

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Boardside Chat: Pro Bono Programs at the USPTO

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June 9, 2022

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Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

Agenda

- Director's remarks
- Patent Pro Bono Program
 - Law School Clinic Certification Program
- Patent Trial and Appeal Board (PTAB)
Pro Bono Program
- Trademark Trial and Appeal Board (TTAB)
Pro Bono Recognition Program

Kathi Vidal

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Director's remarks

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Grant Corboy

Attorney - Patent Pro Bono Program Administrator
Office of Enrollment and Discipline

Patent Pro Bono Program

Patent Pro Bono Program

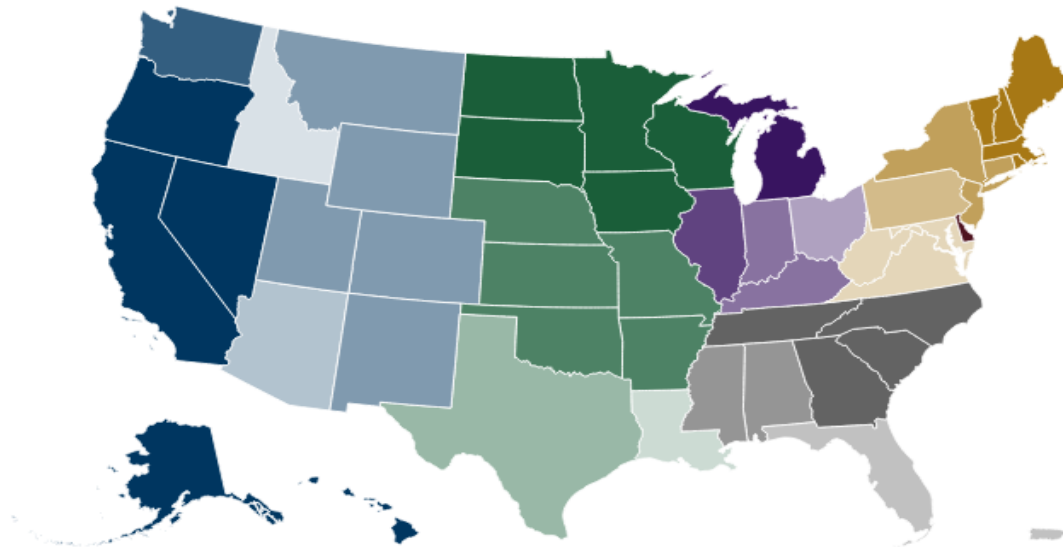
- Independent inventors and small businesses who are financially under-resourced are matched with volunteer practitioners to prepare, file, and prosecute patent applications
 - Section 32 of AIA – The USPTO Director shall work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses
 - The USPTO 2019 – 2022 Strategic Plan calls for the USPTO to enhance “the assistance we provide to independent inventors and small businesses”



Regional patent pro bono programs

- 21 regional programs across the country provide matching services
- Each regional program covers one or more states
- Regional programs are independent of the USPTO and operated by
 - Nonprofit organizations that focus on intellectual property
 - Universities
 - Bar associations
- Regional programs follow general guidelines, but set their own policies and procedures

Current nationwide coverage



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



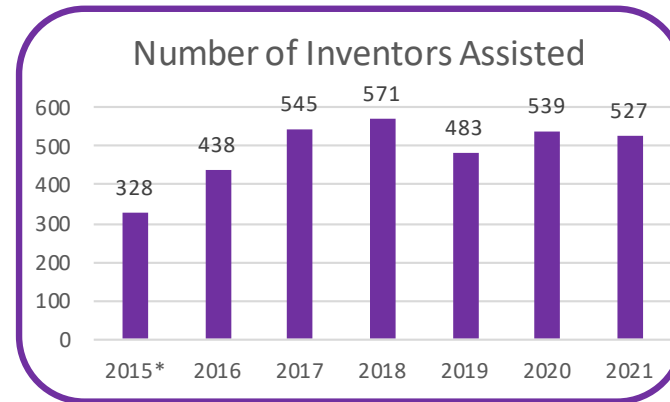
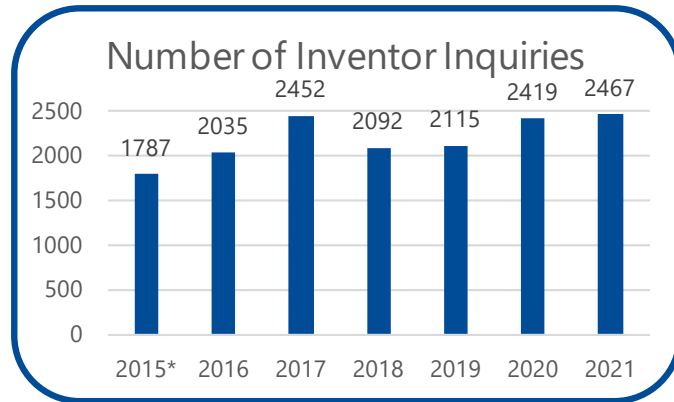
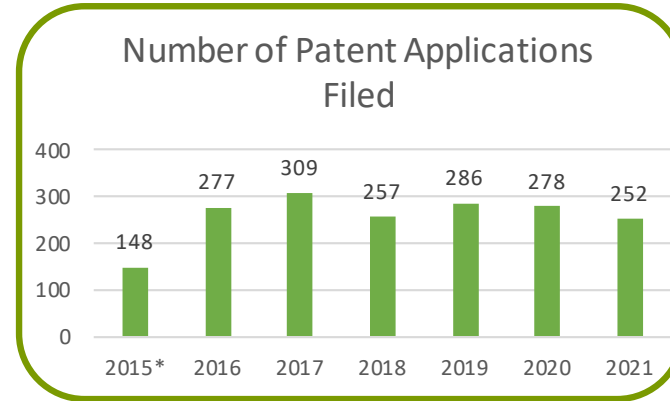
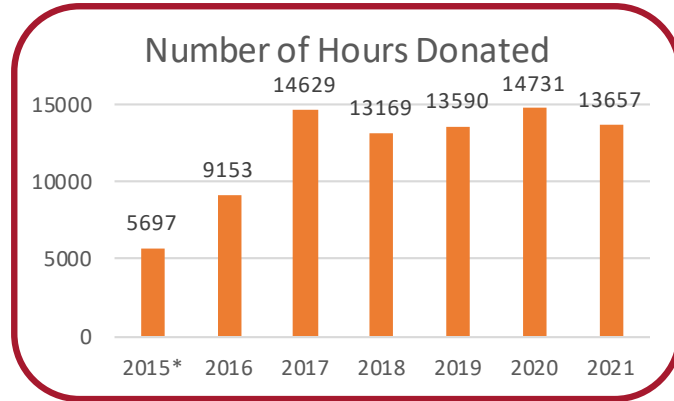
Inventor eligibility

- Regional programs ensure that applicants qualify for patent pro bono assistance by screening for:
 - Income (less than 300% of the poverty guidelines)
 - Regional programs are independent of the USPTO and may vary the guidelines
 - Have a provisional application on file and/or have completed a certificate training course
 - www.uspto.gov/video/cbt/certpck/index.htm
(also available in Spanish)
 - Have an actual invention (more than an idea)
 - Describe with particularity how to make, use, or practice your invention

Patent practitioner volunteers

- More than 1,600 practitioners have volunteered
 - Need outpaces supply
 - Unlike other forms of pro bono representation, only registered patent practitioners can represent financially under-resourced inventors to prepare, file, and prosecute patent applications before the USPTO

Statistics on program use



* Data collection began in Q2 of CY 2015

Benefits of program

- For inventors
 - A pro se inventor is now represented by counsel
 - The inventor is educated about the patent system
 - Professional advice may help the inventor make better decisions
 - Improved patent quality
- For practitioner
 - Patent practitioners can volunteer in their area of expertise
 - State bars increasingly are offering continuing legal education credit for pro bono service
 - Creates a path for inventors to become job creator
 - Inventors may become paying clients



Practitioner recognition

- The USPTO issues certificates to registered patent practitioners who provide 50+ hours of patent pro bono service in a year
- Patent practitioner name, firm, and regional program are posted on the USPTO website
- Signed by the Commissioner for Patents and the Director for the Office of Enrollment and Discipline
- The USPTO has issued over 450 certificates to patent practitioners since 2017
- The USPTO expanded recognition to include consecutive recipients
- Certificate recipients receive signature graphic



Law firm/corporation recognition

- The USPTO recognizes law firms and corporations that support the Patent Pro Bono Program
- Certificates awarded annually based on cumulative hours per firm/corporation and firm/corporation size
- Recipient names are posted on the USPTO website.
- The USPTO recognized more than 20 firms/corporations in 2021
- Law firm hours expanded to include non-practitioner assistance

No. Reg. Practitioners Employed	Minimum Hours
101+	500
31-100	250
11-30	100
1-10	50



More information

- Visit www.uspto.gov/probonopatents
- Email probono@uspto.gov
- Office of Enrollment and Discipline (OED)
 - Phone 571-272-4097

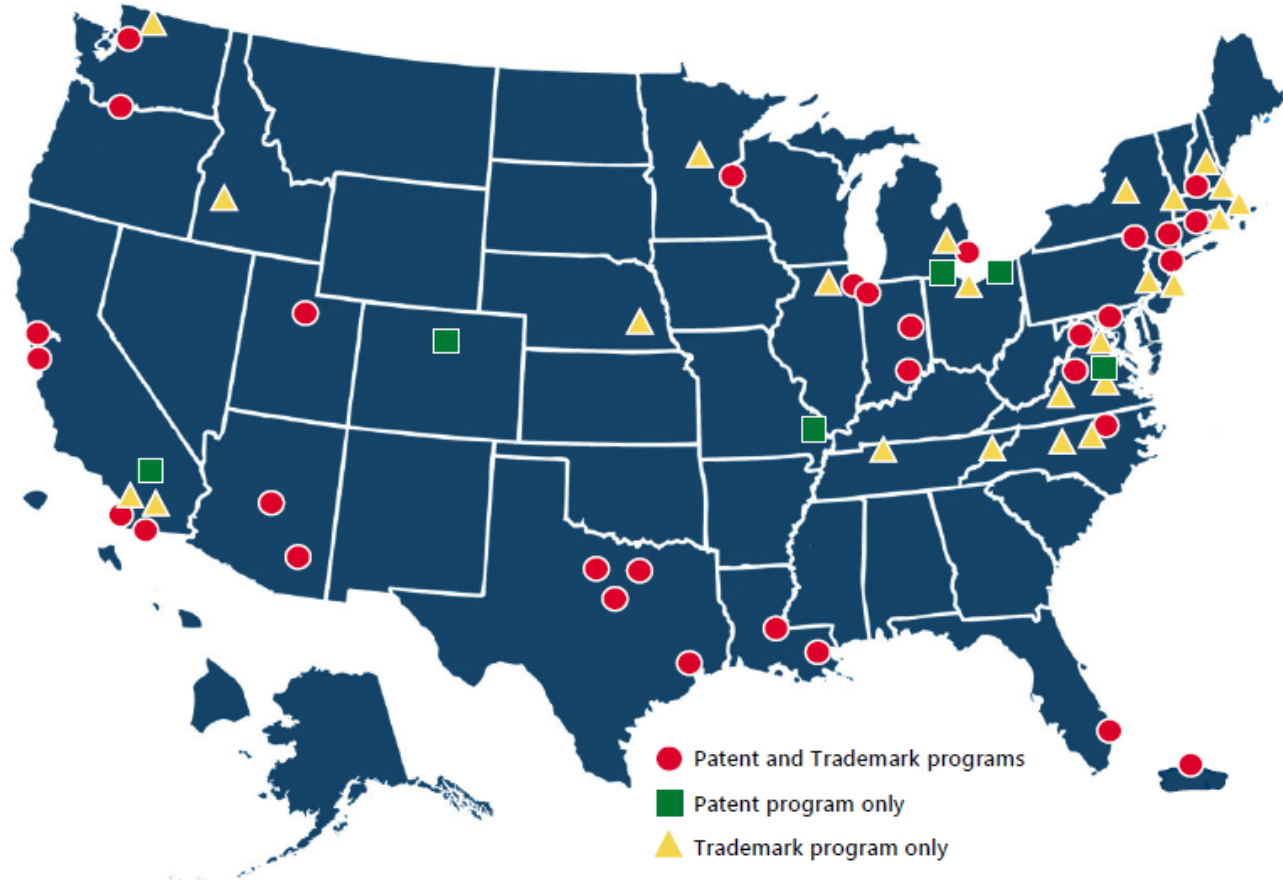


Law School Clinic Certification Program

- Allows students in a participating law school's clinic program to practice before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor
 - The OED Director grants participating law students limited recognition to practice before the USPTO in patents/trademarks.
- Participating in the program gives real-world experience to clinic students while providing IP pro bono services to the community
- Benefits for students, schools, the USPTO, and entrepreneurs and inventors seeking legal representation



Current nationwide coverage



Additional information

- Questions regarding the program may be directed to the Office of Enrollment and Discipline:
 - Phone: 571-272-4097
 - Email: LawSchoolInformation@uspto.gov
- See Frequently Asked Questions for more information:
 - [Law School Clinic Certification Program FAQs](#)



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Invention-Con



www.uspto.gov/about-us/events/invention-con-event-series

Coming August 10–12, 2022!

Invention-Con is the USPTO's annual conference for independent inventors, entrepreneurs, and small business owners whose success depends on guarding their creative work.

For more information, email InventionCon@uspto.gov or call 571-272-8033.





Stacey White
Lead Administrative Patent Judge
Patent Trial and Appeal Board

PTAB Pro Bono Program

PTAB Pro Bono Program

- Assists independent inventors who are financially under-resourced
- PTAB Bar Association works to match volunteer patent professionals with inventors who are financially under-resourced to provide free legal assistance in preparing *ex parte* appeals to the PTAB
- The Program initially will handle *ex parte* appeals only, but may later be expanded to handle AIA proceedings



PTAB Pro Bono Program benefits

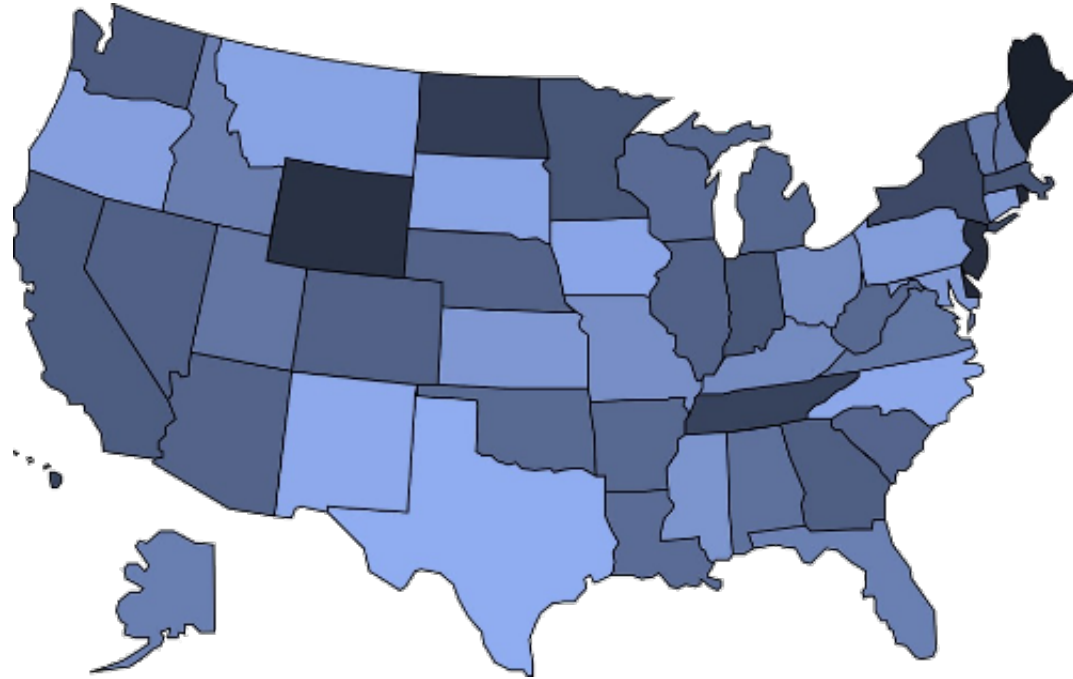
- For inventors:

- Eliminate financial barriers for legal assistance
- Aid inventors who are under-resourced in making effective arguments

- For volunteers:

- Provide legal help in their field of legal practice
- Create new contacts in the community
- Gain experience in working with clients

Nationwide coverage



Administered by the PTAB Bar Association

www.ptabbar.org/ptab_pro_bono.php



Involved entities

- PTAB Bar Association
- Volunteer practitioners (attorneys or agents)
- Independent inventors

PTAB Bar Association

- Serves as the national clearinghouse for this program
- Independent of the USPTO and sets their own policies and procedures
- Responsible for screening and matching PTAB pro bono applicants
 - Ensure applicants meet requirements for PTAB pro bono assistance

Volunteer practitioners: eligibility

- Be a registered patent practitioner with the USPTO in good standing
 - Practitioners who are attorneys must also be in good standing in any state(s) in which they are licensed to practice law
- Have experience in the technology and proceeding type
- Provide malpractice insurance
- Agree to no fee for services
- Provide a representation agreement
 - Termination agreement at completion



How to volunteer

- Create an account and login to the PTAB Bar Association webpage (www.ptabbar.org)
- Complete the volunteer application form available on the PTAB Bar Association webpage
 - Personal information
 - Law firm information
 - Work address
 - Home address
 - Contact information
 - Attorney information
 - Technology preference
 - Languages
 - Electronic signature and date
- Provide all required information, or else the application may be delayed in processing



Processing volunteer forms

- Clearinghouse will enter volunteer information into database
- Clearinghouse will contact all unmatched volunteers regarding new appeals
- Volunteer agrees to representation after:
 - Evaluating case; and
 - Completing conflict check
- Once matched, volunteer will be removed from database for period of ongoing representation

Inventors: eligibility

- Location
 - Domiciled in the U.S.
- Gross household income
 - Limited to 300% of the federal poverty guidelines
 - A single person could have an income of up to \$40,770 (aspe.hhs.gov/poverty-guidelines)
 - Federal poverty guidelines updated yearly
 - The limit increases with additional dependents
- Micro entity status
 - 75% reduction in USPTO fees



Inventors: eligibility

- Appealable rejection in a pending application
- Timing
 - Request assistance within 1 month from date of Office action at issue
- Demonstrate knowledge of the program and the appeal process
 - Established by completing a 2-part video training online
 - Part 1: PTAB Pro Bono Program and application process
 - Part 2: Overview of *ex parte* appeals

Matching inventors with practitioners

- PTAB Bar Association will provide patent practitioners with a brief description of inventor backgrounds and the appeal
- A match will occur within one month after the application is submitted
- If, after a month, there is no match, then PTAB Bar Association will inform the inventor



Scope of representation

- Volunteer will provide inventor with representation agreement and termination letter once representation is complete
- The scope of representation is limited to the PTAB proceeding only, through a PTAB decision
 - Does not include
 - Rehearing
 - Appeal to federal courts

Applying to volunteer with the PTAB Pro Bono Program

- ❑ Apply directly with PTAB Bar Association
 - www.ptabbar.org

- ❑ Visit for more information
 - www.uspto.gov/PTABprobono

Contact info

- PTABprobono@uspto.gov
- PTABprobono@ptabbar.org

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LEAP



- [Legal Experience and Advancement Program \(LEAP\)](#)
- Designed to:
 - Aid in development of the next generation of patent practitioners
 - Encourage a diverse group of advocates to develop their skills before the PTAB
- To qualify, a patent agent or attorney must have:
 - Three or fewer substantive oral arguments in any federal tribunal, including PTAB

Mark Thurmon
Deputy Chief Judge
Trademark Trial and Appeal Board

TTAB Pro Bono Recognition Program

TTAB Pro Bono Program

- Provides representation to pro se parties in TTAB cases
- Recognition program
 - Standards set and published
 - Clearinghouse organizations match attorneys with clients
 - Similar to law school clinic approach
- International Trademark Association (INTA) is the first recognized clearinghouse
- Too early for numbers
 - INTA matched over 300 clients and pro bono attorneys in 2021, before joining



How did we get here?

- The 30,000 foot view
 - Patents pro bono
 - PTAB pro bono
 - TTAB pro bono
 - Trademarks?
- Patent Pro Bono Program led to PTAB Pro Bono Program
- TTAB pro bono program also has roots in the Patent Pro Bono Program
- And this makes sense, because ...

Trademark application process is widely used by pro se parties

- Trademark Electronic Application System (TEAS) forms and instructions opened door to more pro se filing
- Trademarks made filing process simpler and that led to less need for counsel at the filing stage
- Small and medium enterprises filing the most applications
 - Many are pro se
- Pro se trademark applicants need help when something goes wrong
 - Office Actions confuse many pro se applicants
 - TTAB confuses most pro se applicants who end up at the TTAB
 - Some end up at law school clinics
- So there has been less need for a trademark pro bono program focused on filing applications



TTAB pro bono need

- TEAS forms and instructional videos by Trademarks
 - Many pro se parties are able to file using these resources
 - A TTAB proceeding is a very different matter
- TTAB has many rules that do not exist in trademark examination
 - Attorneys often make mistakes in TTAB proceedings
 - Even appeals often confuse pro se parties
 - Record must be complete before appeal
 - No evidence can be filed with appeal brief
 - Applicant's position must be limited to the record
 - Oppositions and cancellations are much more complex
 - Paper trial process and resulting rules are challenging



TTAB pro bono details

- TTAB sets and publishes standards
- Clearinghouse approach
 - Clearinghouse must be nondiscriminatory in assigning attorneys and clients
 - No clients may be excluded because of conflicts
 - Law firms typically cannot operate as clearinghouses
- No fees may be charged for the services
- Clearinghouse sets financial need standard
 - No limit in standards
 - Low risk of pro bono services going to parties who could pay
- Minimal attorney competency standards are included



INTA – TTAB’s First Recognized Pro Bono Clearinghouse

- INTA had existing pro bono committee and program
 - Raised to full committee status in 2021
 - Jenny Simmons at INTA (former USPTO)
 - Timing was fortuitous, so we jumped at the opportunity
- **Impact**
 - In 2021, INTA matched over 300 clients with pro bono counsel
 - Prior to TTAB pro bono recognition
 - INTA 2022 live+ annual meeting roll out



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Next Boardside Chat



- Visit our website for information on our next Boardside Chat.
- Register for and learn about upcoming Boardside Chats, and access past Boardside Chats at:
<https://www.uspto.gov/patents/ptab/ptab-boardside-chats>

