



New Pro Bono Opportunities for Michigan Intellectual Property Attorneys

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Certainly, life as a lawyer is a bit more complex today than it was a century ago. The ever-increasing pressures of the legal marketplace, the need to bill hours, to market to clients, and to attend to the bottom line, have made fulfilling the responsibilities of community service quite difficult. But public service marks the difference between a business and a profession. While a business can afford to focus solely on profits, a profession cannot. It must devote itself first to the community it is responsible to serve. I can imagine no greater duty than fulfilling this obligation. And I can imagine no greater pleasure.

—Justice Sandra Day O'Connor,
Professionalism, 78 Or L R 385, 391 (1999)

Every Michigan attorney understands the challenges facing the profession in addressing the unmet need for legal services among low-income and disadvantaged residents of the state. For intellectual property (IP) attorneys, however, it is often difficult to find community service opportunities that call on their particular legal knowledge and skills. This challenge is exacerbated by a number of factors. First, many traditional legal aid organizations do not coordinate IP-related services. In addition, the fact that representation in IP matters often results in the creation of an economic asset, such as a

patent or copyright, may seem at odds with some notions of pro bono publico (“for the public good”).

In reality, the need for pro bono representation is as important in IP matters as in other legal issues. Low-income and under-resourced inventors, micro-entrepreneurs, artists, arts organizations, and other innovators and creative producers are an important part of the fabric of Michigan’s cultural environment and community identity. These creative endeavors may form the basis of economic self-sufficiency and generate valuable benefits to the community.

Two new Michigan pro bono programs—the Michigan Patent Pro Bono Project and Creative Many Michigan’s Lawyers for the Creative Economy—identify worthwhile IP projects and match volunteer lawyers with under-resourced inventors and creative workers. These projects are valuable additions to Michigan’s network of pro bono legal service organizations and will play an important role in addressing unmet legal needs through the state.

Pro bono publico in Michigan

Pro bono publico has become a well-established tradition among members of the legal profession. Many

IP PRO BONO RESOURCES

Michigan Patent Pro Bono Project

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Michigan lawyers regard pro bono legal service as a personal endeavor as well as a professional obligation. Among members of the broader society, pro bono is regarded as a noble contribution that is respected, appreciated, and admired.¹

Today, pro bono is needed more than ever. The effects of the recession on Michigan's residents have dramatically increased the number of people in poverty. The number of persons in Michigan who qualify for free legal aid because their annual income is below 125 percent of the federal poverty limit (\$24,738 in 2014 for a family of three) has increased 52.6 percent between 2000 and 2013 to more than 2 million persons.² The State Bar of Michigan recognizes the compelling need for legal assistance to the poor and asks its members to give back to the communities by providing legal services to the poor as only lawyers are qualified to do.

The State Bar Representative Assembly has adopted the Voluntary Standard for Pro Bono Participation, which provides the following:

All active members of the State Bar of Michigan should participate in the direct delivery of pro bono legal services to the poor by annually:

1. Providing representation without charge to a minimum of three low income individuals; or
2. Providing a minimum of thirty hours of representation or services, without charge, to low income individuals or organizations; or
3. Providing a minimum of thirty hours of professional services at no fee or at a reduced fee to persons of limited means or to public service or charitable groups or organizations; or
4. Contributing a minimum of \$300 to not-for-profit programs organized for the purpose of delivering civil legal services to low income individuals or organizations. The minimum recommended contribution level is \$500 per year for those lawyers whose income allows a higher contribution.³

Michigan attorneys have a long tradition of responding to the needs of low-income residents⁴ who cannot afford to pay for legal help in civil matters, and many Michigan attorneys generously give both service and financial support, working together to address the unmet legal needs of the poor. In addition, the Bar has collaborated with non-profit groups to develop new vehicles to deliver needed legal services.

U.S. Patent and Trademark Office pro bono program

The Michigan Patent Pro Bono Project is part of a nationwide network of regional pro bono programs initiated by the U.S. Patent and Trademark Office (USPTO). The USPTO's patent pro bono initiative began in earnest in late 2011 after enactment of the Leahy Smith America Invents Act, which specifically authorized the office to establish pro bono programs throughout the country.⁵ After President Obama's executive action in February 2014 required the USPTO to hire the first-ever national coordinator for patent pro bono, the initiative gained momentum, expanding from a handful of states with programs to all 50 states by August 2015. As of fall 2015, the nationwide effort has resulted in the creation of 19 regional hubs providing pro bono services to residents in every state. Detailed information on all patent pro bono programs is available at <http://www.uspto.gov/probonopatents>.

Recognizing that a single program design would not be effective in every state or region was particularly important to the program's success in achieving nationwide coverage. Rather, the USPTO encouraged each state to find the right type of program to serve each regional hub. Each hub is a partnership between a state or regional IP law professional association and a nonprofit administrative agency. This approach allows an established nonprofit partner to take on the administrative tasks associated with operating a pro bono program, such as screening prospective clients and matching clients with volunteer IP practitioners, without having to build an entirely new administrative infrastructure.

Although the USPTO program operates through a national network, each state or regional program determines its own operating procedures and eligibility rules based on the needs of the population it serves and the priorities identified by the local IP law community. The USPTO pro bono coordinator and a national Pro Bono Advisory Council consisting of representatives of each program facilitates communication between programs and explores solutions to issues common to multiple regional programs, including the development of best practices. For example, attorneys and administrators who developed the Minnesota program have published an extensive

best-practices handbook containing forms and other administrative materials used in that state's program.⁶ Several regional programs have used this handbook as a starting point for designing an appropriate local program.

Although the USPTO's encouragement has been critical to establishing a nationwide network of regional pro bono programs, much work remains if the network is to be effective in addressing the unmet need for patent legal services throughout the U.S. The USPTO will continue to support and provide technical assistance to the regional programs and the Pro Bono Advisory Council. The patent pro bono movement, however, can only thrive with the support of patent practitioners who volunteer, administrators who run efficient programs, and innovators who use the valuable services designed to help independent inventors. In addition, each regional program must find ways to sustain sources of funding and operational viability into the future so it is able to succeed for years to come. As the nation moves toward these lofty goals, it is inevitable that the programs will result in securing patent protection for innovations that would not otherwise have been protected, much less commercialized.

Michigan Patent Pro Bono Project

The Michigan Patent Pro Bono Project is a collaboration of the State Bar of Michigan Intellectual Property Law Section and the SBM Pro Bono Initiative. The project was initiated as a result of discussions involving key members of the patent law community including law firms, solo practitioners, and in-house corporate IP departments. On the basis of those discussions, an ad hoc steering committee consisting of representatives of law firms with IP practices and in-house corporate IP law departments from across the state was created to develop initial operating guidelines and procedures.

One major decision facing the steering committee at the outset was selecting a nonprofit partner to serve as program administrator. The committee selected the SBM Pro Bono Initiative based on several factors. The goals and prospective clients of a Michigan patent pro bono effort were consistent with the initiative's broad mission to advance access to legal services and attorney participation in pro bono. Moreover, the initiative had the administrative expertise and resources to administer a statewide pro bono program. The steering committee also established eligibility guidelines and the range of services that would be available to clients through the program.

A strong partnership between the local patent law community and an effective nonprofit administrator has made the project particularly well-suited to be one of the first regional programs to open its doors to new clients. In addition to an active and collegial patent law community, the

USPTO previously had chosen Michigan as the site of the first patent office located outside the metropolitan Washington, D.C., area. The Elijah J. McCoy Midwest Regional U.S. Patent and Trademark Office officially opened in 2012 in the Stroh Building in the River Place complex in Detroit. Specifically named in the America Invents Act, it was established to increase outreach, improve retention and recruitment of patent examiners, decrease the patent application backlog, and improve examination quality.

The Detroit patent office was the site of the Michigan Patent Pro Bono Project launch in November 2014. This event notified the community of the newly available services and attracted small businesses, incubators, inventors clubs, and other groups that may provide additional valuable services to pro bono clients. The event also drew the attention of members of Congress and their staff to positive economic growth within their districts and states and encouraged local patent attorneys to volunteer for the program.

Michigan residents may apply for assistance from the project by visiting the program's web page on the SBM Intellectual Property Law Section website.⁷ An online form collects basic information necessary to determine program eligibility. The website also contains a detailed description of the program and links to resources concerning the patent process. If the applicant meets financial eligibility guidelines, the Pro Bono Initiative staff collects basic information about the applicant, the invention at issue, and the status of any pending patent application.

Applicants meeting the eligibility guidelines are considered by a screening committee composed of experienced patent practitioners. Currently, the project provides volunteer patent attorneys to assist with two types of projects, selected because they are complex and may be critical to an applicant's ability to obtain patent protection: (1) the preparation of a nonprovisional domestic patent application based on a previously filed provisional application and (2) the preparation of an amendment and response to a nonfinal office action received in a pending nonprovisional application. The program coordinates with other potential sources of legal services, including law school patent clinics, to refer applicants with patent issues falling outside those two needs.

The screening committee considers the client project—including factors such as the relevant technology, the difficulty or time constraints of the issue, and potential conflict of interest concerns—and attempts to match the applicant with a registered patent attorney who has volunteered to participate in the project. Periodic orientation courses across the state introduce the program to patent attorneys and provide training on its procedures, the scope of services it provides, and issues that may arise in representing pro bono clients. The project's panel of volunteer



lawyers currently includes both in-house counsel and lawyers in private practice, including solo practitioners and attorneys in law firms of all sizes.

Since its creation in November 2014, the project has represented low-income Michigan inventors in filing nonprovisional patent applications and responding to USPTO rejections of pending applications. The number of patent attorney volunteers continues to increase and now includes practitioners from across the state.

Creative Many Michigan's Lawyers for the Creative Economy program

In its role as the leading voice for Michigan's creative and design industries, Creative Many Michigan fosters economic growth opportunities for the state's creative economy—nonprofit and for-profit—through research, advocacy/public policy, professional practice programs, networking, and communications. Its mission is to “develop creative people, creative places, and the creative economy for a competitive Michigan.” The creative sector faces both increasing opportunity and increased challenges to provide pro bono services. Rapidly evolving technological advancements are creating new challenges for the creative community seeking to legally protect its intellectual property and creative assets. Through its Lawyers for the Creative Economy program, Creative Many helps bridge the gap between the creative economy and critical legal services that are often overlooked in the context of pro bono assistance.

At its core, Lawyers for the Creative Economy offers a statewide referral service that provides legal assistance for

income-eligible artists and creative practitioners, creative entrepreneurs and businesses, and nonprofit arts and cultural organizations. Those seeking referrals who do not meet income guidelines for pro bono services may receive referrals on a low bono or full fee-bearing basis. In addition, Lawyers for the Creative Economy provides “Protecting Your Practice” seminars; referral orientations for those seeking legal services through the program; CODE networking and dialogue seminars highlighting topical issues at the intersection of the law, arts, and creative industries; and online resources and connections with information about current arts and creative-industries-related legal matters. The program serves individuals, small businesses, and nonprofits in fields including dance, theater, music, literary arts, visual arts, film/video, creative technology, design, and architecture.

Each prospective client goes through an intensive application process to determine eligibility for pro bono assistance and legal readiness. While the most common matters deal with entity selection and copyright protections, attorneys often have the opportunity to become a part of something truly special. Referred matters range from entity selection to international copyright and employment contract negotiation.

While the services Lawyers for the Creative Economy provide are valuable for creative practitioners, attorneys benefit from the program as well. In addition to providing exciting pro bono opportunities, working with the program gives attorneys the opportunity to grow and diversify their practices and build a network of clients and like-minded colleagues. More importantly, Lawyers for the Creative Economy provides discrete referrals that have

been evaluated by program director Shivangee Pandya, a licensed attorney with a background in entity selection, nonprofit creation, and trademarks.

Prospective clients contact the program and go through a rigorous referral process starting with an application packet complete with financial eligibility information and a nominal application fee. Once received, the application is reviewed by the program director and an intake is scheduled. At intake, the program director works with the prospective client to look at the history of the matter to identify the creative practitioner's immediate and long-term needs. Once the process is complete, Lawyers for the Creative Economy reaches out to prospective referral attorneys to determine which is best suited to handle the client's legal matter. Once confirmation is received from the attorney or the pro bono coordinator that the client has cleared a conflicts check, the program provides the client with relevant contact information and steps out of the relationship.

In addition to matters requiring full representation, Lawyers for the Creative Economy offers other volunteer opportunities. Attorneys with limited hours can volunteer at the program's pop-up clinics, two- to three-hour events where attorneys are available for 45-minute consultations with artists. Attorneys can also volunteer to speak at "Protecting Your Practice" events, where they provide basic information on contract drafting, entity selection, and preserving IP rights. Lawyers for the Creative Economy also offers speaking opportunities for attorneys at its CODE events, which bring creative practitioners and attorneys to the same table to talk about emerging issues such as land use, augmented reality, or net neutrality in a cross-disciplinary context.

While there are many ways to volunteer with Lawyers for the Creative Economy, the most common way attorneys contribute is by becoming part of the larger referral bank of transactional attorneys. Working with the program provides attorneys an opportunity to empower the creative community with meaningful representation as well as support and foster culturally rich communities. ■

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Jennifer M. McDowell was the USPTO's first pro bono coordinator. Since September 2015, she has served on a detail to the General Counsel's Office of the United States Trade Representative. Previously, she was an associate counsel for the USPTO Office of the General Counsel and responsible for the legal clearance of patent and trademark rules for the agency. She received her undergraduate degree in finance from the University of Alabama and graduated from The Catholic University of America Columbus School of Law.

Shivangee Pandya is director of LCE services for Creative Many Michigan's Lawyers for the Creative Economy program. Previously, she was an attorney at Counsel Advocacy Law Line, a not-for-profit law firm providing a range of free civil legal services to low-income individuals and seniors. She earned her JD from Wayne State University Law School and bachelor of arts degrees in religion and economics from Kalamazoo College.

Robert G. Mathis is pro bono service counsel for the State Bar of Michigan. He has extensive experience in pro bono and legal services programs, including Legal Services of South Central Michigan and Elder Law of Michigan, Inc. He earned his undergraduate degree in 1992 from the College of Charleston, a juris doctor from Thomas M. Cooley Law School in 2003, and a master of public administration from Western Michigan University in 2008.

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ENDNOTES

1. See SBM, *Pro Bono Manual* <<http://www.michbar.org/programs/probonomanual>>. All websites cited in this article were accessed January 11, 2016.
2. SBM, *Documenting the Justice Gap in Michigan* (Spring 2015 update), p 2 <<http://www.michbar.org/file/programs/atj/pdfs/justicegap.pdf>>.
3. SBM, *Voluntary Pro Bono Standard* <<http://www.michbar.org/programs/atj/voluntarystds>>.
4. The State Bar's Pro Bono Initiative has adopted guidelines that clients eligible for pro bono legal services have incomes at or below 200 percent of federal poverty level and less than \$5,000 in liquid assets.
5. "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." PL 112-29, § 32, 125 Stat 284.
6. Salmela & Privratsky, *Patent Law Pro Bono: A Best Practices Handbook* (2012) <<http://patentlyo.com/media/docs/2012/10/Salmela-Privratsky-Pro-Bono-Best-Practices-Handbook.pdf>>.
7. See SBM, *Michigan Patent Pro Bono Project* <<http://connect.michbar.org/iplaw/patent>>.