

Transcript of USPTO Listening Session on the Study on Patent Pro Bono Program

June 07, 2023

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DAVID BERDAN: We look forward to comments and questions that we get from this for our study. Thank you to everyone attending, both live and in person and those who are attending virtually. Next on the agenda is for me to introduce one of my favorite people. Derrick Brent is the Deputy Director for USPTO. His title is really Deputy Undersecretary of Commerce for Intellectual Property and Deputy Director of the USPTO. A long title. But well deserved. He serves as principal adviser to our Director of the USPTO. He has a passion for outreach, so he's very busy with us in the patent pro bono program and outreach to underrepresented communities and individuals throughout the states and territories. Let's see. Deputy Director Brent served in all three branches of federal government. He also served in the private sector. He clerked for the Honorable Judge Marbley for the Southern District of Ohio and also served six years as a trial attorney at the U.S. Department of Justice, specifically in the civil rights division, where he received a special achievement award for his trial work. He also served as Chief Counsel in the U.S. Senate where he handled IP, constitutional law, and civil rights issues, while working on judicial nominations. In the private sector, he served as Vice President of and

Associate General Counsel of Masimo and as an engineer for General Motors. He received a Bachelor of Science degree in mechanical engineering from The Ohio State University and earned his doctorate from Northwestern University School of Law. Deputy Director Brent, welcome aboard.

DERRICK BRENT: Thank you for the kind words in the opening. I want to open by stating what a privilege it is to be in this program. One of the first projects that I was able to join when I began here at the USPTO was in the pro bono program. In fact, Will and Grant and all the folks from the pro bono program came over to my office in my first week. It was a great meeting. It was a meeting of the minds, but it was also a meeting of the hearts. That's what made it so special. This is really part of the heart and soul of the Patent and Trademark Office's mission, which is to help bring those, bring the programs and bring the office's resources to those in need. And bring it to them where they are. So this program is important, an important part. Thanks to Congress for giving us an additional mechanism by which to seek to improve the program. I want to wish everyone a good afternoon.

I want to say a big thank you to everyone in the Office of Enrollment and Discipline for everything you do to support the patent program. To all of you who administer the program and are joining us from your posts around the country, thank you for your dedication to inventors and your communities and to your states. By being here today, you are helping to improve lives and upgrade communities through the power of patents. You are on the leading edge of our nation's commitment to broadening participation in the innovation era. So, on behalf of the Director, the senior management team at USPTO, our Patents business unit and all

examiners and colleagues of the USPTO, thank you for your commitment to this mission and for your commitment to our nation's inventors and entrepreneurs.

Administering the patent pro bono program is no easy feat. Keeping your operations viable on limited budgets, working with your local sponsoring organizations and promoting your services to potential inventors who are struggling to make ends meet. But we are here to help you. We hope that we can support you in every way possible. To comply with the requirements under the Unleashing American Innovators Act of 2022, also known as the UAIA, we have been asked to complete a study of the patent pro bono program (PPBP). In order to assess the engagement and health of these programs, the Director and I have been visiting cities around the country. We have been meeting and connecting with pro bono service providers, inventors and business entrepreneurs and IP law students to discuss the PPBP in terms of providing the service. We are trying to learn new ways to bring up and coming inventors into the ecosystem. We have heard from people, people innovators about how the patent program helped them to grow their businesses and reach the marketplace. We've solicited suggestions on how to improve all aspects of our operations and our country's IP system. We continue with this important inquiry here today.

To that end, today we're talking to practitioners, we invite you to let us know your experiences, your success stories, and your challenges. The anecdotes and your experiences are things that only you can provide and give us crucial and vital data points from which we can figure out ways in order to better provide our services. It will help keep the PPBP focused and also to make sure that it is providing the best service possible to our constituents. There's a consistent theme that runs through our USPTO pro bono programs. That is providing critical assistance to

underrepresented inventors and serving as a bridge to inclusive innovation. We are always open to your suggestions on how to IMPROVE and expand the scope of the pro bono program, which is why today's event is so important.

So thanks to the UAIA, and thank you to Congress and the President for signing it into law.

Thanks to those actions, we are poised to build on these programs. To do so, we start today by listening and hearing and taking data. So, I would like to again thank everyone for participating online. Thank you for making time for this important project. I look forward to hearing all the discussion today. Thank you very much.

GRANT CORBOY: I'd like to introduce James Silberman to give some background on the congressional mandated study. Jim?

JAMES SILBERMANN: Thank you, Grant. First, I want to thank the Deputy Director for his remarks and for his support of these programs. Try not to reiterate things. As part of what I'll do is a road map of where we're going and a little bit, as Grant said, the pro bono programs and UAIA which seems easier to say than it actually is. As Grant mentioned, my name is Jim Silberman, Senior Counsel for Intellectual Property Services at the USPTO. As part of that role, I oversee the PPBP which we are here today to gather some information from practitioners. As Dave and Deputy Director Brent mentioned, this is the second of two listening sessions. The first listening session we had was Monday evening, where we heard from inventors and those who received services from the PPBP. The goal is to hear from those providing the intellectual property legal services to those under-resourced individuals and small businesses. So, kind of as some background. As everyone has mentioned, last year on December 29, 2022, the Consolidated Appropriations Act, which included the Unleashing American Innovators Act

(UAIA) set forth some things for the USPTO to look at, as far as its innovation. One of those things was to complete a study on the patent pro bono programs that were initiated under Section 32 of the Leahy-Smith Act. The study is due to Congress a year from the passage of that, so December of this year. There are several areas that the study asked the USPTO to look at with respect to the patent pro bono programs under the American Invents Act. Some of those we'll be addressing today, hearing from the panelists, hearing from individuals in the audience, as well as receiving comments to a Federal Register Notice that we published in April of 2023, which July 11th is the closing date. So here we are on June 7th. For those listening online, there's plenty of opportunity for you to submit your comments to the Federal Register Notice, if you're unable to do it today. But to get that information to us so that we're able to consider that and include that information in the study. So, as I say, some of the areas that we were asked to address in this study were whether the patent pro bono programs sufficiently serve participants. We were all asked whether the programs are sufficiently funded so that they can ultimately serve participants. Another area of study that we can look at today or from comments in the Federal Register Notice are whether the participation requirements of the programs are deterring participation among inventors or the correlator of that, whether there are factors that are deterring attorney participation in providing those pro bono patent legal services to underrepresented individuals and small businesses. There was a question about awareness of the program, whether there's awareness from the individuals who the program seeks to help about the existence of that program, as well as whether the program could benefit from any non-attorney assistance. Now these are all listed in the Federal Register Notice. There's not really a need to go and take notes quickly on this. Let me just say that. What we're doing is to

try to obtain feedback today from the public and specifically from those providers of legal services, that is practitioners who provide services to pro bono clients. That is the goal of this listening session. We are using this listening session as well as our request for comments on the Federal Register to solicit that feedback. That's going to help us evaluate those programs and make recommendations to Congress about possible administrative or legislative action. Again, just to make these programs better so that they are doing what they were intended to do when they were initially passed.

And so a little bit of a road map. We'll listen to me for a bit. I'll try to be brief. I'm almost finished. We'll get an overview of the PPBP from Kim Kelleher. We'll then have an overview of the Patent Trial and Appeal Board (PTAB) Pro Bono Program from Vice Chief Judge Janet Gongola of the PTAB.

We'll then have a presentation from some program stakeholders who are to my right at the table here. We have going from my right to my left Jim Patterson, who is a principal at Patterson Thunte and also chair of the Pro Bono Advisory Council (PBAC). We have Deborah Miron, Director of the not-for-profit program that runs the patent pro bono program in the District of Columbia and the states of Maryland and Virginia. We next have Warren Tuttle. He's the Open Innovation Director of MarketBlast. He's also a PACB member. We have Rodney Rothwell, a partner at Kilpatrick Townsend. We will hear from those individuals in a panel discussion. We'll then open the floor to input and commentary on that. The question and answers from the panel, as well as any comments from the floor, as far as what the panel has discussed or any of the issues that we had today regarding the listening session, those factors that I had gone over.

That being said, if you're unable to get your comments in today, technical issues or whatever the fact may be, that when it comes time for the open commentary, that's when you have a client meeting or phone call, if you're watching online. The Federal Register comment period is open through July 11, 2023 so have plenty of time and we do welcome your feedback on this. We want to hear from you. That's why we're having these sessions on the program. I think with that, that's probably good enough for me. I will then, Grant is going to come up briefly and give us some logistics about how to do that. I know that the chat box is being monitored by Liz Dorsey. So if you have any questions that you'd like to ask, feel free to put them in chat. Grant will then tell me exactly how I messed up, as far as these things go. I thank you for your time today.

GRANT CORBOY: Jim had mentioned the Federal Register Notice. I'm going to pull that up on the screen now. If you do have comments, you can provide them on the Federal Register Notice at this link right here. We will put this up another time during the event. This is another opportunity for you to share comments. As Jim mentioned, it's until July 11, 2023. Without further ado, I'm excited to introduce your next speaker. Her name is Kim Kelleher. She is a pro bono team member. She's always interested in helping provide people with services and sharing this information about the program so that people can get access to free legal assistance.

Without much further ado, let me introduce Kim. Kim?

KIM KELLEHER: Thank you, Grant. Good afternoon, everybody. My name is Kim Kelleher. I am a staff attorney in the Office of Enrollment and Discipline. I do help out with pro bono efforts. My goal today is to make sure that you have all the information you need in order to make comments so that we can receive those comments and process them and get them in a timely manner. So, with that, let's get started. Most of you know this. The PPBP assists financially

under-resourced independent inventors and small businesses. The way that's accomplished is by matching up those inventors with practitioners. And those practitioners are volunteers. That's how it's pro bono. And they act together to file and prosecute patent applications.

Now, the USPTO has a coordinating role in this. But the matching process happens through our 20 regional programs that actually match the inventors and the practitioners. There are a lot of benefits for the inventors and the PTO. On the slide should be also the practitioners. The practitioners get benefits as well, such as being able to work in a pro bono space in their area of expertise, namely patent prosecution. Also, the benefit of helping those financially underserved communities and inventors is a benefit to the practitioners as well. Sometimes there is CLE attached to that too, so that's also a benefit. Where the inventors, they get the opportunity to work with experienced patent practitioners. So, for the PTO, this results in an improvement in patent quality because the inventors are submitting applications that have assistance from the patent practitioners.

Based on AIPLA's recent study of legal fees for patent legal services, we estimate that nearly \$36 million has been donated in legal services to inventors from 2015 to the present. So that's a pretty impressive number. Also of benefit to the PTO, we get increased participation from the patent system for those who may not have participated in the past, which is great for us. This supplements our pro se effort, in that we have an Inventors Assistance Center that helps pro se inventors, but mainly that's primarily for filing documents, so it's not really a legal services arena. That's where the pro bono program really shines.

Some statistics to look at here. Generally we are on an upward trend, which is a good thing. If you look at each of these boxes: the number of hours donated, inventors' inquiries, patents filed

and number of inventors assisted. So that's a good thing. We do see a little bit of a downtick from 2020 in the number of hours donated. That's where our plea comes in for practitioners to step up and volunteer. We need your help in being able to meet the needs. As you can see the number of inventors' inquiries is going up. If you look at the total life of the program, that is, the total number of hours donated is a price approaching 96,000 hours. The number of applications filed is about 2,000. The number of inventor inquiries is about 18,000. And the inventors assisted are about 4,000.

You might think there's a large difference between inventor inquiries and inventors assisted. But there's a reason for that, because if an inventor calls one of the regional programs and has a question, that question may not be relevant to patent pro bono services. Or that inventor may not actually meet the criteria, which we are going to talk about in a minute. This we recently published on our blog. It has to do with whether the PPBP is able to meet those needs of those in underrepresented communities. So, if we take a look at applicant gender demographics, male versus female, what we see is of the people who responded, 43% are female and 57% are male. This is actually a great result because if we take a look at the inventors across the board for PTO, the 43% is much higher than what we would be on average. If we take a look at the applicant race demographics, that's also a very good result in that we're seeing 49% being from minority communities. So, we are targeting or actually meeting those needs in underrepresented communities.

We do have nationwide coverage. The way that's achieved is through those 20 regional programs. Each program can be responsible for one state or for many states. So, for example, if you are an inventor in Seattle, Washington, you would apply to the California Inventors

Assistance Program. If, likewise, if you're a practitioner in Seattle, Washington, and you want to volunteer, you would apply through the California Inventors Assistance Program as well. That QR code that's on your screen, that's a link to our page where you can access this map and find out what program you would be connected with based upon your state. And you can also find out additional information about our program.

The regional programs themselves are operated by nonprofit organizations such as Lawyers for the Arts. They're also operated by universities and bar associations. They do follow the general guidelines of the PTO, but they are independent, and so they have their own set of policies and procedures that both inventors and practitioners must follow. They are responsible for screening and matching the applicants with the volunteer practitioners. They make sure that the applicants meet the requirements for pro bono assistance. And those requirements are basically fourfold.

Now the regional programs can add additional requirements, but these are very general PTO requirements. The gross household income of the inventor is dependent upon the program, but generally limited to 300% of the federal poverty guidelines. Congress has encouraged this number to be increased to 400% and two of our programs have done that. Others are working towards that. For the 300% number, a single person could have an income of up to \$43,740.

With the addition of additional family members, this number would go up. The inventor has to demonstrate knowledge of the patent system. They can do this in one of two ways. They can have at least filed a provisional application with the PTO, or they could have completed a certificate training, which is available online and is also available in Spanish. The third criteria is that they must have an invention, which is more than an idea. So, what this means, practitioners know this, is that the inventor should be able to describe the invention, so that someone could

make and use it. Typically, this is an invention disclosure form. Again, the inventor must have that invention. Lastly, the inventor is responsible for all USPTO fees. However, they may qualify for micro-entity status, which would entitle them to 80% reduction of the fees. There could be additional fees for the inventor to pay, so the regional programs can institute a processing fee. And then there may be drawing fees involved in the application process as well.

This slide is generally for inventors, but it's good for practitioners to know, too, that we encourage the regional programs and regional programs encourage the inventors to communicate openly and freely with the program and with the practitioner. We also encourage early communication so that the practitioner has enough time to prepare and file the application or prepare and file the response. The inventors are also told that there is no guarantee of a match. And they are given a variety of reasons for that. It could be that there is no practitioner currently available in their technology area. It could be that there's a conflict. Could be for a number of reasons. The inventors are told to follow up with the regional programs to make sure, again, that open flow of communication happens. And if, after a period of time passes and there is no match, the inventor is told that, so they can take advantage of other options.

If you're interested in volunteering, as a practitioner, you can apply directly to the program in your region. Again, you can go to our website and go to that map and select your state and it will link you right to the program that is responsible for your area. If you have any questions about this process, please feel free to email us at probono@uspto.gov. Then, lastly, I think this will be a repeating theme. We are requesting comments from the public, that includes practitioners, to improve the patent pro bono programs. Today is one of those opportunities.

There's another opportunity through the Federal Register Notice with the link there. The written comments are due by July 11th. The last bullet you already know. We are hosting two listening sessions. One is today and the other was on Monday. We are already receiving feedback from the inventors and it's been great to hear from them. And with that, I think I will conclude and turn it back over to Grant.

GRANT CORBOY: Thank you, Kimberly. So next is Vice Chief Judge Gongola. She's going to share, this is a recent program, fairly recent, compared to the PPBP. It's for ex parte appeals in front of the PTAB. Janet?

JANET GONGOLA: Thank you very much, Grant. Yes, we are the new kid on the block. We are really happy to be here. I'm happy to be here today to talk to you about the scope of PTAB pro bono. We learned a lot from the PPBP, so I feel like we stood on the shoulders of giants standing up the PTAB program. There are a few different aspects of this program I want to go over with you today.

First, we'll cover some background information. Then, we will talk about eligibility requirements, both for the inventors as well as the volunteer practitioners. Third, we will talk about the process of how matchmaking occurs. That sounds like a little bit like Love is Blind, a Netflix series that I have been binge watching. Then finally, we will cover some of the resources for how to get in touch with the program and how to participate.

Similar to the patent pro bono program, PTAB pro bono seeks to match under-resourced inventors with volunteer patent practitioners, patent attorneys or patent agents to assist them with PTAB proceedings. Right now the scope of the program covers ex parte appeals only.

EVENTUALLY we will include it to cover AIA trials. The intent behind both pro bono programs is

to enable inventors across demographics, across economic levels, across geographic regions to bring innovations to impact. That's the quote from our director Kathi Vidal on this slide. It's a theme for her administration. So various initiatives you will hear her talk about the concept of bringing innovation to impact.

So the benefits of pro bono are very similar to what Kim talked about. For the inventors, the availability of free legal help removes barriers to entry in the patent system. It also helps them make more effective arguments. Not that an inventor individually can't represent themselves well, but I like to think of it as two heads are always better than one. Work product as a team typically is always better than the individual. That's kind of the way the patent pro bono programs work. They can help guide the inventors to putting their best legal face forward. For our practitioners, they get something out of the volunteer service. They are able to provide legal help in the field of their practice. So they don't have to volunteer legal service in immigration law or asylum law. They're able to volunteer in patent practice. They also are able to build up their contacts within the community and ideally the inventors who start out as a pro bono client eventually become a paying client for them, as they meet with success.

The PTAB PPBP is singular. We have one clearinghouse, the PTAB Bar Association that administers the program nationwide. I'll tell you more about the role that the PTAB Bar Association plays. Now, our program was launched a year ago. We are indeed new. We are limited to ex parte appeals. Not appeal to the Federal Circuit, but appeals before the Board alone. Within our first year, we recognized that maybe we were a little too narrow when we set up the program up, so in the spring, we did a few different things to expand the program. We grew the program to cover individual inventors, inventor groups, and inventor-owned small

businesses. We also removed some of the eligibility criteria to enable more inventors to qualify. We increased the income limit. I'll tell you more about that. We removed what's called the micro-entity status so as to not restrict an inventor's previous experience with the patent system when applying for pro bono help. This year, we anticipate having another expansion in the fall into the AIA trial area. We intend to offer free legal help to patent owners and then ideally will grow the program in the future to cover petitioners.

Now let's talk about what it takes for an inventor to qualify or a volunteer to raise their hand and say, I'll help. We're going to talk about eligibility for the three entities listed on the slide. For the inventors, we see a number of criteria here. They have to be domiciled in the United States. And they cannot have an income above a certain level. That level is set at 400% of the federal poverty guidelines. That's the level that Congress suggested through the UAIA, I think, to place the income threshold. So for an individual inventor, this allows them to earn as much as \$58,000 and still get free legal help. It is a sliding income scale for PTAB pro bono similar to the PPBP. I'll talk about that on the next slide, as to what that sliding scale encompasses. Before we get there, a few or more of the eligibility criteria. There is a timeline for an ex parte appeal. Certain filings have to be made within a certain number of months. For our program, inventors must seek help within one month of the date of either a final rejection or a second office action rejection. That one month clock enables the attorneys to have sufficient time to work on a case, learn the technology, write the brief and file the papers with the PTAB. The inventor also must demonstrate some form of knowledge about the program and the appeal process. The reason we have this knowledge requirement is to have the inventors' expectations set. They know how long the process is going to take. They know the number of steps involved. They also know what

they can expect from their volunteer practitioner. We don't want them to have unreasonable expectations as to what the program can do for them. Otherwise, we fear they would be disappointed. And then finally, the inventors must have an ownership interest in the invention. They cannot be under an obligation to assign the invention to a large-sized very profitable entity, for example. That just goes against the grain of the concept of pro bono. Through this program, we are trying to help those who do not have the financial resources to help themselves. So it would seem unfair if these inventors could assign the invention over to a profitable entity yet still receive free legal help. At that point in time, they are able to pay for the legal help for themselves.

Now, on the income sliding scale, this slide is intended to show you that as the size of your household increases, your income limit increases. So for example, if there are four members of your household, you may earn up to \$120,000 and still qualify for pro bono assistance. Now, the clearinghouse. What is their function? The clearinghouse screens the applications and they will solicit volunteer practitioners. They then match the two together once the match is made. Then the practitioners take the case forward from there. The clearinghouse backs out of responsibility, but they monitor how the program is doing. Whatever success is met through these matches gets reported to you. The PTAB Bar Association runs the program independently from the USPTO. We're involved, but we don't do administration of the program on a day-to-day basis. We don't determine if an inventor is eligible. The Bar Association does that function as the clearinghouse. The USPTO supports the pro bono program in terms of publicizing the availability of this free legal help, recognizing inventors who have come through the program, and recognizing volunteer practitioners. We are here to raise the awareness of the program but

ownership of the program resides with the PTAB Bar Association. Now for volunteer practitioners, either agents or attorneys, they must meet certain criteria to participate. The criteria is intended to give inventors an assurance that the volunteers are competent, capable and experienced in the matters for which they will represent the inventors. So we ask that the volunteers complete a form indicating what technology they've worked in, the scope of their practice area. To date, we're limited to ex parte appeals so we don't want to use the PPBP as a training ground for new attorneys. It's intended for experienced attorneys to offer their services to the program. Doesn't mean less experienced attorneys can't participate. They can, but we like them to do so under the umbrella or the overview of a more experienced practitioner. The practitioners must provide malpractice insurance. The Bar Association will not provide insurance. And we ask that the attorneys or agents enter into a representation agreement with the inventors. The purpose of that representation agreement is to specifically list the exact services to be covered. We don't want inventors to be confused that they think they have an attorney for any and all purposes when, in fact, the attorney is there to represent them only in their matter before the PTAB. The representation is free for the attorney fees. However, the inventor is responsible for paying any Government required filing fees for the appeal. And there are a few of those in the appeals process.

Now let's go to process. How does this all work? On the PTAB Bar Association website, there are forms for volunteers and practitioners to fill out. Once an inventor application is received, the Bar Association will send an email to all the volunteers to see who would like to represent this particular inventor. And the volunteers can raise their hand. They get some background information about the inventor so that they understand the scope of the issue, the technology.

They can make a conflict check to ensure that the practitioner is free and clear to represent this inventor. And if so, the volunteer will raise their hand. The PTAB Bar Association connects the two. A match made in heaven, hopefully, happens and off they go to continue the work. Now, it is not possible in every single instance for the Bar Association to achieve a match. It may be such that, given the point in time, who is available to volunteer, their conflicts, that an inventor will not be able to be matched. Should that occur, because we have a time clock running, if no volunteer attorney is found after one month, the Bar Association will contact the inventor and let them know. Unfortunately, this time around, we don't have a volunteer for you. We cannot make a match. But check back in the future. By making that communication, the inventor knows they will either need to proceed on their own or they may, if they would help at that point have to secure paid legal counsel to help them. But the circle is closed so that no inventor is ever out there wondering, am I going to get help or not? And in the meantime, forego any rights.

Now the last thing I want to leave you with are the resources of where to go for more information about what I addressed today. The slide here lists a variety of websites, the PTAB Bar Association website, and the USPTO website where you can find information to sign up for the program. Alternatively, this slide features two email addresses. PTAB, that you can contact. I check the emails. You'll receive a response from me or another member of the team. We will be in touch with you. We are very committed to making this program a success. We want to help you. We encourage both inventors and volunteer practitioners to take advantage of the program. We're the new kid on the block, but I'm very pleased to report we have successfully made four matches so far. Those matches really occurred after we broadened out the eligibility criteria. So now that we have started to crawl, we're hoping to start to walk and eventually we

start to run. I hope all of you will be running that marathon with us. Happy to answer any questions, but my time with you is now concluded and I will turn things back over to our moderator, Grant Corboy, who will take us into the next segment of the program. Thank you.

GRANT CORBOY: Thank you, Janet. Now I'm going to go to this next session, which I'm really excited to begin. But before I start, I did see we will have time for questions. If one of the presenters caused you to think about something, please feel free to put those questions in the Question and Answer session. Then, after this panel discussion, we will open it up and you can raise your hand, unmute your mic and provide comments verbally. With the information Kim and Janet had mentioned, the USPTO is really a cheerleader for the PPBP. The AIA indicates that the PTO should encourage the establishment of these programs. The [people who are actually doing the work are to my right, so it is important to hear from them and get their perspective on the program. So let me start immediately to my right by introducing Jim Patterson. Jim Patterson is the principal and founder of Patterson Thuente IP located in Minneapolis, Minnesota. The PPBP started over a decade ago with Jim's leadership and watching the Pilot Program in his home state of Minnesota. Since then, Jim has been instrumental in the PPBP in over 50 states. Internationally, Jim continues his role in the creation of an expansion of the international patent pro bono program, specifically the initiative undertaken in conjunction with the World Economic Forum. As an attorney, Jim has over 30 years of experience in all elements of intellectual property prosecution, whether it be patents, trademarks, copyrights, even litigation. He has spent his career helping innovators profit from their intellectual property. Thanks for being here. Next we have Deborah Miron, Executive Director of the Federal Circuit Bar Association covering Virginia, D.C., West Virginia and Maryland. She brings a wealth of

experience to a distinguished career as a judge, executive, litigator and dedicated public servant of the United States Government. From 2002 to 2020, she served as the Chief Administrative Judge under the MSPB, whose primary review in court is the United States Court of Appeals of the Federal Circuit. In that capacity, she had legal and supervisory oversight of the offices of more than 60 administrative judges charged with hearing and issuing decisions in over 5,000 federal employee appeals each year. She also coordinated the mediation appeals program. She was appointed to the advisory counsel for the United States Court of Appeals for the Federal Circuit. Deborah is a recipient of numerous awards including MSPB's highest honor. She received an award for justice for victims of crimes presented by the former U.S. Attorney General Eric Holder for the extraordinary assistance of her employee who was the victim of stalking and violent assault. It enabled the Department of Justice to prosecute the stalker. By virtue of having catapulted off a U.S. Navy carrier, she received the Navy Superior Civilian Civil Service Award and twice received the Navy medal of meritorious civilian service. Previously, Deborah served as Deputy Assistant General Counsel of the Manpower and Reserve Affairs for the Department of the Navy where she was senior legal adviser for military and personnel issues in the Pentagon and supervised the 18 legal offices in the United States within the department. She was appointed counsel to the committee on opportunities for military and civilian women in the Navy. Deborah received her BA from the State University of New York at Buffalo where she was elected to Phi Beta Kappa. She was a senior executive fellow at the John F. Kennedy school of government at Harvard University and selected as a member of the Senior Executive Service of the United States of America. Deborah, thank you for being here. Next to Deborah, we have Warren Tuttle, an Open Innovation Director for Marketblast, the premiere platform for

submitting new and unique products directly to leading companies. Warren also oversees the open innovation product program for publicly traded lifetime brands in housewares including Farberware, KitchenAid and 40 other brands. The Merchant Media and other direct response television sites, Smart Spin, True Touch, etc. For many years, Warren has also helped Techtronic Industries, you might know them as Rigid. Warren has been behind many highly successful consumer products including MSPO, gourmet olive sprayer, the Smart Spin storage container system, the odor absorbing splatter screen, and knife sharpener. Warren personally interacts with thousands of inventors every year and initiates over 100 new consumer product licensing agreements that have collectively generated over \$1 billion in retail sales. Warren is also a well-known advocate for inventors' rights. He served for 12 years as President of the United Inventors Association, a 501(c)(3) with high ethical standards that helps inventors through education, advocacy and sponsorship of inventors, and sponsorships of inventors in several industrial trade shows, most notably the national hardware and houseware shows. Warren serves as a board member of the Pro Bono Advisory Council. Additionally, he cochairs the Creator Committee for the United States Intellectual Property Alliance. Warren's book the "Honest Guide to Profitable Innovation" is published by Harper's Collins and available on Amazon. Warren, thank you for being here today. Lastly but not least we have Rodney Rothwell. Rodney is a registered patent attorney with 15 years' experience in patent procurement, client counseling and portfolio development enforcement. Primarily at the intersection between biology and software. Rodney has counseled a diverse set of clients including individual inventors, startups, small, mid and large size companies including Fortune 500 companies in a wide range of technologies with an emphasis on bioinformatics, biology and artificial intelligence technology. Rodney is a volunteer

patent practitioner for the PPBP where he volunteers through the Bar Association. Rodney has handled many patent pro bono representations and encourages his associates to volunteer as well. Rodney, thank you for being here.

Before I begin, I'd like to mention, please hold questions until the end. At the end of their presentations, we'll have an opportunity to hear directly from you. Without further ado, let's get to our first question. Jim, you drew the short straw, so we'll start with you. Start by introducing yourself to the audience and talk about your role in the PPBP.

JIM PATTERSON: Thanks. I have been involved from the very beginning and it's been a delight and a highlight of my career to see the interaction with the PTO. Thank you, Grant, for all you and your colleagues do. And the Patent Bar extending across the nation for their willingness to participate. Maybe just one point along the lines of encouraging the bar and celebrating what they have done. When the program first started, there was a question about would the bar step forward because it's a heavy lift to ask of an individual attorney, or of a law firm to provide its partners and associates in the pro bono role, which ends up being a monetary value of 5, 10, even up to \$20,000 to get a patent application on file. That's a big donation. Would attorneys step up and would the large law firms accommodate their associates to be able to do it? I say that because individual law firms, my experience across my career, step up almost automatically. The answer is, if we are not careful when we subscribe and solicit for volunteers, we get too many. It's always a challenge to make sure that we have the right amount of volunteers to the number of attorneys. Number of volunteer attorneys to the number of people that apply to the program. So for that broad question, I'd just like to say that and summarize it as a thank you so much to the Bar for all that they have done and continue to do in stepping up as volunteers.

GRANT CORBOY: Deborah, what is your experience and perspective about the PPBP?

DEBORAH MIRON: Thank you. So I came to the federal circuit bar association as Executive Director just when the pandemic hit, timing being what it is. So we, but even before that, as you noted in that very generous introduction, I was involved with the circuit community as one of the review tribunals. And so I was on the other side of helping to set up pro bono programs because the Bar Association did not have just this patent pro bono program, even in patents we also do have an intellectual property program. We also do MSPB, civilian personnel and veterans. But as you know, it takes a certain level of expertise to handle patent cases. It does in the other areas as well. We're able to train patent lawyers often who are former law clerks at the Federal Circuit and have been exposed to veterans' cases, MSPB cases. We need patent lawyers to volunteer for patent pro bono cases. We have many. Most of our membership are patent lawyers, and so we have many volunteers. What we are trying to do is make sure we get those love matches, so nicely put before. I think that as we have Rodney here to talk about his experience as a practitioner, he's a great example of how to maximize and get more success so our lawyers are very busy. At any given moment, they may not be able to take an individual case. But what some practitioners do so well is to be able to reach out to their associates, other colleagues that they know to enlist their help, if they can't take the case. I think that's the kind of maximizing of resources that we need someone to do. We're looking at those opportunities and making very good use of USPTO expertise. I have called on them and all of you, thank you all for helping me because I really want you to keep us constantly improving. You've helped me do that by sharing best practices from others and linking us to other organizations so we can learn how other organization, other regional organizations operate.

GRANT CORBOY: Thank you. Warren, same question to you. You are going to bring the inventors' perspective, I hope.

WARREN TUTTLE: Sure. Let me first give a shoutout to Jim Patterson whom I call the Nelson Mandela of the PPBP. He is really the father of it. Without Jim, we wouldn't be here today. He was tasked with getting this thing off the ground. I don't think people realized how complicated and involved it was. He had to go to London to negotiate with Lloyds of London to get it insured. There's a lot to it. Jim and I have been friends for a long time. Hard to believe, he is so calm. But we are really good friends. We've worked on a lot of inventor products together. When Jim asked me to get involved, I jumped at the opportunity. The PPBP is symbolic of the outreach of greater inclusion in America to the innovation ecosystem. Quite frankly, we don't run on all cylinders in this country. I also serve on the Council for Innovation Inclusion. I remember the quote being that we're probably running about 25% efficiency in terms of innovation in this country that we've excluded women, minorities, and rural folks and the military. It's been something that has been of great interest to me for a long time. Sometimes as an older, getting older every day, white male, we take many things for granted here. But when we stop and look around for our kids and the next generation, what is it that we are doing to give back? That challenge and that perspective is what drew me into this. It's overwhelming in a lot of ways. The first part of the program since I have been involved with the board from the beginning, seven or eight years now, was to build a structure or platform that could handle this, be it hubs, be it attorneys, be it that. I have had nine businesses, so I love building things. It's wonderful. But you get to the point where you build all these structures and have pyramids and towers and these wonderful things. The fun part is coming now where we have this institution in great

cooperation with the USPTO and so forth. Now we need to run stuff through it. We have types. Let's run some water through it and get it going. That's why we are here today for the inventor side of it. I work with many thousands of inventors every year. There are many that you meet along the way that don't have the resources. Everyone will know that inventors have a hard time. There's a lot of challenges. There are big businesses that don't necessarily have their best interest at heart. They want to change the patent system to benefit them and their lofty place. They forget sometimes what this country is built on to begin with. There are a lot of people running businesses that take advantage of inventors that charge for services that inventors take and don't have a snowball's chance of hell to succeed in it. So we have all those inventors. When I talk to them, I find oftentimes I'll run into people at or near the poverty line and somehow they borrowed or begged from their family \$5,000 to take these ridiculous inventor company things and come up with nothing. We try to direct them to the actual resources that can help them. The patent system is a very important part of this. If they want to license their product, becomes collateral for their licensing deal and success. We try to send them there. We try to make sure they're helped in the hub system and all you're doing as practitioners out there is critical to this. I can go on for four more hours but that will be my opening statement. We'll go from there.

GRANT CORBOY: Thanks, Warren. Rodney, tell us about yourself and your role in the patent pro bono program.

RODNEY ROTHWELL: Sure. So my role has been for seven or eight years, basically being a volunteer practitioner. That role has taken on other more managerial roles. I have been vice chair of the patent and pro bono program at the Federal Circuit Bar Association. I have also been Chair of that program. And I manage a lot of the cases and a program at my current firm

where we intake those cases and manage them from intake all the way until closing. Throughout the number of years, probably been 20 or 30 cases that I have handled in various degrees. Whether it was just counsel to the filing of a patent application [Inaudible] from my standpoint, I see benefits of the program both ways. I see it not only on the inventor side, but I also see it for the volunteer side as well. For the inventors, they're getting free counsel. Not only for patents, but also oftentimes get free counsel in a lot of other areas around patents, licensing, contract work, freedom to operation. And then from, you know, from the attorneys' side, there are a number of benefits, but a lot of attorneys enjoy giving back to the community or being involved in their community. The practical experience that we get from representing the inventors themselves. A lot of the questions they ask you don't get on a day-to-day basis representing large companies. You don't get asked questions like, why did you write this, that? Things that are seen at a much higher level. Lots of practical experience that you get. Then lastly there's the benefit of just developing a network, additional resources. Obviously, there's hope on both sides that that patent is a tool that helps that inventor go on to do great things. Being part of that and hopefully someday being part of helping them take it to the next level and maybe having them as a client is part of the benefit of being a volunteer.

GRANT CORBOY: Thank you, Rodney. You don't get off that easy, Rodney. We're doing the snake method here so you get to go next. What do you say from a patent practitioner perspective as the major challenge that you face in your participation of the PPBP? And can you see the other challenges other practitioners maybe not similarly circumstanced as you would face in participating in this program?

RODNEY ROTHWELL: Right. Challenges. There's a lot of challenges. Let's talk about some of the key challenges that we face on a day-to-day basis. One is awareness of inventors. I would say, you know, even though it's easy to Google and find the PPBP through the U.S. Patent and Trademark Office, there are still inventors that don't know it exists. So making more of a media blitz and providing more information about the availability of this program would be helpful. It's not only on the U.S. Patent and Trademark Office. It's also on the practitioner side. A lot of times practitioners, especially when we are intaking a case, we're looking at it from multiple standpoints. One of the things we're evaluating is what kind of entity is this? A large entity? Small entity? A micro entity? Not with respect to fees but how we're going to actually strategize things. I think it's important for practitioners to ask, is there a chance that you could qualify for pro bono service? If so, maybe I'm not the right person to be representing you. Maybe you should go through that service. Obviously, it's a lot cheaper. I think that's on practitioners to kind of cover that as they're going through things with inventors or potential clients as an additional route for a patent rather than simply charging them for drafting the application as a response or what have you. That's a challenge from our perspective, the practitioner is just the resource. There are only a few patent attorneys in the country, let alone how many want to volunteer for these cases on a day-to-day basis. I see the list of inventors come out every day. It is getting harder to find volunteers that are willing to take these cases. So being able to increase the number of volunteers and match demand is something that needs to be taken into consideration going forward. From my standpoint, I take as many cases as I can but I can't take them all. I try to find associates or colleagues or other people that are willing to help and pitch

in. Sometimes it's a collaborative effort across not just firms but across firms and organizations, things like that.

GRANT CORBOY: Thank you. Okay. Warren, what do you see as the challenges that face the PPBP?

WARREN TUTTLE: Number one as Rodney said, awareness. Obviously within the general population of the United States very little awareness of the program. In the inventor's world there's still not a lot; I do communicate a lot with inventors by email and by forms and things like that. I try to talk to three or four times a week. Very few are aware of the program. So, I think that's number one. Also, there's a different level and standard of participation and execution at the hubs. I think that's normal and natural when you start. You have a great setup here. I know Minnesota has a great state setup. But there are some that are struggling. That is something we on the Pro Bono Advisory Council are trying to help there. It's interesting because you want to draw more awareness and participation but as Jim was saying before, you need the right number of lawyers, and do we have the infrastructure to handle that? Ideally, you would like all of America to hear about this and participate but it's still new. There are a number of things we're doing. We just had a terrific event at the University of Minnesota. We'll have those running every quarter at different cities around the country. I'd say that's the primary thing.

GRANT CORBOY: Deborah, how about you? What do you see are the challenges?

DEBORAH MIRON: Well, to speak on what has already been said, I would say in terms of getting the word out, our jurisdiction encompasses where we're sitting now, in Northern Virginia, as well as West Virginia. Getting the word to varied populations may be different and so we need to maybe figure out who is receiving, who's coming in and who's receiving that

information and how best to tailor the information and get it out there in certain ways. And then we do have a long list of volunteers, many people are busy. I think there are many retired patent lawyers who may have the time and expertise, as long as they keep up with legal developments and interests. And there are those who are very interested in the program but they don't have the malpractice insurance so that can be a problem. Then I would say that, in terms of the benefits for practitioners, there are so many there. I even hear when it doesn't work out, having a lawyer speak with someone and explain where they fell short. Maybe they can fix it in the future or look at something different. Or even having a lawyer explain the process is helpful. I think we have all those challenges and more. I'm very hopeful of that. It's the right thing to do. I think we're gonna figure it out because everybody's heart is in the right place.

GRANT CORBOY: Jim?

JIM PATTERSON: For the biggest challenge, I'd go right to where the rubber meets the road, as they say. That is at the 20 regional hubs. We have to have a little bit of background on that. If we have inventors with a need and attorneys that are willing to offer services, there has to be a matchmaker between that can give the right support to the attorneys, give the right recruitment effort to get the local attorneys, talk to the attorneys about the differences as Rodney pointed out between representing Exxon and someone who just came up with a great idea. It's a different approach. That comes down to the 20 regional areas. Those 20 regional hubs. Those hubs cover all 50 states. Each of those hubs is an independent nonprofit organization of one sort or another. Most 501(c)(3). And then you get to the question of, what are they doing and what do they need to do the work that they're doing? That I think is where a lot of the focus needs to be, right where it's happening. That comes down to funding. You need to have an

administrator. The administrator needs to have a staff. Hubs need to have an advertising budget. They need to have an outreach budget. The Patent Office has done well in terms of helping with that funding within the constraints that they have. But it is not enough. That's not a criticism of the PTO. It's a criticism of the constraints that you are living with. I know these are being done at the behest of Congress. If Congress wants to hear from someone beside the four of us and say, what do you need? It's not just raw dollars, here's money for you. But looking into the finances. How do you support that financial aspect? Yes, there is a place for government assistance in that. And the government assistance is not, here's money, see what you can do with it. It is "here's money to give you the resources to see what you can do with it." I think, and it has been my experience, that has resonated across the political spectrum of ideology. When you get down to it, it's a program that teaches people how to fish. It teaches them how to stand on their feet. It teaches them to live the American dream of having an idea and bringing it to market and doing it themselves with the support that's needed.

GRANT CORBOY: On the same lines, challenges, but if you could have any wish, what would be the area of improvement you would like to see for the PPBP? I'll start with you, Jim? What would you like to see improved in the PPBP?

JIM PATTERSON: A focus on the hubs. A focus on staffing the hubs. Certainly, the PTO has a real role with a central distribution of information and encouragement. It's within the regional hubs where it really takes place. One of the things we found over the years and particularly with going out and talking to donors about, this is why you should be interested in this program. It often comes down to, what's going on in my area. You can say all government is local. Pro bono is a very local endeavor. I am sort of answering the same question, but it does come down to

those 20 regional programs, where they're actually doing the matching. They're having a human interaction from the inventor and attorney and putting them together. They need to be supported. They need to be supported with funding to hire competent staff.

GRANT CORBOY: Deborah, what do you say as somebody who's running the Circuit Bar Patent Pro Bono Program is an area for improvement?

DEBORAH MIRON: I think I would agree that we could use more help. I know, having retired from a long career in the government, I hesitate to say that. Unless USPTO has more support, I know how hard that is. I know those constraints. Within those constraint, I'm very grateful for all the support and cheerleading we get. I do think USPTO is in a unique position to get involved if they have the time and resources themselves to get involved with all the regions on a deeper dive kind of way. Then to bring that altogether to improve the overall program. I do think having so much in isolation there are differences but there are all commonalties that we can learn from one another. I think USPTO is in a position to help share that if they had the time and resources to do it and could help us.

GRANT CORBOY: Warren, from the inventor's perspective?

WARREN TUTTLE: This an easy one for me. I come at this from a non-attorney standpoint. I'm probably the only non-attorney in this room. I'm proud of it, by the way.

JIM PATTERSON: And we're proud to be attorneys, too.

WARREN TUTTLE: Jim said, now you're bragging. It's, again, I say you build structures. When you get a patent or property, you're also building a structure. This is all great stuff. It requires a lot of great legal advice and background and it's all essential. But then comes the next step which is, now you have your diploma. I remember I graduated from high school and they called

it commencement. Why do they call it commencement? I have just arrived. Whatever you call it, it's just the beginning. Now it's time to monetize what you've done, commercialize. My definition is making fun. If you go out and spend money and don't make it, especially if you don't have the money, it can have an ill effect on your life and the quality of your family's life. I have been through it. I have lost an entire business once and put my family at risk. We need to start thinking what is the next step now that maybe we help get the IP. How do we give direction? How do you raise capital to get it going? How do you get the expertise and background to get started? If you want a license, where do you go? Something we have given a lot of thought and time with. We talk about this constantly. Lot of times government cannot provide these answers because, frankly, there's a whole bunch of reasons. Maybe they don't have the expertise. There's an issue, who do you help? Who do you not help? There's a lot of historical experience with government working with enterprises to facilitate this. But then they have to be the right facilitator. Do they really care? So these are things that I see as the future as we build the platform. How do we help folks take the next steps? How do we do these events? How do we provide education? I know once they leave an attorney's office with a patent filing, that ends one part of it perhaps. How do they take that next step of going out and becoming entrepreneurs or how do we get them to monetize that, feel good about it? That sends a powerful signal that the program is working. That's really in all of the companies that I have run programs for, nothing clicks until you have a winner. Then everybody in the company gets it suddenly. That's what we need here to take the next step.

GRANT CORBOY: Rodney, if you could do any improvement to the PPBP, I'll let you know at the last meeting they suggested pro bono hours be tax deductible. Go ahead, what do you see as an area to improve?

RODNEY ROTHWELL: Tax deduction would be something. That wasn't necessarily what I was looking at. To Jim's point, where we're bringing an attorney or volunteer together with an inventor, to be able to create that relationship, the attorneys need information. It's a fairly complicated process. Probably shouldn't be, but it is a complicated process to bring in a pro bono client and do a conflicts check. Get them engaged for whatever services they're looking for, and finding the volunteer, or get the work going and proceed with everything on time. Especially if you're up against a deadline. Getting the package from the hub with enough details so we don't have to sit down with the inventor first and kind of go through those details. Unfortunately, it will send them back to the program or tell them, you know, we love your technology, but we don't have anybody in that space. Knowing that stuff beforehand so that before we ever engage with the inventor, we can do all those checks. We can do the conflicts check. We can make sure we have somebody that can handle that technology, that we have the time for whatever the project is. Sometimes we get the project and we only get a title. We don't even know what service they're looking for. I think that is one area that we can constantly help improve, is collecting more information that can be handed out to the attorneys then ultimately a strategy and create [Inaudible]

GRANT CORBOY: You and I spoke before about the inventor who was with you. They tend to be protective about their inventions. So the regional offices are in a tough spot. They're trying to

get information but they don't want too much information because they will get to you where there's a relationship. That's a tough problem, isn't it?

RODNEY ROTHWELL: It is a hard line to walk. Getting them to give you the information and getting enough information to the attorneys so they don't have to sit down with the inventor themselves beforehand and give them the bad news that for whatever reason they won't be able to represent them.

JIM PATTERSON: I'm going to jump in here. Something specific to that, we're working with the Minnesota hub on something, mission platform that companies use that have all the information. That's something we would donate. We, at some point, we're not quite ready. When you get everything, it would be in a standardized platform and you could communicate and get your answers directly. That could be a big help.

GRANT CORBOY: I'm going to mix it up and start with you, Deborah. This is the final question. What could the USPTO do better to support you? Our organization, attorneys, inventors, whatever? Just what could USPTO do better?

DEBORAH MIRON: I think we need us all together. These kinds of sessions are very helpful, as you can see, even just talking among ourselves. So I think the opportunity to share experiences and learn from one another and to share ideas is, if you have the time and resources, which I know is problematic. I think whatever you can do to bring this together or share best practices or what you've seen work, suggestions, sure, more resources for us. That would be great. They have to be targeted resources. Not for us. We don't ask for money from USPTO. That's not what we're looking for. But it does come down to helping us identify what we can do to make this more, as good as it is, we want it to be more. We're very proud of it. We want it to be more alive

and effective. So if you can help us expand that reach by further support, sharing what you've learned from how well it's working in other places, or not, that would be great.

GRANT CORBOY: Thank you. Warren, what would you like to see of the USPTO?

WARREN TUTTLE: Course, we love you guys dearly. We really do sincerely. I think this Pathways Event we did in Minnesota, and those who aren't familiar with it, a hands-on event at the University of Minnesota where your team came out from the Patent Office and we had other folks that spent a day providing information to folks. It was more local. It's all local community. And we are talking about continuing those events here in Washington, D.C.; Oakland, California; Atlanta, Georgia and Chicago, Illinois. I think they're important to keep those up. You can go out locally. You can form outreach around the hubs so that it becomes there. You get the word out through inventor's clubs and communities, you can get maybe local businesses involved. Lot of effort and time traveling. Hands-on outreach is important. So we appreciate the terrific support we got from the USPTO to help fund that and put it together. We as volunteers pay our own way. That's nothing compared to what it costs to put on one of these events. Please, please keep doing that. Do one in Atlanta in February. We've been talking about that. It's a community that has, it's perfect with all types of things that can come together. You'll see numbers and metrics go up. I'll put in a big pitch for that.

GRANT CORBOY: We know from our Deputy Director, his remarks. It's really important to meet people where they are. That's been her major focus. Rodney, what would you like to see of the USPTO?

RODNEY ROTHWELL: Two things pop to mind. One I think it's important for the PTO to tell the story. The good stories. The ones where it worked out and there was a success. Lot of people

look to Youtube and social media for DIY or what have you. If you can see that story and see how that person went from x to the end and kind of mirror that, even though it doesn't work in every scenario. To be able to see the program is working for some people and how they go about doing it, I think it's important to tell that story. And then the second one would be I think it would help out if we could add to the ADS basically a pro bono selection. Designate that application as a pro bono application. We could do small and maybe micro entities. Not necessarily for reduced fees any further than pro bono, but that would be nice. But for data tracking purposes. To be able to give maybe additional credit to examiners to give them an extended amount of time to review these applications so they aren't having time crunch to go to and RC and create more work for the applicant or inventors or what have you. It also allows you to see how many times they are issuing. We need a lot better data tracking.

GRANT CORBOY: Thank you. Just to let you know, this is my fault for not informing you. There is a pro bono cert form. You can go to the FORMS web page. It's a voluntary certification. Some inventors have said that they're concerned with including that in the application. If you've got a conversation with your client and they're willing to put that into the application, that does give us some tracking. It's on the miscellaneous forms. You can upload it. That would help us. Good.

Thank you. Jim?

JIM PATTERSON: Thanks, Grant. Your question is a good one but it presupposes that there's a fault that is glaring and that we can identify. I think there is an area that needs to be transitioned to. And I think the Patent Office is. But if we look back on what we have done so far, the Patent Office and then the folks on this panel and the organizations that we represent, we created something from nothing. And that has been a great effort. But we are now in a transition, as

Warren said. We have the structures. They are in place. We have the experiences we can look back on and say, what's better? Realizing that now is the time to transition from a startup company, startup phase to a sustaining phase. The Pathways is a vehicle that incorporates that as part of it. But I think as a mindset for the Patent Office and for those of us involved, it's realizing this is a new phase. It's time to recalibrate. Not to look at what's wrong, but look at what can we do now to go forward faster?

GRANT CORBOY: Great. That's all I have. Before I open the floor up to questions, I did see in the audience that we have Jonathan Knight. Jonathan, could you come to the microphone up here? Jonathan is counsel for WilmerHale in Washington, D.C. Jonathan started as a patent prosecution expert but now focuses more on inter partes review and ex parte appeals before the Appeals Board. I would like for him to discuss support of the PTAB Bar Association's Patent Pro Bono Program and issues concerning what he sees as practitioner support for the PTAB Pro Bono Program and any other information he would like to share. So the floor is yours. [No audio]

>> Hold on for one second.

JONATHAN KNIGHT: In addition to the PPBP, there's also a program when an inventor is at the stage where they have a final rejection and patent prosecution is closing and they need, they're basically at the stage where they are faced with appeal or taking some other action to reopen prosecution. The PTAB Bar Association has a pro bono program that acts as a clearinghouse to match practitioners, hopefully some of you, with financially under resourced inventors and small companies that are owned by inventors. After going through this matching process with the inventor, the goal is for you to provide assistance until either the prosecution gets reopened or

the appeal occurs and it's then decided. Not every engagement would necessarily result in a full-blown appeal process. Pro se applicants frequently get stuck on rejections that are quite manageable if you have professional assistance. So the outcome might be, you know, an examiner to clear up issues or might be an amendment. If it does come to appeal, the scope of the representation could include the full appeal process. Conferences, drafting appeal, drafting applies, all the way through to oral argument. But sort of the scope of the representation is limited similar to the PPBP. It's limited to the matter that's been assigned. There's no expectation that the volunteer patent agent or attorney is going to provide assistance on any other matter. If you're interested in volunteering, there are just a few requirements. You should have a registration number. You can either be a patent agent or attorney registered to practice before the USPTO. You should have malpractice insurance and you should be in a position to generate the representation letter so the engagement will be between you the practitioner and the client. To apply, if you actually just Google the PTAB pro bono program, the first hit you get should be the USPTO with a page for the program. There's a link where you can click on the application. If you don't want to do that, you can look me up or look up somebody at the PTAB Bar Association, and we'll be happy to get you set up. One of the areas we're focused on this year is increasing engagement. It's a relatively new program. We spent the first year trying to get the word out. We work a lot with the USPTO website and advertise also through the PTAB Bar Association. We also reach out to the regional directors and also pro bono administrators. You also, if you're interested, you can help by getting the word out. If you would love to help with a webinar or short advice clinic. So if you have those kinds of ideas for engagement, feel free to

reach out to me or the PTAB. Love to hear from you and work with us. Thank you. Look forward to hearing your thoughts and comments and really appreciate the opportunity.

GRANT CORBOY: Thank you. Okay. Now we're going to open it up to questions. There's two ways you can provide us questions. The first is via raising your hand. The other is by putting your question in the question and answer box. If you have any questions at this time, I do see one person with their hand up. What I'm going to do, Mary Gaffney, I'm going to allow you to unmute and ask your question.

MARY GAFFNEY: I was looking to be able to find how to get on pro bono assistance for the trademark process, not the patents process. Is that the same department? I didn't think so.

GRANT CORBOY: This is the patent pro bono program.

MARY GAFFNEY: Right. Right.

GRANT CORBOY: Early on when Kim gave her presentation, did you capture that QR code by chance?

MARY GAFFNEY: I believe I did.

GRANT CORBOY: Awesome. If you go to that QR code on the site on the left-hand side, you're going to see pro se assistance and law clinic certification program on the left. If you click on that, there are 60 plus law schools in the United States that the USPTO has certified to provide, among other things, trademark assistance.

MARY GAFFNEY: That's terrific.

GRANT CORBOY: The option for you would be to go to one of those schools that either covers your area, or in the other box there's "all United States." Under the "all United States," you can also send an email to those to see if they can help you. The other thing I will say, we do work

very closely with INTA. They have what I'll call sort of a public sector patent trademark pro bono program. So, if you go into our website under free legal resources, you can also look up INTA there. It provides the link to that program as well.

GRANT CORBOY: Terrific. Thank you so much. Any other questions, please raise your hand.

Edward Howard, I'm going to allow you to talk. Edward, please talk.

EDWARD HOWARD: Hi. Can you hear me?

GRANT CORBOY: Yes, we can hear you.

EDWARD HOWARD: Terrific. Thanks, Grant, for getting this together. The lineup has been terrific. Been a great learning experience. Just by way of background, I am outside Philadelphia. I'm part of the Pennsylvania Bar Association. I'm chair of the patent section and chair of the pro bono committee of the section. Working with John at the Penn State clinic. So from a patent perspective, what we are trying to do is profitize our members, get them engaged and work with the clinic. As somewhat of a newbie in this area, my question or questions would focus on issues with malpractice from a small firm perspective as well as a larger firm issue concerning malpractice. That's number one. Number two have we had success getting CLE credit for the patent attorneys who are supporting inventors? Number three, the scope of representation as we go through the patent prosecution process. Have we really focused on representation up to allowance or abandonment and what issues have you seen? I'll stop there. I have many more questions, but we'll stop there.

GRANT CORBOY: Thank you. I didn't bring a pen so I appreciate you stopping at three. Let's open that up to the panel. Jim?

JIM PATTERSON: We had experience in all three of those. I'd be happy to talk but raise your hand, interrupt please, other panelists. Malpractice is an interesting issue when it comes to pro bono. It always comes up. I think it comes up as an excuse not to get involved. I am not aware of any instances, not that they would immediately be brought to me to know, but I think either I would know or OED would know. Which isn't to say, don't worry about it. You have to worry about it. One of the reasons you have to worry about it, independent inventors and people with no means are the most demanding clients. They often have unrealistic expectations. But having said that, most attorneys volunteering are from private law firms and their insurance covers them regardless. That's after extensive discussions with Lloyds and with other carriers. Secondly, the hubs will have their own insurance. That's negotiated between the hubs and the carrier that services them. It's something you absolutely want to be aware of, but please don't use it as an excuse. We are attorneys. We are taught how to manage issues and problems. This is absolutely a solvable problem. It cannot and should not be an excuse for getting involved. It is solvable. In terms of credit, that's up to each individual state bar or the state organization that grants it. Yes, states do give credit. Some do for representation. And in terms of whether that applies in Pennsylvania, I don't know. It certainly is something that can be looked at. If it's not, there's models to be followed. I know Minnesota because I'm from Minnesota. Minnesota presents a model there. Not the only solution to it, however. In terms of scope of representation, one of the things I learned from my mother, who was very big on volunteer services. Spent a lot of time with the Red Cross. That's where she donated a lot of her time. You should never tell somebody they can't do something good for somebody else. Okay? And I don't I don't know of a situation where a program, one of the hubs or patent office would say, you can do this but you can't do

that. It is, this is what comes within the scope of us. But you're a lawyer. If you're recognized under your state bar, if you're entitled to give those services, there's nothing that says you have to get paid for it. There should be no bar other than being realistic about how you offer free services and who you offer them to. Meaning, make sure there's a need. Make sure you have time.

DEBORAH MIRON: I would say this. I mentioned retired attorneys because I have spoken to them as a group. We have many who are members. It is a problem. They are no longer associated with the firm that covered their malpractice. Also some of our corporate attorneys have other restrictions on providing pro bono services. I wouldn't say there I would say sometimes people do want to take something and have some strings on that. Not saying there's no work around. It's not our regional hub that's providing the malpractice insurance.

JIM PATTERSON: Deborah, you reminded me of an important point I wanted to make. We have worked in our program with corporations that are self-insured, right? That presents the problem. Corporations are self-insured. What we have done is paired those volunteers with someone in a private law firm, which is not a huge drain on the attorney. It's a matter of reviewing, talking with that sort of thing. That has been effective. That's something we worked out with Kevin Rhodes at 3M. That has been effective in giving them an opportunity.

GRANT CORBOY: I'd also like to mention, too, more than 50%, so more than ten of our regional patent pro bono programs do offer malpractice insurance. Part of the issue is that Pennsylvania was just stood up in January of 2023. It's a new program. I'm hoping as it gets more mature, those extra capabilities are brought online. But the other nice thing about the USPTO, federal jurisdiction. You could also volunteer to other programs if that's a prohibition for you specifically

to participate in the program. You can go to one of those programs that does offer it and volunteer through it that way as well.

EDWARD HOWARD: I think that's all good information. Part of my question really to be mindful of what, number one, what good ideas, what items have worked in the past and then listen. We went there. It didn't really work. Let's move on. I'm a big proponent of what gets measured gets done. You have measurements out there. You have things that maybe we don't know yet. You have things there. Part of what I am focused on with the PBA and John in the PSU clinic is to kind of mine some of the areas that you guys have already gone through. Get that information and then apply it to our situation. Go forward from there. So thank you again. Appreciate your input.

GRANT CORBOY: Thank you for yours. I don't see any hands right now. Are there any questions from the q&a?

ELIZABETH DORSEY: We've had several questions about malpractice insurance, which I think has been discussed. Another question that we've had is whether the patent pro bono program has considered the impact to attorneys who are dealing with small clients and whether offering pro bono could be to the detriment of some of those solo practitioners working with small clients.

GRANT CORBOY: To the panel?

JIM PATTERSON: That most definitely has been a consideration right from the very start. The qualifications to the monetary qualification, if you will, was set at 300% of the poverty rate with the idea that that would include enough folks for the program. Course, it was 1,000%, you'd have lots of people that would qualify. But 300% would capture a population that was real and

manageable but would also, in most cases, if not all case, not intrude on the private bar. If someone was at that 300% of the poverty level or below, could they afford the services really? You do get into the issue of solo practitioners or folks that are willing to charge far less than the market rate. Actually that is an active discussion. Should it be 400%, 500%, 600%? Those are the issues that are grappled with, impinging on the private bar is not protecting certain individuals from the bar. That is not the point but certainly comes to mind. But it is being very aware of what services are being provided by the private bar and why would we get in the way of those things being offered as they are on a fee for service basis. Long way of getting to the point of, yes, very much a consideration. 300% has not run into many objections. Whether it should be raised is an active consideration, which it is right now.

DEBORAH MIRON: I would just add that as I mentioned, we have other subject area of pro bono. This comes up I feel with other specialties and we have the same problem. When you're offering pro bono service, you risk taking away business from them, that is their livelihood. But we try to make the eligibility requirements from the applicant be such that they are unlikely to have been able to go to those small firms for their business.

GRANT CORBOY: I'll say from the last meeting, one of the great suggestions or points that was brought up is that the federal poverty line is a federal number. Right? What's going on in Alabama might not be the same as what's going on in California. And so giving the autonomy of these regional patent pro bono programs, they have the ability to flex their requirements to get out of their community. Several have done that. State Bar of Michigan puts it at 200% of federal poverty guidelines because that's what suits their community. Volunteers in Birmingham, who does Mississippi and Alabama, similarly reduced their number to 200%. Those considerations

when you have this map of flexible programs, they can look at the needs of the community and adapt their financial requirements based on what's consistent with what their community would tolerate. I hope that answers your question. We do have a couple more hands. Donna Brown Hartnett, I'm going to allow you to talk.

DONNA HARTNETT: Thank you so much. There is outstanding content in this program, delighted to be able to even be a listener. I'm a Virginia-barred attorney who happens to live in California, who has also lived in several other states across the country. I also happen to be a former government employee who has retired due to a disability. And I am teaching at the local junior college level. I teach entrepreneurship and business law, hence is my question. I happen to be African-American, if anybody cares, and a female. I'm kind of curious about reaching underserved populations and maybe exploring the opportunity to do so through education and watching Invention Con with USPTO. There was one young lady who said she was so articulate. I just don't understand how come there's no relationship between Department of Education and the USPTO. I know that is kind of far reaching. But it's something to be considered, wondering if that has been considered. And then secondarily, is there a standard of measurement for, by zip code, which areas are we reaching? And by age.

>> Okay. [Inaudible]

>> Yeah. So first of all, on the junior college front, awesome. Thanks for your efforts there. There's such great potential around America, take advantage of our junior college, to teach. Outside of the USPTO but with several high ranking USPTO people involved. United States Intellectual Property Alliance. That's a national organization that exists to promote intellectual property in America and has about 100 board members. The subject of education is prime.

There are specific people at the U.S. Patent and Trademark Office that are dedicated very much to the educational pursuit. So there's a lot of things coming out of there to reach out to junior colleges. It is not an old organization. They're getting off the ground. When we meet next, I'm going to pass that this came through the pro bono program. It's a bigger issue than pro bono. It's something that's vital. I think that's something, I would say that is something we can look to for help in that area. Great question.

GRANT CORBOY: Donna, thank you for raising your hand. I will say if you have any more ideas, please go to the federal notice location. That's one question they are always concerned about. How do we reach the typically under-served communities? We're excited to hear ideas from the public on how better to do that. I see a bunch of questions that are coming in from the q&a. Liz, are there any coming in before I go to the next one?

ELIZABETH DORSEY: One participant would like to know a little bit more about getting CLE credit for pro bono work.

GRANT CORBOY: Okay. I can take a stab at that. Some of our programs have reached out to the local state bars. The State Bar of Wisconsin has reached out to Chicago and authorized service through that program to account for CLE credit. For every five hours you get one hour of CLE credit. Don't quote me on this. Also Colorado, our MiCasa program, is reaching out to their state bars. They're reaching out to Utah to see if they can certify the Colorado program, service through that program to get CLE credit. It's an ongoing process. I will also say, because we're in the Office of Enrollment and Discipline, the Director, Will Covey, is a big proponent of us going to the local areas and providing ethics talks. If we coordinate it with the bar and the bar certifies that talk for credit, you can get CLE for attending those meetings as well. We are working it from

the program's perspective as well as from the USPTO perspective. Anything else? Okay. Let's go to, I see a hand, Rudolph Notrod.

RUDOPHL NOTROD: Yes, hello.

GRANT CORBOY: Hi, Rudolph.

RUDOLPH NOTROD: Under the pro bono program, is a client inventor participating or even expected to participate in any of the proceedings, like the oral hearing? Or anything before, other than just handing over the case to the pro bono attorney and that's it?

GRANT CORBOY: For an oral hearing, are you talking before the Patent Trial and Appeal Board?

RUDOLPH NOTROD: Yeah.

GRANT CORBOY: Okay. Does anybody here have experience with that?

JANET GONGOLA: Hello. This is Janet Gongola from the Patent Trial and Appeal Board. I will try to answer your question. If you are pro se but you joined the PTAB Pro Bono Program and you are at the stage of an oral hearing, the inventor is permitted to attend the oral hearing. It is up to you as to whether you want to have time to make any argument or you defer all of the argument time to your attorney. Either way is permissible and we have had both occur. Sometimes it may be more useful to allow the attorney to make the argument for you. Simply because they have had prior experience making arguments and they are accustomed to the logistics and format. They may always defer to you at any point if there's a question that the panel may ask you that would require the inventors' input. Does that help?

RUDOLPH NOTROD: Yes, very good. Thank you.

JANET GONGOLA: Great. Thank you. Thank you.

GRANT CORBOY: Okay. There are no hands. Anymore, Liz, from the question and answer box?

ELIZABETH DORSEY: There was a question about whether there is a compilation of the states that are giving CLE credit, such as a spreadsheet?

GRANT CORBOY: No, we don't. So what we do encourage you to do is contact the regional program that covers your area and see if they do have that capability. That's a great suggestion.

DEBORAH MIRON: I would say it would be helpful to have a compilation. Because we're a national bar association and so our lawyers are barred in states across the country. If there are any states offering CLE for their hours working for us, that would be good to know.

GRANT CORBOY: Anything else, Liz?

ELIZABETH DORSEY: Not at this time.

GRANT CORBOY: Okay. Great. I think that that's going to conclude our event for today. First of all, I'd like to thank the panelists. A lot of the panelists traveled a great distance and spent a great deal of time getting here at their own dime. So thank you very much for coming here. Also to the speakers for sharing information about the patent pro bono program, PTAB program. With that, I'll turn it over to Jim Silbermann to close us out.

JIM SILBERMANN: I'm not sure what I have to say more than what Grant said but thanking the speakers. I do appreciate everybody's time today and helping us with this listening session. Want to shoutout to the people in my group who helped me run the USPTO patent pro bono program. I want to thank Janet for coming out from PTAB. Patent pro bono program. In providing these resources. And for those listening online or reading the transcript, I'll just reiterate that, one, we do appreciate the feedback. The reason we're having these listening sessions is so we can complete the congressionally mandated study. These are good points for us to hear back from and provide to Congress and see where they go. I know there was a lot of

questions about CLE. There were questions about malpractice insurance and things like that, that we have obviously done within our program. Then ways that we can maybe improve that as well, as far as working with the regional programs. I know we have a quarterly administrators conference where we get the program directors for this. This is feedback that we want. These are things we are trying to improve in the program as a whole. Then obviously, at some point the big ask, which I will deflect to Mr. Patterson as his commentary. That's something that, as I understand from my high school civics class, is that power of the purse does sit with Congress. That may be something they'd want to hear about. In closing, I want to thank everybody for coming. I also want to thank everybody who is online listening, for providing your commentary today through the unmuted allow to talk feature, which I found to be personally very intriguing. Also remind I don't know where the web link is. There is that ability to respond to the federal notice. If you weren't able to get your commentary in or weren't able to formulate it, we'd love to hear back from you. July 11th I think is the deadline for doing that. I would ask everybody who has some input or any input if you didn't want to do this to please respond to the Federal Register notice. For those concerned about having your name read out, it's my understanding that such submissions can be done anonymously. Although, while it is submitted, it is also tracked. I'm not saying go create a Gmail account on your own. What we want is information back on how we can improve this program. Mostly what can be done so that those individuals in areas who are underserved. The efficiency I think that Warren referred to. The amount of efficiency of innovation. We can capture that for the economy as a whole to make our economy grow. There are ideas out there, basically. Sounds like an "X Files" thing. The ideas are out there. We just need to find them. That's where I think some of this feedback's helpful. Thank the

panelists. Thanks to Grant for moderating. Thanks to everybody else. With that we will officially close our second listening session.