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How The Patent Pro Bono Program Is Making A Difference

Law360, New York (September 15, 2015, 9:44 AM ET) -- In the past four years, patent practitioners have launched pro bono programs across the country to provide free legal assistance to financially under-resourced inventors, beginning with a pilot in Minnesota in 2011. Under the USPTO's leadership, all 50 states have now launched a regional program. California inventor Zbigniew Doroszkiewicz's story exemplifies the positive impact these programs are making on the lives of inventors.

Scott Pojunas

Overview of Patent Pro Bono Programs

The first dedicated patent pro bono program in the United States launched as a pilot in Minnesota in June 2011. This pilot program became the LegalCORPS Inventor Assistance Program (IAP). LegalCORPS is an independent nonprofit founded in Minnesota in 2004 to provide nonlitigation business law pro bono services to low-income individuals and nonprofit organizations. In 2011, LegalCORPS expanded its mission to take on patent pro bono. Since the program's launch, LegalCORPS IAP volunteer patent attorneys have helped more than 20 low income inventors and entrepreneurs obtain patents on their inventions and work towards commercialization.

Jennifer McDowell

Since the 2011 enactment of the America Invents Act, the USPTO has been working more formally with intellectual property law associations across the country to establish additional patent pro bono programs designed to assist financially under-resourced inventors. The California Inventors Assistance Program (CIAP) was among the first wave of inventor assistance programs following the Minnesota pilot program and was the first program to allow inventors and attorneys in surrounding states to participate in its program. CIAP now services nine states, including California, Oregon, Washington, Nevada, Arizona, Montana, Idaho, Alaska and Hawaii.

Amy Salmela

Many other programs similar to LegalCORPS IAP and CIAP have launched across the country. When President Obama issued his executive action in February 2014, the USPTO ramped up its efforts by hiring a full-time pro bono coordinator and a dedicated team of pro bono lawyers. In mid-2014, only 19 states had a patent pro bono program and many of these states were covered through CIAP. All 50 states now provide access to a program.

The USPTO has achieved this success through a regional approach. In particular, the USPTO

finds capable nonprofit entities, bar associations and universities across the U.S. who then administer the program by accepting client applications, screening those applications, and referring them to qualified patent volunteer lawyers. Presently, 18 regional programs are in full operation.

Still a relatively new concept in the world of pro bono, patent pro bono provides modest-means inventors with a most valuable resource: free patent legal services. Many of these inventors do not file pro se applications before the USPTO, which generally increases the quality of the applications filed and results in fewer rejections for mere formalities. With competent counsel to represent them, the inventors are better positioned to obtain the full scope of protection for the intellectual property to which they are entitled. And the rest of America can eagerly await the commercialization of innovation that might not have otherwise reached the marketplace.

In the four years since the beginning of the program, over two dozen patents have issued through a regional patent pro bono program, a significant number given that pendency time at the USPTO can often be lengthy. The story of California inventor Zbigniew "ZB" Doroszkiewicz highlights how these patent pro bono programs are making a difference. In the remainder of this article, Hewlett-Packard attorney Scott Pojunas, Doroszkiewicz's pro bono patent lawyer, tells his account of the positive impact the pro bono program can have for an inventor.

Doroszkiewicz's Story: The Path to a Granted United States Patent

I first met Doroszkiewicz when I volunteered to assist him through HP's relationship with California Lawyers for the Arts (CLA), a California nonprofit that serves as the statewide administrator for the CIAP. Building on the Office of the General Counsel's commitment to support pro bono efforts, Gail Su, a fellow attorney in the Intellectual Property Section, launched a patent pro bono program at HP in 2013. Our department partnered with CLA and several law firms that assist us with filing applications and responses. For Doroszkiewicz's case, I worked with Dan Ovanezian, a partner at Lowenstein Sandler LLP.

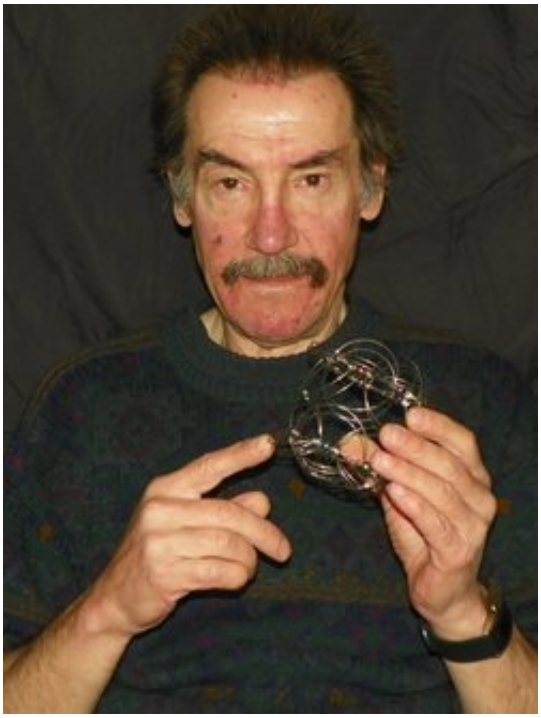
When I first spoke with Doroszkiewicz, it was immediately clear that he is an artistic, passionate person. He expresses himself through his oil paintings, painted wooden boxes, ceramic, photography and other fine art. Inspired by the mandala, an ancient symbol representing the universe, Doroszkiewicz invented a three-dimensional wire mandala assembled using dozens of intricately connected segments. Built with an arrangement of wires of different lengths, Doroszkiewicz's mandala seamlessly shifts between shapes in a way that would seem impossible given its rigid components. Having received a street artist license from the San Francisco Art Commission, Doroszkiewicz sells his wire mandala at a booth in San Francisco.

In 2011, after Doroszkiewicz perfected his wire mandala, he drafted and filed a patent application, working with his longtime friend Josie Grant, a San Francisco mural artist. Doroszkiewicz explained that hiring a patent attorney would have been cost-prohibitive, so he prepared his application pro se despite his limited knowledge of U.S. patent law. Doroszkiewicz unfortunately encountered difficulties during patent examination due to the complexities relating to application content.

Compounding the challenges, Doroszkiewicz is a non-native English speaker, having moved to the United States from Poland in 1989 as a political refugee. After moving to the U.S., Doroszkiewicz spent a short period in Salt Lake City before he settled in San Francisco, drawn to its European feel and cultural diversity. Although Doroszkiewicz has lived in the U.S. for over 25 years, the patent examination process depends heavily on subtle nuances in language and thus presented an additional hurdle for him.

In December 2013, Doroszkiewicz received a nonfinal office action rejecting his application.

Between February 2014 and May 2014, he filed three responses to the office action, but each response was rejected as noncompliant for failing to comply with the USPTO's formalities. Eventually, in July 2014, Doroszkiewicz received a final office action again rejecting his application on three different grounds. At that point, he felt frustrated and disheartened with the U.S. patent system and felt "lost in the process." Paying a patent attorney was not financially feasible, but Doroszkiewicz was not yet ready to give up on his invention. Josie Grant had previously used pro bono counsel for a civil rights action related to her murals and suggested that he seek assistance through CLA.



Doroszkiewicz pictured with one implementation of his wire toy mandala.

We were assigned as Doroszkiewicz's counsel following a placement coordinated by Gail Su through CLA. During our initial consultation, Doroszkiewicz explained his invention and what he believed to be his inventive contribution. He also mailed me a model of the wire mandala, which proved to be very useful in understanding its intricate construction. After reviewing his application file, I determined that we would need to draft a new set of claims and correct informalities in the specification and drawings.

As a next step, we recommended that we schedule an interview with the patent examiner to discuss the case in detail. I decided to conduct the interview in-person at the USPTO's headquarters in Alexandria, Virginia. Although interviews are within the discretion of the examiner following a final office action, the examiner and her supervisory patent examiner graciously granted our request. During the interview, I demonstrated Doroszkiewicz's invention using his model and explained what we believed to be the features differentiating his invention from the prior art. The interview was very productive, as the examiner and SPE provided helpful guidance on possible options for advancing Doroszkiewicz's case.

Following the interview, Dan Ovanezian and I again met with Doroszkiewicz to debrief him on the interview and agree on a strategy. We ultimately elected to file an amendment under the USPTO's After Final Consideration Pilot, rather than filing a request for continued examination, which would have immediately incurred a $300 fee. With this amendment, we corrected informalities in the detailed description and figures and presented a new claim set. This approach was not without risk, as failure to obtain an allowance would have required us to file an RCE with the $300 fee plus additional extension fees.

About six weeks after we filed the response, we received great news from the USPTO. The

examiner had mailed a notice of allowance, signaling that Doroszkiewicz's application would be granted as a patent following payment of one additional fee. His patent was officially granted on Feb. 10, 2015. I recently spoke with Doroszkiewicz, and he relayed that obtaining a granted U.S. patent "changed his life" and is a "life dream realized." With his patent now in hand, Doroszkiewicz is beginning to market his invention and hopes to commercialize his wire mandala on a larger scale.

As a software patent attorney, I never expected that one of the most impactful cases in my career would be for a three-dimensional piece of art. A novice patent practitioner quickly learns that the patent system can be difficult to navigate and overwhelming at times. Representing ZB Doroszkiewicz showed me, however, that these challenges are multiplied for pro se patent applicants who must also bridge the gap between the technical and legal.

The Patent Pro Bono Program presents an exceptional opportunity for patent practitioners to leverage their technical and legal expertise to bridge this gap. Based on my experience with Doroszkiewicz's case, I learned that any patent practitioner can truly make a difference, and I encourage practitioners to strongly consider volunteering through their regional patent pro bono program.

For additional information about the Patent Pro Bono Program and your regional office, please visit www.uspto.gov/probonopatents.

—By Scott Pojunas, Hewlett-Packard Company, Jennifer McDowell, U.S. Patent and Trademark Office, and Amy Salmela, Patterson Thuente Pedersen PA

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