fees
- **Regional programs may charge an application fee of \$25-\$150.**

General criteria for inventors (cont.)

- Some regional programs have additional requirements
 - For example, some may require you to file a provisional patent application with the USPTO before applying for pro bono assistance
- Applicants with an upcoming deadline may not be able to be matched with a practitioner
 - For example, if you have a provisional application on file with the USPTO, your regional program may only attempt to match you with a practitioner if you apply 3-6 months in advance of your provisional application's expiration date
 - This allows time to find a practitioner and time for the practitioner to complete the work

Micro-entity status (75% reduction in USPTO fees)

- The AIA defines a micro entity as a patent applicant who certifies that he/she
 - Qualifies as a small entity
 - Has not been named as an inventor on more than 4 previously filed patent applications
 - Did not, in the calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding 3 times the median household income
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is paid, had a gross income exceeding 3 times the median household income

Matching with a patent practitioner

- Assuming you qualify for pro bono assistance, your regional program will provide its patent practitioners with a brief description of you and your invention
 - There is no guarantee that a practitioner will choose to work with you on your invention
 - Reasons an invention may not be chosen may include, but are not limited to:
 - No practitioner with experience in your technology
 - You or your invention/business conflicts with an existing or former client of the practitioner
- Follow up with your regional program periodically to verify your status
- If, after a period of time, no practitioner chooses to work on your invention, then your regional program will inform you that no practitioner is available to serve you
 - Your regional program may provide you with other resources that may help you pursue your patent application

Working with a patent practitioner

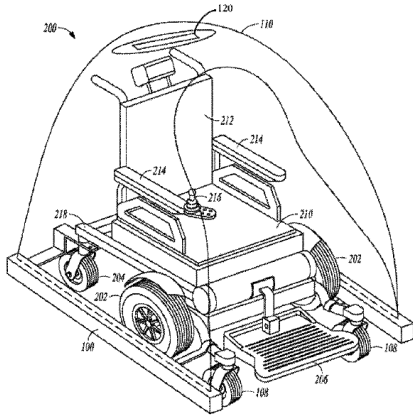
- If matched, be an active participant in your patent application preparation and filing!
 - Be able to describe your invention, its inventive feature(s), and the problem that you are trying to solve
 - Know your marketplace
 - Be aware of similar inventions or solutions to the problem
 - Be responsive to the practitioner's requests
- The practitioner may require you to sign an engagement letter or retainer agreement
 - Such letters may discuss information including, but not limited to
 - The scope of services provided
 - Any ancillary fees
 - The reasons that the practitioner may withdraw from the representation
 - Avoid verbal agreements

Working with a patent practitioner

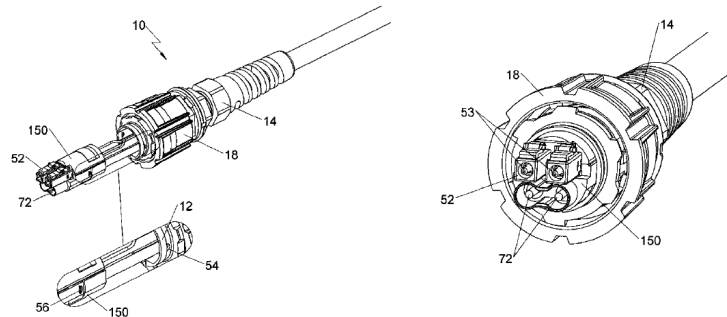
- The scope of services provided may be limited to just a portion of the patenting process
 - This is also called a limited engagement or “unbundled” services
 - The patent application process has several stages including
 - Preparation and filing of the patent application
 - Response to USPTO communications
 - If the patent is granted, the payment of periodic maintenance fees
 - For example, a practitioner may help prepare and file your application, but may not agree to help with the other stages of the process
 - The practitioner must obtain your *informed consent* to limit the scope of services
- In addition to USPTO fees, you may need to pay for ancillary fees such as drawings
 - You are responsible for USPTO fees - do not ask the practitioner to advance or pay your USPTO fees
 - Ask questions

Success stories

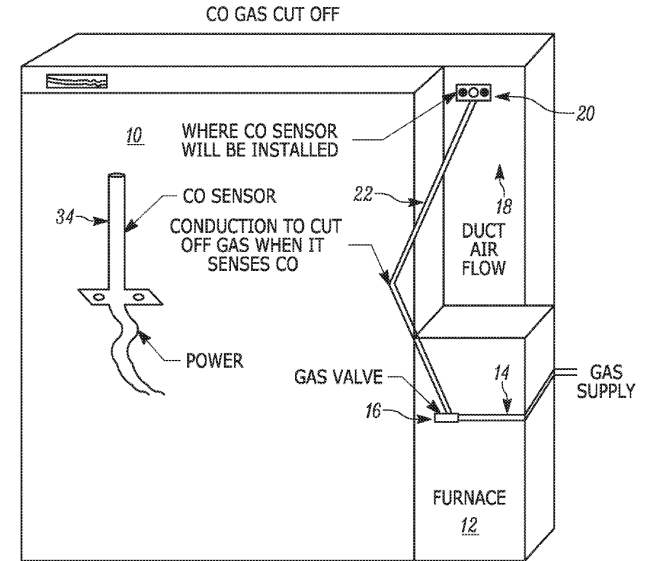
Wheelchair Protector
US 9,943,455



Optical Fiber Connector
US 10,396,512



Carbon Monoxide Detector
US 10,101,027



Applying to the Patent Pro Bono Program

- To apply
- Apply directly with your regional program
 - To find the regional program that serves you, see www.uspto.gov/probonopatents for a map of the United States and select your state
- Email probono@uspto.gov if you have any questions

Finding a patent practitioner

(<https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/finding-patent-practitioner>)

The screenshot shows the top navigation bar of the USPTO website. On the left is the USPTO logo and the text "UNITED STATES PATENT AND TRADEMARK OFFICE". On the right are links for "About Us", "Jobs", "Contact Us", and "MyUSPTO". Below this is a search bar with the text "Search uspto.gov" and a magnifying glass icon. A secondary navigation bar contains links for "Patents", "Trademarks", "IP Policy", and "Learning and Resources", along with a "Find It Fast" button. Below that is a breadcrumb trail: "Home > Learning and Resources > Patent and Trademark Practitioners > Finding a patent practitioner", and social sharing icons for "Share" and "Print".

Patent & trademark practitioners

Becoming a patent practitioner

Finding a patent practitioner

Register of active patent practitioners

Disciplined practitioners

Becoming a trademark practitioner

Finding a trademark practitioner

Information for current practitioners

Finding a patent practitioner

Finding a registered patent practitioner

OED maintains a [register of active patent practitioners](#) who are eligible to represent others before the USPTO in patent matters. Only registered patent attorneys and agents, and individuals granted limited recognition, may represent patent applicants before the USPTO. Individuals not listed on the register are generally unable to represent others before the USPTO in patent matters.

While OED maintains the register, the USPTO cannot aid in the selection or recommendation of an attorney or agent. You may also consider the services of the Law School Clinic Certification or Patent Pro Bono programs.

Disciplined practitioners

For information about practitioners who have been disciplined, search [OED Final Decisions in the FOIA Reading Room](#).

Historical roster books

View and download [roster books published since 1883](#).



Finding a patent practitioner cont.

Practitioner search

Last name OFF Exact match

First name OFF Exact match

Middle initial

Business/firm OFF Exact match

Country ▼

State/province ▼

City OFF Exact match

Postal code OFF Exact match

Registration No. Please enter numbers only. Ex: 12345

OFF Only search for practitioners currently accepting new clients

OFF Include limited recognition ⓘ



Other USPTO resources

- The Pro Se Assistance Program offers services for inventors filing without assistance from a patent practitioner
 - Call (866) 767-3848 between 8:30 a.m. and 5 p.m., Monday-Friday, ET
 - www.uspto.gov/ProSePatents
- The Inventors Assistance Center answers general questions concerning patent examining policy and procedure, such as
 - Necessary formats and items needed for your patent application and
 - Completing the forms
 - www.uspto.gov/learning-and-resources/support-centers/inventors-assistance-center-iac
- Scam prevention
 - www.uspto.gov/inventors/scam_prevention/index.jsp
- Review online resources found at www.uspto.gov



