

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **USPTO Inventor Info Chat Series:** ***Free Legal Services for Inventors***

**James M. Silbermann**

Office of Enrollment and Discipline Staff Attorney

**John Kirkpatrick**

Patent Pro Bono Administrator and Staff Attorney

**Daniel Kolker - Moderator**

Supervisory Patent Examiner

November 16, 2017

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Office of Innovation Development (OID)

- In Person Assistance (by appointment) for Pro Se Applicants
- Assistance Hotline 1-866-767-3848
- Patent Email Support  
[innovationdevelopment@uspto.gov](mailto:innovationdevelopment@uspto.gov)
- PTRC Partnership for Patent Education Courses
- Inventor Outreach – Independent Inventor Conferences – Education for Inventor Organizations
- <http://www.uspto.gov/inventors>



# **An Overview of the USPTO Law School Clinic Certification Program**

James M. Silbermann

Office of Enrollment and Discipline  
Staff Attorney

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# USPTO Law School Clinic Certification Program - Overview

- Allows students in a participating law school's clinic program to practice before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor.
- The OED Director grants participating law students limited recognition to practice before the USPTO in patents/trademarks.
- Signed into law on December 16, 2014. Current expansion period closes December 29, 2017.
- Currently 53 law schools actively participate:
  - 21 trademark only,
  - 7 patent only,
  - 25 both patent & trademark.



## PATENT AND TRADEMARK PROGRAMS

- 1 American University, Washington College of Law – Washington, D.C.
- 2 Arizona State University Sandra Day O'Connor College of Law – Phoenix, Arizona
- 3 Baylor Law School – Waco, Texas
- 4 Fordham University School of Law – New York, New York
- 5 Indiana University Maurer School of Law – Bloomington, Indiana
- 6 Indiana University Robert H. McKinney School of Law – Indianapolis, Indiana
- 7 Lewis & Clark Law School – Portland, Oregon
- 8 Lincoln Law School of San Jose – San Jose, California
- 9 Mitchell Hamline School of Law – Saint Paul, Minnesota
- 10 New York Law School – New York, New York
- 11 North Carolina Central University School of Law – Durham, North Carolina
- 12 South Texas College of Law – Houston, Texas
- 13 Southern Methodist University Dedman School of Law – Dallas, Texas
- 14 Southern University Law Center – Baton Rouge, Louisiana
- 15 Suffolk University Law School – Boston, Massachusetts
- 16 Texas A&M University School of Law – Fort Worth, Texas
- 17 The John Marshall Law School – Chicago, Illinois
- 18 Thomas Jefferson School of Law – San Diego, California
- 19 Tulane University Law School – New Orleans, Louisiana
- 20 University of California, Los Angeles School of Law – Los Angeles, California
- 21 University of Connecticut School of Law – Hartford, Connecticut
- 22 University of Maryland School of Law – Baltimore, Maryland
- 23 University of Notre Dame Law School – Notre Dame, Indiana
- 24 University of Puerto Rico School of Law – San Juan, Puerto Rico
- 25 University of Washington School of Law – Seattle, Washington

## PATENT PROGRAM ONLY

- 26 Brooklyn Law School – Brooklyn, New York
- 27 Case Western Reserve University School of Law – Cleveland, Ohio
- 28 University of Arizona, James E. Rogers College of Law – Tucson, Arizona
- 29 University of Colorado Law School – Boulder, Colorado
- 30 University of Detroit Mercy School of Law – Detroit, Michigan
- 31 Washington University in St. Louis School of Law – St. Louis, Missouri
- 32 Wayne State University Law School – Detroit, Michigan

## TRADEMARK PROGRAM ONLY

- 33 California Western School of Law – San Diego, California
- 34 Howard University School of Law – Washington, D.C.
- 35 Michigan State University College of Law – East Lansing, Michigan
- 36 Northeastern University School of Law – Boston, Massachusetts
- 37 Northwestern Pritzker School of Law – Chicago, Illinois
- 38 Roger Williams University School of Law – Providence, Rhode Island
- 39 Rutgers Law School – Newark, New Jersey
- 40 Saint Louis University School of Law – Saint Louis, Missouri
- 41 Seattle University School of Law – Seattle, Washington
- 42 Syracuse University College of Law – Syracuse, New York
- 43 The George Washington University School of Law – Washington, D.C.

- 44 University of Akron School of Law – Akron, Ohio
- 45 University of Idaho College of Law – Boise, Idaho
- 46 University of Nebraska College of Law – Lincoln, Nebraska
- 47 University of New Hampshire School of Law – Concord, New Hampshire
- 48 University of North Carolina at Chapel Hill School of Law – Chapel Hill, North Carolina
- 49 University of Richmond School of Law – Richmond, Virginia
- 50 University of San Francisco School of Law – San Francisco, California
- 51 University of St. Thomas School of Law – Minneapolis, Minnesota
- 52 University of Tennessee College of Law – Knoxville, Tennessee
- 53 Vanderbilt Law School – Nashville, Tennessee
- 54 Western New England University School of Law – Springfield, Massachusetts
- 55 West Virginia University School of Law – Morgantown, West Virginia

November 2017



Email questions to:  
[inventorinfochat@uspto.gov](mailto:inventorinfochat@uspto.gov)

# USPTO Law School Clinic Certification Program – Program History

- The Program began as a pilot program in the Fall Semester of 2008 with six participating law school clinics. The Program previously expanded in 2010, 2012, and 2014.
- In June 2016, the Program again opened for expansion and will accept applications from law school clinics through December 29, 2017.
- Currently, 53 law school clinics participate in the Program: 25 clinics participate in both the Patent and Trademark portions of the Program, 21 clinics participate only in the Trademark portion of the Program, and 7 clinics participate only in the Patent portion of the Program.



# Clinic Participation Requirements

- Each law school clinic must meet and maintain the requirements for USPTO certification in order for the law school clinic to participate in the Program and for the law school clinic students to practice before the USPTO.
- Each law school clinic that wishes to have its students practice patent and/or trademark law before the USPTO must agree to the rules, requirements and procedures of the Program as set forth by the USPTO, including having the law school's Faculty Clinic Supervisor certify that the law school clinic and participating law school clinic students will abide by the terms and requirements set forth by the USPTO.
- The Law School Dean, or one authorized to act for the dean, must certify that each participating law school student has completed his/her first year of law school or the equivalent, is in compliance with the law school's ethics code, and is of good moral character and reputation. The Faculty Clinic Supervisor(s) must ensure that a conflict of interest check is performed.

Email questions to:  
[inventorinfochat@uspto.gov](mailto:inventorinfochat@uspto.gov)

# Clinic Participation Requirements

- The participating law school clinic students will 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.



# Faculty Clinic Supervisor

- The Faculty Clinic Supervisor is responsible for instructing, mentoring, overseeing and supervising all participating law school students in the clinic and is responsible for all applications and documents submitted to the USPTO through the clinic.



# Services Certified Clinics May Provide To Their Clients

- Patent activities may include: 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 activities may include: 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.

# Statistics – Snapshot of Clinic Filings

- More than 3,000 law school clinic students have participated in the Program.
- More than 650 patent applications have been filed, and more than 2,400 trademark applications have been filed.



# Filing Statistics – How Clinics Have Helped Others

## Law School Clinic Statistics (FY2009-FY2017, Q3)

### □ Patent application filing statistics (as reported by law schools)

- FY2009 - 21 patent applications
- FY2010 - 17 patent applications
- FY2011 - 29 patent applications
- FY2012 - 18 patent applications
- FY2013 - 108 patent applications
- FY2014 - 113 patent applications
- FY2015 - 113 patent applications
- FY2016 - 126 patent applications
- FY2017 (Q1-Q3) - 108 patent applications

### □ Trademark application filing statistics (as reported by law schools)

- FY2009 - 74 trademark applications
- FY2010 - 71 trademark applications
- FY2011 - 83 trademark applications
- FY2012 - 101 trademark applications
- FY2013 - 209 trademark applications
- FY2014 - 407 trademark applications
- FY2015 - 543 trademark applications
- FY2016 - 515 trademark applications
- FY2017 (Q1-Q3) - 477 trademark applications



# Contacting Participating Law School Clinics

- You can contact the participating law school clinics directly through the contact information on the following web page:

<https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1>

# Contacting Participating Law School Clinics

## Participating Law Schools

The law schools listed below participate in the USPTO Law School Clinic Certification Program. **Please contact the school at the listed e-mail address if you wish to make general inquiries or request legal services.**

**\*\*ACCEPTANCE AS A CLIENT IS  
SUBJECT TO THE LAW SCHOOL'S  
REQUIREMENTS AND DISCRETION**

Participating Law Schools	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
American University, Washington College of Law	<a href="mailto:iplclinic@wcl.american.edu">iplclinic@wcl.american.edu</a> ✉	Patents and Trademarks	District of Columbia, Maryland and Virginia Only
Arizona State University Sandra Day O'Conner College of Law	<a href="mailto:patent_clinic@asu.edu">patent_clinic@asu.edu</a> ✉ (patents) <a href="mailto:Trademark_clinic@asu.edu">Trademark_clinic@asu.edu</a> ✉ (trademarks)	Patents and Trademarks	All United States
Baylor Law School	<a href="mailto:iplawclinic@baylor.edu">iplawclinic@baylor.edu</a> ✉ <a href="mailto:patents@baylor.edu">patents@baylor.edu</a> ✉ (patents) <a href="mailto:trademarks@baylor.edu">trademarks@baylor.edu</a> ✉ (trademarks)	Patents and Trademarks	Texas Only

Email questions to:  
[inventorinfochat@uspto.gov](mailto:inventorinfochat@uspto.gov)



# An Overview of the Patent Pro Bono Program

John Kirkpatrick

Patent Pro Bono Administrator and  
Staff Attorney

UNITED STATES  
PATENT AND TRADEMARK OFFICE



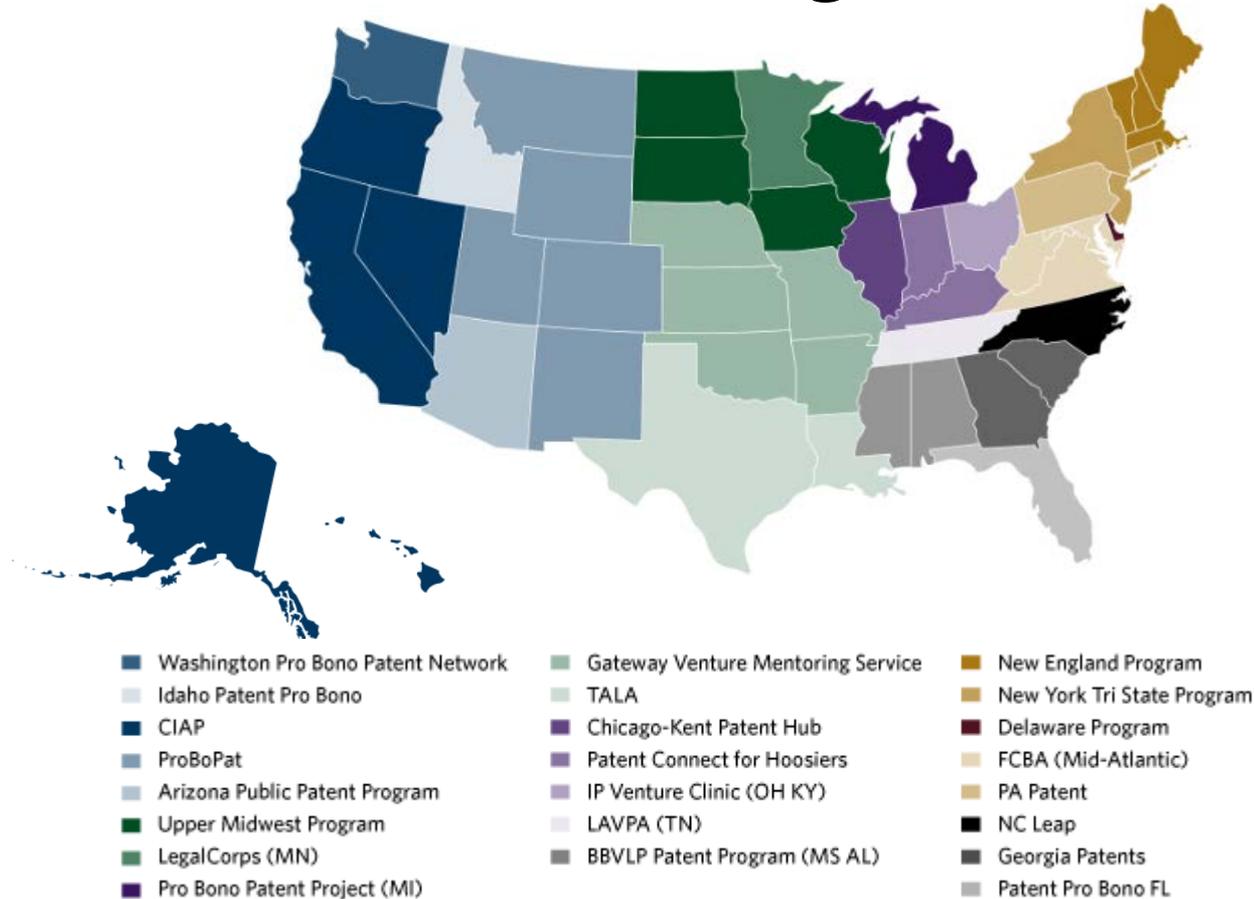


# Patent Pro Bono Program

- **Assists financially under-resourced independent inventors and small businesses.**
  - The America Invents Act calls on the USPTO to work with and support IP law associations to establish patent pro bono programs.
  - “pro bono” means that patent practitioners volunteer their legal services.
    - Pro bono applicants are still responsible for *all USPTO fees* and other potential non-USPTO fees, such as drawings drafted by a third party.
    - Entity status discounts regarding USPTO fees may be available
- **The Program is available in every state through 23 regional programs.**
- **Each regional program endeavors to match inventors and small businesses who apply with patent practitioners who volunteer to file and prosecute patent applications.**



# Patent Pro Bono Program Coverage



Email questions to:  
[inventorinfochat@uspto.gov](mailto:inventorinfochat@uspto.gov)



# Pro Bono Program Statistics

- **Since March of 2015:**
  - Over 5,600 persons have made inquiries;
  - Over 1,100 persons have been placed with a practitioner;
  - Over 1,500 practitioners are available to volunteer; and
  - Over 430 non-provisional patent applications have been filed.



# Patent Pro Bono Program

## Mission

- Increase accessibility to the patent system.
- Promote small business growth and development.
- Help ensure that no deserving invention lacks patent protection because of a lack of money to hire a practitioner.
- Enhance patent quality by have experienced patent professionals prepare, file, and prosecute applications.
- Provide opportunity for patent practitioners to serve in their area of expertise.

# Benefits of Representation

- **Pro se applicants (not represented by a patent practitioner):**
  - May have difficulty writing targeted claims;
  - May be unfamiliar with filing a patent application; and
  - May have difficulty responding to Office communications.
- **Patent practitioners are *registered* to practice before the USPTO. Practitioners:**
  - Have demonstrated knowledge of USPTO practice and procedure;
  - Possess the legal, scientific, and technical qualifications necessary to advise applicants;
  - Have knowledge and skill in preparing and filing patent applications; and
  - Have shown good moral character and reputation.

# General Criteria for Pro Bono Applicants

- **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 \$36,180 (<https://aspe.hhs.gov/poverty-guidelines>).
  - The limit increases with additional person(s).
- **Knowledge of the patent system.**
  - Have at least a provisional application on file with the USPTO *and/or* successfully complete the certificate training course at <http://www.uspto.gov/video/cbt/certpck/index.htm>.
- **Have an invention, not merely an idea.**
  - One should be able to describe the invention so that someone could make and use the invention.
- ***Pay all USPTO fees* (entity status discounts may be available).**



# Criteria for Pro Bono Applicants cont.

- **Even if a pro bono applicant qualifies financially, the regional programs may not be able to guarantee a match with a practitioner for a variety of reasons, among them:**
  - Change in financial status;
  - Invention not fully formed or developed;
  - Practitioner unwilling or unable to prosecute application; or
  - Lack of available practitioners.
- **Some regional programs have additional requirements.**
  - Pro bono applicants with an upcoming deadline may not be able to be served.
    - Many regional programs require the expiration date of the provisional patent application to be at least 3-6 months in the future in order to find a practitioner to work on the non-provisional patent application.
    - Sufficient time is required to match the applicant with a practitioner; and
    - The practitioner needs sufficient time to file a non-provisional application for the applicant.



# Matching with a Practitioner

- Assuming a pro bono application is accepted by the regional program, the program will provide its patent practitioners with a brief description of the applicant's invention.
- A practitioner may then volunteer to work with the pro bono applicant to file and/or prosecute a patent application for the invention.
  - *No guarantee* that a practitioner will choose to work with the pro bono applicant.
  - Reasons that practitioners may choose not to work with a pro bono applicant may include, but are not limited to:
    - The invention requires more development (not more than an idea);
    - Practitioner is not experienced in the technology; or
    - Applicant's invention/business conflicts with an existing or former client of the practitioner.
- **If no practitioner chooses to work with a pro bono applicant, then the regional program will inform the applicant that no match is available.**
  - Closure notification provides other resources that are available to continue pursuing a patent application (*i.e.* pro se assistance center, law school clinic program, etc.)
  - The pro bono applicants should follow up with the regional program periodically to verify the status of the application for pro bono assistance.

# Working with a Patent Practitioner

- **If matched, be an active participant in the patent application filing and prosecution!**
  - Be able to describe the invention, its inventive feature(s), and the problem solved;
  - Know the marketplace;
  - Be aware of similar inventions or solutions to the problem; and
  - Be responsive to the practitioner's requests.
- **The practitioner should provide an engagement letter or retainer agreement for the pro bono applicant to sign to:**
  - Inform the applicant of the scope of services provided, any ancillary fees, and the reasons that the practitioner may withdraw from the representation.
  - The scope of services provided may be limited to just a portion of the patent application process.
    - This is also called a limited engagement or "unbundled" services.
    - The patent application process has several stages including filing, response to USPTO Office actions/communications, and, if the patent is granted, the payment of periodic maintenance fees.
    - For example, a practitioner may help the applicant file the application, but may not agree to help the applicant with the other stages of the process.
  - Signing an engagement letter means that the applicant has agreed to its terms.
- **In addition to USPTO fees, applicants may need to pay for fees charged by a third party, such as the drafting of drawings.**
  - Applicants are responsible for USPTO fees and should not ask the practitioner to front or pay the USPTO fees.

# Applying to the Patent Pro Bono Program

Two ways to apply:

1. 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.
2. Apply through an online portal, the National Clearinghouse, operated by the Federal Circuit Bar Association.
  - <http://fedcirbar.org/Pro-Bono-Scholarships/PTO-Pro-Bono/National-Clearinghouse-Application-Submission>

E-mail [probono@uspto.gov](mailto:probono@uspto.gov) if you have any questions!

# Apply Directly to Program

The screenshot shows the top of the USPTO website. The header includes the USPTO logo, the text "UNITED STATES PATENT AND TRADEMARK OFFICE", and navigation links for "About Us", "Jobs", "Contact Us", and "MyUSPTO". A search bar with the text "Search uspto.gov" is also present. Below the header is a navigation menu with tabs for "Patents", "Trademarks", "IP Policy", and "Learning and Resources", along with a "Quick links" dropdown. A breadcrumb trail reads "Home / Patents: Getting Started / Using legal services / Pro Bono / Patent Pro Bono Program".

- Intellectual property legal assistance programs
- Patent pro bono program**
- Law school clinic program

## Patent Pro Bono Program

The Program provides free legal assistance to under-resourced inventors interested in securing patent protection for their inventions. Please select your state to find out more about the patent pro bono program that serves you.

- [Inventors](#)
- [Attorneys](#)
- [News & Events](#)

[What We Are Saying](#)

[What They Are Saying](#)

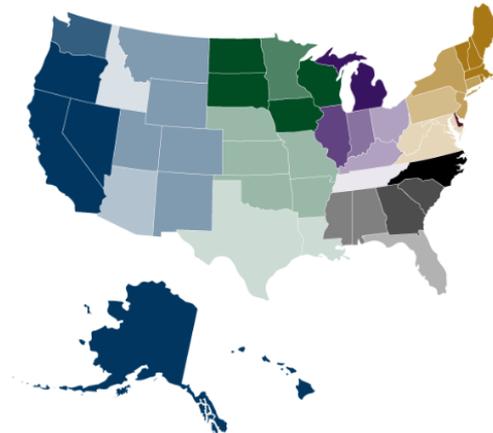
## Coverage of Patent Pro Bono Program

**Upcoming Events**  
**University of Texas Law School Advanced Patent Law Institute**  
Nov 2, 2017 07:30 AM CT  
Austin, TX

**SBDC Women's Small Business Conference**  
Nov 2, 2017 07:30 AM MT  
Loveland, CO

**Intellectual Property Basics and Midwest Regional Office Tour**  
Nov 2, 2017 12:00 PM ET  
Detroit, MI

[See the full events calendar](#)



Email questions to:  
[inventorinfochat@uspto.gov](mailto:inventorinfochat@uspto.gov)

[www.uspto.gov/probonopatents](http://www.uspto.gov/probonopatents)

# National Clearinghouse

Federal Circuit Bar Association  
BENCH&BAR® CONTACT JOIN FCBA RENEW EVENTS NEWS  
LOGIN

Enter Search Term

About FCBA Membership Publications Programs & Sponsorship Global Outreach Pro Bono & Scholarships

Pro Bono & Scholarships > PTO Pro Bono > National Clearinghouse Application Submission

## National Clearinghouse Application Submission

### Details

Pro bono service request form – all information provided will be held in strict confidence.

### Personal Information - First Inventor Only

First Name: \*

Middle Initial

Last Name: \*

Street Address1: \*

Street Address2

City: \*

<http://fedcirbar.org/Pro-Bono-Scholarships/PTO-Pro-Bono/National-Clearinghouse-Application-Submission>

Email questions to:  
inventorinfochat@uspto.gov





# Applying for a Patent Without Assistance from a Practitioner

- **The Pro Se Assistance Program offers various services for inventors filing on their own (also called “pro se”), including:**
  - Dedicated personnel for assisting people filing applications.
  - Walk-in assistance for the general public at USPTO Headquarters (by appointment).
  - A fully equipped public computer workstation for walk-in visitors at the USPTO.
  - Targeted support to connect applicants with relevant resources and information.
  - Call 1 (800) 786-9199 between 8:30 a.m. to 5 p.m., Monday-Friday, Eastern time.
- **The Inventors Assistance Center can answer general questions concerning patent examining policy and procedure**
  - Patent examining policy.
  - Necessary formats and items needed for your patent application.
  - Assist you with forms needed and with filling out the forms.
- **Review online resources found at [uspto.gov](https://www.uspto.gov).**



# Additional Information

- Comprehensive Information and Training Material for First Inventor to File:  
[http://www.uspto.gov/aia\\_implementation/patents.jsp#heading-10](http://www.uspto.gov/aia_implementation/patents.jsp#heading-10)
- Inventor Resources: <http://www.uspto.gov/inventors/index.jsp>
- IP Awareness Assessment Tool:  
<http://www.uspto.gov/inventors/assessment/index.html>
- Scam Prevention:  
[http://www.uspto.gov/inventors/scam\\_prevention/index.jsp](http://www.uspto.gov/inventors/scam_prevention/index.jsp)
- Pro Bono: <http://www.uspto.gov/patents-getting-started/using-legal-services/pro-bono/patent-pro-bono-program>
- Utility Patent Application Guide:  
<http://www.uspto.gov/patents/resources/types/utility.jsp>

# Upcoming OID Events

- January 18, 2018 – Inventor Info Chat– Overview of the Patent Examination Process
- August 17-18, 2018 - Invention-Con 18

For more information or to register for any of the above events contact us at [oidevents@uspto.gov](mailto:oidevents@uspto.gov)

<https://www.uspto.gov/patents-application-process/inventor-info-chat>





UNITED STATES  
PATENT AND TRADEMARK OFFICE

# Thank You!

Send your questions to:

[inventorinfochat@uspto.gov](mailto:inventorinfochat@uspto.gov)

To inquire about OID services please contact us at:

[InnovationDevelopment@uspto.gov](mailto:InnovationDevelopment@uspto.gov)

1.866.767.3848

Presented By:

James M. Silbermann and  
John Kirkpatrick



