

UNLEASHING AMERICAN INNOVATORS ACT OF 2022

STUDY OF THE PATENT PRO BONO PROGRAMS



United States Patent and Trademark Office

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

December 29, 2023

The Honorable Richard Durbin
Chairman, Senate Judiciary Committee
United States Senate
Washington, DC 20510

The Honorable Jim Jordan
Chairman, House Judiciary Committee
United States House of Representatives
Washington, DC 20515

The Honorable Lindsay Graham
Ranking Member, Senate Judiciary Committee
United States Senate
Washington, DC 20510

The Honorable Jerrold Nadler
Ranking Member, House Judiciary Committee
United States House of Representatives
Washington, DC 20515

Dear Chairmen and Ranking Members:

As required by the Unleashing American Innovators Act of 2022 (UAIA) under the Consolidated Appropriations Act (Act), Pub. L. 117-328, I am pleased to submit this report on the results of a study of the patent pro bono programs. This study builds on the work the United States Patent and Trademark Office (USPTO) has conducted for over a decade—work that has been expanded and strengthened under my leadership and in collaboration with the Pro Bono Advisory Council (PBAC)—to bring more people in America into the innovation ecosystem by offering free legal counsel. It also builds on the work of this Administration, and the work we have done at the USPTO since the spring of 2022, to expand USPTO offerings and create new ones to open the doors wide to innovation and entrepreneurship across our great nation. We know this is the key to creating jobs, fostering economic prosperity, and addressing societal challenges.

To support this study of the patent pro bono programs, the USPTO regularly collected metric data regarding the administrative performance of the patent pro bono programs. The USPTO also solicited public comments through public listening sessions on June 5, 2023, and June 7, 2023, titled "Inventor Listening Session for Patent Pro Bono Programs" and "Patent Practitioner Listening Session for Patent Pro Bono Programs," respectively. The USPTO also solicited comments through a Federal Register Notice published on April 12, 2023, and, to provide more time for interested persons to respond, through a subsequent June 29, 2023, notice extending the deadline for submission through August 11, 2023. The listening sessions and Federal Register Notices invited interested parties to provide feedback on the regional patent pro bono programs. In particular, the USPTO solicited feedback to assess whether the regional patent pro bono programs are sufficiently serving prospective and existing participants, whether participation requirements deter participation among inventors, whether inventors are aware of the program, whether there are any factors that may deter attorney participation, and whether the program would be improved by including non-attorney advocates.

In total, the USPTO received 14 comments (available at www.regulations.gov/docket/PTO-C-2023-0009/comments) from a variety of stakeholders, including legal associations, inventor groups, nonprofit entities, businesses, practitioners, and inventors.

On behalf of the USPTO, I am pleased to deliver this study titled "Unleashing American Innovators Act of 2022: Study of the Patent Pro Bono Programs." At a high level, the study found that these thriving programs are successfully meeting the needs of under-resourced independent inventors and small businesses. Specifically, the study found:

- From 2015 through 2022, over \$39.3 million in donated legal services was provided to under-resourced inventors and small businesses. The USPTO's annual expenditure on the regional patent pro bono programs, which is approximately \$1.2 million, serves as a force multiplier, amplifying the overall amount of funds donated to the public in the form of valuable donated legal services. For every dollar the USPTO spends annually for the regional patent pro bono programs to administer referral services, the public sees anywhere from \$5.52 to \$9.67 annually in direct legal assistance to independent inventors and small businesses.
- When I came on board at the USPTO, the agency and I held an early meeting with the PBAC to assess ways in which the pro bono offerings could be expanded. Based on feedback from that meeting, the USPTO took the proactive step of increasing the fiscal year 2023 budget for the program from \$680,000 to approximately \$1.2 million. The funding that has been allocated from the \$1.2 million was premised not only on fund matching but also on the individual organizations presenting a concrete plan on how the money would be used to enhance access. Though in past years there had been turnover in the regional patent pro bono programs due to the inability of partner organizations to succeed, the additional funding and support has resulted in no turnover in the regional patent pro bono programs in 2023.
- The regional patent pro bono programs effectively expand access to the patent system to historically underserved communities, with those applicants who identify as Black, Native American, or mixed race doing so at or above the existing proportions in the U.S. population. Applicants identifying as Black accounted for 30% of those participating in the program in 2021 and 35% in 2022, and those identifying as Native American accounted for 1.5% in 2021 and 1.6% in 2022.
- Approximately 7.9% of patent pro bono applicants in 2022 were veterans, which was greater than the 5.2% of veterans in the 2020 U.S. population.
- Also, whereas women participate in patenting in the U.S. at a rate of 12-13%, the Patent Pro Bono Program shows high participation rates by women, who accounted for 41% of applicants in 2021 and 43% in 2022.
- The primary condition restricting inventor participation is the financial screening requirement of the regional patent pro bono programs, and the USPTO is working with the programs, where practicable, to increase the threshold to a gross household income that is not more than 400% of the federal poverty line as set forth in the UAIA.

- Year-over-year increases in the number of individuals inquiring about the patent pro bono program in the past few years, including a 6% jump from 2021-2022, indicate that the USPTO, the PBAC, and the regional patent pro bono programs' promotion efforts are improving inventor awareness.
- The regional patent pro bono programs include a significant number of non-attorney advocates (registered patent agents) who support the program, with data showing that approximately 23% of patent pro bono application filings were filed by a registered patent agent.

In coordination with the PBAC, and in response to the many listening sessions I have conducted with inventors and those who have not traditionally had full access to the innovation ecosystem, the USPTO and I are working to expand the resources available to the public through the Patent Pro Bono Program. The PBAC is also working on providing reduced-fee search services, non-disclosure agreements, and licensing help through the regional patent pro bono programs.

In addition to promoting inclusive innovation by strengthening and increasing our pro bono offerings, the USPTO and I have worked since April 2022 to elevate the USPTO and the United States to the status of gold standards in terms of expanding the innovation ecosystem. We have built these efforts into our strategic plan as our first pillar. We have developed new USPTO programming and launched new initiatives such as the Women's Entrepreneurship (WE) initiative, in conjunction with Gina Raimondo, Secretary of Commerce. We now lead the Department of Commerce's military initiative promoting and supporting innovation and entrepreneurship among our military families and veterans. Through my work as a Co-Chair on the Economic Development Administration's National Advisory Council on Innovation and Entrepreneurship, we are building a National Entrepreneurship Strategy. Through my leadership, along with that of Secretary Raimondo, on the Council for Inclusive Innovation, we launched the first-ever First-time Filer Expedited Examination Pilot Program, we introduced a new tool (IP Identifier) for innovators to use to identify their intellectual property (IP), and we are running a pilot to enable the USPTO workforce to be champions for IP across the country. We have also expanded the patent bar and have published a final rule that creates a design patent bar to reduce barriers so more people across the country can assist inventors.

In addition, we are identifying and removing barriers by better serving pro se applicants. For example, we have established Pro Se Champions in the USPTO's Patents organization and have provided all employees with tools that will aid in engaging with pro se applicants at every step of their journey. We also have a full range of contact centers committed to assisting inventors and pro se applicants, and a pro se resources page that provides consolidated access to educational information addressing common questions received from applicants at various stages of the patent application process.

We have also introduced new welcome letters that are sent to each patent and trademark filer which support inventors along their journey, starting with their very first patent and trademark filing.

We are starting with our children and have expanded Camp Invention—a collaboration with the National Inventors Hall of Fame—which provided innovation and IP education to over 367,000 children this year. We have expanded our train-the-trainer programs for teachers and launched our

first-ever Master Teacher of Invention and Intellectual Property Education Program with STEMisED¹ to cultivate a network of teacher-leaders who will empower educators to foster invention and IP education among their students. In addition, we are expanding our Patent and Trademark Resource Center footprint to ensure that more Americans can get patent and trademark assistance in their local libraries. And this year, the USPTO led an initiative across 35 IP offices and organizations around the globe to issue the global IP offices' joint statement on International Women's Day 2023: Innovation and technology for gender equality.²

In response to our recent efforts, the USPTO has topped the list of the most accessible IP office websites for the first time.³ That said, we are still working hard to make sure our resources are available and useful to all. In December 2022, we released a virtual assistant in our Trademarks organization to enhance customer service by providing immediate, targeted answers to common customer questions and to make it easy to find the status of an application or registration. And in September 2023, we made enhancements to our agency's tools by expanding the use of chatbots and launching an updated website search tool to improve the search experience for all web visitors.

The study that follows provides information on the current state of the patent pro bono programs. We look forward to continuing to grow this critical program that broadens access to the IP system as we work across the USPTO and the U.S. government and with Congress to identify and deliver on additional initiatives at speed and scale.

Focusing on the pro bono program, the study also provides a legislative suggestion that could assist the USPTO in doing more to achieve its mission.

- The regional patent pro bono programs are sufficiently funded at current participation rates, but the existing funding mechanism, the Department of Commerce's Joint Project Authority, structurally limits the growth and sustainability of the program. A new funding mechanism that would allow the USPTO to provide funds to the regional patent pro bono programs without requiring equitable contributions from the regional programs is needed to expand patent referral service operations and promotion efforts. The USPTO proposes that Congress provide Other Transaction Authority that will not only permit the USPTO to enter into Other Transaction Authority Agreements to fully fund the regional patent pro bono programs, but will also allow the USPTO to enter into similar partnerships to advance the USPTO mission.

¹ See www.stemised.com/.

² See www.uspto.gov/about-us/news-updates/global-ip-offices-joint-statement-international-womens-day-2023-innovation-0#:~:text=%E2%80%9CThat%20said%2C%20we%20must%20continue,in%20relation%20to%20IP%20policy.

³ See www.worldtrademarkreview.com/article/uspto-website-ranked-worlds-most-accessible-ip-office-web-platform.

Please let me know how we can be of any further assistance.

Sincerely,



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

cc: The Honorable Chris Coons, Chairman, Subcommittee on Intellectual Property
The Honorable Thom Tillis, Ranking Member, Subcommittee on Intellectual Property
The Honorable Darrell Issa, Chairman, Subcommittee on Courts, Intellectual Property, and the
Internet
The Honorable Hank Johnson, Ranking Member, Subcommittee on Courts, Intellectual Property,
and the Internet

Acknowledgements

This report reflects the exemplary dedication and expertise of the management and staff attorneys of the Office of Enrollment and Discipline (OED), which manages the Patent Pro Bono Program at the USPTO, and in particular, of the following principal contributors: David Berdan, General Counsel; Will Covey, Deputy General Counsel and Director for the OED; James Silbermann, Senior Counsel for Enrollment and Intellectual Property Legal Services; William Griffin, Deputy Director of the OED; and Grant Corboy, Elizabeth Dorsey, Dahlia Girgis, Kim Kelleher, and Diana Oleksa, all OED Staff Attorneys. Without their extraordinary leadership and considerable efforts in managing this program, together with their deep understanding of the subject matter, this report would not have been possible.

I am also immensely grateful to the following team members from the Office of the Chief Economist (OCE), the Office of General Law (OGL), the Office of the Chief Financial Officer (OCFO), the Office of Procurement (OP), and the Office of Governmental Affairs (OGA): Andy Toole, Chief Economist (OCE); Nicholas Rada, Deputy Chief Economist (OCE); Heidi Bourgeois, Associate Counsel (OGL); Michelle Picard, Chief of Staff and Senior Advisor (OCFO); Kristin Fuller, Director of Procurement (OP); Kim Alton, Deputy Director (OGA); and Tamara Foley, Attorney Advisor (OGA).

I would also like to thank the technical support team, who helped assemble the drafts and facilitate the visuals and production of this report, including: Leticia Dooley, Supervisory Management and Program Analyst (OED); Bernice Littlejohn, Program Analyst (OED); Rick Heddlesten, Visual Information Specialist in the Office of the Commissioner for Patents; and Tom Berry, Senior Analyst and Advisor (OCFO).

I also wish to thank Jim Patterson, Joe Mischler, and Morris Newman of the PBAC for their valuable contributions in providing content regarding the PBAC's support of the Patent Pro Bono Program. In addition, I thank them for their deep and engaged efforts to work with the USPTO over time, including over the past year and a half, as we've expanded pro bono services as part of our efforts to expand the entire innovation ecosystem to lift communities, create jobs, and solve world problems.

Finally, I would like to extend my gratitude to all the members of the public who provided written comments in response to the Federal Register Notices. Their wide-ranging experiences and thoughtful submissions provided critical insights into the impact of the Patent Pro Bono Program on independent inventors and small businesses. And I offer thanks to everyone who has played a role in running the programs and donating time to help innovators across our country. Through this work, we lift others, protect IP, and create opportunities and jobs in every corner of our great nation.

Sincerely,



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

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1. Introducing the USPTO Patent Pro Bono Program

The Leahy-Smith America Invents Act (AIA), passed in 2011, provided that 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.”¹ On February 20, 2014, the White House directed the USPTO to expand the Patent Pro Bono Program (Program) to cover all 50 states and dedicate resources to assisting inventors with obtaining legal representation.² In response, in 2015 the USPTO developed a nationwide network of regional patent pro bono programs, many of which serve multiple states. The Patent Pro Bono Program continues to support expanded services provided through the affiliated regional patent pro bono programs.

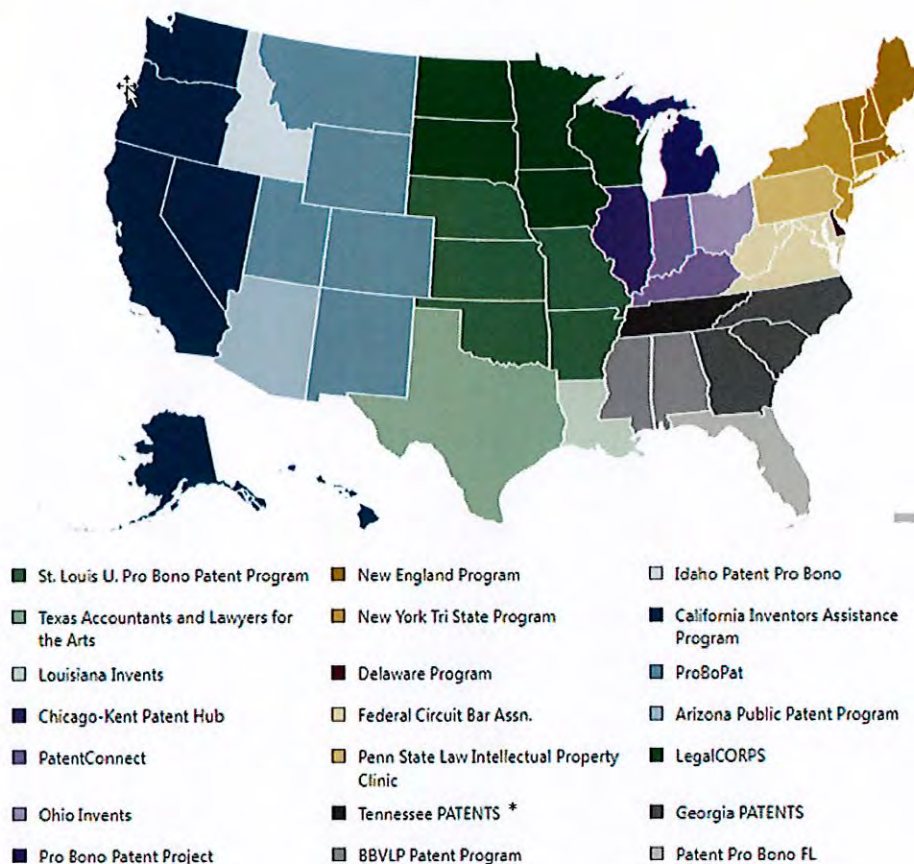
The current nationwide network of 20 independently operated not-for-profit regional patent pro bono programs matches volunteer patent professionals with financially under-resourced inventors and small businesses for the purpose of preparing, filing, and prosecuting patent applications. The network provides access to patent prosecution assistance across all 50 states, the District of Columbia, and Puerto Rico.

Under-resourced individuals and small businesses seeking free legal patent prosecution assistance can apply to the regional patent pro bono program that covers the state in which they reside. The map below illustrates the network of patent pro bono programs and the regions they cover.

¹ Pub. L. No. 112-29, 125 Stat. 284 (2011), Sec. 32.

² White House, “Answering the President’s Call to Strengthen Our Patent System and Foster Innovation,” February 20, 2014, <https://obamawhitehouse.archives.gov/the-press-office/2014/02/20/fact-sheet-executive-actions-answering-president-s-call-strengthen-our-p>.

Figure 1. Map of the regional patent pro bono programs



* Tennessee PATENTS is managed by Georgia Lawyers for the Arts-Georgia PATENTS Program.

The undergirding goal of the Patent Pro Bono Program is to increase access to the patent system for inventors and entrepreneurs who may not have the financial means to navigate the complexities of the system. Startups and other small businesses are the engine of the American economy, having created 64% of new American private sector jobs in the past 15 years—approximately 1.5 million jobs each year.³ Between 1995 and 2019, small business employment grew by 17.2%, and small businesses now employ nearly half of U.S. employees.⁴ Startups whose first patent application is approved create more jobs and enjoy faster sales growth than startups that fail to obtain patent protection.⁵ The approval of a startup's first patent application increases its employment over the next five years by

³ See Chamber of Commerce, "Small Business Statistics," www.chamberofcommerce.org/small-business-statistics/.

⁴ See U.S. Small Business Administration, "2022 Small Business Profile," <https://advocacy.sba.gov/wp-content/uploads/2022/08/Small-Business-Economic-Profile-US.pdf>.

⁵ "What Is a Patent Worth? Evidence from the U.S. Patent 'Lottery,'" *Journal of Finance*, USPTO Economic Working Paper 2015-5, revised July 9, 2019.

55%, on average.⁶ By providing free patent prosecution services to individuals and small businesses seeking protection for their inventions, the Program promotes innovation and supports job creation.

Expanding access to the innovation ecosystem can improve the economy. Women are under-represented in patenting, comprising only 13% of all resident inventors named on U.S. patents granted in 2019.⁷ Including more women, African Americans, and other minorities in the initial stages of the innovation process could increase gross domestic product (GDP) per capita by 0.6% to 4.4%.⁸ By extrapolation, and using the Bureau of Economic Analysis's annual GDP calculation, 4.4% percent of the U.S. GDP in 2021 (\$23 trillion), represents about \$1 trillion in economic gain. The Patent Pro Bono Program is reaching underserved inventor communities to contribute to the growth of the U.S. economy.

To further participation in the innovation ecosystem, the USPTO also launched pro bono programs for matters before the Patent Trial and Appeal Board (PTAB) and the Trademark Trial and Appeal Board (TTAB). The PTAB Bar Association serves as a national clearinghouse to connect volunteer practitioners with eligible inventors for PTAB matters.⁹ The International Trademark Association serves as the first clearinghouse for TTAB-related matters, connecting volunteer trademark practitioners with eligible individuals and organizations.¹⁰ These programs provide the public with resources to help spur inclusive innovation throughout the United States.

2. Characterizing the patent pro bono program structure, operation, and participation

This section provides an overview of the Patent Pro Bono Program, including the role and function of the main organizations responsible for its operation: the USPTO, the Pro Bono Advisory Council (PBAC), and the regional not-for-profit patent pro bono programs. Additionally, it explores significant topics such as the importance of volunteer patent practitioners, participation by non-attorneys, and recently captured demographic and geographical information on participants. The growth of the Program indicates that the USPTO, the PBAC, and the regional patent pro bono programs are effectively promoting the Program to raise public awareness. Lastly, this section includes USPTO findings showing that the main barriers for participation are the financial screening requirements, and that the data suggest the Program is sufficiently serving prospective and existing participants.

⁶ *Id.*

⁷ See USPTO Office of the Chief Economist, "Progress and Potential: 2020 update on U.S. women inventor-patentees," July 2020, www.uspto.gov/sites/default/files/documents/OCE-DH-Progress-Potential-2020.pdf.

⁸ Lisa Cook, "Addressing gender and racial disparities in the U.S. labor market to boost wages and power innovation, January 14, 2021, <https://equitablegrowth.org/addressing-gender-and-racial-disparities-in-the-u-s-labor-market-to-boost-wages-and-power-innovation/>.

⁹ Additional information on the USPTO's PTAB Pro Bono Program is available in Appendix A.

¹⁰ Additional information on the USPTO's TTAB Pro Bono Program is available in Appendix B.

2.1 Describing the organization, structure, and services of the Patent Pro Bono Program

There are three main organizations responsible for the establishment and operation of the Patent Pro Bono Program: the USPTO, the PBAC, and the regional patent pro bono programs. Each entity has a necessary and specific role in the Program. A brief description of each and its role in the Patent Pro Bono Program follows.

Figure 2. Patent pro bono support organizations



2.1.1 Role of the USPTO

With the passage of the AIA in 2011, the USPTO increased its efforts to encourage patent practitioners to volunteer their legal services in a pro bono environment. Realizing that no structured opportunities existed, at that time, for patent practitioners to render pro bono services in their area of expertise, USPTO staff collaborated with existing nonprofits across the country to establish viable programs to provide patent pro bono services.

Currently, the USPTO encourages the establishment of patent pro bono programs across the United States so under-resourced inventors and small businesses have access to this valuable resource. Once established, the USPTO provides these programs with technical assistance, opportunities for collaboration, and financial support.

Since the passage of the AIA, the USPTO and the PBAC have been working to develop best practices for operating and maintaining a patent pro bono program. In 2012, the USPTO and the PBAC

compiled and published best practices in *Patent Law Pro Bono: A Best Practices Handbook*.¹¹ The handbook provides highly practical guidance in the form of sample documents such as applications for legal assistance, intake forms, and inventor information forms. In addition, the USPTO continues to enhance best practices by collecting information regarding the performance and operation of the regional patent pro bono programs. The USPTO shares this information with intellectual property (IP) law organizations interested in hosting a patent pro bono program. By sharing best practices, lessons learned, and existing data on expected utilization, the USPTO reduces the risks of hosting a patent pro bono program for the potential hosts.

In addition, the USPTO ensures the successful operation of the Program by promoting collaboration between the regional patent pro bono programs. The USPTO hosts quarterly administrator conferences to share current trends in the metrics, recent Program developments, and focus areas. Importantly, the conferences provide an open forum where administrators share experiences and collaborate. These administrator conferences are typically held virtually; however, the USPTO holds an in-person conference at USPTO headquarters biennially.¹² The in-person conferences further the collaborative dialogue between administrators; these connections are beneficial when addressing issues that arise during the operation of the regional patent pro bono programs.

The USPTO shares some of the burden associated with operating a patent pro bono program by entering into partnerships with regional programs to provide administrative support through its Joint Project Authority (JPA). Specifically, 15 U.S.C. 1525 provides that the Department of Commerce may enter into joint projects with nonprofit, research, or public organizations on matters of mutual interest, the cost of which is equitably apportioned. Prior to 2015, the USPTO did not partner with regional patent pro bono programs in this way. At the time, the Patent Pro Bono Program had nine regional patent pro bono programs covering roughly 20 states. In fiscal year (FY) 2015, the USPTO began entering into joint project agreements with regional patent pro bono programs via the Secretary of Commerce's JPA, improving the sustainability of the existing regional patent pro bono programs and encouraging the establishment of other programs throughout the United States. By partnering with regional programs to provide administrative support, the USPTO attained nationwide coverage in the summer of 2015. In FY 2022, the USPTO met with the PBAC to assess ways in which the pro bono offerings could be expanded. Based on feedback from that meeting, the USPTO took the proactive step of increasing the FY 2023 budget for the Program from \$680,000 to approximately \$1.2 million. In FY 2023, the USPTO participated in joint projects for administrative support for 16 of the 20 regional patent pro bono programs.¹³ The total contribution by the USPTO to these joint projects is

¹¹ See Amy M. Salmela and Mark R. Privratsky, "Patent Law Pro Bono: A Best Practices Handbook," *Cybaris* 4, no. 1 (2013), available at <https://open.mitchellhamline.edu/cgi/viewcontent.cgi?article=1013&context=cybaris>.

¹² This every-other-year cadence was interrupted by the pandemic. The administrator conference hosted at the USPTO will begin again in the late spring/early summer of 2024.

¹³ The four organizations operating regional patent pro bono programs that are not supported through a partnership agreement with the USPTO are: the Federal Circuit Bar Association, the State Bar of Michigan, the University of Idaho, and Widener University.

approximately \$1.2 million.¹⁴ The funding that was allocated from the \$1.2 million was premised not only on fund matching, but also on the individual organizations presenting a concrete plan on how the money would be used to enhance access to the patent system. Though in past years there had been turnover in the regional patent pro bono programs due to, in some cases, the financial instability of the partner organizations, the additional funding and support stopped the turnover of regional patent pro bono programs in calendar year 2023.

The USPTO also supports the regional patent pro bono programs by encouraging patent practitioners and inventors to participate. Volunteer patent practitioners are the linchpin of the Program. The USPTO promotes the Program to patent practitioners to increase awareness throughout the patent bar.

For example, the USPTO sends out monthly emails to more than 100 state and local IP organizations to promote the Patent Pro Bono Program. The monthly emails also offer the opportunity for presentations to the local IP organization, including sought-after continuing legal education (CLE) ethics content to increase participation and attendance. In addition, the USPTO shares its knowledge of regional patent pro bono program procedures and issues regarding pro bono representation to answer questions and to encourage practitioners to participate.

The USPTO attends conferences and meetings held by national IP, pro bono, and corporate patent counsel organizations to offer greater exposure for the Patent Pro Bono Program to a national audience. These events are often not readily accessible to the regional patent pro bono programs.

The USPTO manages the Patent Pro Bono Program through its Office of Enrollment and Discipline (OED). OED administers the Program with a dedicated Pro Bono Coordinator, OED staff attorneys, and other support staff. The team supports the regional patent pro bono programs, the PBAC, potential patent applicants, and patent practitioners interested in learning more about the Patent Pro Bono Program.

The OED team collects operational metrics from the regional patent pro bono programs on a quarterly basis. The metrics give insight into a particular regional patent pro bono program's service to the public for a given quarter and can illuminate valuable trends regarding a program's ability to attract applicants and volunteers. The metrics are valuable in informing the funding process and measuring and communicating the impact of the Program on the under-resourced inventor and small business community.

¹⁴ Due to the equitable apportionment of the USPTO's Joint Project Authority, the actual value of referral administration services provided by the regional patent pro bono programs is more than \$2.4 million, or twice the approximately \$1.2 million obligated to the regional patent pro bono programs on an annual basis.

2.1.2 Role of the Pro Bono Advisory Council (PBAC)

The PBAC is a 501(c)(3) organization whose core mission is to assist the USPTO with the administration of patent pro bono programs across the United States. The PBAC achieves this mission by providing support for the regional patent pro bono programs in the areas of awareness, participation, and sustainability.

The PBAC is managed through its board of directors.¹⁵ The directors utilize their broad experience in the legal profession, pro bono services, and the provision of assistance to inventors to achieve commercial success. The PBAC hosts important conversations with federal and private sector experts on how under-resourced innovators can leverage the USPTO's Patent Pro Bono Program to bring their ideas and products to market.

A critical role of the PBAC is to assist the regional patent pro bono programs in areas where the USPTO is unable to, by, for example, connecting regional patent pro bono programs with malpractice insurance providers, fundraising, and connecting programs with prior art search services to facilitate application screening. Moreover, the PBAC assists inventors using the regional patent pro bono programs with invention commercialization.

The PBAC meets annually with each regional patent pro bono program on a one-on-one basis, along with the USPTO. These annual meetings, combined with quarterly conferences that include all the programs, facilitate ongoing reviews of practices that optimize each program's services to inventors. The PBAC analyzes regional program data in depth to provide detailed demographic and programmatic information nationwide, and individually for each regional program.

In collaboration with the USPTO, the PBAC engages in a series of conferences held in cities throughout the nation. These conferences focus on outreach and recognition to encourage participation by eligible inventors and pro bono attorneys. The conferences also focus on assisting inventors with commercializing their inventions.

The PBAC has partnered with a venture capital firm to provide free information to patent pro bono inventors on best practices to obtain startup funding. The PBAC has also partnered with a firm to provide free services to connect patent pro bono inventors with businesses interested in licensing their inventions.

¹⁵ The PBAC's Board of Directors includes: Jim Patterson, Patent Attorney and Chair, PBAC, Principal and Founder of Patterson Thuermer IP; Kirk Damman, Patent Attorney and Secretary, PBAC, Member of Lewis Rice; Joe Mischler, Chair, Fundraising and Treasury, PBAC, Partner at Actional Intellectual Property Insights, Founder of MStreet Advisory; and Warren Tuttle, Non-Attorney and Co-Chair, PBAC, Founder of Tuttle Innovation, Co-Founder of Market-Blast.

The PBAC members are a diverse and dynamic group of professionals consisting of attorney practitioners and non-attorney business professionals dedicated to advancing the Patent Pro Bono Program.¹⁶ This balanced composition ensures a comprehensive perspective on matters related to the Program. The attorney practitioners on the board bring a wealth of legal expertise and experience in patent law, while the non-attorney business professionals contribute their strategic insights and practical industry knowledge. This collaborative approach enables the council to effectively fulfill its mission of providing pro bono patent assistance to under-resourced inventors and innovators, thereby fostering a more inclusive and equitable innovation ecosystem.

2.1.3 Role of the regional patent pro bono programs

The regional patent pro bono programs are independently operated by entities such as bar associations, law school clinics, and lawyer referral services. The regional patent pro bono programs match financially under-resourced inventors and small businesses with volunteer patent attorneys and agents for the purpose of securing patent protection. The USPTO's Patent Pro Bono Program would not succeed without the referral services provided by the regional patent pro bono programs.

To perform this matchmaking operation, regional patent pro bono programs must actively identify viable applicants. Each regional program promotes the Program as a resource to independent inventors and small businesses in their region. All regional programs have a website featuring an electronic applicant intake form. The form elicits information from the applicants that the program uses to determine whether the applicant qualifies for free legal assistance.

Among other things, intake screening forms request the applicant's contact information, voluntary demographic information, household income, related business interests, and information regarding the invention. The administrator assembles this data and contacts the applicant to obtain any additional information, such as financial documentation to verify financial eligibility. The administrator then assembles a case file, which is used to evaluate the applicant for acceptance into the Program.

¹⁶ Attorney David Kappos, former Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, August 2009-January 2013; Professor Lateef Mtima, Professor of Law at Howard University, Founder and Director of the Institute for Intellectual Property and Social Justice; Attorney Dara Kendell, Senior Vice President and General Counsel at Procter & Gamble; United States District Court Judge Nina Wang; Attorney Ben Fernandez, WilmerHale; Attorney Dana Colarulli, Executive Director of the Licensing Executives Society International, former Director of the USPTO's Office of Governmental Affairs; Attorney Christie Thoene, Vice President of Policy and Legal Communications, Qualcomm; Lecturer, Design Historian, and Industrial Designer/Inventor James Howard, Executive Director of the Black Inventors Hall of Fame; Attorney Tahda Ahtone, enrolled citizen of the Kiowa Nation, Founder of JackRabbit Development and the Ahtone Law Firm; Attorney Ulysses Williams, IP Counsel, Pall Life Sciences Corporation; Dr. Paul Campbell, Co-Founder, Brown Venture Group; Attorney Chinwe Ohanele, Senior Program Manager, Michelson Philanthropies; and Attorney Andrea Hence Evans, Principal, Evans IP Law.

The regional patent pro bono programs perform a review of the case file to determine whether the applicant qualifies for placement. The screening does not assess the merits of the case or address questions with respect to inventorship, patentability, outstanding rejections, or related substantive eligibility. The screening involves an evaluation of the information provided by applicant against the specific screening requirements for each program. Generally, these screening requirements are centered around residency, financial eligibility, knowledge of the patent system, and possession of a potentially patentable invention. Upon approval by the regional patent pro bono program, the administrator attempts to match the applicant with a volunteer patent practitioner. Applicants that fail to satisfy the screening requirements are notified and provided information regarding other resources to consider for pursuing protection of their IP.

Regional patent pro bono programs must have a bench of volunteer patent practitioners to support their matching operations. To build up their volunteer base, the regional patent pro bono programs host networking events, send promotional email flyers, and present directly to law firms and IP organizations in their region. The patent practitioners likewise volunteer through an intake form hosted on a regional patent pro bono program website.

Each regional patent pro bono program has slightly different methods to match volunteers with qualified applicants. Generally, a regional program emails a list of approved applicants awaiting placement to their roster of volunteers. The email contains basic information about the applicants, such as name, title, and a brief description of their invention. The volunteer patent practitioner can use this information to do a preliminary conflict check and identify the technology area of the invention. In some cases, the information will include a date by which the applicant must be matched.¹⁷ Applicants who are approved for placement and not selected by a volunteer are notified so they can seek other alternatives for assistance (pro se assistance, law school clinics, etc.).

If a volunteer patent practitioner is interested in representing an applicant on the case list, they notify the regional patent pro bono program, and the regional patent pro bono program provides the applicant with the volunteer's contact information. The applicant is responsible for contacting the volunteer patent practitioner to schedule a consultation.

At the consultation, the volunteer and the applicant discuss the invention and decide whether to engage each other and proceed with the preparation and prosecution of an application before the USPTO.¹⁸ Typically, an engagement letter is executed between the patent practitioner and the applicant, and the representation proceeds as if the applicant were a paying client.

¹⁷ The first-to-file system under the AIA requires some urgency on the part of applicants to file their applications with the USPTO in order to obtain a priority date as early as possible. Therefore, the regional patent pro bono programs only attempt to place an applicant for a finite period of time.

¹⁸ 37 C.F.R. § 11.102 of the USPTO Rules of Professional Conduct allows for limited scope representation. As such, the applicant and volunteer may limit their representation to preparing an application, filing the application, responding to an office action, etc. However, the USPTO encourages the regional patent pro bono programs to have their volunteers represent applicants through allowance or final rejection.

Once a match is made, regional patent pro bono programs ask the volunteers to continue providing status updates regarding the representation, including the dates when the application is filed, when and if a patent is issued on the invention, and when the representation concludes. The regional programs also request that the volunteers log their pro bono service hours. Volunteer hours are an important metric for determining the amount of free legal services provided to the public and are also used to recognize volunteers. The information is collected by the regional patent pro bono programs and shared with the USPTO and the PBAC to help promote the Program.

In addition to their outreach efforts to patent practitioners, the regional patent pro bono programs promote the services to inventors and small businesses in their local region by advertising via websites and social media; attending local inventor conferences; attending university events; working with Patent and Trademark Resource Centers; and hosting “brief advice clinics,” where volunteer patent practitioners meet with inventors to provide information on IP.

2.2 Supporting volunteer participation in the patent pro bono programs

The USPTO collects limited information regarding volunteers who participate through the regional patent pro bono programs and focuses on two metrics: (1) the number of hours volunteered, and (2) the number of patent practitioners agreeing to accept cases.¹⁹ Given this limited information on volunteers, the USPTO relied heavily on both a June 7, 2023, practitioner listening session²⁰ and a Federal Register Notice²¹ requesting comments from patent practitioners on the patent pro bono programs for additional information on volunteer participation. The USPTO also relied on research from a prior published study on attorney pro bono participation.

¹⁹ This is the number of patent practitioners who have signed on to volunteer through one of the regional patent pro bono programs, i.e., the total number of volunteers on every regional patent pro bono program’s volunteer roster.

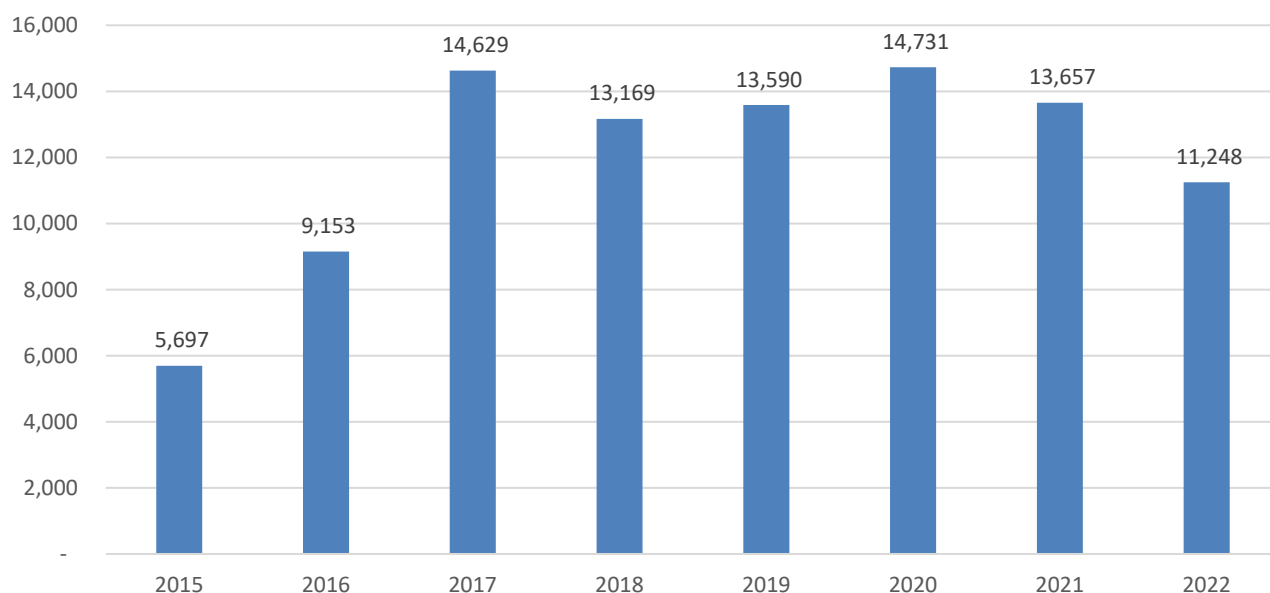
²⁰ A transcript of the June 7, 2023, practitioner listening session is available in Appendix C.

²¹ The comments to the Federal Register Notice are available at www.regulations.gov/docket/PTO-C-2023-0009/comments. A table of the comments and USPTO responses is available in Appendix D.

2.2.1 Hourly volunteer participation and the number of rostered volunteers

Since 2015, the first year of available data, the regional patent pro bono programs have reported an average 10% annual increase in volunteer hours donated to the regional patent pro bono programs (Figure 3).²² Through calendar year 2022, 95,874 total hours were donated by volunteers to help under-resourced inventors and small businesses.

Figure 3. Hours donated to the regional patent pro bono programs, by year, 2015-2022



We can apply a financial value to those hours by using an average hourly billing rate for a private firm associate. The American Intellectual Property Law Association’s Economic Survey provides hourly billing rates for 14 cities or regions throughout the United States. In 2016, the average rate was \$381.64/hour.²³ We extrapolated that per-hour rate to the entire 2015-2022 period using the World Bank’s Consumer Price Index specific to the United States, which adjusted the 2016 hourly rate to change with inflation.²⁴ Multiplying each year’s adjusted hourly rate by the total number of hours volunteered annually, and summing over time, showed that over \$39.3 million in direct legal assistance was provided to under-resourced inventors and small businesses from 2015-2022.

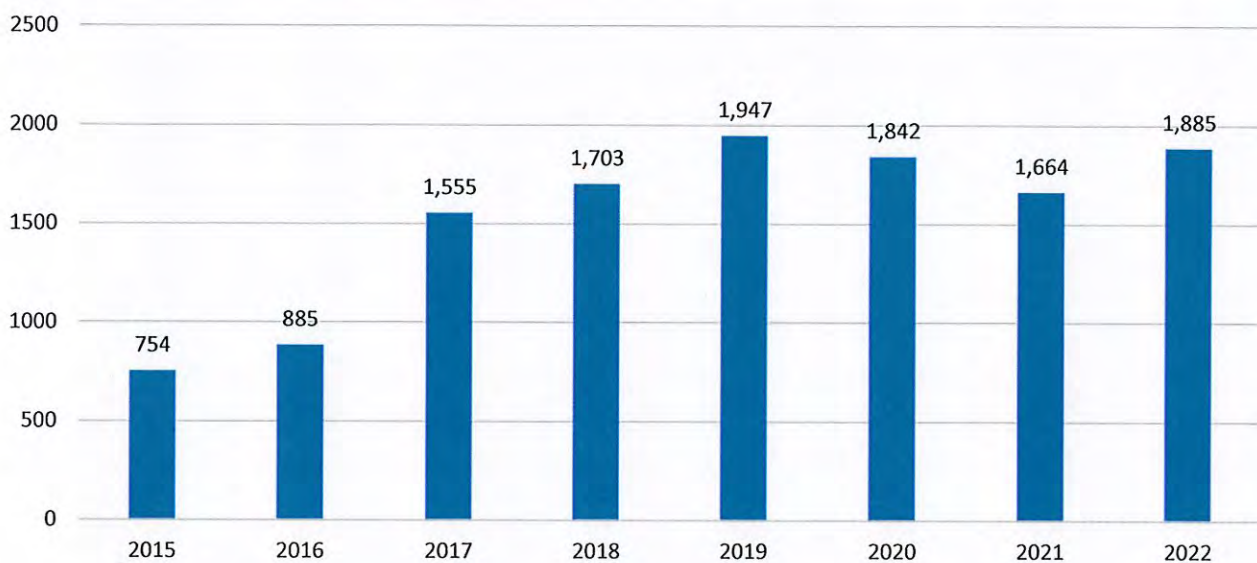
²² Here and elsewhere, average growth rates are geometric, i.e., growth that increases by a constant ratio or percentage over the timeframe.

²³ See American Intellectual Property Law Association, “2017 Report of the Economic Survey,” Appendix I-39, <https://user-35215390377.cld.bz/2017-Report-of-the-Economic-Survey/130/>.

²⁴ See World Bank, World Development Indicators, <https://databank.worldbank.org/source/world-development-indicators>.

In 2015, the USPTO began capturing the number of volunteer patent practitioners on the rosters of the regional patent pro bono programs. This number indicates the potential availability of volunteers to match with qualified applicants. The regional patent pro bono programs have reported an average 14% annual increase in the number of volunteers on their rosters who are available to volunteer (Figure 4). The number of reported rostered volunteers may not actually reflect the number of volunteers available to volunteer at any one point in time due to factors that deter volunteers from accepting placement of a qualified applicant, such as a lack of time, family commitments, or other personal obligations.²⁵

Figure 4. Rostered regional patent pro bono program volunteer patent practitioners, by year, 2015-2022



2.2.2 Factors that encourage or discourage volunteer participation (Cong. Qn. Sec. 105 (a)(2)(A)(v))

The referral services provided by the regional patent pro bono programs would not function without a stable base of volunteer patent practitioners. Therefore, it is necessary to understand what factors attract or deter patent practitioners from volunteering with a regional patent pro bono program.

²⁵ See section 2.2.2.1, Deterring participation, below.

2.2.2.1 Deterring participation

The USPTO collects limited information from the regional patent pro bono programs regarding their volunteer patent practitioners. To better understand what factors impact attorney participation, the USPTO held a patent practitioner listening session on June 7, 2023. The USPTO also accepted written comments, in response to a Federal Register Notice, via the Federal eRulemaking Portal.

During the June 7, 2023, listening session, the USPTO solicited specific feedback from patent practitioners. The practitioners identified the lack of malpractice insurance and CLE credit for pro bono service as deterrents to their participation.

To supplement information collected from the USPTO's stakeholders, the agency relied on an extensive study performed by the American Bar Association (ABA). In 2017, the ABA conducted a study of the pro bono work of America's attorneys. Approximately 47,000 attorneys from 24 states responded to the survey.²⁶ The study examined the primary factors deterring and motivating pro bono participation. The ABA findings that malpractice insurance and CLE credit are important factors in pro bono participation is consistent with the feedback the USPTO received at the June 7, 2023 listening session.

Figure 5 shows the various factors discouraging pro bono participation according to the survey.²⁷ Each factor is evaluated on a scale of 1 to 5, with 1 indicating a "not discouraging" rating and 5 being a "very discouraging" rating. The ABA survey results show, for example, that a "lack of time" was the most discouraging factor for pro bono participation, with an average rating of 4.24.²⁸ Thus, according to the ABA study, attorneys were most deterred by personal factors such as lack of time, family commitments, and lack of skills or experience.²⁹ Practical concerns, such as a lack of malpractice insurance, also gave lawyers pause when considering pro bono work. Furthermore, some attorneys preferred to assist the under-resourced in other ways, such as by providing low-fee representation or engaging in non-legal volunteer work.³⁰

One area that may be specific to IP representation is the lack of a history of or focus on IP in the pro bono space. The most common areas of law for pro bono assistance include housing, family law, benefits, veterans' issues, and consumer issues.³¹

²⁶ April Faith-Slaker, "Supporting Justice: A Report on the Pro Bono Work of America's Lawyers," ABA Standing Committee on Pro Bono and Public Service and the Center for Pro Bono, April 2018, www.americanbar.org/content/dam/aba/administrative/probono_public_service/ls_pb_supporting_justice_iv_final.pdf. Copyright 2018 American Bar Association. Reprinted by permission.

²⁷ This information was taken from "Supporting Justice," Figure 16: Discouraging Factors.

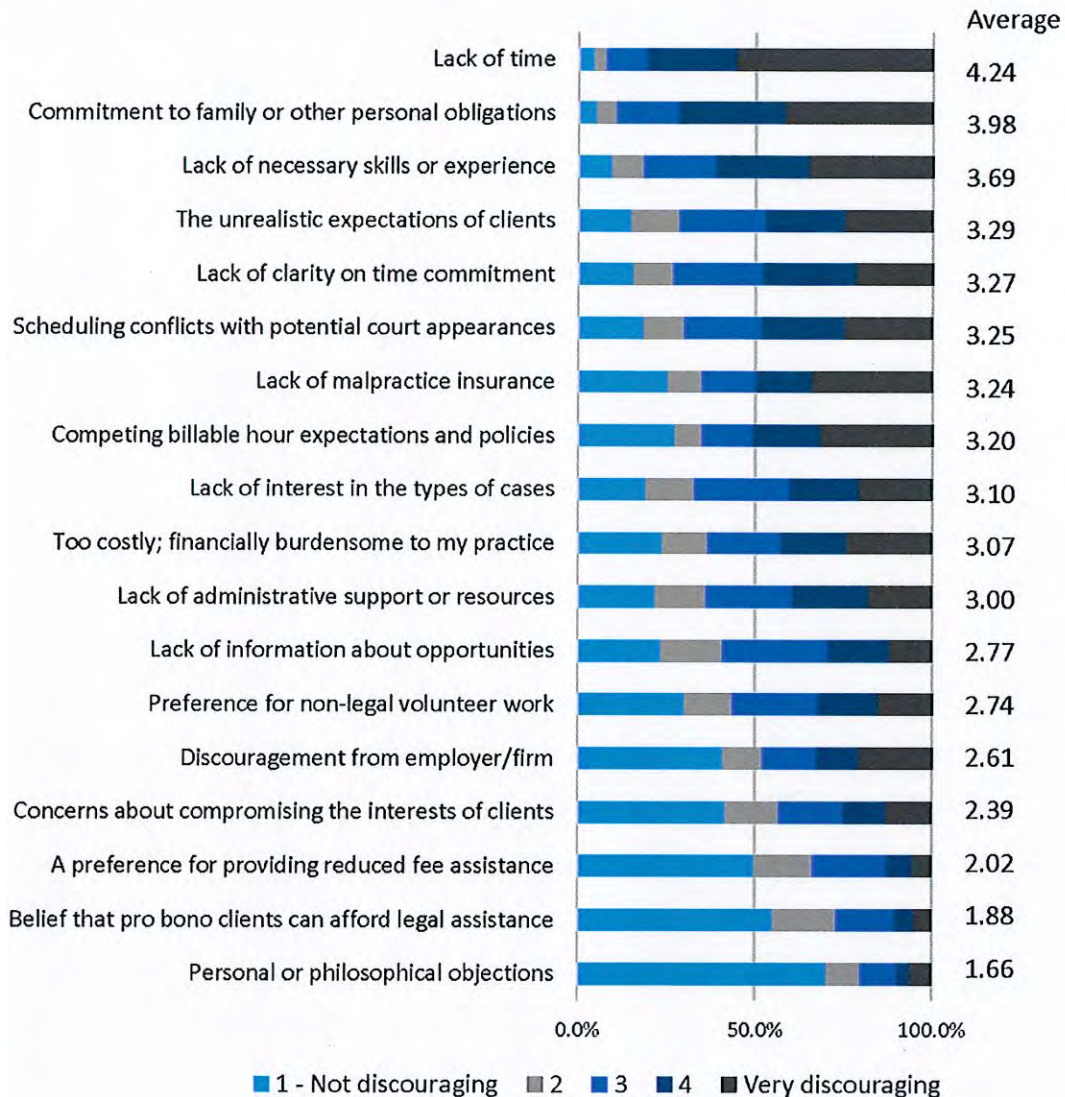
²⁸ *Id.*

²⁹ *Id.*

³⁰ *Id.*

³¹ Legal Services Corporation, "Report of the Pro Bono Task Force," 2012, www.lsc.gov/our-impact/publications/other-publications-and-reports/report-pro-bono-task-force.

Figure 5. Discouraging Factors



2.2.2.2 Encouraging pro bono service

Patent practitioners participating in the USPTO listening session identified the availability of malpractice insurance and the option to obtain CLE credit for pro bono service as factors that would increase their participation. This is consistent with the results of the ABA study. Attorneys responding to the ABA suggested a variety of methods to encourage pro bono service, including offering CLE credit, offering free CLE courses, and providing formal recognition.³²

The Patent Pro Bono Program is working to further encourage pro bono participation by providing solutions to issues surrounding formal recognition, malpractice insurance, and CLE credit.

³² *Id.* at 21.

Regarding formal recognition, the USPTO issues recognition certificates to all registered patent practitioners who contribute at least 50 hours of pro bono service through a regional patent pro bono program in a calendar year. The USPTO has issued over 500 certificates to practitioners and over 100 certificates to law firms.³³ Recipients can also choose to have their name listed on the USPTO's website for public pro bono recognition.³⁴

Regarding malpractice insurance, more than half of the regional patent pro bono programs provide some form of malpractice insurance to cover their volunteers, addressing a major factor that deters attorneys from providing pro bono assistance.³⁵ Due to the federal nature of practice in patent matters before the USPTO, attorneys concerned about obtaining malpractice insurance can choose to participate in a program that offers insurance. The PBAC has assisted, and will continue to assist, the regional programs with obtaining malpractice insurance for practitioners participating in the Patent Pro Bono Program.

The USPTO previously attempted to provide CLE recognition for pro bono service. In August 2020, the USPTO updated its regulations to provide for voluntary certification of CLE to the OED Director.³⁶ The USPTO encouraged participation in the Patent Pro Bono Program by allowing for up to two CLE credits to be earned by completing pro bono work. In October 2020, the USPTO published proposed CLE guidelines with a request for comments.³⁷ In January 2023, after considering negative public comments, the USPTO eliminated the provisions of the USPTO regulations related to the voluntary reporting of CLE.³⁸ Although the USPTO is currently unable to recognize CLE credit for pro bono participation, some volunteer practitioners obtain state CLE credit for participation in the Patent Pro Bono Program. Furthermore, the USPTO assists practitioners by regularly organizing or participating in CLE credit presentations across the country.³⁹

³³ The USPTO provides recognition certificates to law firms based on the size of the law firm and the total hours volunteered by their patent practitioners. Requirements for pro bono certificates for law firms are available at www.uspto.gov/patents/basics/using-legal-services/pro-bono/attorneys.

³⁴ The list of practitioners recognized for participation in 2022 is available at www.uspto.gov/patents/basics/using-legal-services/pro-bono/practitioner-recognition-2022.

³⁵ The following programs provide malpractice insurance: Arts and Business Council of Greater Boston, Arts and Business Council of Miami, Delaware Law School, Georgia Lawyers for the Arts, Idaho Patent Pro Bono Program, LegalCORPS, Louisiana Invents, New York Volunteer Lawyers for the Arts, Ohio Invents, PatentConnect, Texas Accountants and Lawyers for the Arts, and Volunteer Lawyers of Birmingham. See Appendix E.

³⁶ Setting and Adjusting Patent Fees During Fiscal Year 2020, 85 FR 46932 (August 3, 2020).

³⁷ Proposed Continuing Legal Education Guidelines, 85 FR 64128 (October 9, 2020).

³⁸ Final Rule Eliminating Continuing Legal Education Credit Certification and Recognition for Patent Practitioners, 88 FR 4906 (January 26, 2023).

³⁹ A listing of OED speaking engagements is available at www.uspto.gov/about-us/organizational-offices/office-general-counsel/office-enrollment-and-discipline/speaking.

Research suggests that participation in pro bono service during law school leads to increased pro bono work after graduation.⁴⁰ To facilitate pro bono service during law school, the USPTO operates the Law School Clinic Certification Program.⁴¹ There are more than 60 participating law schools providing pro bono legal services to the public. There are more than 40 clinics that participate in the patent portion of the Program. Between FY 2009 and June 2023, 1,643 patent applications were filed through the Law School Clinic Certification Program. Students participating in the Law School Clinic Certification Program may be more likely to participate in the Patent Pro Bono Program after graduation; they are also more likely to have the necessary skills and experience to assist under-resourced inventors in the future.⁴²

Pro bono work in the IP realm is a social investment in America's innovation system. By continuing to highlight the Patent Pro Bono Program through presentations and events, the USPTO can emphasize the value of pro bono patent services and encourage practitioner participation.⁴³

2.2.3 Expansion of Program to non-attorney advocates (Cong. Qn. Sec. 105 (a)(2)(A)(vi))

As the demand for free patent prosecution assistance will often outpace the supply of volunteers, it is important to find additional volunteers to fill the demand gap. The inclusion of non-attorney advocates may help address this imbalance. The USPTO has defined the phrase "non-attorney advocates" to mean non-attorney assistance. We have interpreted "non-attorney advocates" in this manner to capture non-attorney practitioners, or agents, who offer their prosecution services to applicants. In addition, non-attorneys may provide other services such as drafting services, paralegal support, prior art searches, etc. With the exception of patent agents, non-attorney assistants may not practice law before the USPTO. (Congressional Question Sec. 105 (a)(2)(A)(vi)).

⁴⁰ Faith-Slaker, *supra* n. 26, at 27.

⁴¹ The USPTO delivered a report on the Law School Clinic Certification Program to Congress on December 14, 2016. The report is available in Appendix F.

⁴² Additional information on the USPTO's Law School Clinic Certification Program is available in Appendix G.

⁴³ The USPTO held several such events this year, including the Pathways to Inclusive Innovation programs on March 9, 2023, in Minneapolis, Minnesota, and on October 11, 2023, in Alexandria, Virginia.

2.2.3.1 Background on patent agents

A patent agent is a non-attorney practitioner (who fulfills the USPTO requirements) registered to practice before the USPTO in the preparation and prosecution of patent applications pursuant to 37 C.F.R. §§ 11.5 and 11.6(b).

Congress has long recognized the important role and function of patent agents “[t]o promote the progress of science and useful arts, by securing for limited times to . . . inventors the exclusive right to their respective . . . discoveries.”⁴⁴ Competent prosecution of a patent application requires detailed knowledge and expertise in specialized technical and scientific fields.

37 C.F.R. §§ 11.6(b) and 11.7(a)(2) recognize and authorize non-attorney individuals who fulfill the scientific/technical and good moral character and reputation requirements to be registered as patent agents.

As patent agents, they are authorized to engage in the patent-related activities outlined in 37 C.F.R. § 11.5(b)(1):

preparing or prosecuting any patent application; consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office; drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the Office regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent Trial and Appeal Board, or other proceeding.

The USPTO is not alone in authorizing the practice of law by non-attorneys. The State of Washington provides a reasonable and effective model for non-lawyer specialists. In 2012, the Washington Supreme Court paved the way for this model as a means of providing affordable legal services by authorizing Limited License Legal Technicians (LLLTs) to practice family law only. LLLTs operate independently without the supervision of an attorney but, like patent agents, are limited in area and scope of practice, i.e., they cannot litigate or represent individuals in court or engage in negotiations.⁴⁵ Utah and Arizona operate similar programs.⁴⁶

The motivations of these states include declines in law school enrollment, lawyer attrition rates and maturing populations, a lack of accessible pro bono patent services in some locales, and the inability of clients to pay for expensive legal services. These realities, among others, led to a shift in the assessment of the legal landscape as to the availability and delivery of much-needed but scarce legal services.

⁴⁴ U.S. Const. art I, § 8, cl. 8; 35 U.S.C. 2(b)(2)(D).

⁴⁵ In June 2020, the Washington Supreme Court decided to sunset the LLLT program. The award of new licenses ended in July 2023. *In the Matter of Suggested Amendments to APR*, Order No. 25700-A-1361, Wash. Sup. Ct. (July 1, 2021).

⁴⁶ See Arizona Codes of Judicial Administration § 7-208; Rules Governing the Utah State Bar, R. 14-802.

2.2.3.2 Data on patent agent support

The OED captures the registration information of practitioners that practice before the USPTO. Recent data found that approximately 27% of registered practitioners are patent agents and 73% are patent attorneys.⁴⁷ There is some intrinsic error in these percentages because some practitioner agents subsequently obtain law licenses and fail to update their information with the OED. Similarly, attorneys who allow their licenses to lapse in the relevant jurisdiction may fail to change their status to patent agent.⁴⁸ While not exact, these percentages tend to be generally representative of the breakdown of patent agents and patent attorneys authorized to practice before the USPTO. Using these percentages as a benchmark will allow the USPTO to compare the composition of volunteers in the patent pro bono program to that of volunteers in the patent bar.

The USPTO does not collect specific information regarding volunteer patent practitioners who participate through the regional patent pro bono programs.⁴⁹ While the regional programs collect personally identifiable information from their volunteers, they only report aggregate metrics to the USPTO regarding the volunteers, i.e., the number of volunteers, the number of volunteer hours donated, etc. Therefore, the USPTO devised a derivative method to obtain a breakdown of patent attorney and patent agent volunteers.

In 2017, the USPTO started collecting patent pro bono application filing information using the PTO/AIA/440 form,⁵⁰ which allows volunteers to voluntarily certify their representation as pro bono by including it in their patent application filings. The USPTO is able to search its patent application database for the PTO/AIA/440 form to identify the particular volunteer patent practitioner associated with each application and cross-reference the practitioner's registration number with their agent or attorney status in the OED roster. The form was included in 581 patent applications through December 31, 2022. Of these, 23% were filed by patent agents, and 77% were filed by patent attorneys.

⁴⁷ See <https://oedci.uspto.gov/OEDCI> (last accessed 5/25/2023).

⁴⁸ To address this issue, the USPTO published a notice of proposed rulemaking proposing to remove a fee required when changing one's status from a patent agent to a patent attorney in order to encourage more practitioners to update their status. See Changes to the Representation of Others Before the United States Patent and Trademark Office, 87 FR 54930 (September 8, 2022).

⁴⁹ The USPTO does capture the names of volunteer patent practitioners who provide at least 50 hours of service to the regional patent pro bono programs for recognition.

⁵⁰ See www.uspto.gov/sites/default/files/documents/aia0440.pdf.

2.2.3.3 Increasing patent agent participation

Ideally, the patent pro bono program would like to have the support of patent practitioners, i.e., patent attorneys and patent agents, consistent with the percentages on the OED roster. Based on filing information using PTO/AIA/440, it appears that the Patent Pro Bono Program can increase the participation of patent agents to better align with the overall registration reported to the OED. To address the shortfall, the USPTO has presented information on the Patent Pro Bono Program at the 2022 Annual Conference of the National Association of Patent Practitioners (NAPP). NAPP is a 501(c)(6) nonprofit trade association with hundreds of member patent practitioners throughout the United States, split almost evenly between patent agents and patent attorneys. Presenting information on the Patent Pro Bono Program to NAPP raises awareness among its members and encourages patent agent participation. Having even more patent agents volunteer would increase the number of practitioners available for pro bono applicants.

2.2.4 Non-attorney assistance

The PBAC has undertaken an ambitious effort to foster collaboration between non-attorney resources and patent-seeking inventors. These partnerships will significantly contribute to the mission of leveling the playing field and ensuring equal access to patent protection for all inventors, regardless of their financial resources.

The PBAC has taken significant steps to foster partnerships with patent search service providers to offer discounted patent search services. This initiative aims to improve access to patent-related resources, enhance the quality of patent applications, and contribute to fostering innovation among inventors who face financial barriers.

The PBAC was established to address the challenges faced by inventors with limited financial means who seek to protect their IP through the patent system. Recognizing the importance of equitable access to patent services, the PBAC has sought out collaborations with non-attorney resources to complement existing pro bono legal services and bridge the gap for under-resourced inventors. The primary goal of this initiative is to facilitate the patent process for these inventors, empowering them to protect their IP and fostering innovation across all sectors of the economy. By collaborating with non-attorney resources, the PBAC seeks to minimize barriers to patenting, increase inclusivity in the innovation landscape, and promote the growth of small businesses and individual inventors.

As an example of this initiative, the PBAC has established a strategic partnership with cutting-edge patent search service providers, to offer their services at a steeply discounted cost for under-resourced inventors. These providers utilize advanced artificial intelligence technology to conduct comprehensive patent searches, including a comprehensive analysis of prior art, thereby enabling inventors to assess the novelty and patentability of their innovations, and leading to stronger and more enforceable patents.

Benefits of the partnership:

- *Affordability*: Through this collaboration, under-resourced inventors can access the patent search service providers at a substantially lower cost, which significantly reduces their financial burden and ensures that financial constraints do not hinder their ability to conduct thorough patent searches.
- *Enhanced Quality of Patent Applications*: By using the patent search service providers' sophisticated patent search technology, inventors can identify existing patents and prior art more effectively. This, in turn, helps improve the quality of their patent applications, increasing the likelihood of successful patent grants.
- *Timely and Efficient Processes*: The integration of search capabilities powered by artificial intelligence streamlines the patent search process, reducing the time required to identify relevant prior art. This expedites the overall patent application process, benefiting inventors and their pro bono attorneys with faster responses and decision-making. The patent search service providers have promised to deliver search results within 24 to 48 hours.
- *Empowerment and Inclusivity*: By actively seeking partnerships with non-attorney resources, the PBAC demonstrates its commitment to empowering underprivileged inventors, promoting inclusivity, and supporting diversity in the innovation ecosystem.
- *Expanded Reach of Pro Bono Services*: By collaborating with patent search service providers, the PBAC can extend its reach and impact, supporting a greater number of under-resourced inventors nationwide. This aligns with the USPTO's mission to foster innovation and equitable access to the patent system.

The collaboration between the PBAC and non-attorney service providers represents a significant step toward enhancing access to patent services for under-resourced inventors. By offering discounted patent search services, the partnership aims to improve the quality of patent applications and ultimately foster innovation across the nation. The success of this initiative further underscores the importance of proactive engagement with non-attorney entities to create a more inclusive and supportive patent ecosystem.

2.3 Detailing participation in the patent pro bono programs

The legislative history of the AIA underscores the importance of the Program to support under-resourced inventors and small businesses. In June 2011, the House Committee on the Judiciary issued a favorable report on H.R. 1249, which provided that the Director of the USPTO would “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.”⁵¹ The committee report identified “the importance of individuals and small businesses to the patent system and our national culture of innovation” as the motivation of Congress.⁵² By September 2011, H.R. 1249 had passed both chambers by large bipartisan margins and was enacted as the AIA.⁵³

To fulfill the legislative intent of Congress, the Patent Pro Bono Program seeks to enhance access to the patent system, ensuring that inventors from all backgrounds have a fair chance to protect their IP and contribute to innovation. Recognizing the financial hurdles often associated with patent applications, the USPTO established this Program to provide crucial assistance to inventors who might otherwise face significant barriers. Recently, the USPTO Pro Bono Program began collecting the demographic information of patent pro bono program applicants to ascertain the Program’s impact on inclusivity and equitable access to patent services.

2.3.1 Annual inventor participation and location information

Since 2015, when the USPTO began collecting information on the Patent Pro Bono Program, the number of individuals inquiring about the Program has grown, and steadily so in the past few years. This upward trend is likely in response to the USPTO’s efforts to promote the Program and increase recognition of its value. By connecting applicants with experienced patent practitioners, the Program fosters collaboration, knowledge sharing, and guidance, ultimately leading to more successful patent applications. Figure 6 illustrates data on the regional patent pro bono programs’ number of inquiries from the public seeking information on the Patent Pro Bono Program. The data represent the submission of applicant intake forms, phone and email inquiries, and attendance at events hosted by

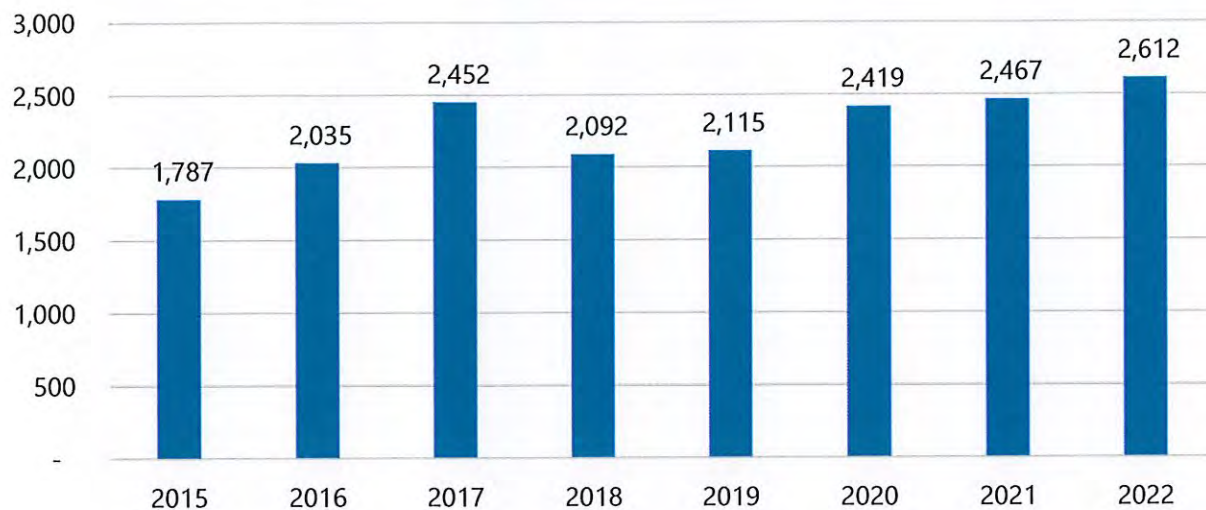
⁵¹ H.R. REP. NO. 112-98, at 38 (2011) (reproducing § 29 of the Act, later enacted as § 32).

⁵² *Id.* at 56.

⁵³ First introduced in the Senate as S. 23, the AIA passed the Senate on March 8, 2011, by a vote of 95-5. See www.congress.gov/bill/112th-congress/senate-bill/23/all-actions. The bill passed the House with amendment on June 23, 2011, by a vote of 304-117 as H.R. 1249. The amended bill passed the Senate on September 8, 2011, by a vote of 89-9 and was signed into law on September 16, 2011. See www.congress.gov/bill/112th-congress/house-bill/1249/all-actions. See also, Jennifer M. McDowell et. al., “The USPTO Patent Pro Bono Program,” 7 *Cybaris* 7, no. 1, 7-8 (2015).

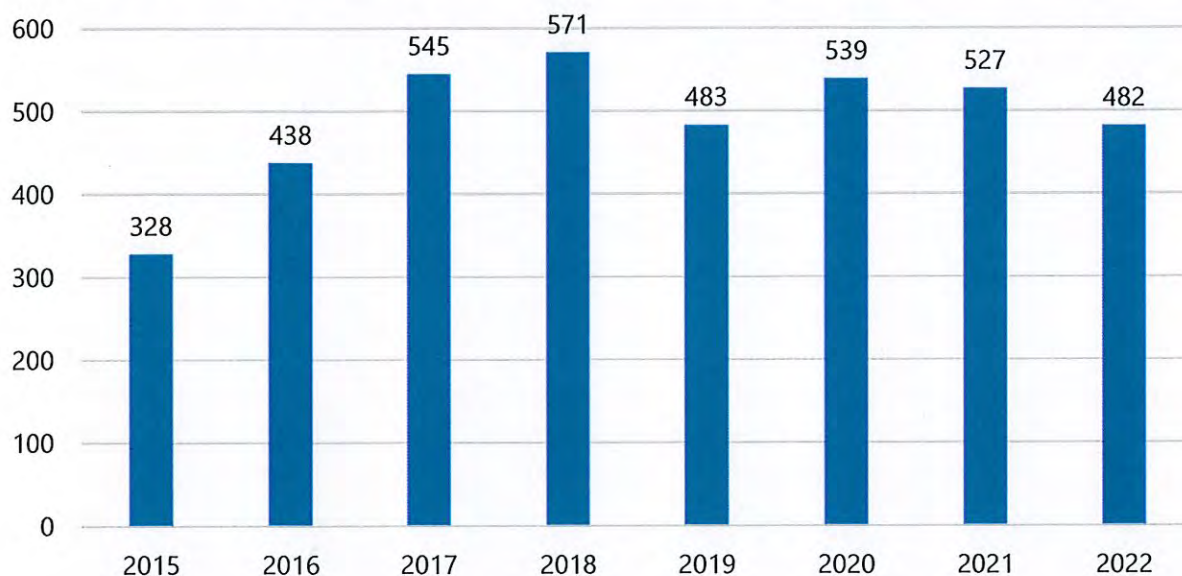
regional patent pro bono programs regarding the Patent Pro Bono Program. The number of inquiries from 2015-2022 increased by an average rate of 6% per year.

Figure 6. Inquiries made to the patent pro bono programs, by year, 2015-2022



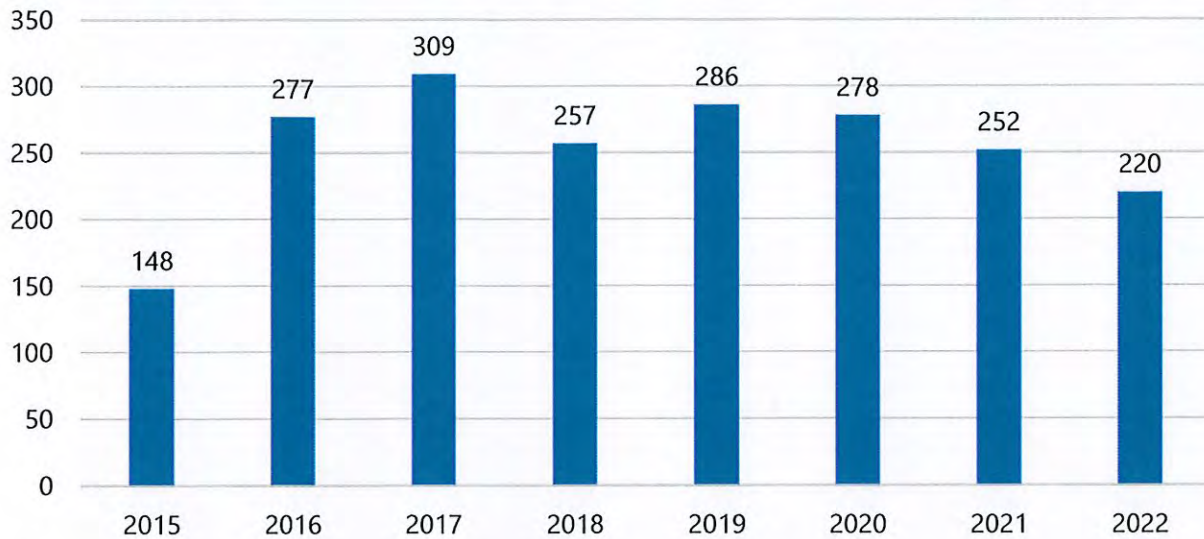
An essential metric demonstrating the Program’s efficacy is the number of applicants matched, since this metric indicates direct legal assistance provided to inventors. Matched applicants are a more important metric than, for example, the number of applications filed, since some matched applicants may not file a patent application. For example, after consulting with a patent practitioner, an inventor may determine that they are not ready to file an application or that pursuing patent protection is not in their best interest. The consultations with applicants also help ensure that the applications that are ultimately filed with the USPTO have a higher probability of resulting in a patent. Figure 7 reflects annual data from the regional patent pro bono programs capturing the number of matches between volunteer patent practitioners and approved applicants. These programs report over 3,900 matches, growing from 2015-2022 by 6% per annum on average.

Figure 7. Regional program applicant matches with volunteer patent practitioners, by year, 2015-2022



Ideally, matches between volunteer patent practitioners and under-resourced inventors result in applications filed with the USPTO. Since 2015, the regional patent pro bono programs have reported more than 2,000 applications filed through the Program. These are applications for inventions that might not have otherwise been filed with the USPTO. These applications encompass a wide range of innovative ideas, contributing to the advancement of various industries and promoting economic growth. By removing financial obstacles, the Program empowers inventors who may have otherwise been unable to protect their IP rights, encouraging creativity and stimulating entrepreneurial endeavors. Figure 8 below shows the annual breakdown of applications filed with the USPTO as reported by the regional patent pro bono programs. During the period represented, there were 253 applications per year on average, growing annually at 6% since 2015.

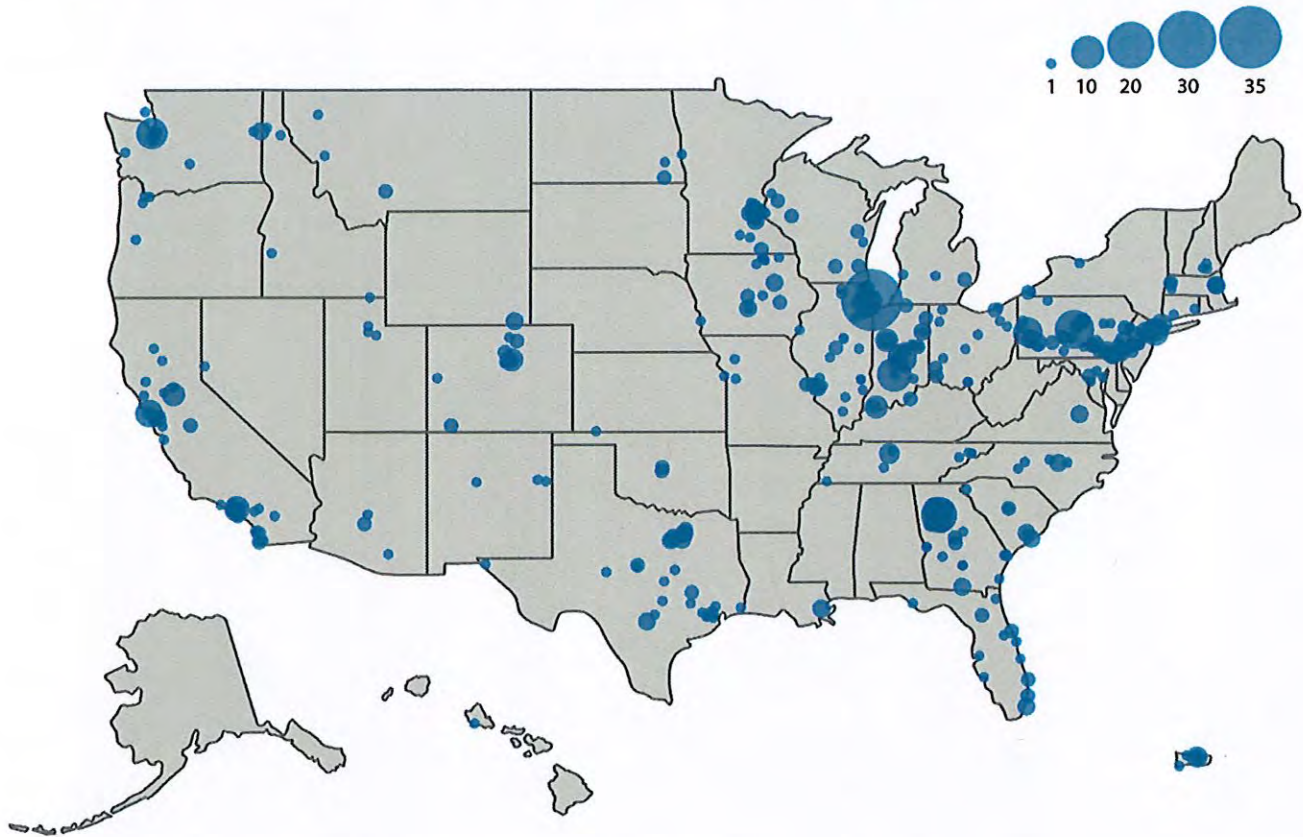
Figure 8. USPTO application filings (provisional, non-provisional, and design), by year, 2015-2022



As mentioned above, the USPTO started collecting patent pro bono application filing information in 2017 using the PTO/AIA/440 form, which allows volunteers to voluntarily certify their representation as pro bono by including it in their patent application filings. The USPTO is then able to search its patent application database for the PTO/AIA/440 form to identify the city and state for the inventor or inventors associated with each application. The 622 unique applications that included the PTO/AIA/440 form were associated with 744 U.S. inventors.⁵⁴ While the 622 unique applications do not represent all the applications filed under the Patent Pro Bono Program, the heat map below provides a location distribution for those patent application filers who included the pro bono certification form in their application.

⁵⁴ The data for the PTO/AIA/440 form for inventor city and state location was collected through June 18, 2023.

Figure 9. Inventors certifying patent pro bono representation, totals from January 2017-May 2023



2.3.2 Demographics of inventor participation

While the number of inventor inquiries, the number of matches, and the location of inventors are indicators of the Program's overall effectiveness, it is also crucial to consider the demographic information submitted by individuals benefiting from the Patent Pro Bono Program. In recognition of the importance of inclusivity, the USPTO started collecting voluntary demographic data from the regional patent pro bono programs in 2021. This expanded data collection enables a more comprehensive understanding of the Program's reach and effectiveness, thereby allowing for the identification of any disparities in participation. With this information, targeted efforts can be undertaken to ensure that individuals from under-represented groups participate.

2.3.2.1 Gender diversity in the patent pro bono programs

Starting in January 2021, regional patent pro bono programs began reporting metrics on applicant demographics.⁵⁵ The information provided below represents self-reported demographic information during the 2021 and 2022 calendar years (Table 1). In some instances, applicants may have chosen not to respond to the regional programs' survey on demographics or may have chosen to respond with "do not specify" to specific questions within a survey. In total, 81% of respondents self-reported their gender over the two years.

Table 1: Gender responses from regional patent pro bono program applicant surveys, 2021-2022

YEAR	MALE	FEMALE	DID NOT SPECIFY
2021	785	549	386
2022	816	611	264
2021-2022 change	4%	11%	-32%

Table 1 shows that the number of applicants who chose to specify their gender increased 7%, from 1,334 in 2021 to 1,427 in 2022. While a majority of those applicants are men, the number of women applicants increased more than the number of men over the two years. Notably, the number of applicants who did not specify their gender decreased substantially.

The Patent Pro Bono Program data show high participation rates by women applicants (Table 1). Of those responding, women applicants accounted for a 41% share in 2021 and a 43% share in 2022. Two touchstones for comparison are the gender balance of the U.S. population and that of the patenting population. U.S. Census data show the population in 2020 included slightly more women; 49.5% identified as "Male" and 50.5% identified as "Female."⁵⁶ USPTO estimates show the inventive population in 2019 included more men; about 13% of all resident inventor-patentees were women.⁵⁷ Thus, for those individuals who elected to indicate their gender as female on their applications for assistance through the regional patent pro bono programs, they were doing so at rates near the population average and three times higher than the U.S. resident inventor-patentee population statistic.

⁵⁵ Some regional patent pro bono programs collected demographic information prior to January 2021, but the USPTO began collecting demographic information from all the regional patent pro bono programs in January 2021.

⁵⁶ See www.census.gov/quickfacts/fact/table/US/SEX255221.

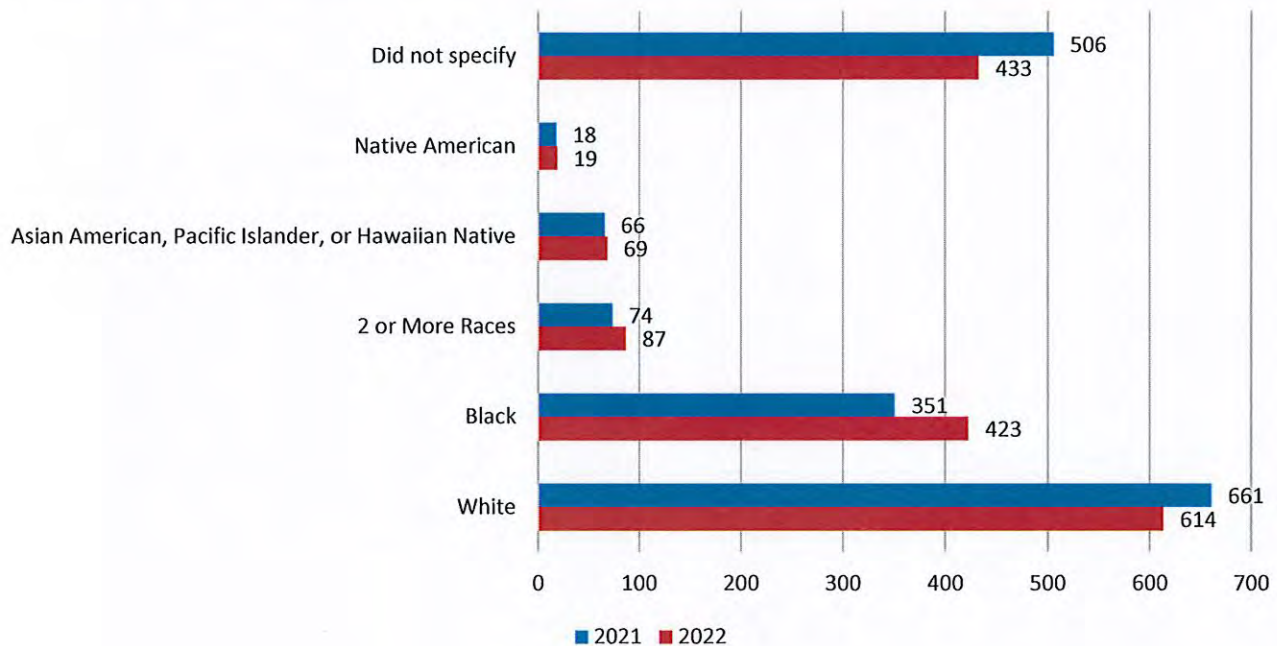
⁵⁷ See USPTO Office of the Chief Economist, "Progress and Potential," www.uspto.gov/sites/default/files/documents/OCE-DH-Progress-Potential-2020.pdf.

2.3.2.2 Racial demographics of patent pro bono program applicants

Figure 10 illustrates the racial demographic responses from the regional patent pro bono program survey. Similar to the gender responses, it shows an increasing share of respondents willing to offer their race to the regional patent pro bono programs in 2022 relative to 2021. In 2021, 506 respondents, or 30% of all respondents, chose not to provide the USPTO their race. In 2022, that share had dropped to 26%.

In addition to more self-reported race responses in 2022, we also see higher applications from all except white applicants, who saw a dip from 661 applications in 2021 to 614 in 2022. As shown in Table 2, the under-represented groups of those who identify as Black; Native American; Asian American, Pacific Islander, or Hawaiian Native; or mixed races are being served by the Patent Pro Bono Program near or above their existing proportions in the U.S. population.⁵⁸

Figure 10. Racial demographic responses to the regional patent pro bono program surveys, 2021-2022



⁵⁸ The percentage of the participation of those who identify as Asian American, Pacific Islander, or Hawaiian Native is slightly below that identified in the 2020 U.S. Census Data.

Table 2: Demographic responses to the regional patent pro bono program surveys relative to U.S. Census Data, 2021-2022

YEAR	BLACK	NATIVE AMERICAN	WHITE	ASIAN AMERICAN, PACIFIC ISLANDER, OR HAWAIIAN NATIVE	2 OR MORE OR "OTHER RACE"
2021	30%	1.5%	56.5%	5.6%	6.3%
2022	35%	1.6%	50.5%	5.7%	7.2%
2020 U.S. Census Data ⁵⁹	13.6%	1.3%	75.5%	6.1%	3.0%

Table 3: Ethnicity responses to the regional patent pro bono program surveys, 2021-2022

YEAR	HISPANIC	NOT HISPANIC	DID NOT SPECIFY	% REPORTED HISPANIC
2021	116	702	573	14.2%
2022	132	828	467	13.8%
2021-2022 change	14%	18%	-18%	

A large percentage of applicants chose not to specify their ethnicity, as represented in Table 3, indicating a high degree of uncertainty in these data. If the data are representative, it would appear to indicate that the Patent Pro Bono Program could provide greater outreach and promotion to Hispanic communities. Three of the regional patent pro bono programs—Mi Casa Resource Center’s ProBoPat in Denver, Colorado; Texas Accountants and Lawyers for the Arts in Austin, Texas; and the Arts and Business Council of Miami’s Patent Pro Bono FL, in Miami, Florida—have large Hispanic communities in their regions. The USPTO is coordinating with the programs to help drive further inclusion of Hispanic innovators.

2.3.2.3 Veteran status of Patent Pro Bono Program applicants

The regional patent pro bono programs allow applicants to indicate whether they are a veteran. Unlike the request for gender, race, and ethnicity information, there is no option for the applicant to “prefer not to specify” their veteran status.

⁵⁹ See www.census.gov/quickfacts/fact/table/US/PST045222, July 1, 2022 (V2022).

Table 4: Veteran status responses to the regional patent pro bono program surveys, 2021-2022

YEAR	APPLICANTS	INDICATED VETERAN STATUS	% INDICATING VETERAN STATUS
2021	1,752	116	6.6%
2022	1,847	145	7.9%
2021-2022 change	5%	25%	

The 7.9% of applicants indicating veteran status in 2022 was above the 5.2% of the total U.S. population who reported being a veteran in the 2020 U.S. Census.⁶⁰

2.3.3 Summary of inventor participation in the Patent Pro Bono Program

The Patent Pro Bono Program serves as a vital mechanism for enhancing access to the patent system for inventors of all backgrounds. By enabling inventors to overcome financial barriers, the Program promotes inclusivity and fosters innovation. The recent collection of demographic information by the USPTO underscores its commitment to equitable access, ensuring that inventors from diverse backgrounds have the necessary resources to protect their IP and contribute to the advancement of society. Through the Patent Pro Bono Program, the USPTO drives progress and encourages inventors to shape the future.

2.4 Increasing inventor awareness (Cong. Qn. Sec. 105 (a)(2)(A)(iv))

To achieve the overall participation numbers above, the USPTO initiated a vigorous promotion campaign to inform the public about the Patent Pro Bono Program. The USPTO held a listening session on June 5, 2023, to solicit feedback regarding whether inventors are aware of the regional patent pro bono programs.⁶¹ Over 100 attendees took part in the listening session, either in person or online. The USPTO also solicited written comments from the public via the Federal eRulemaking Portal.⁶² During the listening session, commenters highlighted the importance of the public promotion of the Program. One written commenter, Kathleen Lynch, expressed her concern that “many entrepreneurs and small business owners who otherwise might qualify for the Program do not know about it.” To further increase awareness, the USPTO is heavily promoting the Patent Pro Bono Program to both inventors and patent practitioners, as it is critical to have an adequate number of volunteers available to be matched.

⁶⁰ See www.census.gov/quickfacts/fact/table/US/PST045222 (The USPTO used the Census’s five-year estimate for the number of veterans, 17,431,290, which is 5.2% of the total population of 333,287,557, the population estimate as of July 1, 2022).

⁶¹ A transcript of the June 5, 2023, inventor listening session is available in Appendix H.

⁶² Comments are available at www.regulations.gov/docket/PTO-C-2023-0009/comments.

2.4.1 Inventor outreach

The USPTO, the USPTO Regional Offices, the PBAC, and the regional patent pro bono programs perform significant outreach to inventors, entrepreneurs, and small businesses.

2.4.1.1 Webpage and plain language

The USPTO is making significant efforts to enhance the visibility of its Patent Pro Bono Program through an updated webpage aimed at improving search engine optimization (SEO). The USPTO is employing various SEO best practices to ensure the Program is more readily discoverable by the public. The webpage's content is being updated with relevant keywords and plain language, enabling search engines and the public to better understand and index the information. Additionally, the USPTO is optimizing the page's structure and metadata, making it more appealing to search engine algorithms. These changes are designed to increase engagement and reduce bounce rates, thereby improving the webpage's search ranking.

Using Google Analytics, the USPTO tracks unique page views for the Patent Pro Bono Program. From October 1-December 31, 2022, Google Analytics indicated 14,064 unique page views of the USPTO Patent Pro Bono Program's landing page.⁶³ After implementation of the changes, for the period from July 1-September 30, 2023, Google Analytics indicated 16,105 unique page views, or an increase of 14%.

By leveraging the power of the internet and adopting these SEO strategies, the USPTO is paving the way for a more accessible and widely known Patent Pro Bono Program, thereby fostering greater innovation and inclusivity in the IP ecosystem.

2.4.1.2 Events/training

The USPTO Patent Pro Bono Program plans and executes Pathways to Inclusive Innovation events for inventors and entrepreneurs. The events are planned quarterly across the country and welcome inventors who are interested in learning more about protecting IP, securing funding, and developing a network. The events heavily promote the free services offered through the regional patent pro bono programs. Pathways events are conducted in coordination with the PBAC and the Small Business Administration.⁶⁴ The USPTO also works with other federal agencies at Pathways events, such as NASA and the Federal Laboratory Consortium, to promote resources they have available for inventors and entrepreneurs.

⁶³ Fourth quarter calendar year 2022 unique webpage data was used as a baseline because the USPTO heavily promoted a Pathways to Inclusive Innovation event that took place on March 9, 2023, and public listening sessions that took place on June 5 and 7, 2023, which increased traffic to the Patent Pro Bono Program webpage during the first and second quarters of calendar year 2023. The fourth quarter calendar year 2022 data represents traffic to the webpage without any additional promotion.

⁶⁴ The first Pathways to Inclusive Innovation event was held in Minneapolis, Minnesota, on March 9, 2023.

To educate inventors and highlight resources like the Patent Pro Bono Program, the USPTO also hosts a variety of stakeholder programs, such as a three-day Stakeholder Training on Examination Practice and Procedure for inventors. In addition, the USPTO hosts Stakeholder Offerings and Resources courses featuring recent training delivered to experienced USPTO examiners. These training events are free and open to the public. Similarly, the USPTO offers a Stakeholder Application Readiness Training workshop that focuses on helping the public learn the fundamentals of the patent application process. Each of these programs provides the public with information on the Patent Pro Bono Program.

The USPTO Regional Offices in Michigan, Texas, Colorado, and California, and the Eastern Regional Outreach Office at headquarters in Virginia heavily promote the Patent Pro Bono Program through their outreach activities targeting financially under-resourced inventors or small business owners who are interested in securing patent rights. Many of the outreach activities involve collaborations with the Small Business Administration (SBA) and SBA's Small Business Development Centers to promote USPTO resources such as the Patent Pro Bono Program. Outreach activities also extend to coordination with SBA's Small Business Innovation Research (SBIR) and Small Business Technology Transfer (STTR) programs through participation in SBA's annual SBIR/STTR Road Tour, a national outreach effort that connects innovators and entrepreneurs with Federal agency procurement and research program personnel through a multi-day bus tour around the country.

Through collaborations with a variety of organizations focused on certain groups, such as military or Spanish-speaking communities, the Regional Offices' outreach activities and programs directly promote USPTO resources to targeted communities to expand American innovation to all. Audience-tailored presentations to K-12 schools, colleges, and universities, including Historically Black Colleges and Universities, also highlight IP education and related resources through many virtual, hybrid, and in-person events. Furthermore, outreach programs often involve collaborations with local bar associations on pro bono tours and workshops to reach those in underserved and under-represented areas to provide educational sessions on patents, trademarks, copyrights, and trade secrets, along with technology-specific breakout sessions and one-on-one consultations.

2.4.1.3 Welcome letter initiative

As part of our commitment to expanding the innovation ecosystem and providing timely and valuable resources to those beginning their IP journey, the USPTO is now providing official "welcome letters" to applicants to help them more quickly and easily navigate the patent and trademark application processes and to connect them with relevant resources.

The USPTO started issuing welcome letters in 2023. The letters are sent, either electronically or by postal mail, with a filing receipt in newly filed patent and trademark applications. The letters for both patent and trademark applicants highlight free resources, such as the Patent Pro Bono Program.

2.4.1.4 Additional work by the USPTO Director

In addition to the welcome letters, since April 2022 the Director of the USPTO has also engaged the community by seeking out opportunities to speak to inventors and would-be inventors; by launching the Women's Entrepreneurship (WE) initiative with Gina Raimondo, Secretary of Commerce; and by creating a monthly email newsletter for inventors. The Director has also engaged the military community by facilitating Entrepreneurship Essentials programs on military installations in the U.S. and abroad. Through all these initiatives, the Director regularly and consistently highlights pro bono offerings. She also worked with USPTO staff to create a colorful and informative postcard on pro bono services that the USPTO regularly distributes at conferences and USPTO information booths at IP events.

2.4.1.5 Regional patent pro bono programs

The regional patent pro bono programs also conduct inventor outreach. They promote the resource to their local region by advertising via websites, attending local inventor conferences, and hosting "brief advice clinics," where volunteer patent practitioners meet with inventors to provide information on IP and answer questions.

2.4.1.6 Conclusion

The efforts outlined above are paying dividends. In the first quarter of calendar year 2023, there was a 45% year-over-year increase in the number of applicants requesting services, suggesting that the outreach has been effective. In addition, there was a 14% year-over-year increase in patent practitioners agreeing to accept cases.

2.5 Previewing inventor requirements for participation (Cong. Qn. Sec. 105 (a)(2)(A)(iii))

The USPTO raises public awareness about the Patent Pro Bono Program, but interested inventors must take the initiative and apply to the regional patent pro bono programs to obtain free assistance. The regional patent pro bono programs screen applicants to ascertain the readiness of an individual to obtain free patent prosecution assistance. The USPTO studied the impact of these screening requirements for individuals seeking assistance through the regional patent pro bono programs. This section investigates whether any of the participation requirements serve as a deterrent for prospective participants.

2.5.1 Background

Each regional patent pro bono program sets forth specific requirements for participation. The requirements are determined by regional patent pro bono programs in conference with board/steering committee members, taking into consideration community input from external stakeholders. In addition, the USPTO provides guidelines for participation that the regional programs can consider; however, the leaders of the regional programs set the specific requirements for each program.

The USPTO developed guidelines for participation in the Patent Pro Bono Program in consultation with the America Invents Act Pro Bono Task Force (Pro Bono Task Force, a forerunner to the PBAC),

pursuant to section 32 of the AIA.⁶⁵ The Pro Bono Task Force included IP thought leaders in academia, private and corporate practice, and the U.S. Court of Appeals for the Federal Circuit.⁶⁶ The Pro Bono Task Force applied its members' broad experience in the legal profession in the provision of pro bono service, along with the practical experience of having observed the LegalCORPS Minnesota Pilot Program in 2011. LegalCORPS, a nonprofit organization that provides free assistance in non-litigation business law matters to low-income small business owners, small nonprofit organizations, and low-income innovators in Minnesota through the services of volunteer lawyers, expanded its services under the Minnesota Pilot Program to include providing patent pro bono referral services. The Pro Bono Task Force adopted its findings in the best practices handbook, which set forth the rationale for the requirements for participation.⁶⁷ This was done with the understanding that these best practices would later inform the establishment of similar programs around the country.

In general, the regional patent pro bono programs have adopted the following guidelines for participation: (1) the applicant must have a household income of less than three times the federal poverty level,⁶⁸ (2) the applicant must demonstrate knowledge of the patent system through the filing of a provisional patent application or the completion of a training course, and (3) the applicant must be able to describe the invention and how it works.

In addition to meeting financial, knowledge, and invention requirements, many regional patent pro bono programs have expanded these basic requirements to satisfy organizational needs and increase the likelihood of a successful outcome. Some additional requirements for participation set forth by the regional patent pro bono programs include: an administration fee, state residency requirements, a payment method for USPTO fees, a prior art search, a meeting with a program administrator, and a meeting with a patent practitioner to review and approve an invention for placement. The regional patent pro bono programs have found that additional screening helps with program sustainability, compliance with some funding requirements, adherence to the rules of the organization, verification that the inventor has a *bona fide* invention, and facilitation of engagement when matched with a patent practitioner.

⁶⁵ Pub. L. No. 112-29, 125 Stat. 284 (2011), Sec. 32.

(a) IN GENERAL.--The 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.

⁶⁶ As of August 2012, the Pro Bono Task Force members included: James Brookshire, Federal Circuit Bar Association; Jay Erstling, William Mitchell College of Law; Candee Goodman, Lindquist & Vennum; Georgann Grunebach, Fox Group; Harry Gwinnell, Greenblum & Bernstein; James Patterson, Patterson Thuyente IP; Mark Privratsky, Lindquist & Vennum; The Hon. Randall Rader, U.S. Court of Appeals for the Federal Circuit; Kevin Rhodes, 3M Innovative Properties Company; Paul Roberts, Foley & Lardner; Amy Salmela, Patterson Thuyente IP; Warren Tuttle, United Inventors Association; and Laura Zeman-Mullen, Zeman-Mullen & Ford.

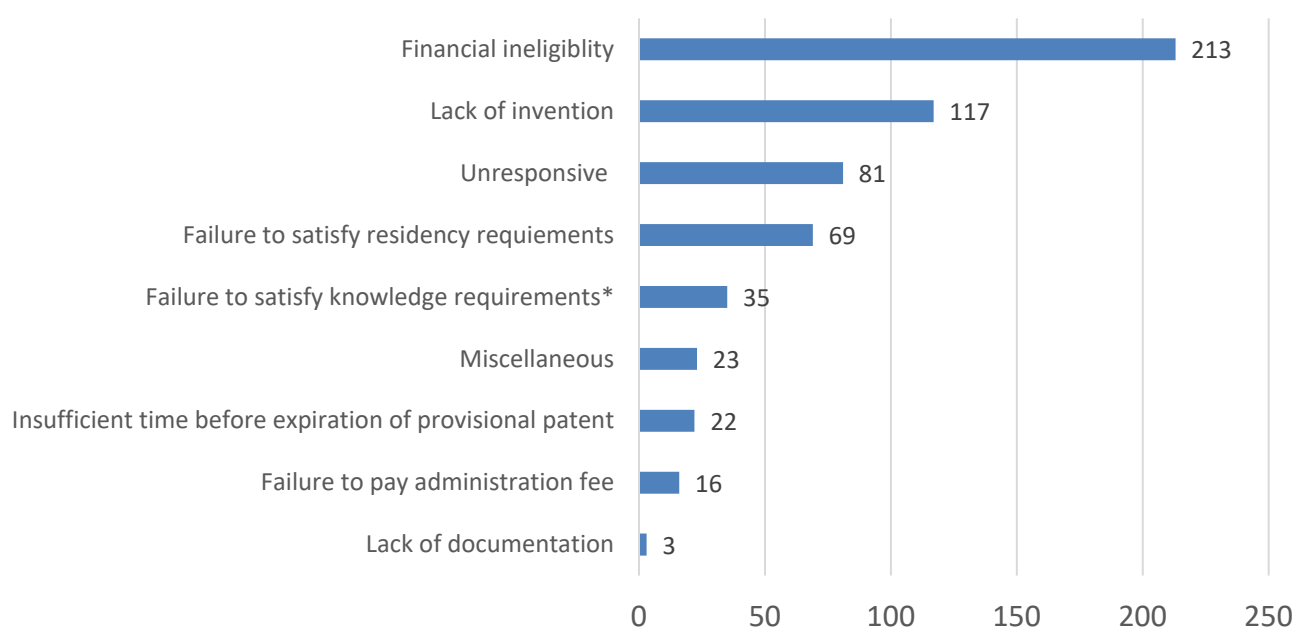
⁶⁷ See Amy M. Salmela and Mark R. Privratsky, *supra* n. 11.

⁶⁸ At the time of this report, only a few regional patent pro bono programs had increased their financial requirements for participation to 400% of the federal poverty level as set forth in the Unleashing American Innovators Act of 2022. The USPTO is currently working with the regional bono programs to increase their financial requirements to the new threshold. Currently, most pro bono service is provided to those whose household income is less than 300% of the federal poverty level.

2.5.2 Requirements that may serve as a deterrent for participation

From the second quarter of calendar year 2015 through the first quarter of 2020, the USPTO captured information on regional patent pro bono program screening operations.⁶⁹ Previously, the regional patent pro bono programs were to list “some reasons for [applicant] disqualification.” This metric did not capture the absolute number of disqualifications, but rather provided the USPTO with an anecdotal overview, for each quarter, of the general factors that the regional patent pro bono programs attributed to applicant disqualification. The graph below provides a consolidated list of the factors identified by the regional patent pro bono programs as having disqualified prospective applicants.

Figure 11. Factors that disqualified applicants, Q2/2015 to Q1/2020



* The USPTO offers a patent training course in both English and Spanish that produces a course completion certificate. The regional patent pro bono programs use the course completion certificate to show the applicant possesses knowledge of the patent system.

The regional patent pro bono programs disqualified 71% of applicants for one of the following reasons: failure to meet income requirements, lack of invention, or unresponsiveness to the regional program. Of those, financial ineligibility was the most important, disqualifying 37% of applicants. The other two, lack of invention and unresponsiveness, are fundamental to participation in the Program. No modification to the screening requirements would change the requirement that an inventor must have a patentable invention and must respond to the administrators’ requests for information to complete the application process.

⁶⁹ The USPTO reduced the number of screening operation metrics collected from the regional patent pro bono programs when the USPTO expanded its data collection to include the demographic information of applicants in 2020. This was done to avoid increasing the collection burden on the regional patent pro bono programs and to refrain from deterring them from their mission of matching under-resourced applicants.

2.5.3 Addressing the main driver restricting participation—financial ineligibility

On December 29, 2022, President Biden signed the Consolidated Appropriations Act, Public Law 117-328, which provided appropriations to federal agencies and established or modified various programs. It included the Unleashing American Innovators Act of 2022 (UAIA or the Act), which, among other things, required the USPTO Director to work with the regional patent pro bono programs to expand income eligibility to “an individual living in a household, the gross household income of which is not more than 400% of the Federal poverty line.” Increasing the financial threshold for participation directly addresses the main factor disqualifying applicants from participation.

After the passage of the Act, the USPTO met with the regional patent pro bono programs at two quarterly administrators’ meetings (January 26, 2023, and April 20, 2023) to discuss increasing their financial threshold for participation to not more than 400% of the federal poverty line. Regional patent pro bono programs indicated that they would attempt to adjust the financial participation requirements but needed time to update client intake infrastructure, websites, and promotion material. In addition, many programs expressed a need to obtain feedback from stakeholders to assess any reservations or difficulties in changing to the new financial threshold.

At the April 20, 2023, meeting, the USPTO took an *ad hoc* survey to ascertain the extent to which the regional patent pro bono programs would be capable of expanding their financial threshold for participation. Of the 14 regional programs that provided a response, eight indicated an ability to expand their income screening threshold up to 400% of the federal poverty line. The other six regional programs could not affirmatively commit to a change at the meeting. One administrator stated that they “would need to learn more from the pro bono attorneys and explore the ramifications” of the change. Another administrator indicated two constraints that could impact their ability to adjust to the new requirements: the regional patent pro bono program’s bandwidth and the ability of volunteers to support more cases. A third administrator indicated that a firm that supports their program generally had a policy for providing pro bono services to those at 187% of the federal poverty line but expanded the requirement for allowable pro bono service to those at 300% of the federal poverty line solely for the patent program. It is unclear whether that firm would be willing to extend the support of its volunteers at the higher threshold.

One regional patent pro bono program, operated through the State Bar of Michigan (SBM), is structurally limited from increasing its threshold beyond 200% of the federal poverty line. The SBM sets forth a Voluntary Pro Bono Standard that encourages all members of the SBM to participate in direct delivery of pro bono legal services by annually providing “representation without charge to a minimum of three low income individuals or 30 hours of pro bono service.”⁷⁰ The SBM further defines “low income individuals” as clients whose income does not exceed 200% of the federal poverty line.⁷¹ Since the SBM defines the required financial threshold for pro bono service, it is unlikely that practitioners in Michigan would volunteer for a service that would not count toward their annual pro bono service aspirational goal. In addition, for the regional patent pro bono program to be

⁷⁰ See State Bar of Michigan, “Voluntary Pro Bono Standard,” www.michbar.org/programs/atj/voluntarystds.

⁷¹ See State Bar of Michigan, “Pro Bono Service in Michigan,” www.michbar.org/alawyerhelps/probonoservi.

administered by SBM staff, clients of the Program must qualify for pro bono legal services as defined by the SBM. Increasing the threshold would effectively prohibit SBM staff from continuing to administer the program.

Similarly, Volunteer Lawyers of Birmingham (VLB), a regional patent pro bono program that covers Alabama and Mississippi, indicated a structural funding limitation in increasing their threshold beyond 200% of the federal poverty line. VLB obtains some of its funding through the Legal Services Corporation (LSC). LSC-funded programs are required to devote 12.5% of their budgets to providing pro bono legal assistance to eligible clients.⁷² This is referred to as the Private Attorney Involvement (PAI) requirement.⁷³ PAI referrals are usually made to volunteer attorneys by a member of the legal services program staff or by an outside subcontracting entity (such as a local bar association). To be eligible for these services, a prospective client must generally have income that is at or below 125% of the official federal poverty guidelines.⁷⁴ Thus, for VLB to receive LSC funds, it must comply with LSC's financial requirements for prospective clients. While the threshold of 200% of the federal poverty income is over the 125% limit set by the LSC, some patent pro bono clients are covered using LSC funds. A further increase in the financial requirements for participation would move VLB's regional patent pro bono program further away from parity with LSC's requirements, perhaps eliminating patent pro bono services from LSC coverage.

Of the eight regional patent pro bono programs that indicated an ability to expand their income screening threshold up to 400% of the federal poverty line, four had done so already: the Penn State Intellectual Property Clinic, California Lawyers for the Arts, LegalCORPS, and the Chicago-Kent Patent Hub. These regional patent pro bono programs have updated their intake forms, websites, and screening practices to enable participation for individuals with household incomes of not more than 400% of the federal poverty line. The USPTO will continue to work with the regional patent pro bono programs on updating their financial screening requirements, where practicable, and to promote to the public those regional patent pro bono programs that have updated their screening requirements to the higher financial threshold.

2.6 Serving prospective and existing participants (Cong. Qn. Sec. 105 (a)(2)(A)(i))

This section focuses on prospective and existing participants in the regional patent pro bono programs, and assesses whether those participants are being sufficiently served by them. Two metrics assess whether prospective participants are sufficiently being served: the number of inquiries to the regional programs and the number of applicants. Three metrics assess whether existing participants are being sufficiently served: the volume of applications processed, approved matches with a volunteer patent practitioner, and patent applications filed on behalf of patent pro bono participants.

⁷² 45 C.F.R. § 1614.2.

⁷³ *Id.*

⁷⁴ 45 C.F.R. § 1611.3(c)(1).

2.6.1 Prospective participants in the patent pro bono programs

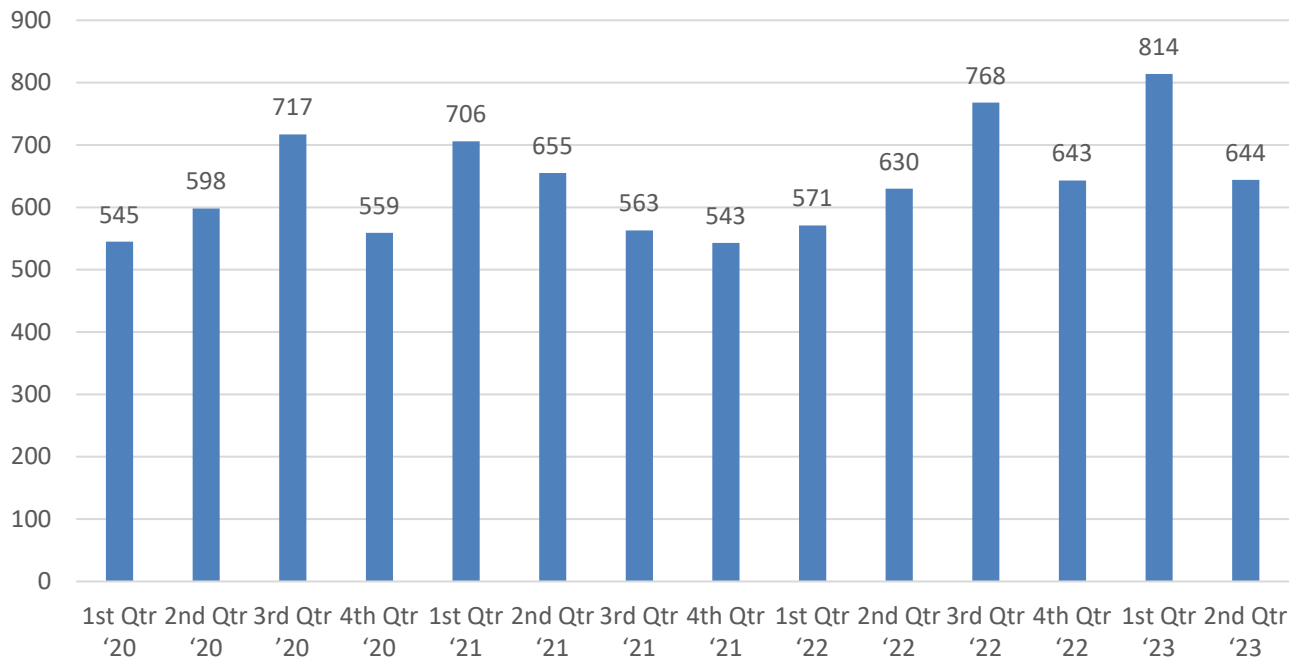
The USPTO defines prospective participants as those individuals who have inquired about the free prosecution services provided by the regional patent pro bono programs.⁷⁵ The USPTO requested that the regional patent pro bono programs capture the number of such inquiries starting in calendar year 2020. The prospective participant data capture inquiries about services via phone, email, fax, letter, or application to the regional programs. The regional programs also capture the number of applications for services submitted on a quarterly basis. Accordingly, the number of inquiries will always be more than the number of applicants.

The extent to which the patent pro bono programs are sufficiently serving prospective participants is determined, in part, by the regional programs' ability to support and respond to inquiries from the public. The figure below includes the number of inquiries to the regional patent pro bono programs by quarter starting in the first quarter of 2020.

From the first calendar quarter of 2020 to the second quarter of 2023, there was an average of 640 inquiries from prospective participants each quarter (Figure 12). The number of inquiries grew by an average of 1.3% each quarter, rising from 545 in the first period to 644 in the last. The regional patent pro bono programs have not indicated any difficulty handling this gradual increase in demand.

⁷⁵ Not all prospective participants who request information about the Program apply for assistance. For example, some prospective participants may, upon learning of the financial requirements for participation, decide that they would not qualify for assistance and therefore do not apply. Others, upon learning that they will be responsible for USPTO application fees, may decide not to pursue filing an application due to financial constraints.

Figure 12. Prospective participant inquiries, by calendar year quarter, Q1/2020-Q2/2023

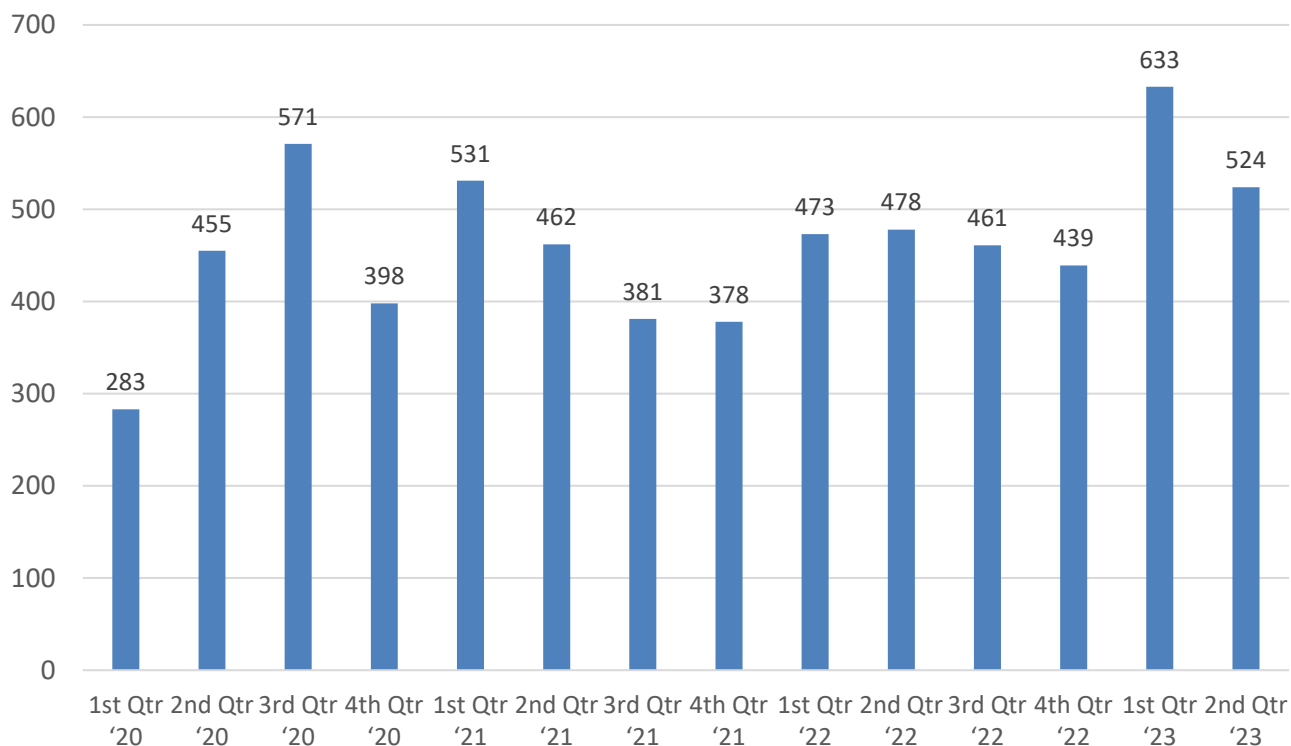


The inquiries to the regional patent pro bono programs may ultimately lead to individuals applying for assistance. Figure 13 illustrates the number of individuals applying for assistance through the regional patent pro bono programs by quarter, starting with the first quarter of calendar year 2020 and ending with the second quarter of calendar year 2023. On average, over that period there were 462 applicants per quarter, rising by nearly 5% per quarter from 283 in the first period to 524 in the last.

The data indicate that there are between 1-2 inquiries about the Program for each individual application. This relationship has improved since the start of the sample period, falling quickly from nearly 2 inquiries for each application in the first quarter of 2020, and settling along an average of 1.4 inquiries per application to the regional patent pro bono programs. This decrease may be due, in part, to efforts by the regional patent pro bono programs and the USPTO to promote awareness of the Program and its participation requirements.

Importantly, the USPTO took the proactive step of increasing the budget for the Program from \$680,000 in FY 2023 to approximately \$1.2 million in FY 2024. This additional funding will help the regional patent pro bono programs increase their operational efficiency to handle the increase in inquiries and applicants.

Figure 13. Applicants to the regional patent pro bono programs, by calendar year quarter, Q1/2020-Q2/2023



The improvement in the number of inquiries per application and the steep boost in funding for the Program indicate a strong commitment by the USPTO to aid the regional patent pro bono programs in serving prospective participants in the Patent Pro Bono Program.

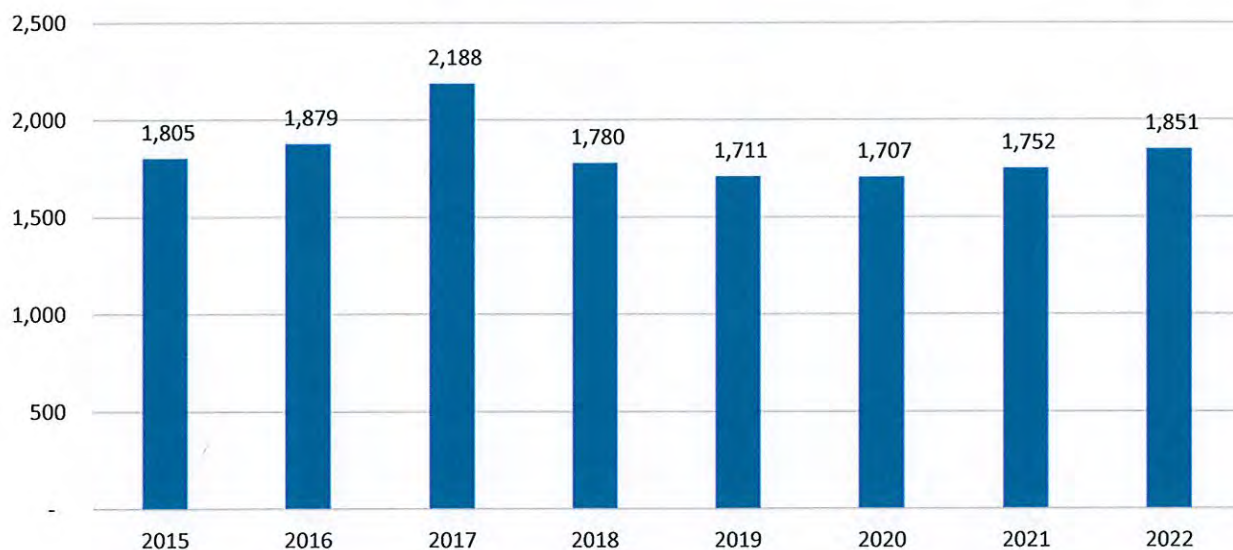
2.6.2 Existing participants in the patent pro bono programs

The USPTO defines existing participants as those individuals who applied for free patent services through one of the regional patent pro bono programs.

The primary way the regional patent pro bono programs are serving existing participants is evidenced by the high volume of applications processed by the programs.

The regional patent pro bono programs maintain statistics on the number of individuals who complete online applications for free patent prosecution services. The regional patent pro bono programs screen the online applications to determine whether the applicants meet the participation requirements. In 2015, the USPTO began capturing the number of applications for assistance filed through the regional patent pro bono programs. Through calendar year 2022, the public used these programs to file 14,673 applications, or 1,834 per year (Figure 14). Note that this figure includes annualized numbers from Figure 13 to present the longest time-series trend available.

Figure 14. Applications for assistance filed through the regional patent pro bono programs, by year, 2015-2022

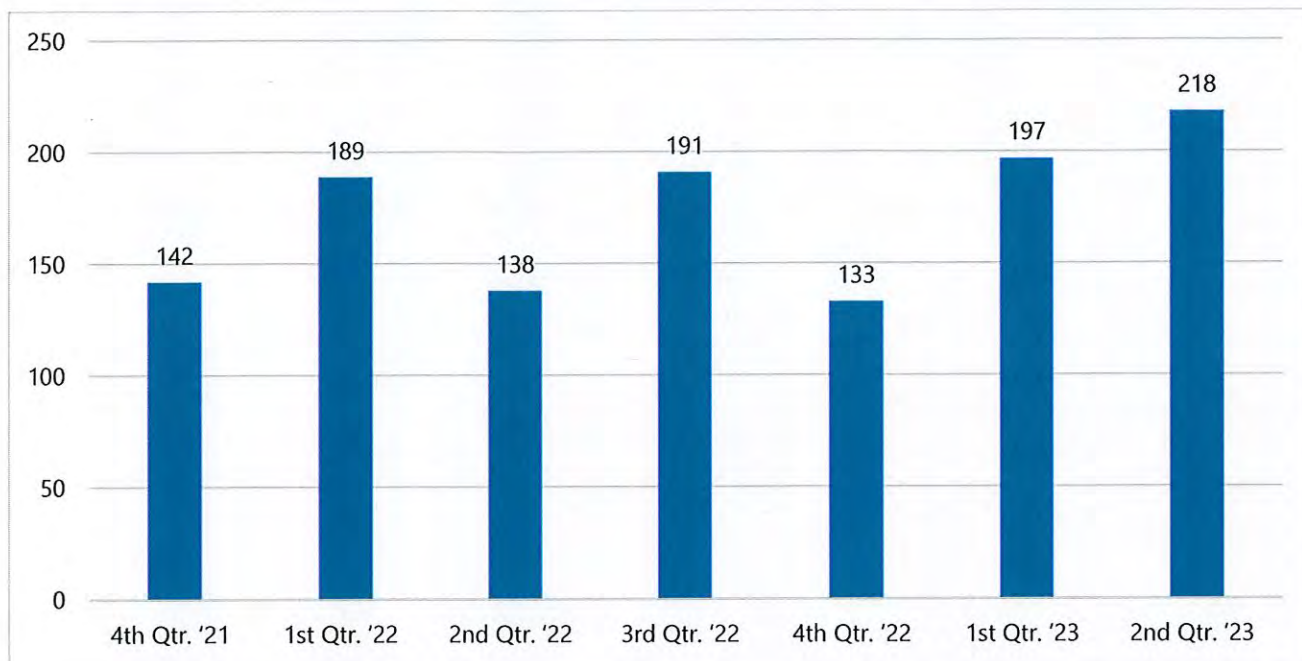


The regional patent pro bono programs have not expressed any concerns in handling this volume of applications. To reduce the burden on their administrative resources, many regional patent pro bono programs require that applications be submitted via an online web form. Most of these programs have structured their web forms to require applicants to supply all the necessary information in order to complete and submit the form, thereby improving the efficiency of the programs' administrative processes.

As described in section 2.5 of this report, "Previewing inventor requirements for participation," the regional patent pro bono programs screen applicants against their requirements for participation to facilitate a match with a patent practitioner. The regional patent pro bono programs have found that rigorous screening helps ensure that the inventors being referred for a match have a *bona fide* invention.

Due to the participation requirements of the regional patent pro bono programs, approximately 36% of applicants are approved for placement. Figure 15 presents the number of applicants approved for placement by calendar-year quarter. Note that prior to the fourth quarter of calendar year 2021, the USPTO did not collect these data.

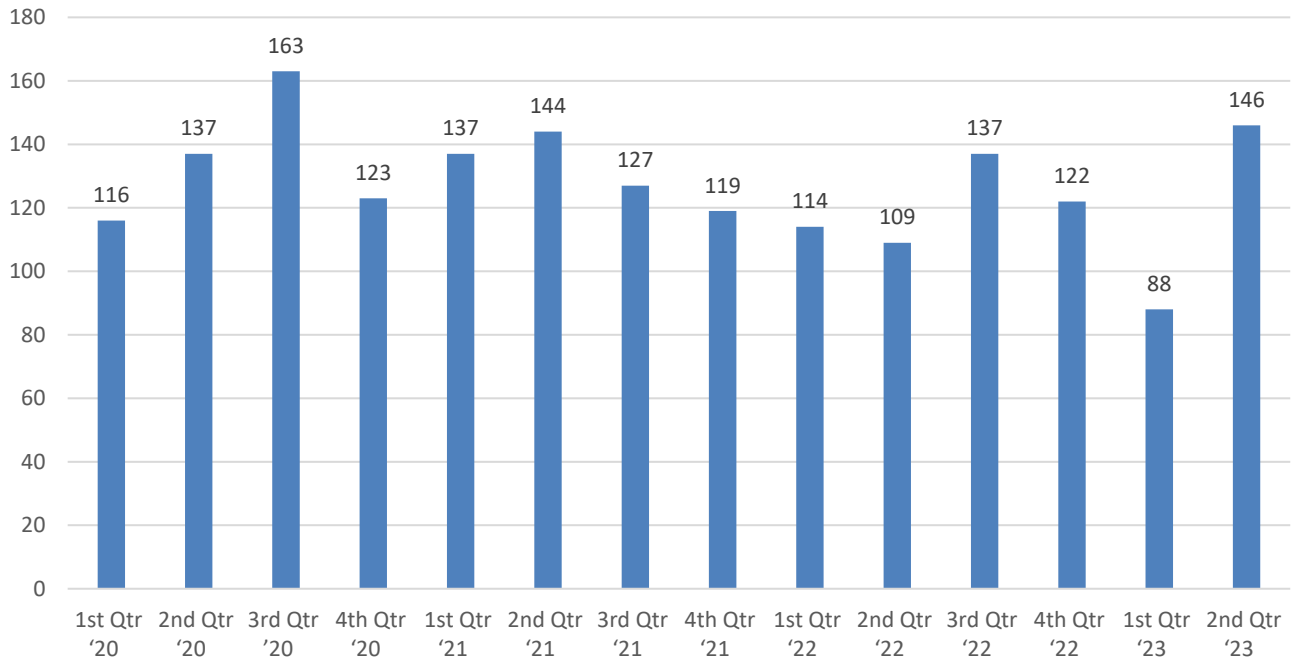
Figure 15. Patent pro bono applicants approved for placement, Q4/2021-Q2/2023



The second way regional patent pro bono programs are sufficiently serving existing applicants is by matching approved applicants with pro bono attorneys. Figure 16 shows the number of matches made by the regional patent pro bono programs between volunteer patent practitioners and qualified pro bono applicants per quarter, starting in 2020. In the seven calendar-year quarters for which data on the number of qualified applicants and the number of matches were collected, we found that roughly 7 in 10 qualified applicants were successfully paired with volunteer patent practitioners.

The USPTO supports the regional patent pro bono programs by encouraging volunteers so more are available for a match. However, the regional programs have indicated various factors that prevent approved applicants from being matched. Those factors include an inability of the inventor to pay filing fees, failure to contact the volunteer practitioner, a perceived lack of marketability of the invention, a lack of volunteer availability, volunteer disqualification due to a conflict of interest, and a lack of volunteers with appropriate technical backgrounds.

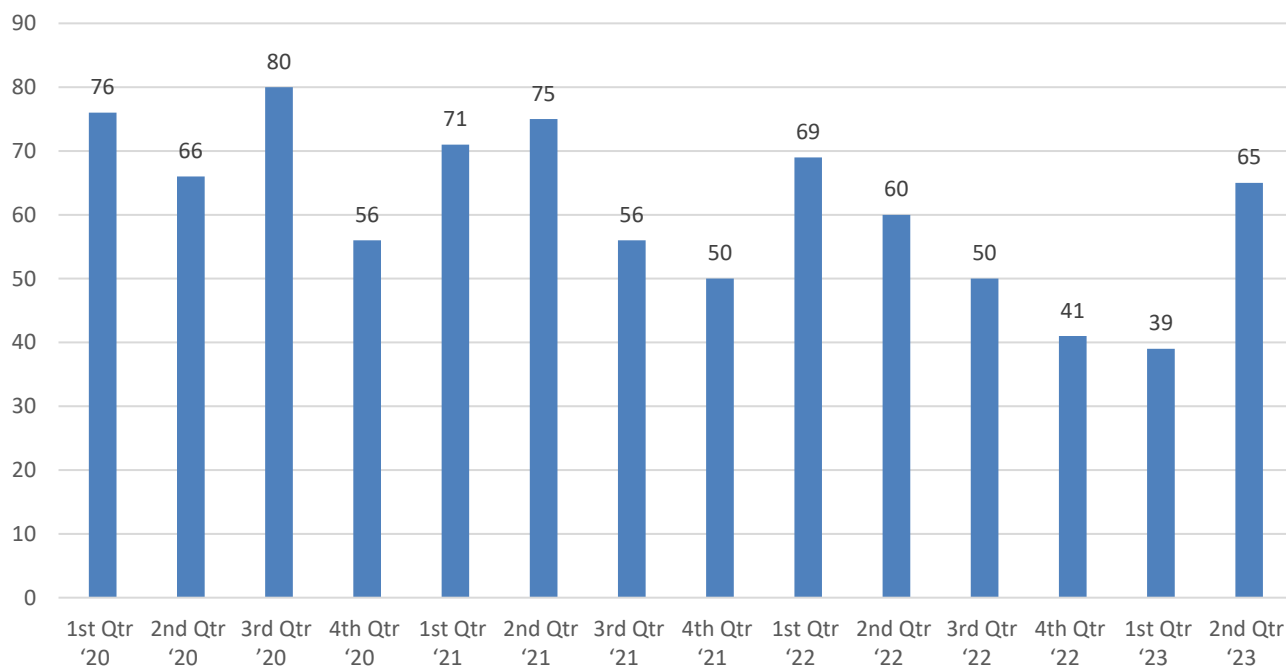
Figure 16. Approved applicant matches with volunteer patent practitioners, Q1/2020-Q2/2023



The third way regional patent pro bono programs sufficiently serve existing applicants is by supporting volunteer patent practitioners in filing patent applications on behalf of approved participants. From October 2017-June 2023, the regional patent pro bono programs reported more than 1,460 patent application filings on behalf of program participants.

Figure 17 illustrates quarterly filing data from the first calendar-year quarter of 2020 to the second calendar-year quarter of 2023. These data show that, on average, nearly 50% of matched applicants file a patent application.

Figure 17. USPTO patent application filings from pro bono program matches, Q1/2020-Q2/2023



Importantly, the number of patent application filings identified by the regional patent pro bono programs may not accurately reflect the current number of patent applications filed by their applicants.

It is well recognized that legal aid organizations have little infrastructure or capacity for tracking data and are better at tracking “outputs” than downstream outcomes.⁷⁶ This difficulty manifests itself in the regional patent pro bono programs. Regional programs are able to accurately determine “outputs” for which they are responsible: the number of inquiries and applications to the program, the number of applications approved for placement, and the number of matches with patent practitioners. But downstream information is difficult for the administrators to collect; for example, patent applications may be filed months after the match. Furthermore, the patent application may take years to be granted.⁷⁷ Adding to this difficulty in collecting downstream outcomes from volunteer practitioners is the fact that many practitioners change law firms.⁷⁸ The result is that regional patent pro bono programs often are not equipped to capture these “outcomes” that occur long after the match.

⁷⁶ National Center for Access to Justice, “Tracking Outcomes: A Guide for Civil Legal Aid Providers & Funders,” June 20, 2018, <https://ncaj.org/sites/default/files/2021-02/NCAJ-Outcomes-Guide-complete-for-6-20-18.pdf>.

⁷⁷ Traditional total pendency including requests for continued examination is 28.2 months as of September 2023. See www.uspto.gov/dashboard/patents/pendency.html.

⁷⁸ Jessica Blaemire, “Analysis: Are Lawyers Jumping Ship? Or Sailing to Other Firms?” Bloomberg Law, July 26, 2022, <https://news.bloomberglaw.com/bloomberg-law-analysis/analysis-are-lawyers-jumping-ship-or-sailing-to-other-firms>. Law firm attorneys

To address the issue of downstream data collection, the USPTO started collecting patent pro bono application filing information at the USPTO by creating a voluntary form, PTO/AIA/440,⁷⁹ which allows volunteers to voluntarily certify their representation as pro bono by including the form in their patent application filings. The USPTO can then search its patent application database and collect application filing and patent issuance information without burdening the regional patent pro bono programs. The USPTO introduced this form in October 2017. Since then, the form was included in 603 patent applications through December 31, 2022. During that same time frame, the regional patent pro bono programs reported more than 1,360 patent application filings with the USPTO.

The disparity between application filing information obtained from the PTO/AIA/440 form and that reported by the regional patent pro bono programs may be due, in part, to a lack of familiarity with the form. For example, during the fourth quarter of 2017, when the USPTO first introduced the pro bono certification form, only 19 of the forms were included with patent applications. Over that same time frame, the regional patent pro bono programs reported 70 patent applications filed. As time progressed and the regional patent pro bono programs continued to promote the use of the form, adoption increased. For the 4th quarter 2022, there were 35 applications that included the pro bono certification form, while the regional patent pro bono programs reported 41 patent applications filed with the USPTO.

The form has not been universally included in patent applications for a variety of reasons. Most importantly, it is a *voluntary* certification. The form expressly states “the undersigned attorney hereby *voluntarily* certifies the following . . . ” The voluntary nature of the certification enabled the USPTO to launch the form without formal rulemaking or without it falling under the requirements of the Paperwork Reduction Act.⁸⁰ Another consideration is that since volunteer practitioners are encouraged to treat pro bono applicants the same as paying clients, it is not surprising that those same volunteers decide not to include a voluntary certification that is not required for their paying clients. Some volunteers have expressly refused to use the form, indicating that its inclusion could potentially impact a client’s ability to later obtain funding or defend against potential infringers. Volunteers have indicated that the form, which is publicly available in the application’s image file wrapper, is essentially disclosing an applicant’s lack of resources due to the requirements for participation in the Program. To address this concern, the USPTO is investigating changing the visibility of the form so that it is not available to the public.

responded that, on average, 5.7 attorneys whom they personally knew had departed, and that 4.1 attorneys from their specific practice group had departed.

⁷⁹ www.uspto.gov/sites/default/files/documents/aia0440.pdf.

⁸⁰ A voluntary certification is outside the scope of the Paperwork Reduction Act.

2.6.3 Summary findings of service to prospective and existing participants

From the first quarter of 2020 to the second quarter of 2023, the regional patent pro bono programs received, on average each calendar-year quarter, 462 applications for their services. Using a somewhat shorter period (seven calendar-year quarters of data) to approximate the first quarter 2020-second quarter 2023 period, we found roughly 36% of applicants are approved for services. Applying this share of applicants approved to the entire sample period, we found an average of 165 applications approved for services.⁸¹ Of those 165, 127 applicants to the regional patent pro bono program advanced from an initial application to working with pro bono counsel. Those 127 pro bono practitioner-inventor collaborations per quarter resulted in an average of 61 applications for a patent to the USPTO. Thus, a little more than one-third of all applications approved by the regional patent pro bono programs for services resulted in a USPTO patent application each quarter of calendar year 2020-2022.

3. Enhancing opportunities for the regional patent pro bono programs

The data show that the Patent Pro Bono Program is helping increase access to the patent system, especially for historically underserved communities. The demographic data show an improvement in the engagement of groups that have traditionally had difficulty accessing the patent system, including a measurable jump in the past year. Addressing this untapped resource of inventors by providing access to typically underserved communities means that the Program is helping drive U.S. innovation and stimulating economic growth. It is important for the USPTO to continue the trend of ensuring that inventors from all backgrounds have an equitable chance to protect their IP and contribute to innovation.

While the USPTO initiates the establishment of the regional patent pro bono programs, to make the most impactful change, stakeholders' energy and resources should be directed toward the regional patent pro bono programs to ensure their ability to provide patent pro bono referral services. Improving their ability to promote the Program, screen applicants, recruit volunteers, place qualified applicants, and track outcomes will enhance the overall reach of the Program. At the June 7, 2023, listening session, Jim Patterson of the PBAC framed the issue succinctly, saying, "I think . . . a lot of the focus needs to be right where it's happening [the regional patent pro bono programs]. 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." Without sufficient financial resources, the regional patent pro bono programs are limited in the amount of patent pro bono referral service operations they are able to provide.

⁸¹ The Q1 FY 2020-Q2 FY 2023 average number of applicants is 462, but the Q4 FY 2021-Q2 FY 2023 average is 484; thus, 36% of 484 is 173.

3.1 Funding of the regional patent pro bono programs (Cong. Qn. Sec. 105 (a)(2)(A)(ii))

In February 2014, the White House issued an executive action to “help expand the existing America Invents Act Pro Bono Program to cover all 50 states.”⁸² To achieve this goal and help encourage IP organizations to establish these programs across the United States, the USPTO worked collaboratively with IP organizations and shared the cost of administration efforts. By reducing a major impediment to participation—the cost of running a referral service—the USPTO attained nationwide patent pro bono coverage in the summer of 2015.

The USPTO uses the Department of Commerce’s JPA to cost-share the administrative efforts of the regional patent pro bono programs.⁸³ The JPA allows for equitable cost sharing with IP organizations for activities of mutual interest, does not require a formal acquisition via the USPTO’s Office of Procurement, and can easily be terminated, if needed. The flexibility of the JPA allows the USPTO to quickly engage and work with an IP organization interested in hosting a regional patent pro bono program.

The USPTO shares the cost of administration efforts for most of the regional patent pro bono programs. JPA agreements are in place with 16 of the 20 regional patent pro bono programs. Four of the patent pro bono programs do not share administrative costs with the USPTO because they are funded through other means.⁸⁴ For the regional programs with which the USPTO has entered into JPA agreements, the USPTO contribution to the costs varies annually for each program, ranging from approximately \$23,000-\$119,000. Different types of organizations have different compensation and overhead and locality factors, resulting in varying funding allocations across the programs.

The regional patent pro bono programs encounter a variety of costs in administering the programs. Such costs may include support for an administrator, advertising/marketing, rent, equipment, and travel. In 2011, the Minnesota Pilot Program estimated an anticipated annual expense budget for program administration of \$55,000. Adjusted for inflation, that expense budget has increased to \$75,383 today.⁸⁵ Depending on the size and location of the program, budgets may be noticeably larger. For example, Volunteer Lawyers for the Arts in New York, a regional patent pro bono program that covers New York, New Jersey, and Connecticut, had a 2022-2023 annual budget of \$302,302, of which the USPTO contributes only 39%, or \$119,000. The high cost of office space, salaries, and overhead greatly increases the total cost to administer the program in that region.

⁸² White House, “Answering the President’s Call to Strengthen Our Patent System and Foster Innovation.”

⁸³ See 15 U.S.C. 1525. The Department of Commerce’s JPA provides that the Department may enter into joint projects with nonprofit, research, or public organizations on matters of mutual interest, the cost of which is equitably apportioned.

⁸⁴ For example, the Michigan Pro Bono Patent Project is run through the State Bar of Michigan and is supported exclusively through dues charged to members of the Michigan State Bar.

⁸⁵ See U.S. Bureau of Labor Statistics, “CPI Inflation Calculator,” www.bls.gov/data/inflation_calculator.htm (calculating the inflation increase from January 2011 to March 2023).

In 2017, the USPTO's Office of Finance conducted an internal review of the Patent Pro Bono Program.⁸⁶ The Office of Finance determined that a majority of the regional patent pro bono programs were operating efficiently and had the necessary funding to provide high-quality service to participants. The review was based, in part, on a survey of 10 regional patent pro bono programs: three high-volume programs, three medium-volume programs, three low-volume programs, and one self-sustaining program. In addition, the Office of Finance looked at funding data for each of the regional programs. In general, the review determined that the regional patent pro bono programs were satisfied with the level of support provided by the USPTO Patent Pro Bono Program.

While the regional patent pro bono programs generally had the necessary funding to serve existing and prospective participants, a significant majority of the programs relied on the USPTO to pay for some of the costs of administering their program. One survey participant emphasized that "[i]t is unlikely that our organization can sustain this program on a long-term basis without continued financial and administrative support from the USPTO." Another participant expressed concern that cuts to USPTO funding could undermine support for the program.

In 2019, as part of its requirements under the joint project agreements, the USPTO included the requirement that the regional patent pro bono programs provide "sustainability plans" to illustrate how they intended to fund their equitable cost-share.⁸⁷ The sustainability plans showed that while the regional patent pro bono programs were sufficiently funded, they spent a significant amount of their time fundraising to meet their equitable cost-share obligation. One program indicated that it was unable to find enough contributions from its sponsors, so it would "heavily rely on general operating funds" to cover the shortfall. The expenditure of time on fundraising takes resources directly away from patent pro bono administration services for under-resourced inventors and small businesses. In addition, limitations on a program's ability to fundraise also restrict its ability to grow.

When Director Kathi Vidal joined the USPTO in 2022, the agency held an early meeting with the PBAC to assess ways in which the pro bono offerings could be expanded. Based on feedback from that meeting, the USPTO took the proactive step of increasing the FY 2023 budget for the Program from \$680,000 to approximately \$1.2 million. The funding that has been allocated from the \$1.2 million was premised not only on fund matching but also on the individual organizations presenting a concrete plan on how the money would be used to enhance access to the patent system. The additional funding has helped and will continue to help the regional patent pro bono programs support prospective participants. With equitable cost sharing at current levels, the regional patent pro bono programs have the necessary funding to provide high-quality service to prospective participants. And though in past years there has been turnover in the regional programs providing patent pro bono assistance due to factors including the financial instability of some partner organizations, the additional funding and support stopped the turnover of regional programs in calendar year 2023. At the time of this study, the regional patent pro bono programs had not indicated to the USPTO any difficulty in supporting prospective and existing participants at current levels.

⁸⁶ The Patent Pro Bono Program Review is provided in Appendix I. Appendices to this report are available upon request.

⁸⁷ The regional patent pro bono programs' 2019 sustainability plans are available upon request.

As mentioned, there are limitations with equitable cost-sharing through the JPA.⁸⁸ A regional patent pro bono program might not be able to match an increase in funding via a JPA agreement. Thus, to some extent, the growth of the Program is limited by the regional patent pro bono programs' ability to raise sufficient funds to match the USPTO's contributions. Therefore, the flexibility the JPA allows for easily partnering with IP organizations is countered somewhat by the limitation of requiring equitable cost-sharing.

3.2 Alternative approaches for funding the regional patent pro bono programs

Given the known limitations of the JPA, the USPTO is considering several options for a structure that is better able to support the regional patent pro bono programs.

3.2.1 Working within the JPA

One option is to maintain the current JPA approach, but to use a provision in the JPA statute that allows the Department of Commerce to "waive payment of any portion of [joint project] costs by others, when authorized to do so under regulations approved by the Office of Management and Budget."⁸⁹ It may be possible that this provision could be used to allow an increase in the USPTO's contributions to the regional patent pro bono programs, with a "waiver" of the increased contributions by the nonprofit partners that would otherwise be required to maintain an equitable apportionment of costs between the parties. Exploration of this possibility would require coordination with the Department of Commerce. Because the JPA is not intended to be used primarily for the purpose of transferring funds from an agency to a partner organization, it is unlikely that this approach will lead to a dramatic increase in the amount of funds that the USPTO can provide to support the regional patent pro bono programs.

3.2.2 Other Transaction Authority

Another option is to seek Other Transaction (OT) Authority from Congress. OT Authority permits agencies to enter into Other Transaction Agreements (OTA). An OTA is a unique legal instrument, different from a contract, grant, or cooperative agreement.

OTAs offer tremendous flexibility. An OTA is generally not subject to the Federal Acquisition Regulation (unless otherwise specified by Congress or in the OTA's terms and conditions), nor are OTAs covered by requirements enumerated in grant statutes or regulations. OTAs, nevertheless, are subject to the limits and legislative mandates included in the congressional grant of OT Authority to an agency, as well as any internal guidance, policy, or direction promulgated by the agency. Agencies generally establish internal policies and guidance to ensure that abuses will not occur when invoking OT Authority. Approval of OTAs usually must be obtained from fairly high levels within an agency, as a protection from possible abuses of the authority that could result in congressional revocation.

⁸⁸ The USPTO considered using conventional procurement vehicles and competitively bid the patent pro bono administration to the public, but determined that the effort to advertise and competitively bid procurements or to make sole source justifications for the regional patent pro bono programs made it difficult to use procurement contracts to fund the programs.

⁸⁹ 15 U.S.C. 1525.

Congressional grants of OT Authority vary between agencies, with some agencies receiving wide swaths of latitude and flexibility regarding the underlying subject matter of OTAs, as well as their terms and conditions. Other agencies have been granted only very narrow authority to enter into OTAs, and then only for very specific activities. The degree of latitude that Congress provides agencies depends on a variety of factors, including Congress's desire for legislative oversight, the amount of money involved (some grants of OT Authority contain dollar or percentage limits), and the subject matter. A grant of OT Authority may also be used more broadly across the agency's efforts and initiatives and might be useful to the agency in other contexts.

3.2.3 Conclusion

The USPTO is constrained in its ability to provide additional financial resources to regional patent pro bono programs using the current JPA funding approach. The JPA requires the contributions by the joint project partners to be "equitable," which means that increases in USPTO contributions must generally be met with increases in our non-profit partners' contributions. Because many of our partners do not have additional resources available, USPTO is limited in its ability to provide additional funding. Additional flexibility can be found within the JPA structure, or by seeking OT Authority from Congress. Such authority would provide the USPTO with much more flexibility in funding regional patent pro bono programs. Additionally, depending on the scope of any OT Authority the agency receives, it may also be useful in achieving other agency goals.

4. Potential Options for Improved Stability and Flexibility

Because the Patent Pro Bono Program depends on the financial stability of its regional partners, the program could provide greater stability and better ensure continuity if USPTO had the authority and flexibility to support regional patent pro bono programs and preserve and expand access to the patent system for those who need it most. To this end, USPTO considers working within a special provision of the Joint Project Authority (JPA) and seeking legislation for Other Transaction Authority . OT Authority, in particular, could be used as a tool to reach the Federal marketplace to increase access to non-traditional entities and underserved communities. This funding mechanism could allow the USPTO the ability to strengthen funding of administrative, business development, and outreach services provided by regional patent pro bono programs and alleviate the financial burden that often leads to their withdrawal. This authority could also be used to support, expand, and establish other agency programs that seek to sustain and expand access to the innovation ecosystem.

Since 2015, the USPTO has worked diligently to maintain nationwide patent pro bono coverage. Despite these efforts, we have seen a significant turnover in the regional patent pro bono programs that support the Program.⁹⁰ This ongoing turnover jeopardizes the availability of these services to the public. While various factors contribute to this, a major factor is the financial strain imposed on the host pro bono organizations responsible for administering the program.

⁹⁰ On average, the USPTO sees a 10%-20% annual turnover in the organizations that support the Patent Pro Bono Program. The USPTO has maintained nationwide coverage by having other existing regional patent pro bono programs cover the vacancies or by finding alternative replacement organizations.

Under the current funding approach that uses the Department of Commerce's JPA, the regional patent pro bono programs bear a significant financial burden for administering the program. The JPA requires contributions to be "equitable," meaning that each regional program must cover a proportionate share of its administration service costs. In certain instances, this equitable contribution becomes unsustainable, leading to the withdrawal of regional programs from providing patent prosecution referral services. These occurrences and uncertainties threaten the continuity of the Patent Pro Bono Program, potentially depriving underserved inventors of access to this valuable resource.

Providing the USPTO with OT Authority would help alleviate this financial burden and ensure the continued availability of this vital program.⁹¹ Specifically, OT Authority would provide the USPTO with the flexibility to allocate its resources more effectively to support regional patent pro bono programs. It would allow the USPTO to fully fund the administrative services provided by these programs without the requirement that an equitable share of those costs be covered by the regional programs, thereby alleviating the financial burden that often leads to their withdrawal. The USPTO would also be better equipped to adapt to the unique circumstances and financial challenges faced by each of the regional programs and to potentially expand the Program to more regions, since the USPTO could help mitigate the financial burden that the regional patent pro bono programs face.

The Patent Pro Bono Program is a vital initiative that provides access to the patent system for individuals and entities that are unable to afford the services of a patent practitioner. It has been instrumental in democratizing access to the patent system and has played a pivotal role in ensuring that historically underserved groups and under-represented inventors have the opportunity to protect their IP. The Program not only serves as a source of optimism for under-resourced inventors, but also contributes to the inclusive innovation ecosystem our nation strives to foster. It is a testament to our commitment to equitable participation in innovation.

The USPTO will consider formal submission of a legislative proposal for OT Authority to continue the tradition of innovation and invention, promoting equity and providing opportunities to underserved inventors who have the potential to shape the future.

⁹¹ As with other federal agencies, OT Authority will allow the USPTO to work more effectively with our private sector partners, such as the regional patent pro bono programs, in sharing the financial costs of providing pro bono patent prosecution services. For instance, NASA has successfully utilized OT Authority for years, enabling the agency to establish effective partnerships with private sector organizations through sharing financial costs, which has been instrumental in helping the agency achieve its goals and advancing its mission.



APPENDIX A - Overview of the PTAB Pro Bono Program

A. Introduction

The United States Patent and Trademark Office (USPTO) recognized a need for under-resourced parties to gain access to legal representation in proceedings before the Patent Trial and Appeal Board (PTAB). To meet this need, the USPTO has partnered with the PTAB Bar Association to provide pro bono legal representation for clients who qualify for assistance with ex parte appeals through the PTAB Pro Bono Program (PTAB Pro Bono). The USPTO aims to promote innovation, regardless of an inventor's financial resources.

The PTAB Bar Association began accepting volunteer practitioners for PTAB Pro Bono in March 2022. PTAB Pro Bono began accepting applications from potential individual inventors in June 2022. The program was expanded in April 2023 to accept applications for potential inventor groups and inventor-owned small businesses. Additionally, the eligibility criteria were relaxed to enable more inventors to qualify.

PTAB Pro Bono is in its nascent stages, and several opportunities exist to enhance the program going forward. These enhancements may make the program even more useful to the under-resourced inventing community and may bring innovations to impact even faster.

B. Overview

The USPTO and the PTAB Bar Association worked in collaboration to create PTAB Pro Bono. A PTAB Pro Bono Steering Committee, which is composed of attorneys from law firms, individuals with experience in providing pro bono services, and representatives from the PTAB Bar Association, regularly provides input.

The PTAB Bar Association serves as the clearinghouse for PTAB Pro Bono. In this role, the PTAB Bar Association registers volunteer practitioners, performs applicant intake for potential pro bono clients, and matches potential pro bono clients with volunteer practitioners. The PTAB Bar Association does not provide legal advice or assistance of any kind to the potential pro bono clients.

C. Pro Bono Applicant Eligibility

PTAB Pro Bono serves under-resourced members of the innovation community seeking to appeal a patentability rejection from a patent examiner to the PTAB. A rejection of a patent application may be appealed to the PTAB after a second or final rejection of the claims. To be eligible to participate in the program, an individual inventor seeking representation through PTAB Pro Bono must meet certain eligibility requirements:

- **Domicile:** the inventor must reside in the United States.
- **Income:** the inventor must have a total household income of less than 400% of the federal poverty guidelines.

- **Knowledge:** the inventor must demonstrate knowledge by successfully completing a video training course consisting of two videos. The first video explains how PTAB Pro Bono operates and how to apply for assistance under the program. The second video discusses the ex parte appeal process.
- **Timing:** the inventor must apply to the program within one month from the date of an office action in which the claims have been twice or finally rejected.
- **Ownership interest:** the inventor must not be under an obligation to assign (sell or give ownership of) the application or resulting patent to a third party.

When it originally started, PTAB Pro Bono required individual inventors to qualify as a micro entity, which limited an inventor to having three or fewer filed patent applications. And when it originally started, PTAB Pro Bono had a lower income threshold of 300% of the federal poverty limit. In April 2023, to enable more inventors to qualify, the micro entity requirement was eliminated, and the income threshold was increased.

In addition, as of April 2023, inventors who are part of an inventor group of up to four known inventors may apply for pro bono assistance. In that circumstance, each known inventor must meet the above listed qualifications. Inventor-owned small businesses may be eligible as well. The small business must be 100% inventor-owned, and there may be no more than four known inventors. Each inventor-owner must meet the above qualifications, and there are limits on the business's income. Specifically, if the business was operating in the preceding calendar year, it must have had a total gross income of less than \$150,000, and the business must expect/project a total gross income of less than \$150,000 in the calendar year when the application for pro bono assistance is filed.

Inventors seeking assistance through PTAB Pro Bono must apply on the PTAB Bar Association's website (www.ptabbar.org/ptab_pro_bono.php). The PTAB Bar Association reviews completed applications to determine whether the applicant meets the eligibility qualifications. If the applicant satisfies all the eligibility requirements, then the PTAB Bar Association attempts to match the applicant with a volunteer practitioner. If the applicant does not qualify, then the PTAB Bar Association recommends additional resources that may be of assistance, including the USPTO's Pro Se Assistance Program. Qualifying for the program does not guarantee that the applicant will receive pro bono representation.

D. Volunteer Practitioners

Patent practitioners interested in volunteering to provide pro bono assistance to an under-resourced inventor must register on the PTAB Bar Association's website (www.ptabbar.org/ptab_pro_bono.php). The PTAB Bar Association reviews the volunteer practitioner's information to gain an understanding of the volunteer practitioner's practice expertise, from both a technological and a legal standpoint. Volunteer practitioners must be licensed patent attorneys or patent agents registered with the USPTO, must maintain their own malpractice insurance, must agree to accept no fee for their services, and

must provide a representation agreement to any potential pro bono clients that details the scope of representation.

E. State of the PTAB Pro Bono Program

PTAB Pro Bono is a healthy program in its nascent stage. On the volunteer practitioner side, more than 60 practitioners had volunteered to assist pro bono clients with ex parte appeals as of August 2023.

On the inventor side, it has been more challenging to make inroads into the inventor community. As of August 2023, five qualified inventors had applied to the program, and all had been matched with pro bono representation.

The USPTO and the PTAB Bar Association have attempted to promote the program as extensively as possible to inventors and will continue to do so. For example, as of early 2023, Patent Examiners may include information in a final rejection for a pro se applicant regarding the PTAB and the possibility for legal assistance with PTAB proceedings. In addition, both the USPTO and the PTAB Bar Association have conducted outreach activities in person and virtually with inventor groups, bar associations, entrepreneurial organizations, and administrators for Patent Pro Bono. These activities have included presentations and discussions.

F. Opportunities for Future Expansion

PTAB Pro Bono was created to reduce financial barriers for under-resourced parties that appear before the PTAB. The PTAB's legal proceeding may be difficult for an individual to navigate without the assistance of competent legal representation. PTAB Pro Bono has successfully matched under-resourced inventors with volunteer patent practitioners, but there are opportunities to do more in the future.

The PTAB Bar Association has noted that some members of the public have found it unclear which USPTO pro bono program is available to help with a particular situation. For example, members of the public have, on occasion, contacted PTAB Pro Bono to obtain assistance with filing patent applications. When that occurs, the PTAB Bar Association refers those individuals to the Patent Pro Bono Program.

In an effort to achieve greater clarity, PTAB Pro Bono and the Patent Pro Bono Program have taken steps to distinguish the two programs. First, each has added links to its webpage directing members of the public to the appropriate webpage for their circumstance. Second, the USPTO has a webpage listing all its free services to allow members of the public to select the service most appropriate for their needs (www.uspto.gov/learning-and-resources/access-our-free-services). PTAB Pro Bono and the Patent Pro Bono Program are separately listed on this free services webpage. Third, patent examiners can include information about assistance with legal proceedings in final rejections issued to pro se applicants. It has been proposed that such notifications be included in all final rejections. This proposal is under consideration.

Currently, PTAB Pro Bono assists inventors only with ex parte appeals before the PTAB, and the volunteer representation ends with the receipt of a decision on the ex parte appeal. Proposals have been made to expand the scope of PTAB Pro Bono. One proposal is to help inventors with appeals to

the U.S. Court of Appeals for the Federal Circuit in cases in which the inventor is unsuccessful in its arguments before the PTAB. Another proposal is to expand PTAB Pro Bono to contested cases under the America Invents Act (e.g., inter partes reviews and post-grant reviews). A last proposal is to provide assistance to inventors with licensing negotiations for issued patents. These proposals are all under consideration.

At this time, the USPTO provides no funding to support PTAB Pro Bono. Some proposals have suggested the provision of greater financial support. For instance, more inventors may be able to make use of the program if funding were available to offset or eliminate USPTO fees for these appeals. Currently, recipients of pro bono assistance are required to pay all applicable USPTO fees. These fees can amount to over \$1,200 per appeal, and for financially under-resourced inventors, that amount may present a significant barrier. In addition, the PTAB Bar Association incurs costs to administer the program. A cost-sharing agreement with the USPTO may enhance the PTAB Bar Association's ability to administer this program. These proposals are under consideration, too.

G. Conclusion

Financial barriers should not stand in the way of promoting innovation. Through PTAB Pro Bono, individual inventors, inventor groups, and inventor-owned small businesses have an avenue to obtain free legal assistance with PTAB ex parte appeals in spite of financial constraints that would have otherwise left them without competent legal assistance. PTAB Pro Bono is one more step forward in making the U.S. patent system accessible to all without regard to financial need and in bringing even more innovation to impact.

APPENDIX B - Overview of the TTAB Pro Bono Program

A. Introduction

The Leahy-Smith America Invents Act (AIA) encourages the United States 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.”

In furtherance of that goal, the Trademark Trial and Appeal Board (TTAB or Board) Pro Bono Clearinghouse Recognition Program (Recognition Program) recognizes organizations meeting specific criteria, explained further below, that coordinate the provision of free legal services to members of the public who have business before the TTAB, and who might not otherwise have affordable access to such legal assistance. The Recognition Program launched in January 2022 with the recognition of the Pro Bono Clearinghouse operated and administered by the International Trademark Association. The Recognition Program is open for expansion to additional pro bono legal service coordinators and accepts applications on a rolling basis.

B. Overview

Although the Trademark Rules of Practice allow a party to represent itself in a TTAB proceeding, it is strongly advisable for parties to secure the services of an attorney who is familiar with the technicalities of the procedural and substantive law involved in proceedings before the Board. However, securing the assistance of an attorney is beyond the means of many under-resourced individuals and organizations. The TTAB seeks to expand the number of individuals and organizations who qualify to receive free legal assistance in connection with inter partes and ex parte matters by recognizing clearinghouses that match such parties with attorneys who are willing to handle cases on a pro bono basis.

The Recognition Program recognizes clearinghouses that certify that their programs meet the following criteria:

1. Legal services are provided by an individual who is an active member in good standing of the bar of the highest court of any state, which includes the District of Columbia and any U.S. commonwealth or territory. See 37 C.F.R. § 11.1; TRADEMARK MANUAL OF EXAMINING PROCEDURE § 602.01 (2023).
2. Legal services are provided to clients who are financially under-resourced (such as individuals; small to medium-sized enterprises; and not-for-profit, nonprofit, or charitable organizations with low operating budgets) on a nondiscriminatory basis.
3. Participating practitioners may neither ask for nor receive any fee or compensation of any kind for legal services from a client referred by a recognized clearinghouse on whose behalf service is rendered, unless circumstances change (such as the nature or scope of services or the financial eligibility of the client).

4. Participating practitioners have a process to ensure that no conflicts exist with the representation of clients referred by the clearinghouse.
5. Participating practitioners must carry legal malpractice insurance.
6. Lead practitioners assigned to represent a party before the TTAB agree to remain counsel of record in the proceeding until completion, unless they move to withdraw pursuant to the Trademark Rules of Practice. See 37 C.F.R. § 11.116.
7. Lead practitioners assigned by the clearinghouse to represent a party before the TTAB must certify that they are familiar with the Trademark Rules of Practice and the Trademark Board Manual of Procedure and have:
 - a. Acted as a counsel of record in at least two proceedings before the TTAB at least through service of written discovery; or
 - b. Completed an educational or training program on TTAB practice approved by the clearinghouse; or
 - c. Practiced in the trademark field for at least three years.

C. Recognition Program Statistics

The size and scope of this program are limited, and recognized clearinghouses may not have a suitable volunteer available for every qualified applicant. Thus, qualifying for assistance does not guarantee that every applicant will receive representation.

Statistics regarding the Recognition Program are not yet available. The TTAB anticipates that it may, in the future, request that organizations participating in the Recognition Program provide the TTAB Pro Bono Coordinator with periodic reports regarding pro bono clearinghouse activity, such as: the number of prospective clients who inquired about receiving pro bono services in TTAB matters, the number of clients who received a referral to a participating practitioner for pro bono services in TTAB matters, the number of attorneys who volunteered to provide services through the pro bono clearinghouse, information about backlogs of those waiting to be matched with a practitioner, a list of pending proceedings referred by the clearinghouse that are being handled by participating practitioners, the number of hours expended by participating practitioners on proceedings referred by the clearinghouse and blended average hourly rates for the same, and demographic information regarding clients.

D. Benefits of the Recognition Program

The goal of the Recognition Program is to serve clients who are financially under-resourced (including individuals; small to medium-sized enterprises; and not-for-profit, nonprofit, or charitable organizations with low operating budgets) that might not otherwise have affordable access to legal assistance. The participating organizations will have the opportunity to establish referral clearinghouses to match eligible clients participating in proceedings before the TTAB with outside attorneys who volunteer to provide services free of charge.

Participating counsel will benefit from clearinghouse pro bono programs that are part of the Recognition Program by having the opportunity to engage in substantial and meaningful direct interaction with clients who might not be able to afford legal counsel in matters before the TTAB. Such representations offer less experienced counsel the opportunity to develop the skill of practicing before the TTAB. This opportunity may not be available to them by representing paying clients. In addition, these interactions offer more experienced counsel the opportunity to train the next generation of TTAB practitioners without billing constraints.

Because qualified practitioners are critical to the success of the Recognition Program, to incentivize future participation the TTAB may commence additional programs to publicly acknowledge volunteer practitioners. In addition, the TTAB may work with organizations to develop educational materials to train attorneys who are new to TTAB practice.

E. Conclusion

One of the main goals of the USPTO is to provide all Americans with the opportunity to participate fully in the innovation ecosystem, which helps drive our economic growth. The USPTO is committed to providing enhanced access and support to innovators, creators, entrepreneurs, and brand owners across the country, regardless of economic resources. Through the Recognition Program, the TTAB hopes to expand access to qualified legal representation to individuals, small to medium-sized enterprises, and not-for-profit, nonprofit, or charitable organizations with low operating budgets, and to promote the education and training of trademark practitioners.

APPENDIX C - Transcript of Practitioner Listening Session

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

June 07, 2023

JOB #23836

This transcript is being provided in an edited format. Communication Access Realtime Translation (CART) is provided in order to facilitate communication accessibility and may not be a totally verbatim record of the proceedings. Due to the nature of a live event, terms or names that were not provided prior to the assignment will be spelled phonetically and may or may not represent the true spelling.

DAVE 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 patent 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. 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 pro bono program 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 share your experiences, your success stories, your challenges with us. 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 pro bono program 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 to 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 Silbermann 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 Silbermann, Senior Counsel for Intellectual Property Services at the USPTO. In part of that role, I oversee the patent pro bono program which we are here today to gather some information about 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 patent pro bono program. 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 includes the Unleashing American Innovators Act 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's 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 that 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 today in this proceeding. 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. So, 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 patent pro bono program from Kim Kelleher. We'll then have an overview of the PTAB Pro Bono Program from Vice Chief Judge Janet Gongola of the Patent Trial and Appeal Board.

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 Thuente and also chair of the Pro Bono Advisory Council. We have Deborah Miron, Director of the not-for-profit program that runs the patent pro bono program in the District of Columbia and state of Maryland and Virginia. We next have Warren Tuttle. He's the Open Innovation Director of MarketBlast. He's also a Pro Bono Advisory Council board 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 timely. So, with that, let's get started. Most of you know this. The patent pro bono program 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 actually happens through our 20 regional programs that actually work to match the inventors and the practitioners. There's 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 out those financially underserved communities and inventors as 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, what that results in for the PTO is an improvement in patent quality because the inventors are submitting applications that have assistance from the patent practitioners so we get increase in patent quality.

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 with 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' inquiry, patents filed and number of inventors assistance. So that's a good thing. We do see a little bit of a downtick from 2020 on 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 life of program total, total life of the program I guess is another way to say that, 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 is 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 up 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 patent pro bono program is actually able to meet those, the 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. 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 on additional requirements in addition to these, 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 a provisional application on file with us, or they could have completed a certificate training for us, which is available online and is also available in Spanish. The third criteria is that they have to 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 has to 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 already. We are hosting two listening sessions. One is today. One 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 patent pro bono program. It's for ex parte appeals in front of the Patent Trial and Appeal Board. 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 patent pro bono program, 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. So 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.

Okay. 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 patent pro bono program is singular. We have one clearinghouse, the PTAB Bar Association that administers the program nationwide. I'll tell you more as we go on about the role that the PTAB Bar Association plays. Now, our program is what launched a year ago. We are indeed new. We are limited to ex parte appeals. Not appeal of the 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 the program up. So in the spring, we did a few different things to expand the program already. 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 to not restrict inventors' previous experience with the patent system when applying for pro bono help. We, this year, anticipate we're going to have 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 patent pro bono. 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 have to seek help within one month of the date of either a final rejection or a second office action rejection. That one month clock set in place in order for the attorneys to have sufficient time to work with a case, learn the technology, write the briefing and file the papers with the Patent Trial and Appeal Board. The inventor also must demonstrate some form of knowledge about the program and the appeal process. The reason we have this knowledge requirement is so that inventors will have their 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. We're trying, through this program, to help those who do not have the financial resources to help themselves. So really seems 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. What success is met through these matches? And report that success to all of you. The PTAB Bar Association runs the program

independent 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 publicizes the availability of this free legal help. Of recognizing inventors who have come through the program, recognizing volunteer practitioners. We are there to help 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 set to give inventors an assurance that the volunteers are competent, capable and they're 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. Right now we're limited to ex parte appeals so we don't want to use the patent pro bono program 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 kind of 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 lay out what services will be covered. We don't want inventors to be confused that they think they have an attorney for any and all purposes that they need when, in fact, the attorney is there to represent them only in their matter before the Patent Trial and Appeal Board. 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 appeal process.

Okay. Now the transition. 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 out an email to all of the volunteers asking, who would like to represent this 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, the bar association, after one month, if they cannot find a volunteer attorney, they 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. Okay.

Now the last thing I want to leave you with are the resources of where to go for more information about what I spoke on today. The slide here lists for you a variety of websites, the PTAB bar association website, USPTO website where you can go to find information to sign up on 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 one other 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. So thanks, 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. After that, after this panel discussion, we're then going to open it up and you can raise your hand, unmute your mic and provide comments verbally. With that information, again, as Kim and Janet had mentioned, the USPTO is really cheerleaders for this patent pro bono program. AIA says we're supposed to encourage the establishment of these programs. And so the people that are really doing the work I hope people think I'm doing work. The people really doing the work are to my right. So to hear from them and get their perspective on the program is very important. So let me start immediately to my right by introducing Jim Patterson. Jim Patterson is the principal and founder of Patterson Thunete IP located in Minneapolis, Minnesota. The patent pro bono program got its start 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 patent pro bono program in over 50 states. Internationally, Jim continues his role in the creation of an expansion of the international patent pro bono program. 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 her former by the former U.S. Attorney General Eric Holder for the extraordinary assistance for 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 on military and personnel issues in the Pentagon and supervised the 18 legal offices in the United States within the department. And 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, 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 and 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 501c3 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, startup, 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 patent pro bono program 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. I think they will provide us a lot of information. At the end of their presentation, we'll have an opportunity to hear directly from you. Without much 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 on the patent pro bono program.

JIM PATTERSON: Thanks. I have been involved from the very beginning and I have been it's been a delight and highlight of my career to see the interaction between the patent office. 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 on the patent pro bono program?

DEBORAH MIRON: Thank you. Thanks for having us. 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 has not just this patent pro bono program, even in patent 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 they have, 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 then, if they can't take the case they enlist their help. 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, 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 who I call the Nelson Mandela of the pro bono program. 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. Inventors Association. When Jim asked me to get involved, I jumped at the opportunity. The patent pro bono program is symbolic for 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 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 that 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's 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 of 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. From the inventors, they're getting free counsel. Not only for patents, but also oftentimes get free counsel in a lot of other areas around patent, licensing, contract work, freedom to operation. And then from, you know, from the attorneys' side, the benefits are, there's a number of them, 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. Lot of practical experience that you get. Then lastly there's the benefit of just developing a network, additional resource. 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 patent pro bono program? 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 patent pro bono program through the U.S. Patent and Trademark Office there's 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 resources. There's 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 on. 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 out 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 patent pro bono program?

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 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, 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. Well 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 any legal developments and interests, are really people 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 we talked

about, 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 501c3. 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 on the patent office. 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's, 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 patent pro bono program? I'll start with you, Jim? What would you like to see improved in the patent pro bono program?

JIM PATTERSON: A focus on the hubs. A focus on staffing the hubs. Certainly the patent office 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 as 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 the central 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 no 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 patent pro bono program, 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 conflict 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. It depends. 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 cost to put one of these events on. 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 let you know, this is my fault for not informing you. There is a pro bono cert form. You can go on 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 really 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 interparty 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 patent pro bono program, 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 sort of 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 patent pro bono program. 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 somebody at the PTAB bar up 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 you 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 actually not even the patent process but for the trademark 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 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 the 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, 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 willing to 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 and I don't perceive 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 that that the 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 mind 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. That actually 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. Right now is an actively under consideration.

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

RUDOLPH 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 with 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, however it's submitted it's 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's 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.

APPENDIX D - Responses to Written Comments

Commenter	Comment	Response
<p>365 Productions Inc</p>	<p>Thank you for allowing this platform for comments. As a business owner of a creative company and an inventor following specific suggestions from my SCORE mentor, I decided to follow up on the Pro Bono Program by completing the required training on the USPTO site, I registered to have direct access and apply for patents to four different inventions, but I wanted to make sure I was properly doing what it is required and with the professional Pro Bono assistance. I contacted two different Pro Bono lawyers in Mobile, Alabama who are listed as part of the program, but I received no response in return after several times during a two months period I tried. Next, I tried a different location in Birmingham, Alabama and the same situation was duplicated and this time I also tried by email communication.</p> <p>In addition, during the attendance to a USPTO webinar about the Pro Bono process of patents and trademarks registrations I was allowed to reach out to the presenter and I did mentioned my past experience. I was instructed to email her at the Colorado office for further assistance with my Pro Bono request, but as of this date I have not received any response back.</p> <p>As learned from getting very involved in the USPTO process for filling, it is understandable that the workload is extremely high with the many applications received every month, but after I have tried these many times in these different ways and always followed instructions, it has become a bit discouraging following up on the Pro Bono program. Unfortunately, not a good fit for an inventor who wants to make the world better with good useful inventions.</p>	<p>The Patent Pro Bono Program is a network of 20 regional not-for-profit programs that are associated with the USPTO’s efforts to promote the availability of free patent legal services to under-resourced inventors and small businesses. The USPTO does not directly provide legal services to the public. Interested parties must apply through the regional program for their geographic region. You can learn more about the USPTO Patent Pro Bono Program by visiting the website at www.uspto.gov/probonopatents. Click on your state on the map to identify the specific regional program that accepts applicants in your state. Once you are directed to the website for your program, you can follow their instructions for applying to the program online. To be considered for participation, you must submit an application to a regional program. See pages 33-35 of the Report for additional information on applying to a regional program.</p>
<p>Anonymous</p>	<p>Universities and Non-Profit research institutions have long struggled to patent their technology due to cost. Small entity status can be helpful. Grant funding that can cover patenting costs is also very helpful. However, discounted fees and help in covering the cost of preparing and prosecuting IP rights in the US and abroad does not permit many to go beyond a provisional or PCT filing without a licensee. For over 40 years,</p>	<p>Public service work, including work not traditionally classified as pro bono work, is crucially important. In 2016, the American Bar Association surveyed attorneys regarding the type of public service work they performed outside of pro bono. April Faith-Slaker, <i>Supporting Justice: A Report on the Pro Bono Work of America’s Lawyers</i>, ABA Standing Comm. On Pro Bono (2018). Reduced fee legal</p>

	<p>our firm has offered discounted rates for legal services to universities and non-profits as part of our mission. We have deep roots in the academic world and appreciate the challenges of identifying and protecting IP created in the basic research environment. Creating an IP position allows for researchers to collaborate freely and is a crucial component of the innovation ecosystem. It provides a basis for inter-institutional cooperation and agreements, and a pathway to collaborate with, and obtain research funding from, commercial partners. Providing affordable, non-profit rates allows for the creation of high quality IP that can hold its own over the years of research and development necessary to move the technology into the clinic and market place. We have never considered this pro bono, but rather giving back to the non-profits that contribute so much to everyone's well being. The long term relationships and successes over the years are very meaningful, and because our business model is built around doing this work, it has been sustainable as well.</p>	<p>service was the most common form of such public service. Approximately 20% of the attorneys engaged in public service work reported that they provided reduced fee legal services, with an average of 73.1 hours per year. Reduced fee services and pro bono play important roles in helping under-resourced entities bring their innovations to the marketplace. See page 13 of the Report mentioning reduced fee legal assistance.</p>
Sundus Baig	<p>Patent Pro Bono Program can benefit more applicants if at least a threshold number of patent or trademark practitioners are available on any given day to provide pro bono services for prosecuting patent or trademark applications or litigating their appeals before PTAB or TTAB. One untapped in-house resource, which PTO can deploy in furthering this goal, is patent examiners with law degrees and trademark attorneys. These employees, as part of a separate managerial unit, would only provide pro bono patent and trademark representational services to applicants and not any examination services, thus addressing any conflict of interest. Moreover, this managerial unit would operate in the same manner as a public defender's office providing services in civil law.</p>	<p>The USPTO encourages the establishment of patent pro bono programs across the United States to provide under-resourced inventors and small businesses with free legal services. To support these programs, the USPTO provides technical, logistical, and financial support. The USPTO does not directly provide legal services to the public. Generally, attorneys who are employed by the USPTO cannot represent a client in a matter where the United States is a party or has an interest. As the United States has an interest in the issuance of patents, USPTO employees may not provide pro bono services related to obtaining a patent. Furthermore, USPTO employees generally cannot engage in pro bono representation before a Federal agency or Federal court. See <i>generally</i> 5 C.F.R. § 2635.801. The USPTO is working to encourage greater practitioner participation in the program. See Report at page 15 regarding USPTO efforts to encourage practitioner participation in the Patent Pro Bono Program.</p>
Anita Rose	<p>Please assist small-time arts people the means to assist with patent messes not of our making</p>	<p>The USPTO provides critical assistance to under-resourced inventors, serving as a bridge to an inclusive innovation economy. Interested</p>

	like mine.	parties may apply through the regional program for their geographic region. You can learn more about the USPTO Patent Pro Bono Program by visiting the website at www.uspto.gov/probonopatents . See pages 32-34 of the Report for a discussion of the individuals assisted through the Patent Pro Bono Program.
Marc Brown	I am a highly experience[d] retired patent attorney that would do more pro bono patent work if the patent office provide malpractice insurance that covered this work.	More than half of the regional pro bono programs provide some form of malpractice insurance to cover their volunteers, addressing a major factor that deters attorneys from providing pro bono assistance. The following programs provide malpractice insurance: Arts and Business Council of Greater Boston, Arts and Business Council of Miami, Delaware Law School, Georgia Lawyers for the Arts, Idaho Patent Pro Bono Program, LegalCorps, Louisiana Invents, New York Volunteer Lawyers for the Arts, Ohio Invents, PatentConnect, Texas Accountants and Lawyers for the Arts, and Volunteer Lawyers of Birmingham. Due to the federal nature of practice in patent matters before the USPTO, attorneys concerned about obtaining malpractice insurance may choose to participate in a program that offers insurance. See page 15 of the Report for a discussion of malpractice insurance.
Inventors Groups of America	I am writing in regards to Question 9: Are prospective participants aware of the patent pro bono programs? What more can be done to improve awareness of the pro bono programs for these participants? As a leader of the largest group for inventors online, I am concerned that prospective participants are not aware of the patent pro bono programs. Inventors understand the importance of protecting their intellectual property. The thought of having their idea stolen fills them with fear. One of their first questions is, how am I going to protect this? The high cost of getting a patent is a barrier for inventors, especially those with fewer resources. A frequent question that we hear at Inventors Groups of America is how and where to get free legal help with a patent application. When informally polled, less than half of IGA members said they knew about the patent pro bono programs. This is despite hosting guests from the USPTO for educational presentations numerous times over the past	<p>To increase awareness, the USPTO is heavily promoting the Patent Pro Bono Program. The USPTO Patent Pro Bono Program plans and executes Pathways to Inclusive Innovation events for inventors and entrepreneurs. The events are held quarterly across the country and welcome inventors who are interested in learning more about protecting intellectual property, securing funding, and growing a network. The events significantly promote the free services offered through the regional pro bono programs. Pathways events are conducted in cooperation with the Pro Bono Advisory Council and the Small Business Administration.</p> <p>The USPTO Patent Pro Bono Program conducts additional ongoing public outreach through multiple communication formats. In addition, to educate inventors and highlight resources like the PPBP, the USPTO hosts a three-day Stakeholder Training on Examination Practice</p>

	<p>few years. The word is not getting out fast enough.</p>	<p>and Procedure (STEPP) for inventors that highlights the patent pro bono programs.</p> <p>The USPTO Regional Offices in Michigan, Texas, Colorado, and the Eastern Regional Outreach Office at Headquarters, engage in significant promotion of the Patent Pro Bono Program through outreach across the country. Many of the outreach activities collaborate with the Small Business Administration (SBA) and Small Business Development Center (SBDC) to promote USPTO resources such as the PPBP. See pages 29-32 of the Report for a discussion of public outreach.</p>
Kathleen Lynch	<p>I have been involved in the Patent Pro Bono program in North Carolina since its inception. One major issue I believe we have is that many entrepreneurs and small business owners who otherwise might qualify for the program do not know about it. I think there needs to be a media campaign to target entrepreneurial and small business communities to let folks know about the program.</p>	<p>Please see above discussion. Furthermore, the PPBP is creating new media to publicize PPBP inventor success stories. The USPTO shares these stories through its website and social media accounts.</p> <p>See pages 29-32 of the Report for a discussion of public outreach.</p>
American Intellectual Property Law Association (AIPLA)	<p>Full comment is too long to include in table and is available upon request. AIPLA expressed that, while attorneys were familiar with the USPTO Patent Pro Bono Program, they were less familiar with their regional pro bono program. AIPLA recommended that the regional pro bono offices reach out to bar associations and law firms within their local area to build stronger connections. AIPLA also recommended expanding the program to enable non-lawyer participation.</p>	<p>The regional pro bono programs currently interact with bar associations and law firms to encourage participation in the regional programs. The programs will continue to grow and cultivate those efforts. For a further discussion of outreach efforts, please see page 9 of the Report. Patent agents currently participate in the Pro Bono Program. Data collected by the Pro Bono Program indicates that more than 20% of patent applications filed through the pro bono program are filed by patent agents. For more details on patent agent participation in the program, see pages 17-19 of the Report. Furthermore, the PBAC is establishing partnerships with patent search providers to provide discounted patent search services. For more details on PBAC's efforts to collaborate with non-attorney resources, see page 19 of the Report.</p>
Anonymous	<p>Entrepreneurship is, and should remain, outside of the USPTO's purview. That is the job of the Small Business Administration (SBA). The recent shift towards entrepreneurship distracts the USPTO from its mission . . . A patent is not a lottery ticket. Most small business / solo inventors don't know what to do with a patent</p>	<p>The USPTO collaborates with the Small Business Administration and other government agencies. For example, the SBA is currently involved in the Pathways to Inclusive Innovation events for inventors and entrepreneurs. The events are planned quarterly across the country and welcome inventors who are interested in</p>

	<p>once they get it. Science and technology rarely translate to business acumen. The Patent Office should collaborate with the SBA. In that collaboration, the Patent Office can provide informational resources about the patent process to the SBA, including the availability of programs like the Patent Pro Bono Program. The SBA can then use its established methods to provide information and support to entrepreneurs . . .</p>	<p>learning more about protecting intellectual property, securing funding, and growing a network. The events significantly promote the free services offered through the regional pro bono programs. For further information on the Pathways to Inclusive Innovation events and collaboration with the SBA see page 30 of the Report.</p>
Anonymous	<p>This comment is too long to reproduce in its entirety but is available upon request. The commenter expressed his frustration with his experience volunteering with the program. He stated that the program did not provide him with sufficient client information to perform an adequate conflict check. He also expressed concern that law firms were using the program to let their associates get training and experience on pro bono clients. The commenter suggested that law school clinics could successfully house regional pro bono programs. Finally, he suggested that the regional programs should review their case management systems and recruit experienced attorneys.</p>	<p>Generally, the regional pro bono program provides the volunteer practitioner with basic information about the applicant, such as name, title, address, and a description of their invention. The volunteer patent practitioner should be able to use this information to do a conflict check and identify the technology area of the invention. At the next administrators' meeting, the Patent Pro Bono Program will discuss best practices with the regional program. See page 9 of the Report for a discussion of information provided to volunteer practitioners. Regarding the concern that the program is being used for training purposes, generally practitioners must have at least three years of patent prosecution experience to participate in the program. Regarding the suggestion that pro bono programs be housed by law schools, the USPTO works with law schools to encourage the provision of free legal services to inventors. For example, the Pennsylvania pro bono program is hosted by The Penn State Law Intellectual Property Clinic. The regional programs continue to review and improve their case management systems.</p>
Invent Together	<p>This comment is too long to reproduce in its entirety but is available upon request. The commenter suggested that pro bono assistance be expanded to include enforcement of rights in federal district court. Regarding the current programs, Invent Together suggested that the USPTO implement one nationwide set of criteria for inventor participation. In addition, Invent Together suggested that the USPTO provide financial assistance so that the regional programs may support applicants with incomes up to 400% of the federal poverty level. Finally, Invent Together suggested that the Pro Bono Program increase awareness of the program</p>	<p>The USPTO is currently working with the regional programs to expand eligibility to an individual living in a household, the gross income of which is not more than 400% of the Federal poverty line. See page 35 of the Report for a discussion of the expansion of income eligibility. The USPTO is taking action to introduce plain language on the webpage and other promotional materials. See page 30 for a discussion of changes to the USPTO webpage. Regarding implementing one nationwide set of criteria for inventor participation, the regional programs face structural limitations that would make such a change extremely difficult. Please</p>

	and alter the terminology surrounding the program.	see pages 35-36 of the Report for a discussion of the programs' structural limitations.
Fair Inventing Fund	This comment is too long to reproduce in its entirety but is available upon request. The Fair Inventing Fund recommended that the USPTO canvas the pro bono programs to determine if any would participate in a pilot program for patent litigation. In addition, the commenter suggested reaching out to bar associations to recruit lawyers. Third, the commenter suggested that the USPTO join the White House Legal Aid Interagency Roundtable.	The regional pro bono programs currently interact with bar associations and law firms to encourage participation in the regional programs. The Patent Pro Bono Program frequently gives presentations to national and local bar associations. We will continue to grow and cultivate those efforts. For a further discussion of outreach efforts, please see page 6 of the Report.
Michael Darden	This comment is too long to reproduce in its entirety but is available upon request. The commenter suggested that the pro bono programs should assist with enforcement. In terms of concrete, specific steps for the programs, Mr. Darden recommended: (1) utilizing a different method for calculating financial participation, (2) utilizing non-attorneys for the programs, and (3) expanding the program to include disabled or neurodiverse inventors.	Regarding licensing, many volunteers have expressed an interest in providing additional services to inventors to help them succeed. In addition, the PBAC is looking to encourage the expansion of provided services. PBAC has partnered with a firm to provide no-cost services to connect patent pro bono inventors with businesses interested in licensing their inventions. For more information on PBAC see www.probonoadvisorycouncil.org . The 300% financial threshold was developed by the America Invents Act Pro Bono Task Force (a forerunner to the Pro Bono Advisory Council) pursuant to the Leahy-Smith America Invents Act. In the UAIA, Congress directed the USPTO to work with the regional programs to increase from 300% to 400%. See page 35 of the Report. Patent agents currently participate in the Pro Bono Program. Data collected by the Pro Bono Program indicates that more than 20% of pro bono patent applications filed by patent pro bono practitioners are filed by patent agents. For more details on patent agent participation in the program, see pages 17-19 of the Report. The Pro Bono Program is available to provide free legal services to individuals with disabilities. The regional programs do not preclude those with disabilities from participating. Generally, the regional programs screen applicants to determine if they meet financial, residency, and other requirements. Inventors who meet the requirements may participate. See page 32 of the Report for a discussion of participation requirements.
PTAB Bar Association- Comment on	The PTAB pro bono program was launched one year ago on June 1, 2022. During its first year of operations, the Association accepted	See PTAB Pro Bono Appendix § E

<p>whether program is sufficiently serving existing participants</p>	<p>over 60 volunteers willing to provide pro bono representation for <i>ex parte</i> appeals, and every accepted PTAB pro bono applicant has been matched with an attorney for representation.</p> <p>Additionally, as of March 2023, the program has been modified to enable more inventors to qualify for free legal assistance. Specifically, inventor groups and inventor-owned small businesses are now eligible in addition to solo inventors. Further, the micro entity status requirement was removed, and the income requirement was increased from 300% to 400% of the federal poverty guidelines.</p>	
<p>PTAB Bar Association-Comment on whether barriers exist that prevent the program from sufficiently serving participants</p>	<p>The Association submits reaching target participants is a barrier for the program. There is no single vehicle to publicize the availability of the program to inventors. As a result, word of the program has been slow to spread within the inventing community. The Association recommends increased advertising and marketing of the PTAB pro bono program to inform potential participants about the program.</p> <p>Additionally, some inventors are confused about the type of assistance offered through the programs. The Association often receives correspondence from inventors in need of help with filing an application as opposed to appearing before the PTAB in an <i>ex parte</i> appeal. The Association redirects these inventors to the PATENTS pro bono program. To alleviate this confusion, the Association recommends that the USPTO create a single webpage explaining the services offered through the PATENTS and PTAB pro bono programs and the Pro Se Assistance Program as well as the timing constraints for applying for help.</p>	<p>See PTAB Pro Bono Appendix §§ E, F</p>
<p>PTAB Bar Association-Comment on whether there</p>	<p>The PTAB pro bono program enables an inventor to secure help in filing an <i>ex parte</i> appeal following a second or final examiner rejection. The program ends when an</p>	<p>See PTAB Pro Bono Appendix § F</p>

<p>are additional services participants would like to see the patent pro bono programs provide.</p>	<p>inventor receives a decision from the PTAB. If an inventor is not successful before the PTAB in securing a reversal of the examiner's rejection, one option for the inventor is to appeal to the U.S. Court of Appeals for the Federal Circuit. The program may benefit from an expansion to include Federal Circuit appeals from adverse <i>ex parte</i> PTAB decisions.</p>	
<p>PTAB Bar Association-Comment on whether the pro bono programs are sufficiently serving prospective participants</p>	<p>Yes. The PTAB pro bono program responds to all inquiries by prospective participants and recommends additional resources to prospective participants that do not qualify for the PTAB pro bono program which include referring prospective participants to the PATENTS pro bono program and the Pro Se Assistance program.</p>	<p>See PTAB Pro Bono Appendix § E</p>
<p>PTAB Bar Association-Comment on whether there are barriers to sufficiently serving prospective participants</p>	<p>As noted earlier for Question 3, inventors regularly confuse the type of free legal help available through the PATENT and PTAB pro bono programs and Pro Se Assistance Program. The USPTO could help prospective participants by clarifying the scope of each program, explaining the differences between them, and highlighting the timing for when each program is applicable. In addition, as mentioned earlier, the PTAB pro bono program currently is limited to free legal assistance for <i>ex parte</i> appeals. Expanding the PTAB pro bono program to include pro bono representation in AIA trials is currently being evaluated.</p>	<p>See PTAB Pro Bono Appendix §§ E, F</p>
<p>PTAB Bar Association-Comment on whether the programs are sufficiently funded</p>	<p>There is currently no funding from the UPSTO to support the PTAB pro bono program. The Association relies on volunteer members to administer the program. In doing so, the Association is able to minimize operational costs. The Association funded the creation of the website and currently pays for the website to be maintained. If the program expands significantly, funding may be needed to cover operational costs, for example, the salary for a non-volunteer administrator to run the program.</p>	<p>See PTAB Pro Bono Appendix § F</p>

PTAB Bar Association- Comment on whether participation requirements are a deterrent	No. The Association believes the current participation requirements are balanced and do not deter prospective applicants. As noted earlier, both inventor groups and inventor-owned small businesses are now eligible in addition to solo inventors. Also, the micro entity status requirement was removed, and the income requirement was increased from 300% to 400% of the federal poverty guidelines.	See PTAB Pro Bono Appendix §§ A, C
PTAB Bar Association- comment on whether prospective participants are aware of the programs	The Association and the USPTO have taken many steps to advertise and inform the public of the availability of the PTAB pro bono program, including hosting webinars, webpages, emails, video meetings with prospective applicants, video conferences with regional directors and the other pro bono administrators, press releases, and Association events. Both the Association and USPTO are continuing these efforts. Again, the Association recommends a single webpage explaining the free legal services covered by the PATENTS and PTAB pro bono programs and Pro Se Assistance Program to better serve the participants of the different programs.	See PTAB Pro Bono Appendix § F
PTAB Bar Association – Comment on whether removing participation requirements would be a deterrent to practitioner participation	Yes. The Association submits that volunteer attorneys and agents are looking to assist under-resourced participants who are not able to afford representation. Accordingly, removal of the income requirement may deter some volunteers from participating in the program. The Association submits that the current participation requirements are appropriate and balanced.	See PTAB Pro Bono Appendix § C
PTAB Bar Association- Comment on	The Association understands that conflicts of interest and the limited time frame for <i>ex parte</i> appeals may deter attorneys from	See PTAB Pro Bono Appendix §§ D, E

<p>factors deterring attorney participation</p>	<p>volunteering to participate in the PTAB pro bono program. As to the latter, a Notice of Appeal must be filed within three months of receiving a second or final rejection and an appeal brief must be filed within two months of the Notice of Appeal to avoid late fees associated with extensions of time. Thus, very shortly after accepting representation, attorneys must have adequate time on their calendars readily available to confer with inventors and draft the needed brief or response.</p> <p>The amount of time needed to file an <i>ex parte</i> appeal and the immediacy of the due dates present barriers for greater participation.</p>	
<p>PTAB Bar Association- Comment on recommended steps to dramatically increase pro bono representation</p>	<p>The USPTO should take more actions to engage innovators and inform them about the pro bono programs. For example, as mentioned, the USPTO should create a website for “Free Help” to centralize all information about pro bono assistance and pro se assistance so those unfamiliar with the legal and patent process can find the information and understand it in layperson terms. Additionally, the USPTO could enhance existing public outreach events, such as Invention Con, stadium tours, and the Inventor Hour Series, to increase advertising and marketing of the pro bono programs.</p> <p>The Association likewise suggests including a form paragraph about the availability of the PTAB pro bono program in ALL in Final Office Actions to raise awareness of the PTAB pro bono program among applicants and practitioners at the precise time when they are faced with the decision of whether to file an <i>ex parte</i> appeal.</p> <p>The Association further submits that the USPTO should consider waiving USPTO fees for participants as a way to increase the number of program participants. Participation may increase if the PTAB pro bono program includes funding to cover the</p>	<p>See PTAB Pro Bono Appendix § F</p>

	<p>cost of Notice of Appeal fees, Appeal Forwarding Fees, RCE fees, etc. as these fees, even, at the small and micro entity status level, may deter participants. For example, for a small entity, the Notice of Appeal fee is \$336 and the Appeal Forwarding fee is \$944. Providing \$13,000 in funding would cover appeal fees for 10 small entities. Lastly, in order to significantly increase the <i>ex parte</i> participant pool, the Association submits the income requirements would need to be increased.</p>	
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APPENDIX E - Malpractice Insurance Coverage

Program	State(s) Served	Malpractice Ins.	Website
(ABCGB) Arts & Business Council of Greater Boston	Maine, New Hampshire, Vermont, Massachusetts, Rhode Island	Yes	artsandbusinessccouncil.org
California Inventors Assistance Program	Hawaii, Alaska, California, Nevada, Oregon, Washington	Not widely offered	calawyersforthearts.org
New York Volunteer Lawyers for the Arts	Connecticut, New York, New Jersey	Yes	vlany.org
Michigan Pro Bono Patent Project	Michigan	Potentially available through bar programs	michbar.org
ProBoPat	Colorado, Montana, Wyoming, Utah, New Mexico	No; Colorado Chapter of Corporate Counsel offers malpractice insurance	micasaresourcecenter.org
Ella Project	Louisiana	Yes	ellanola.org
Saint Louis University	Nebraska, Kansas, Oklahoma, Arkansas, Missouri	No	slu.edu
Texas Accountants and Lawyers for the Arts	Texas	Yes	talarts.org
PatentConnect	Indiana, Kentucky	Yes	patentconnect.org
Federal Circuit Bar Association	Maryland, District of Columbia, Virginia, West Virginia	No	fedcirbar.org
Georgia Lawyers for the Arts	Georgia, North Carolina, South Carolina	Yes, for patent attorneys	gapatents.org
Volunteer Lawyers Birmingham	Alabama, Mississippi	Yes	vlbham.org
Penn State Intellectual Property Clinic	Pennsylvania	No	psu.edu
Arts and Business Council of Miami	Florida	Yes	artsbizmiami.org
Chicago-Kent	Illinois	No	lit.edu
Ohio Invents	Ohio	Yes	ohio-patentprobono.org
Delaware Law School	Delaware	Yes	delawarelaw.widener.edu
LegalCORPS	Minnesota, North Dakota, South Dakota, Iowa, Wisconsin	Yes	legalcorps.org
University of Arizona	Arizona	No	azpublicpatentprogram. arizona.edu
Idaho Patent Pro Bono Program	Idaho	Yes	uidaho.edu/law

APPENDIX F

Report to Congress
December 2016

Report on the Law School Clinic Certification Program



Prepared by:
The Office of Enrollment and Discipline of the
United States Patent and Trademark Office

REPORT ON THE LAW SCHOOL CLINIC CERTIFICATION PROGRAM

**THE OFFICE OF ENROLLMENT AND DISCIPLINE OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Michelle K. Lee

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

William R. Covey

**Deputy General Counsel and
Director of the Office of Enrollment and Discipline for the
United States Patent and Trademark Office**

REPORT ON THE LAW SCHOOL CLINIC CERTIFICATION PROGRAM

THE OFFICE OF ENROLLMENT AND DISCIPLINE OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

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SUMMARY

As required by the USPTO Law School Clinic Certification Program Act (P.L. 113-227¹), the Office of Enrollment and Discipline (“OED”) of the USPTO is pleased to submit this report on behalf of the Director of the USPTO. This report fulfills the requirements of the act by describing the number of law schools and law students participating in the Program, the work done through the Program, the benefits of the Program, and any recommendations for modifications to the Program.

The United States Patent and Trademark Office began the Law School Clinic Certification Program (“Program”) to allow law school students to practice patent and/or trademark law under supervision before the USPTO on a *pro bono* basis for clients that qualify for assistance from one of the participating law schools’ clinics.

The Program began as a pilot program in the Fall Semester of 2008 with six participating law school clinics. The Program expanded in 2010, 2012, and 2014. Currently, 45 law school clinics participate in the Program, 18 clinics participate in both the Patent and Trademark portions of the Program, 20 clinics participate only in the Trademark portion of the Program, and 7 clinics participate only in the Patent portion of the Program. In June 2016, the Program again opened for expansion and will accept applications from law school clinics through June 30, 2017.

As evident from the map on the following page, the Program has grown significantly since it began with only six schools in 2008.

¹ An act to establish the Law School Clinic Certification Program of the United States Patent and Trademark Office, and for other purposes, Pub. L. No. 113-227, 128 Stat. 2114 (2014). U.S. Rep. Hakeem Jeffries (NY-08) and Rep. Steve Chabot (R-OH) sponsored the bipartisan bill.



LAW SCHOOL

CLINIC CERTIFICATION PROGRAM



PATENT AND TRADEMARK PROGRAMS

- 1 Arizona State University Sandra Day O'Connor College of Law – Tempe, Arizona
- 2 Baylor Law School – Waco, Texas
- 3 Fordham University School of Law – New York, New York
- 4 Indiana University Maurer School of Law – Bloomington, Indiana
- 5 Lincoln Law School of San Jose – San Jose, California
- 6 Mitchell Hamline School of Law – Saint Paul, Minnesota
- 7 North Carolina Central University School of Law – Durham, North Carolina
- 8 South Texas College of Law – Houston, Texas
- 9 Southern Methodist University Dedman School of Law – Dallas, Texas
- 10 Texas A&M University School of Law – Fort Worth, Texas
- 11 The John Marshall Law School – Chicago, Illinois
- 12 Thomas Jefferson School of Law – San Diego, California
- 13 University of California, Los Angeles School of Law – Los Angeles, California
- 14 University of Connecticut School of Law – Hartford, Connecticut
- 15 University of Maryland School of Law – Baltimore, Maryland
- 16 University of Notre Dame Law School – Notre Dame, Indiana
- 17 University of Puerto Rico School of Law – San Juan, Puerto Rico
- 18 University of Washington School of Law – Seattle, Washington

PATENT PROGRAM ONLY

- 19 University of Arizona, James E. Rogers College of Law – Tucson, Arizona
- 20 Brooklyn Law School – Brooklyn, New York
- 21 Case Western Reserve University School of Law – Cleveland, Ohio
- 22 New York Law School – New York, New York
- 23 University of Colorado Law School – Boulder, Colorado
- 24 University of Detroit Mercy School of Law – Detroit, Michigan
- 25 Wayne State University Law School – Detroit, Michigan

TRADEMARK PROGRAM ONLY

- 26 American University, Washington College of Law – Washington, D.C.
- 27 California Western School of Law – San Diego, California
- 28 Howard University School of Law – Washington, D.C.
- 29 Lewis & Clark College School of Law – Portland, Oregon
- 30 Michigan State University College of Law – East Lansing, Michigan
- 31 Northwestern Pritzker School of Law – Chicago, Illinois
- 32 Roger Williams University School of Law – Bristol, Rhode Island
- 33 Rutgers Law School – Newark, New Jersey
- 34 Saint Louis University School of Law – Saint Louis, Missouri
- 35 The George Washington University School of Law – Washington, D.C.
- 36 University of Akron School of Law – Akron, Ohio
- 37 University of Idaho College of Law – Moscow, Idaho
- 38 University of New Hampshire School of Law – Concord, New Hampshire
- 39 University of North Carolina at Chapel Hill School of Law – Chapel Hill, North Carolina
- 40 University of Richmond School of Law – Richmond, Virginia
- 41 University of San Francisco School of Law – San Francisco, California
- 42 University of Tennessee College of Law – Knoxville, Tennessee
- 43 Vanderbilt Law School – Nashville, Tennessee
- 44 Western New England University School of Law – Springfield, Massachusetts
- 45 West Virginia University School of Law – Morgantown, West Virginia

December 2016

On December 16, 2014, Public Law No. 113-227 removed the “pilot” status and established the Program for ten years. The USPTO published a final rule implementing Public Law No. 113-227 and establishing regulations and procedures for application to, and participation in, the Law School Clinic Certification Program. The final rule was published on May 27, 2016, and became effective on June 27, 2016.²



Congressman Hakeem Jeffries speaking with law school students and faculty at the 2015 annual visit to the USPTO

I. INTRODUCTION

The Law School Clinic Certification Program allows law school students to practice patent and trademark law before the USPTO under the strict guidance of a Faculty Clinic Supervisor. A Faculty Clinic Supervisor is a registered patent attorney or patent agent who has practiced before the USPTO in patent matters (Patent program), or is a licensed attorney in good standing with the highest court of a State who has practiced before the USPTO in trademark matters (Trademark program).

² USPTO Law School Clinic Certification Program, 81 F.R. 33591 (June 27, 2016) (to be codified at 37 C.F.R. pt. 11).

All students applying for the Patent or Trademark programs must have the requisite legal qualifications, and must be of good moral character and reputation. To qualify to practice in the Patent program, each student must also have the required scientific and technical qualifications for registration. After finding each student qualified, the USPTO grants the law student practitioners limited recognition to practice before the USPTO. Students in either the Patent or Trademark program are permitted to, among other things, draft and file patent or trademark applications with the USPTO, respond to USPTO communications, and communicate with patent examiners and trademark examining attorneys.

The USPTO accepts law schools into the Program that demonstrate they maintain strong clinical programs. Overall, the schools must possess exemplary intellectual property curricula supporting a participating student's hands-on learning in the clinic; a commitment to networking and effective outreach in the community; comprehensive intellectual property ("IP") *pro bono* services; and excellent case management systems. Each law school clinic must meet and maintain the requirements for participation in the Program in order for clinic students to practice before the USPTO.

Participating in the Program gives real-world experience to clinic students while providing IP *pro bono* services to the community. Thus, the Program provides tangible benefits not only for students, schools, and the USPTO, but also for entrepreneurs and inventors seeking legal representation. The students become better equipped with the knowledge and skills necessary to handle the challenges of intellectual property law that are essential in today's innovation economy, while helping to ensure that American businesses and entrepreneurs have access to the resources they need to succeed.

II. DISCUSSION

A. Overview of Program

In order to participate in the Program and for the clinic students to practice before the USPTO, each law school clinic must meet and maintain the requirements for USPTO certification. All schools accredited by the American Bar Association are eligible for participation in the Program and are examined for acceptance using identical criteria set forth by the USPTO.

Each law school's Faculty Clinic Supervisor must certify that the law school clinic and participating law school clinic students will abide by the requirements promulgated by the USPTO. The Law School Dean, or one authorized to act for the Dean, must also certify that each participating law school clinic student has completed their first year of law school or the equivalent, is in compliance with the law school's ethics code, and has had no moral character issues prior to attending law school or while in attendance. The Faculty Clinic Supervisor must ensure that a conflict of interest check is performed for each participating law school clinic student and each client or potential client of the clinic.

The participating law school clinic students have the opportunity to practice in patent and/or trademark law by prosecuting patent applications and/or trademark applications before the USPTO under the guidance of the Faculty Clinic Supervisor. The law school clinic students in a patent clinic have the opportunity to participate in one or more patent activities including: counseling clients regarding patent matters, performing patentability searches and drafting patentability opinions for a client's invention, and drafting and filing of patent applications, responses to Office Actions and other documents in patent applications. Trademark clinic students have the opportunity to participate in one or more trademark activities including: counseling clients regarding trademark matters, performing registerability searches and drafting registerability opinions for a client's trademark, and drafting and filing of trademark applications, responses to Office Actions and other documents in trademark

applications. Matters before either the Patent Trial and Appeal Board or the Trademark Trial and Appeal Board are not included in the Program, but participating clinics may be and have been permitted to participate in these proceedings on a case-by-case basis.

The Faculty Clinic Supervisor is responsible for instructing, mentoring, overseeing and supervising all participating law school clinic students and is responsible for all applications and documents submitted to the USPTO through the clinic. The Faculty Clinic Supervisor for a patent clinic must, at a minimum, be a registered patent practitioner in good standing with OED and possess at least three (3) years of experience in prosecuting patent applications before the USPTO within the last five (5) years. The Faculty Clinic Supervisor for a trademark clinic must, at a minimum, be a licensed attorney in good standing with the highest court of a State and in active status, and possess at least three (3) years of experience in prosecuting trademark applications before the USPTO within the last five (5) years.

The law school clinic, through the Faculty Clinic Supervisor, must provide seamless representation of patent or trademark clients, notwithstanding the law school clinic students' semester schedule. A law school clinic student's class, examination, or matriculation schedule may not impede the business practices of the USPTO and the representation of patent and/or trademark clients before the USPTO. It is the responsibility of the Faculty Clinic Supervisor to ensure that applications are timely filed, that USPTO inquiries are timely responded to, and that no gap in client representation occurs.

B. Program Statistics

Since its inception in the Fall Semester of 2008, the number of participating law schools and law school clinic students has expanded significantly and the number of patent and trademark applications filed has increased. As displayed in the following chart, to date, more than 2,700 law school clinic students have participated in the Program, more than 540 patent applications have been filed, and more than 2,000

trademark applications have been filed.

<i>Year</i>	<i>Number of Participating Schools</i>	<i>Number of Participating Students</i>	<i>Number of Patent Applications Filed (FY)</i>	<i>Number of Trademark Applications Filed (FY)</i>
<i>*2009</i>	6	122	21	74
<i>2010</i>	16	148	17	71
<i>2011</i>	16	232	29	83
<i>2012</i>	29	294	18	101
<i>2013</i>	29	390	108	209
<i>2014</i>	46	480	113	407
<i>2015</i>	45	571	113	543
<i>2016</i>	45	535	126	515
<i>Total</i>		<i>2772</i>	545	2003

Commencing January 2017,³ law school clinics are required to report biannually to OED the following information: the number of law students participating in each of the patent and trademark practice areas of the school's clinic; the number of faculty participating in each of the patent and trademark practice areas of the school's clinic; the number of persons to whom the school's clinic provided assistance in any given patent or trademark matter but with whom no practitioner-client relationship had formed; the number of client representations undertaken for each of the patent and trademark practice areas of the school's clinic; the identity and number of

³ Previously, law school clinics were required to report quarterly to OED the number of applications filed by each clinic. The new reporting requirements were established by the final rule, which became effective June 27, 2016. The USPTO will begin collecting the newly required data in January 2017 in order to give clinics sufficient notice of the new requirements as well as ample time to put systems in place to collect the additional data.

applications and responses filed in each of the patent and/or trademark practice areas of the school's clinic; the number of patents issued, or trademarks registered, to clients of the clinic; and all other information specified by the OED Director.

C. Benefits of Program

The goal of the Program is to give students the opportunity to gain experience practicing before the USPTO, while providing IP *pro bono* legal services to under-resourced companies, small businesses, and individuals with innovative ideas. In doing so, there are significant benefits to participation in the Program not only for the clinic students, schools and the USPTO, but also for the clients whom these clinics serve.



Law schools students, professors, and USPTO speakers in attendance at the 2016 annual visit to the USPTO

1. *Benefits to the Clinic Students*

The clinic students who participate in the Program gain invaluable real-world experience that will better prepare them to be “practice-ready” attorneys upon graduation. Specifically, under the supervision of the Faculty Clinic Supervisor, participating clinic students are introduced to the patent and trademark system first-hand and are able to perform the following activities involved in obtaining a patent or trademark: communicating with and counseling clinic clients regarding patent and trademark matters; conducting patent and trademark searches and providing opinions on patentability or registrability; drafting and filing patent and trademark applications; responses to communications from the USPTO, and other documents; and communicating with patent examiners and trademark examining attorneys. As discussed further below, clinic students may also benefit from expedited review of

the applications they file with the USPTO on behalf of their clients, which makes it more likely that the students will receive substantive examination of the applications they file within the same school year.

The Program allows clinic students to practice in a law firm-type setting and gives them a unique opportunity to be treated as practitioners for purposes of practicing before the USPTO. Students admitted into the Program are granted limited recognition and assigned temporary practice numbers for use while they are participating in the law school clinic. The limited recognition numbers permit the students to file patent and/or trademark applications, respond to USPTO communications, sign documents, and communicate with patent examiners and trademark examining attorneys just like registered practitioners. Students in IP clinics at schools not participating in the USPTO Program are not granted limited recognition to practice before the USPTO while in law school, so this is a significant benefit to participating clinic students.

One of the Program requirements for participating law school clinics is a protocol for a seamless transfer of cases from outgoing law school clinic students to incoming law school clinic students from semester to semester, through the continued supervision of the Faculty Clinic Supervisor. It is critical for clients and for the USPTO that there is no disruption in the USPTO conducting its business. Accordingly, clinic students are required to learn and execute this transition protocol as if working in a law firm. Each clinic's process may vary slightly, but generally students will learn case management skills, including how to track and properly document their work, analyze and summarize the work they have completed in a transition memorandum, and communicate effectively with their colleagues and supervisors.

By treating clinic students like practitioners, the Program challenges students and provides them with an opportunity to put their classroom skills to practice. The Program allows clinic students to develop and improve their legal skills, judgement, and professional values. Clinic students begin to realize the type of practitioner they

want to become and learn how to handle legal problems that may arise as a practitioner. Clinic students also gain invaluable communication skills by learning how to interact with clients, including proper demeanor, what questions to ask, how to work with various personalities, and how to counsel clients. Furthermore, clinic students learn about legal ethics and issues that commonly arise in practice.

Because of this unique exposure to the practice of intellectual property law, clinic students also become more valuable and marketable to future employers in the IP legal community. In a competitive area of the law that is rapidly growing, clinic students become equipped with interesting and relevant experiences to reference in job interviews and to demonstrate their qualifications. They are able to discuss the challenges of working in the IP law field and establish their understanding of practicing as a lawyer in a law firm-type setting. Ideally, participation in the Program will ultimately inspire these clinic students to pursue careers in IP law, such as in private practice, or even at the USPTO.

2. Benefits to the School

There are also significant benefits to the schools that participate in the Program. Specifically, schools that are part of the Program benefit from recognition of the school's IP program by the USPTO, ongoing interaction with the USPTO, and greater exposure and publicity for the school and the IP clinic.



Roundtable discussions with attendees of the 2016 annual law school clinic visit to the USPTO

The Program requires participating schools to meet specific requirements and to maintain strong clinical programs to remain a participant of the Program. The USPTO

does not require or encourage one particular law clinic structure over another. However, the USPTO does expect that each accepted law school will have a strong IP program, including a variety of foundational and advanced IP courses, a carefully structured IP clinic, and an emphasis on experiential, hands-on learning. Accordingly, once accepted into the Program, law schools gain valuable credibility from being recognized as one of the exemplary and prestigious schools meeting the USPTO's eligibility criteria. In light of the ABA's adoption of new accreditation standards requiring more "experiential learning" opportunities for students, the Program may also be particularly beneficial for schools seeking to meet these new requirements.

Law schools with clinics participating in the USPTO Program also benefit from being affiliated with the USPTO and from greater exposure for the school and the IP clinic. All participating law schools are listed on the USPTO's website, along with the clinic's email address, the IP practice area of the clinic, and the geographic area of the clinic (from which the law school may accept clients), for the benefit of the public. If a member of the public seeking legal representation for their IP matter(s) contacts the USPTO for assistance, they may be referred to the clinics participating in the Program.

Furthermore, since the Program began, the USPTO has been making frequent site visits to participating law schools throughout the country. The purpose of these visits is to keep the lines of communication open between the participating schools and the USPTO, discuss employment opportunities at the USPTO with students, discuss the clinic students' experiences, and encourage participation in the Program from current law school students. During the visits, USPTO representatives meet with law school deans, meet and discuss the operation of the clinic with the supervisors and clinic directors, meet the students currently enrolled in the clinic to learn about their experiences, and talk with law students interested in IP law about the benefits of participating in the clinic and career opportunities at the USPTO.

The USPTO also annually invites clinic faculty and students from participating schools to the USPTO for a day of speakers and roundtable discussions regarding career

opportunities at the USPTO, ethics before the USPTO, and other interesting topics. The event has also included a live Trademark Trial and Appeal Board and/or Patent Trial and Appeal Board hearing for the attendees to observe, as well as faculty and student networking sessions.



Deputy General Counsel and OED Director Will Covey speaking with attendees of the 2016 annual visit to the USPTO

Participating schools further benefit from their affiliation with the Program by being associated with the other participating law schools and clinics. Specifically, the USPTO organizes networking teleconferences for the clinic faculty at the participating law schools. One of the participating law schools typically volunteers to host the conference and selects a topic for discussion. The conferences are optional and serve as an efficient way for clinic faculty to share common issues and best practices among the clinics. Aside from the scheduled teleconferences organized by the USPTO, clinic faculty at participating schools often contact one another for general questions, advice, or support regarding the management of a law school clinic. As the Program continues to expand, this is particularly beneficial for schools new to the clinic program and/or for clinic faculty new to the clinic setting.

3. *Benefits to the Clients*

In addition to the participating schools and students, the Program provides significant tangible benefits to the communities these clinics serve by making IP *pro bono* services more readily available to small businesses and individual inventors seeking protection of their intellectual property. In doing so, the clinics in the Program provide IP legal services to a community that might not otherwise be able to obtain representation due to financial constraints. In turn, the Program helps strengthen small businesses and innovation-based entrepreneurship, both of which are part of the key building blocks of economic growth.

The law school clinics participating in the Program are required to provide their patent and/or trademark services on a *pro bono* basis. Each individual clinic decides whether to establish income thresholds and other requirements for accepting clients.

Once becoming a client of one of the participating law school clinics, the client not only benefits from IP *pro bono* services, but may also benefit from expedited review of his/her applications by the USPTO. For trademark applications, the USPTO has trademark examining attorneys who volunteer to be specifically assigned to work on the law school clinic applications in addition to their regular applications. This is beneficial for the students as well as the clients because the examining attorneys are familiar with the Program and historically have processed the applications quicker than an average trademark application. For patent applications, the Request to Make Special Program, which began in the fall semester of 2012, permits each participating law school to designate a predetermined number of applications per academic year to be advanced out of turn, with additional applications being awarded for advancement of examination on an *ad hoc* basis. As seen in the chart below, the Request to Make Special Program benefits the clinic students and their clients as the applications are examined significantly quicker than the average patent application.

<i>School Year</i>	<i>Number of Requests to Make Special Filed</i>	<i>Average time from filing to first Office Action for those Applications that received an Office Action within School Year</i>	<i>Average time from Request granted to first Office Action</i>
<i>2013-2014</i>	10	4 months	60 days
<i>2014-2015</i>	15	7 months	40 days
<i>2015-2016</i>	13	5 months	54 days

* According to the USPTO Patents Dashboard, as viewed on December 14, 2016, the average number of months from the standard patent application filing date to the date a first Office Action is mailed by the USPTO is 15.9 months. See <http://www.uspto.gov/dashboards/patents/main.dashxml>.

4. *Benefits to the USPTO*

One of the main goals of the USPTO is to promote stronger and more effective IP protection for U.S. innovators and entrepreneurs within the United States and around the world. Well-educated and well-trained patent and trademark practitioners are critical to the USPTO's mission of fostering innovation and economic growth by strengthening protection for novel ideas and inventions and encouraging the dissemination of new technologies.



Roundtable discussions with attendees of the 2016 annual law school clinic visit to the USPTO

Accordingly, the Program benefits the USPTO by better preparing participating law school clinic students for representing others in patent and/or trademark matters

before the Office upon graduation. By providing clinic students with the opportunity to practice in all aspects of obtaining a patent or trademark, the clinic students gain invaluable experience in law school that will help them become more knowledgeable, skilled, and effective practitioners. Having experienced and well-educated practitioners to provide competent representation to U.S. innovators, entrepreneurs, and small businesses is vital to the USPTO carrying out its key mission.

Another one of the USPTO's priorities has been to address the current backlog of patent applications. It is critical that patent examiners be able to speed up their examination process while ensuring that patent quality is maintained. When applications are filed *pro se*, they may contain errors and often slow down the examination process because the examiners have to take more time to analyze the application and work with the *pro se* inventor. By providing *pro bono* legal assistance to individuals and/or small businesses who might otherwise file their patent applications with the USPTO *pro se*, the Program benefits the USPTO by filing better quality applications, which promotes more efficient prosecution.

Additionally, the Leahy-Smith America Invents Act directs 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." In response to this directive, the USPTO established the Patent Pro Bono Program, which is administered by the Federal Circuit Bar Association, and is actively working with regional organizations to establish *pro bono* programs throughout the country. While the Law School Clinic Certification Program is not affiliated with the Patent Pro Bono Program, the USPTO strongly encourages participating law school clinics to engage with these programs throughout the country. This may include assistance to the *pro bono* programs or as a secondary program serving those inventors and small businesses that do not meet certain requirements of the AIA *pro bono* programs. The law school clinics may also consider partnering or coordinating with the AIA *pro bono* program in the school's region.

Through the synergy between both of these programs, the USPTO continues to strive towards a seamless integration of legal systems providing competent legal representation to small businesses and individual innovators seeking protection of their intellectual property.

D. Recommendations of Director

The legislation that established the Program requires that the USPTO include in its Report to Congress any recommendations of the Director for modifications to the Program.

At this time, the USPTO Director has no recommendations for modifications to the Program. With the steady growth of the Program, the USPTO has made changes and improvements as necessary, and the USPTO will continue to review, analyze, and make adjustments to the Program to ensure that it remains as valuable and efficient as possible for the participating law schools, students, and clinic clients, as well as the USPTO.

III. CONCLUSION

Through the Law School Clinic Certification Program, more than 2,700 law school clinic students have been able to practice patent and/or trademark law before the USPTO under the guidance of a Faculty Clinic Supervisor. Not only has this provided superior legal training and invaluable experience to these students, but by providing their IP services to the public *pro bono*, this has also increased access to legal representation for the public.

Specifically, by expanding education about patents, trademarks, and the patents and trademarks system at the law school level, independent inventors and entrepreneurs that have otherwise not been able to obtain quality legal services, have been afforded access to the competent legal representation necessary to succeed and compete in today's economy.

APPENDIX G - Overview of the Law School Clinic Certification Program

A. Introduction

The United States Patent and Trademark Office (USPTO) began the Law School Clinic Certification Program (Program) to allow law school students to practice patent and/or trademark law under supervision before the USPTO on a pro bono basis for clients that qualify for assistance from one of the participating law schools' clinics.

The Program began in the fall semester of 2008 with six participating law school clinics. Currently, 64 law school clinics take part in the Program—38 clinics participate in both the patent and trademark portions of the Program, 23 clinics participate only in the trademark portion of the Program, and three clinics participate only in the patent portion of the Program. The Program is currently accepting applications from law school clinics interested in joining the Program.

B. Overview

The USPTO accepts law schools into the Program that demonstrate they maintain strong clinical programs. Overall, the schools must provide exemplary intellectual property (IP) curricula supporting a participating student's hands-on learning in the clinic, a commitment to networking and effective outreach in the community, comprehensive IP-related *pro bono* services, and excellent case management systems. Each law school clinic must meet and maintain the requirements for participation in the Program in order for clinic students to practice before the USPTO.

The Program allows qualified law school students to practice patent and trademark law before the USPTO under the strict guidance of a Faculty Clinic Supervisor. A Faculty Clinic Supervisor is a registered patent attorney or patent agent who has practiced before the USPTO in patent matters (patent program), or is a licensed attorney in good standing with the highest court of a state who has practiced before the USPTO in trademark matters (trademark program). The Faculty Clinic Supervisor is responsible for instructing, mentoring, overseeing, and supervising all participating law school clinic students and is also responsible for all applications and documents submitted to the USPTO through the clinic. In addition, it is the responsibility of the Faculty Clinic Supervisor to ensure that applications are timely filed, that USPTO inquiries receive timely responses, and that no gap in client representation occurs.

C. Program Statistics

Since its inception in the fall semester of 2008, the numbers of participating law schools and law school clinic students have increased significantly, and the number of patent and trademark applications filed has increased. To date, over 7,000 law school clinic students have participated in the Program. Between 2009 and June 2023, 1,643 patent applications and 6,741 trademark applications were filed in the Program. Between 2017 and June 2023, 1,454 patent responses were filed, 332 patents were issued, and 2,812 trademarks were registered.

Since January 2017,¹ law school clinics have been required to report biannually to the USPTO's Office of Enrollment and Discipline (OED) the following information: the number of law students participating in each of the patent and trademark practice areas of the school's clinic; the number of faculty participating in each of the patent and trademark practice areas of the school's clinic; the number of persons to whom the school's clinic provided assistance in any given patent or trademark matter but with whom no practitioner-client relationship had formed; the number of client representations undertaken for each of the patent and trademark practice areas of the school's clinic; the application numbers and number of applications and responses filed in each of the patent and trademark practice areas of the school's clinic; the number of patents issued, or trademarks registered, to clients of the clinic; and all other information specified by the OED Director.

D. Benefits of Program

The goal of the Program is to provide IP-related pro bono legal services to under-resourced companies, small businesses, and individuals with innovative ideas, while giving students the opportunity to gain real-world experience practicing before the USPTO. In doing so, there are significant benefits to participation in the Program, not only for the clients whom these clinics serve, but also for the clinic students, the schools, and the USPTO.

The Program provides significant tangible benefits to the communities these clinics serve by making IP-related pro bono services more readily available to small businesses and individual inventors seeking to protect their IP. In doing so, the clinics in the Program provide IP-related legal services to a community that might not otherwise be able to obtain representation due to financial constraints. In turn, the Program helps strengthen small businesses and innovation-based entrepreneurship, both of which are key building blocks of economic growth.

Once becoming a client of one of the participating law school clinics, the client not only benefits from IP-related pro bono services, but may also benefit from expedited review of their applications by the USPTO. For trademark applications, the USPTO has trademark examining attorneys who volunteer to be specifically assigned to work on the law school clinic applications in addition to their regular applications. This is beneficial for the students as well as the clients because the examining attorneys are familiar with the Program and historically have processed the applications more quickly than an average trademark application. For patent applications, the Request to Make Special Program permits each participating law school to designate a predetermined number of applications per academic year to be advanced out of turn, which benefits the clinic students and their clients, as the applications are examined much more quickly than the average patent application.

The Program benefits the clinic students by allowing them to practice in a setting similar to a law firm and by giving them the unique opportunity to be treated as practitioners for purposes of practicing before the USPTO. Because of this unique exposure to the practice of IP law, clinic students also become more valuable and marketable to future employers in the IP legal community. In a competitive area of law that is rapidly growing, clinic students become equipped with interesting and relevant experiences to reference in job interviews and to share to demonstrate their qualifications.

¹ Previously, law school clinics were required to report quarterly to the OED only the number of applications filed by each clinic.

Ideally, participation in the Program will ultimately inspire these clinic students to pursue careers in IP law, such as in private practice or even at the USPTO.

There are also significant benefits to the schools that participate in the Program and to the USPTO. Specifically, schools that are part of the Program benefit from recognition of the school's IP program by the USPTO, ongoing interaction with the USPTO, and greater exposure and publicity for the school and the IP clinic. The Program benefits the USPTO by better preparing participating law school clinic students for representing others in patent and/or trademark matters before the USPTO upon graduation. By providing clinic students with the opportunity to practice in all aspects of obtaining a patent or trademark, the Program allows the students to gain invaluable experience in law school that will help them become more knowledgeable, skilled, and effective practitioners. In addition, by providing pro bono legal assistance to individuals and/or small businesses who might otherwise file their patent applications with the USPTO pro se, the Program benefits the USPTO by enabling the filing of better quality applications, which promotes more efficient prosecution.

E. Conclusion

One of the main goals of the USPTO is to promote stronger and more effective IP protection for U.S. innovators and entrepreneurs within the United States and around the world. Through the Program, over 7,000 law school clinic students have been able to practice patent and/or trademark law before the USPTO under the guidance of a Faculty Clinic Supervisor. Well-educated and well-trained patent and trademark practitioners are critical to the USPTO's mission of fostering innovation and economic growth by strengthening protection for novel ideas and inventions and by encouraging the dissemination of new technologies.

APPENDIX H - Listening Session Transcript, Inventor Session

Transcript of USPTO Listening Session on the Patent Pro Bono Program Study -
June 07, 2023 JOB #23836

This transcript is being provided in an edited format. Communication Access Realtime Translation (CART) is provided in order to facilitate communication accessibility and may not be a totally verbatim record of the proceedings. Due to the nature of a live event, terms or names that were not provided prior to the assignment will be spelled phonetically and may or may not represent the true spelling.

Grant Corboy: 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 the principal adviser to our USPTO Director.

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 Marbole for the Southern District of Ohio. He also served six years as a trial attorney at the U.S. Department of Justice, specifically 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, civil rights issues, and working on judicial nominations. In the private sector, he served as vice president and associate general counsel of Mantibo, and 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.

Derek 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 the Programs and the Office's resources to those in need. And bring it to them where they are. So this Program is important. 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 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. In order to assess the engagement and health of these Programs, the Director and I have been visiting cities around the country, meeting and connecting with Pro Bono service providers, inventors and business entrepreneurs and IP law students to discuss the Pro Bono Program in terms of providing the service. We are trying to find new ways to bring up and coming inventors into the ecosystem. We have heard from 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, and we invite you to share your experiences, your success stories, and your challenges with us. 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 to better provide our services. It will help keep the Pro Bono Program 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 AUAI, thank you, Congress, and the President for signing 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 the discussion today. Thank you very much.

Grant Corboy: I'd like to introduce James Silbermann to give some background on the Congressional mandated study. Jim?

James Silbermann: Thank you, Grant. First EUR want to thank the Director for his remarks and for his support of these Programs. I'll 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, on the Pro Bono Programs and UAIA which seem easier to say than they actually are. As Grant mentioned, my name is Jim Silbermann, Senior Counsel for Intellectual Property Services at the USPTO. As part of that role, I oversee the Patent Pro Bono Program which we are here today to gather some information about from practitioners. As Dave and Director Brent mentioned, this is the second of two listening sessions. The first listening session we had was Monday. Monday evening, where we heard from inventors and those who received services from the Patent Pro Bono Program. The goal is to hear from those providing the intellectual property legal services to those under resourced individuals and small businesses. As everyone has mentioned, last year on December 29, 2022, the Consolidated Appropriations Act, which includes the 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 (AIA). Some of those we will 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 with July 11th being 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 in this proceeding. 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 from 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, 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 notice 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 Patent Pro Bono Program from Kim Kelleher. We'll then have an overview of the PTAB Patent Pro Bono Program from Vice Chief Judge Janet Gongola of the Patent Trial and Appeal Board (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 Thuete, and also the Chair of the Pro Bono Advisory Council. We have Deborah Miron, 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 Market Blast. He's also a Pro Bono Advisory Council board 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. We'll have the question and answer (Q&A) portion for 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. 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 notice comment period is open through July 11, 2023 so you 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. Now 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 at 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. The Patent Pro Bono Program 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. And both practitioner and inventor work together to file and prosecute patent applications. Now, the USPTO has a coordinating role in this. But the matching process actually happens through our 20 Regional Programs which actually work to match the inventors and the practitioners. There's 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. For the inventors, they get the opportunity to work with experienced patent practitioners. So, for the PTO, that results in an improvement in patent quality because the inventors are submitting applications that have assistance from patent practitioners, so we get an increase in patent quality. Based on IAPLA'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. The PTO also benefits through 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 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're 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 inventor assistance. So that's a good thing. We do see a little bit of a downtick from 2020 on 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, 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 inventors' inquiries is about 18,000. And the number of inventors assisted is about 4,000. You might think there's a large difference between inventors' inquiries and inventors assisted. But there's a reason for that because if an inventor calls up 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're going to talk about in a minute. This we recently published on our blog. It has to do with whether the Patent Pro Bono Program is able to meet those, the 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 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% 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. Likewise, if you're a practitioner in Seattle, Washington, and you want to volunteer, you would apply through the California Inventors Assistance Program. There is a code that's on your screen, and that's a link to our page where you can access this map and find out what Program you would connect 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 policies and procedures that both inventors and practitioners must follow. They are responsible for screening and matching the applicants with the volunteer practitioners. They ensure that the applicants meet the requirements for pro bono assistance. And those requirements are basically fourfold. Now the Regional Programs can add more 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 family members, this number would go up. The inventor must demonstrate knowledge of the patent system. They can do this in one of two ways. They can have at least a provisional application on file with us, or they could complete a certificate training for us, which is available online. 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, since 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 the 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. It 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, including 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. One 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 Patent Pro Bono Program. It's for ex parte appeals in front of the Patent Trial and Appeal Board (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 Patent Pro Bono Program, so I feel like we stood on the shoulders of giants and 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, 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. So 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. Currently, 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 are the concept of bringing innovation to impact. Okay, 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 services. They are able to provide legal help in the field of their practice, so that 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 Pro Bono clients eventually become a paying client for them, as they meet with success. The PTAB Patent Pro Bono Program is singular. We have one clearing house, the PTAB Bar Association that administers the Program nationwide. I'll tell you more as we go on 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 appeals to the federal circuit, but appeals before the Board only. Within our first year, we recognized that maybe we were a little too narrow when we set up the Program. 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, to not restrict inventors' previous experience with the patent system when applying for Pro Bono help. This year, we anticipate 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 UIAI 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 Patent Pro Bono Program. 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 have to seek help within one month of the date of either a final rejection or a second office action rejection. That one month clock is set in place to allow the attorneys to have sufficient time to work with 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 appeals process. The reason we have this knowledge requirement is so that inventors will have their 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. We're trying, through this Program, to help those who do not have the financial resources to help themselves. So really seems 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 practitioner takes the case forward from there. The clearinghouse backs out of responsibility, but they monitor how the Program is doing: what success is being met through these matches? And they report that success to all of 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 publicizes the availability of this free legal help. Of recognizing inventors who have come through the Program, recognizing volunteer practitioners. We are there to help 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 set to give inventors an assurance that the volunteers are competent, capable and they're 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. Right now, we're limited to ex parte appeals so we don't want to use the Patent Pro Bono Program 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 kind of 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 lay out what services will be covered. We don't want inventors to be confused that they think they have an attorney for any and all purposes that they need when, in fact, the attorney is there to represent them only in their matter before the PTAB. The representation is free from 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 appeal process. Okay. Now the transition. 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 out an email to all the volunteers asking, who would like to represent this 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 conflicts 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, the Bar Association, after one month, if they cannot find a volunteer attorney, they 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 wish 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 said today. The slide here lists a variety of websites, the PTAB Bar Association website, USPTO website where you can go to 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 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 made you think about something, please feel free to put those questions in the question and answer session. And, after this panel discussion, we're then going to open it up and you can raise your hand, unmute your mic and provide verbal comments. With that information, again, as Kim and Janet had mentioned, the USPTO is really a cheerleader for this Patent Pro Bono Program. AIA says we're supposed to encourage the establishment of these Programs. The people who are really doing the work are to my right. So to hear from them and get their perspective on the Program is very important. So let me start immediately to my right by introducing Jim Patterson. Jim Patterson is the principal and founder of Patterson Thuermer IP located in Minneapolis, Minnesota. Patent Pro Bono Program got its start over a decade ago with Jim's leadership and his observing the Pilot Program in his

home state of Minnesota. Since then, Jim has been instrumental in bringing the Patent Pro Bono Program in over 50 states. Internationally, Jim continues his role in the creation of an expansion of the international Patent Pro Bono Program. 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, be it 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, served under 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 has legal and supervisory of the offices of more than 60 administrative judged are 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 MSB's highest honor. She received an award for justice of victims of crimes award presented by her former by the former U.S. attorney general Eric Holder for the extraordinary assistance for her employee who was the victim of stalking and violent assault. It enabled to 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 notorious civilian service. Previously Deborah served as deputy assistant general counsel of the SREFRB affairs for the department of the Navy where she was senior legal adviser on military and personnel issues in the pentagon and supervised the 18 legal offices in the United States within the department. And was appointed counsel to the committee on opportunities for military and civilian women in the Navy. Deborah received her BA from 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, unique products directly to leading companies. Warren also oversees the open innovation product Program for publicly traded lifetime brands in house wares including Faber ware, kitchen aid and 40 other brands. The merchant media and other direct response television states, 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 and 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 well-known advocate for inventors rights. He served for 12 years as president of the united inventors association, 501c3 with high ethical standards and 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 board member of the national Pro Bono Program. 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, startup, 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 Patent Pro Bono Program Program where he volunteers through the Bar Association. Rodney has handled many Patent Pro Bono representation 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. I think they will provide us a lot of information. At the end of their presentation, we'll have an opportunity to hear directly from you. Without much 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 on the Patent Pro Bono Program.

>> Thanks. I have been involved from the very beginning and I have been it's been a delight and highlight of my career to see the interaction between the patent office. 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 in 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.

>> Deborah, what is your experience and perspective on the Patent Pro Bono Program?

>> Thank you. Thanks for having us. So I came to the federal circuit Bar Association as EXECUTIVE director just when the pandemic hit, timing be it 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 has not just this Patent Pro Bono Program, even in patent we also do testify Program of 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 they have, 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 then, if they can't take the case they enlist their help. 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, 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.

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

>> Sure. Let me first give a shoutout to Jim Patterson who I call the Nelson Mandela of the Pro Bono Program. 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. Inventors association. When Jim asked me to get involved, I jumped at the opportunity. The Patent Pro Bono Program symbolic for 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 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 that 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's 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 of 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.

>> Thanks, Warren. Rodney, tell us about yourself and your role in the Patent Pro Bono Program.

>> 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 [PWRG 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. From the inventors, they're getting free counsel. Not only for patents, but also oftentimes get free counsel in a lot of other areas around patent, licensing, contract work, freedom to operation. And then from, you know, from the attorneys' side, the benefits are, there's a number of them, but a lot of attorneys enjoy giving back to the community or being involved there the 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. Lot of practical experience that you get. Then lastly there's the benefit of just developing a network, additional resource. 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 some day 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.

>> 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 Patent Pro Bono Program? And can you see the other challenges other practitioners maybe not similarly circumstanced as you would face in participating in this Program.

>> 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 Patent Pro Bono Program through the U.S. Patent and Trademark Office there's 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 resources. There's 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 on. 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 out and pitch in. Sometimes it's a collaborative effort across not just firms but across firms and organizations, things like that.

>> Thank you. Okay. Warren, what do you see as the challenges that face the Patent Pro Bono Program?

>> 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 of I do communicate a lot with inventors by email and by forms and things like that. I try to talk to three or four 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, 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. Will 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.

>> Deborah, how about you? What do you see are the challenges?

>> 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 go down on 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 any legal developments and interests, are really people 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 we talked about, 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.

>> Jim?

>> 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 match maker 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 of another. Most 5013c. 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 on the patent office. 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. In the government assistance is not, here's money, see what you can do with it. It's, 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.

>> 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 Patent Pro Bono Program? I'll start with you, Jim? What would you like to see Improved in if Patent Pro Bono Program?

>> A focus on the hubs. A focus on staffing the hubs. Certainly the patent office 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.

>> Deborah, what do you say as somebody who's running the circuit bar Patent Pro Bono Program as an area for improvement?

>> 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 the central is in a position to help share that if they had the time and resources to do it and could help us.

>> Warren, from the inventor's perspective?

>> This an easy one for me. I come at this from a non-attorney standpoint. I'm probably the only no attorney in this room. I'm proud of it, by the way.

>> And we're proud to be attorneys, too.

>> 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.

>> Rodney, if you could do any improvement to the Patent Pro Bono Program, 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?

>> 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 confidence collect. 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 conflict collect. 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]

>> 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?

>> 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.

>> 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.

>> 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?

>> 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. It depends. 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.

>> Thank you. Warren, what would you like to see of the USPTO?

>> 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. and Oakland, California, Atlanta, Georgia, 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 cost to put one of these events on. 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.

>> 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?

>> 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 you tube 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 an 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 fund. 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 an 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.

>> Thank you. Just let you know, this is my fault for not informing you. There is a Pro Bono cert form. You can go on 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?

>> 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 really 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 pathway 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?

>> 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 Warner Hill in Washington, D.C. Jonathan started as a patent prosecution expert but now focuses more on interparty 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.

>> In addition to the Patent Pro Bono Program, 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 sort of 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 Patent Pro Bono Program. 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 somebody at the PTAB bar up 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 you 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.

>> 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.

>> I was looking to be able to find how to get on Pro Bono assistance for actually not even the patent process but for the trademark process. Is that the same department? I didn't think so.

>> This is the Patent Pro Bono Program.

>> Right. Right.

>> Early on when Kim gave her presentation, did you capture that qr code by chance?

>> I believe I did.

>> 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 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.

>> That's terrific.

>> 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 the 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.

>> 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.

>> Hi. Can you hear me?

>> Yes, we can hear you.

>> 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 all chair of the Pro Bono committee of the section. Working with John at the Penn State clinic. So from a Pitt perspective, patent TERPB perspective, what we are trying to do is profitize our member, get them engaged and work with the clinic. As somewhat of a newbie in this area, my question or questions would focus on willing to 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 for abandonment and what issues have you seen? I'll stop there. I have many more questions, but we'll stop there.

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

>> 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 and I don't perceive 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.

>> 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.

>> 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.

>> 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 that that the 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.

>> 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 PSU clinic is to kind of mind 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.

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

>> 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 to some of those solo practitioners working with small clients.

>> To the panel?

>> 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. That actually 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. Right now is an actively under consideration.

>> 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.

>> 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.

>> Thank you so much. I'm actually 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 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 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.

>> Donna, thank you for raising your hand. I will say if you have any more ideas, please go to the Federal Register 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?

>> One participant would like to know a little bit more about getting CLE credit for Pro Bono work.

>> 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 me casa 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 on going 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 perspective as well as from the USPTO perspective. Anything else? Okay. Let's go to, I see a hand, Rudolph Notrod.

>> Yes, hello.

>> Hi, Rudolph.

>> Under the Pro Bono Program, is a client inventor participating or even expected to participate in any of the proceedings, like the the oral hearing? Or anything before, other than just handing over the case to the Pro Bono attorney and that's it?

>> For an oral hearing, are you talking before the patent trial and appeals board?

>> Yeah.

>> Okay. Does anybody here have experience with a yep?

>> Hello. This is Jan net 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?

>> Yes, very good. Thank you.

>> Great. Thank you. Thank you.

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

>> There was a question about whether there is a compilation of the states that are giving CLE credit, such as a spread sheet?

>> 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.

>> 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.

>> Anything else, Liz?

>> Not at this time.

>> 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.

>> 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 TPAOEUD 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 was 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 with 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 Register 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 notice. For those concerned about having your name read out, it's my understanding that such submissions can be done anonymously. Although, however it's submitted it's 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's 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.

APPENDIX I

United States Patent and Trademark Office Patent Pro Bono Program Review

Office of Finance

January 2017

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I. Executive Summary

The Office of Finance was asked to perform an independent analysis and review of the USPTO Patent Pro Bono Program (or Patent Pro Bono Program) by the Office of Enrollment and Discipline (OED), the organization that oversees the initiative. The Office of Finance reviewed the existing processes and funding documentation as well as provided a recommendation regarding funding approach in order to ensure a successful, sustainable program. In summary, we determined that the Patent Pro Bono Program processes are transparent and associated policies are adhered to by all members involved.

The Patent Pro Bono Program has been very successful up to now with the application of USPTO dollars and staffing resources. The program allows under resourced inventors and small businesses to gain access to legal representation thereby providing them with the opportunity to apply for a patent. However, it is the conclusion of this study that the program will ultimately have a low probability of success if the USPTO resources are not continued after the initial five years. If the program fails, the probability that these inventions would get to the marketplace is reduced significantly thereby affecting the intellectual property system of which the USPTO is an active player, and in turn economic activity. The program faces challenges in terms of long term sustainability with unstable participants whose donors are not guaranteed on an annual basis. The Office of Finance concurs with the Office of General Counsel's recommendation that the USPTO continue the joint project agreements (JPAs) for five years, from FY 2017 through FY 2021. It is further recommended that the regional programs be funded at a steady state (50% funding year-over-year) by USPTO rather than the current declining rate. And lastly, this study concludes that continued USPTO funding beyond 2021 will be required to promote a higher likelihood of success of the Pro Bono Program.

II. Background/Purpose

Section 32 of the Leahy-Smith America Invents Act (AIA) requires 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 inventors and small businesses.”¹ On

¹ SEC. 32. PRO BONO PROGRAM.

(a) IN GENERAL.--The 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.

February 20, 2014, the White House required the USPTO to dedicate resources to assist potential inventors in acquiring legal representation.² By replicating a pilot program started in Minnesota to create new regional programs to cover all 50 states, the USPTO sought to increase the accessibility of the patent system for all.

Twenty regional nonprofit organizations, universities, and bar associations around the nation serve as a conduit to match under-resourced inventors and small businesses with volunteer patent attorneys to assist with filing and prosecuting patent applications. Sixteen of the programs are funded in part by USPTO, the remaining four programs are self-sustaining.

This document analyzes the Patent Pro Bono Program to gather an understanding of the program's purpose, benefit, operations, customer relationships, and risks.

III. Program Overview

History

Section 32 of the AIA was signed into law on September 16, 2011. Prior to the signing of the AIA, a pilot patent pro bono program was launched in collaboration with LegalCORPS, a Minnesota based nonprofit. After the enactment of the AIA, the USPTO, using the lessons learned from the pilot, sought out intellectual property organizations to start pro bono programs additional states. Two and one half years later, by February 2014, approximately nine organizations were providing patent pro bono services to 19 states in addition to the District of Columbia. In February 2014, the White House required the Patent Pro Bono Program expand to all 50 states. To meet this requirement, the USPTO formed a Patent Pro Bono Team consisting of full time federal staff dedicated to providing support to the regional programs by setting up the necessary processes as well as visiting the programs onsite to ensure success. By utilizing lessons learned from the pilot Minnesota Pro Bono program, and encouraging intellectual property organizations participation through partial reimbursement from the USPTO for program costs, the team worked to set up new pro bono programs in regions that did not have existing programs. As a result of these efforts, the USPTO Patent Pro Bono Program is available nationwide via 20 regional programs that may serve

(b) EFFECTIVE DATE.--This section shall take effect on the date of the enactment of this Act.

² <https://obamawhitehouse.archives.gov/the-press-office/2014/02/20/fact-sheet-executive-actions-answering-president-s-call-strengthen-our-p>.

multiple states. In addition, three programs dedicated to serving residents of individual states are scheduled to start in 2017.

The Patent Pro Bono Program consists of multiple, independently operated regional programs around the nation. These programs are administered independent from the USPTO. Generally speaking, a regional program is an intellectual property non-profit organization, bar association, or a university with a referral service that matches volunteer patent attorneys with eligible independent inventors and small businesses.

The regional programs screen inventors and small businesses to determine eligibility for the Patent Pro Bono Program. The basis upon which this determination is made varies for each program based on the region. Entities interested in obtaining this complimentary legal representation provide information to the program to show that they satisfy the eligibility requirements. According to the program guidelines as cited on the Patent Pro Bono Program website (<https://www.uspto.gov/probonopatents>), generally, there are three criteria in which an entity must meet that make them eligible for this program: (1) household income less than 300% of the Federal poverty level; (2) knowledge of the patent system³, and (3) possession of an invention that can be explained with enough specificity so that an individual with basic skills can create or use the invention.

IV. Current Business Model

Agreement Types

The various participants in the Patent Pro Bono Program currently include the USPTO's Office of Enrollment and Discipline, 20 regional programs, law firms, corporations, independent inventors and small businesses, and the Pro Bono Advisory Council (PBAC), a nonprofit formed to provide technical assistance and coordination among the regional programs. When setting up this program, the USPTO conducted a review of the most appropriate type of agreement to utilize in order to formalize arrangements with the various regional programs. After working with the Office of General Counsel (OGC), the Office of Procurement (OP) and the Office of Planning and Budget (OPB) to assess the various types of agreements, it was determined that the joint program authority/agreement (JPA) would be the best mechanism to encourage intellectual property organizations to establish regional patent pro bono programs. The JPA allows for equitable cost

³ Knowledge of the patent system is demonstrated in one of two ways. An inventor can either have a provisional application on file with the USPTO or, alternatively, can successfully complete a certificate training course on the patent system.

sharing, does not require a formal acquisition via OP, and can easily be terminated if needed. To help ensure that the programs use funds appropriately, the agreements explicitly state that “USPTO’s continued participation in this project, including matching funds...is conditioned on [program name] meeting its obligations under this agreement”. (See *Appendix A – JPA/MOA Example with Case Western University*). In addition, the USPTO anticipates using a Memorandum of Understanding (MOU) is established for those programs that do not require any funding support from the USPTO. These agreements are set up through the agency agreement coordinator in OPB. Although OP was involved in the JPA review early in the process, they are no longer involved in the review. This is one less control that USPTO has in terms of validation of regional rates proposed by programs.

Program Funding

The USPTO budgeted \$3.8M to support up to 18 regional programs, in addition to the PBAC, over a five year period (FY 2017 through FY 2021). This budgeted amount was determined by using the Minnesota pilot program as a basis for expanding into the additional regions taking into account the level of effort required to service each state within a region. (See *Appendix B – Patent Law Pro Bono Best Practices Handbook*). In addition, the individual program funding amounts were determined using input from the various regional programs on the staff that is assigned to support the pro bono work. Agreements are set up between the USPTO and programs across the country who match patent practitioners with eligible inventors. Currently, the USPTO has entered into a JPA with 17 partners in addition to the PBAC.⁴ In order to assist these regional programs in reaching sustainability and establishing a stable financial footing, the USPTO provides partial reimbursements to these programs for the costs of administrating the program.⁵ The extension of funding (FY 2017 through FY 2021) by the USPTO aids regional programs in reaching self-sustainability and steady-state operation. The goal of the program is to have all the regional programs completely self-funded by the end of FY 2021 to maintain access to patent pro bono legal services for citizens throughout the 50 states. If an existing program is unsuccessful and a

⁴ Four of the 20 active regional programs are already completely self-funded and do not require USPTO funding. These programs are the LegalCORPS Inventor Assistance Program (MN); NC LEAP (NC); the Federal Circuit Bar Association (DC, MD, VA, WV), and the Michigan Pro Bono Patent Project (MI). The 17th partner, the University of Arizona, is preparing a launch in March and will become the 21st active program.

⁵ Costs of administering the program often include, but are not limited to, the portion of time spent by an administrator to before the functions needed to screen and match applicants and time spent by a director overseeing program administration and outreach. The JPAs also require each partner to provide in-kind services in equitable proportion. For example, the USPTO may provide technical assistance and support, while the partner may provide marketing materials or host a recognition event.

replacement program is identified, the new program would only have funding from the year it starts through FY 2021, not the full five year period. The USPTO allocated \$640,000 to the Patent Pro Bono Program for FY 2015 and \$667,300 for FY 2016.⁶ For detailed information on funding, refer to *Appendix C - Funding by Program*.

The JPA allows for partial reimbursement to each program (generally up to 50%) of the project costs - this reimbursement is calculated based on the estimated cost provided by the regions to manage the program. The program, in good faith, provides the various positions involved in the process, the position salary and the portion of FTE assigned, and this information is validated against past performance and the level of support necessary for program operation identified in the Best Practices Handbook. The handbook provides in-depth background of the Minnesota Pro Bono Pilot Program and is used as guidance to establish new programs. The programs commit to maintaining adequate accounting records of all expenditures of USPTO funds and to make such records available to USPTO for audit purposes as requested, as specifically stated in each JPA. The initial labor costs were validated by OP as fair and reasonable, and since inception, for most programs, have not changed. Different types of organizations have varying compensation and overhead amounts (e.g. university, law firm, state bar association, etc.) resulting in different funding allocations across programs.

Since the vehicle through which this agreement is established is a JPA, the USPTO's ability to negotiate rates is limited. When the cost estimates seem unreasonable, the Patent Pro Bono Program team follows up with the program to clarify expectations and performance in support of program operation and the regional program typically adjusts their cost proposal to be in alignment with other comparable programs. In general, all cost information received from the programs has been consistent with research performed on cost and overhead rates for specific areas. In determining whether the cost is fair and reasonable, market analysis is performed comparing salary and overhead rates to those of other comparable institutions such as universities (generally higher overhead rates) and is assessed accordingly. Since the USPTO reimbursement does not cover the entire cost of the program, donors, administrative fees and grants provide the remaining funding. Examples of donors include corporations, law firms, individual donations, foundations, and the patent bar.

In accordance with the requirements outlined in the JPA, the regional programs invoice USPTO for reimbursement after work is performed. OED checks the invoice and approves for payment via

⁶ The funds allocated in FY 2015 and 2016 include \$50,000 of travel for USPTO personnel in each year to provide technical assistance, support, and outreach on behalf of the regional programs.

correspondence with the Office of Finance. The team verifies invoices against the budget in their JPA. In addition, they verify that the invoice amount for each task is under the not-to-exceed threshold for the program. The accounting team in the Office of Finance then processes the invoices and makes payments based on the invoiced amount, not to exceed the funded amount.

The Patent Pro Bono team produces a monthly status report that summarizes and monitors program activity and provides this report to the Director of OED (See *Appendix D – Monthly Status Report*).

V. Survey

The Office of Finance conducted a survey of ten programs covering various regions of the United States that support the USPTO Patent Pro Bono Program. The survey was distributed to 3 high volume programs, 3 medium volume programs, 3 low volume programs, and 1 self-sustaining program. The results of the samples were used to identify and assess operational and financial conditions, path to self-sustainability, program risks and challenges, customer satisfaction, program success stories, and suggestions to help the USPTO improve the program. Per the 10 programs surveyed, we received 9 responses for a 90% response rate. The raw survey results are included as reference in *Appendix E – Raw Survey Results* of this document. Although the survey results are briefly summarized below, ABI recommends that the team review the results and determine if any responses or actions are necessary to provide improved service to the programs.

Summary results as shared by the programs are provided below for each category in the questionnaire:

- *Operational and financial conditions* – A majority of regional programs are operating efficiently and currently have the necessary funding to provide high quality service to customers.
- *Path to self-sustainability* – Although funding is available to operate efficiently, long term path to self-sustainability is unclear due to donor commitments.
- *Program risk and challenges* – Funding, support coverage, education and outreach are all challenges cited in the survey by the various programs.
- *Customer satisfaction* – Regional programs are satisfied with the level of support provided by the USPTO Patent Pro Bono Program team.
- *Program success stories* – A success story was submitted related to one inventor's idea getting out to market per support from the Patent Pro Bono Program.

- *Suggestions* – Continued funding support, outreach, and increased education were areas the programs felt the USPTO could improve upon.

VI. Risk Assessment

If the USPTO stops funding the regional programs after FY 2021, there are several possible risks that may negatively impact the Patent Pro Bono Program. As stated in the OED funding memo from March 2016, some of these risks include the following: (1) decrease in sustainability, (2) program failure, (3) difficulty in adding new programs, (4) reducing outreach and marketing, and (5) decreasing service.

The memo also included a statement on a recent PBAC study that was conducted to determine program sustainability. Findings as stated in the OED Budget memo state that “the PBAC evaluated the respective budgets of the regional programs to determine their sustainability after the expiry of the USPTO’s current funding as well as the possibility of program failure and potential loss of the presidentially mandated 50 state coverage. The PBAC study found that almost half of the 20 programs have been in existence for a year or less, are too new to secure funding, and, as such, are sensitive to market factors for sustainability. As a result, the PBAC study suggested that without continued USPTO funding for the regional programs, there is a possibility of at least three programs failing to continue operating within the Program. If the USPTO entirely ceased funding of the regional patent Pro Bono Programs, there is a reasonable likelihood that the 50 state pro bono coverage achieved at the behest of the Executive Action would disintegrate.” (See *Appendix F - OED Memo – Patent Pro Bono Program Proposed Budget*). If USPTO funding is severely reduced or terminated, this would critically affect the Program’s ability to establish new programs and expand the scope of the outreach of current programs.

There are still other potential risks associated with the program. Operational risks include resources being redirected to higher priority tasks limiting resources dedicated to the program as priorities change for the USPTO and OED. There is also reputational risk – as the USPTO continues to dedicate time and effort in establishing this program and the IP community becomes more aware of the benefits and availability of these services, if the program is ultimately unsuccessful and regional programs are unsustainable, this could in turn negatively impact the USPTO’s reputation amongst stakeholders and the national intellectual property community. Finally, there is an obvious financial risk in that as USPTO continues to fund many of the regional programs, the return on investment is not significant in terms of incoming fee revenue as a result of few patent

applications generated through this program. Applicants are large in number initially, then those who qualify are even less in number, those who work with a Pro Bono practitioner are even fewer and finally those that actually apply for a patent are less. Ultimately, the number of patents resulting from the program may not recover the cost of the funding that USPTO provides. Although it is likely that the program funding may be offset by some fee revenue resulting from patent applications initiated via this program, there are potentially other intangible benefits to the program that cannot necessarily be quantified. From a policy perspective, the program is deemed a useful societal function so that potential inventors with good ideas can bring those inventions to market via this channel and so the USPTO may be willing to bear the burden of this risk for the greater good. The program favorably impacts costs of other USPTO functions such as reduced examination costs due to higher quality applications, reduced Pro Se Assistance costs (in-person and telephone assistance costs), and potential reduced inquiries to the technology centers.

VII. Findings/Recommendations

The Office of Finance reviewed documentation and met regularly with the OED team to understand the Patent Pro Bono Program processes in order to recommend additional actions to ensure program success. It is clear that the Patent Pro Bono team worked in partnership with OP and OGC to ensure proper protocols are followed when establishing and maintaining agreements with the regional programs at the onset of this program. The vehicles identified for these agreements are appropriate and the approach used to determine the various funding amounts is reasonable as it is based on input from the various programs and is analyzed against the costs of other comparable entities. The Minnesota Pilot Pro Bono Program highlighted in the Best Practices Handbook serves as the basis for determining the budget which expands the program to cover all 50 states. However, to ensure continue program success and sustainability, the Office of Finance recommends reassessing the current funding approach.

Funding Options

There are several options that the USPTO can pursue related to funding the regional programs. These include:

- 1) Declining (Sliding Scale) – Reduction by 10% each subsequent year of USPTO funds through FY 2021. (current approach)
- 2) Performance Based Funding – Funding based on performance metrics collected from programs.
- 3) Steady State through FY 2021 – 50% of cost provided by USPTO through FY 2021.

- 4) Steady State through FY 2021 and beyond – 50% of cost provided by USPTO through FY 2021 and beyond.

The Office of Finance recommends **Option 4 – Steady State through FY 2021 and beyond**. In our review, we determined that the regional programs require additional time and support to reach program stability. This support by the USPTO is required to ensure continued success by the programs and to enhance their efforts to match under-resourced inventors and small businesses with pro bono attorneys to help assess, file, and prosecute patent applications. Dedicated USPTO resources are needed in order to reduce the risk of program failure and to continue transitioning the regional programs to a steady-state operation and full sustainability. Achieving self-sustainability and fund-raising are the two biggest challenges a program faces. According to the PBAC, research shows that nonprofit organizations can take between 2-7 years to reach self-sustainability which is beyond FY 2021. By extending the length of time that the USPTO provides funding to these regional programs even further, the risk of failure is reduced, and the likelihood of achieving self-sustainability is increased.

The ultimate goal of the USPTO is to provide enough funding to maintain the program long enough to allow it to become self-sustaining. If the USPTO would like to see a successful Pro Bono Program in all 50 states, our assessment and recommendation is that continued funding is required at a **steady state beyond FY 2021** rather than the existing sliding-scale (declining rate) through FY 2021. The concern related to funding is evident in the regional program survey results and funding the programs at a steady state from year to year would alleviate this concern and allow programs to focus on bolstering their own processes in addition to acquiring the donors needed to fund the remaining costs. The declining rate approach does not provide stability to the programs and forces them to spend resources on acquiring donors rather than acquiring potential patent applicants. However, the declining rate allows for reserve to be built up which can accommodate expansion of existing programs or new programs altogether.

The steady state would entail a continued commitment of funding approximately 50% of each regional program's total annual reimbursable administrative costs over the next five years and beyond. Currently, the USPTO funds on a declining scale approximately \$630,000 per year for joint project agreements for the current regional programs for a total of \$2.9M over the next five years, which is significantly less than the \$3.8M budget. This amount would increase if new regional programs are added to the Patent Pro Bono Program, administrative costs of the regional programs increase, and if the USPTO decides to fund at 50% each year as recommended by the Office of Finance and mentioned in the PBAC analyses.

Regarding the performance based approach, operational metrics are provided by the programs to the USPTO on a quarterly basis and tracked by the Pro Bono Team (See *Appendix G – Program Operational Metrics*). In order to inform the funding process, it is critical that in addition to the existing operational metrics, the Patent Pro Bono Program start to develop, based on data collected, the appropriate performance metric data to help measure over time the probable success of various programs around the country. Since the program is relatively new, there is limited data available for analysis. USPTO should continue to collect and monitor this information for the various programs and should encourage all programs to submit metrics on a regular basis rather than on a voluntary basis. These metrics may provide some data to the Patent Pro Bono Team about whether a program is set to succeed or eventually fail, and if the latter is determined, USPTO could consider closely watching a particular program and if it is heading towards failure, USPTO may want to consider ending funding of that program. On the flipside, if it seems like a program is generating patent applications and still requires funding to sustain itself, USPTO can consider further allocation of funds as needed. While the metrics collected by the Pro Bono Team may give insight into a particular program's service to the public for a given quarter, it is a stretch, to say the least, to imply that only these metrics should be used to determine the long-term viability and funding of a program. The metrics can provide valuable trends regarding a program's ability to attract applicants, donors, and volunteers, but the data currently being collected cannot truly speak to a program's operational efficiencies or financial position since much of what is being reported is beyond a program's control. It would be more reasonable to take a holistic approach in evaluating each regional program. Even a side-by-side comparison of these programs must be performed with caution due to the extreme differences between various regional programs (size, tenure, entity type, region, etc.). While the current set of metrics are valuable in their own right and can inform the funding process, it would be prudent to make sure that they are not the sole basis of funding regarding the regional programs.

With regard to the agreement review process, since OP is no longer involved with non-FAR transactions and limits review to Economy Act agreements, we recommend that the Office of Chief Financial Officer (OCFO) consider participation in the funding review to help the Patent Pro Bono Team validate the projected costs provided by the programs via the JPAs. Finally, we agree that having dedicated Patent Pro Bono Team resources in OED, including a Program Director and two administrative FTEs, is sufficient for the current size of the program, but if additional regional programs were to come into existence, additional staff may be required to provide support to these entities and ensure program success in the long term.

