



American Intellectual Property Law Association

August 4, 2023

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via Online Submission: *Regulations.gov*

**Re: Comments of AIPLA on the Study of the Patent Pro Bono Programs 88 Fed.
Reg. 22012 (April 12, 2023) Docket No. PTO-C-2023-0009**

Dear Under Secretary Vidal:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views on the USPTO Study of the Patent Pro Bono Programs.

AIPLA is a national bar association of approximately 7,000 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

COMMENTS

AIPLA supports pro bono efforts by educating AIPLA members about patent pro bono opportunities and programs across the country and offering CLE webinars with the USPTO Office of Enrollment and Discipline on the Patent and PTAB Pro Bono Programs. We commend the Office for initiating the Study of the Patent Pro Bono Programs, and appreciate the opportunity to provide the following comments.

The Unleashing American Innovators Act of 2022 identified areas of interest for the Study of the Patent Pro Bono Programs to include, among other considerations, whether the programs may benefit by expanding participation to non-attorneys, including patent agents and patent paralegals. In support of the Study and to contribute valuable stakeholder input, AIPLA surveyed its Patent Agent Committee to obtain feedback from non-attorney members regarding the Patent Pro Bono Programs.

AIPLA survey respondents consisted of patent agents and attorneys spanning eleven of the twenty-one patent pro bono programs. The respondents answered questions about their familiarity with the national program, their willingness to participate, their awareness of their regional office, their thoughts on non-attorneys participating, and factors that deter or encourage non-attorneys to participate in the Patent Pro Bono Programs.

1. Survey Findings

Almost all of the responses that AIPLA received from its survey expressed the belief that the Patent Pro Bono Programs have improved access for inventors and small businesses to patent prosecution. However, a greater number of inventors and small businesses may be served by allowing patent agents and patent paralegals to participate.

2. Non-Attorney Participation

In general, the respondents of the survey shared a consensus that non-attorneys, such as patent agents, should be allowed to participate in the program. The respondents' reasoning was consistent: because patent agents can practice before the USPTO, they should be able to participate in the Patent Pro Bono Programs. Several respondents expressed the view that the USPTO implied patent agents are excluded from all pro bono work due to their exclusion from the USPTO's Pro Bono Program. The respondents, to a lesser degree, expressed a similar view about paralegal participation. A few respondents noted that paralegals would require supervision as they are not licensed to practice. Overall, respondents expressed the view that paralegals and other non-attorney professionals can contribute substantially to the program.

3. Participation Factors

According to the survey, the main factors that deter non-attorneys from participating seem to be workload, lack of encouragement or opportunity from their employer, and lack of information about the program. Factors that entice non-attorneys to participate include the opportunity to: gain experience; help the less fortunate; and contribute to good corporate citizenship. Survey results suggest that improving awareness and employer attitudes toward pro bono programs could increase participation. Though some law firms may not encourage employee pro bono participation, those that might be persuaded to are more likely to do so if the programs provide volunteer recognition providing the firm some tangential benefit.

The responses indicate that most respondents are familiar with the USPTO Patent Pro Bono Programs, and many are willing to participate. However, forty-two percent of respondents were not familiar with their regional office. This finding hints, despite awareness of the national program, lack of awareness among professionals may be a barrier to participation in regional pro bono programs.

Potential solutions to encourage employee engagement and create greater awareness of the Patent Pro Bono Programs are relatively low-cost. Regional offices can build stronger relationships with and promote themselves to state bar associations and law firms within their jurisdictions. For example, the Rocky Mountain USPTO, Mi Casa Resource Center, and the Colorado Bar Association IP Section established the ProBoPat program to help low-income inventors in Colorado, Montana, New Mexico, Utah, and Wyoming. For over a decade, the USPTO and Mi Casa Resource Center's partnership has recognized local patent practitioners

and law firms for patent law volunteerism on websites, and at celebratory events and IP conferences. Other regional office celebrations of inventors and patent professionals who successfully prosecute patents through the Patent Pro Bono Programs should be systematically shared across USPTO newsletters, social media profiles, and the website to increase participation by all patent practitioners.

AIPLA submits that allowing non-attorney professionals to volunteer in the Patent Pro Bono Programs and increasing awareness of regional offices and recognition of volunteer efforts can result in greater practitioner and inventor participation, without substantial expense.

CONCLUSION

The survey reflects the opinions of patent agents across the country. They are united in their desire to see the USPTO remove the restriction that the USPTO's Patent Pro Bono Program permits only attorneys to participate. Non-attorney professionals expressed a desire to help under-resourced inventors. This suggests participation in the pro bono program can be increased, and more inventors served.

AIPLA acknowledges the efforts by the USPTO to support the Patent Pro Bono Programs. These comments have been provided in the spirit of proposing changes in a way that is compatible with the needs of financially under-resourced inventors and small businesses and available and capable practitioners. Thank you for allowing AIPLA the opportunity to provide comments on the proposed Study of the Patent Pro Bono Programs.

Sincerely,

A handwritten signature in blue ink, appearing to read "B. Batzli".

Brian H. Batzli
President
American Intellectual Property Law Association