


UNITED STATES
PATENT AND TRADEMARK OFFICE





Patent Trial and Appeal Board (PTAB)

Inventor Hour: Episode 33

LiLan Ren, Administrative Patent Judge

Ryan Flax, Lead Administrative Patent Judge

Michael Astorino, Administrative Patent Judge

Tawen Chang, Administrative Patent Judge

John Schneider, Administrative Patent Judge

Stacey White, Lead Administrative Patent Judge

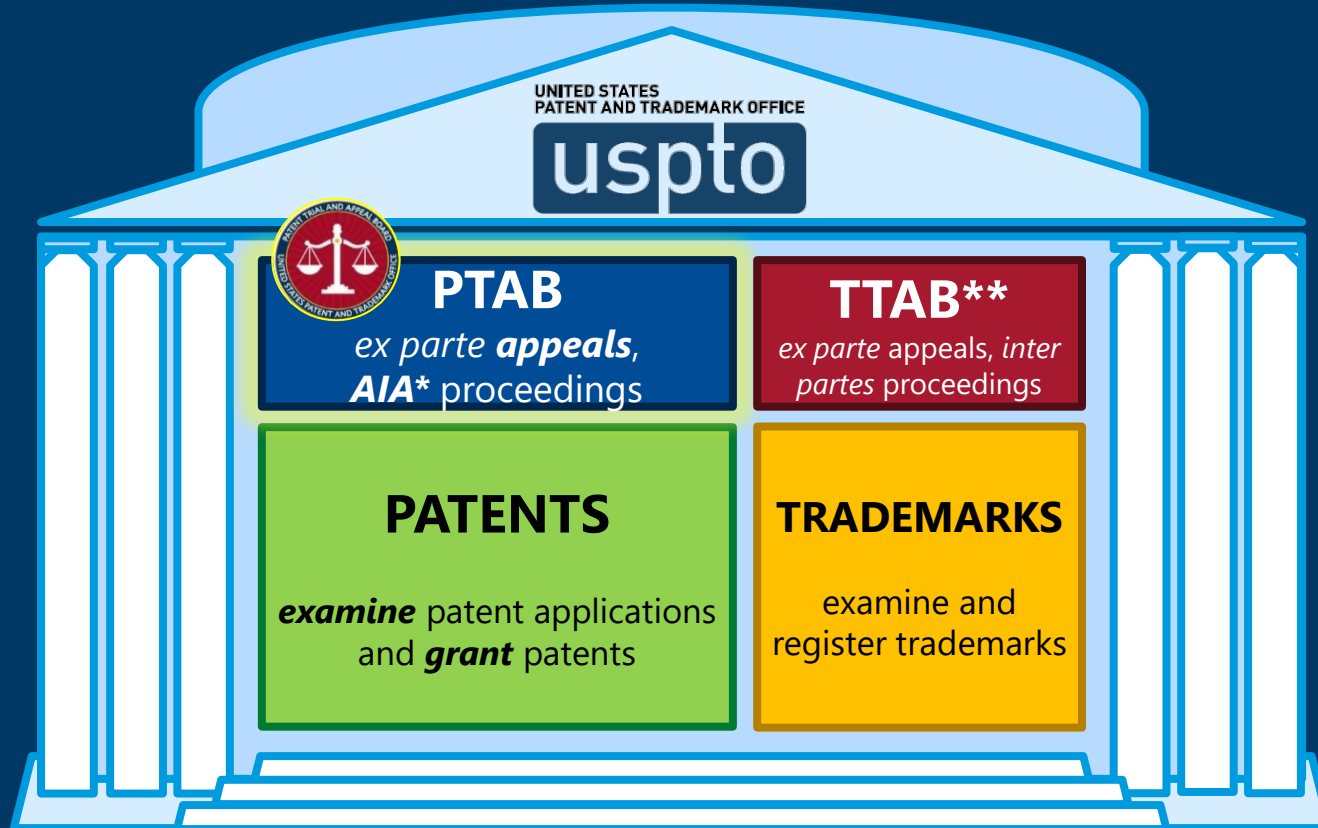
Special Guest: Michael Kim, Vice Chief Administrative Patent Judge

October 24, 2024

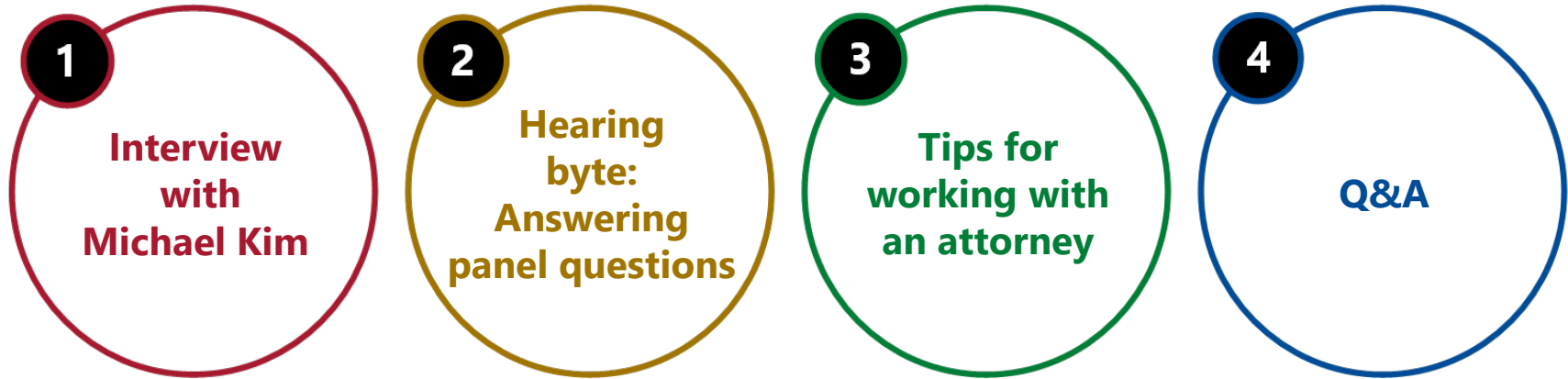


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What is the Patent Trial and Appeal Board?



Today's agenda



*Information not intended as legal advice

Question/comment submission

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

- PTABInventorHour@uspto.gov

Ryan Flax, Lead Administrative Patent Judge



An interview with Michael Kim

Vice Chief Administrative Patent Judge



Michael Kim

*Vice Chief Administrative
Patent Judge*

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PTAB LEAP Program

www.uspto.gov/LEAP



Legal **E**xperience and **A**dvancement **P**rogram provides training and oral advocacy opportunities for less experienced advocates to gain practical experience in proceedings before the Patent Trial and Appeal Board.



LiLan Ren, Administrative Patent Judge
Michael Astorino, Administrative Patent Judge
Tawen Chang, Administrative Patent Judge
John Schneider, Administrative Patent Judge



Hearing byte: How to handle panel questions at an oral hearing

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Journeys of Innovation



- Relatable stories that chronicle the journeys of inventors and entrepreneurs
 - Learn how they got their start, challenges they faced, and what it took to bring their ideas to fruition
 - Learn about the importance of creating and protecting intellectual property
- A new story each month: www.uspto.gov/Journeys
 - A brilliant touch (Ralph Teetor, blind inventor), October 2024



Stacey White, Lead Administrative Patent Judge



Tips for working with a pro bono attorney

Tips for working with a pro bono attorney

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.

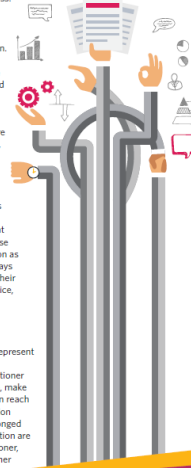
#3 - Listen to your practitioner.

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.

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#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.

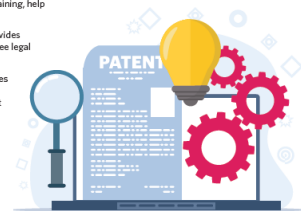
#8 - Show professionalism toward your practitioner.

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 free legal assistance with ex parte appeals to the Patent Trial and Appeal Board (PTAB).

Document created in collaboration with the USPTO Patent Trial and Appeal Board, USPTO Office of Enrollment and Discipline, PTAB Bar Association, New York Volunteer Lawyers for the Arts, and Texas Accountants and Lawyers for the Arts.



Tips for working with a pro bono client

TIPS for Working with a Pro Bono Client

#1 - Treat your pro bono client with dignity and respect.

It is important to treat pro bono clients with the same level of dignity and respect as you would any other client. Consistency in your approach to pro bono client representation demonstrates a commitment to justice for all. Your pro bono client may not be familiar with the patent system or the legal system as a whole, but your passion for their invention and keen interest in the outcome of the proceeding is not diminished by their lack of financial resources.

#2 - Make sure that your pro bono client understands your engagement letter.

Provide your pro bono client with an engagement letter at the beginning of the representation. This letter will outline the scope of the representation—be detailed as to what services you plan to provide. Use plain language and ask whether the pro bono client has any questions. A frank discussion at the beginning of the representation can help to avoid misunderstandings later, for example, about what the representation does and does not cover. Be clear about any and all costs and/or fees (e.g., USPTO fees) your expert the pro bono client to pay. Make sure that your client understands the extent of those costs and is prepared to pay them when required.

#3 - Understand your pro bono client's goals.

Make sure you understand your pro bono client's needs, goals, and priorities. Also, make sure that you have a clear understanding of the particular features of their invention and how it works. After being matched with a pro bono client, discuss their objectives for the proceeding and identify any hurdles, limitations, or perceptions about the process that the pro bono client may have experienced so far. To effectively represent your client, you must have this awareness. Setting the right tone from the outset of the representation will enable you to have open dialogue that will be needed throughout the representation and help you to create a trusted relationship with your client.

#4 - Help your pro bono client understand the patent system.

Ensure your pro bono client has a solid understanding of the patent system. The USPTO provides resources to help the public understand the patent system and the various proceedings before the USPTO. Direct your client to these resources and answer questions that they may have regarding the process. An informed pro bono client is an asset to you in the representation.

#5 - Be an effective communicator with your pro bono client.

Communicate effectively with your pro bono client. Explain complex legal concepts in a clear and accessible manner. Avoid "legalese" use plain language whenever possible, and be mindful of any language barriers. It is important to listen carefully to your client's questions and answer those questions as completely as possible. As much as you reasonably can, anticipate questions your client should ask (but may not know enough to ask), and provide answers to such questions, whether asked or not.



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#6 - Set expectations regarding communications with your pro bono client.

Be clear about what is expected from your pro bono client and any deadlines that must be met. They may be difficult to reach at times, so it is a good practice to ask them about the best times they can be reached. Establish the best ways to reach the client at the outset of representation (e.g., email, text, or phone) and make sure that you have their most up-to-date contact information. Once you make an appointment with a pro bono client, stress that if they cannot make that time, then they should contact you as soon as possible to let you know. Set realistic expectations as to when they may expect to hear from you and follow through on those commitments to avoid the impression that you are not taking the matter seriously. If the pro bono client cannot speak with you when you contact them, set up a specific time that is convenient for both of you when you can call back. Give plenty of advance notice for appointments, and if possible, you may want to remind them a day or two ahead of time. If you need documents from a pro bono client, give advance notice so they will have sufficient time to find and provide the documents. Be mindful of potential issues they may encounter when sending you documents (e.g., size limitation on email or costs associated with delivery of hard copies).

#7 - Build trust with your pro bono client.

Show up for your pro bono commitments. Reliability builds trust and ensures that pro bono clients receive the assistance they need. Your client may have had many difficulties getting to this point and that may make them initially distrustful of the legal profession. Any such distrust will only be worsened if you fail to follow through on commitments made to them. It is important to be clear about when the pro bono client can expect to hear from you. Be careful not to overpromise. Hold yourself to the highest standard of professionalism and create an atmosphere where the client can trust your word. Your pro bono client is counting on you to help them navigate the patent system.

#8 - Have patience and empathy for your pro bono client.

Approach each pro bono client with patience and empathy. They may have limitations on their schedule due to work and/or family commitments. Additionally, your client may have challenges related to language barriers, access to technology, and transportation. Take the time to find out about any such challenges and find creative ways to work around these issues. Ask about what modes of communication they are most comfortable with and establish expectations regarding communication, such as how often email is checked and what time frames to expect a reply to an email. For example, you may be accustomed to checking and responding to email throughout the day, however, your client may not prioritize email and may not routinely communicate through email. Do not assume that the lack of an email response from the pro bono client means that they are not being responsive.

Helpful United States Patent and Trademark Office (USPTO) Resources

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- 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).

Document created in collaboration with the USPTO Patent Trial and Appeal Board, USPTO Office of Enrollment and Discipline, PTAB Bar Association, New York Volunteer Lawyers for the Arts, and Texas Accountants and Lawyers for the Arts.



Goal

Offer suggestions for ways that inventors and volunteer attorneys can work better together

Creation

Joint effort by PTAB, USPTO Office of Enrollment and Discipline, and three pro bono program administrators

- PTAB Bar Association
- New York Volunteer Lawyers for the Arts
- Texas Accountants and Lawyers for the Arts



Tip 1:

Communicate goals with your attorney

- Discuss your objectives and any hurdles or limitations that you have experienced so far
- Being honest and transparent with your attorney is crucial to the relationship

Tip 2:

Understand your engagement letter

- Review your engagement letter and make sure that you understand what the attorney will and will not do and what fees you are expected to pay
- If you have questions about the engagement letter, ask your attorney to explain

Tip 3: **Listen to your attorney**

- Your attorney is knowledgeable about patent law and experienced
- Your attorney aims to do their best for you
- If you have doubts about their advice, discuss them openly and ask questions, but try to trust their judgment

Tip 4:

Be respectful of your attorney's time

- Your attorney has limited availability as they often represent several clients and matters at the same time
- Keep your attorney informed of significant developments or new information
 - No need to contact with daily updates or status requests
- Make sure that your attorney has all of your up-to-date contact information so that they can reach you
- Be responsive to your attorney's messages and requests

Tip 5:

Establish the timing and manner of communications with your attorney

- Discuss the timing and manner of communications with your attorney to set expectations; they often work outside of normal business hours
- Exhibit patience when awaiting a response from your attorney

Tip 6:

Be prepared for meetings with your attorney

- Gather any relevant information and/or documents to bring with you to the meeting with your attorney
- Come with a clear agenda
- Consider developing a list of questions and concerns to stay on track
- Consider taking notes during the meeting

Tip 7:

Ask questions of your attorney

- Actively participate in your case and ask questions of your attorney if you don't understand
- You are ultimately the decision-maker

Tip 8:

Show professionalism toward your attorney

- Extend a thank you
- Gratitude goes a long way in building a relationship

Question/comment submission

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Access our free services


The United States Patent and Trademark Office (USPTO) offers a wide range of intellectual property (IP) resources, including application assistance, education and training, and other services that support the full spectrum of customers—from independent patent and trademark filers, to attorneys and business advisors in both the private and public sectors. Learn more about what USPTO is doing to expand participation in the innovation ecosystem through [inclusive innovation](#), including our [Council for Inclusive Innovation \(CII\)](#).











Using the icons below, select a category to filter the list by your area of interest.


All Resources


Patents


Trademarks


Attorneys and Business Advisors

Title	Description	Resource category
Application Assistance		
Application Assistance Unit (AAU)	Provides assistance with questions and issues pertaining to pre-examination processing of patent applications and the post-examination processing of patent applications.	
Finding a patent practitioner	Search the registry of active patent practitioners who are eligible to represent others before the USPTO in patent matters.	 
Hiring a U.S.-licensed attorney for trademarks	Discover if you are required to hire an attorney and why you should hire an attorney for trademark matters, even if you are not required to.	 
Inventors Assistance Center	Provides patent assistance and information to the public to help make filing a patent application simple and efficient before, during, and after the patent application process (i.e., patent maintenance).	
Law School Clinic Certification Program	Under the supervision of an approved faculty clinic supervisor, law school students provide pro bono representation to individuals and small businesses throughout the country in the prosecution of patent and trademark applications before the USPTO.	 
Patent and Trademark Resource Centers	Nationwide network of 80+ libraries that offers the public trademark and patent assistance. These libraries provide access to examiner-based search systems, and staff demonstrate how to use search tools and offer classes on intellectual property.	 



Questions?

Future programs

Inventor Hour, Episode 34

Thursday, Jan. 23, 2025, noon (ET)

Inventor Hour, Episode 35

Thursday, Feb. 27, 2025, noon (ET)



