

## PROPOSAL FOR IDAHO PATENT PRO BONO PROGRAM

### BACKGROUND ON THE PATENT PRO BONO PROGRAM

The Patent Pro Bono Program was authorized under the Leahy-Smith America Invents Act (AIA) which encouraged the US 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." It is one the Obama Administration's seven [Executive Actions](#) for the USPTO to assist innovators by expanding the pro bono program to cover all 50 states.

The eligibility requirements vary for each program. In general, there are three basic requirements that a successful applicant must meet:

1. Maximum household income. This is region dependent, but the income cut-off is usually 300% of federal poverty levels;
2. Knowledge of the patent system. This requires an inventor to (a) have a current provisional or nonprovisional patent application on file with the USPTO, or (b) successfully complete the on-line Certificate Training Course; and
3. Proof of invention - not just an idea. To demonstrate an invention, the inventor should be able to describe the invention so that someone else could actually make and use the invention. Proof of prior art search is also required.

Idaho has not established its own Program, so services are currently provided by the California Inventors Assistance Program located at <http://www.calawyersforthearts.org/CIAP>

### INTEREST IN IDAHO AND NEEDS ASSESSMENT

Professor Annemarie Bridy and Associate Dean Lee Dillion are working with the IP Section, the Idaho Volunteer Lawyers Program, and the USPTO to investigate the following:

- The administrative requirements for the Program;
- The inventor needs in Idaho for such a program; and
- The interest by the patent bar in Idaho in providing needed pro bono services.

The USPTO has provided us administrative contacts at other law schools running similar programs as well as data on the number of Idaho inventors seeking Pro Bono assistance.

### PROPOSAL BY THE COLLEGE OF LAW

The College believes that the existence of such a Program in Idaho, administered by the College of Law, would be a benefit to the community generally, the patent bar, and students interested in serving as externs or pro bono assistants in the patent prosecution process.

We anticipate that the administration of the Program could be assigned to Dean Dillion as he has experience in administering similar programs in the past such as the externship, Semester in Practice, and Small Business Legal Clinic programs. Professor Bridy, through her outreach and engagement efforts, would provide critical guidance and liaison duties between the College and the IP Section.

We have discussed the feasibility of establishing a patent clinic as part of the existing Small Business Legal Clinic (that currently handles trademark prosecution before the USPTO). However, we do not currently have a consistent flow of students capable of serving in a clinical capacity or the clinical faculty to manage such an effort. That said, we would have students that we could pair from time to time with pro bono attorneys under our externship and pro bono programs.

A successful Patent Pro Bono Program would provide us the opportunity to deliver patent services to the community while we use the existence of the Program to attract more STEM undergraduates to the College in the long term. Combined with our existing clinical efforts, we would be a significant contributor to the high-tech effort in Idaho.

## **PROGRAM REQUIREMENTS**

A successful Patent Pro Bono program in Idaho will require the following:

- Program administration – The College proposes to handle the program administration. Feedback from other law school programs indicates that the administrative demands will include the following:
  - An administrator spending 1-8 hours per week on program administration
  - A program assistant spending 5 hours per week (up to 20 per week initially) maintaining the program website, asking clients for follow-up information, tracking volunteers, etc.
  - A functioning website
- Qualified inventors who meet the 3 program requirements listed above
- IP attorneys in sufficient numbers to meet qualified inventor needs

The main administrative hurdle will be the underwriting or screening of qualified inventors. Most program directors that we have talked to suggest several screening methods:

- An administrative fee that varies from \$50 to \$100 as a way of ensuring program buy-in and “skin in the game” attitude
- A well-developed patent intake form. Suggestions as to an appropriate intake form are welcome.
- A panel to review the application for compliance with the eligibility requirements of the program. The College can handle the income verification, but we will need assistance with the proof of invention requirement.

## OPEN QUESTIONS

***Proof of Knowledge of Patent System.*** As proof of knowledge, some programs require that a provisional or non-provisional patent application be on file already, while others will accept inventors who have completed the USPTO online training module.

In conversations with the USPTO, the USPTO had a preference for the training module completion - reasoning that asking for a provisional or non-provisional application may cause an unprepared inventor to file a poorly worded application. USPTO prefers the training module to better position the inventor and the program, though the choice is up to the program.

***Intake Form Detail.*** The intake forms vary greatly, with some explicitly directing the applicant not to disclose confidential information about the invention (see the Chicago-Kent form at [https://chicagokent.formstack.com/forms/patent\\_hub\\_inventor](https://chicagokent.formstack.com/forms/patent_hub_inventor)), with others asking for detailed information (see the Florida Institute form at <http://www.florida-institute.com/inventor-application>).

The USPTO suggested that the difference largely relates to the screening philosophy of the program, with the more complex intake forms for California and Florida screening out more applicants up front. Though the choice is again up to the program, the USPTO thought that the simpler intake of Chicago-Kent (followed by financial qualification verifications and a patent viability determination) was a better approach, especially where volume isn't great. In all cases, the program will need NDA/confidentiality agreements between the inventor and the program.

***Scope of Service by the Volunteer Attorney.*** The scope of services provided by the volunteer attorney varies under each program. Almost all of the existing programs expect the volunteer attorneys to prosecute both provisional and non-provisional applications.

In terms of the prosecution process, the scope varies. For example, the Florida Institute (at <http://www.florida-institute.com/inventor-application>) provides:

1. *Consultation: All VPAs agree to consult with the matched inventor regarding his/her invention regardless of whether or not the inventor has a pending application with the USPTO.*
2. *Inventor has yet to file anything with the USPTO: If the invention is not currently associated with a pending provisional or non-provisional patent application, Representation shall generally include review of the invention, and filing of a U.S. provisional or non-provisional application. Representation may also include a Response to the First Office Action on the Merits if the inventor demonstrates continued development of the invention and associated business.*
3. *Inventor has a pending provisional patent application: If the invention is currently associated with a pending provisional patent application, Representation shall generally include filing of a U.S. non-provisional application claiming priority to the provisional application; or converting the provisional application to a U.S. non-provisional application. Representation may also include a Response to the First Office Action on the Merits if the inventor demonstrates continued development of the invention and associated business.*

*Representation beyond the scope as defined by the Program will be agreed upon by the individual VPA and the client.*

Chicago Kent (at <http://www.kentlaw.iit.edu/seeking-legal-help/illinois-patent-pro-bono/volunteer-attorney-information>) provides for a more extensive engagement:

- 1. The attorney will draft and file one non-provisional U.S. patent application.*
- 2. The attorney will prosecute the patent application at the USPTO until either (i) a response is filed to a final office action or (ii) the application issues as a patent.*
- 3. The attorney will commit to monitor and docket all deadlines.*
- 4. The attorney is not responsible for requests for continued examination, appeals, challenges to USPTO decisions in a court of law, prosecution after issue or response to final office action, foreign patent applications, international patent applications, or additional U.S. patent applications.*
- 5. The attorney's services may be expanded by mutual agreement between the inventor(s) and the attorney, which should be in writing.*
- 6. The attorney may only withdraw from representation if allowed to do so under applicable ethical rules.*

We will need to decide the scope of representation. We anticipate that the program would refer both provisional and non-provisional patent matters and that the volunteer attorney would prosecute the patent application at the USPTO until either (i) a response is filed to a final office action or (ii) the application issues as a patent.

## **TO-DO LIST**

1. Confirm volunteer attorney interest and capacity
2. Develop web page – See Florida at <http://www.florida-institute.com/FloBono> and Widener at <http://delawarelaw.widener.edu/community-friends/patent-pro-bono-program/>
  - Main page – program description
  - Inventor page – information and application. See Birmingham's page for a nice summary of inventor obligations at <http://vlpbirmingham.org/patent-requirements/> including prior art requirements. See also <http://glarts.org/patents/inventors/>
  - Volunteer Attorney page – information and application
  - FAQ – see one example at <http://legalcorps.org/inventors/frequently-asked-questions> and another at <http://www.micasaresourcecenter.org/wp-content/uploads/2013/04/ProBoPat-FAQ-Document.pdf> and <http://mitchellhamline.edu/intellectual-property-institute/inventor-assistance-program/frequently-asked-questions/>
3. Define scope of work
4. Develop report back processes