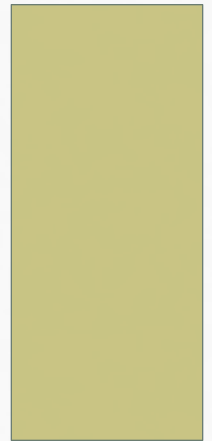




INVENTOR ASSISTANCE PROGRAM



Inventor Assistance Program (IAP): Minnesota Invention

What it is:

- Nation's 1st patent law pro bono program, developing with USPTO involvement
- Pilot program blazing trail for patent law pro bono efforts in other states

HOW the Inventor Assistance Program (IAP) Came to Be

- In 2010, **Director Kappos** told leading members of Minnesota's IP legal community of hopes of developing patent law pro bono programs across the nation ... they responded.
- They invited LegalCORPS to help them develop a pilot program in Minnesota.
- The project was co-founded by LegalCORPS and the law firms of **Patterson Thuentel IP, Lindquist & Vennum** and **Myer & Njus**.
- The program was launched in 2011 with the encouragement and involvement of the USPTO -- and with the support of a group of Minnesota corporations and law firms.

IAP Founding Funders

- 3M
- VALSPAR
- FAEGRE & BENSON
- MERCHANT & GOULD
- DORSEY
- SCHWEGMAN LUNDBERG & WOESSNER
- ECOLAB
- ROBINS KAPLAN
- FREDRIKSON & BYRON
- MUETING RAASCH & GEBHARDT
- BARNES & THORNBURG
- FULBRIGHT & JAWORSKI
- FISH & RICHARDSON
- SCHUMAKER & SIEFFERT

WHY Patent Law Pro Bono?

- Expand access to the patent law system to individuals with good ideas – but without financial resources for expensive legal services
- Overcome one financial roadblock to bringing new innovations to market – boost for economy
- Help USPTO reduce backlog, smooth process involving pro se patent applicants
- Provide patent attorneys opportunities for pro bono legal service in their unique area of the law
- Rule of Professional Conduct #6.1: Aspire to provide 50 hours pro bono per year



LegalCORPS: What it is & does

- Provides free assistance in transactional business law matters to low-income entrepreneurs and small nonprofits – through services of volunteer attorneys.
- Independent nonprofit incorporated in 2004 at the recommendation of an MSBA task force.
- Expands access to our legal system and provides business lawyers opportunities for public service in their areas of expertise.

Services the IAP Provides

Patent prosecution for non-provisional applications:

- Assistance with filing non-provisional patent application
- Assistance with responses to USPTO office actions
- (Applicants for assistance with filing provisional patent applications now are referred to the IP Law Clinic at William Mitchell College of Law)
- Eligible clients can get related business law assistance through LegalCORPS (e.g., entity formation, license agreements ...)
- **(Clients must pay all USPTO filing fees)**

Types of Assistance IAP Does NOT Provide

- prior art searching,
- patentability analysis, clearance or freedom to operate analysis,
- licensing, transfer, enforcement or disputes
- assistance with the prosecution of international patent applications that correspond to the application.

WHO Does the LegalCORPS IAP Serve ?

Inventors must:

- Have a strong connection to Minnesota.
- Have already filed a patent application with the USPTO.
- Meet income guidelines (300 % of the federal poverty level or below)
- Pass a subject matter screen by the program.

Progress of the IAP

Since fall, 24 applicants have been found eligible & referred for pro bono assistance:

- 1 patent issued after assistance in response to office action
- 8 now in patent prosecution process
- 8 referred to William Mitchell IP Clinic for help with provisional applications
- 2 in attorney recruitment stage
- 5 clients decided not to proceed

(At least 60 individuals have inquired about receiving assistance through the IAP)

Progress of the IAP

Since fall:

- 40 attorneys have joined the volunteer roster for the program
- 23 have attended program orientation sessions – now eligible for referral of pro bono matters through the IAP

VOLUNTEERING for the IAP

- LegalCORPS provides professional liability insurance for properly licensed attorneys on its volunteer roster for pro bono matters referred to them by LegalCORPS.
- Attorneys can register online with the volunteer form on www.legalcorps.org
- To get referrals of IAP clients, attorneys must attend a program orientation/training session

What Volunteers Commit to Doing

- Engagement letters outline the scope of representation for each matter
- The scope of representation does not include any other patent application(s)
- Volunteers use own docketing software -- LegalCORPS not docketing volunteers' cases
- The client should directly pay costs
- Attorney should advise client about costs in advance.
- Attorneys advise that when a patent issues, **the client will be responsible for enforcement & business development**

Nationwide Implementation Task Force

America Invents Act Mandate [35 USC, 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.
- (b) **EFFECTIVE DATE.** – This section shall take effect on the date of enactment of this Act.

Nationwide Implementation Task Force

- **Mission**

- Facilitate nationwide implementation of patent pro bono programs

- **Objectives**

- Monitor progress of Minnesota Patent Pro Bono Pilot
- Develop a representative model and best practices manual for launch of additional patent pro bono pilots
- Provide ongoing guidance to additional pilots
- Examine ways to create efficiencies for and among pilots
- Respond to requests from the USPTO
- Provide progress reports on nationwide implementation
- Disseminate information on importance of pro bono IP
- At request of USPTO Director, meet quarterly

Nationwide Implementation Task Force

- **Task Force Makeup**
 - **USPTO**
 - **John Calvert** – Administrator of the USPTO Inventor Assistance Center
 - **Judiciary**
 - **Chief Judge Randall Rader** – U.S. Court of Appeals for the Federal Circuit
 - **James Brookshire** – Executive Director, Federal Circuit Bar Association
 - **Minnesota Patent Pro Bono Pilot**
 - **Jim Patterson** – Managing Partner, Patterson Thuyente IP
 - **Candee Goodman** – Pro Bono Director, Lindquist & Vennum, PLLP
 - **National IP Community**
 - **ABA**
 - **Amy Salmela** – Patterson Thuyente IP, IPL Section Pro Bono Committee co-chair
 - **Paul Roberts** – Foley & Lardner
 - **AIPLA**
 - **Georgann Gruneback** – Fox Group
 - **Laura Zeman-Mullen** – Zeman-Mullen & Ford
 - **IPO**
 - **Kevin Rhodes** – Chief IP Counsel, 3M
 - **Harry Gwinnell** – Greenblum & Berstein
 - **Independent Inventor Community**
 - **Warren Tuttle** – President, United Inventors Association
 - **IP Academic Community**
 - **Jay Erstling** – William Mitchell College of Law

Nationwide Implementation Task Force

Rollout Timeline

- 4 new programs in 2012
 - California
 - Colorado
 - Texas
 - Washington D.C. area
- 10 new programs in 2013

CONCLUSION

- Minnesota's IP & pro bono legal communities are taking the lead in an important initiative to expand access to a part of our legal system that has had very limited pro bono activity
- More information: www.legalcorps.org