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PUSHING AHEAD WITH THE PRO BONO ASSISTANCE PROGRAM

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ABSTRACT

Lawyers often contribute their time and energy helping the under-resourced through pro bono work, whether because it's required of them or because of a personal desire to assist those less fortunate. But until 2011, few, if any programs were available for IP Professionals to volunteer their time for patent legal services, leaving them to contribute to areas of law outside their expertise. A group of IP law experts from LegalCORPS and a pro bono program created by the America Invents Act (AIA) has changed that. In this brief Article, John Calvert, author of the AIA provision that created the USPTO Pro Bono Assistance Program, discusses the creation of this new program, its successes, and goals for the immediate future. He also explains how IP Professionals can get involved with this exciting new opportunity to help those under-resourced.

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PUSHING AHEAD WITH THE PRO BONO ASSISTANCE PROGRAM

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The United States Patent and Trademark Office (USPTO) has been reaching out to independent inventors and small businesses for a number of years. One of the comments we hear most from this group is that it is too expensive to get a patent—not necessarily the fees associated with filing, but the cost of hiring a skilled attorney who can prosecute the application successfully and obtain solid legal protection for the innovation. That is where the USPTO has made many past efforts to connect intellectual property law volunteers with under-resourced inventors. Each time the effort failed due to a number of reasons. But in 2011, as the America Invents Act (AIA) began making headway through Congress, a group of attorneys in Minneapolis, Minnesota, stepped up to the plate. They hit a home run.

The group, made up of IP law experts from LegalCORPS, analyzed why previous attempts to establish a pro bono patent legal service had failed. What they found was the need for an intake, screening, and referral service (IS&R) that could buffer volunteer attorneys from patent applicants. The simple mechanics of an IS&R reduced potential liability and conflict issues. These two concerns, it turns out, were the main reasons that prior efforts had failed to take shape.

Establishing a pilot pro bono program was not easy. This first program in Minnesota took over a year to construct. The LegalCORPS team started by working out the program framework and compiling a list of best practices. Even after the pilot opened its doors for clients it would be four months until the first client was identified, vetted, and matched with a volunteer patent attorney. The careful

* © John Calvert 2013. John Calvert is currently the Senior Advisor of the Office of Innovation Development at the USPTO. As Senior Advisor, his duties include assisting and advising the Associate Commissioner for Innovation Development on ways to increase the USPTO's exposure in the independent inventor, small business and entrepreneurial communities. Mr. Calvert helped author the America Invents Act including the pro bono initiatives and the independent inventor/small business Ombudsman program.

Prior to being named Senior Advisor, Mr. Calvert was Administrator for the Inventor Assistance Program at the USPTO. While in that post his duties included inventor outreach, small business outreach, and university outreach initiatives. While Administrator, Mr. Calvert expanded the Inventor Assistance Program to include educational initiatives for students, inventors, and small businesses and created inventor assistance through pro bono and pro se initiatives.

Mr. Calvert graduated from North Carolina State University with a Bachelor of Science Degree in Textile Technology in May 1971. He worked for 13 years in the textile industry prior to returning to N.C. State University to pursue a Master of Science Degree in Textile Management. In 1990, Mr. Calvert joined the U.S. Patent and Trademark Office as an examiner specializing in textile technology. John became a Primary Examiner in 1995 and a Supervisory Patent Examiner in 1998. He was responsible for supervising as many as 25 examiners in the areas of textile technology and absorbent products. He also served as Acting Director for the Office of Independent Inventor Programs.

Mr. Calvert received the Department of Commerce Bronze Medal for superior Federal service and the United States Patent and Trademark Office Exceptional Career Award. Mr. Calvert completed studies in the Syracuse University, Maxwell School certificates program of Advanced Public Management and completed the Executive Development Seminar sponsored by the Office of Personnel Management.

planning and team effort paid off, and the first patent was issued in March 2012, just six months after operations began. The success, enthusiasm, community support and potential generated by this first pro bono program in Minnesota breathed new life into the idea of founding a nationwide program that could serve all financially under-resourced independent inventors and small businesses across America. Where others had failed, LegalCORPS of Minnesota succeeded in laying down the foundation for effective IS&R and getting the ball rolling.

This brings us to the America Invents Act. During the AIA's congressional debate, Congresswomen Judy Chu (D-Calif.) offered an amendment to Section 32 that directed the 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."

With an amended section 32, the AIA was signed into law on September 16, 2011, jumpstarting the process for a nationwide pro bono program. In fact, even before the official launch of the Minnesota pilot program, efforts had already started to identify a team and build a program in Colorado. In early 2012, groups in both northern and southern California were contacted, followed shortly after by the Federal Circuit Bar Association in the D.C. Metropolitan area and more than another dozen potential programs. There are currently four operational programs in Minnesota, Colorado, California, and the D.C. metro area that are accepting clients and volunteers to offer services.

Initially, a five-year goal had been set to open seventy programs across the country which would be city-specific, but this goal was adjusted to a regional approach due to potential conflict issues (in cities, for example, that only focus on specific types of technology with multiple competitors) and cities where legal representation is sparse. The new goal is to have the entire country covered by AIA pro bono programs by the end of June 2014. This is a realistic goal. In fact, there may be as many as sixteen programs operational by the end of 2013, and there have already been requests for information from areas not currently on the proposed program list. The USPTO is looking for interested attorneys, both private and corporate, to volunteer and assist in the groundwork to help those inventors needing assistance.

As we progressed through the process of forming multiple programs, there were a number of issues that came forward. Each of these issues was brought before a task force constituted of members from national IP organizations and other legal groups. The task force worked to solve these issues and assist the programs in fashioning a consistent message for clients. A national clearinghouse was also formed to serve as a single point-of-entry into the regional pro bono programs. The task force determined that each inventor or small business should have some "skin in the game" to make sure the process of getting a patent was not just a vanity issue. Inventors are asked to pay their own fees to the USPTO. They are also required to have some knowledge of the patent system. We felt that the more opportunities to opt out before seeing an attorney increased the odds of having a good invention enter a regional program.

Now, what does this mean for you as an IP law professional? There is a need for pro bono opportunities in the field of intellectual property. Many attorneys I talk with have a desire to volunteer their legal services, whether it is because their firms require it or because they are driven by a personal sense of duty and commitment to a cause, yet many end up doing pro bono work in areas outside their expertise. The

AIA pro bono program creates ideal pro bono opportunities for IP attorneys. We offer you the opportunity to join an existing program, one that has been tested for success and is in need of skilled and committed attorneys looking to boost America's innovation and small business economy.

Please contact me directly at John.Calvert@USPTO.gov to see where programs are planned and if there is one near you. Or, let me know if you are interested in creating a program where one is not currently planned. There will be plenty of assistance available to help you get started.