

PATENT LAW PRO BONO: A BEST PRACTICES HANDBOOK

AMY M. SALMELA[†] AND MARK R. PRIVRATSKY[‡]

[†] Amy M. Salmela is a partner with Patterson Thuent IP. Amy is a registered patent attorney and electrical engineer, and her practice focuses on patent prosecution, strategic intellectual property portfolio development and management, and related intellectual property matters. Amy serves on LegalCORP's Inventor Assistance Program committee, as well as the AIA Pro Bono Task Force, which guides the nationwide rollout of patent law pro bono programs.

[‡] Mark R. Privratsky is a partner with Lindquist & Vennum, PLLP, where he chairs the intellectual property practice group. Mark's practice focuses on patent, trade-secret, and related intellectual property litigation. Mark serves on LegalCORP's Inventor Assistance Program committee, as well as the AIA Pro Bono Task Force, which guides the nationwide rollout of patent law pro bono programs.

AUTHORS' NOTE

The success of the pilot patent pro bono program implemented in Minnesota could not have been achieved without the experience of LegalCORPS, a non-profit entity committed to expanding access to the legal system for clients who would otherwise be unable to afford business legal services. Special thanks are given to LegalCORPS and its Board of Directors.

The authors also wish to thank the following contributors for their invaluable assistance in developing this handbook as well as for their broader efforts in support of patent law pro bono and the Minnesota Pilot:

John Calvert
U.S. Patent &
Trademark Office

Dave Justmann
Smiths Medical

Kevin Rhodes
3M Innovative
Properties Company

Tracy Dann
Patterson Thuent IP

Neil Meyer
Meyer & Njus

Janet Schafer
LegalCORPS

Jay A. Erstling
William Mitchell
College of Law

James H. Patterson
Patterson Thuent IP

Andy Ubel
The Valspar
Corporation

Candee Goodman
Lindquist & Vennum
PLLP

Michael Vitt
LegalCORPS

This handbook was written with the goal of sharing best practices from the pilot patent pro bono program in Minnesota in order to assist with the creation and development of similar programs across the country. This nationwide effort is being supported by the America Invents Act Pro Bono Task Force, and the authors are grateful for the input from and acceptance of this handbook by the members of the Task Force.

America Invents Act Pro Bono Task Force

(As of August 2012)

John Calvert
U.S. Patent & Trademark Office

Randall R. Rader
U.S. Court of Appeals for the
Federal Circuit

James H. Patterson
Patterson Thuent IP

Candee Goodman
Lindquist & Vennum PLLP

Jay A. Erstling
William Mitchell College of Law

Georgann Grunebach
Fox Group

Kevin Rhodes
3M Innovative Properties Company

Paul A. Roberts
Foley & Lardner

Amy M. Salmela
Patterson Thuent IP

Warren Tuttle
United Inventors Association

Harry Gwinnell
Greenblum & Bernstein

James Brookshire
Federal Circuit Bar Association

Laura Zeman-Mullen
Zeman-Mullen & Ford

Mark R. Privratsky
Lindquist & Vennum PLLP

TABLE OF CONTENTS

Authors' Note.....	2
Table of Contents	4
Preface.....	6
I. Introduction	8
II. Getting Started.....	9
A. Structure and Organization	10
1. Leadership	10
2. Supporting Organization and Staffing.....	12
3. Law School Clinic Programs and Other Partners.....	17
B. Mission and Goals.....	17
1. Needs Assessment	17
2. Program Priorities and Goal Setting.....	18
3. Process Definition.....	18
C. Budget	19
D. Coordination with Other Organizations.....	20
E. Timeframe.....	20
F. Publicity	21
III. Providing Services	22
A. Delivery Approaches	22
B. Client Intake, Screening, and Referral.....	23
1. Finding Clients	24
2. Screening and Qualification Processes.....	25
3. Volunteer Attorney Matching.....	33
4. Coordination with Law School Clinic Programs.....	35
C. Volunteering	36
1. Recruitment	36
2. Orientation.....	37
3. Responsibilities.....	37
4. Fostering Private Practice and In-House Participation.....	38
D. Attorney-Client Relationship.....	39
1. Scope of Representation	39
2. Fee Responsibility	47
3. Withdrawal	50
4. File Closing.....	53
E. Example Case Study	55
F. External Services	57

- 1. Search, Drawings, and Other 57
- 2. Business Law Support 57
- IV. Tracking and Evaluation..... 58
 - A. Recordkeeping and Metrics 58
 - B. Ongoing Funding 60
- V. Lessons Learned from the Minnesota Pilot..... 62
- VI. Moving Forward 63
- VII. Conclusion..... 66
- Appendix A..... 67
- Appendix B 91

PREFACE

Remarks by Randall R. Rader
Chief Judge of the United States Court of Appeals for the Federal Circuit

In this era of global markets, innovation and invention are the keys to success. Products or services are not likely to play any significant role in the market without improvements on current offerings. Therefore, the modern currency that buys access to market opportunity is a patent. A patent is accepted worldwide as evidence of an improvement to devices or methods. Because a patent is such an essential market tool, basic fairness suggests that this currency ought to be available to inventors throughout all strata of the economy. The patent process should not be the sole province of corporate engineers. Human genius can emerge from the lowliest basement as well as the highest penthouse. With that in mind, the basement inventor needs access as well to the modern currency of the global market.

By its very nature, however, the acquisition of a patent requires special legal talents and abilities. No doubt drafting patent claims is the most challenging writing assignment in all of the law – requiring careful wording to define and avoid the past work in any technical field while also predicting the potential future of fast-moving technology. These legal skills, of course, require vast training and practice which, of course, comes at a price. That price can raise a difficult barrier for the basement inventor to compete for the currency of the modern market.

Thus, to address this basic demand for fairness and universal market opportunity, the America Invents Act foresees the need for a Pro Bono program to assist the basement inventor. For their dedication to both fairness and the patent system, the Pro Bono Task Force, LegalCORPS, and its Board of Directors deserve vast commendation for their dedication to these lofty ideals. A true measure of an attorney's dedication to the ideals of his or her profession is willingness to undertake pro bono representation. It is a duty and honor for attorneys to make top-notch legal services available everywhere. This handbook is a challenge to attorneys in the intellectual property field to step up and accept their responsibility as an officer of the court and a servant of the law. Pro bono representation helps the basement inventor to take a rightful place in the progress of science and technology. Indeed, in many ways, the United States has grown to prominence on the vision and entrepreneurial spirit of those inventors. Undoubtedly many patent prosecutors have already been providing pro bono patent services. This handbook envisions screening, referral, and case

management functions of an IAP to facilitate even more opportunity for inventors from all walks of life.

This superb handbook will prove invaluable to those structuring Patent Law Pro Bono programs and the generous attorneys that embark on this worthy endeavor. The global market with its global currency of innovation suggests as well that the pro bono responsibility is global. In the future, the U.S. public should benefit from advances in personalized medicine, or communications, or other technology advances from basement inventors around the world. This handbook sets in motion a great experiment in fairness and market opportunity.

I. INTRODUCTION

Attorneys may appreciate their clients, colleagues, and overall legal careers, but still find themselves seeking something more. To find additional fulfillment, many attorneys get involved in their communities and give back by providing pro bono legal services to clients in need. In the pro bono world, a transactional attorney is able to cover general corporate areas even if the specific issue faced by the pro bono client does not fall directly within the attorney's usual practice area. Likewise, litigators typically have various options for assisting pro bono clients by appearing in court, including for small claims, housing, harassment, immigration, or criminal defense, or by assisting within another dispute resolution proceeding. For in-house and private practice patent prosecution attorneys, however, representing clients in front of the United States Patent & Trademark Office (USPTO) on a daily basis likely has not prepared the attorney to fight a deportation order or defend an unlawful detainer. Offering services in a discipline in which one does not normally practice may be stressful and even create a potential for mistakes. A need therefore has existed for years for patent attorneys to be able to help low-income inventors in the area of patent prosecution.

The client side of the equation presents a compelling need as well. Inventors seek the fulfillment of their dreams of one day seeing their inventions for sale on the shelves of local retail establishments, or in today's world, the internet. These inventors understand that a significant step to protecting their innovation is to obtain a patent. When faced with the complex and sometimes expensive process that patent prosecution may be, however, low-income inventors realize that they must proceed pro se or not at all. Fortunately, many inventors apply the same resolve and determination they used to conceive their inventions and tackle the problem head-on. Unfortunately, the patent prosecution process is not necessarily suited for the novice, and the inventor may become frustrated and even jaded, notwithstanding the USPTO's ongoing efforts to make the process more accessible. These inventors fit the mold to be the perfect clients for the patent prosecution attorneys seeking to offer pro bono services in their respective fields.

The vision to meet these two needs began with David Kappos, the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. Director Kappos recognized the demand in the independent inventor community for pro bono assistance with prosecuting patent applications and reached out to Candee Goodman of Lindquist & Vennum PLLP and Jim Patterson of Patterson, Thuente, Christensen, Pedersen, P.A. Both are leaders within their respective Minneapolis, Minnesota law firms having demonstrated ties to both pro bono legal services and intellectual property law. In April 2010, Director Kappos, Goodman, Patterson, and John Calvert, then Administrator of the Inventor

Assistance Program (IAP), began discussing how to create a program to eliminate the financial hurdles that often prohibit independent inventors from patenting and bringing to market great ideas. Calvert, Goodman, Patterson, and several other USPTO and Minnesota colleagues worked tirelessly thereafter to make a pro bono patent law program a reality. The team from Minnesota formed various committees which worked toward securing funding, setting processes and procedures, recruiting volunteers, and generating nationwide buzz and support. A first of its kind program, the LegalCORPS Inventor Assistance Program launched in Minnesota on June 8, 2011. This "Minnesota Pilot" is an IAP that matches volunteer patent attorneys with inventors having already filed pro se patent applications for their inventions.

Pursuant to Section 32 of the America Invents Act (AIA), which took effect in September 2011,¹ the USPTO was directed to work with and support intellectual property law associations to establish pro bono programs across the nation. In accordance with this Congressional mandate and with Minnesota leading the way, the America Invents Act Pro Bono Task Force convened in October 2011 to coordinate nationwide efforts to develop similar programs in other areas of the country. As of the writing of this handbook, five more programs are slated to come online in 2012, eleven more in 2013, and complete regional coverage of the country is a goal by 2014.

II. GETTING STARTED

Director Kappos' vision was shared by the patent bar and, as is typical with regard to pro bono legal services, bar members rolled up their sleeves to make the vision a reality. Although the vision is national in scope, a pilot was initiated in Minnesota in light of the initial commitment by the individuals and firms mentioned above.

As the Minnesota Pilot was the first to become fully operational, this best practices handbook reflects the Minnesota experience with respect to the provision of patent law pro bono legal services as well as general pro bono principles. This handbook is nevertheless intended to provide guidance

¹ Leahy-Smith America Invents Act of 2011 § 32, Pub. L. No. 112-29, 125 Stat. 284.

Sec. 32 Pro Bono Program

(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 the enactment of this Act.

throughout the country regardless of the region in which subsequent programs are developed, and it is the goal of the AIA Pro Bono Task Force to expand the handbook to reflect the experiences of those other programs as they take shape. In other words, it is anticipated that certain region-specific features may be developed by other programs in the future, and that subsequent versions of this handbook will be issued.

A. *Structure and Organization*

While pro bono legal services can be, and are, provided by attorneys who independently form relationships with clients in need, the establishment of a structure to handle intake, screening, and referral is a fundamental requirement for any robust pro bono IAP. This requirement was set forth at the very beginning of the Minnesota Pilot by the leadership group that defined the organization, mission, and goals of the program.

1. *Leadership*

Leadership is important in setting up an IAP. Experience suggests that leadership should include individuals with experience not only in patent law but also in providing pro bono legal services. In addition, individuals with other professional experience, such as marketing and fundraising, can be extremely helpful in getting a program off the ground.

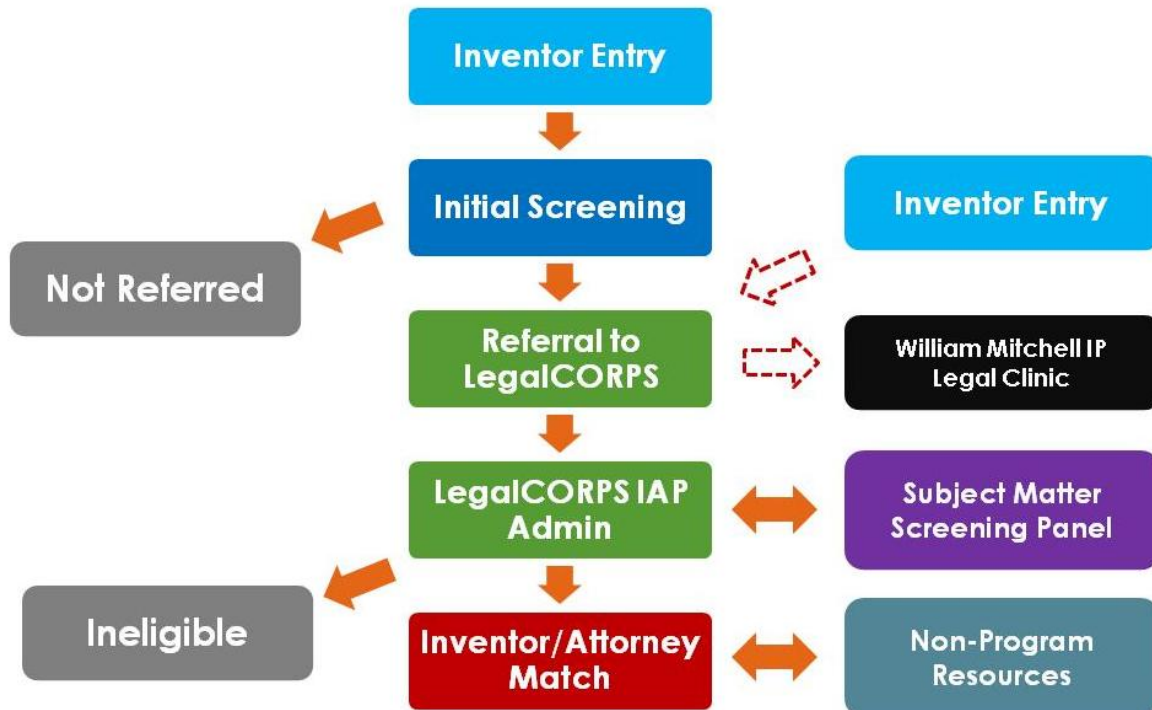
The Minnesota Pilot was conceived through the vision and drive of three Minneapolis law firms with the encouragement of the USPTO. Individuals from these firms created a Steering Committee. The Steering Committee was made up of a local intake, screening, and referral (ISR) legal services organization, and representatives from corporations, other law firms, and a local law school. The Steering Committee formed two subcommittees: a Process Committee and a Funding Committee.

The Process Committee's focus was to create procedures involving the following:

1. Inventor entry;
2. Initial screening;
3. Referral to ISR;
4. ISR administrator intake;
5. ISR volunteer identification and screening;
6. ISR client screening;

7. ISR referral;
8. Identification and development of forms; and
9. File closing procedures, including withdrawal.

An example flow chart for the Minnesota Pilot follows:



In the Minnesota Pilot, the Process Committee was composed of in-house IP counsel from local corporations, private practice IP counsel, and representatives from the ISR. The members had diverse backgrounds, including first-hand experience with prosecuting patents, marketing legal services, inventing, and providing pro bono legal services. In order to launch a complete program, it is important to involve individuals with experience in more than just patent prosecution, including experience in coordination, management, and marketing of pro bono programs. The work of the Process Committee is primarily front-loaded in the sense that its fundamental responsibility is to define and put in place a foundation for the everyday aspects of the IAP. Accordingly, committee members need to be cognizant that a significant time commitment will be required as the

program is set up. The Process Committee, however, may be dissolved once the program is operational, save for one or two individuals who desire to stay involved to assist with questions as necessary. Depending upon the goals of the ISR ultimately leading the program, the full Process Committee may plan for annual meetings where a comprehensive review of earlier implemented procedures is conducted and remain available on an ad hoc basis.

The Funding Committee's purpose is to plan and facilitate initial fundraising. Notwithstanding that the IAP provides free legal services, and that it is not responsible for out-of-pocket costs incurred by patent applicants, the IAP requires funding nonetheless. For example, as discussed in the next section, the backbone of the program is its administrator, responsible for overall monitoring of the day-to-day activities of the IAP. It is difficult, if not impossible, to find a volunteer for this position, and thus funding for it and related program expenses is a necessity.

Law firms and corporate citizens who base their businesses on intellectual property understand the importance of innovation to the successes of their home state and their country, and the Funding Committee focused its efforts on these entities. Coincidentally, these entities typically have foundations and community relations mechanisms in place. Many also employ patent attorneys who personally want to provide pro bono legal services but have historically been unable to do so within their areas of expertise. It is important for any Funding Committee to recognize that its funding targets may already be supporting other programs in the pro bono area. In addition, certain industries may disproportionately feel the impact of economic fluctuations. Thus, the success of the Funding Committee will be greater if its chairperson can lead by example because he or she leads an entity experiencing the same business challenges, yet is willing to be one of the initial funders.

2. Supporting Organization and Staffing

The supporting organization, or ISR, is central to success for any pro bono program, patent law-related or otherwise. The clients and volunteers are tasked with the actual acceptance and provision of legal services. For such a relationship to succeed, it must be supported by a "match-maker" (the ISR) that provides administrative and moral support.

For example, the Minnesota ISR, LegalCORPS, is a not-for-profit entity that had already acquired a track record of success providing free assistance in transactional business law matters to low-income entrepreneurs and small nonprofits through the services of volunteer attorneys. LegalCORPS, incorporated in 2004, is independent and was developed at the recommendation of a state bar association task force. Since its establishment, it has expanded access to the legal

system for clients who would otherwise be unable to afford business legal services and provided business attorneys with opportunities for public service in their areas of expertise by matching attorney with client. LegalCORPS was willing to expand the scope of its services, and patent prosecution seemed a natural fit.

Although the ISR was previously staffed with an executive director and an administrator who conducted the ISR for the business transactional services provided, patent law pro bono services present unique challenges. Subject matter conflicts, interaction with the USPTO, and multi-phase cases all benefit from having a dedicated administrator. As such, a dedicated half-time position was funded, allowing for the hiring of an IAP administrator. Following are the specific job requirements of the position:

Position Summary. Responsible for the day-to-day operation of the LegalCORPS Inventor Assistance Program. Supports all aspects of pro bono services offered to eligible clients seeking assistance with filing patent applications with the United States Patent & Trademark Office (USPTO). Manages and executes client application review, eligibility determination, placement, monitoring, and closure. Responsible for initial development of tools and systems necessary for efficient handling of duties listed below, as well as support for initial recruitment of volunteer patent attorneys, as well as other duties assigned by the LegalCORPS executive director.

- Essential Functions
 - Case Management
 - Conduct initial assessment of applications for eligibility and patent viability
 - Submit eligible applications to review panel for further assessment of patent viability, coordinate review panel assessment process, and communicate review process outcome to applicant.
 - Coordinate volunteer attorney assignments for accepted applications.
 - Open, manage, and close files for accepted matters.

- Monitor progress of open matters and provide assistance to volunteer attorneys as needed and if appropriate.
 - Keep accurate and timely records of all volunteer services, their progression, and ultimate results.
- Program Development
 - Coordinate recruitment of volunteer attorneys.
 - Assist with activities related to program funding.
 - Create and maintain database of volunteer attorneys that includes designation specific to patent law work, such as technology area expertise.
 - Develop volunteer attorney pro bono time recordkeeping system.
 - Develop and maintain database of clients and matters.
 - Work with review panel to develop initial assessment checklist.
 - Develop form letters and document templates for use in communicating with clients and attorneys, and as needed to support volunteer attorneys.
- Qualifications
 - Understanding of business and factors that can create successful or unsuccessful outcomes for new ventures.
 - Past experience with patents and patent law (optional).
 - Experience with implementing new programs and/or building systems and tools from the ground up.

- Ability to manage deadlines and hold others accountable to deadlines.
- Strong interpersonal and communications skills, including the ability to adapt to the needs of diverse clientele.
- Ability to use technology, such as Microsoft Office or other database software to create recordkeeping and reporting system.
- Must be detail-oriented, organized and have previous project management experience.

One of the optional qualifications suggested above is that the administrator has some past experiences with patents and patent law. This does not mean that the administrator must be an attorney formally trained in providing patent prosecution legal services. It very well may be that the best candidate for the job is a former patent attorney; however, the ISR should not limit its search only to such applicants. Best practice dictates that the administrator be able to understand some of the more common terms used in patent prosecution and be able to familiarize himself or herself with some of the basic processes that the volunteer attorneys may use to assist the pro bono clients. However, because a large part of the administrator's job will be working with attorneys and clients to complete and keep metrics of the intake and matchmaking process, a candidate with strengths in communication, organization, and the use of spreadsheets or similar database programs is a must. The best candidate therefore may be a paralegal or legal administrator who has experience with patent prosecution legal services.

As evidenced by the above, the position of administrator transcends many responsibilities and tasks. It should also be obvious that staffing the position should not be taken lightly. Because the ISR may have other areas in which it provides legal services, its executive director cannot simultaneously fill both the role of patent law pro bono administrator and manager of the ISR. The success of any program will be intimately tied to the IAP administrator.

a. Funders

As discussed above, funding for the Minnesota Pilot came from corporations highly invested in intellectual property as well as law firms that practice in the area of intellectual property law. So that no one entity felt like it was providing more than its fair share, the funders each provided a modest initial donation of \$5,000 and committed to make the same contribution in each of the following two years.

The Minnesota Pilot also considered funding sources such as grants or support from industry-based organizations. For example, inquiry was made of angel-type investors, private foundations, and trade group networks. While timing was a factor in the Minnesota Pilot, other programs should also consider those sources.

b. Volunteers

Patent prosecution attorneys have not traditionally had opportunities to provide pro bono legal services within their areas of expertise. Thus, there are few, if any, organized programs which match patent prosecution attorneys with inventors in need. Accordingly, to fulfill their commitment to pro bono work, patent prosecution attorneys have traditionally participated in non-intellectual property related legal clinics and pro bono programs providing services in other substantive areas. As a result, it can be expected that enthusiasm for an IAP will be high as it will provide these individuals the opportunities they have desired but lacked.

Volunteers for an IAP will include private patent law practitioners, both individuals and those from law firms who support pro bono work. Further, the pro bono program anticipates volunteers who are corporate attorneys who may or may not have to educate their employers before participation is endorsed, and law students who can participate in conjunction with a licensed attorney serving as a volunteer attorney, particularly those who practice as in-house patent counsel or through specialized law school clinic programs that are discussed later in this handbook. Patent agents also may have interest in volunteering but must be paired with an attorney, due to the nature of the counsel that clients of the program will require.

c. Clients

The American dream is often expressed by the example of the million dollar idea being conceived in the backyard garage of an independent thinker. Unfortunately, that dream may encounter obstacles that come in the form of complicated patent rules and processes put in place with the best intentions but unintended consequences. Inventors without the training necessary to navigate those rules and processes or the resources to obtain assistance from experienced professionals often find themselves proceeding pro se. This is frustrating for the inventors and often leads to a more time-consuming examination by patent examiners. Inventors unwilling or unable to proceed pro se may see their ideas remain unprotected and lost to the public domain. Society also loses out because of undeveloped innovation and missed economic opportunities. Ultimately, the clients that receive pro bono patent prosecution legal services may start companies, employ other people, and fulfill their American dream.

3. *Law School Clinic Programs and Other Partners*

Law school intellectual property law clinics are growing nationwide and provide an excellent resource for IAPs. Involving a clinic in an IAP not only allows volunteer attorneys to seek the assistance of law students, it also offers law students the opportunity to gain valuable prosecution skills while experiencing the rewards that come from pro bono practice. The USPTO's Law School Clinical Certification Pilot program allows law students in a participating law school's clinic program to practice intellectual property law before the USPTO under the guidance of a Law School Faculty Clinic Supervisor. The program is administered by the Office of Enrollment and Discipline, which grants the law students limited recognition to practice before the Office. Students gain experience drafting and filing patent applications for clients of the law school clinic and gain experience answering Office Actions and communicating with examiners for the applications they have filed. The William Mitchell College of Law Intellectual Property Law Clinic, one of the USPTO certified clinics, has been participating in the Minnesota Pilot since the program's inception. Its role is to serve as the repository for applications for assistance from inventors who do not qualify for the Minnesota Pilot.²

Experience has also shown that other patent-related service providers may have interest in partnering with an IAP. These potential partners include software providers, patent illustrators, and search firms, all of which may have valuable resources to contribute. All potential partnerships should be vetted carefully and managed by the IAP administrator.

B. Mission and Goals

The mission and most basic goal of any IAP is to provide pro bono legal assistance to qualified pro se applicants. Doing so allows outreach to the independent inventor community and creates an opportunity for members of the patent bar to experience meaningful pro bono service. The program also aims to reduce pro se applicant-generated USPTO backlog.

1. Needs Assessment

There are varying needs depending upon the perspective from which the program is assessed. Inventors with limited resources need assistance prosecuting their applications. Patent prosecution attorneys prefer to provide pro bono

² See U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/ip/boards/oed/practitioner/agents/law_school_pilot.jsp (last visited Aug. 31, 2012), for more information on the USPTO's Law School Clinical Certification Pilot Program.

services in their substantive areas. The USPTO operates most efficiently if engaged by professionals that understand its rules and procedures. Corporate citizens seek relationships with future counsel and employees who can contribute to the bottom line. The IAP is geared toward benefiting each participant regardless of the respective need that exists.

2. Program Priorities and Goal Setting

Certain IAPs will focus on promoting inventors in-state, while others may take a more regional approach. Regardless of the breadth of scope set for each individual IAP, some features must be present at a foundational level. For example, the Minnesota Pilot requires that the inventor have a strong connection to Minnesota and an income that does not exceed 300% of the federal poverty guidelines. This level of client income was chosen both out of altruism and concern with respect to impinging upon the work of private attorneys in the community. It provides realistic access to legal assistance in light of the fees due to the USPTO and related hard costs for which the client is responsible. In addition, the inventor must have already filed a patent application that meets USPTO subject matter requirements. Also, although in its infancy, the USPTO has begun to offer training modules for inventors to complete prior to participation in the IAP.

Based on the requirements to access the IAP, the program founders can better estimate the number of potential cases likely to be administered. With that information, the founders can structure other aspects of the IAP such as the number of volunteers needed. It should be kept in mind that the ultimate goal of an IAP may not be to obtain allowance of any particular patent application; instead, it may be to provide counsel to clients who otherwise would go without.

3. Process Definition

It is not uncommon for prosecution of a single patent application to bridge multiple years, and thus the IAP founders must have at the outset a clear definition of the scope of representation the IAP intends to offer. Although this scope must be specified in great detail in the attorney-client engagement letter, at a higher level it may be discussed with reference to patent prosecution milestones. For example, the Minnesota Pilot starts with the requirement that an application, whether provisional or non-provisional, already be on file at the USPTO. It typically ends with either allowance or a final rejection. Other IAPs could reduce the scope of process to the preparation and filing of provisional applications only. Yet another IAP could intend to assist a client on continuation, divisional, and even foreign counterpart applications. Because the resources required are directly

tied to the scope adopted by the IAP, it is imperative that when defining the process the overall picture be considered.

C. Budget

Budgetary constraints are a reality for any pro bono program, regardless of scope. Planning and then implementing the approved budget require diligence and monitoring. Funders expect that their contributions will be used to meet the goals for which they donated. Similarly, everyone wants to squeeze out of every dollar as much value as possible. When providing pro bono legal services, unexpected budgetary surprises must be minimized, if not eliminated.

The Minnesota Pilot, as an example, anticipated that it would require revenue to support an administrator, provide professional liability insurance for its volunteers, and cover rent, equipment, supplies, travel, and related expenses. Beyond that, the ISR adopting the IAP already had in place a structure to support its overhead, and the IAP was expected to create only a nominal increase. The half-time administrator's salary and benefits package required a budget entry of approximately \$45,000 in Minnesota. Obviously, depending upon the location and size of other programs, salaries and related overhead may be more or less.

As for liability insurance coverage, the Minnesota Pilot was fortunate to be led by an ISR that already had a policy specific to pro bono legal services. Nonetheless, due to the new services to be provided under the IAP, the ISR felt compelled to increase policy limits, which resulted in a slight increase of the ISR's premiums. The entire policy's annual premium was approximately \$3,900 and included coverage for attorneys' professional liability, management liability errors and omissions, employment practices, punitive damages, criminal defense, outside practice of law, and a primary pro bono endorsement. In total, the Minnesota Pilot anticipated an annual expense budget of \$55,000, and in its first year has found this to be reasonably accurate.

As previously mentioned, the primary funding sources of the IAP are corporate citizens and law firms with a focus on intellectual property. Other sources may exist in the form of bar associations, professional organizations, and law schools. Due to the often limited resources of these other groups, however, in-kind donations may be better realized from them. Granting agencies are another source of funding to consider. These sources typically have long lead times or specific annual deadlines, as well as other requirements that support their distinct missions. These limitations may or may not make grants feasible as initial funding sources, but could be considered in longer-term planning.

D. Coordination with Other Organizations

To achieve success, any IAP needs the support of more than just its founders, funders, volunteers, and clients. Likewise, the process and related startup committees alone are insufficient. Success requires strong relationships with professional membership organizations, such as local, regional, and national bar associations, in areas both including and outside of intellectual property (e.g., sections related to business law and emerging technologies). These other-organization relationships benefit the IAP because of the connections they create, which may lead to further funding, volunteer recruitment, and client referrals as well as to the infusion of new approaches and new ideas. These organizations also are a fertile source for new leadership to assist with the ongoing committee work that will be necessary to sustain the program's growth.

E. Timeframe

Starting an IAP cannot be done overnight. As discussed throughout this handbook, there are multiple facets to the IAP, including but not limited to creating processes and procedures, funding, staffing, and coordination. Although many attorneys, in their excitement about the potential of pro bono, will offer their services to get the program up and running, those attorneys have to be able to operate within a realistic time frame and organizational structure. A Steering Committee is therefore essential not only for setting a timeline but also for requiring accountability to its parameters, and, most importantly, being willing to step back and change the timeline as necessary.

Because various aspects of the IAP will no doubt occur at the same time - for example, obtaining funding while creating processes - the timeline need not (in fact, probably should not) be linear. The timeline also should be flexible, since nothing ever goes as quickly or smoothly as initially expected. In rough figures, it would not be surprising if initial fundraising endeavors would take six to nine months. Without a doubt, the fundraising process will be expedited once the ice is broken by one or two founding funders, but identifying and wooing those funders can take time. The preparation of procedures, in the same sense, requires one or two individuals to prepare a first draft, which can take six to nine months or more. Once these first hurdles are overcome, both funding and process drafting proceed at a more efficient pace.

Other aspects also require a patient and steadfast but forward-looking approach. Although there will be many volunteer attorneys who will seek to contribute their time, identifying them and proceeding with the orientation process may consume three to six months alone. Similarly, the launch of the IAP

cannot occur without the volunteer attorneys' counterparts: the inventors. Due to confidentiality concerns, personality types, income restrictions, and other factors, reaching and processing the intake of inventor clients will itself be more time-consuming than anticipated. Some of the founders of the Minnesota Pilot were surprised and somewhat frustrated that inventors did not come flocking to the program in its earliest days, but the few founders with experience providing pro bono legal services understood that many influences dictate the lives of clients in need of such services. As such, the IAP must be flexible, and the Steering Committee must realize that regardless of its best intentions of keeping its timelines, adjustments and new directions should be embraced because they will inevitably benefit the clients and the overall program.

F. Publicity

Publicity can help advance a new IAP at various stages of development. At the outset, it can raise awareness of the IAP and promote understanding of its mission among potential volunteers and funders. As the IAP gets underway, it is important to catch the attention of potential clients and give recognition to early supporters. Milestones such as the first patent or the IAP's one-year anniversary should be publicized to validate the program's sustainability to all constituents.

It is prudent to make publicity part of the initial plan. In the beginning, the Minnesota Pilot utilized publicity/promotion in the following ways:

- Media: Articles announcing the program in local and national publications, targeted toward business, IP-specific, and legal audiences. As the IAP progresses and grows, it will be important to recognize the volunteers and inventors and help promote the business generating potential of the IAP. It is important to identify spokespeople and someone to manage incoming media requests.
- Events: As the first IAP, the Minnesota Pilot was able to capitalize on the uniqueness of the USPTO's involvement. Director Kappos attended two events in Minneapolis that drew potential volunteers, both from corporations and law firms. The first event was to gauge the level of interest from the local patent bar. The second was to celebrate the launch of the IAP, recognize the founding committees and volunteers, and raise awareness among members of the bar.
- Speaking engagements: Members of the Minnesota Pilot Steering Committee spoke at local and national events. Those presentations not only served to promote the Minnesota Pilot, but also to increase enthusiasm in other states to support the plan for a nationwide rollout.

- Outreach to industry organizations: Organizations including the Minnesota Intellectual Property Law Association, Minnesota Inventors Congress, LifeScience Alley, and the Minnesota High Tech Association were supportive and helpful in spreading the word among their members. Steering Committee members attended industry events held by those organizations and met with key leaders. In the future, it is expected that organizations such as those will serve as client and volunteer referral sources, potential funders, and partners in ongoing publicity for the IAP.
- Website: It is important that the ISR have a section of its website dedicated to the IAP or at least that IAP information be easy to find.³
- Printed materials: The Minnesota Pilot created a simple tri-fold brochure that could be printed economically and then handed out at CLEs and other patent bar events. Another brochure was created specifically for potential clients.

Publicity is about outreach, and one key element of doing it well is to spend time building a solid contact list. Who are the leaders within corporate legal departments who could champion a sponsorship by their companies? Which law firms will want to be involved? Which media contacts will have an interest in pro bono services or entrepreneurship? Who are the leaders of the industry and entrepreneur/inventor associations in your area?

IAPs should be promoted on an ongoing basis to keep enthusiasm high and to ensure a steady stream of interested inventors, volunteers, and necessary funds.

III. PROVIDING SERVICES

It goes without saying that access to justice and provision of pro bono legal services to clients who would otherwise go without is the fundamental point of this entire endeavor. Therefore, it is essential that that point remain the focus of every step of the process. Different approaches to providing legal services, or even different legal services themselves, may be provided by different IAPs, and thought should be given to the approach which best suits each individual IAP.

A. *Delivery Approaches*

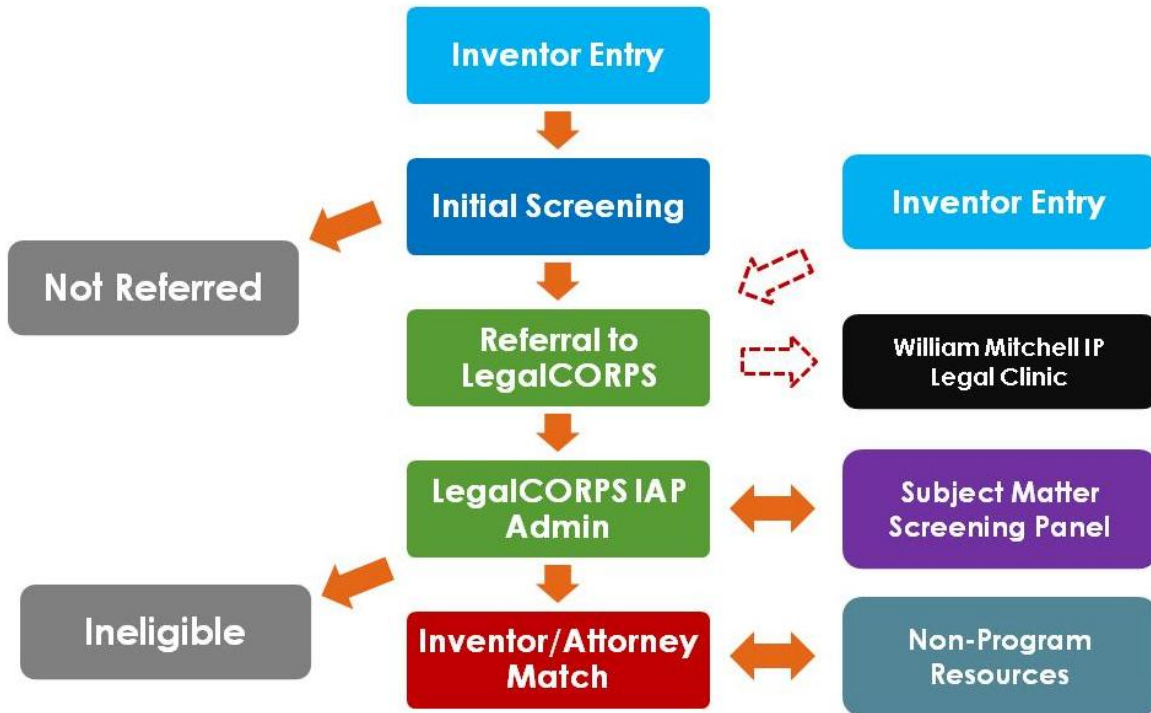
The scope of the representation will determine the delivery approaches for each IAP. For example, the Minnesota Pilot is a program organized around providing “unbundled” services. This means that the client does not receive legal

³ See LEGALCORPS, <http://www.legalcorps.org/inventors> (last visited Aug. 31, 2012), for more information on the Minnesota Pilot program.

services to meet every need. Instead, the representation is limited to the provision of patent prosecution services, which are further limited to a distinct phase or task. Each inventor in the Minnesota Pilot must have at a minimum filed a provisional patent application at the USPTO. From that starting point, the Minnesota Pilot either assists the inventor through at least the preparation and filing of a utility application, or prosecution of a utility application to allowance or final rejection. The Minnesota Pilot currently is not organized to provide after-final rejection services (e.g., appeal, RCE, continuation, etc.) unless volunteer attorneys express a specific interest in doing so. The IAP also does not expect the volunteer attorney to conduct prior art searching, patentability analysis, clearance or freedom to operate analysis, licensing, transfer, enforcement or disputes, or assist with prosecution of corresponding international patent applications. Notwithstanding those parameters, the Minnesota Pilot is designed to be flexible, so that if a volunteer attorney agrees to provide any of those other services (assuming the engagement letter so specifies or a new engagement letter is executed), the ISR will support the ongoing relationship. Other IAPs may choose to provide more or fewer patent-related legal services depending upon the resources available. In other words, the delivery approaches may vary across IAPs.

B. Client Intake, Screening, and Referral

It seems simple: if there are clients in need of legal services and attorneys willing to volunteer their time, a program should be able to build itself. Earlier attempts to set up IAPs, however, were not successful, and review of those attempts suggested that a key component to any successful IAP is a central administrative function, the ISR. Once that function is realized, one of the most important tasks of the ISR is the initial identification of clients, followed by intake, screening, and referral of those who qualify. Focus now shifts to execution of the IAP portion of the flowchart reproduced below.



1. Finding Clients

Finding clients for a pro bono legal services program may be more difficult than first thought. An IAP cannot simply hang a shingle and expect pro se inventors who have pending applications to come knocking. Accordingly, the Minnesota Pilot initially received assistance in finding clients from the USPTO. To date, the overriding characteristic required for a case to be considered by the Minnesota Pilot is that the inventor must have a Minnesota nexus. With this qualifier, the USPTO assisted in the identification of pending pro se applications, either published or unpublished. Cases within the unpublished category may be provisional or non-provisional applications. Initially it was anticipated that this process would yield approximately 70 cases a year. The USPTO notifies an inventor by letter that an IAP may be available in their area for assistance. No notice of the names or other information regarding the inventors or their patent applications is provided to the IAP; rather, the responsibility is on the inventor to contact the ISR. The ISR does not communicate with the pro se inventor until the

inventor has responded to the USPTO's notification by contacting the administrator at the ISR.

2. *Screening and Qualification Processes*

Once the inventor has reached out to the ISR, the administrator seeks additional information via intake forms to be completed by the inventor. The forms include an "Application for Free Legal Assistance" and an "Inventor Information Form," both of which permit the ISR to begin determining whether the inventor qualifies for the IAP. The application asks for contact information, information about race or ethnicity, household income, and related business interests; it also includes a statement ensuring that the applicant is aware and agrees that the ISR may disclose the applicant's information to potential volunteer attorneys. The Inventor Information Form seeks information about the underlying invention and related patent application and inquires about conception and ownership of the invention to ensure that the applicant is entitled to apply for a patent. The ISR also requires the inventor to deposit a nominal administrative fee of \$50.00, which is refundable if the case is ultimately not accepted into the IAP. Copies of the intake forms and a sample ineligibility letter follow.⁴

⁴ See *infra* Appendix A for complete copies of the forms and letters.



LegalCORPS
Inventor Assistance Program

**Application for Free
 Legal Assistance**

Note: If the business has multiple owners, each owner must complete a separate application. In addition to this financial information form, please submit the Inventor Information Form.

Name:

Spouse/domestic partner name:

Business name:

Street Address:

City:

State: Zip:

E-mail address:

Business phone:

Website address:

Daytime phone:

Evening phone:

About the business owner:

Race/Ethnicity (select one or more)

African/American American Indian Hispanic/Latino White/Caucasian

African/Other Asian/Pacific Islander Other

Gender: Male Female

Gross Monthly Household income \$

Household size Adults Children

What do you rely on as your PRIMARY source of Household income? (check only one)

Self-employed (full-time) Self-employed (part-time) Spouse/Partner Income

Full-time job Part-time job Savings/Investment Alimony/Child Support Disability

Public Assistance Unemployment Insurance Social Security Other

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

Application for LegalCORPS Inventor Assistance Program ... 2

About the business:

Business status: Start-up (not operating yet) Existing

(For existing businesses only) Year established _____ or acquired _____

Number of employees full-time _____ part-time _____

How many of these employees are family members? _____

How did you learn about LegalCORPS and the Inventor Assistance Program? _____

Your application must include a check for \$50.00, payable to LegalCORPS. This is a placement fee and will be refunded if LegalCORPS is unable to place your matter. Any legal services provided will be free of charge.

The information given here is correct and true to the best of my knowledge. I understand that LegalCORPS may verify financial information by reviewing documents I provide.

Signature: _____ Date: _____

Print name: _____

Send this form and any attachments to:

LegalCORPS Inventor Assist Program
600 Nicollet Mall, Suite 380
Minneapolis, MN 55402

LegalCORPS will use and disclose your information only to the extent necessary and appropriate. By submitting your application, you agree that we may disclose your information to others, including volunteer law firms and lawyers who will consider assisting you.


Before finally determining your eligibility for free legal services from LegalCORPS volunteers, we may ask you for further information (including your individual tax information) and might ask you to submit further financial statements.

For more information, please call 612-278-6348 or 1-888-454-5267, or email us at: inventorassist@legalcorps.org

LegalCORPS does not discriminate on the basis of race, color, religion, creed, national origin, disability, sexual orientation, or status with regard to public assistance.

In addition to this financial information form, please submit the Inventor Information Form.

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

	<p><i>LegalCORPS</i> <i><u>Inventor Assistance Program</u></i></p>	<p>Inventor Information Form</p>
<p>Full name:</p>		
<p>Residence:</p>		
<p>Title of invention:</p>		
<p>Category of invention (e.g. medical device for cardiac rhythm management, method of making food products, chemical composition for cleaning clothes):</p>		
<p>Person(s) who have helped conceive or build an embodiment of the invention (for example, helped with ideas, efforts, financial support, or another form of support):</p>		
<p>Person(s) or company(ies) who may own or have rights in the invention:</p>		
<p>Current employer, date hired, your position/title:</p>		
<p>Past employer(s) and dates(s) or employment within the past 3 years:</p>		
<p>Person(s) or company(ies) with whom you have entered into a confidentiality agreement, non-compete agreement, or other agreement that relates to the invention:</p>		
<p><i>For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402</i></p>		



Date

Dear:

Thank you for applying to the LegalCORPS Inventor Assistance Program. After review of your application, we have determined that you do not meet the income parameters of the program and therefore are not eligible to receive assistance. As we do not keep administrative fees unless a case is accepted, we are returning your application fee of \$50.

The following is a short list of additional resources that may be helpful as you proceed with patenting your invention:

- The United States Patent and Trademark Office website: www.uspto.gov contains a wealth of information for independent inventors. The USPTO also maintains a searchable list of registered patent attorneys and agents in Minnesota on its website.
- William Mitchell College of Law, a law school located in St. Paul, assists a limited number of inventor applicants each school year through its Intellectual Property Law Clinic. The clinic provides one-on-one consultation with a certified student attorney, under the supervision of a clinic attorney, and assistance in filing patent applications. For more information contact the Clinic Administrative Coordinator at (651) 290-6351 or jean.backes@wmitchell.edu.
- There are a large number of patent attorneys in Minnesota that may be able to assist you, particularly solo practitioners who may offer lower-cost services. They can be found through the Minnesota State Bar Association's referral service at: www.MNfindalawyer.com.

We extend our best wishes in your endeavor.

Regards,

Janet Schafer
Administrator
LegalCORPS Inventor Assistance Program
612-278-6348

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

The administrator uses this information to create a file, which has as its cover sheet an “Intake Form,” an example of which follows.⁵ The administrator continues to update this form throughout the life of the case.

⁵ *See also* Appendix A.



LegalCORPS
Inventor Assistance Program

Intake Form

Date: _____

Name: _____

Address: _____

Telephone: _____

Email: _____

Financial level: _____

Referral source: _____

Assistance needed: _____

Important dates: _____

Any communications from USPTO? _____

Have they used a patent attorney in the past: _____

Who: _____ Left because: _____

Referred to: _____

Follow up: _____

Volunteer Attorney assigned : _____

Administrative fee paid: _____

FORM	DATE SENT
Inventor contacts	
Inventor info	
Confidentiality agreement	
Acceptance and match letter	
Engagement letter	
Closing form	
Withdrawal letter	
Other	

The administrator may need to request additional information from the inventor to verify financial and other qualifications. For example, where the inventor's application has not yet been published, the inventor must provide a copy of his or her pending application in order for the ISR to proceed with further screening. In an effort to preserve confidentiality and protect the inventor's rights, the ISR presents the inventor with the following Non-Disclosure/Confidentiality Agreement. *See also* Appendix A.

6/2012



CONFIDENTIALITY AGREEMENT

Dated _____, 20 _____

This Agreement is made between:

Name of receiving party: _____ (“Recipient”); and

Name of Patent Applicant: _____ (“Applicant”).

The purpose of this Agreement is to allow Applicant to disclose to Recipient certain limited confidential information about Applicant's patent application in order to assist Recipient in determining whether Recipient may receive such confidential information as part of Recipient's volunteer work with the **LegalCORPS Inventor Assistance Program**. Recipient will, as more fully described below, use such confidential information for the purpose of assisting Applicant in connection with the **LegalCORPS Inventor Assistance Program**, including for purposes of determining whether Recipient (if the Recipient is an attorney) or other LegalCORPS volunteer attorney may undertake the legal representation of Applicant in connection with Applicant's patent application. **NOTWITHSTANDING ANYTHING TO THE CONTRARY HEREIN, THIS AGREEMENT DOES NOT CREATE AN ATTORNEY-CLIENT RELATIONSHIP BETWEEN RECIPIENT AND APPLICANT.** This Agreement will be effective as of the date first written above.

By signing below, and in consideration for Recipient's promise to maintain in confidence the information disclosed by Applicant pursuant to the terms and conditions set forth herein, Applicant hereby agrees to disclose all necessary or pertinent information about Applicant's U.S. patent application no. _____ (the “Patent Application”) for the purposes described above.

By signing below, and in consideration for Applicant's foregoing promise to disclose information about Patent Application, Recipient hereby (i) agrees to keep confidential all information disclosed by Applicant related to or concerning Patent Application, (ii) agrees not to disclose or make any use of such confidential information for any purpose other as set forth in the immediately preceding paragraph, and (iii) agrees that the foregoing obligations of confidentiality will remain in effect for a period of two (2) years from the effective date of this Agreement regardless of whether the Recipient undertakes any representation of Applicant or whether Applicant is assisted in any way by the **LegalCORPS Inventor Assistance Program**. Notwithstanding the foregoing, Recipient agrees that he/she will return or otherwise destroy all such confidential information promptly when Recipient has completed his/her investigation of the Patent Application for the purposes contemplated in this Agreement; provided, however, that Applicant may retain copies of such confidential information for solely archival purposes.

This Agreement may not be changed, modified, released, discharged, abandoned or otherwise amended, in whole or in part, except by an instrument in writing, signed by Recipient and Applicant. This Agreement constitutes the entire agreement regarding confidentiality between Recipient and Applicant, superseding any previous oral or written communications, representations, understandings or agreements between Recipient and Applicant. This Agreement shall be governed by the laws of the State of Minnesota.

APPLICANT:

Name: _____
Date: _____

RECIPIENT:

Name: _____
Date: _____

This document is executed by the ISR administrator as well as an attorney-based Screening Committee. The Screening Committee's purpose is two-fold: to confirm that a complete application exists and to determine that the invention disclosed in that application is of a type that corresponds to the substantive and technical expertise of a volunteer attorney in the IAP. The Minnesota Pilot Screening Committee includes one in-house attorney and two private practice attorneys with varying technical backgrounds. Each Screening Committee member carries out a conflicts check with respect to each application prior to reviewing the inventor's confidential information.

The purpose of the screening is to determine basic eligibility; therefore, a cursory review by the committee is all that is needed. The Screening Committee does not need to determine the merits of the case (although impending prosecution deadlines may be considered to determine whether sufficient time remains for a volunteer attorney to become familiar with the client and case, then prepare the documents necessary to meet the deadline), nor does it have to address questions with respect to inventorship, patentability, outstanding rejections, and related substantive eligibility. Upon approval by the Screening Committee, the administrator moves forward to identify a volunteer attorney.

3. Volunteer Attorney Matching

As discussed elsewhere in the handbook, when an attorney seeks to volunteer for the IAP, he or she completes a Volunteer Application with the ISR.⁶

The volunteer attorney indicates his or her preferred substantive area of practice (e.g., mechanical, electrical, chemical, etc.), which helps the ISR make the match. Accordingly, once the Screening Committee has instructed the administrator to move forward with the case, the ISR matches the inventor with a suitable volunteer attorney. The administrator contacts the volunteer attorney to gauge interest and availability and to provide the volunteer attorney the information necessary for the attorney to conduct a conflicts check. If the volunteer attorney is unable to accept the case, the administrator identifies another volunteer attorney and performs the same process. Once a volunteer attorney who is able to take the case is found, the administrator mails a notification letter to the client. A sample notification letter follows.⁷

⁶ The Minnesota Pilot Volunteer Application, for example, is available at <http://legalcorps.org/volunteers/how-to-become-a-volunteer/volunteer-form> (last visited Aug. 31, 2012).

⁷ See also Appendix A.



[Date]

[Address]

Dear [Name]:

Thank you for applying to the LegalCORPS Inventor Assistance Program. I am very happy to inform you that, after review of your application, we have determined that you meet the income and other parameters of the program and, therefore, are eligible to receive assistance.

Using your inventor information form, I have identified a volunteer attorney whose technical background makes [her/him] well suited for assisting you. This attorney has received your Invention Information form to run a preliminary conflict-of-interests check. If the attorney does not have a conflict [he/she] will contact you to set up an initial meeting.

The volunteer attorney selected is:

Contact at:

If this match does not work out for some reason, please feel free to contact me again so that I may search our database for another volunteer.

Regards,

Janet Schafer
Administrator
LegalCORPS Inventor Assistance Program
612-278-6348

*For more information, contact LegalCORPS at 612-278-6348,
inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

As with the contact required after the USPTO mails a letter to the inventor indicating the presence of an IAP in their area, the responsibility to establish contact between the volunteer attorney and the inventor lies with the inventor. The reason for inventor-initiated communication is so the inventor consciously claims ownership of the attorney-client relationship. See below for additional information regarding memorializing the scope of representation between the volunteer attorney and inventor/client in an engagement letter.

4. Coordination with Law School Clinic Programs

There are a number of cases in which potential applicants for an IAP will not meet the program's qualifications. With respect to the Minnesota Pilot, for example, an inventor may not yet have a patent application pending with the USPTO, or his or her application may be incomplete. An inventor may not qualify financially for the IAP or may otherwise not meet the characteristics common to someone who proceeds pro se. In any of these situations, the client may still desire and need legal services but, without some form of assistance, will be unable to retain them. The Minnesota Pilot has developed a partnership with William Mitchell College of Law (WMCL), which is one of the USPTO's Law School Clinical Certification Pilot programs previously mentioned above. This clinical program allows law students attending WMCL and participating in its intellectual property law clinic program to practice before the USPTO under the guidance of a Law School Faculty Clinic Supervisor. As a result, the Minnesota Pilot and WMCL are able to work together in several important ways: the Minnesota Pilot is able to refer cases that it believes are worthy but do not meet the Pilot's qualifications to WMCL, and law students are available to assist volunteer attorneys, especially those in corporations who may lack the support law firms provide. Given the benefits to both the IAP and the law school, establishing a partnership may be considered a priority wherever geography and the law school curriculum permit.⁸

If, after attention from the law school clinic program, a case becomes eligible for the Minnesota Pilot, the law school clinic may refer that case back to the ISR. For example, once a provisional application is filed, the eligible inventor may choose to seek assistance with the rest of the prosecution process from the ISR.

⁸ See U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/ip/boards/oed/practitioner/agents/law_school_pilot.jsp (last visited Aug. 31, 2012), for more information.

C. *Volunteering*

A patent prosecution pro bono legal services program is only as strong as its volunteers. The attorneys who are willing to provide free legal services must be both of high caliber and number. Only registered patent attorneys in good standing and with three or more years of experience are allowed to provide legal services to clients in the program. Unfortunately, due to insurance requirements, volunteers must be registered patent attorneys, so even though patent agents may practice in other contexts before the USPTO, they are not allowed to act alone in the IAP.

Each registered patent attorney is tasked, typically, with one case in the program, though more than one attorney may work on the same case. In other words, if an attorney prefers and the client consents, an in-house attorney may associate with a private practice attorney, or an attorney may associate with a law student participating in a law school clinical program, to act as a team on any one particular inventor's case. Depending upon its number of clients, the IAP may find itself in need of an exponential number of legal services providers. However the attorneys are later associated with one another, if at all, the first step in their volunteering is to be listed on the ISR's volunteer roster by filling out a form.⁹

As a volunteer in the IAP, an attorney is insured through a professional liability policy purchased by the ISR. In the Minnesota Pilot, for example, the policy provides a coverage limit of \$1 million. Technically, volunteer attorneys associated with private law firms are likely also covered by the professional liability policies of their employers. This is probably not the case for volunteer attorneys employed in-house at corporations. It is important to note that the Minnesota Pilot's ISR was able to obtain coverage because it provides pro bono legal services in areas other than patent prosecution. In other words, the pro bono insurance policy is of the same kind as general policies that an ISR not providing patent services would hold. The Minnesota Pilot further benefited by its membership in the National Legal Aid Defender Association (NLADA), a non-profit membership organization that devotes its resources to advocating equal access to justice for all Americans. Accordingly, a best practice may include the ISR's affiliation with NLADA, or another volunteer-attorney advocacy organization.

1. *Recruitment*

It is worth noting that although many attorneys who are seeking opportunities to provide pro bono legal services will find the ISR's web site and complete the

⁹ See *supra* note 6.

volunteer form on their own, the ISR may need to recruit attorneys. Recruitment involves approaching the founding funders for volunteers, asking for volunteers at presentations made to patent-related associations, and other advertising and word of mouth requests for volunteers. Volunteer recruitment is an ongoing responsibility of the ISR.

2. *Orientation*

Although much has been written on how to provide pro bono legal services as well as on how to prosecute a patent application, the two have not before been successfully wedded. Accordingly, the Minnesota Pilot prepared an orientation program which entails approximately two hours of in-class continuing legal education. Topics covered include the history of the ISR, the goals of pro bono, and the best practices to employ with respect to the attorney-client relationship. A third hour of education involves a discussion of ethical issues specific to the provision of patent prosecution services. The Minnesota Pilot also includes training expressly covering the differences that may exist between the provision of legal services to pro bono clients versus non-pro bono clients. The orientation is lead by two attorneys on the Screening Committee, the administrator from the ISR, and an ethics professional associated with the state Professional Responsibility Board.

Initially, the Minnesota Pilot's orientation was more exhaustive because it was the first in the nation and therefore new to every potential volunteer. As refinements have been made and familiarity with the program has increased, the orientation has been streamlined, which benefits both the ISR and the attorneys volunteering to take cases. A copy of the complete orientation slideshow offered by the Minnesota Pilot is included herewith.¹⁰ A volunteer attorney handbook that includes sample forms and documents, such as those included in Appendix A, as well as other resources and information is provided to each attorney at the orientation session.

3. *Responsibilities*

Not surprisingly, the primary responsibilities of a volunteer attorney are the provision of outstanding legal services to the client. The IAP does not look over the attorney's shoulder with respect to this aspect of the relationship. In fact, because of attorney-client confidentiality, the ISR cannot invade the relationship. The IAP does not provide legal advice to the attorney or the client. Once the match is made, it is solely the attorney's responsibility to provide legal advice, just as he or she would to a client in a non-pro bono relationship. At the same

¹⁰ See Appendix B.

time, however, the ISR exists to support the volunteer in any way the attorney may need. Best practices require a trusting relationship between the volunteer and the ISR, as one would expect exists in any pro bono legal services context.

More specifically, for example, an attorney must conduct his or her own conflicts check prior to taking on a new case. The process of searching for and reviewing conflicts is conducted solely by the attorney in accordance with the normal practice that the attorney uses for non-pro bono clients. This search must include subject matter conflicts. The ISR does not participate in the attorney's client-based or subject-based conflicts searches, nor does the ISR conduct an internal conflicts check of its own. Likewise, the attorney's usual methods of docketing, client communication, and file maintenance are the attorney's responsibility in the pro bono relationship. The ISR does not docket any part of any case in the IAP, nor does it keep a copy of the prosecution file or communicate with the client about case developments. It is extremely important for the attorney to embrace the pro bono client relationship in the exact same way that that attorney does his or her paying clients. But again, the ISR exists not only to match clients with attorneys but also to support the attorneys, however needed, at their request.

4. Fostering Private Practice and In-House Participation

There are obvious benefits to engaging the entire bar in the IAP. For example, the pool of volunteer attorneys is that much greater if both private practice and in-house attorneys have the opportunity to participate. In addition, the employers of volunteer attorneys that are able to provide in-kind support may be more willing to also contribute financially. Fostering participation by all attorneys, whether private practice or in-house, will make the IAP stronger in the long run.

However, there are fundamental differences in the provision of services depending upon whether the volunteer attorney is employed in their everyday practice by a corporation or by a law firm. These differences require the IAP, in some instances, to have different processes in place. For example, an in-house attorney's employer may not allow docketing of cases not owned by that employer. The employer likely does not want its employee-attorneys practicing law in a subject matter area that conflicts with the corporation's business. The corporation also may have a responsibility to others to be a good steward of its limited resources, which translates into a prohibition on the use of company systems for non-company endeavors. Similarly, the corporation must be sensitive to issues involving business or industry conflicts. There are also significant issues involving insurance coverage that exist for an in-house volunteer and his or her employer because such companies may be self-insured or otherwise have

coverage which is restricted to work performed only in the interests of the company.

These concerns may also exist in a law firm or solo practitioner office, but to a lesser degree. Nevertheless, it is possible for attorneys, wherever employed, to overcome the hurdles presented by their day-to-day practices, and the ISR should be a resource to provide the necessary tools and support. Best practices require a deliberate consideration of the needs presented by the differences between private practice and in-house practice of law. See additional information specific to engagement, docketing, and fee handling below.

D. Attorney-Client Relationship

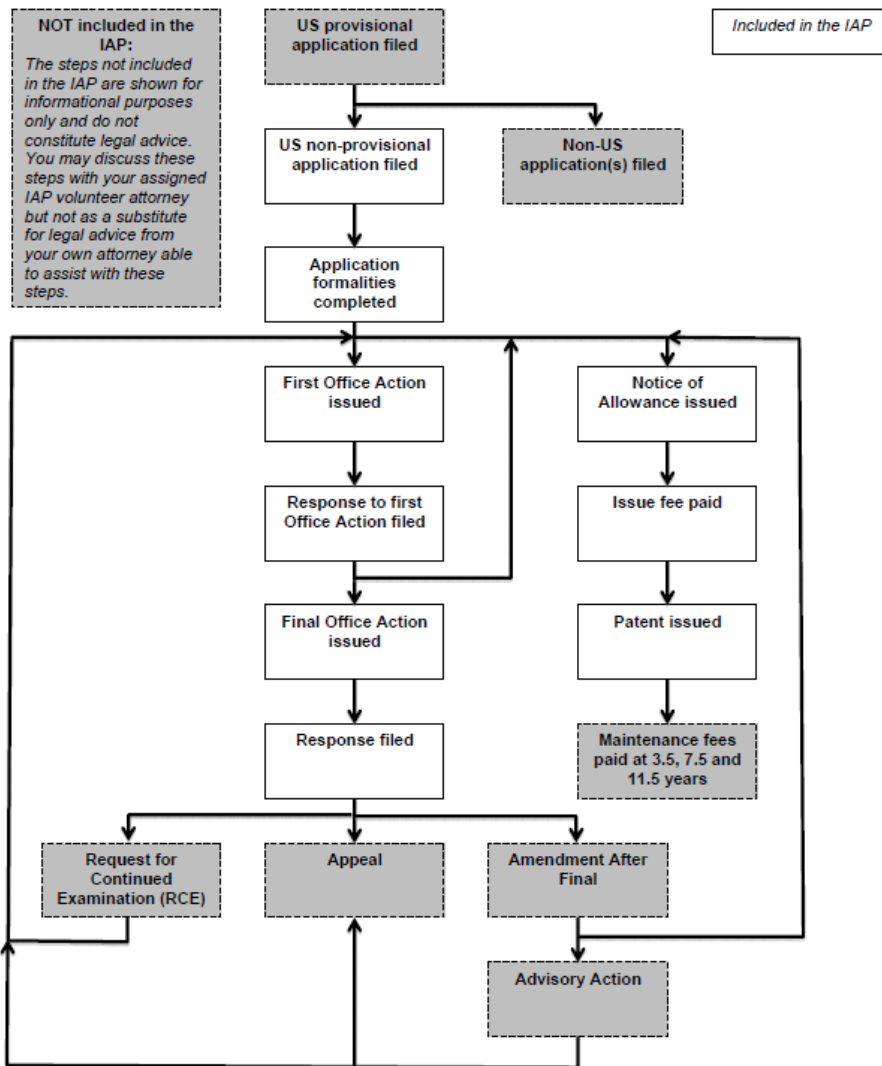
As with paid attorney-client relationships, both the client and the volunteer attorney agree in the pro bono relationship to actively participate and put forth all reasonable efforts to prosecute the application. The most important rule to abide by is that the attorney should not make decisions for the client. The pro bono aspect of the relationship may cause following this rule to be more difficult than first expected. Clients, for example, may be less sophisticated in the purchasing of legal services, as well as possibly skeptical of attorneys or the government in general and unfamiliar with the rules and procedures of USPTO. The secret to a successful attorney-client relationship is clear communication that sets appropriate client expectations from day one of the relationship. As one would expect, the engagement letter is a critical tool in these communications.

1. Scope of Representation

The scope of representation is set by the engagement letter. Depending upon the services bundled in the IAP as well as the particular agreement between a client and attorney, the engagement letter should specify the legal services that are going to be provided. In the Minnesota Pilot, the client does not receive legal services to meet every need he or she may have. Instead, the IAP assists the inventor through at least the filing of a non-provisional application or prosecution of a non-provisional application to allowance or final rejection. Unless a new engagement letter is executed, the Minnesota Pilot is not currently organized to provide after-final rejection services (e.g., appeal, RCE, continuation, etc.). Although the engagement letter governs the scope of representation, a volunteer attorney may use the following flowchart to assist in discussing that scope of representation with his or her client and the limitations thereon in conjunction with the steps of a basic U.S. patent prosecution.¹¹

¹¹ A copy of the flowchart is also included in Appendix A.

Basic US Patent Prosecution



The IAP also does not expect, but also does not expressly prohibit, the volunteer attorney to conduct prior art searching, patentability analysis, clearance or freedom to operate analysis, licensing, assignments, enforcement or disputes,

or assist with prosecution of international patent applications that correspond to the application.

A complete copy of the Minnesota Pilot engagement letter as of May 2012 follows.¹² In addition, a copy of the form of the engagement letter that may be used when a law school clinic program student assists the volunteer in the representation is included in Appendix A.

¹² See also Appendix A.



LegalCORPS
Investor Assistance Program

**Engagement Letter
Template**

(Date)

(Name)

(Address)

Re: LegalCORPS Inventor Assistance Program Engagement Letter

Dear (Client):

This letter confirms representation of you (“Client”) by the undersigned volunteer attorney (“Volunteer”) in connection with the intellectual property matter defined and on the terms set forth below.

We believe it is important to our mutual success that we explain, in writing, the responsibilities and expectations of both parties to the attorney-client relationship. This letter is the agreement that sets forth the terms of our relationship. Please examine this agreement carefully and let us know immediately if you have any questions or concerns. No work will be performed and no attorney-client relationship is established until this agreement has been signed and returned.

1. Project & Scope

LegalCORPS will assist in arranging for Volunteer to agree to assist you with prosecution of U.S. Patent Application No. _____ (“Application”) before the U.S. Patent & Trademark Office (USPTO) (“Representation”).

The ability of Volunteer to undertake the Representation will depend upon Volunteer conducting a conflict check with respect to Volunteer’s existing clients and matters. Client agrees to provide sufficient information regarding the Application, such as the title and an abstract, synopsis or other summary, to enable Volunteer to conduct a conflict check if such a check has not already been conducted. Volunteer agrees to keep the information confidential, consistent with an attorney’s duty of confidentiality.

A. Provisional U.S. Applications

If the Application is a pending provisional U.S. patent application, the Representation includes filing a non-provisional U.S. patent application claiming priority to the provisional application, or converting the Application to a non-provisional U.S. patent application. The Representation may be extended to include prosecution of the non-

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

provisional U.S. patent application in accordance with paragraph 1(B) below only if mutually agreed upon by Client and Volunteer.

B. Non-Provisional U.S. Applications

If the Application is a pending non-provisional U.S. patent application, the Representation includes prosecution until a Final Office Action is received or the Application issues as a patent, whichever occurs first. Any Representation beyond these events must be mutually agreed upon by Client and Volunteer and requires a new engagement letter be signed by the parties.

If the Application issues as a patent, Client will be responsible for docketing and making any maintenance fee payments by the appropriate deadline. No assistance with maintenance fee matters is included in the scope of Representation.

C. Other Applications and Tasks Are Not Included

The scope of Representation is limited to that identified above and does not include any other patent application(s), whether pending or merely contemplated, related to the Application or unrelated, and/or U.S. or foreign. Assistance with prior art searching, patentability analysis, clearance or freedom-to-operate studies, non-infringement analyses, marketing, business development, licensing, transfer, enforcement or disputes with respect to the invention or any patent rights resulting from the Application, and other tasks are also not included in the scope of Representation.

Foreign patent applications, whether pending or merely contemplated, formally related to the Application or not, also are not included in the scope of Representation. Foreign patent rights related to the invention of the Application may already be unavailable or may be lost depending upon any public disclosure of the invention of the Application and/or whether more than one year has passed since the earliest priority date of the Application. Client should seek counsel from Volunteer if foreign patent rights may be desired, though assistance with any foreign applications is outside the scope of Representation unless otherwise agreed upon in writing by both Client and Volunteer.

The scope of the Representation may be changed, however, at any time by mutual written consent of Client and Volunteer, though Volunteer may withdraw as indicated in paragraph 5 below.

2. Fees, Costs, & Disbursements

Volunteer will provide the services during the Representation free of charge. Client, however, shall pay directly to the USPTO, patent search services, drafting services and/or other providers all costs or expenses incurred by Client. Such expenses may include draftsperson charges, government and recording fees, computerized research charges, patent search charges, copying costs, and postage. Client will be advised of costs in

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

advance. Client will be required to make all such payments directly, such as by credit card or check made payable to the payee, without placing any funds in Volunteer's possession and with any funds sent and payable to Volunteer promptly returned. Client will be informed of any exceptions to this requirement, if available, after Volunteer has been specifically identified. Any exception must be in writing and signed by both parties.

Volunteer reserves the right to discontinue all legal services and terminate Representation if costs are not paid in a timely manner. Volunteer will not, however, discontinue service without giving notice of such intention.

3. Mutual Communications

Volunteer and Client acknowledge that considerable time and effort by each is required in order to successfully obtain a patent. The submission of a patent application is just the start of the process, and both Client and Volunteer agree to actively participate and put forth effort toward obtaining a patent. Delays in Client response time to Volunteer requests for information or assistance can necessitate payment of additional USPTO extension fees, the payment of which will be the sole responsibility of Client.

Volunteer will promptly comply with Client's reasonable requests for information regarding the status of the Representation. Volunteer shall consult with Client and shall abide by Client's decision with respect to the objectives of the Representation, subject to Volunteer's ethical and legal obligations and professional judgment.

Client will cooperate with Volunteer in order to be effectively and efficiently served by Volunteer during the course of the Representation. Client agrees to provide Volunteer with any information or documents reasonably necessary or useful for this Representation, including any change in Client's contacts, address or telephone numbers and any significant change in Client's financial or business condition. Client also will provide Volunteer with any information or documents which may be related to compliance with the duty of disclosure and/or the duty of candor and good faith when practicing before the USPTO. Insufficient Client effort will be adequate cause for attorney withdrawal.

4. Sufficient Connection to Minnesota & Financial Eligibility

Client has been accepted by LegalCORPS using certain connection to Minnesota and financial eligibility criteria. Client certifies that the connection to Minnesota and financial information supplied by it to LegalCORPS or Volunteer is complete and correct. Volunteer may withdraw Representation if that connection to Minnesota or financial information is not complete or direct or if Client's condition changes such that Client no longer has a sufficient connection to Minnesota or would be able to pay for the Representation.

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

In addition, Volunteer is free to apply Volunteer's own financial eligibility criteria and may withdraw from the Representation or discontinue delivery of services at any time based on its application of Volunteer's own financial eligibility criteria. Further, if Client obtains a licensee to or sells the Application or any other patent or application, Client must immediately inform LegalCORPS of such, along with the terms of the license agreement and/or sale.

5. Withdrawal or Termination of Representation

Pursuant to the Rules of Professional Conduct applicable to Volunteer's practice, Volunteer may withdraw from the Representation after taking reasonable steps to avoid prejudice to the Client. Volunteer may withdraw if, in its judgment, the Client is not cooperating with Volunteer, if the Client insists that Volunteer engage in conduct that is contrary to the judgment or advice of Volunteer or is contrary to law or rule, if the Client does not comply with the terms set forth in this letter, or for any other good reason. Volunteer may also withdraw because of the occurrence of an event ending Representation as specified in paragraph 1. Client will be notified of Volunteer's withdrawal in writing.

Volunteer and/or LegalCORPS may assist Client in finding new counsel, at their discretion.

6. Role of LegalCORPS

LegalCORPS is a referral service, not a law firm. Client acknowledges that while LegalCORPS, a Minnesota nonprofit corporation, has assisted in arranging the Representation, LegalCORPS has no responsibility for the performance of the Representation. Client waives any and all claims against LegalCORPS.

7. Sharing of Information

Volunteer is authorized by Client to report to LegalCORPS concerning the Representation so that LegalCORPS will be able to keep information concerning its program and use information about the Representation to help assist other clients. Client authorizes the use by Volunteer and LegalCORPS of the documents drafted during the course of the Representation for use in assisting other clients, organizations or individuals that request assistance from LegalCORPS. However, Client may direct Volunteer to delete information in documents that Client deems confidential.

Please contact Janet Schafer at LegalCORPS at: 612-278-6348 if you have any problems or questions.

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

AGREEMENT AND ACCEPTANCE: The undersigned [Client]/[representative of Client] hereby agrees to the above terms and conditions.

Dated: _____
[Client's name if an entity]

[Client's name if an individual] [Name of Officer]
Its _____

The undersigned Volunteer hereby agrees to the above terms and conditions.

Dated: _____

[Volunteer Name]

For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402

As in any attorney-client relationship, unexpected events sometimes arise which may inevitably cause the scope of representation to change. One such event could be that after initial consultation, the attorney realizes that the inventor's specified needs are misplaced or that the earlier anticipated next steps are not warranted. Another cause for change may be that the attorney learns of additional facts, which had they been known prior to engagement would have prevented the relationship due to conflict. Whatever the reason, changing, updating, or terminating the scope of representation must be done as soon as practical in order to respect the rights of the inventor and keep a strong line of communication open. Such a change must be reported to the ISR immediately. The ISR must at all times have on file a copy of the current engagement letter that sets forth the correct scope of representation. Obviously, if the attorney must withdraw after the relationship is commenced, termination as contemplated by the engagement letter (including documenting the withdrawal with the USPTO, as discussed below) is a requirement.

2. *Fee Responsibility*

While the volunteer attorney will provide his or her services free of charge during the representation, the client must bear responsibility for paying directly to the USPTO or other vendor fees for patent search services, drafting services or any other costs or expenses related to the representation. These expenses may include draftsperson charges, government and recording fees, computerized research charges, patent search charges, copying costs, and postage. Best practices require that the client be advised of costs in advance. The client may be required to make all such payments directly, such as by credit card or check made payable to the payee (e.g., the USPTO), without placing any funds in the volunteer attorney's possession and with any funds sent and payable to the volunteer attorney promptly returned to avoid any appearance of impropriety.

As mentioned above, the issue of fees, costs, and disbursements may be impacted by the differences between in-house and private practice volunteer attorneys. Although a private practice volunteer attorney is set up to hold funds in trust or pay through his or her deposit account, an in-house attorney likely does not have those options. If an in-house attorney is working a case alone, best practice dictates that no funds be received by the attorney from the client to hold in trust. The client must either provide a credit card charge authorization prior to the transaction or a check payable directly to the USPTO. A sample credit card charge authorization form follows.¹³ Because the USPTO has, over the years, increased the efficiency of prosecution via the use of deposit accounts and credit

¹³ See also Appendix A.

cards and now encourages the use of electronic filing by charging an extra fee for non-electronic filings, in-house volunteer attorneys may find it easier to associate with a private practice attorney or a law student practicing under the auspices of a law school clinic (if available) so the client may also take advantage of these conveniences.

CREDIT CARD CHARGE AUTHORIZATION

*****All information must be provided to process the charge.*****

Cardholder Name (as it appears on the credit card)

Credit Card Billing Address

_____, _____
City State Zip Code

Type of Credit Card (check one): Visa MasterCard Other _____

Account Number

Expiration Date (MM/YY)

3 Digit V Number
(On Back of Card)

I authorize _____ to charge US\$ _____

to my credit card indicated above for the following purpose: _____

Signature of Cardholder

Date

Volunteer attorneys also should take special care with respect to the use of USPTO deadline extensions. While use of extensions may be commonplace in the attorney's regular practice, they may be misunderstood by pro bono clients (e.g., interpreted as the volunteer attorney prioritizing their case below those of paying clients) and require fees pro bono clients are unwilling or unable to pay. Therefore, best practice is general avoidance of extension taking, if possible, or clear communication with the client if an extension is unavoidable (e.g., the client has failed to communicate in a timely manner such that filing a particular document is inevitably delayed), particularly with respect to who is responsible for the necessary fee.

3. *Withdrawal*

Situations may arise that require the volunteer attorney to withdraw from the representation of the client. The attorney may develop a conflict, for example, or the client may become non-responsive or otherwise uncooperative, leaving the attorney no choice but to terminate the representation. Whatever the reason, if withdrawal is necessary, the process must be conducted with the same professionalism as was offered throughout the representation. The primary goal is the protection of the interests of the client. This means that, notwithstanding the reason necessitating the withdrawal, volunteers must not remove themselves from a file if there is a reply due in the patent application. Each situation must be handled in light of the circumstances presented as well as the relevant rules of professional conduct governing the attorney's actions and in a manner that ensures that the client's interests are protected.

More particularly, the attorney may refer the client back to the ISR if the inventor has unrealistic expectations; a conflict becomes apparent; the client is nonresponsive, uncooperative or does not pay necessary fees or costs; the attorney is generally uncomfortable with the relationship; or the client is no longer financially eligible (e.g., if the technology is licensed or the application is sold). In any of these scenarios, the first step in the process of withdrawal is for the attorney to bring the issues to the attention of the ISR administrator. It is imperative that the ISR be involved in all matters where withdrawal is being considered, because in certain situations the ISR may assign a different volunteer attorney to the client's matter. Even if another attorney is not to be assigned, the ISR, as the matchmaker, must be made aware that the attorney-client relationship it facilitated will be coming to an end.

Assuming withdrawal is the correct decision, the attorney should utilize the USPTO's web-based ePetition for withdrawal of patent attorney or agent. The

USPTO's PDF form (PTO/SB/83) is not required. The withdrawal process is governed by 37 CFR § 1.36(b), which provides, in pertinent part:

A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Board of Patent Appeals and Interferences.

For more information about withdrawal generally, please refer to the USPTO's website at www.uspto.gov.

Although the regulation provides that the applicant or patent owner will be notified of the withdrawal, it should be the responsibility of the attorney and the ISR to communicate, or at least attempt to communicate, with the client regarding the termination of their relationship. Following is a template letter which may be used to initiate such communications.¹⁴

¹⁴ See also Appendix A.



LegalCORPS
Inventor Assistance Program

**Withdrawal Letter
Template**

(Date)

(Name)

(Address)

Re: LegalCORPS Inventor Assistance Program Withdrawal Letter

USPTO Serial No.

Dear (Client):

This letter is to give you written notice of my withdrawal from representing you in the above-identified patent case. I am withdrawing because: [of your lack of cooperation; of your non-payment of USPTO filing fees; the change in ownership of the underlying intellectual property rights; the change in your financial condition; you insist that I engage in conduct that is contrary to my judgment or advice, or is, in my opinion, contrary to law or rule; you have not complied with the terms set forth in the engagement letter; or for any other good reason]. I am withdrawing after having taking reasonable steps to avoid prejudice to you, the Client.

I am returning with this letter your documents, including: [provisional patent application; non-provisional patent application; drawings; claims as currently amended at the USPTO; and any outstanding office action].

You [do or do not] have an office action outstanding. It is your responsibility to respond to the office action. To reply without additional fees, your response is due no later than _____. You may be able to respond later with the payment of additional fees, however, you must determine what other statutory deadlines, if any, apply to your case, either by yourself or by retaining new counsel.

[Because your matter involved a provisional application, I was able to act in a representative capacity pursuant to 37 CFR 1.34 without a formal power of attorney. Accordingly, there is no need for me to obtain the USPTO's permission to withdraw. However, I have also put LegalCORPS on notice that I have withdrawn.] [I have filed with the USPTO the requisite paperwork to notify it of my withdrawal, and I include herewith a copy of that document. I have also put LegalCORPS on notice that I have withdrawn.] Please note again that unless you retain new counsel or prosecute your patent application yourself, you may lose your rights.

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

As with paying clients, there must be written notice within the file clearly establishing that the client was sufficiently informed that the matter for which the legal services were being provided has ended. Direct and clear communication with the client is key, beginning with the scope of representation set forth in the engagement letter through completion or possible termination of the attorney-client relationship.

4. File Closing

Metrics with respect to the program must be kept for various reasons. Thus, regardless of the basis for withdrawal of an attorney or the otherwise termination of the attorney-client relationship, the ISR's records must be updated at file closing. The following Case Closing form is suitable to accomplish this goal.¹⁵

¹⁵ See also Appendix A.



LegalCORPS
Inventor Assistance Program

**Full Representation
Case Closing Form**

Client Name: _____ **Date case opened:** _____

Attorney: _____ **Hours Volunteered:** _____

Names of other attorneys, paralegals, interpreters, law students or others (if any) who assisted you on this matter, and the number of pro bono hours they provided:

_____ **Hours Volunteered** _____
_____ **Hours Volunteered** _____
_____ **Hours Volunteered** _____

Please describe (for our funders) work you and others performed pro bono for this client, and how it could affect the success of the client’s small business or nonprofit mission:

Please check major reason case was closed (indicating the highest level of service you provided):

- All matters covered by client engagement agreement completed
- Referred for litigation or other contested dispute resolution procedure
- Provisional Patent Application filed
- Non-provisional Patent Application prosecuted to “final” office action
- Counsel and Advice
- Client Withdrew
- Other (specify) _____

Note: Case closings are listed in order of highest to lowest level of service. You may choose more than one reason case was closed if applicable.

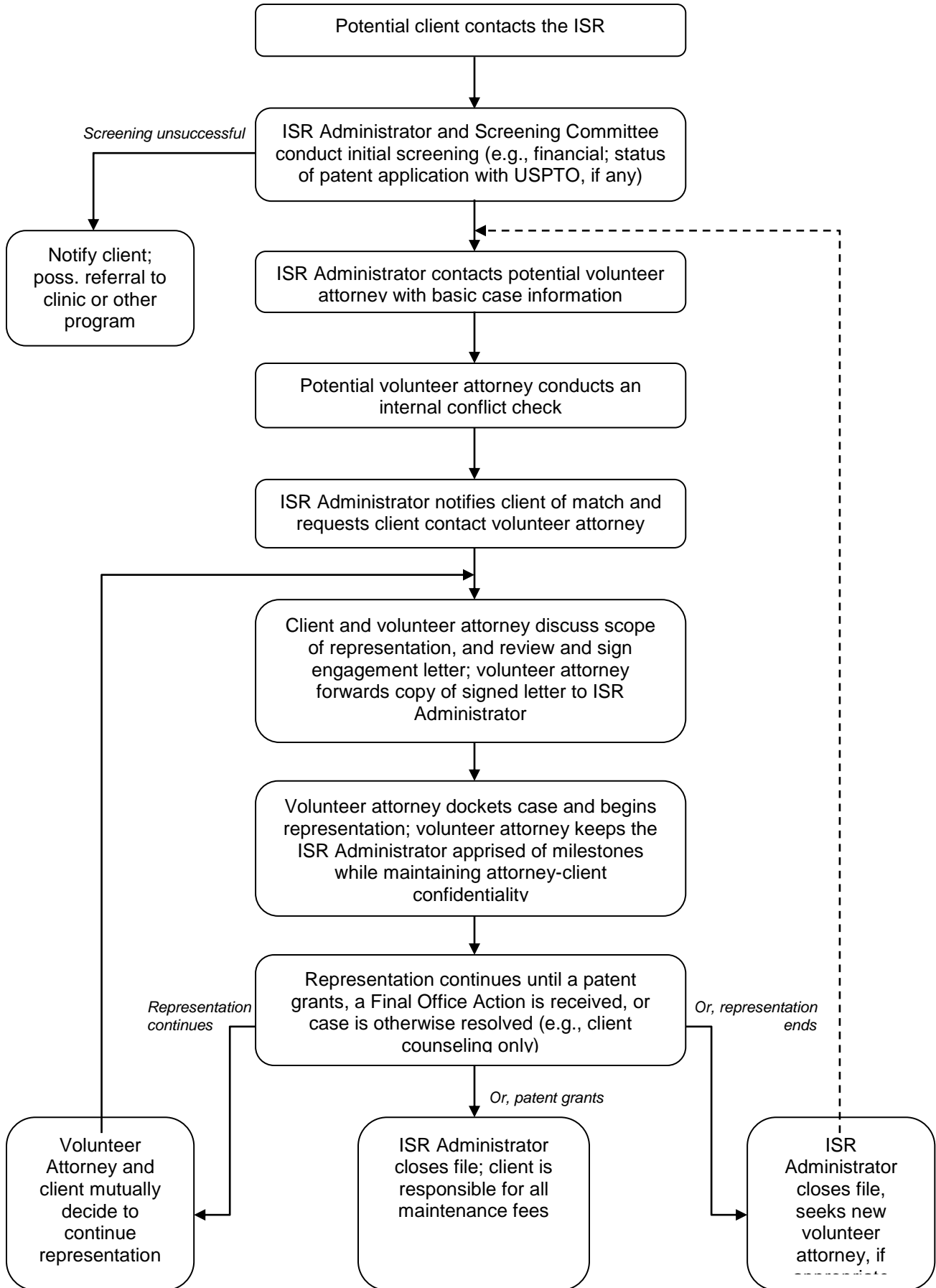
LegalCORPS’ funders may require us to provide a copy of your Client Representation Agreement for this client the following documents. Please enclose a copy or inform us here of the expected date of delivery (Date Sent): _____

Signed: _____ **Dated:** _____

***If you assist this client again, please have the client contact us first for rescreening.**

E. Example Case Study

In an effort to summarize the information contained in this handbook, the following “case study” provides a point-by-point synopsis in flowchart form of the process used by the Minnesota Pilot.



F. *External Services*

1. *Search, Drawings, and Other*

Because of limited resources, the IAP will almost certainly not be able to shoulder the out-of-pocket costs associated with the patent prosecution process. The focus of the IAP should be to provide volunteer legal services, not to pay fees and other hard costs associated with an application. Due to similar limited resources, the inventors also may be unable to pay for the traditional costs associated with utilizing vendors who provide services such as patent searches or drafting of formal drawings. Ideally, a volunteer attorney will be able to provide legal services to a pro bono client without the need for high outside costs. Although the USPTO does not require a patent search, if the attorney thinks one would be desirable, a minimal search using publicly available databases or libraries should be sufficient. Illustrations may be efficiently created by the client or the volunteer attorney may already have a practice of generating the drawings with the use of commonly available word processing or drafting programs. Notwithstanding these options, it is a best practice for the IAP to compile and maintain lists of external resources for ancillary services, preferably at a free or low-cost charge.

2. *Business Law Support*

The prosecution of a pro bono patent application does not occur in a vacuum. In other words, the inventor likely has other legal needs with respect to the future success of his or her invention. Although IAPs are limited in the services they may be able to provide, they may have resources and connections to external services to which they can refer their inventors. Thus, IAPs should take account of the connections they already have and should investigate the possibility of establishing new ones. Association with independent agencies that provide the following types of assistance would be beneficial:

- Non-patent legal assistance

There are organizations that provide free transactional business law assistance (e.g., entity formation, licensing, trademarks, contract negotiations, etc.), including independent nonprofit organizations involved exclusively with business law assistance, programs of state or local bar associations, volunteer attorney programs of legal aid groups, and law school clinics.

- Small business technical support

Agencies like Small Business Development Centers or SCORE are geared toward providing legal services to small businesses, and have further affiliations with the U.S. Small Business Administration (SBA). These agencies may provide volunteer business advisers, and related training and free counseling on business startup and ongoing operations issues.

- Inventor support organizations and agencies

Associations like the United Inventors Association, as well as city, state and regionally-based inventor networks, provide information on the patenting process and subsequent licensing and product development. Similar services may be available through university programs as well as local and state economic development agencies.

IV. TRACKING AND EVALUATION

A. *Recordkeeping and Metrics*

In order to respond to the different resources supporting the IAP (e.g., funders, the USPTO, law firms, and corporate citizens), the IAP will need to maintain a variety of metrics. Although success is truly measured by the good the IAP provides to pro se inventors, statistics will be necessary to sustain funding and volunteer participation. In addition, the more data kept, the better situated the ISR will be to improve the services it provides in years to come.

Best practices dictate that, at the very least, the IAP keep a detailed record of the number of: programs, attorneys, program/clinic partnerships, and resolved cases, all of which will be of benefit to the USPTO. Funders may be interested in this same information, but they may also find it beneficial to know: the number and sources of calls; the types of cases accepted/rejected and, if rejected, why; the resolution of closed cases; the number of program/clinic cases; and the number of hours spent in delivering professional services. The IAPs themselves may be interested in tracking and comparing information on data, such as case pendency and technologies covered, as well as on success stories and lessons learned.

Finally, surveying clients about their experiences with the IAP and, in particular, the attorney volunteers who assisted on their case, may provide invaluable insight as to how to make the provision of individual legal services better.

The following list sets forth a standard grouping of categories of metrics to be recorded:

- Number of inquiries (by phone, email, or conventional mail)
- Applicant's (or inquirer's) referral source
- Inventor name and contact information
- Applicant's annual gross household income level
- Subject matter and technical area of invention
- Client completion of USPTO web site educational modules
- Client's stage in patent process
- Name of attorney volunteer(s)
- Date of referral to attorney
- Type of assistance to be provided
- Hours of pro bono assistance provided
- Outcome of matter
- Case closing form sent/received
- Client race/ethnicity (client optional)
- Client age
- Status of ISR application
 - Forms sent & date
 - Forms received & date
 - Determination of eligibility re: income guidelines
 - Determination of eligibility re: invention subject matter (screening panel)
 - Acceptance or rejection letter sent
 - Payment or waiver of administrative fee

In addition to retaining information with respect to the clients, the ISR may want to preserve metrics about its volunteer attorneys, such as:

- Name
- Address
- Employer
- Contact information
- USPTO registration number & date of registration
- State attorney license number
- Technical background & areas of expertise
- Technical areas & industries that could pose conflict of interest
- Hours of pro bono assistance provided in program

B. Ongoing Funding

To ensure that the ISR has the resources to cover expenses, including insurance premiums and the program administrator's salary, ongoing fundraising efforts will be needed. For example, LegalCORPS sought and received three-year pledges of financial support from Minnesota corporations and law firms that have an interest both in patent law and in pro bono legal services. The founding funders committed to fulfill their pledges annually during the three-year pilot phase. An example invoice used to obtain subsequent years' installments follows.¹⁶

¹⁶ See also Appendix A.

INVOICE

Date: June 28, 2012



LegalCORPS
 600 Nicollet Mall, Suite 390A
 Minneapolis, MN 55402
 612-752-6678
 Email: info@legalcorps.org

BILL TO Name
 Address
 Address
 City, MN ZIP
 000-000-0000
 Email: xxx@xxxx.com

PLEDGE DATE	NAME OF CONTACT	TELEPHONE NUMBER
00/00/2011		

DATE	DESCRIPTION	BALANCE DUE
5/9/2012	2 nd installment of 3-year pledge of \$5,000 per year for support of Inventor Assistance Program (Patent Law Pro Bono Program) as a founding funder	\$5,000.00 for 2012 (\$5,000.00 for 2013 will remain on 3-year pledge)

LegalCORPS is tax-exempt under Sec. 501(c)3 of the federal tax code. This donation is tax-deductible.

For more information, please call Michael Vitt at (612) 278-6374

LegalCORPS appreciates your support!

It is important to be thinking more than three years out, however. Thus, best practices may include seeking other sources for ongoing funding. These may include:

- Annual program sponsorship from corporations, law firms, foundations, and other organizations;
- Donations from corporations and law firms in support of their employees who volunteer for the IAP;
- Expanding the program's philosophy to include "low bono" assistance. This could involve sliding administrative fees for services to clients with annual household incomes above the original pro bono ceiling; or
- Endowments from citizens interested in supporting independent inventors.

V. LESSONS LEARNED FROM THE MINNESOTA PILOT

Pro bono work is rewarding! Not much else needs to be said. The volunteer attorneys, clients, and various others who have assisted in the creation and implementation of the Minnesota Pilot have experienced firsthand the personal and professional satisfaction that comes from doing pro bono work. This is the most important lesson that anyone following the path of providing patent related pro bono services will learn.

From a more concrete perspective, the Minnesota Pilot has learned that pro se clients who have already interacted with the USPTO are very sophisticated. Their inventions are not whimsical, but instead are practical and evidence well thought-out utilitarian applications that will benefit society. Pro bono clients are no different than paying clients with regard to their passion and commitment for their particular legal matter. They are also no different in the sense that they have many things going on in their busy lives. Clients, of any ilk, typically are not sitting around waiting for an attorney to call them. The Minnesota Pilot initiated contact with pro se applicants who had unpublished applications on file by relying upon the USPTO to send information about the availability of the Minnesota Pilot. Due to the confidential nature of the unpublished applications, the USPTO could not share with the Minnesota Pilot the inventors' names or contact information, and thus the Minnesota Pilot could not directly follow up with those inventors. The result was that few of them reached out to the Minnesota Pilot. For published applications, however, the Minnesota Pilot did send subsequent communications to the pro se applicants, which resulted in more clients accessing the program.

Volunteer attorneys, as they typically do with their paying clients, contribute 100+% in the representation of their pro bono clients. The Minnesota Pilot's expectations of Minnesota attorneys were overwhelmingly fulfilled. Indeed, the Minnesota Pilot occasionally has suffered from the fortunate problem of having more volunteer attorneys than cases for prosecution. The Minnesota Pilot has learned that, to strike the correct balance between attorneys and clients, it needs to conduct training sessions for its volunteers no sooner than every six months. When volunteer attorneys are especially zealous in their excitement for the IAP, they are included in subcommittees to keep the program improving.

There have also been some harder lessons learned. The Minnesota Pilot underestimated the time necessary to set up all aspects of the IAP. Issues including funding, preparation of forms, retention of staff, and coordination of the schedules of volunteers, add up to exponentially more time than expected when the program was first conceived. Likewise, even once up and running, it took time and resources to overcome the skepticism of some individuals both to participate in the IAP and to support it from afar. Delegating responsibility and sharing the public eye also created tensions for which constant diplomacy was and is necessary.

A strong core of individuals who are focused on the ultimate goal - the provision of legal services to those who otherwise would go without - keeps the IAP on track. As explained above, pro bono work is rewarding. Those leading the program are confident that as long as they never forget the ultimate goal, any tension or other quasi-obstacle that the Minnesota Pilot faces will be easily overcome.

VI. MOVING FORWARD

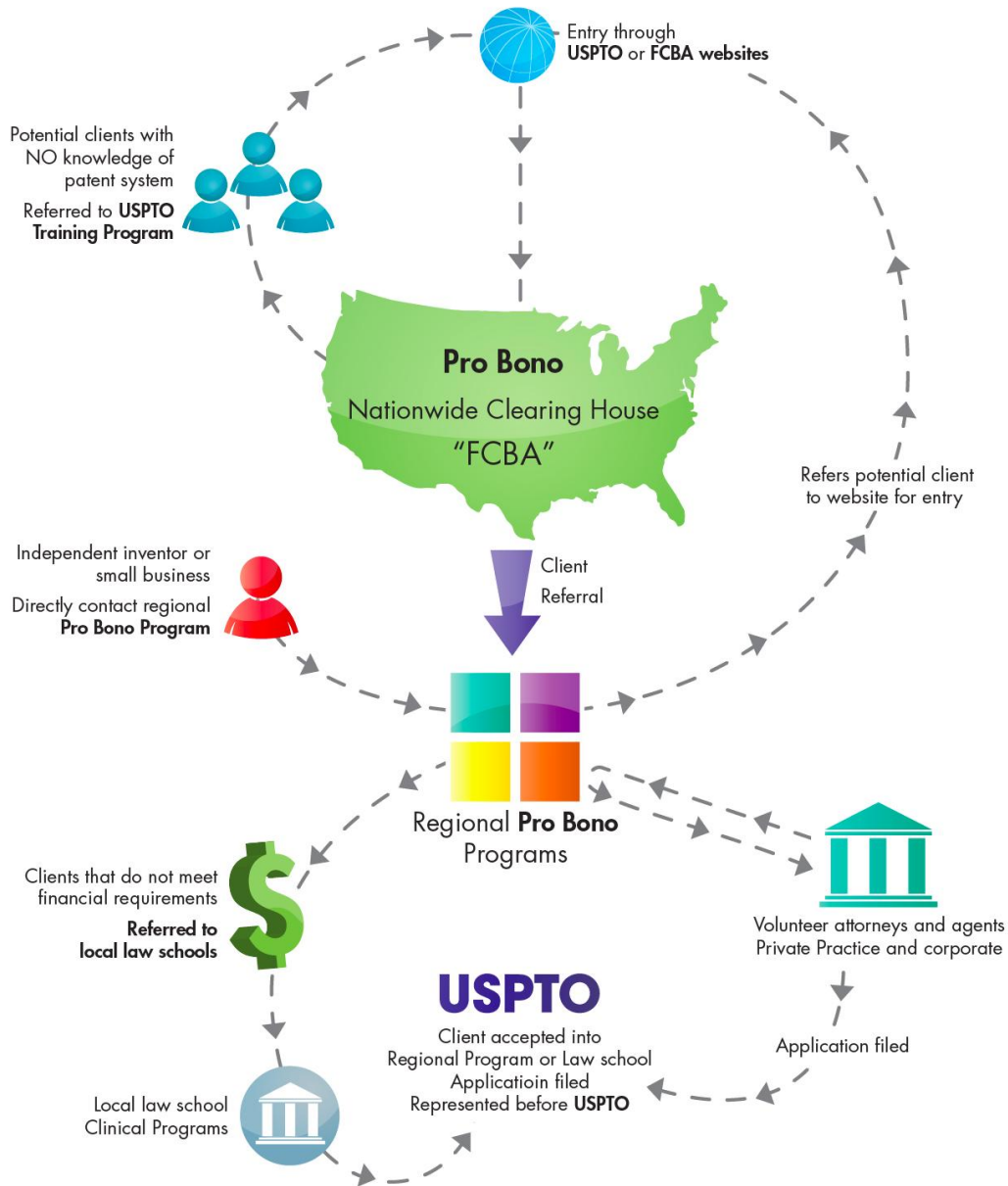
As the "pilot," the Minnesota IAP truly was the first in the nation. Understanding that prior attempts in other locales had failed due to the absence of an administrative ISR, the Minnesota Pilot's success can be tied to its founders' association early on with a local ISR, LegalCORPS. The purpose of the pilot, however, is to expand to other regions, and that process began early on in the life of the Minnesota Pilot with the establishment of the national AIA Pro Bono Task Force. Pursuant to Section 32 of the AIA, the USPTO now has a mandate to work with and support intellectual property law associations to establish IAPs across the nation.¹⁷ The goal is to have the whole country covered with IAPs within five years of launching the Minnesota Pilot. Understanding the magnitude of this initiative, Director Kappos asked the Minnesota Pilot founders to help form the

¹⁷ Leahy-Smith America Invents Act of 2011 § 32, Pub. L. No. 112-29, 125 Stat. 284.

task force. The AIA Pro Bono Task Force currently includes a number of the people responsible for the Minnesota Pilot as well as representatives from the USPTO, the judiciary, academia, the American Bar Association (ABA), the American Intellectual Property Law Association (AIPLA), the Intellectual Property Owners Association (IPO), and the United Inventors Association, all equally committed to pro bono legal services. The AIA Pro Bono Task Force will develop best practices to be used by each new program, provide ongoing guidance, examine ways to create efficiencies for and among programs, and report results back to the USPTO.

Although initially there was some discussion about having a program in each state, the members of the AIA Pro Bono Task Force have come to realize that a more regional model, with offices around the country serving a handful of states, would be more efficient. Accordingly, IAPs are already operational in California and Colorado and are currently being organized in the Washington, DC, area, the New York metropolitan area and Texas. Each has its own local steering and sub-committees, with volunteers working to establish programs that mirror the Minnesota Pilot.

As news of the nationwide initiative spread, other national associations have come forward with offers of assistance. For example, the Federal Circuit Bar Association (FCBA) is studying how it may assist the USPTO with the initial screening of pro se applications that could be forwarded to every regional program. Plans continue to unfold for the USPTO's website to provide a series of educational videos/modules on the patent prosecution process, so that pro se inventors may be better prepared when accessing the system. The website may also provide a portal, whereby pro se inventors could complete an application to seek assistance from the regional IAPs. The ultimate model for nationwide coverage is represented in the following diagram:



Finally, although the Minnesota Pilot was not set up to provide “low bono” services, Minnesota and other programs may someday choose to supplement pure pro bono with a “low bono” program component. The Minnesota Pilot was configured to provide services to pro se inventors with an income up to 300% of the federal poverty guidelines. While those inventors are the least likely to have the resources to move forward with their inventions, many others no doubt have incomes above the limit but still well below the amount needed to retain an

attorney at standard billing rates. Thus, there is a need for a program that would allow for a sliding scale fee schedule for inventors who do not meet the pro bono income limits.

VII. CONCLUSION

The vision that the USPTO and three Minnesota law firms had has flourished with the support of numerous volunteers providing both financial and in-kind support. The Minnesota Pilot has proven that it is possible to provide pro bono patent assistance, and it has consequently served as a catalyst for individuals and organizations in other jurisdictions. This initiative has been so successful that it is likely that within five years programs will be thriving across the country, and qualifying pro se inventors in every state will have access to pro bono legal services. Let us strive to achieve that goal so that all inventors can finally have access to justice!

APPENDIX A

<i>Form</i>	<i>Page</i>
Application for Free Legal Assistance	68-69
Inventor Information Form	70
Ineligibility Letter	71
Intake Form	72
Confidentiality Agreement	73
Notification Letter	74
Basic Patent Prosecution Process Flowchart	75
Engagement Letter Template	76-80
Engagement Letter (Clinic Student) Template	81-86
Credit Card Charge Authorization Form	87
Withdrawal Letter Template	88
Case Closing Form	89
Funder Invoice	90

6/2012



LegalCORPS
Inventor Assistance Program

**Application for Free
 Legal Assistance**

Note: If the business has multiple owners, each owner must complete a separate application. In addition to this financial information form, please submit the Inventor Information Form.

Name:

Spouse/domestic partner name:

Business name:

Street Address:

City:

State:

Zip:

E-mail address:

Business phone:

Website address:

Daytime phone:

Evening phone:

About the business owner:

Race/Ethnicity (select one or more)

- African/American
 American Indian
 Hispanic/Latino
 White/Caucasian
 African/Other
 Asian/Pacific Islander
 Other

Gender: Male Female

Gross Monthly Household income \$

Household size **Adults** **Children**

What do you rely on as your PRIMARY source of Household income? (check only one)

- Self-employed (full-time)
 Self-employed (part-time)
 Spouse/Partner Income
 Full-time job
 Part-time job
 Savings/Investment
 Alimony/Child Support
 Disability
 Public Assistance
 Unemployment Insurance
 Social Security
 Other

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

6/2012



LegalCORPS
Inventor Assistance Program

**Application for Free
 Legal Assistance**

Note: If the business has multiple owners, each owner must complete a separate application. In addition to this financial information form, please submit the Inventor Information Form.

Name:

Spouse/domestic partner name:

Business name:

Street Address:

City:

State:

Zip:

E-mail address:

Business phone:

Website address:

Daytime phone:

Evening phone:

About the business owner:

Race/Ethnicity (select one or more)

- African/American
 American Indian
 Hispanic/Latino
 White/Caucasian
 African/Other
 Asian/Pacific Islander
 Other

Gender: Male Female

Gross Monthly Household income \$

Household size Adults Children

What do you rely on as your PRIMARY source of Household income? (check only one)

- Self-employed (full-time)
 Self-employed (part-time)
 Spouse/Partner Income
 Full-time job
 Part-time job
 Savings/Investment
 Alimony/Child Support
 Disability
 Public Assistance
 Unemployment Insurance
 Social Security
 Other

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*



LegalCORPS
Inventor Assistance Program

**Inventor Information
Form**

Full name:

Residence:

Title of invention:

Category of invention (e.g. medical device for cardiac rhythm management, method of making food products, chemical composition for cleaning clothes):

Person(s) who have helped conceive or build an embodiment of the invention (for example, helped with ideas, efforts, financial support, or another form of support):

Person(s) or company(ies) who may own or have rights in the invention:

Current employer, date hired, your position/title:

Past employer(s) and dates(s) or employment within the past 3 years:

Person(s) or company(ies) with whom you have entered into a confidentiality agreement, non-compete agreement, or other agreement that relates to the invention:

For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402



Date

Dear:

Thank you for applying to the LegalCORPS Inventor Assistance Program. After review of your application, we have determined that you do not meet the income parameters of the program and therefore are not eligible to receive assistance. As we do not keep administrative fees unless a case is accepted, we are returning your application fee of \$50.

The following is a short list of additional resources that may be helpful as you proceed with patenting your invention:

- The United States Patent and Trademark Office website: www.uspto.gov contains a wealth of information for independent inventors. The USPTO also maintains a searchable list of registered patent attorneys and agents in Minnesota on its website.
- William Mitchell College of Law, a law school located in St. Paul, assists a limited number of inventor applicants each school year through its Intellectual Property Law Clinic. The clinic provides one-on-one consultation with a certified student attorney, under the supervision of a clinic attorney, and assistance in filing patent applications. For more information contact the Clinic Administrative Coordinator at (651) 290-6351 or jean.backes@wmitchell.edu.
- There are a large number of patent attorneys in Minnesota that may be able to assist you, particularly solo practitioners who may offer lower-cost services. They can be found through the Minnesota State Bar Association's referral service at: www.MNfindalawyer.com.

We extend our best wishes in your endeavor.

Regards,

Janet Schafer
Administrator
LegalCORPS Inventor Assistance Program
612-278-6348

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*



LegalCORPS
Inventor Assistance Program

Intake Form

Date: _____

Name: _____

Address: _____

Telephone: _____

Email: _____

Financial level: _____

Referral source: _____

Assistance needed: _____

Important dates: _____

Any communications from USPTO? _____

Have they used a patent attorney in the past: _____

Who: _____ Left because: _____

Referred to: _____

Follow up: _____

Volunteer Attorney assigned : _____

Administrative fee paid: _____

FORM	DATE SENT
Inventor contacts	
Inventor info	
Confidentiality agreement	
Acceptance and match letter	
Engagement letter	
Closing form	
Withdrawal letter	
Other	

6/2012



CONFIDENTIALITY AGREEMENT

Dated _____, 20_____

This Agreement is made between:

Name of receiving party: _____ (“Recipient”); and

Name of Patent Applicant: _____ (“Applicant”).

The purpose of this Agreement is to allow Applicant to disclose to Recipient certain limited confidential information about Applicant’s patent application in order to assist Recipient in determining whether Recipient may receive such confidential information as part of Recipient’s volunteer work with the **LegalCORPS Inventor Assistance Program**. Recipient will, as more fully described below, use such confidential information for the purpose of assisting Applicant in connection with the **LegalCORPS Inventor Assistance Program**, including for purposes of determining whether Recipient (if the Recipient is an attorney) or other LegalCORPS volunteer attorney may undertake the legal representation of Applicant in connection with Applicant’s patent application. NOTWITHSTANDING ANYTHING TO THE CONTRARY HEREIN, THIS AGREEMENT DOES NOT CREATE AN ATTORNEY-CLIENT RELATIONSHIP BETWEEN RECIPIENT AND APPLICANT. This Agreement will be effective as of the date first written above.

By signing below, and in consideration for Recipient’s promise to maintain in confidence the information disclosed by Applicant pursuant to the terms and conditions set forth herein, Applicant hereby agrees to disclose all necessary or pertinent information about Applicant’s U.S. patent application no. _____ (the “Patent Application”) for the purposes described above.

By signing below, and in consideration for Applicant’s foregoing promise to disclose information about Patent Application, Recipient hereby (i) agrees to keep confidential all information disclosed by Applicant related to or concerning Patent Application, (ii) agrees not to disclose or make any use of such confidential information for any purpose other as set forth in the immediately preceding paragraph, and (iii) agrees that the foregoing obligations of confidentiality will remain in effect for a period of two (2) years from the effective date of this Agreement regardless of whether the Recipient undertakes any representation of Applicant or whether Applicant is assisted in any way by the **LegalCORPS Inventor Assistance Program**. Notwithstanding the foregoing, Recipient agrees that he/she will return or otherwise destroy all such confidential information promptly when Recipient has completed his/her investigation of the Patent Application for the purposes contemplated in this Agreement; provided, however, that Applicant may retain copies of such confidential information for solely archival purposes.

This Agreement may not be changed, modified, released, discharged, abandoned or otherwise amended, in whole or in part, except by an instrument in writing, signed by Recipient and Applicant. This Agreement constitutes the entire agreement regarding confidentiality between Recipient and Applicant, superseding any previous oral or written communications, representations, understandings or agreements between Recipient and Applicant. This Agreement shall be governed by the laws of the State of Minnesota.

APPLICANT:

Name: _____
Date: _____

RECIPIENT:

Name: _____
Date: _____

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*



[Date]

[Address]

Dear [Name]:

Thank you for applying to the LegalCORPS Inventor Assistance Program. I am very happy to inform you that, after review of your application, we have determined that you meet the income and other parameters of the program and, therefore, are eligible to receive assistance.

Using your inventor information form, I have identified a volunteer attorney whose technical background makes [her/him] well suited for assisting you. This attorney has received your Invention Information form to run a preliminary conflict-of-interests check. If the attorney does not have a conflict [he/she] will contact you to set up an initial meeting.

The volunteer attorney selected is:

Contact at:

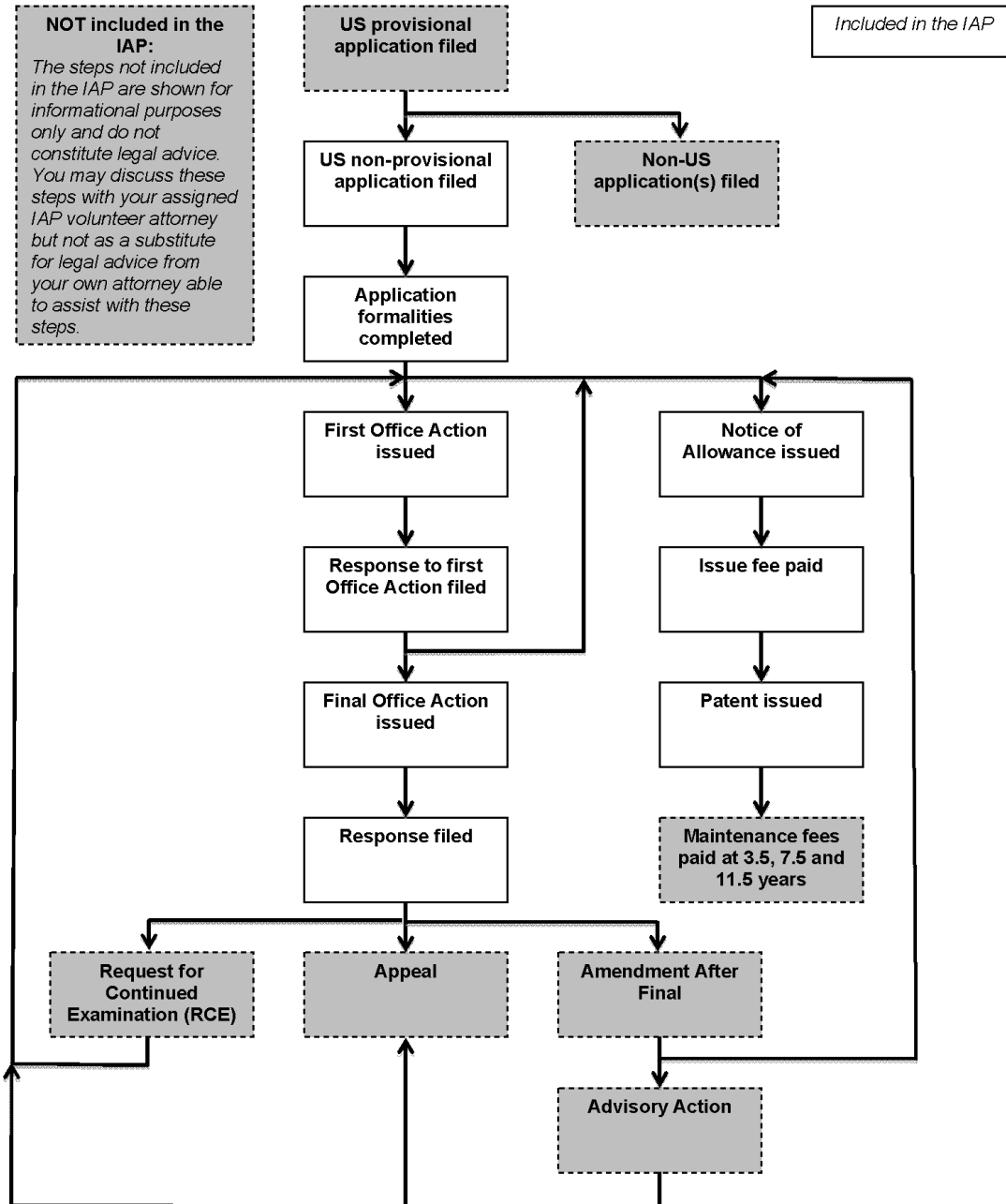
If this match does not work out for some reason, please feel free to contact me again so that I may search our database for another volunteer.

Regards,

Janet Schafer
Administrator
LegalCORPS Inventor Assistance Program
612-278-6348

*For more information, contact LegalCORPS at 612-278-6348,
inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

Basic US Patent Prosecution





LegalCORPS
Inventor Assistance Program

**Engagement Letter
 Template**

(Date)

(Name)

(Address)

Re: LegalCORPS Inventor Assistance Program Engagement Letter

Dear (Client):

This letter confirms representation of you (“Client”) by the undersigned volunteer attorney (“Volunteer”) in connection with the intellectual property matter defined and on the terms set forth below.

We believe it is important to our mutual success that we explain, in writing, the responsibilities and expectations of both parties to the attorney-client relationship. This letter is the agreement that sets forth the terms of our relationship. Please examine this agreement carefully and let us know immediately if you have any questions or concerns. No work will be performed and no attorney-client relationship is established until this agreement has been signed and returned.

1. Project & Scope

LegalCORPS will assist in arranging for Volunteer to agree to assist you with prosecution of U.S. Patent Application No. _____ (“Application”) before the U.S. Patent & Trademark Office (USPTO) (“Representation”).

The ability of Volunteer to undertake the Representation will depend upon Volunteer conducting a conflict check with respect to Volunteer’s existing clients and matters. Client agrees to provide sufficient information regarding the Application, such as the title and an abstract, synopsis or other summary, to enable Volunteer to conduct a conflict check if such a check has not already been conducted. Volunteer agrees to keep the information confidential, consistent with an attorney’s duty of confidentiality.

A. Provisional U.S. Applications

If the Application is a pending provisional U.S. patent application, the Representation includes filing a non-provisional U.S. patent application claiming priority to the provisional application, or converting the Application to a non-provisional U.S. patent application. The Representation may be extended to include prosecution of the non-

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

provisional U.S. patent application in accordance with paragraph 1(B) below only if mutually agreed upon by Client and Volunteer.

B. Non-Provisional U.S. Applications

If the Application is a pending non-provisional U.S. patent application, the Representation includes prosecution until a Final Office Action is received or the Application issues as a patent, whichever occurs first. Any Representation beyond these events must be mutually agreed upon by Client and Volunteer and requires a new engagement letter be signed by the parties.

If the Application issues as a patent, Client will be responsible for docketing and making any maintenance fee payments by the appropriate deadline. No assistance with maintenance fee matters is included in the scope of Representation.

C. Other Applications and Tasks Are Not Included

The scope of Representation is limited to that identified above and does not include any other patent application(s), whether pending or merely contemplated, related to the Application or unrelated, and/or U.S. or foreign. Assistance with prior art searching, patentability analysis, clearance or freedom-to-operate studies, non-infringement analyses, marketing, business development, licensing, transfer, enforcement or disputes with respect to the invention or any patent rights resulting from the Application, and other tasks are also not included in the scope of Representation.

Foreign patent applications, whether pending or merely contemplated, formally related to the Application or not, also are not included in the scope of Representation. Foreign patent rights related to the invention of the Application may already be unavailable or may be lost depending upon any public disclosure of the invention of the Application and/or whether more than one year has passed since the earliest priority date of the Application. Client should seek counsel from Volunteer if foreign patent rights may be desired, though assistance with any foreign applications is outside the scope of Representation unless otherwise agreed upon in writing by both Client and Volunteer.

The scope of the Representation may be changed, however, at any time by mutual written consent of Client and Volunteer, though Volunteer may withdraw as indicated in paragraph 5 below.

2. Fees, Costs, & Disbursements

Volunteer will provide the services during the Representation free of charge. Client, however, shall pay directly to the USPTO, patent search services, drafting services and/or other providers all costs or expenses incurred by Client. Such expenses may include draftsperson charges, government and recording fees, computerized research charges, patent search charges, copying costs, and postage. Client will be advised of costs in

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*

advance. Client will be required to make all such payments directly, such as by credit card or check made payable to the payee, without placing any funds in Volunteer's possession and with any funds sent and payable to Volunteer promptly returned. Client will be informed of any exceptions to this requirement, if available, after Volunteer has been specifically identified. Any exception must be in writing and signed by both parties.

Volunteer reserves the right to discontinue all legal services and terminate Representation if costs are not paid in a timely manner. Volunteer will not, however, discontinue service without giving notice of such intention.

3. Mutual Communications

Volunteer and Client acknowledge that considerable time and effort by each is required in order to successfully obtain a patent. The submission of a patent application is just the start of the process, and both Client and Volunteer agree to actively participate and put forth effort toward obtaining a patent. Delays in Client response time to Volunteer requests for information or assistance can necessitate payment of additional USPTO extension fees, the payment of which will be the sole responsibility of Client.

Volunteer will promptly comply with Client's reasonable requests for information regarding the status of the Representation. Volunteer shall consult with Client and shall abide by Client's decision with respect to the objectives of the Representation, subject to Volunteer's ethical and legal obligations and professional judgment.

Client will cooperate with Volunteer in order to be effectively and efficiently served by Volunteer during the course of the Representation. Client agrees to provide Volunteer with any information or documents reasonably necessary or useful for this Representation, including any change in Client's contacts, address or telephone numbers and any significant change in Client's financial or business condition. Client also will provide Volunteer with any information or documents which may be related to compliance with the duty of disclosure and/or the duty of candor and good faith when practicing before the USPTO. Insufficient Client effort will be adequate cause for attorney withdrawal.

4. Sufficient Connection to Minnesota & Financial Eligibility

Client has been accepted by LegalCORPS using certain connection to Minnesota and financial eligibility criteria. Client certifies that the connection to Minnesota and financial information supplied by it to LegalCORPS or Volunteer is complete and correct. Volunteer may withdraw Representation if that connection to Minnesota or financial information is not complete or direct or if Client's condition changes such that Client no longer has a sufficient connection to Minnesota or would be able to pay for the Representation.

For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402

In addition, Volunteer is free to apply Volunteer's own financial eligibility criteria and may withdraw from the Representation or discontinue delivery of services at any time based on its application of Volunteer's own financial eligibility criteria. Further, if Client obtains a licensee to or sells the Application or any other patent or application, Client must immediately inform LegalCORPS of such, along with the terms of the license agreement and/or sale.

5. Withdrawal or Termination of Representation

Pursuant to the Rules of Professional Conduct applicable to Volunteer's practice, Volunteer may withdraw from the Representation after taking reasonable steps to avoid prejudice to the Client. Volunteer may withdraw if, in its judgment, the Client is not cooperating with Volunteer, if the Client insists that Volunteer engage in conduct that is contrary to the judgment or advice of Volunteer or is contrary to law or rule, if the Client does not comply with the terms set forth in this letter, or for any other good reason. Volunteer may also withdraw because of the occurrence of an event ending Representation as specified in paragraph 1. Client will be notified of Volunteer's withdrawal in writing.

Volunteer and/or LegalCORPS may assist Client in finding new counsel, at their discretion.

6. Role of LegalCORPS

LegalCORPS is a referral service, not a law firm. Client acknowledges that while LegalCORPS, a Minnesota nonprofit corporation, has assisted in arranging the Representation, LegalCORPS has no responsibility for the performance of the Representation. Client waives any and all claims against LegalCORPS.

7. Sharing of Information

Volunteer is authorized by Client to report to LegalCORPS concerning the Representation so that LegalCORPS will be able to keep information concerning its program and use information about the Representation to help assist other clients. Client authorizes the use by Volunteer and LegalCORPS of the documents drafted during the course of the Representation for use in assisting other clients, organizations or individuals that request assistance from LegalCORPS. However, Client may direct Volunteer to delete information in documents that Client deems confidential.

Please contact Janet Schafer at LegalCORPS at: 612-278-6348 if you have any problems or questions.

For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402

AGREEMENT AND ACCEPTANCE: The undersigned [Client]/[representative of Client] hereby agrees to the above terms and conditions.

Dated: _____
_____ [Client's name if an entity]
[Client's name if an individual] _____
[Name of Officer]
Its _____

The undersigned Volunteer hereby agrees to the above terms and conditions.

Dated: _____

[Volunteer Name]



LegalCORPS
Inventor Assistance Program

**Engagement Letter
(Clinic Student) Template**

(Date)

(Name)

(Address)

Re: LegalCORPS Inventor Assistance Program Engagement Letter

Dear (Client):

This letter confirms representation of you (“Client”) by the undersigned volunteer attorney (“Volunteer”) in connection with the intellectual property matter defined and on the terms set forth below. The William Mitchell College of Law Intellectual Property Law Clinic (“Clinic”) will assign a certified student attorney (“Student Attorney”) to assist the Volunteer in connection with this matter.

We believe it is important to our mutual success that we explain, in writing, the responsibilities and expectations of both parties to the attorney-client relationship. This letter is the agreement that sets forth the terms of our relationship. Please examine this agreement carefully and let us know immediately if you have any questions or concerns. No work will be performed and no attorney-client relationship is established until this agreement has been signed and returned.

1. Project & Scope

LegalCORPS will assist in arranging for Volunteer to agree to assist you with prosecution of a patent application claiming priority to U.S. Provisional Patent Application No. ----- (“Application”) filed on ----- before the U.S. Patent & Trademark Office (USPTO) (“Representation”). Volunteer will solicit the help of a Student Attorney from the Clinic to assist with the Representation.

The ability of Volunteer to undertake the Representation will depend upon Volunteer conducting a conflict check with respect to Volunteer’s existing clients and matters. Client agrees to provide sufficient information regarding the Application, such as the title and an abstract, synopsis or other summary, to enable Volunteer to conduct a conflict check if such a check has not already been conducted. Volunteer agrees to keep the information confidential, consistent with an attorney’s duty of confidentiality except that Volunteer may share this information with the Clinic to enable the Clinic to conduct its own conflict check and to identify a suitable Student Attorney. The Student Attorney and

the Clinic also agree to keep the information confidential, consistent with an attorney's duty of confidentiality.

A. Provisional U.S. Applications

If the Application is a pending provisional U.S. patent application, the Representation includes filing a non-provisional U.S. patent application claiming priority to the provisional application, or converting the Application to a non-provisional U.S. patent application. The Representation may be extended to include prosecution of the non-provisional U.S. patent application in accordance with paragraph 1(B) below only if mutually agreed upon by Client, Volunteer, and the Clinic.

B. Non-Provisional U.S. Applications

If the Application is a pending non-provisional U.S. patent application, the Representation includes prosecution until a Final Office Action is received or the Application issues as a patent, whichever occurs first. Any Representation beyond these events must be mutually agreed upon by Client, Volunteer, and the Clinic, and requires a new engagement letter be signed by all the parties involved in such Representation.

If the Application issues as a patent, Client will be responsible for docketing and making any maintenance fee payments by the appropriate deadline. No assistance with maintenance fee matters is included in the scope of Representation.

C. Other Applications and Tasks Are Not Included

The scope of Representation is limited to that identified above and does not include any other patent application(s), whether pending or merely contemplated, related to the Application or unrelated, and/or U.S. or foreign. Assistance with prior art searching, patentability analysis, clearance or freedom-to-operate studies, non-infringement analyses, marketing, business development, licensing, transfer, enforcement or disputes with respect to the invention or any patent rights resulting from the Application, and other tasks are also not included in the scope of Representation.

Foreign patent applications, whether pending or merely contemplated, formally related to the Application or not, also are not included in the scope of Representation. Foreign patent rights related to the invention of the Application may already be unavailable or may be lost depending upon any public disclosure of the invention of the Application and/or whether more than one year has passed since the earliest priority date of the Application. Client should seek counsel from Volunteer if foreign patent rights may be desired, though assistance with any foreign applications is outside the scope of Representation unless otherwise agreed upon in writing by both Client and Volunteer.

The scope of the Representation may be changed, however, at any time by mutual written consent of Client, Volunteer, and the Clinic, though Volunteer and/or the Clinic may withdraw as indicated in paragraph 5 below.

2. Fees, Costs, & Disbursements

Volunteer and the Clinic including the assigned Student Attorney will provide the services during the Representation free of charge. Client, however, shall pay directly to the USPTO, patent search services, drafting services and/or other providers all costs or expenses incurred by Client. Such expenses may include draftsperson charges, government and recording fees, computerized research charges, patent search charges, copying costs, and postage. Client will be advised of costs in advance. Client will be required to make all such payments directly, such as by credit card or check made payable to the payee, without placing any funds in Volunteer's possession and with any funds sent and payable to Volunteer promptly returned. Client will be informed of any exceptions to this requirement, if available, after Volunteer has been specifically identified. Any exception must be in writing and signed by both parties.

The Volunteer and/or the Clinic including its Student Attorney reserve the right to discontinue all legal services and terminate Representation if costs are not paid in a timely manner. Neither Volunteer nor the Clinic including its Student Attorney will discontinue service without giving notice of such intention.

3. Mutual Communications

Volunteer, the Clinic including its assigned Student Attorney, and Client acknowledge that considerable time and effort by each is required in order to successfully obtain a patent. The submission of a patent application is just the start of the process, and Client, Volunteer, and Student Attorney agree to actively participate and put forth effort toward obtaining a patent. Delays in Client response time to Volunteer or Student Attorney requests for information or assistance can necessitate payment of additional USPTO extension fees, the payment of which will be the sole responsibility of Client.

Volunteer and the Clinic including its assigned Student Attorney will promptly comply with Client's reasonable requests for information regarding the status of the Representation. Volunteer and Student Attorney shall consult with Client and shall abide by Client's decision with respect to the objectives of the Representation, subject to ethical and legal obligations and professional judgment.

Client will cooperate with Volunteer and the Clinic through its assigned Student Attorney in order to be effectively and efficiently served during the course of the Representation. Client agrees to provide Volunteer and Student Attorney with any information or documents reasonably necessary or useful for this Representation, including any change in Client's contacts, address or telephone numbers and any significant change in Client's

For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402

4

financial or business condition. Client also will provide Volunteer or Student Attorney with any information or documents which may be related to compliance with the duty of disclosure and/or the duty of candor and good faith when practicing before the USPTO. Insufficient Client effort will be adequate cause for withdrawal from Representation by the Volunteer and/or the Clinic including its assigned Student Attorney.

4. Sufficient Nexus to Minnesota & Financial Eligibility

Client has been accepted by LegalCORPS using certain nexus to Minnesota and financial eligibility criteria. Client certifies that the nexus to Minnesota and financial information supplied by it to LegalCORPS or Volunteer is complete and correct. Volunteer and/or the Clinic including its assigned Student Attorney may withdraw Representation if that nexus to Minnesota or financial information is not complete or direct or if Client's condition changes such that Client no longer has a sufficient nexus to Minnesota or would be able to pay for the Representation.

In addition, Volunteer is free to apply Volunteer's own financial eligibility criteria and may withdraw from the Representation or discontinue delivery of services at any time based on its application of Volunteer's own financial eligibility criteria. Further, if Client obtains a licensee to or sells the Application or any other patent or application, Client must immediately inform LegalCORPS of such, along with the terms of the license agreement and/or sale.

5. Withdrawal or Termination of Representation

Pursuant to the Rules of Professional Conduct applicable to legal practice before the USPTO, Volunteer and/or the Clinic including its assigned Student Attorney may withdraw from the Representation after taking reasonable steps to avoid prejudice to the Client. Volunteer and/or the Clinic including its assigned Student Attorney may withdraw if, in its judgment, the Client is not cooperating with Volunteer and/or Student Attorney, if the Client insists that Volunteer and/or Student Attorney engage in conduct that is contrary to the judgment or advice of Volunteer and/or Student Attorney or is contrary to law or rule, if the Client does not comply with the terms set forth in this letter, or for any other good reason. Volunteer and/or the Clinic including its assigned Student Attorney may also withdraw because of the occurrence of an event ending Representation as specified in paragraph 1. Client will be notified of withdrawal of Volunteer and/or the Clinic in writing. Volunteer, the Clinic, and/or LegalCORPS may assist Client in finding new counsel, at their discretion.

6. Role of LegalCORPS

LegalCORPS is a referral service, not a law firm. Client acknowledges that while LegalCORPS, a Minnesota nonprofit corporation, has assisted in arranging the

For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402

Representation, LegalCORPS has no responsibility for the performance of the Representation. Client waives any and all claims against LegalCORPS.

7. **Sharing of Information**

Volunteer and the Clinic including its assigned Student Attorney are authorized by Client to report to LegalCORPS concerning the Representation so that LegalCORPS will be able to keep information concerning its program and use information about the Representation to help assist other clients. Client authorizes the use by Volunteer, the Clinic, and LegalCORPS of the documents drafted during the course of the Representation for use in assisting other clients, organizations or individuals that request assistance from LegalCORPS. However, Client may direct Volunteer and/or the Clinic to delete information in documents that Client deems confidential.

The Clinic will decide which Student Attorney will work on Client's case. Client understands that Student Attorneys are not licensed attorneys, but certified student attorneys who are granted limited recognition by the USPTO to practice in patent cases while serving in the Clinic. Student Attorneys must adhere to the USPTO's Rules of Professional Conduct. Client further understands that the Student Attorney assigned to Client's case is doing this work as part of her/his law school education. She/he works under the supervision of Volunteer and Clinic Faculty Supervisors. The Clinic may assign other Student Attorneys work on Client's case and Client will be told as soon as possible if another Student Attorney will be assigned to Client's case. All correspondence regarding Client's patent application will be sent to William Mitchell College of Law, and documents and correspondence relating to Representation will be kept on file and docketed by the Clinic.

The Clinic will keep Client's case confidential. The assigned Student Attorney and other members of the Clinic will not talk about Client's case with anyone outside of the Clinic without Client's permission, unless ordered by a court. Client gives permission to the Clinic to discuss Client's case with other members of the Clinic and understands that Client's case may be discussed in Clinic classroom meetings for educational purposes and for obtaining input on various issues that may arise during the Representation.

Please contact the undersigned Volunteer, or the administrator of the LegalCORPS Inventor Assistance Program, if you have any questions.

AGREEMENT AND ACCEPTANCE:

The undersigned Volunteer hereby agrees to the above terms and conditions.

Name: _____

Date: _____

For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or 600 Nicollet Mall, Suite 390A, Minneapolis MN 55402

The undersigned representative of the William Mitchell College of Law Intellectual Property Clinic hereby agrees to the above terms and conditions.

Name: _____
Jay Erstling

Date: _____

The undersigned Client hereby agrees to the above terms and conditions.

Name: _____

Date: _____

CREDIT CARD CHARGE AUTHORIZATION

All information must be provided to process the charge.

Cardholder Name (as it appears on the credit card)

Credit Card Billing Address

_____, _____
City State Zip Code

Type of Credit Card (check one): Visa MasterCard Other _____

Account Number Expiration Date (MM/YY) 3 Digit V Number
(On Back of Card)

I authorize _____ to charge US\$ _____
to my credit card indicated above for the following purpose: _____

Signature of Cardholder Date



LegalCORPS
Inventor Assistance Program

**Withdrawal Letter
Template**

(Date)

(Name)

(Address)

Re: LegalCORPS Inventor Assistance Program Withdrawal Letter

USPTO Serial No.

Dear (Client):

This letter is to give you written notice of my withdrawal from representing you in the above-identified patent case. I am withdrawing because: [of your lack of cooperation; of your non-payment of USPTO filing fees; the change in ownership of the underlying intellectual property rights; the change in your financial condition; you insist that I engage in conduct that is contrary to my judgment or advice, or is, in my opinion, contrary to law or rule; you have not complied with the terms set forth in the engagement letter; or for any other good reason]. I am withdrawing after having taking reasonable steps to avoid prejudice to you, the Client.

I am returning with this letter your documents, including: [provisional patent application; non-provisional patent application; drawings; claims as currently amended at the USPTO; and any outstanding office action].

You [do or do not] have an office action outstanding. It is your responsibility to respond to the office action. To reply without additional fees, your response is due no later than _____. You may be able to respond later with the payment of additional fees, however, you must determine what other statutory deadlines, if any, apply to your case, either by yourself or by retaining new counsel.

[Because your matter involved a provisional application, I was able to act in a representative capacity pursuant to 37 CFR 1.34 without a formal power of attorney. Accordingly, there is no need for me to obtain the USPTO's permission to withdraw. However, I have also put LegalCORPS on notice that I have withdrawn.] [I have filed with the USPTO the requisite paperwork to notify it of my withdrawal, and I include herewith a copy of that document. I have also put LegalCORPS on notice that I have withdrawn.] Please note again that unless you retain new counsel or prosecute your patent application yourself, you may lose your rights.

*For more information, contact LegalCORPS at 612-278-6348, inventorassist@legalcorps.org or
600 Nicollet Mall, Suite 390A, Minneapolis MN 55402*



LegalCORPS
Inventor Assistance Program

**Full Representation
Case Closing Form**

Client Name: _____ **Date case opened:** _____

Attorney: _____ **Hours Volunteered:** _____

Names of other attorneys, paralegals, interpreters, law students or others (if any) who assisted you on this matter, and the number of pro bono hours they provided:

_____ **Hours Volunteered** _____
_____ **Hours Volunteered** _____
_____ **Hours Volunteered** _____

Please describe (for our funders) work you and others performed pro bono for this client, and how it could affect the success of the client’s small business or nonprofit mission:

Please check major reason case was closed (indicating the highest level of service you provided):

- All matters covered by client engagement agreement completed
- Referred for litigation or other contested dispute resolution procedure
- Provisional Patent Application filed
- Non-provisional Patent Application prosecuted to “final” office action
- Counsel and Advice
- Client Withdrew
- Other (specify) _____

Note: Case closings are listed in order of highest to lowest level of service. You may choose more than one reason case was closed if applicable.

LegalCORPS’ funders may require us to provide a copy of your Client Representation Agreement for this client the following documents. Please enclose a copy or inform us here of the expected date of delivery (Date Sent): _____

Signed: _____ **Dated:** _____

***If you assist this client again, please have the client contact us first for rescreening.**

INVOICE

Date: August 29, 2012

LegalCORPS
 600 Nicollet Mall, Suite 390A
 Minneapolis, MN 55402
 612-752-6678
 Email: info@legalcorps.org



BILL TO Name
 Address
 Address
 City, MN ZIP
 000-000-0000
 Email: xxx@xxxx.com

PLEDGE DATE	NAME OF CONTACT	TELEPHONE NUMBER
00/00/2011		

DATE	DESCRIPTION	BALANCE DUE
5/9/2012	2 nd installment of 3-year pledge of \$5,000 per year for support of Inventor Assistance Program (Patent Law Pro Bono Program) as a founding funder	\$5,000.00 for 2012 (\$5,000.00 for 2013 will remain on 3-year pledge)

LegalCORPS is tax-exempt under Sec. 501(c)3 of the federal tax code. This donation is tax-deductible.

For more information, please call Michael Vitt at (612) 278-6374

LegalCORPS appreciates your support!

APPENDIX B

<i>Form</i>	<i>Page</i>
Inventor Assistance Program Power Point Presentation	92-101



HISTORY & MISSION OF LEGALCORPS

- 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

HOW THE INVENTOR ASSISTANCE PROGRAM (IAP) CAME TO BE

- Co-founded by LegalCORPS and the law firms of Patterson Thuentel IP, Lindquist & Vennum and Myer & Njus.
- Developed with the encouragement of the United States Patent & Trademark Office (USPTO) and the support of a group of Minnesota corporations and law firms.

IAP FOUNDING FUNDERS

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

WHAT DOES THE LEGALCORPS IAP DO?

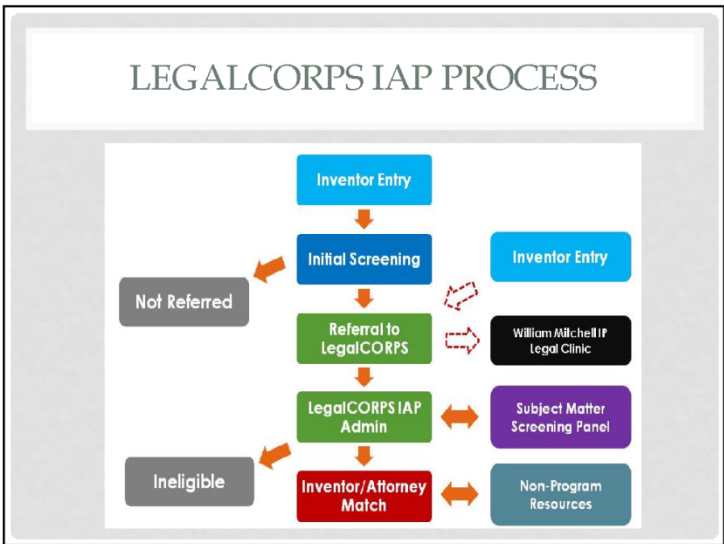
- Conducts financial eligibility screening of inventors
- Matches inventors with volunteer attorneys for patent prosecution assistance
- Provides general information and outreach to the independent inventor community
- Manages a volunteer attorney roster and conducts orientation (see form at <http://legalcorps.org/volunteers/how-to-become-a-volunteer/volunteer-form>)
- Provides volunteer attorneys with malpractice insurance for matters referred to them by LegalCORPS IAP (coverage limit: \$1M)
- Provides general information and support to volunteer attorneys

WHAT DOES THE LEGALCORPS IAP **NOT** DO?

- Provide legal services
- Docket deadlines
- Match volunteer attorneys for any of the following tasks:
 - Patent searching
 - Patentability or clearance opinions
 - Licensing, transfer, enforcement or disputes
 - Assistance with non-U.S. patent applications
 - Preparation of provisional patent applications (currently)

WHO DOES THE LEGALCORPS IAP SERVE ?

- Inventors must:
 - Have a strong connection to Minnesota
 - Have already filed a patent application with the USPTO
 - Have household income not exceeding 300 % of the federal poverty guidelines
 - Pass a basic screening



PROCESS FOR VOLUNTEERS: CASE STUDY

1. The IAP administrator contacts a potential volunteer attorney with basic case information after the client has passed the financial and basic screening
2. The volunteer attorney conducts an internal conflict check and notifies the IAP administrator of the result
3. If the conflict check is clear, the IAP administrator notifies the client of an attorney match

PROCESS FOR VOLUNTEERS: CASE STUDY

4. The client initiates contact with the volunteer attorney
5. The volunteer attorney and client meet to discuss the scope of representation, and an engagement letter is reviewed and signed
 - IAP has a sample engagement letter and other forms for use by volunteer attorneys
 - Firms may prefer or require that attorneys use firm engagement letters, which should be amended to make clear certain specific aspects of the IAP: "unbundled" scope of representation (i.e., identification of patent application by serial number), responsibility for payment of USPTO and other fees, exclusion of assistance with non-U.S. applications, etc.

PROCESS FOR VOLUNTEERS: CASE STUDY

6. A copy of the signed engagement letter must be forwarded to the IAP administrator
7. The volunteer attorney docket any applicable deadlines

PROCESS FOR VOLUNTEERS: CASE STUDY

8. The client is responsible for all fees
 - E.g., USPTO fees, draftsman charges, external search fees, etc.
 - The volunteer attorney should apprise the client early and often of any fees due
 - Generally acceptable fee payment methodologies
 - Client credit card (template authorization form available)
 - Check payable to, e.g., the USPTO
 - Check payable to a law firm for deposit in an appropriate trust account
 - Attorney/firm can advance fees at own risk
 - An in-house attorney cannot use a law firm's trust account, nor can LegalCORPS set up a trust account for the program because it is not a law firm
 - Use extensions, if available, very carefully and only with client communication

PROCESS FOR VOLUNTEERS: CASE STUDY

9. As milestones are reached, the volunteer attorney provides general updates to the IAP administrator
10. Assistance continues until the scope of representation is resolved (e.g., a Final Office Action issues, a patent grants, a non-provisional application is filed, etc.)
 - The volunteer attorney should notify the IAP administrator so that the case can be closed
 - Representation may continue if both the client and the volunteer attorney agree and a new engagement letter is signed

PROCESS FOR VOLUNTEERS: CASE STUDY

11. When a patent is received, the client is responsible for all docketing and maintenance fees
12. The volunteer attorney may be placed back on the volunteer roster for another case, at the volunteer attorney's request

ATTORNEY-CLIENT RELATIONSHIP

- Both client and volunteer attorney agree to actively participate and put forth effort toward obtaining a patent
- Clients may be unfamiliar with the patent process and/or skeptical of attorneys and the USPTO
- Don't make decisions for the client
 - Provide counsel with respect to the objectives of the representation subject to volunteer's ethical and legal obligations and professional judgment

ATTORNEY-CLIENT RELATIONSHIP

- When to refer the client back to LegalCORPS:
 - The inventor has unrealistic expectations
 - A conflict becomes apparent
 - Client is nonresponsive or uncooperative
 - Nonpayment of necessary fees
 - The attorney is generally uncomfortable with the relationship
 - LegalCORPS may require withdrawal if a client is no longer financially eligible, if the technology is licensed or the application sold

ATTORNEY-CLIENT RELATIONSHIP

- How to refer the client back to LegalCORPS:
 - Bring issues to the attention of the IAP administrator right away
- What happens to a client that is referred back?
 - Depending on circumstances, attorney-client relationship is terminated and attorney withdraws
 - Client may be reassigned to another volunteer attorney, if appropriate
 - Client may be advised that further assistance cannot be provided

SUMMARY

- What we've learned so far
- What's next
- Questions

CONTACTS

- We are happy to assist and value your feedback

Janet Schafer
LegalCORPS IAP
(612) 278-6348
jschafer@legalcorps.org

Amy Salmela
Patterson Thunte IP
(612) 252-1538
salmela@ptslaw.com

Mark Privratsky
Lindquist & Vennum
(612) 371-3524
mprivratsky@lindquist.com