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

Not only was the passage of the Leahy-Smith America Invents Act (AIA) in September 2011 a game changer for patent practice in the United States, it heralded the beginning of a new era in patent pro bono services. Section 32 of the AIA directs the U.S. Patent and Trademark Office (USPTO) to “work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses.” The revolutionary patent pro bono programs that have developed in the wake of the AIA are helping to level the playing field for all financially under-resourced entrepreneurs by providing eligible inventors and small businesses throughout the nation equal access to the patent system.

Brief History of the Patent Pro Bono Program

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

As focus on the patent system, particularly patent reform, has continued, the ever-present need to incentivize and protect new inventions has not been lost. To further encourage innovation and improve the patent system, President Barack Obama issued various executive actions in early 2014. One such action called upon members of the patent bar to provide individual inventors and small businesses legal assistance in navigating the patent system so that the mandate of the AIA pro bono program could be expanded to cover every state in the country.

To accomplish the congressional mandate set forth in the AIA and respond to the President’s call to action, the USPTO formed a patent pro bono team headed by McDowell. With an initial goal of expanding coverage to every state by mid-2014, the USPTO now anticipates that patent pro bono services will be available in all 50 states by the end of 2015. With coverage already expanded to 45 states and the District of Columbia, the USPTO is well on its way to meeting its goal.

How the Patent Pro Bono Program Works

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

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

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Representative Types of Patent Pro Bono Programs

The first patent pro bono program was sponsored by LegalCORPS in Minnesota in 2011. According to McDowell, volunteer participation in patent pro bono programs vary widely, with some of the more established programs having more than 100 volunteer attorneys. One largely untapped resource for these programs is in-house corporate counsel registered to practice before the USPTO. Through a patent pro bono program, corporate attorneys registered to practice before the USPTO now have a way to perform pro bono work within their field. For corporate attorneys registered to practice before the USPTO but in a position that does not call upon those skills on a daily basis, the patent pro bono program gives them a vehicle through which they can develop experience in an area they may wish to remain engaged.

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

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Conclusion

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

Endnotes

3Id.
4Id.
10For a few states, the national clearinghouse also serves the role

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


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

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

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


22Id.

23Id.

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

25Id.