

10 Things Every New Patent Practitioner Should Know



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How to write a patent application

One of the most basic things any new patent practitioner needs to learn is how to draft a patent application. But writing a patent application is not as easy as many believe.

PLI has a treatise titled *How to Write a Patent Application*, which is excellent but pricey. It is written for attorneys and patent agents, where *Patent It Yourself* is written for independent inventors.

How to Write a Patent Application walks you through working with the inventor, doing patent searches, writing the specification, drafting claims and filing a patent application.

LexisNexis has an excellent, although more advance book titled *Rules of Patent Drafting: Guidelines from Federal Circuit Case Law*.

IPWatchdog.com also has hundreds of articles on drafting applications and writing claims for both beginners and those who are more advanced.

National Association of Patent Practitioners

The National Association of Patent Practitioners (NAPP®) is a 501(c)(6) nonprofit trade association. The organization was founded by patent practitioners, mostly patent agents, who had an interest in forming an organization that is focused on procedure before the USPTO. NAPP supports its members by disseminating information via newsletter and its two e-mail discussion forums: The General Discussion Forum and the Patent Practice Forum™. The General Discussion Forum provides a forum for members to discuss a variety of issues from member-to-member referrals to Patent Law Reform. The Patent Practice Forum™ is focused strictly on patent practice issues and allows for an on-going daily discussion between members on issues related to practice before the USPTO, PCT Practice and Foreign patent practice. These discussion forums are extremely active, and members ask for and provide substantive advice on a daily basis. If you have a question someone in the organization will almost certainly be able to point you in the right direction.

It can be extremely difficult to find malpractice insurance for patent work, but NAPP has worked together with an Insurance company to create affordable malpractice insurance. Every patent agent, patent attorney or patent firm should join NAPP just for the insurance.

Finding a Job

The way you get a job is through networking.

There are numerous patent bar associations scattered across the country. Find one that is nearby that have regular meetings (typically monthly meetings) and join. Do not arrive resume in hand, but certainly have business cards.

First, you must identify what YOU bring to the table that is unique. If you qualify to take the patent bar exam chances are that you have some meaningful scientific background. Focus on those things that you know something about and do a patent search in order to find out which attorneys and which firms are operating in that space.

Target those firms, and consider tailoring your resume for the job for which you are applying.

Finding Work

The way you get a job is through networking.

One way that many patent agents and solo patent attorneys pick up work is by being available to help other patent attorneys and larger firms with what is known in the industry as "overflow work." An established patent attorney might find himself or herself overwhelmed with work several times a year.

Networking and letting others know you are available to accept overflow work is a great way to get started when you are trying to establish your own practice. So too is speaking at inventor organizations or even hosting your own inventor forums at a local library or community center. Writing articles online and looking for and accepting speaking engagements that you can credibly handle builds the aura of expertise, which translates into trust.

Reading Patents and Files

One way you can learn about what goes on in a patent case is to read patents and then review file histories. As we all know, there is very little you cannot learn if you are willing to read and put in the time. Do a patent search to find some patents that you know something about from a technical standpoint and then read them. If you read enough patents, particularly well drafted patents, you will start to see patterns. When you find some patents that you think seem particularly well written go to Public PAIR and find the file history. Read the rejections given by the patent examiner and read the Amendments filed by the applicant's attorney or agent. You might want to save some of the patents and responses that you find particularly interesting so that you can create your own file of examples.

Patent Searching

If you are going to do your own patent searching you will want to become familiar with the United States Patent Office patent search page. There is also another excellent (and free) site that you should consider using when searching – Free Patents Online. Perhaps the best thing about Free Patents Online is that they provide copies of the actual PDF documents, which contain all the images. There are also a number of other free solutions, like Patentory.com.

Google also offers patent search functionality with Google Patent Search, which is lightning fast (unlike the USPTO online database) but does not have that many search fields and some find difficult to use. Additionally, the most recent patents are not typically available on Google. What this means is you should not rely only on Google, but you really must use Google. The Google database covers patents that are issued all the way back to US Patent No. 1. This scope is much broader than either Free Patents or the USPTO. So, while you might not find everything, you really need to check yourself using the Google database.

Confidentiality: Prospective Clients

The minute a client contacts you to seek your advice or potentially hire you the attorney-client privilege (or agent-client privilege) attaches and everything you learn must be kept confidential. But what if you do not accept the case? You still must keep information confidential.

One particular problem arises, however, when the individual believes you have accepted the case. If the prospective client thinks you represent them then you do, regardless of whether you actually entered into a representation agreement or not.

This is one of the many reasons why you want to make sure that everyone understands that representation will not be accepted or undertaken unless and until a written representation agreement has been entered into.

Client Agreements

A written agreement sets the expectations for what you will do and deliver, and it can also be quite useful for setting any expectations or obligations the client will have, such as providing information relating to an invention, reviewing drafts, and providing feedback.

Client Agreements are also important in order to explain payment terms to clients. Patent practitioners will frequently quote work on a project basis rather than charge by the hour. This provides cost certainty to the client, which clients like, but it can create headaches for practitioners if terms are not thought through. What if the project is not completed because the client refuses to participate and provide the feedback you need, or they simply disappear? Will the client be able to ask for revisions? How many revisions? If the invention changes as the application is in process, or significantly expands, will the same flat fee quoted apply?

Client Trust Accounts: Retainers

One thing that virtually every patent attorney and patent agent learns is that if you do not get the money from the client up front you are not likely to get paid without expending large amounts of time chasing clients for payment. At the end of the day you will also simply not be able to collect everything you are owed because clients will sometimes simply refuse to pay, particularly if you opined that their invention is not patentable. It is a sad reality, but the last person in line to be paid always seems to be the lawyer.

This is why most require payment in advance for the services to be rendered, unless the client is a well-established corporation or a long-term client you feel comfortable billing because of a track record of payments. What is critically important to understand, however, is that if you are going to accept payment in advance you absolutely **MUST** have a separate bank account that you use **ONLY** for the purpose of holding client money that has not yet been earned. This is called a Client Trust Account.

You **ABSOLUTELY CANNOT** co-mingle business funds with unearned funds, and you **MUST** have a separate bank account.

Ending a Representation Relationship

When a relationship is over it is the obligation of the attorney or agent to clearly and with no uncertain terms communicate the finality of the relationship to the client. No ambiguity can be tolerated because if there is ambiguity what the client believes is what will govern. Thus, when a client contracts for work on a project-by-project basis it is critical that the final reporting letter explain that all work is finally completed, and no further work will be done on behalf of the client. Similarly, if you are awaiting communication or instructions from a client that needs to be put in writing clearly. Likewise, when an ongoing representation has finished, perhaps because a patent has been obtained, you must close out the file and sent a letter to the client explaining the file is closed and no further action will be taken, or work undertaken on behalf of the client. Of course, you can invite the client to contact you if they need assistance, but the ball needs to be placed in the client's court.

The End

Q&A



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