

Pro Bono Work Is Valuable In IP And Continued Learning

By **Lisa Holubar and Ariel Katz** (February 1, 2023)

The value of pro bono legal representation cannot be overstated.

A Legal Services Corp. study found that approximately 80% of the legal needs of the poor are being unmet.[1] The same study found that roughly 1 million cases per year are being rejected because legal aid programs lack the resources to handle them.

The need for legal representation is not just present in the criminal law realm. Inventors and artists need legal help, with a Chicago nonprofit alone taking over 1,000 pro bono artist cases in a single year.[2]

Aside from the dire need for free intellectual property legal services, pro bono representation is also invaluable to attorneys. Providing legal services helps attorneys hone their skill sets and often provides substantive legal experience in ways not easily accessible to young attorneys on billable matters.[3]

Representing pro bono clients can also force attorneys to reckon with the injustices in society, making them more empathetic and well-rounded advocates.

Despite the importance of pro bono representation, the U.S. Patent and Trademark Office, on Nov. 14, 2022, eliminated a rule on continuing legal education reporting that would have, in part, counted pro bono work as CLE.

To be clear, the rule was not directed specifically to pro bono. Rather, under the rule, attorneys and practitioners would have been required to biennially submit mandatory registration statements in which they could voluntarily state whether they completed six credits of CLE within the previous 24 months.[4]

The rule appears to have been eliminated due to concerns over added layers of reporting CLE to the USPTO in addition to states. Nevertheless, its elimination raises the issue of pro bono's importance in IP practice and the tie between CLE and pro bono.

History of State-Mandated CLE

CLE began in the early 1900s as a way for new lawyers to attend lectures and learn from experts in the legal field.[5] The CLE movement grew after World War II as a way for legal professionals whose careers had been interrupted by the war to refresh their skills and be updated on new legal developments.

Mandatory CLE as part of maintaining one's legal license came much later. In the mid-1970s, Minnesota and Iowa were the first states to require mandatory CLE.[6] A majority of states followed suit in the 1980s and 1990s mandating CLE as part of lawyers maintaining their licensure.[7] Currently, only four states — Maryland, Massachusetts, Michigan and South Dakota, along with Washington, D.C. — do not mandate CLE hours.

CLE requirements have not been static since their adoptions, with both the number of



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required hours and types of learning hours seeing change.

For example, several states have recently enacted changes to the types of subcategories that count toward CLE credit. Ohio, for instance, as of Jan. 1, allows attorneys to earn all their CLE credits through self studying, as opposed to attendance at in-person courses.[8]

In addition, several states have implemented decisions in the past few years requiring training around implicit bias or equity. And most recently, in 2022, New York added a new one-credit CLE requirement focusing on cybersecurity, privacy and data protection.

Unlike CLE, pro bono services are not mandated by either the American Bar Association or on a statewide level.[9] But because all but four states require CLE credit, it would be easy for states to set up a system where attorneys can count their pro bono hours toward CLE credit.

Conversely, setting up a CLE reporting system internally in the USPTO, and requiring attorneys to report hours to both their states and the USPTO, would add costs and complexities for both parties. This is partly why the USPTO decided to reject the proposal.

USPTO Decision Breakdown

The USPTO published its proposal as a final rule on Aug. 3, 2020.[10] The USPTO followed up on Oct. 9, 2020, with proposed CLE guidelines and a request for comments.[11] The CLE rule essentially provided that registered patent practitioners and persons granted limited recognition to practice in patent matters would be required to biennially file a mandatory registration statement with the USPTO.

On the statement, attorneys and practitioners were to have stated whether they had voluntarily completed six CLE credits within the 24-month reporting period, with five of the six credits in patent law and practice, and one in ethics. Those who certified completion of CLE were to have been recognized in the USPTO's online practitioner database.

Such recognition was to consist of a notation on the practitioner's individual profile, which stated: "This practitioner has certified completion of six patent credits of continuing legal education within the previous 24 months." [12]

Significantly, the proposal also would have allowed for pro bono work through the USPTO pro bono program to substitute for up to two of the five reported CLE hours. The pro bono hours would not have been a one-to-one replacement. Rather, attorneys and practitioners could have earned one hour of USPTO patent CLE credit for every three hours of pro bono service completed.[13]

Many attorneys submitted comments adverse to the CLE rule. Attorneys voiced concerns about how the ruling would add costs to the USPTO, which would need more personnel in place to track the reporting, as well as add costs and complexities to attorneys reporting hours. Further, attorneys did not want potential clients to misconstrue voluntary CLE reporters as somehow more qualified than those attorneys or practitioners opting out.[14]

In response to the many negative comments, the USPTO first delayed implementation of the CLE rule and then eliminated it.[15] In so doing, the USPTO specifically noted that "[i]n the future, the Office may reconsider CLE reporting for patent practitioners."

It also noted that

active participation in patent, trademark, Patent Trial and Appeal Board, and Trademark Trial and Appeal Board pro bono programs is essential for ensuring that all those who can contribute to job creation, economic prosperity, and world problem-solving have access to the innovation ecosystem and have the ability to protect their intellectual property for their benefit and for the good of the country.[16]

At first blush, the USPTO's decision may appear to devalue pro bono work, but in reality it merely maintains the status quo of keeping CLE reporting in the hands of the state. Although the decision may make sense for the USPTO, states that do not currently count pro bono hours toward CLE credit should take up the mantle and allow attorneys to count their pro bono work toward their CLE credit.

States That Allow Pro Bono Hours to Count Toward CLE Credit

Allowing CLE credit for pro bono hours, though only recently considered by the USPTO, is not necessarily a new trend. New York began offering CLE credit in 2001 for pro bono hours.[17]

Although some states have more recently allowed pro bono hours to count toward CLE credit — like Colorado, which adopted its pro bono CLE policy in 2018 — at present, a little less than half of all states allow pro bono hours to count toward CLE requirements. Those states are Alabama, Arizona, Arkansas, Colorado, Delaware, Louisiana, Minnesota, New York, Nevada, North Dakota, Ohio, Oregon, Pennsylvania, Tennessee, Washington, West Virginia, Wisconsin and Wyoming.[18]

Most of these states do not offer a one-to-one ratio for pro bono hours to CLE credit hours. For example, Arizona, Colorado, Louisiana, Pennsylvania, Tennessee, Wisconsin and Wyoming all award one CLE credit for every five hours of pro bono service, while several states offer one credit for six hours of service.

Other States Should Follow Suit and Allow Pro Bono Hours to Count Toward CLE

Although the goals of CLE are to sharpen lawyering skills and stay abreast of updates on legal developments, many studies find that CLE in its current iteration is ineffective.[19]

Specifically, many CLE classes are taught with lectures that require only passive listening from the participants rather than active learning. Further, with many states allowing CLE classes to be attended remotely, attorneys can have a lecture on in the background without even listening.

Conversely, pro bono representation requires attorneys to be actively engaged with a matter and learning by doing, which is one of the best ways to learn.[20] Ultimately, as any practicing attorney knows, engaging in any type of legal work is better education than sitting in a lecture hall.

As to those who argue that there is no educational difference between paying client work and pro bono work,[21] that position is belied by the fact that, especially in the case of young associates, pro bono work provides greater client access, more case management responsibility, and more substantive work, with less scut work. It also allows for them to work in new areas of the law in which attorneys often cannot obtain billable hours.[22]

While advocates of pro bono patent work may be disappointed by the USPTO's decision to

do away with its CLE rule, especially as it relates to promoting pro bono work, that decision merely maintains the status quo of states acting as the gatekeepers of CLE reporting.

Attorneys can still count their pro bono hours toward fulfilling their states' CLE requirements if the state to which they report allows such credit. Moving forward, proponents of pro bono CLE credit should lobby their states to adopt policies that award CLE credit for pro bono hours.

Conclusion

Ultimately, pro bono experiences for all attorneys, whether they practice before the USPTO or not, are invaluable as both a way to learn by doing and as a way to help those of lesser means obtain access to IP attorney assistance.

The USPTO decision to not set up a reporting body for CLE pro bono hours as part of the USPTO does not necessarily undermine this laudable goal, which the USPTO itself noted.[23]

Instead, it keeps CLE reporting in the hands of the state, where it has been since the CLE's inception several decades ago. As states continue to add different subcategories for what counts as CLE credit — including cybersecurity courses, courses on implicit bias and explicit bias training, and remote learning options — they should allow pro bono hours to count toward CLE credit.

After all, as Aristotle said, "For the things we have to learn before we can do them, we learn by doing them."

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[1] Evelyn Nieves, "80% of Poor Lack Civil Legal Aid, Study Says," Wash. Post, Oct. 15, 2005. Read the full article here: <https://www.washingtonpost.com/wp-dyn/content/article/2005/10/14/AR2005101401861.html>.

[2] <https://chicagobarfoundation.org/blog/campaign-in-action/removing-legal-obstacles-artistic-dreams/>.

[3] See Law article by George T. Lewis, "The Business Case for Pro Bono" at <https://www.baylor.edu/law/review/doc.php/377846.pdf>.

[4] See, 85 FR 64128, which can be located at <https://www.govinfo.gov/content/pkg/FR-2020-10-09/pdf/2020-22420.pdf>.

[5] A law review article on the history of CLE can be accessed at <https://scholarship.law.stjohns.edu/cgi/viewcontent.cgi?article=2655&context=lawreview>

[6] See id.

[7] More information on mandatory CLE requirements and breaking down the benefits of these requirements can be found at <https://www.law.georgetown.edu/legal-ethics-journal/wp-content/uploads/sites/24/2020/09/GT-GJLE200005.pdf>.

[8] For a more detailed breakdown of recent CLE changes by each state, visit <https://www.pli.edu/credit/Recent-Rule-Changes>.

[9] See ABA Rule 6.1 Voluntary Pro Bono Publico Service - Comment https://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/rule_6_1_voluntary_pro_bono_publico_service/comment_on_rule_6_1/.

[10] Final Rule published on August 3, 2020 (85 FR 46932). The August Final Rule noted "the purpose of the CLE certification and recognition is to incentivize practitioners to engage in CLE relevant to their practice before the [USPTO]."

[11] See, endnote 4, supra.

[12] Id.

[13] The USPTO's decision rejecting the plan to offer CLE credit for pro bono work can be found here: <https://www.federalregister.gov/documents/2022/11/14/2022-24676/eliminating-continuing-legal-education-certification-and-recognition-for-patent-practitioners>.

[14] See, for example, the IPO comments. https://www.uspto.gov/sites/default/files/documents/AIPLA_Letter_to_USPTO_on_CLE_Guidance_010721_FINAL.pdf; https://www.uspto.gov/sites/default/files/documents/Comment_CLE_Guidelines_Besek.pdf; https://www.uspto.gov/sites/default/files/documents/Comment_CLE_Guidelines_Hunziker.pdf.

[15] See endnote 10, supra.

[16] FR Doc. 2022-24676 Filed: 11/10/2022, available online at [federalregister.gov/d/2022-24676](https://www.federalregister.gov/d/2022-24676).

[17] New York's CLE guidelines can be accessed here: <http://ww2.nycourts.gov/sites/default/files/document/files/2018-09/Revised%20Section3d11.pdf>.

[18] The ABA website provides a detailed overview of the current states that offer CLE credit for pro bono hours: https://www.americanbar.org/groups/probono_public_service/policy/cle_rules/.

[19] See Law article by Rima Sirota, "Making CLE Voluntary and Pro Bono Mandatory: A Law Faculty Test Case" at <https://scholarship.law.georgetown.edu/cgi/viewcontent.cgi?article=3062&context=facpub>.

[20] See id.

[21] See Comments to the USPTO proposed ruling from the New York Intellectual Property Law Association accessed at https://www.uspto.gov/sites/default/files/documents/FINAL_NYIPLA_Comments_on_USPTO_CLE_Requirements.pdf ("The NYIPLA disagrees, however, that pro bono activities should qualify for CLE credit because there is no principled basis to distinguish on the job training for pro bono clients as contrasted to for paying clients. CLE credit should be earned for professional educational activities, not client work.")

[22] See endnote 3, supra.

[23] See endnote 13, supra.