Not Mere Litigation:  
Using the ITC When Infringing Products Have Already Been Imported or Not All of the Importing Competitors are Known

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“A Section 337 investigation is not mere litigation among private parties.”

Most readers of this publication are aware of Section 337, a trade statute intended to deal with unfair trade practices, including IP infringement. It is well known that the US International Trade Commission in Washington, DC can issue an order directing US Customs to block all imports of goods found to infringe by companies named in an ITC complaint: a limited exclusion order. What if, however, the infringers have imported thousands of infringing products already (beyond the reach of Customs) and are selling them from warehouses inside the United States? Also, what if only some of the current importers are known or other companies start importing such products after the ITC investigation is finished? The remedies for such situations are less commonly known. This article will address those orders that cover products that have already been imported (cease and desist orders) and those orders that bar even the products of unknown current or future infringers (general exclusion orders).

Background

An intellectual property owner seeking to enforce its rights (a complainant in ITC parlance) may find a Section 337 action attractive for several reasons, including the Commission’s in rem jurisdictional power. Since its jurisdiction is derived from the imported articles, and not the presence of the parties or the performance of unfair acts within the United States, the Commission is empowered to address infringement by multiple parties and products in a single forum, without distracting and expensive disputes over jurisdiction or service, especially over foreign parties. Additionally, once an investigation begins, no party may transfer the case out of the ITC to some district court that the party believes may be better or more convenient for it. Moreover, this in rem jurisdiction permits the Commission to provide unique

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View from the Chair

“Whatever you are, be a good one.” – Abraham Lincoln

Simple words to live by from a wise man. As lawyers, especially those who specialize in the ever-evolving area of intellectual property, a key component to being good at what we do is staying current and being knowledgeable about changes in intellectual property law. I believe that another important factor that contributes to our success is interacting with and learning from other practitioners. As wise woman noted,1 we can’t live (or practice law) long enough to experience everything ourselves. Regardless of whether we have just graduated from law school, have practiced for years or are nearing the end of our legal careers, we can always learn something (and usually quite a bit) from others. In that spirit, one of the key missions of the Intellectual Property Law Council is to provide quality continuing IP legal education programs to our members, while at the same time offering opportunities for our members to network and reconnect with each other. The Council plans the annual Spring Seminar and IP Institute with these objectives in mind. In simple terms, our goal is to help our members be the best IP lawyers they can be and, hopefully, have a little fun in the process.

Since last fall, the Council has been hard at work planning quality programs for 2016. This year, the Spring Seminar will be held on March 14, 2016 at the Kellogg Center on the campus of Michigan State University in East Lansing (Go Green!). The Seminar will include a number of practical sessions planned to benefit your practice including key considerations when sending and responding to IP cease and desist letters, and the “Top Ten-ish” IP licensing and agreement mistakes. We are also honored to have USPTO Commissioner for Trademarks, Mary Boney Denison and USPTO Patent Reform Coordinator, Janet Gongola provide updates from the USPTO. Our lunch speaker will be FBI Investigator, Chris A. Bartolo who will provide tips on how to protect against and successfully prosecute IP theft cases. Our seminar will also include sessions on functional claiming and patent eligibility, design patent law changes, enforcing unregistrable trademarks and a unique in-house perspective from J.J. Kramer, Senior Director, Legal counsel – IP, Abercrombie & Fitch. Please do not miss what is sure to be an excellent program! You can find additional information regarding the seminar and register online at www.icle.org/springip.

In July, we will return to Mackinac Island. The 42nd Intellectual Property Law Institute will take place at the Grand Hotel on July 21-23, 2016. Join us for annual updates from distinguished national speakers and discuss them over cocktails while enjoying the view from the Grand’s majestic front porch. We are also very excited that the 42nd Institute will include “The Judge’s Perspective on IP Litigation” presented by the Honorable Kara F. Stoll, US Court of Appeals for the Federal Court, and “TTAB Views from the Bench” presented by the Honorable Gerald F. Rogers, USPTO, Trademark Trial and Appeal Board Chief Judge. Further information and registration for the IP Law Institute are now available at www.icle.org/summerip.

We truly look forward to meeting with and learning from all of you this year. So, please, mark your calendars and join us in East Lansing and Mackinac in 2016! Please also let me or any of our Council members know if you have any suggestions for future programs or other Section initiatives.

Kristen I. Spano,
Chair, Intellectual Property Section

Endnote
1 “Learn from the mistakes of others. You can’t live long enough to make them all yourself.” – Eleanor Roosevelt

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remedies, including orders prohibiting entry of infringing articles (or other articles that harm a domestic industry) into the United States. These orders are enforced by Customs officials at all ports of entry. The Commission may also issue cease and desist orders against products already imported and held in inventory in the United States. The availability of these powerful remedies is a major factor encouraging complainants to seek relief at the Commission, instead of, or in addition to, district courts.¹

Section 337 requires that the Commission make its determination as to a violation at the “earliest practicable time.” The Commission typically sets the “target date” for concluding an investigation at 15-16 months from institution. The target date is not merely aspirational; absent unusual circumstances, the Commission typically completes its investigation by the target date set by the ITC. Generally, if a fifteen-month target date has been set, a bench trial before an Administrative Law Judge (ALJ) is conducted within about eight or nine months, and the ALJ’s decision will issue within approximately ten-to-eleven months.

The Figure One shows a typical timeline for ITC investigations.

The ALJs at the ITC all have extensive trial experience, are familiar with intellectual property litigation, and have handled numerous Section 337 investigations. Discovery disputes are resolved rapidly, and the ALJs are particularly experienced with foreign discovery difficulties that may arise.² To this end, protective orders for confidential business information are routinely issued and steadfastly enforced in Section 337 proceedings, enabling counsel and experts for the parties to have access to confidential information of the parties.

Before addressing these forms of relief available from the ITC, an overview of Section 337 investigations and the process followed during investigations is useful.³ First, as the quote above indicates, Section 337 investigations are quite different from patent litigation in federal district courts. For example, an ITC complainant must establish that an industry in the United States relating to the articles protected by the patent or other IP right exists or is in the process of being established. This “domestic industry” requirement arises from the ITC’s role as an international trade remedy forum and has no counterpart in district court litigation. The chart above summarizes some additional differences.

**ITC v. District Court**

When the Commission starts an investigation (as it almost always does), a notice is published in the Federal Register notifying the public of the investigation, and the investigation is assigned to an ALJ. If temporary relief (analogous to a preliminary injunction) is sought, the proceedings must be concluded within 90 days after the ITC starts an investigation, unless the case is more complicated and the Commission grants a 60-day extension. For permanent relief, a target date of 15-16 months is usually set for the Commission’s determination.

The ALJ oversees the investigation and discovery under the provisions of the Administrative Procedure Act and the Commission’s Rules. Additionally, each ALJ has his or her own Ground Rules. Bench trials are held before the ALJ. The ALJ considers the evidence presented at the hearing as well as extensive pre- and post-hearing briefs submitted by the parties. The ALJ then prepares an Initial Determination (ID) as to whether there has been a violation of Section 337 and
a Recommended Determination (RD) recommending an appropriate remedy should the Commission find a violation. The ID includes the ALJ’s findings of fact and conclusions of law. The ID is generally issued four months before the target date for the investigation (usually about one year after institution). The parties have ten days after the ALJ issues the ID to petition the ITC to review any aspect of the ID with which they disagree or else they waive their rights to appeal to the Federal Circuit.

The Commission may decline to review the ALJ’s determinations in whole or in part, in which case the unreviewed portions of the ID become the official determination of the Commission. If the Commission does review the ALJ’s determination, it usually directs the parties to submit additional briefing on particular issues under review before issuing its final determination on or before the target date. Commission determinations finding a violation of Section 337 are subject to a sixty-day review period by the President (acting through the US Trade Representative), during which time any imports must be made under bond posted by the respondent(s). A President may disapprove the determination and proposed remedy for policy reasons, in which case the Commission determination will have no force or effect. After the close of the review period, the Commission’s determination becomes final. Final determinations may be appealed to the Federal Circuit.

The process at the ITC can be grueling and unfamiliar, the rewards that the relief obtained can provide may make it worth the effort. We now discuss two of the lesser known forms of relief that the ITC provides.

**Forms of Relief**

The most commonly issued ITC remedy is an order directing US Customs to bar entry of articles from being imported into the United States. Indeed, Section 337 requires the Commission to issue an exclusion order upon the finding of a Section 337 violation unless the effects of one of the public interest factors set forth in the statute outweigh such a remedy. See *Spansion, Inc. v. Int’l Trade Comm’n*, 629 F.3d 1331, 1358 (Fed. Cir. 2010). Exclusion orders apply only to goods imported after the Commission’s determination, and do not cover goods imported before that time. In patent cases, an exclusion order usually lasts until the patent expires. In non-patent cases the exclusion order may remain in force indefinitely. In some cases involving common law trademark infringement and trade dress misappropriation, the Commission has not set expiration dates for the exclusion orders, but has required the complainants to demonstrate their ongoing use of the trade dress or trademark at issue. See, e.g., *Certain Novelty Glasses, Inv. No. 337-TA-55, Commission Determination and Order* (July 11, 1979).
found in violation of Section 337 (limited exclusion order). Downstream products of companies not named in an ITC complaint that contain or incorporate the infringing product are not subject to limited exclusion orders. See Kyocera Wireless Corp. v. Int’l Trade Commission, 545 F.3d 1340, 1345 (Fed. Cir. 2008) (“[T]he ITC has no statutory authority to issue [a limited exclusion order] against downstream products of non-respondents.”).

The Commission may consider the administrative burden of enforcing exclusion orders when fashioning a remedy. For example, in Cigarettes and Lens-Fitted Film Packages, which involved products typically carried into the country by travelers, the Commission issued exclusion orders with a “personal use exception” exempting non-commercial quantities of goods imported by individuals. See General Exclusion Order, Certain Lens-Fitted Film Packages, Inv. No. 337-TA-406 (June 2, 1999); General Exclusion Order, Certain Cigarettes and Packaging Thereof, Inv. No. 337-TA-424 (Oct. 16, 2000). These exceptions greatly reduced the administrative burden on Customs in enforcing the exclusion order. The Commission also stayed the implementation of its limited exclusion order for four months in one investigation involving cellular telephones in order to give carriers time to obtain non-infringing telephones. Limited Exclusion Order, Certain Personal Data and Mobile Communication Devices and Related Software, Inv. No. 337-TA-710 (Dec. 19, 2011).

During the Presidential review period, any imports made must be under bond. The amount of bond is determined by the Commission, and is designed to offset the respondent’s competitive advantage from continued unfair acts and to prevent the respondent from undercutting complainant’s prices. The burden is on the complainant to justify the appropriate bond rate, and the Commission has set bonds anywhere from no bond at all, in Certain Multiple Mode Outdoor Grills and Parts Thereof, Inv. No. 337-TA-895, Comm’n Op. at 60-62 (Feb. 20, 2015), to 100 percent of entered value and even higher. See, e.g., Certain Liquid Crystal Display Modules, Products Containing Same, and Method: Using the Same, Inv. No. 337-TA-634, Comm’n Op. at 6-7 (Nov. 24, 2009).

Unless the President disapproves the remedial orders, these bonds are forfeited to the complainant (after motions practice before the ITC).

Next, we look at two of the lesser known remedies that the ITC may enter. These address situations where the products have already been imported (and are beyond the reach of Customs) and those where only some of the importers are known to the IP rights holder or where infringing imports start after an ITC exclusion order issues.

**Cease & Desist Orders**

The Commission may also issue a cease and desist order, either alone or in conjunction with an exclusion order. Cease and desist orders are directed to a specific respondent and apply only to actions or conduct inside the United States. Examples of actions prohibited under cease and desist orders include marketing infringing goods, selling or otherwise commercializing infringing products in inventory, and other anti-competitive conduct. In some cases, cease and desist orders may apply to goods imported before a Commission determination of a violation. For example, these orders pertain to infringing goods held in inventory in the United States. The Commission has generally declined to issue cease and desist orders against importers that do not have commercially significant inventory in the United States, or against companies that arrange for shipments but do not directly import products. This practice was affirmed by the Federal Circuit in Fuji Photo Film Co. v. Int’l Trade Commission, 386 F.3d 1095 (Fed. Cir. 2004). There is, however, no requirement in the statute itself that requires a finding of commercially significant inventory before such an order can be issued.

In some circumstances, a cease and desist order may be more effective than an exclusion order in providing a remedy to a complainant. As discussed below, the penalties for violating a cease and desist order are quite severe, and companies may fear such an order even more than an exclusion order. Moreover, the opportunity to obtain cease and desist orders may prevent a respondent from stockpiling large quantities of the accused products in the US before an exclusion order is issued. In addition, while an exclusion order may be limited to imported components that infringe or otherwise violate Section 337, a cease and desist order may reach products incorporating those components, even if the products are assembled in the US.

Cease and desist orders are enforced by the Commission itself. If a respondent does not comply with a cease and desist order, the Commission can bring a civil action to recover a fine, which helps the Commission ensure compliance with its orders. The fine is the greater of either $100,000 per day for each day on which a violation occurs, or twice the domestic value of the imported items. The Commission has exercised this power to impose substantial fines in several cases, including an $11 million fine in Ink Cartridges and Components Thereof and a $6 million fine in Two-Way Global Satellite Communication Devices, Systems and Components Thereof. Both decisions were affirmed by the Federal Circuit. Ninestar Tech. Co., Ltd. v. Int’l Trade Commission, 667 F.3d 1373, 1380 (Fed. Cir. 2012); DeLorme Pub’g Co., Inc. v. Int’l Trade Commission, 805 F.3d 1328, 1336 (Fed. Cir. 2015).

For those instances where products have been imported before an exclusion order has issued or products that somehow get through Customs after an exclusion order has issued, the cease and desist order, with its substantial penalties, can be a highly effective remedy.

**General Exclusion Orders**

For those situations where only some of the importers are known or companies begin importing infringing products after
an exclusion order has issued, the general exclusion order can be very effective. Under such orders, Customs is directed to seize all products that infringe certain claims of certain patents. There is no restriction on the companies affected by such an order. In fact, there have been instances where a company’s products have been stopped by Customs when the company had no knowledge that there had ever been an ITC investigation or orders entered.

General exclusion orders are entered less often than limited orders because such a broad order may stifle legitimate trade, and, in many cases, a limited exclusion order may adequately protect the domestic industry. The Commission has determined, however, that general exclusion orders are appropriate where there is a “pattern of unauthorized use” by respondents, it is particularly easy to avoid a limited exclusion order, or where it is difficult to identify the source of the infringing products. Recent investigations in which general exclusion orders were issued include Certain Cases for Portable Electronic Devices, Inv. No. 337-TA-867/861, Certain Toner Cartridges and Components Thereof, Inv. No. 337-TA-829, and Certain LED Photographic Lighting Devices and Components Thereof, Inv. No. 337-TA-804.

For instances where only some of the importers of infringing products are known, a general exclusion order can be highly effective against such importers who are identified later. (At that point, the IP rights holder can work directly with US Customs officials to ensure the general exclusion order is enforced against such companies.) As noted, the general exclusion order will apply to those products whose makers may never even have known of a proceeding until their goods are stopped by Customs. At that point, those makers are quickly given actual notice by puzzled, impatient customers awaiting delivery of the products.

Conclusion

A Section 337 proceeding is a uniquely powerful tool for enforcing intellectual property rights against infringing importers. The Commission’s in rem jurisdiction allows for remedies such as exclusion orders, enforced by Customs officials directly at ports of entry, unlike injunctions available (where the eBay conditions are met) from district courts. Furthermore, a complainant must diligently work with Customs ex parte during the enforcement stage, to identify infringing products, and to ensure that infringing products are not allowed into the stream of commerce here. These opportunities to work with Customs permit a more customized remedy than is available from district courts. When new companies import infringing goods after the ITC investigation concludes, an IP owner with a general exclusion order need only work with Customs to stop such products – there is no need for expensive litigation again.

Section 337 intellectual property litigation affords distinct opportunities to rid the United States market of infringing goods (or at least to reduce them). IP owners who work closely with the Commission and Customs to obtain and enforce ITC orders can augment the enforcement efforts and make an already unique and forceful remedy even more effective.

Endnotes

1 Monetary damages are not available at the ITC. In order to seek such damages, intellectual property owners often file suit in federal district court simultaneously with filing a complaint at the Commission. If requested by the defendant/respondent, and where the allegations are the same, district court actions are stayed while the ITC conducts its investigation and until all appeals are resolved. In re Princo Corp., 478 F.3d 1345, 1357 (Fed. Cir. 2007).

2 Discovery deadlines are much shorter at the ITC than in district court – responses to discovery requests and motions are due typically in ten or fewer calendar days.

3 Given the expedited schedule of ITC investigations, the thirty days between the time a complaint is filed and the Commission decides whether or not to institute an investigation is a critical time for all parties to undertake many important tasks. For more information on actions to be taken before an investigation starts, see the authors’ series of articles entitled The Calm Before the Storm, available at www.steptoe.com/publications-11008.html.

4 Such a disapproval has happened only once in the last in the last two decades.

5 As discussed below, infringing products that were imported before the ITC’s Final Determination are subject to seizure under a cease and desist order that can also be entered by the ITC.
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Protecting IP in an Agile Software Development Environment

By Christopher George & Raymond Millien

“Gone are the days of three-year $50 million software programs. Now, I want returns on investment within three to five months. We need to change the way we develop software so that we can get things out into the market quicker.”

—Trevor Mather, Former CEO of ThoughtWorks

Over the last decade, there has been a movement among the software developer community to employ some form of “agile development” rather than the traditional software development methodology. The belief is that these agile methodologies lead to higher quality software and faster development cycles. More recently, the implementation of agile software development has transitioned not only from small startups to large companies, but also from enterprises developing non-critical, consumer apps to those developing software for medical, aviation, military, and financial systems, where the presence of errors pose high human or economic risk. With these transitions, intellectual property (IP) law practitioners must adopt their traditional lawyering approaches to capturing and securing IP (especially patent) rights. A failure to recognize and adapt to the agile software development environment will result in a failure of IP law practitioners’ essential job function—helping to create or sustain client profitability and enable long-term business growth.

Traditional Software Development

Before understanding what agile software development approaches are, we first discuss the “traditional” software development approach.

First described in 1970, the traditional software development approach (often called the “waterfall approach”) involves a sequential, flow-down five-step process illustrated in figure 1. Waterfall projects begin with a requirements phase where all the functional, technical, and marketing requirements of the software are documented before moving to the design phase. There, the software architecture of the product is documented before moving on to the actual coding of all the requirements. Once coding is complete, the software is tested (and debugged) before it is deployed in a customer environment. This sequential “throw it over the wall” approach, where designers, developers, and testers fail to interact during each step of the process, takes place over the course of several months or even years. Thus, end users typically only get to see results at the very end of the waterfall project.

The major shortcoming of the waterfall approach is that all the requirements for a software product are defined at the beginning of a project, when project members rarely have perfect information. Thus, the most important design decisions are made with the least amount of knowledge. Further, as market changes inevitably cause user requirements to change over the course of a years-long project, pivoting to meet the competitive landscape is costly (and almost impossible).

Agile Software Development

In contrast to the sequential, waterfall approach is the agile software development approach. Generally speaking, the agile approach employs small, cross-functional teams of designers, coders, and testers working through multiple iterations (called “sprints”) that last two to four weeks in order to produce a potentially shippable product. After each sprint—each delivering a software product with increasing functionality—there is an opportunity for (internal and external) customers to review the latest incremental build. Agile is based on the notion that
sometimes customers need to see the wrong product before they can articulate what they really need!

The agile software development movement traces its roots to a group of 17 influential software developers who, in 2001, issued a *Manifesto for Agile Software Development* and then formed the nonprofit Agile Alliance. The manifesto distills the agile development philosophy into 12 principles, the first of which reads: “Our highest priority is to satisfy the customer through early and continuous delivery of valuable software.”

Today, there is no singly accepted definition of what constitutes agile development. In fact, while a 2013 survey of over 3,500 software professionals concluded that 88 percent of organizations were using some form of agile, a 2012 survey of 200 companies found over 100 definitions of what the term even meant. Since then, numerous agile development approaches have been developed (e.g., Scrum, Extreme Programming (XP), Feature-Driven Development (FDD), Kanban, Lean, etc.), all more or less adhering to the 12 principles to achieve higher quality software in a shorter period of time via self-organizing teams collaborating with customers with less documentation and reduced time to market.

![Figure 2: Agile Software Development Approach](image)

As shown in figure 2, agile projects proceed in an iterative fashion where new features are integrated to extend the capabilities of the software. That is, each sprint delivers user-desired, working, and tested features. Each iteration generally consists of four distinct phases: planning, development, user review, and retrospective.

In the planning phase, all stakeholders (i.e., designers, testers, coders, and product management) meet to decide and document which new features are to be added to the software, or what changes to existing features need to be made. Once decided, the order of feature completion or change is prioritized. Next, the development team creates a list of technical tasks necessary to create each of the one or more desired features, and allocates a time and resource estimate to each such task. This phase comes to an end when all stakeholders agree upon the features to be implemented within the given time and resource constraints.

In the development phase, the development team works to code, test, and debug the one or more features agreed upon between product management and other stakeholders during the planning phase. Then, in the user review phase, the development team demonstrates the software and its newly implemented features or changes to product management (and perhaps potential customers/product advisors). Product management then decides if the software is correct and complete. Thus, completed features are removed from the list of features needing another planning phase, and incomplete features are again candidates for future iterations. Lastly, in the retrospective phase, the development team meets to reflect on the last iteration and discuss those tasks, techniques, and team interactions that worked and those that need improvement.

In sum, organizations implementing agile development approaches believe that the software development process improves through “more stable requirements, earlier fault detection, less lead times for testing, increased communication, and increased adaptive capacity.” With respect to measuring the effectiveness of various agile development approaches, one proponent states it best:

> When it comes to measurements, agilists have a different philosophy than traditionalists. We believe that metrics such as cost variance, schedule variance, requirements variance, and task variance are virtually meaningless . . . . Instead, . . . [d]oesn’t it make sense to measure the success of software development efforts by the delivery of working software?

### Challenges to Capturing and Protecting IP within Agile

There has been much written and debated about the patentability of software (and, more generally, computer-implemented inventions). This is especially true since the June 2014 U.S. Supreme Court decision in *Alice Corp. Pty. Ltd. v. CLS Bank International*. Despite this, software—the output of a $600 billion annual revenue, two-million-person IT industry—is not only eligible for patent protection, but accounts for more than 50 percent of issued U.S. patents (as shown in figure 3). That said, we now turn to the challenges of capturing and protecting intellectual property within an agile software development environment.

As discussed above, agile software development emphasizes short time frames and fast-paced (“sprint”) work cycles. While agile development produces innovations worth protecting, the limits imposed by an agile methodology wreak havoc on the traditional workflow of an IP practitioner. For instance, traditional IP capture methodologies rely on a more relaxed flow of invention disclosure, evaluation, strategy, and IP rights procurement, which unfolds over a period of several months.
during (or sometimes after) a traditional product development cycle. In an agile environment, however, a faster-paced, condensed idea submission and evaluation process that occurs over the course of a few days or weeks is needed. Similarly, the rapid pace of sprints leaves developers with precious little time to strategize, analyze, document, and capture potential intellectual property. Thus, while the post-Alice requirements for robust software IP patent protection are increasing, the time available to evaluate and provide details for such software IP protection decreases within an agile environment.

Further complicating IP capture efforts is the reality that any given sprint may only result in completion of a portion of a product, rather than a fully functioning product. With only small portions of an ultimate deliverable being completed in each sprint, it can be difficult to determine when enough innovation has occurred to warrant seeking IP protection. Additionally, the use of many discrete sprints and their respective deliverables can cause clients to lose perspective and fail to appreciate that a series of smaller innovations can lead to a larger creative output worthy of IP protection. That is, agile developers often “can’t see the forest for the trees,” as they focus on smaller, more manageable sprint deliverables. Lastly, shortened agile time frames and a focus on sprint deliverables may contribute to a decrease in communication between team members and legal personnel, which also negatively affects the identification of, and action upon, protectable intellectual property.

In sum, a focus on smaller, more immediate deliverables in a shortened time frame can cause participants to lose sight of their deliverables’ innovative qualities when faced with specific agile procedures and a rush to deliver within a sprint’s time frame. An emphasis on continuous, iterative delivery may have the unfortunate side effect of devaluing innovative contributions in the eyes of many on the development team. That is, moving from one sprint to the next may often work against the reflection and reconsideration of earlier sprints, as the agile process forces participants to focus solely on what’s needed for the current sprint. Pushing requirements from one sprint to the next can create the false sense of “well, we’re just catching up to where we wanted to be in the last sprint,” rather than appreciating the innovation that has already been made. While the retrospective phase asks team members to consider what occurred in that last sprint, it will often not include IP considerations for the project as a whole.

Techniques

Against the backdrop of the many challenges presented above, we now provide six considerations for IP practitioners whose clients employ agile development methodologies in order to effectively identify and protect intellectual property.

Third-Party Nondisclosure Agreements with Feedback Clauses

During the many user review phases of an agile project, a developer has to necessarily disclose the product under development to a potential (external) customer in order to gain valuable insight about the features just developed. Thus, how does such a client protect its intellectual property? Well, a nondisclosure agreement (NDA)—even if it is called
a “product advisor agreement”—is a must. But an NDA with a “feedback clause” is even better. A simple example of such a clause is:

Notwithstanding any other provision in this Agreement, if Customer provides any ideas, suggestions, or recommendations regarding the Product (“Feedback”), Company is free to use and incorporate such Feedback in its products, without payment of royalties or other consideration to Customer, so long as Company does not infringe any of Customer’s IP rights in the Feedback which existed prior to the time of providing such Feedback.

A more advanced example is as follows:
Customer understands that, as a product advisor, Company may ask that Customer: (i) provide feedback or input on a number of topics, including but not limited to, the design, functionality, user interface, development, and integration or release strategy of Company’s products or services; and (ii) participate in focus groups and/or the usability evaluation for certain Company products, prototypes, or mock-ups. Unless otherwise agreed to in writing by Company and Customer pursuant to a separate agreement, Customer acknowledges and agrees that any such feedback, input, or participation by Customer in any such activities (collectively, “Feedback”) is provided on a voluntary basis only and Customer will not seek or be entitled to receive any compensation in any form for such Feedback. Further, Customer agrees that no Feedback provided by it shall include confidential or proprietary information that is owned by Customer or any other third party, or that Customer is compelled to keep confidential by law or otherwise. To the extent that any IP is created, conceived, developed, or made during the course of Customer’s engagement as a product advisor, it shall be exclusively owned by, and is hereby assigned to, Company, whether it is based upon, makes references to, incorporates, or otherwise makes use of, in whole or in part, Feedback.

**Personnel Agreements with IP Assignment Clauses**

Given the current environment in which workers are as mobile as the apps they create, one of the biggest threats to a company’s intellectual property, unfortunately, is its own employees and contractors. Thus, it is prudent for IP practitioners to advise their clients to: (1) enter into employment and contractor agreements that contain nondisclosure obligations and IP assignment clauses with all personnel upon their initial engagement with the company; and (2) implement physical and IT security controls (e.g., document management systems, data loss prevention software, USB block, etc.) to control access to source code files and design documents. Further, fostering a culture of IP training (both formal and informal “brown bags”) and inventor incentives (e.g., remuneration, recognition plaques, annual dinners, etc.) will assure that company personnel are not only aware of intellectual property, but also enthusiastically participate in its capture, protection, and enforcement.

**Copyright Notices**

Software code and its resulting graphical user interface (GUI) and user experience (UX) designs are, of course, also protectable via copyright, which vests automatically when created. Marking code files with copyright notices provides some protection during agile sprints to at least warn all personnel with (authorized and unauthorized) access that such files contain company intellectual property. Actual copyright registration of at least a portion of a project’s software code (e.g., every x iterations or every y months) should also be considered to give clients the ability to send cease and desist letters, sue, collect increased damages, etc. Thus, while a software product’s design should be evaluated from a (utility and design) patent perspective, copyright protection can also be a quick and inexpensive tool to protect intellectual property during and after agile development.

A simple example of a copyright notice for project files is “©” or “Copyright” followed by the year and company name. A more advanced copyright notice to remind personnel of the importance of intellectual property is as follows:

```
/*
 * Copyright © [year] by [Company]. All rights reserved.
 *
 * The copyright to the computer software herein is the property of Company.
 * The software may be used and/or copied only with the written permission of
 * Company or in accordance with the terms and conditions stipulated in
 * the agreement/contract under which the software has been supplied.
 */
```

**Treat as a Trade Secret and Then Evaluate for Patent Protection**

The trade secret laws offer protection for a variety of software-related innovations, such as any “formula, pattern, compilation, program, device, method, technique, or process.” Thus, any code or design that has independent economic value from not being generally known to the public can be
classified and protected as a trade secret so long as reasonable steps are taken to keep it confidential. Thus, making sure that clients have a trade secret protection protocol with defined steps to mark, log, and track trade secret materials (e.g., code, comments, algorithms, design docs, etc.) is essential. For example, software code, comments, know-how, processes, algorithms, etc., can be labeled and protected as trade secrets. A client's trade secret protocol—often termed a "data protection policy"—should include steps for determining: (1) whether the subject matter is already known, (2) whether the subject matter is able to be kept secret from end users, and (3) whether access to the subject matter can be controlled.

Once a trade secret protection protocol is in place and incorporated into the agile development process (e.g., before the user review phase), implementing the protocol involves: (1) marking and storing trade secret materials separate from non-trade secret materials; (2) educating employees (e.g., via new employee orientation, current employee reminders, and departing employee exit interviews) on the importance of marking and keeping trade secret materials confidential and restricted; (3) executing appropriate confidentiality or non-disclosure agreements; and (4) periodically reviewing documents and procedures for compliance. While there are no "magic words" that must be present to indicate a trade secret, recognizable phrases include "trade secret," "confidential," or "proprietary information." Such phrases can be added to a header, footer, comment, background, etc., within any source code document, comment/notes file, manual, or any other project documentation.

An example of a more detailed trade secret label is as follows:

This document contains confidential and proprietary trade secret information owned and controlled by Company. Reproduction or distribution of this document, or use of the information contained herein in any way, is strictly forbidden without express authorization from the Company. Care shall be taken to maintain the confidentiality of this document and its constituent information and prevent its disclosure outside of Company facilities.

Information labeled as a trade secret during one sprint can be revisited and perhaps later filed as a patent application in a subsequent sprint or wrap-up review.

**Series Provisional Patent Application Filings Followed by at Least One Nonprovisional**

Given agile's iterative approach, a client may best be served by filing one or more U.S. provisional patent applications during each sprint. An initial meeting at the planning phase can be used to set a rough roadmap for provisional application filings. Invention disclosure information can then be gathered during the development phase for filing before the user review phase.

With one or more provisionals filed according to a regular rhythm throughout the multisprint development process, one or more nonprovisional patent application filings can be filed at the end of the project. This rhythm should allow an IP practitioner adequate time to prepare resulting nonprovisionals that are robust (and "Alice-proof") without losing any benefit of the provisionals' priority dates. While a provisional, of course, should include a thorough, enabling description of the relevant subject matter, being able to ignore some of the nonprovisional application "niceties" and spend less time drafting claims allows the practitioner to adjust to the filing pace necessitated by the sprints' short duration. Such a provisional drafting process can also help to reduce overall costs because any sums spent in preparing provisional applications should save cost when associated nonprovisionals are later filed.

A focus on a single, discrete innovation (or a few closely related innovations) in each provisional filing should allow the practitioner to optimize their drafting efficiency, while also minimizing back-and-forth between the practitioner and the inventors, who don't have much time to spend on IP matters in a typical sprint cycle. Then, at the end of a project, the inventors, IP practitioner, and managers can reflect on the development work done and the provisionals filed, and revisit the filing strategy in order to finalize the nonprovisional filings needed for the resulting product. Lessons learned from one sprint to the next may alter or otherwise impact the initial IP protection strategy. Ultimate filings may include utility filings to protect the functionality of the product (which can take advantage of the filing dates of the earlier-filed provisionals), and design filings to protect the product's GUI and UX (which, unfortunately, cannot claim priority to any of the provisional applications). Some provisionals, rather than being incorporated into a nonprovisional filing and published, may be allowed to lapse and remain secret, protected by the company as trade secrets instead.

**Structured Invention Disclosures and Patent Application Filings**

Drafting provisional and nonprovisional applications according to a modular and/or template approach created for the particular product under development should decrease the time (and expense) needed to prepare multiple filings. For example, a practitioner may develop one or more application templates that provide certain base information, background systems and methods, terminology, and other frameworks, upon which each filing can be built. Using such templates, the practitioner can then focus on describing the inventive aspects of the application without spending too much time (re) inventing the wheel, all while keeping pace with the agile development process. Shorter, "nonboilerplate" write-ups will result in shorter reviews and provide a better fit within the time and resource constraints imposed by agile development. The process described herein comports with the new first-to-file
U.S. patent system by following the “Chicago voting rule”—file “early and often”!

Summary: An IP Rhythm to Match Agile’s Fast-Paced Iterations

As discussed above, IP practitioners have many tools at their disposal to advise and serve their clients in identifying and protecting intellectual property while accommodating the unique demands of the various agile software development methodologies employed by such clients. These approaches are not mutually exclusive and can be applied in various combinations to provide robust IP protection. For example, software developed through an agile process can be protected by an NDA, copyright, trade secret (in whole or in part), and multiple, modular template-based provisional applications followed by at least one nonprovisional application. Agile software development—like other innovations produced by various R&D methodologies—demands a multifaceted IP strategy, client engagement, and frequent monitoring by IP counsel.

As shown in figure 4, the goal of the practitioner should be to mirror the client’s agile development methodology with the six considerations discussed above. This results in an IP-educated development team entering into the planning phase where initial IP priorities are identified. In the sprint phase, inventions can be mined, and in the user review phase, provisional filings are made. During the retrospective phase, IP protection strategies can be reviewed, confirmed, and finalized. Using this rhythm, each iteration of the agile project provides a subsequent opportunity to further refine the IP capture/protection strategy. The resulting product can then be reviewed prior to release to identify further opportunities for (domestic and international) patent filings and other protection mechanisms (e.g., trademark and copyright registrations, end-user license agreements, etc.).

Conclusion

More and more clients from enterprises of all sizes and from varying industries are producing (and will begin to produce) software using agile development methodologies as they seek to produce higher-quality software faster. While the adoption of these agile approaches has no effect on IP rights themselves, it does affect how IP practitioners should counsel their clients. That is, IP rights are IP rights, and the basic requirements for their registration and enforcement obviously remain unchanged. But, if the First Commandment of Business—“know thy customer”—is a guide, IP practitioners should educate themselves about the agile methodologies their clients use to innovate, and be more nimble in their approach to counseling and securing IP rights for such agilist clients.

This article, which originally appeared in the ABA’s Landslide® Magazine in July 2015, reflects the authors’ current personal views and should not necessarily be attributed to their current or former employers, or their respective clients or customers.
Endnotes
3 VersionOne, 8th Annual State of Agile Survey (2014).
4 See Brian Bloom, Agile Development Costly, Confusing: Report, IT World Can. (July 23, 2012).
5 This is the most popular form of agile software development. (For a tutorial video, see http://scrumtrainingseries.com/Intro_to_Scrum/Intro_to_Scrum.htm.)
7 Id. at 49.
10 134 S. Ct. 2347 (2014) (holding that an “inventive concept” must be present in a patent claim to ensure that, in practice, the claim amounts to significantly more than a patent on a law of nature, natural phenomena, or abstract idea).
13 Symantec Corp., What’s Yours Is Mine: How Employees Are Putting Your Intellectual Property at Risk (2013) (citing survey results that 59 percent of U.S. software developers believe that they have the right to reuse source code they’ve written for their next employer; and 42 percent believe that employees should have ownership rights in their inventions).

Congratulations Patent Pro Bono Project Volunteers

During 2014-2015, the following volunteer attorneys accepted pro bono client referrals through the Michigan Patent Pro Bono Project:

- Justin Barry, Brooks Kushman PC
- Erin Bowles, Brooks Kushman PC
- Mark Harper, Dinsmore & Shohl
- John Nemazi, Brooks Kushman PC
- Norm Sims, Dobrusin Law Firm
- University of Detroit Mercy Law School International IP Clinic
- Wayne State University law School Patent Procurement Clinic

In *B&B Hardware v. Hargis Industries*, the Supreme Court held that, under some circumstances, determinations by the USPTO Trademark Trial and Appeal Board could have preclusive effect in subsequent federal court litigation involving the identical issue. The possibility of a preclusive effect raises strategic concerns in both trademark and patent matters, since the Court’s reasoning potentially applies equally to Patent Trial and Appeal Board determinations. Recently, two district courts addressed the practical impact of *B&B Hardware* and collateral estoppel in trademark and patent infringement litigation.

**Practice Points**

- In *B&B Hardware*, the Supreme Court held that a TTAB determination could have preclusive effect in subsequent federal court litigation if both proceedings involved substantially the same issue.
- The Supreme Court noted that, in many situations, differences between administrative and federal court proceedings will prevent preclusive effect.
- In *Ashe v. PNC Financial Services Group, Inc.*, the United States District Court for the District of Maryland applied *B&B Hardware* to hold that a TTAB ruling on priority of trademark use precluded litigation of the issue in a subsequent trademark infringement action.
- In *Contentguard Holdings, Inc. v. Amazon.com, Inc.*, the United States District Court for Eastern District of Texas ruled that differences between the claim construction standards used in USPTO AIA post grant proceedings and in federal court litigation prevented a PTAB final determination from having preclusive effect in a subsequent patent infringement action.

**Background**

The issue of likelihood of confusion frequently arises in both trademark registration and infringement contexts. When an applicant files a trademark application and a third party opposes the application, the United States Patent and Trademark Office's Trademark Trial and Appeal Board (“TTAB”) must determine whether a likelihood of confusion exists between the marks. The end result is that the applicant’s mark is either allowed to proceed or refused registration. Similarly, a district court may be called upon to decide these same issues when a trademark owner sues in federal court for trademark infringement. Unlike the result of the TTAB decision, however, if a district court decides that a likelihood of confusion exists between the marks, the consequences may include damages and an injunction.

In *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293 (2015), the issue of likelihood of confusion was decided by the TTAB and subsequently by a district court with opposite outcomes. Facing the question whether the TTAB’s earlier decision on the issue of likelihood of confusion should have been binding on the district court, the Supreme Court held that decisions by the TTAB may be binding on a federal district court considering the same or similar issue. Applying the Restatement (Second) of Judgments § 27, the Court noted that “subject to certain well-known exceptions, the general rule is that when an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim.” 135 S. Ct. at 1303 (quotation omitted). The Court recognized, however, that “use” of a mark as described in an application or registration can be materially different from how the mark is actually used in the marketplace, which may have a deciding impact on the likelihood of confusion determination. Because the TTAB may not always consider actual marketplace usage, the Court found that “for a great many registration decisions issue preclusion obviously will not apply.” *Id.* at 1306.

**Practical Implications for Trademark Practice**

Most matters before the TTAB are cancellation or opposition proceedings, such as was the case in *B&B Hardware*. Grounds for these actions include claims of priority, likelihood of confusion, descriptiveness, genericness, or abandonment, among others. The decision in *B&B Hardware* means that, under certain circumstances, a party that received an unfavorable outcome before the TTAB may be bound to the TTAB’s decision in a subsequent matter before the federal courts. For
example, if the parties to a TTAB opposition decision later litigate the same issue before a court, the winning party will smartly argue that B&B Hardware demands that the losing party is bound by the prior decision of the TTAB.

Of course, B&B Hardware makes clear that the determination whether issue preclusion applies will be assessed by district courts on a case-by-case basis. The analysis is necessarily fact-intensive, so the application of issue preclusion will likely be thoroughly contested in many cases. The implications of B&B Hardware will become clearer as courts are called upon to apply the decision to trademark disputes.

Recently, the first trademark infringement case to apply the principles set forth in B&B Hardware was decided by the United States District Court for the District of Maryland, which granted a motion to dismiss a complaint for trademark infringement on the grounds of collateral estoppel. Ashe v. PNC Financial Services Group, Inc., No. PWG-15-144, 2015 WL 7252190 (D. Md. Nov. 17, 2015). In Ashe, both parties filed federal trademark applications for the mark “SPENDOLOGY.” PNC filed an opposition with the TTAB against Ashe’s application, and Ashe and PNC filed cross-motions for summary judgment on the basis of priority. The TTAB found that PNC clearly established prior use of the mark, so Ashe’s application to register the “SPENDOLOGY” trademark was refused. Subsequently, Ashe filed a trademark infringement action against PNC in the district of Maryland. The district court found that the TTAB’s determination of priority of use in the opposition proceeding was the same as the determination of priority in an infringement action. The decision was careful to distinguish this issue from that of likelihood of confusion, which the Supreme Court addressed in B&B Hardware, noting that the parties’ “marketplace usage” of the mark was inapplicable to the determination of priority. Moreover, as the issue of priority was resolved in the TTAB proceeding, the issue was “critical and necessary” to the TTAB judgment, the judgment was final, and Ashe had a full and fair opportunity to litigate the issue before the TTAB. Thus, the requirements for issue preclusion were satisfied. PNC’s priority was established before the TTAB, and therefore Ashe’s claim before the court was barred.

Until a more substantial body of case law develops, clients should view the Supreme Court’s decision in B&B Hardware as unambiguously raising the stakes for final TTAB determinations. Indeed, the Ashe case confirms that principles established in B&B Hardware may be applied to issues beyond likelihood of confusion. In deciding whether to litigate to a final decision in a TTAB proceeding, B&B Hardware should cause all parties to carefully assess their strategy. Since determinations by the TTAB may be binding in later cases, parties may decide to expend greater resources to assure a favorable result. Therefore, a party may opt to invest in a survey or other expert testimony or to pursue more extensive discovery earlier in an opposition or cancellation proceeding. Alternatively, it may be more beneficial to withdraw from proceedings or try to shift to federal district court. As a result, clients should carefully weigh the strategic importance of pursuing a matter before the TTAB against the now-elevated risks of obtaining that board’s final decision.

**Potential Impact on Patent Practice**

Although B&B Hardware did not specifically mention AIA inter partes review or post grant review proceedings, the parallels between TTAB opposition proceedings at issue in that case and administrative proceedings before the Patent Trial and Appeal Board (“PTAB”) suggest that preclusion could be hotly contested in future cases. Numerous issues in dispute during AIA proceedings parallel issues likely to arise in subsequent district court infringement and declaratory judgment actions, including claim construction, novelty, and obviousness.

In Contentguard Holdings, Inc. v. Amazon.com, Inc., No. 2:13-CV-1112-JRG, 2015 WL 5996363 (E.D. Tex. Oct. 14, 2015), the United States District Court for Eastern District of Texas found that not only did B&B Hardware not establish a per se rule of exclusion in trademark disputes, “it is far from clear [whether] the Supreme Court intended for its narrow holding in B&B Hardware to per se extend to patent proceedings.” Id. at *1. The court noted that the decision in B&B Hardware hinged on the fact that the TTAB and district courts apply the same likelihood of confusion standard in both registration and infringement contexts. In contrast, the PTAB and district courts use different standards for claim construction. While PTAB proceedings feature detailed inter partes procedures comparable to those available in federal court actions, the applicable standard for construing disputed claims is different. The PTAB applies the same “broadest reasonable interpretation” standard that applies to all USPTO proceedings, rather than the more restrictive district court standard “ordinary and customary” construction. See In re Cuozzo Speed Techs., LLC, 778 F.3d 1271 (Fed. Cir. 2015). Therefore, the district court held that because the claim construction standards are different between the district court and the PTAB, B&B Hardware did not apply to create a preclusive effect.

As in the trademark context, the full impact of B&B Hardware in patent litigation will become clear only after other courts apply the decision to serial PTAB and district court proceedings. Ultimately, it is unclear whether the different claim construction standards applied will prove substantial enough to prevent issue preclusion in later district court patent infringement actions.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.
Introduction

The Michigan Patent Pro Bono Project seeks to address the unmet need for patent legal services in Michigan by matching low-income inventors and innovators with volunteer patent attorneys. In its first year of operation, the Project received requests for legal services from 42 persons. Of these, six were placed with volunteer attorneys and three more were placed with law school patent clinical programs. One applicant is awaiting placement. During 2015, the structure and procedures of the Project were adopted. Several outreach programs introduced the Project to the community and attorneys.

Organization

Initially, the Project began with informal discussions between representatives of leading Michigan IP law firms, in-house patent law departments, and other institutions. Based on those meetings, it was determined that a pro bono effort to provide pro bono legal services would be supported by a significant portion of the IP legal community. In particular, the group recognized a need for in-house counsel to satisfy their pro bono commitment by representing clients in patent matters.

The State Bar of Michigan Intellectual Property Law Section (“IPLS”), including its chairs, Adam Strauss and Karl Ondersma, strongly supported the development of a pro bono program. David Berry, an IPLS council member, organized an ad hoc steering committee including the following people:

- Frank Angileri, Brooks Kushman
- John S. Artz, Dickinson Wright
- David Berry, Brooks Kushman/Wayne State Law School
- Sharon Brady, Dow Corning
- William Coughlin, Ford Global Technologies
- Denise Glassmeyer, Young Basile
- Andrew Grove, Honigman
- John Guenther, Dykema
- Stephen Olson, Harness, Dickey & Pierce
- Karl Ondersma, Gardner Linn Burkhart & Flory
- Norman Sims, Dobrusin Law Offices
- Michael Stewart, Fishman Stewart Yamaguchi
- Adam Strauss, Stryker Corporation
- John VanOphem, VanOphem IP Law

The steering committee approved initial operating procedures, which were based on the procedures developed by the Minnesota pro bono pilot program, but adapted to address the particular requirements for a Michigan program. The steering committee identified two potential not-for-profit organizations to serve as an administrative partner for the program. The State Bar of Michigan Pro Bono Initiative (“PBI”) was selected to be the Project’s administrative partner in Fall 2014.

On September 17, 2015, the IPLS formally amended its by-laws to establish the Project as a standing committee of the Section. The approved amended by-laws are attached hereto as Exhibit A.

Operation

Launch

The Project officially launched during a ceremony at the Elijah J. McCoy Regional U.S. Patent Office in Detroit, Michigan on November 18, 2014. Speakers included Thomas Rombach, then President of the State Bar of Michigan, Jennifer M. McDowell, USPTO National Pro Bono Coordinator, and Jennifer Grieco, then Treasurer of the State Bar of Michigan. The event was webcast live on the USPTO website.

Funding

The Project has incurred modest start-up costs, consisting of some travel expenses and refreshments associated with the launch ceremony and receptions and meetings across the state to introduce attorneys and potential clients to the Project. The IPLS is currently holding funds representing excess sponsorship donations relating to the Gala Reception to celebrate the opening of the Elijah McCoy Regional U.S. Patent Office on July 12, 2012, and those excess donations are earmarked for the pro bono effort. During 2014-2015 SBM fiscal year, $4,663.15 in Project-related expenditures were approved by the IPLS Council.

Ongoing operating expenses for the Project are minimal. The SBM PBI provides administrative support services at no
cost, and volunteer attorneys may obtain malpractice insurance through the SBM PBI insurance policy. Currently, there is no immediate need for the Project to secure additional start-up or operations funding.

**Clients Served**

Since the Project launch, a screening committee has worked with the PBI to screen applicants based on their legal needs and available program resources. The following attorneys served on the committee: Sharon Brady (Dow Corning), Denise Glassmeyer (Young Basile), Norm Sims (Dobrusin Law Firm), Robert Mathis (PBI), and David Berry (Brooks Kushman).

From program launch through December 31, 2015:

- Applications for assistance submitted: 42
- Applicants placed: 9
  - 6 with volunteer attorneys
  - 3 with law school clinical programs
- Reasons for not accepting applicants:
  - No application filed with USPTO: 22
  - Over income: 6
  - Client not responsive: 3
  - Not a patent issue: 1
  - Not a Michigan resident: 1

The following firms/organizations accepted pro bono referrals through the date of this report:

- Brooks Kushman
- Gifford Krass/Dinsmore & Shohl
- Dobrusin Law Firm
- Kreis Enderle
- Wayne State Law School Patent Procurement Clinic
- University of Detroit Mercy Law School International IP Clinic

**Coordination**

The Project closely coordinates its operations with the USPTO and a national association of regional patent pro bono programs. The USPTO has collaborated with regional IP law associations to establish a network of 18 regional programs, servicing low-income inventors in all 50 states. On October 25, 2013, at the invitation of Chief Judge Randall Rader of the U.S. Court of Appeals for the Federal Circuit, David Berry signed the inaugural AIA Pro Bono Advisory Council Charter on behalf of the State Bar of Michigan Intellectual Property Law Section. The signing ceremony was held at the Federal Circuit courthouse in Washington. In addition, in December 2015 David Berry was appointed to the Board of Directors of the Pro Bono Advisory Council, a non-profit corporation which will provide support, coordination, and educational services to the regional programs.

**Promotion**

Since the launch of the Project, the following public programs and communications have introduced the program to the public and interested attorneys:

- Volunteer Attorney Orientations:
  - Grand Rapids, MI (Nov. 11, 2014)
  - Southfield, MI (Nov. 12, 2014)
  - East Lansing, MI (March 16, 2015)
- USPTO Detroit Office Saturday Program at Detroit Public Library (May 16, 2015)
- Cornerstone Alliance Community Program, Benton Harbor, MI (September 16, 2015)
- In addition, detailed information concerning the Project, online application forms, and links to additional information are located on the State Bar of Michigan website (connect.michbar.org/iplaw/patent).
- Additional links to the Project are located on the USPTO website (http://www.uspto.gov/patents-getting-started/using-legal-services/pro-bono/patent-pro-bono-program) and the Federal Circuit Bar Association website.
- The Project was featured in a blog post by USPTO Director Michelle K. Lee on the USPTO Director’s Bog, and on the Department of Commerce’s Minority Business Development Agency website (http://www.mbdagov/blogger/innovation/patent-pro-bono-program-expansion-benefit-inventors-nationwide).
- The Project was also mentioned in a Law360 feature article by Ms. McDowell (http://www.law360.com/articles/616894/an-update-on-uspto-s-patent-pro-bono-initiative).

**Coordination with Other IP Resources**

In addition to coordinating with law firms and in-house law departments, the project has coordinated with other IP legal resources. It has referred inquiries involving non-patent IP legal issues to Creative Many of Michigan, which operates the Lawyers for the Creative Economy (“LCE”) program. It has referred clients to USPTO-certified law school patent clinical programs at Wayne State University Law School and University of Detroit Mercy Law School.