Why was the INTA pro bono committee formed?

The committee was formed six years ago out of a presidential task force for the International Trademark Association (INTA) that looked at pro bono activities. I have been on the committee since its inception. At the beginning, we were trying to understand what INTA could do in the pro bono space, and what its role could be.

One of the first projects we undertook was to put together what we call the pro bono toolkit. The toolkit compiled information from as many jurisdictions as possible to see how those particular bars treated pro bono services, because we found out that there is disparity around the world. We wanted to learn more about that and provide as much information to INTA members about pro bono services in their particular countries.

As the committee progressed, however, the one question that everybody had was: where are all the pro bono trademark clients? We all want to do pro bono work, but we don’t know how to find the clients.

Doing pro bono work in intellectual property is very different to other fields of law. In the US, for example, there are funnels for people to go through in say, domestic violence, to access pro bono services.

The greater good

Many lawyers want to work pro bono in order to make a difference. But in IP, it can be a challenge. Rick Biagi, chair of the International Trademark Association’s pro bono committee, explains how he hopes to change this.
Pro Bono

Pro bono work is very rewarding. In certain cases I’ve taken on, I don’t want to use the words ‘life changing’, but one case I can think of literally changed lives. It was very rewarding because, frankly, as IP attorneys, that’s not something we can do very often.

How far has the committee come in its first six years?

We’ve developed what we call the clearinghouse. Those in need of pro bono services come to INTA, they go through an intake process, and then their name is submitted to one or more practitioners in their jurisdiction who can then opt to assist them.

Trying to enact this on a global scale is a humongous undertaking. We decided to do a pilot programme first, in the US and Germany, that was only available to members of the pro bono committee. The pilot programme is in place for two years. This will allow us to make sure all the mechanics of this will work. Right now, everything is flowing through the pro bono committee, but long term, the plan is to open it up to all INTA members. Any practitioner in any jurisdiction who is interested in providing pro bono services will be able to do it.

The pilot had a soft start on 1 January, but its official start is 20 July. This was to get some things working behind the scenes. The mechanics are already in place, but what hasn’t happened yet is the communication to the outside world. So in July we’re going to be communicating it to the US and Germany, to let them know it exists.

During the soft start period, we’ve had one or two people come in organically asking for pro bono services. INTA also gets, from time to time, requests for pro bono services. We’ve put these people through the system, but it hasn’t been advertised.

We’re confident in the mechanics and the reason we’re doing this pilot is to tweak things, prove it within the committee, then roll it out fully.

The pro bono system will hopefully in future be managed by INTA staff, with the committee remaining a part of it, much like the programmes that INTA already runs. That’s our long-term goal. Right now, the committee is doing the work, but INTA staff are picking up the advertising with our assistance.

WIPO recently launched its own pro bono service. Is that something the committee would like to get involved with?

The World IP Organization is interested in speaking to our committee about what we’re doing. The US Patent and Trademark Office also has a pro bono arm to it, but it’s only on the patent side. That was again something that we saw was a void. An organisation such as INTA, which has such a reputation for brand owners around the world, can go out there championing this issue, and people would know this is there place to go to find pro bono counsel.

How will can pro bono services promote a healthy brand and trademark system online?

A number of years ago, I was on a committee in the USPTO that looked at the topic of trademark bullying and the notion that there are big corporations that go after small businesses for trademark infringement. There’s a perception that the big company is bullying the small company into submission because they have no ability to defend themselves from a financial standpoint.

If those people had pro bono services to help them, not only to defend themselves, but to stop them from getting into that situation in the first place, with a practitioner helping to guide them, then a lot of these ‘bullying’ situations would not happen in the first place. The USPTO saw that as an issue that required it to go out and provide education on how to file trademarks correctly.

The pro bono clearinghouse is the second step in that process: to have a stable of practitioners worldwide that can help with trademark issues. A key element of that is getting the word out. But once it’s there, I really do believe that, in these situations where people go into business blindly without doing the proper searches, they could have a trained practitioner helping them clear a trademark and know if it’s infringing.

Do you highlight the pro bono work that attorneys undertake?

Several times throughout the year, we publish a spotlight article in the INTA Bulletin on someone who has done interesting or moving pro bono work. Every year, we also give a couple of awards at leadership meetings to showcase the people who have done good work in pro bono. With the clearinghouse, we’re going to be able to quantify that more.

Groups such as the Electronic Frontier Foundation often take up causes and provide pro bono counsel to involved parties. Is this something your committee is advocating?

There are lots of groups such as the Electronic Frontier Foundation that assist in pro bono services. But we don’t see ourselves as a competitor to them, we complement them. Many of these groups focus on different areas, certainly not the trademark side. INTA is a huge group worldwide, and we can tap into this for trademark expertise around the world, which no other organisation has. We really see ourselves partnering with these organisations to make life easier for them when they do get trademark pro bono clients through. They can run it straight through the INTA pro bono clearinghouse.

The pro bono clearinghouse is the second step in the process: to have a stable of practitioners worldwide that can help with trademark issues.

Rick Biagi, chair of INTA pro bono committee and member at Neal & McDevitt