

TIPS for Working with a Pro Bono Practitioner



#1 - Communicate goals with your practitioner.

Make sure your practitioner understands your needs, goals, and priorities. After being matched with a volunteer practitioner, discuss your objectives for the proceeding and identify any fears that you are experiencing, or hurdles or limitations that you have experienced so far. For your practitioner to effectively represent your interests, they must have this awareness. Being honest and transparent with your practitioner is crucial to the relationship.

#2 - Understand your engagement letter.

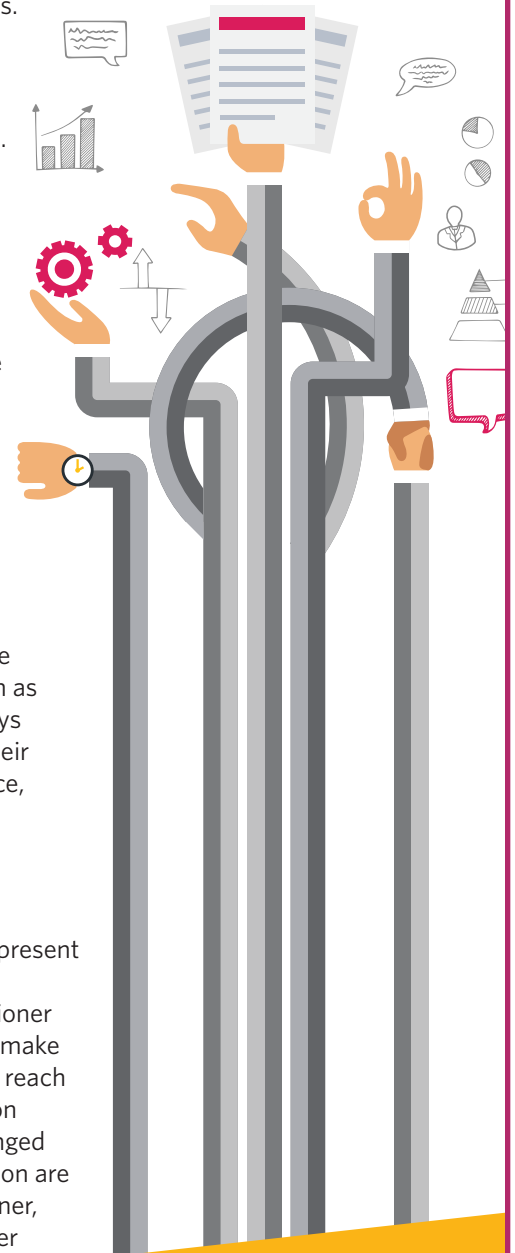
Your practitioner will provide an engagement letter at the beginning of the representation. Engagement letters may differ depending on your practitioner and the case, so do not assume that all engagement letters are the same. This letter will outline the scope of the representation—what services the practitioner plans to provide. Review this carefully and make sure that you understand what the practitioner will and will not do and what fees you are expected to pay. “Pro bono” means that the practitioner will not be taking a fee for his or her services, but there are other costs and/or fees (e.g., USPTO fees) that you are still expected to pay. Make sure that you understand the extent of those costs and are prepared to pay them when required. If you have questions about the engagement letter, ask your practitioner to explain.

#3 - Listen to your practitioner.

It is very important to listen to your practitioner. Patent attorneys and agents spend extensive time learning and applying patent law. Your practitioner is a specialist who has volunteered to use his or her expertise to help you obtain the patent protection or other outcome that you seek. For example, you may have had ups and downs along your patent journey; your practitioner is on your team and has volunteered their time and skill because they want to help you. Their advice on the best steps to take in pursuing patent protection as well as the scope of possible patent protection for your particular invention may not always match your hopes or expectations. Importantly, however, they are advising based upon their knowledge and experience to do their best for you. If you have questions about their advice, discuss them openly, but try to keep an open mind and give appropriate respect to their judgment and experience.

#4 - Be respectful of your practitioner's time.

Pro bono practitioners volunteer their services and have limited availability. They often represent several clients and matters at the same time. There typically is no need to contact your practitioner with daily updates or status requests. You should, however, keep your practitioner informed of any significant developments or new information that comes your way. Also, make sure that your practitioner has all of your up-to-date contact information so that they can reach you. Be responsive to their messages and requests. If your practitioner asks for information or actions, promptly provide what is needed. If you are not going to be available for prolonged time periods, share this information with your practitioner. Cooperation and communication are essential, and delays can hinder progress on your case. After speaking with your practitioner, it may be useful to agree on a follow-up time so that you both know when to expect further communications with each other.



#5 - Establish the timing and manner of communications with your practitioner.

When you reach out to your practitioner, do not expect an immediate response. Practitioners may be attending to other clients and matters. A delayed response does not mean that your practitioner is ignoring you or failing to take your case seriously. It is common business practice for practitioners to respond within a few hours to a few days. If your need is urgent, be sure to communicate that urgency to your practitioner, and follow-up with them if you do not receive a response in a reasonable time frame under the circumstances. Likewise, you should discuss the timing and manner of communications with your practitioner. For example, practitioners often work outside of normal business hours, and you may be limited to having communications at a certain time of day. As another example, practitioners may work better through email or text whereas you may prefer telephone calls. By establishing the timing and manner of communications at the outset, you can create the framework for a good working relationship with your practitioner.

#6 - Be prepared for meetings with your practitioner.

When preparing for a meeting with your practitioner, review any educational materials regarding the patent application process and/or mechanics of the relevant USPTO proceedings. Your practitioner can point you to such material. These materials may answer some of your questions and allow you to focus your meeting with your practitioner on the specific issues impacting your case rather than general processes. Additionally, gather relevant documents and information pertinent to your case, and come with a clear agenda. Consider developing a list of questions and concerns. It may be beneficial to email your practitioner with your questions in advance of a meeting. An advance email will give your practitioner time to consider your questions and provide well thought out responses. Feel free to take notes during the meeting to refer to as your matter progresses.

#7 - Ask questions of your practitioner.

Ask your practitioner about legal processes, potential outcomes, and any uncertainties or perceptions you may have about the patent application process and mechanics of USPTO proceedings. Educate yourself about your legal rights and responsibilities. This empowers you to actively participate in your case. Decisions made during your case impact, for example, the strength of your patent, the breadth of your patent protection, and the enforceability of your patent. It is important that you understand the strategy, process, and documents filed with the USPTO, so don't hesitate to ask questions as needed. While your practitioner provides guidance, remember that you are an active participant and the ultimate decision-maker.

#8 - Show professionalism toward your practitioner.

Show gratitude for your practitioner's time, expertise, and work. A simple thank-you can go a long way in acknowledging their contribution and building your relationship. If you encounter any difficulties with your practitioner, attempt to show grace and talk with your practitioner to resolve the issues. If you are not able to reach a resolution, then you may wish to discontinue the representation. Similarly, if your interactions with your practitioner are not respectful and courteous, he or she may decline to continue the representation. In either situation, a replacement practitioner is not guaranteed.

Helpful United States Patent and Trademark Office (USPTO) Resources

- Free resources available from the USPTO (www.uspto.gov/FreeServices) include patent application assistance, education and training, help appealing or fixing an issue, and other services.
- Patent Pro Bono (www.uspto.gov/ProBonoPatents) provides resources for inventors and small businesses seeking free legal assistance preparing and filing patent applications.
- PTAB Pro Bono (www.uspto.gov/PTABProBono) provides resources for inventors and small businesses seeking free legal assistance with ex parte appeals to the Patent Trial and Appeal Board (PTAB).

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