

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Overview of the Patent Pro Bono Program

Patent Pro Bono Team

Office of Enrollment and Discipline

United States Patent and Trademark Office

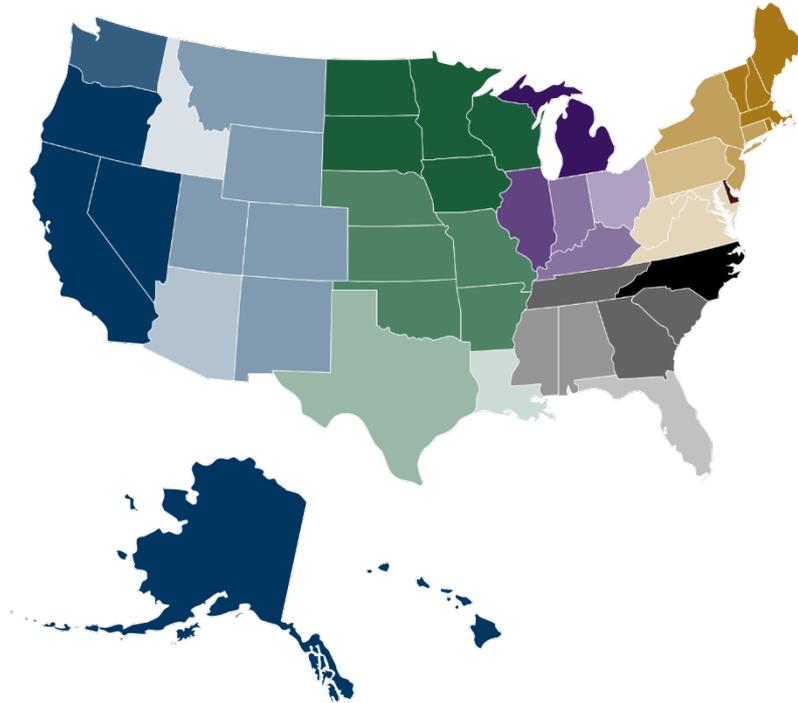
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# Patent Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses
  - Section 32 of AIA – The USPTO’s 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
  - USPTO 2019 – 2022 Strategic Plan calls for the USPTO to enhance “the assistance we provide to independent inventors and small businesses”
- 22 regional programs work to match financially under-resourced inventors and small businesses with volunteer practitioners to file and prosecute patent applications

# Current nationwide coverage



- |                                      |                                      |                              |
|--------------------------------------|--------------------------------------|------------------------------|
| ■ Washington Pro Bono Patent Network | ■ Gateway Venture Mentoring Service  | ■ New York Tri State Program |
| ■ Idaho Patent Pro Bono              | ■ TALA                               | ■ Delaware Program           |
| ■ CLA                                | ■ The Ella Project                   | ■ FCBA (Mid-Atlantic)        |
| ■ ProBoPat                           | ■ Chicago-Kent Patent Hub            | ■ PA Patent                  |
| ■ Arizona Public Patent Program      | ■ PatentConnect for Hoosiers (IN KY) | ■ NC Leap                    |
| ■ LegalCorps (MN)                    | ■ Ohio Invents                       | ■ Georgia Patents            |
| ■ Pro Bono Patent Project (MI)       | ■ BBVLP Patent Program (MS AL)       | ■ Patent Pro Bono FL         |
|                                      | ■ New England Program                |                              |



# Regional patent pro bono programs

- Regional programs may cover individual or multiple states
- Regional programs are operated by
  - Nonprofit organizations focusing on copyright and trademark (e.g., lawyers for the arts)
  - Universities
  - Bar associations
- Regional programs follow general guidelines but are independent of the USPTO and set their own policies and procedures
- Regional programs are responsible for screening and matching patent pro bono applicants
  - Ensure applicants meet requirements for pro bono assistance
  - Screen for
    - Income
    - Knowledge of the patent system
    - An actual invention (more than an idea)

# General criteria for inventors

- **Gross household income**
  - Regional program dependent, but usually limited to 300% of the federal poverty guidelines
  - A single person could have an income of up to \$37,470 (<https://aspe.hhs.gov/poverty-guidelines>)
  - The limit increases with additional dependents
- **Demonstrate knowledge of the patent system**
  - Have at least a provisional application on file with the USPTO or have completed a certificate training course [www.uspto.gov/video/cbt/certpck/index.htm](http://www.uspto.gov/video/cbt/certpck/index.htm)
- **Have an invention; more than an idea**
  - To demonstrate that there is an invention one should be able to describe the invention so that someone could make and use the invention
  - Responsible for all USPTO fees
  - Micro-entity status provides a 75% reduction in USPTO fees
- **Regional programs may charge application fee of \$25-\$150**

# General criteria for inventors (cont.)

- Some regional programs have additional requirements
  - For example, some may require you to file a provisional patent application with the USPTO before applying for pro bono assistance
- Applicants with an upcoming deadline may not be able to be matched with a practitioner
  - For example, if you have a provisional application on file with the USPTO, your regional program may only attempt to match you with a practitioner if you apply three to six months in advance of your provisional application's expiration date
  - This allows time to find a practitioner and time for the practitioner to complete the work

# Micro-entity status (75% reduction in USPTO fees)

- The AIA defines a micro entity as a patent applicant who certifies that he/she
  - Qualifies as a small entity
  - Has not been named as an inventor on more than four previously filed patent applications
  - Did not, in the calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding three times the median household income
  - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is paid, had a gross income exceeding three times the median household income

# Matching with a patent practitioner

- Assuming you qualify for pro bono assistance, your regional program will provide its patent practitioners with a brief description of you and your invention
  - There is no guarantee that a practitioner will choose to work with you on your invention
  - Reasons an invention may not be chosen may include, but are not limited to:
    - No practitioner with experience in your technology
    - You or your invention/business conflicts with an existing or former client of the practitioner
- Follow up with your regional program periodically to verify your status
- If, after a period of time, no practitioner chooses to work on your invention, then your regional program will inform you that no practitioner is available to serve you
  - Your regional program may provide you with other resources that may help you pursue your patent application

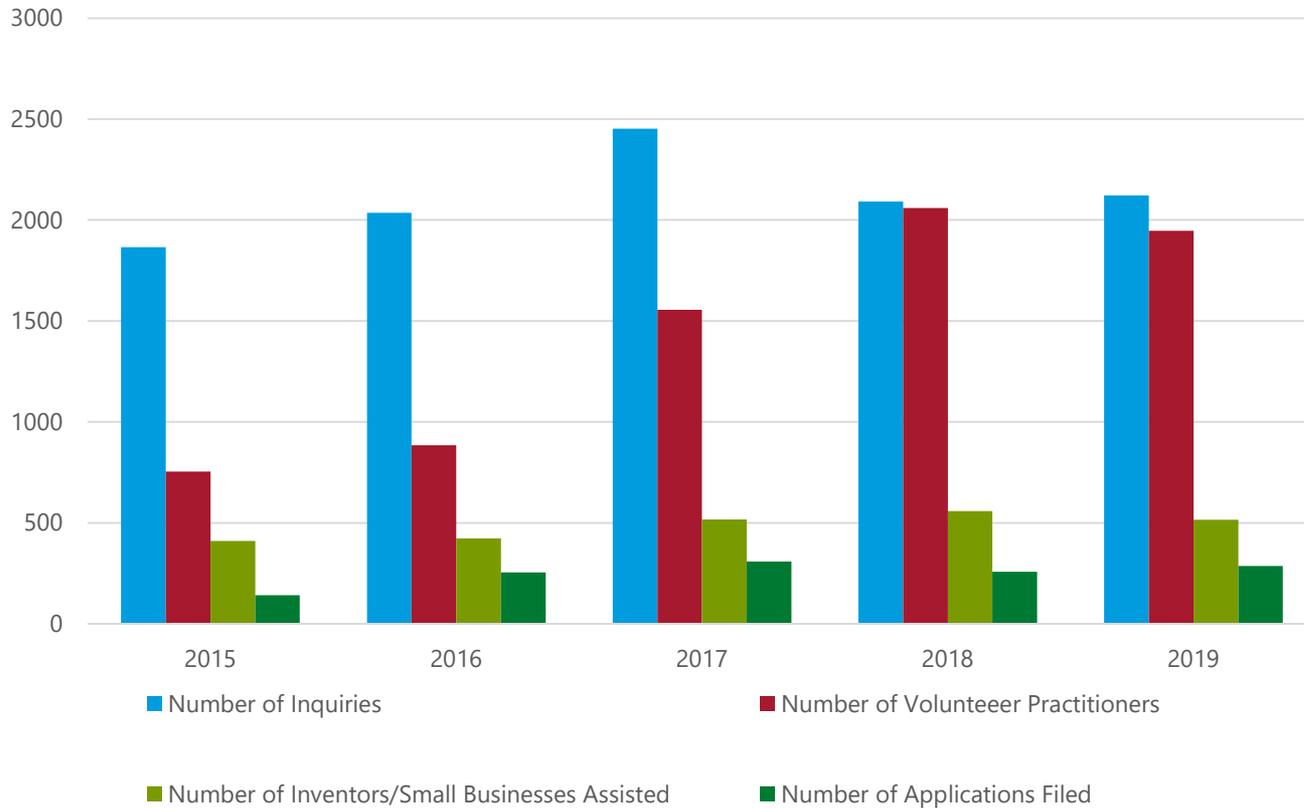
# Working with a patent practitioner

- If matched, be an active participant in your patent application preparation and filing!
  - Be able to describe your invention, its inventive feature(s), and the problem that you are trying to solve
  - Know your marketplace
  - Be aware of similar inventions or solutions to the problem
  - Be responsive to the practitioner's requests
- The practitioner may require you to sign an engagement letter or retainer agreement
  - Such letters may discuss information including, but not limited to
    - The scope of services provided
    - Any ancillary fees
    - The reasons that the practitioner may withdraw from the representation
  - Avoid verbal agreements

# Working with a patent practitioner

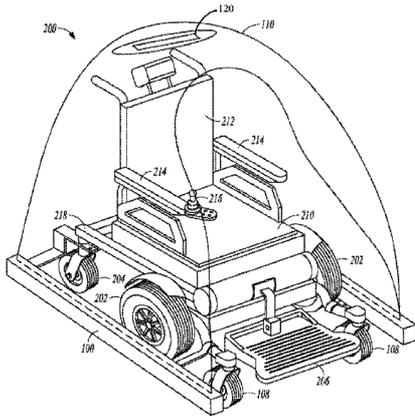
- The scope of services provided may be limited to just a portion of the patenting process
  - This is also called a limited engagement or “unbundled” services
  - The patent application process has several stages including
    - Preparation and filing of the patent application
    - Response to USPTO communications
    - If the patent is granted, the payment of periodic maintenance fees
  - For example, a practitioner may help prepare and file your application, but may not agree to help with the other stages of the process
  - The practitioner must obtain your *informed consent* to limit the scope of services
- In addition to USPTO fees, you may need to pay for ancillary fees such as drawings
  - You are responsible for USPTO fees - do not ask the practitioner to advance or pay your USPTO fees
  - Ask questions

# Program growth

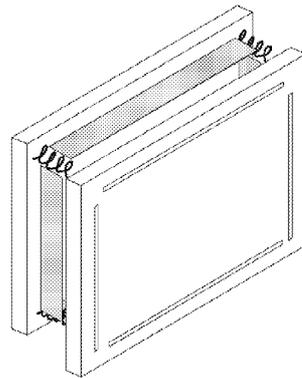


# Success stories

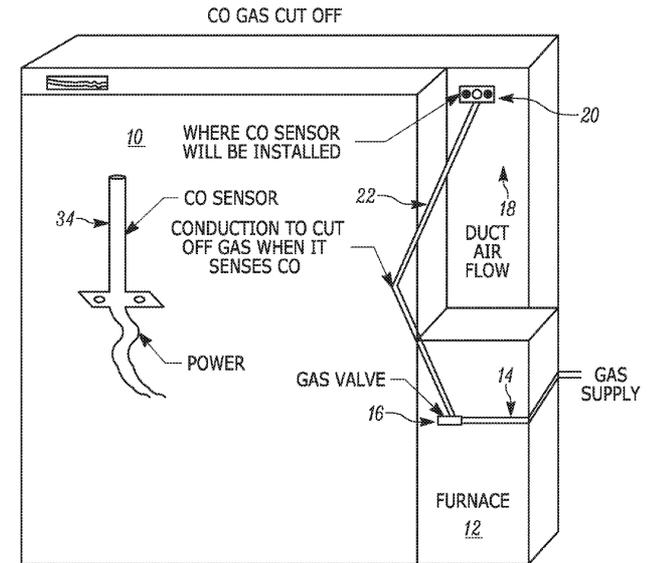
Wheelchair Protector  
U.S. 9,943,455



Precision Dry Wall Punch  
U.S. 10,391,665



Carbon Monoxide Detector  
U.S. 10,101,027



# Applying to the Patent Pro Bono Program

- Apply directly with your regional program
  - To find the regional program that serves you, see [www.uspto.gov/probonopatents](http://www.uspto.gov/probonopatents) for a map of the United States and select your state
- E-mail [probono@uspto.gov](mailto:probono@uspto.gov) if you have any questions

# Patent practitioners are the linchpin

- More than 2,000 practitioners have signed on to volunteer
  - Need outpaces supply
  - Unlike other forms of pro bono representation, only registered practitioners can represent financially under-resourced inventors to prepare, file, and prosecute patent applications before the USPTO
- Improved patent quality
  - A pro se inventor is now represented
  - The inventor is educated about the patent system
  - Professional advice may help the inventor make better decisions
    - “No” may be what the inventor needs to hear
- Practitioner benefits
  - Inventors may become paying clients
  - State bars increasingly are offering continuing legal education credit for pro bono service
  - USPTO certificate for those who provide 50+ hours of patent pro bono service in calendar year
    - Contact your regional program for more information

# Practitioner recognition

- The USPTO issues certificates to registered patent practitioners who provide 50+ hours of patent pro bono service in a calendar year
- Patent practitioner name, firm, and regional program are posted on the USPTO website
- Signed by the Commissioner for Patents and the Director for the Office of Enrollment and Discipline
- The USPTO has recognized over 160 patent practitioners



# Pro bono certification form

- Practitioner voluntarily certifies filing as pro bono
- Form uploaded by practitioner and included as part of the Image File Wrapper
- Enables the USPTO to track the impact of the PPBP

CERTIFICATION OF PRO BONO REPRESENTATION (Page 1 of 1)			
First Named Inventor		Application Serial Number (if known)	
Title of Invention			
THE UNDERSIGNED ATTORNEY HEREBY VOLUNTARILY CERTIFIES THE FOLLOWING:  <input type="checkbox"/> I am submitting a filing for the above-identified application pro bono.			
Signature		Date	
Name (Print/Typed)		Practitioner Registration Number	
<b>Note:</b> This form must be signed in accordance with 37 CFR 1.33. Please see 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required and indicate below the total number of forms submitted.*			
<input type="checkbox"/> *Total of _____ forms are submitted.			

# Patent pro bono graphic



# How to volunteer

1. Be a registered patent practitioner with the USPTO in good standing
  - Practitioners who are attorneys must also be in good standing in any state(s) in which they are licensed to practice law
2. In general, have at least three years experience prosecuting applications
  - If not, consider teaming up with another practitioner
  - Requirement may vary with your regional program
3. Volunteer
  - Select your state from the U.S. map at [www.uspto.gov/probonopatents](http://www.uspto.gov/probonopatents) and follow the instructions on your regional program's website

# More information

- Visit [www.uspto.gov/probonopatents](http://www.uspto.gov/probonopatents)
- Email [probono@uspto.gov](mailto:probono@uspto.gov)



# The Law School Clinic Certification Program

- Another option for pro bono assistance
  - Permits law school students enrolled in a participating law school's clinic to practice patent and/or trademark law before the USPTO
    - Students practice under the guidance and supervision of an approved faculty clinic supervisor
    - Legal services are provided pro bono to inventors/applicants
- Inventors/applicants are responsible for USPTO filing fees and costs
- See [www.uspto.gov/LawSchoolClinic](http://www.uspto.gov/LawSchoolClinic)



# USPTO legal careers

Position	USPTO Office
Staff attorney	Office of Patent Legal Administration
Attorney advisor	Trademarks, Trademark Trial and Appeal Board
Patent attorney, attorney	Office of Policy and International Affairs
Staff attorney	Office of Petitions
Judge	Patent Trial and Appeal Board
Staff attorney, counsel	Office of General Counsel
Regional Outreach Officer	Regional Offices
Patent Examiner	Patents

