

Hiring an Intellectual Property Lawyer



Contacting a lawyer can be intimidating. What type of lawyer do I need? How do I find one? What will it cost? How do I decide?

Some considerations...

There's an old saying that "nobody likes lawyers... until they need one." Many times you need a lawyer because something bad has happened. You've been sued. You're fighting with your

business partner. An employee or customer is alleging misconduct.

But it can be even more important to talk to a lawyer when things are good. A lawyer can help you avoid that lawsuit, clearly document your partnership relationship, or avoid activities that may unknowingly violate the law. A lawyer should be seen as a trusted advisor and someone you can lean on to provide good advice when needed, protect your assets, and help your business grow.

Intellectual property (or "IP") lawyers help develop, register, protect, and defend patents, trademarks, copyrights, and trade secrets.

- **Patents** are exclusive rights granted for inventions by the federal government through the U.S. Patent Office. Patents typically involve a product or a process that provides new ways of doing something, or offer new technical solutions to a problem. The government also grants **design patents**, which protect the ornamental appearance of an invention – how a product looks (but not how the product works or functions).
- **Trademarks** are brand names – typically a word, phrase, slogan, or logo – used to identify a business or its products or services. Trademarks can be registered with the U.S. Patent and Trademark Office, which provides enhanced ownership rights and remedies.
- **Copyrights** are exclusive rights in creative works that are fixed in a tangible medium, such as sculptures, books, drawings, songs, paintings, or computer programs. Exclusive rights granted under copyright law include the right to control the reproduction, distribution, performance, and display of your works. Copyrights are registered with the U.S. Copyright Office.
- **Trade secrets** are confidential information you own that is not generally known to the public, that provides your business with an advantage over your competitors, and that you take appropriate steps to maintain as secret.

If you are looking for an IP lawyer, it can be difficult to know where to start and what to expect. Here is some information and advice.

Finding a Lawyer

There are over 1.3 *million* lawyers in the United States.¹ Some work in government, some in-house for a public or private company, and some in private practice. It can be daunting to know where to start your search.

Attorney Referrals: If you have used a lawyer in the past, check with him or her about a referral. Even if the attorney does not handle IP matters, he or she probably knows someone who does.

Even if you have never hired a lawyer you probably know someone who has. Reach out to fellow business owners and friends for recommendations. Don't hesitate to ask that parent at the soccer game who once mentioned a bankruptcy law case she worked on. She likely knows an intellectual property attorney, too, or can steer you in the right direction. Real estate agents, tax advisors, and accountants often work with lawyers and those lawyers may work with or know someone who specializes in IP law.

State and local bar associations often provide lawyer referral services. Take a look at your local bar association website.

Get Multiple Referrals: If possible, get multiple referrals. Availability, costs, or a willingness to take you on as a client might be obstacles with the first lawyer you contact. Lawyers have different communication styles, and communication is key to a successful relationship. It is good to speak to a few before selecting the one you feel most comfortable with and who has the expertise (and availability) you need.

Do Your Research: Before contacting an intellectual property law attorney or firm, do some research on your own. Most attorneys have a website where they provide information about themselves, their education and experience, and their practice areas. Attorneys are often members of different mandatory or voluntary local, state, or national bar associations. Those who represent clients before the U.S. Patent Office must take and pass the Patent Bar Examination. These associations provide important information about attorney bar members, which can include whether the member is currently licensed and in good standing and whether the attorney has ever had any bar complaints or been involved in disciplinary proceedings.

Conflict Checks: When you first contact an attorney or law firm, be prepared to provide some basic information for what is called a "conflict check." A good IP attorney will want to make sure helping you with your business brands and inventions will not conflict with work provided to another current or former client. Do not be surprised if before the first meeting you are asked to provide your name, your business name, the names of any co-owners or key employees of the business, the trademarks you are inquiring about, the general subject of the patent you seek, and information about any adverse or potentially adverse parties. It can take some time for a lawyer or law firm to run this preliminary information through a client conflict database and past other attorneys at the firm. If after a conflict check an attorney responds he or she cannot handle your case, don't jump to any conclusions. A lawyer will often decline a representation if they believe there is even a potential the representation might conflict with trademarks or patents handled for other clients. After all, the attorney wants to be 100% on your side.

¹ <https://www.statista.com/statistics/740222/number-of-lawyers-us/>

The First Meeting: Remember that lawyers are selling legal advice and legal services, which are often measured by the time involved in the matter. Before your first meeting, find out if the lawyer will charge for the meeting and the fee amount. Many lawyers do not charge for an initial consultation, usually limited to a certain amount of time, such as 30 minutes or an hour.

Other lawyers may charge for the initial meeting, either for a fixed amount or at an hourly rate, depending on how long the meeting lasts. Find out how much time the attorney has for the initial meeting, whether you will be charged for the meeting, how much that charge will be, and how it should be paid. If the lawyer doesn't mention a cost, *ask*. Just because an attorney doesn't tell you she is charging you for a meeting doesn't mean she won't send you a bill and expect to be paid. No one likes surprises, so make sure you understand the costs up front.

Use Your Time Wisely: The first meeting with an attorney could be in person, by telephone, or by video. At the meeting, the lawyer will evaluate your business and legal concerns and help you identify a proper course of action. But the lawyer is also evaluating *you* as a potential client. A lawyer sells time, and if it seems like the potential matter is going to take more time than he has available (or will cost more money than you are willing to pay), he may decline the representation.

Go to the meeting prepared and ready to discuss relevant facts, provide pertinent information, and answer questions truthfully. Take important documents, product examples, designs, drawings, or anything else that will help the attorney quickly grasp the nature of your business and the services you require. Don't tell the attorney to go to your website to find information (although she has probably already been there). Instead, print and take (or email in advance) pertinent information.

Attorneys often want information about a client's business, its products, its services, its competitors, and the industry in general. But remember time is money. As much as you may love talking about how you built your business from scratch and all of the obstacles you encountered along the way, consider whether that information is relevant to the meeting and a good use of your limited time.

Legal Fees: Before the meeting concludes, make sure you ask about legal fees and costs if it hasn't come up already. Some lawyers handle work on a flat-fee basis (*e.g.*, this much for a new trademark application, this much for an agreement or letter). Some lawyers bill by the hour, in which case you will want to know the lawyer's hourly rate and the hourly rate of others at the firm who might work with her, as well as the anticipated billable time the project will take. But rates aren't everything: A more expensive attorney who estimates two hours for a project may be a better choice than a lower-rate attorney who estimates three hours.

A lawyer should put anticipated fees, hourly rates, and estimated costs in writing. If he or she doesn't, do not hesitate to send a confirming email to the attorney summarizing your understanding of expected charges. It happens frequently that a client and lawyer have a falling out over money, quite often when the time involved is greater (and the bills are higher) than anticipated.

The Bottom Line is Good Communication: The most successful lawyer/client relationship is one with a foundation of trust and good communication. Work with an attorney you like, who communicates well with you, keeps you updated on actions taken, responds to emails and telephone calls promptly, and answers your questions in a manner you understand. A good lawyer will become a valuable member of your team and trusted advisor, helping you navigate complex legal issues so you can focus on the day-to-day business activities you love.

About HARTMAN TITUS



Hartman Titus is a U.S. law firm focusing on trademark, patent, copyright and other intellectual property transactions and litigation, business matters, and general commercial litigation. The firm represents a broad range of U.S. and international clients, including large corporations, middle-market companies, non-profits, and small businesses. The firm has been selected as a “Best Law Firm” by *U.S. News and World Report* for each year 2013 to 2021. Firm attorneys also were selected as a “Best

Lawyer” in each of the 2011 to 2021 editions of *Best Lawyers in America*. Since 2014, Brad Hartman has been selected “Lawyer of the Year” in various areas of intellectual property law and litigation. In 2021, Brad was named “Lawyer of the Year” for his trademark law work in Phoenix, Arizona.

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