

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Trial and Appeal Board Inventor Hour Webinar: **Episode 7** PTAB Pro Bono Program

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UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Program structure
- Participant eligibility
- Volunteer eligibility
- Clearinghouse functions
- Questions

Question/comment submission

To send in questions or comments about the presentation, please email:

PTABInventorHour@uspto.gov

Pro bono program structure

Pro bono

- Definition = “for the public good”
- Refers to services rendered by a professional for free or at a lower cost
- Example usage:
 - The attorneys are representing the client pro bono
 - Pro bono legal services

Pro bono program goals

- For inventor participants:
 - Eliminate financial barriers for legal assistance
 - Aid under-resourced inventors in making effective arguments
- For volunteer attorneys:
 - Provide legal help in their field of legal practice
 - Create new contacts in the community
 - Gain experience in working with clients

Pro bono program scope

- Starting with a pilot of limited scope
 - Beginning with *ex parte* appeals (10 during first year) and later expanding to AIA trials
 - Participant must be the sole inventor; the program will later expand to inventor groups and small businesses
 - Volunteer practitioners must be from law firms and be members of the PTAB Bar Association; the program will later expand to non-members, solo practitioners, and corporate counsel

Roles and responsibilities

- PTAB Bar Association: administer program
- USPTO: support via training

Participant eligibility

Participant eligibility criteria

- Domiciled in U.S.
- Limited financial resources (income less than 300% of federal poverty guidelines)
- Certification of Micro Entity Status in patent application
- Not otherwise represented by a practitioner in the PTAB proceeding
- Request assistance within 1 month from date of Office action at issue
- Able to pay all USPTO fees and ancillary costs associated with the appeal
- Knowledge established by completing a 2-part video training online
 - Part 1: PTAB Pro Bono Program and application process
 - Part 2: Overview of *ex parte* appeals



HHS poverty guidelines for 2022*

Persons in the Household	Poverty Level	300% Poverty
1	\$13,590	\$40,770
2	\$18,310	\$54,930
3	\$23,030	\$69,090
4	\$27,750	\$83,250
5	\$32,470	\$97,410
6	\$37,190	\$111,570
7	\$41,910	\$125,730
8	\$46,630	\$139,890

*Poverty guidelines for the 48 contiguous states and the District of Columbia.
Available at <https://aspe.hhs.gov/topics/poverty-economic-mobility/poverty-guidelines>



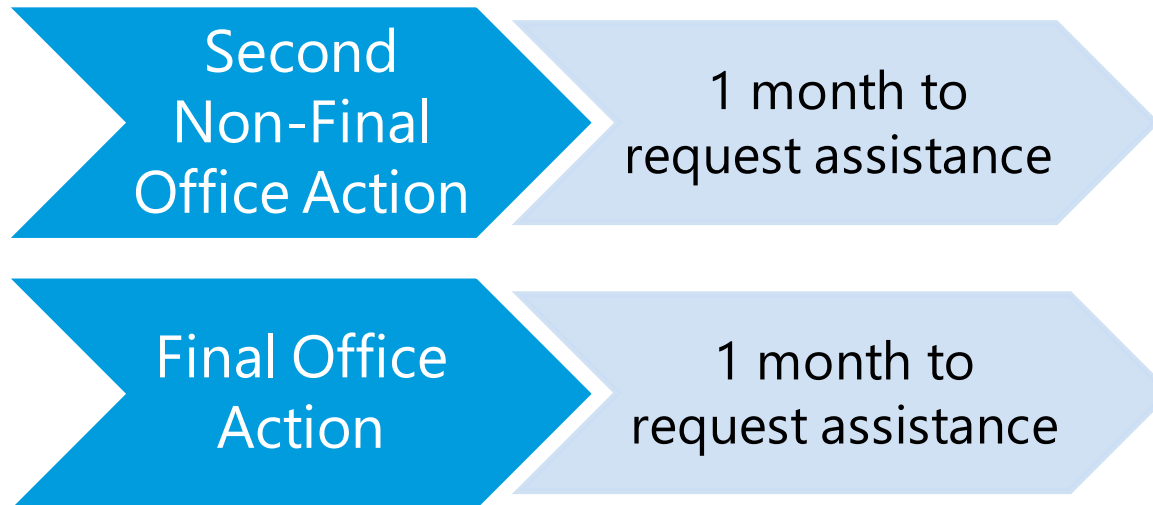
Micro entity status

- Micro entity defines a certain type of patent applicant
- A micro entity:
 - Qualifies as a small entity (a person, small business concern with less than 500 employees, or nonprofit organization);
 - Has not been named as an inventor on more than 4 previously filed patent applications;
 - Did not, in calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding 3 times median household income; and
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which applicable fee is paid, had a gross income exceeding 3 times the median household income.
- Eligible for 75% off most patent fees



Timing for applying

- Request assistance within 1 month from date of Office action at issue
- Examples:



Knowledge

- Training videos regarding
 - PTAB Pro Bono Program (1 hour); and
 - Appeal process (1 hour)

Accessing the training videos

The screenshot shows the USPTO website's Patent Trial and Appeal Board (PTAB) page. The header includes the USPTO logo, navigation links (About Us, Jobs, Contact Us, MyUSPTO), and a search bar. The main navigation bar has tabs for Patents, Trademarks, IP Policy, and Learning and Resources, along with a 'Find It Fast' button. The breadcrumb trail is Home > Patents > Patent Trial and Appeal Board. The page title is 'Patent Trial and Appeal Board'. A paragraph describes the PTAB's functions. Below are three columns of resources:

- Trials and appeals**
 - > Resources and guidance
 - > Trial proceedings
 - > Appeals proceedings
 - > New to PTAB?
 - > Preparing for hearings
 - > Fees
 - > **PTAB Pro Bono**
- Decisions**
 - > All PTAB decision data
 - > AIA daily decisions
 - > Precedential and informative decisions
 - > Precedential Opinion Panel (POP)
- Learn more**
 - > Statistics
 - > Databases and IT tools
 - > Frequently asked questions
 - > Boardside Chat webinar series
 - > PTAB Inventor Hour series
 - > PTAB suggestion box, contact info, and speaker request form
 - > Recent proposals, pilot programs, and final rules
 - > PTAB Judicial Law Clerk Program

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/patent-trial-and-appeal-board-pro-bono-program-independent>

Main menu

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Patent Trial and Appeal Board Pro Bono Program for independent inventors

Inventors that meet certain financial thresholds and other criteria may be eligible for free legal assistance when appearing before the Patent Trial and Appeal Board (PTAB). The PTAB Pro Bono Program matches volunteer patent professionals with financially under-resourced inventors to provide free legal assistance in preparing ex parte appeals to the PTAB. The PTAB Pro Bono Program is administered by the PTAB Bar Association.



Requirements

To be eligible to participate in the PTAB Pro Bono Program, a patent applicant must meet certain eligibility requirements.

- **Location**

You must be domiciled in the United States of America.

- **Income**

Your gross household income should be less than 3 times the [federal poverty level guidelines](#). [↗](#)

- **Status**

You must have a certification of [micro entity status](#) in your patent application that is the subject of the appeal.

- **Timing**

You must apply to the program within 1 month from the date of the office action in which the claims have been twice or finally rejected.

- **Knowledge**

You must demonstrate knowledge of the ex parte appeal process by successfully completing a video training course. The video training course involves two videos. The first video explains how the PTAB Pro Bono Program works (coming soon). The second video walks through the [ex parte appeal process](#). You must complete both videos.



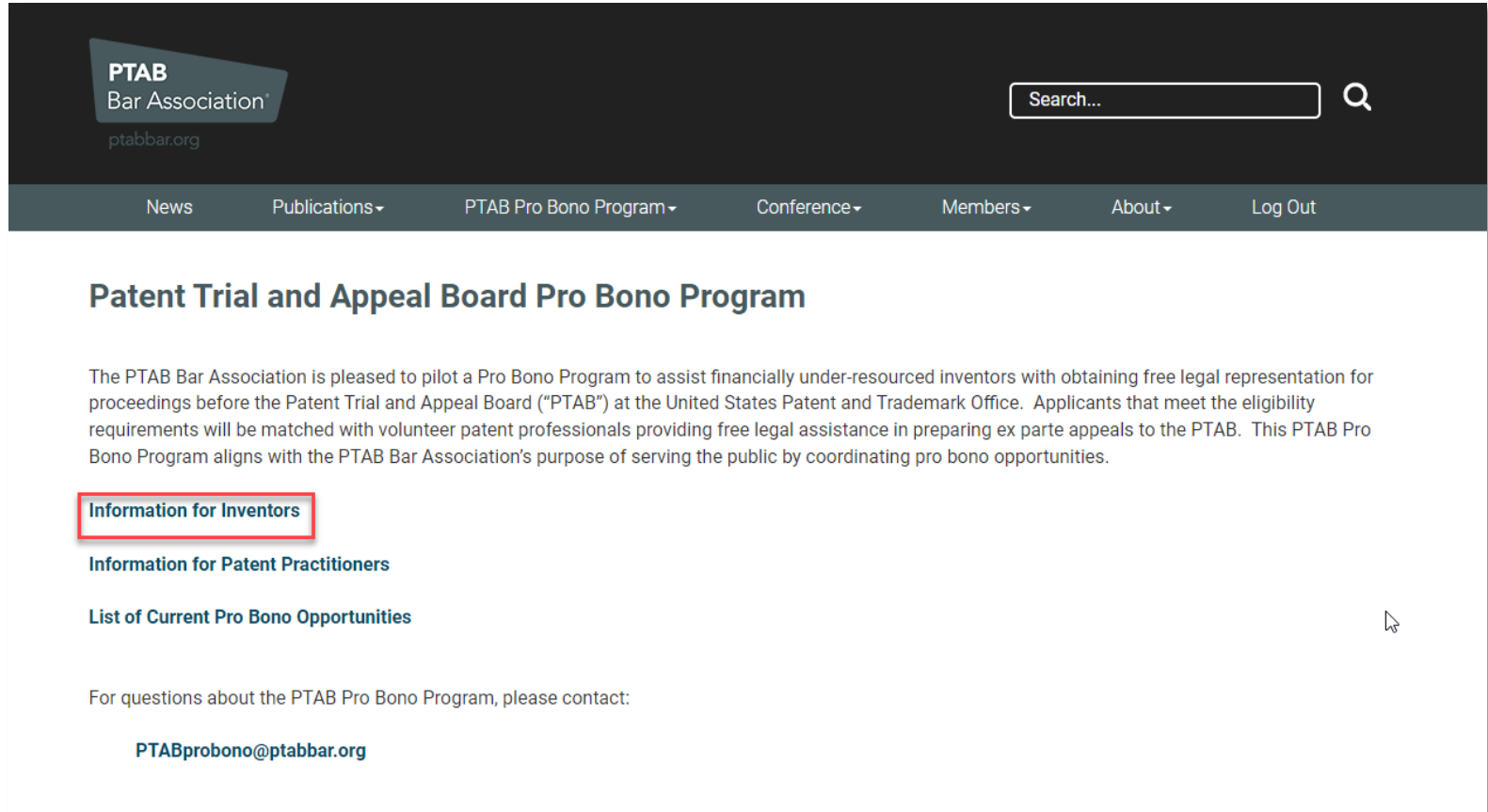
How to apply

- Complete the inventor application form available on the PTAB Bar Association webpage
 - Personal information
 - Demographic information
 - Financial information
 - Patent pro bono program
 - Knowledge
 - Invention/appeal information
 - Micro entity certification
 - Disclosure
 - Electronic signature and date
- Provide all required information to avoid any processing delays



Step 1: Access the inventor application form

ptabbar.org



The screenshot shows the PTAB Bar Association website. The header includes the PTAB Bar Association logo and a search bar. The navigation menu contains links for News, Publications, PTAB Pro Bono Program, Conference, Members, About, and Log Out. The main content area is titled "Patent Trial and Appeal Board Pro Bono Program" and contains a paragraph describing the program. Below the paragraph are three links: "Information for Inventors" (highlighted with a red box), "Information for Patent Practitioners", and "List of Current Pro Bono Opportunities". At the bottom, there is a contact information section with the email address PTABprobono@ptabbar.org.

PTAB
Bar Association
ptabbar.org

Search...

News Publications PTAB Pro Bono Program Conference Members About Log Out

Patent Trial and Appeal Board Pro Bono Program

The PTAB Bar Association is pleased to pilot a Pro Bono Program to assist financially under-resourced inventors with obtaining free legal representation for proceedings before the Patent Trial and Appeal Board ("PTAB") at the United States Patent and Trademark Office. Applicants that meet the eligibility requirements will be matched with volunteer patent professionals providing free legal assistance in preparing ex parte appeals to the PTAB. This PTAB Pro Bono Program aligns with the PTAB Bar Association's purpose of serving the public by coordinating pro bono opportunities.

Information for Inventors

Information for Patent Practitioners

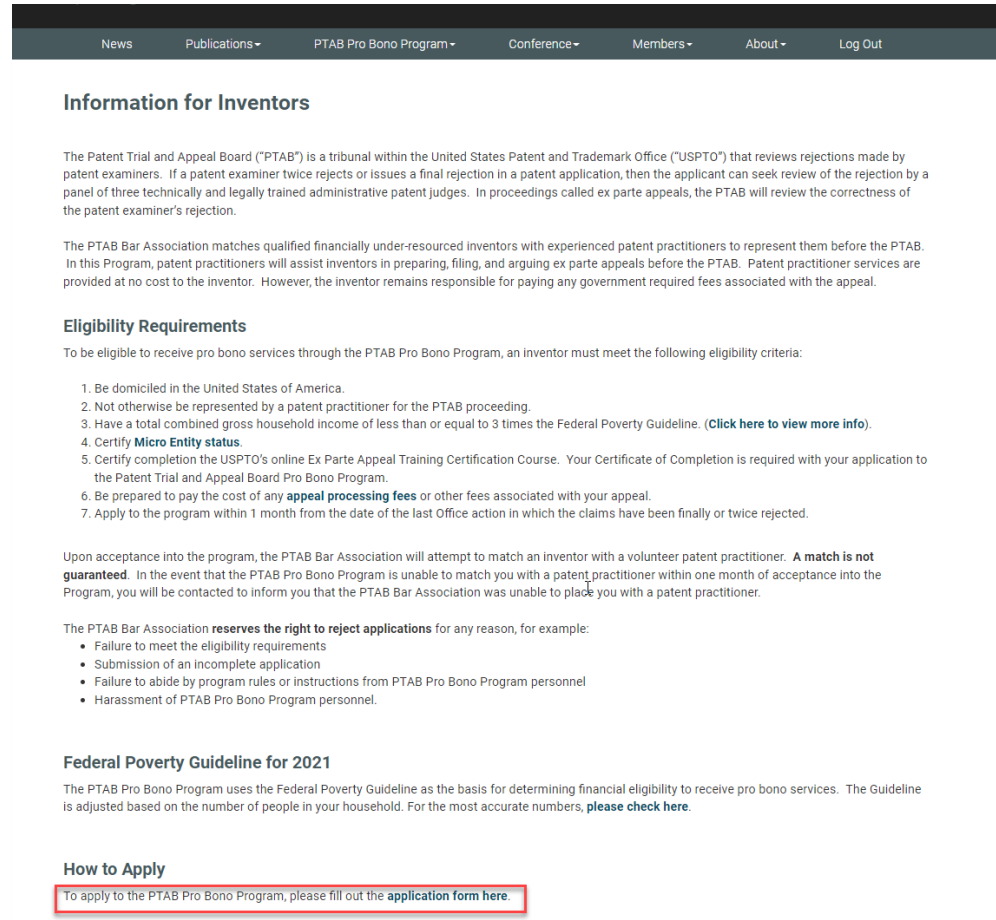
List of Current Pro Bono Opportunities

For questions about the PTAB Pro Bono Program, please contact:

PTABprobono@ptabbar.org

Step 2: Access the inventor application form

ptabbar.org



The screenshot shows the website's navigation bar with links for News, Publications, PTAB Pro Bono Program, Conference, Members, About, and Log Out. The main content area is titled "Information for Inventors" and provides details about the PTAB, the PTAB Bar Association's Pro Bono Program, eligibility requirements, and how to apply. A red box highlights the "application form here" link in the "How to Apply" section.

News Publications - PTAB Pro Bono Program - Conference - Members - About - Log Out

Information for Inventors

The Patent Trial and Appeal Board ("PTAB") is a tribunal within the United States Patent and Trademark Office ("USPTO") that reviews rejections made by patent examiners. If a patent examiner twice rejects or issues a final rejection in a patent application, then the applicant can seek review of the rejection by a panel of three technically and legally trained administrative patent judges. In proceedings called ex parte appeals, the PTAB will review the correctness of the patent examiner's rejection.

The PTAB Bar Association matches qualified financially under-resourced inventors with experienced patent practitioners to represent them before the PTAB. In this Program, patent practitioners will assist inventors in preparing, filing, and arguing ex parte appeals before the PTAB. Patent practitioner services are provided at no cost to the inventor. However, the inventor remains responsible for paying any government required fees associated with the appeal.

Eligibility Requirements

To be eligible to receive pro bono services through the PTAB Pro Bono Program, an inventor must meet the following eligibility criteria:

1. Be domiciled in the United States of America.
2. Not otherwise be represented by a patent practitioner for the PTAB proceeding.
3. Have a total combined gross household income of less than or equal to 3 times the Federal Poverty Guideline. ([Click here to view more info](#)).
4. Certify **Micro Entity status**.
5. Certify completion the USPTO's online Ex Parte Appeal Training Certification Course. Your Certificate of Completion is required with your application to the Patent Trial and Appeal Board Pro Bono Program.
6. Be prepared to pay the cost of any **appeal processing fees** or other fees associated with your appeal.
7. Apply to the program within 1 month from the date of the last Office action in which the claims have been finally or twice rejected.

Upon acceptance into the program, the PTAB Bar Association will attempt to match an inventor with a volunteer patent practitioner. **A match is not guaranteed.** In the event that the PTAB Pro Bono Program is unable to match you with a patent practitioner within one month of acceptance into the program, you will be contacted to inform you that the PTAB Bar Association was unable to place you with a patent practitioner.

The PTAB Bar Association **reserves the right to reject applications** for any reason, for example:

- Failure to meet the eligibility requirements
- Submission of an incomplete application
- Failure to abide by program rules or instructions from PTAB Pro Bono Program personnel
- Harassment of PTAB Pro Bono Program personnel.

Federal Poverty Guideline for 2021

The PTAB Pro Bono Program uses the Federal Poverty Guideline as the basis for determining financial eligibility to receive pro bono services. The Guideline is adjusted based on the number of people in your household. For the most accurate numbers, [please check here](#).

How to Apply

To apply to the PTAB Pro Bono Program, please fill out the [application form here](#).

Step 3: Access the inventor application form

ptabbar.org

Thank you for your interest. We expect to start taking applications on June 1, 2022.

* - indicates required fields

Submission Type
Select an Option

Personal Information

Salutation *
Select an Option

First Name *
[Text Field]

Middle Name *
[Text Field]

Last Name *
[Text Field]

Phone *
[Text Field]

Email *
[Text Field]

Address *
[Text Field]

Address 2
[Text Field]

City *
[Text Field]

State *
[Text Field]

Zip *
[Text Field]

Demographic Data

Gender *
Select an Option

Ethnicity *
Select an Option

Race *
Select an Option

Veteran Status *
Select an Option

Financial Information

Do you have a household income of less than 300% (3x) federal poverty guidelines? *
Select an Option

<https://www.ehpa.gov/topics/poverty-economic-mobility/poverty-guidelines>

* The PTAB Bar Association administrator may ask you to provide proof of income such as tax payments, disability benefits, Medicaid information, etc.

Patent Pro Bono Program

Has this application for appeal assistance been prosecuted by a volunteer attorney? *
Select an Option

If yes, please provide *

Name of Regional Program
[Text Field]

Patent Attorney/Agent Name
[Text Field]

Patent Attorney/Agent Registration Number
[Text Field]

* The PTAB Bar Association may reach out to 1) the prior regional program to confirm it considers the application ripe for appeal.

Knowledge

You must demonstrate knowledge of the ex parte appeal process by successfully completing the training course offered by the USPTO. **Have you completed the training course offered by the USPTO? ***
Select an Option

Invention / Appeal Information

Title of Invention *
[Text Field]

Basic Subject Area *
Bio/Lifesciences
Ornamental Design
Mechanical
Chemical
Electrical/Computer

select all that apply

Application No. *
[Text Field]

Certification of Micro Entity Status

Is there a Certification of Micro Entity Status in your application? *
Select an Option

Status of Application *
Select an Option

Date of Last Office Action *
[Text Field]

Briefly describe the basis for appeal (please limit explanation to what you can type in this box)
[Text Area]

Disclosures

By submitting my electronic signature below, and by submitting this application, I am making the following representations:

1. The information provided by me in this application is, to the best of my knowledge, complete and accurate.
2. I understand that submitting false or misleading information may result in delay or denial of services.
3. I understand that misrepresenting the financial information used to establish my qualification for micro-entity status to the United States Patent and Trademark Office may constitute fraud, and could result in the invalidation of the patent or application.
4. I will notify the PTAB Bar Association program if any of the information in this application materially changes prior to placement with an attorney, especially if any inventor's income should suddenly increase.
5. I have not shared any confidential information in filing out this application with the PTAB Bar Association.
6. I understand that continuation in the program is at the discretion of the program administrator, and that filling out this application does not entitle me to any services.
7. I agree and understand that this application does not create an attorney-client relationship between any named inventor or myself and any individual attorney or the PTAB Bar Association.
8. I understand that the matter may be placed with either a patent attorney or patent agent, and that this person's representation may be limited to the filing of a pre-appeal and Notice of Appeal for the invention referenced in this application.
9. I understand that PTAB Bar Association's scope of services are limited to the placement of cases for filing patent appeals and that if I have another legal issue prior to placement with a patent attorney/agent, PTAB Bar Association will not handle the placement of these issues. I further understand that while my assigned attorney may take on these additional matters, they may charge additional fees for these services.
10. I understand that the applicant remains responsible for the payment of all necessary governmental fees and ancillary fees when necessary.

Electronic Signature and Date Stamp

Please sign below using your mouse or your finger on a touchscreen device


[Signature Field]

Signature Date *
04/12/2022

[Clear]

After submitting this application, the program administrator will review the details and will attempt to contact you within a reasonable period of time. Please only call the office or e-mail for confirmation if you do not receive an automated confirmation e-mail. Keep in mind that the office is usually closed on and around major holidays, and delays are likely during these periods of the year. Please review your application carefully before submitting. Submitting your application multiple times will cause unnecessary delays. We ask you to please be certain of your responses before pressing the submit button. If you need to make material changes after hitting submit, please e-mail us at PTABprobono@ptabbar.org, but DO NOT submit and then go back to make changes and submit again.

I'm not a robot

 hCAPTCHA
Privacy - Terms

Submit >>

Identify examiner error

Certification of Micro Entity Status

Is there a Certification of Micro Entity Status in your application? *

Status of Application *

Date of Last Office Action *

Briefly describe the basis for appeal (please limit explanation to what you believe to be the error in the broadest independent claim rejected by the Examiner) *

Examiner error = appealable issue(s)

- Not every disagreement with the examiner is something that may be appealed.
- If the form of the claim (as distinguished from its substance) is improper, an "objection" is made.
- The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection."
- The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the PTAB, while an objection, if persisted, may be reviewed only by way of petition to the Director of the USPTO.

Examiner error = appealable issue(s)

- This Program only provides assistance to inventors with appealable issues.
- Please describe what you believe the examiner did wrong in deciding that the subject matter of your claims is not eligible for patent protection.
- For example, do you believe the examiner misunderstood your claims or the prior art applied to your claims.
- There are many appealable issues. Please describe your issue in enough detail for a potential attorney to understand what you believe to be the problem with the examiner's rejection.
- Please be careful not to reveal anything that you believe to be confidential.

After application submission

- Please be patient
- The Clearinghouse will review the application for completeness
- The Clearinghouse determines if the application is eligible for assistance
- The Clearinghouse will reach out

Question/comment submission

To send in questions or comments about the presentation, please email:

PTABInventorHour@uspto.gov

Knowledge check

Question 1: true or false?

Inventors do not pay anything if they are part of the pro bono program.

Question 2: true or false?

There is a time limit on when an inventor can apply for pro bono assistance.

Question 3: true or false?

Inventors are not required to complete the training videos before submitting a request for pro bono assistance.

Volunteer eligibility

Volunteer patent practitioner qualifications

- Be a U.S. licensed attorney or patent agent
- Have experience in the technology and proceeding type
- Provide malpractice insurance
- Agree to no fee for services
- Provide a representation agreement

After volunteer form submission

- Clearinghouse will enter volunteer information into database
- Clearinghouse will contact all unmatched volunteers regarding new inventor applications
- Volunteer agrees to representation after:
 - Evaluating case; and
 - Completing conflict check
- Once matched, volunteer will be removed from database for period of ongoing representation

Clearinghouse functions

Clearinghouse functions

- Managing the intake of applications
- Reviewing/screening applications
- Assessing applications through an intake/initial screening process
- Coordinating recruitment and assessment of volunteer attorneys
- Providing orientation and guidance to newly recruited attorneys
- Matching volunteer attorneys with accepted applicants to the Pilot Program
- Keeping accurate records of volunteer attorneys and applicants/parties

Matching

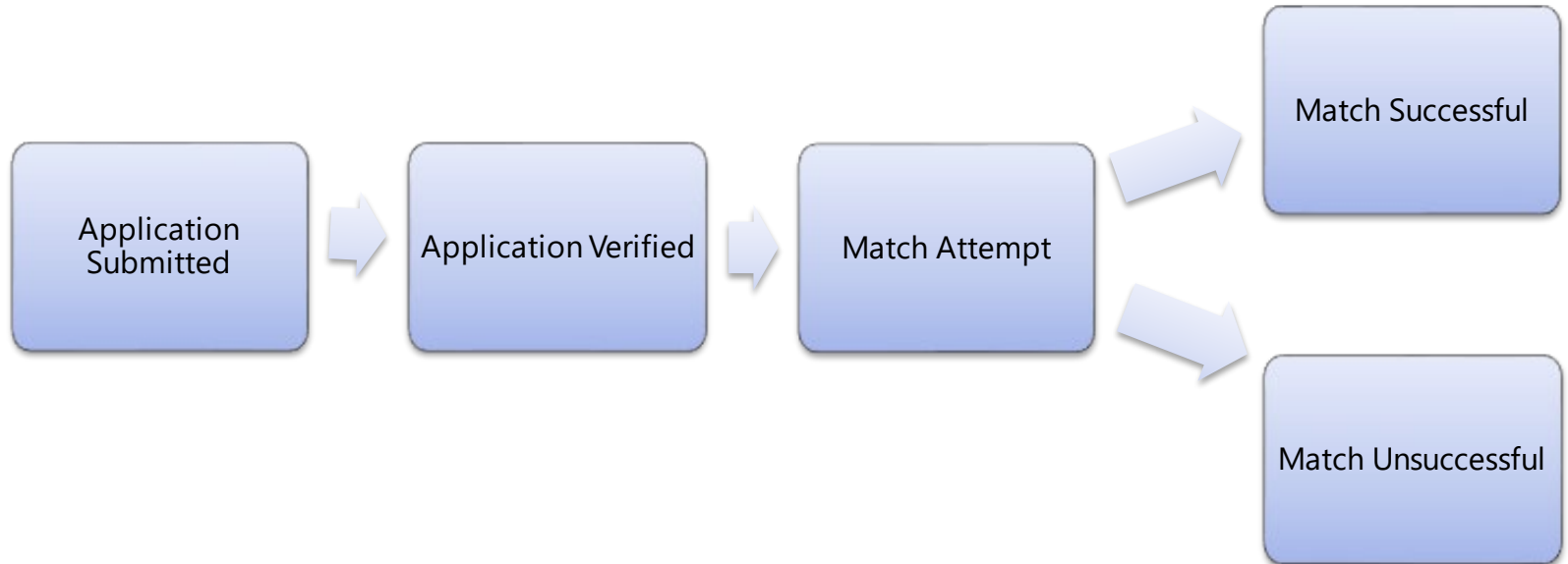
- Conducted by PTAB Bar Association Clearinghouse
- Clearinghouse reviews application for completeness
- Clearinghouse contacts applicant prior to matching to verify applicant
- Placement requests are sent to all volunteers via email

Matching (cont.)

- Volunteers respond to email request if interested
- Clearinghouse will connect volunteer with inventor via email

Timing for matching

- Placement occurs less than one month after applicant has been qualified for placement



After matching

- Clearinghouse ends involvement once matching is made
- Scope of representation is for PTAB proceeding only through a Board decision (but not rehearing or appeal to the federal courts)
- Volunteer will provide inventor with representation agreement and termination letter once representation is complete

Question/comment submission

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PTABInventorHour@uspto.gov

Knowledge check

Question 4: true or false?

If you believe the examiner did something wrong then you can always file an appeal.

Question 5: true or false?

All inventors who apply for assistance will be matched with a volunteer attorney.

Question 6: true or false?

When an inventor is matched with a volunteer, the scope of representation is limited to the proceeding before the Board through a Board decision.

Successful matches

Participant tips

- Fill out application completely
- Be responsive to volunteer attorney throughout process
- Be patient; process takes time and Board will not issue a decision overnight

Contact info

- PTABprobono@uspto.gov
- PTABprobono@ptabbar.org

Question/comment submission

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PTABInventorHour@uspto.gov

Future Inventor Hour webinars

- **May 26, 2022**, noon to 1 p.m. ET
- June 23, 2022 (same time)



Thank You



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