Suggested Checklists for Intake Process of US Counsel

Engagement between US Counsel and Client

☐ Federal Circuit Bar Association (FCBA) matched OUS Counsel with US Counsel, and received preliminary National Phase Application information (e.g., WO Publication number).

☐ Perform conflict check in accordance with standard operating procedures.

☐ Conflict check clears – Contact the FCBA as soon as possible to report the clearance and acceptance of the National Phase Application; receive contact information for the OUS Counsel from the FCBA, prepare engagement letter/rules of representation for the Client; and forward engagement letter/rules of representation to OUS Counsel in an introductory communication.

OR

☐ Conflict check does not clear – contact the FCBA as soon as possible and return for re-assignment.

☐ While each US Counsel or his or her law firm will have its own policy for engagement and representation, the US Counsel should send an engagement letter/rules of representation to the OUS Counsel for execution by the Client to create the attorney-client relationship. It is recommended that the engagement letter/rules of representation address the following:

☐ Continued pro bono client qualification – The client will promptly communicate any changes to the information they provided for pro bono status eligibility to the OUS Counsel. The OUS Counsel should promptly pass any such information along to WIPO for continued evaluation of pro bono client qualification.

☐ Limitation of representation to commitment to file – the engagement letter may be limited to a single event (e.g., a single National Phase Application filing, a single OA response in a National Phase Application, etc.), as it may be infeasible to have perpetual representation for these pro bono cases. For example, if US Counsel is only going to file a National Phase Application, the engagement letter should make it clear that the US Counsel is only responsible for that National Phase Application and for responding to any formality requirements, and that the responsibility does not include any prosecution-related matters subsequent to the filing of the National Phase Application and responding to any formality requirements.

Also, it is advisable to provide clear communication (documented in an email or letter) to the Client that outlines what the limited representation includes in the grand scheme of the patent prosecution process and what is not included in the limited representation. For example, if US Counsel is only filing the National Phase Application and responding to any formality requirements, US Counsel should make sure the Client
understands the patent process does not end with the filing of the National Phase Application and provide information on what the Client can expect to happen next.

In the instance of limited representation, the recommended course of action for US Counsel is to only act in a representative capacity (i.e. no power of attorney is filed with the application). Acting in a representative capacity allows the US Counsel to use the correspondence address of the US Firm for the filing in order to receive communications from the USPTO regarding post-filing informalities, while also allowing for the US Counsel to change the correspondence address to that of the OUS Counsel or Client after post-filing formalities are taken care of, in accordance with the engagement letter. Note that filing an application in a representative capacity obviates the need to submit a PTO/SB/83 (04-13) (withdrawal of attorney or agent) since there is no Power of Attorney filed before the USPTO.

Optionally expanding the representation for commitment to prosecute – A commitment to prosecute may be made by the US Counsel as well, at any time, though it is not required for a US Counsel to prosecute the National Phase Application. Please note that such an expansion should be reflected in supplementation of the engagement letter.

Withdrawal – The US Counsel may withdraw if the Client is unprofessional (e.g., abusive, non-responding), or does not advance payment of the fees described herein. For example, the Client should understand that either the client or the US Counsel may terminate the attorney-client relationship at any appropriate time. US Counsel may elect to withdraw for reasons which might include, but not be limited to, failure of the Client to cooperate fully in representation, failure to provide advance payment of fees, or failure to follow advice on a material matter or any fact or circumstance that, in view of US Counsel, renders continuing representation unlawful or unethical. In addition, the Client should understand that, if not previously terminated, the attorney-client relationship will terminate upon the later of: (1) US Counsel forwarding of the Official Filing Receipt to the OUS Counsel/Client; or (2) US Counsel reporting to the OUS Counsel/Client the filing of a response to any formality requirements received from the USPTO concurrent with the forwarding of the Official Filing Receipt. Upon termination, US Counsel may file a Change of Correspondence Address with the USPTO which will result in all subsequent USPTO correspondence being mailed only to the OUS Counsel/Client address.

During withdrawal from representation of the Client, it is important again to have clear communication (documented in an email or letter) to let the Client know that US Counsel is withdrawing in accordance with the engagement letter, and what the Client can expect to happen next (such as receiving an Office Action from the Office in a year or so). Also, it is advisable to emphasize that the Client needs to keep the correspondence address that they provide to the USPTO up-to-date for the foreseeable future, and that the Client
should re-engage with the Inventor Assistance Program for assistance if they are unable to respond to any office communication themselves.

☐ Contact with client – Upon execution of the engagement letter by the client, an attorney-client relationship is established between the client and the US Counsel. The OUS Counsel will be involved in the introductory communication and should remain as a liaison between the Client and US Counsel through-out the attorney-client relationship. However, the US Counsel service depends upon cooperation by the Client. This includes the Client remaining in communication with the US Counsel, providing a current address and telephone number, and ensuring that instructions and/or information provided to the US Counsel are accurate, complete and timely. If US Counsel is unable to contact the Client directly or via the OUS Counsel at the provided address, without our being informed of a new address, the US Counsel may consider that a termination of representation of the Client and will have no further responsibility for this matter.

☐ Payment – Applicable USPTO fees are to be provided to the US Counsel in advance of filing. The US Counsel is under no obligation to advance fees to the Client. For example, US Counsel will provide the patent legal services (e.g., filing the National Phase Application) to the Client on a pro bono basis. US Counsel will not charge for professional time and will not charge for routine office expenses. However, depending on the nature of the representation, there may be expenses or costs that US Counsel will ask the Client to pay. For example, there are official fees that must be paid to the USPTO in connection with filing the National Stage Application and, in some instances, addressing formality requirements. These fees may include, but are not limited to, filing fees, excess claim fees, processing fees, extension of time fees, and the like. The Client will be solely responsible for all official fees, and US Counsel may require payment from the Client prior to paying such fees to the USPTO. US Counsel should discuss any official fees with the Client as they arise.

National Stage Filing

☐ Instructions received to file National Stage Application.

☐ Confirmation of entity status:

☐ Large  ☐ Small  ☐ Micro

☐ Advance payment of filing fees.

☐ Application as filed in Word format. The US Counsel is not obligated to file more than three independent claims and more than twenty total claims. The US Counsel may, however, choose to offer to file more claims, provided the USPTO fees are paid in advance.
☐ Drawings as filed (or replacement drawings submitted) in PDF, Visio, or Word format. If the US Counsel considers the drawings to be substandard, the US Counsel may notify the OUS Counsel that better drawings are required and that the OUS Counsel should provide better drawings, or else the drawings that were received will be the ones that are filed. The US Counsel may, however, choose to offer to obtain better drawings, provided the cost is paid in advance.

☐ Translation of the National Stage Application in Word format (if not in English). If the National Stage Application is not in English, the OUS Counsel should provide an English translation that is an exact replication of the International Application as filed, per US requirements. The US Counsel may, however, choose to offer to obtain a translation, provided the cost is paid in advance.

☐ Copies of any demand or amendments (e.g., Article 19 or 34 amendments) made during international phase in Word format.

☐ Translation of any demand or amendments (e.g., Article 19 or 34 amendments), and any annexes (if not in English).

☐ Verify all priority documents received (PCT/IB/304).

☐ If applicable, verify assignment executed for priority application(s).

☐ US Counsel to provide to OUS Counsel for execution, and OUS Counsel to return as soon as possible, and preferably before the 30 month deadline:

  ☐ Executed Oath/Declaration;
  ☐ Executed Power of Attorney (optional); and
  ☐ Executed Assignment (if applicable).

Determine if 92bis request for change is necessary.

☐ Yes ☐ No

Has the PCT application been assigned to another entity?

☐ Yes ☐ No

If the PCT application been assigned to another entity, does that entity qualify for pro bono representation?

☐ Yes ☐ No
Does any third party have any rights to the invention disclosed in the PCT application?

☐ Yes ☐ No

If any third party has any rights to the invention disclosed in the PCT application, does that party qualify for pro bono representation?

☐ Yes ☐ No

Has any other relevant information changed since the OUS attorney filed the PCT application?

☐ Yes ☐ No

Is the client or OUS attorney aware of any prior art or other information that may be material to patentability and needs to be disclosed to the USPTO?

☐ Yes ☐ No

☐ A list of all references cited in the International Search Report, specification of application, any foreign priority application search or examination reports, and any other references material to patentability known to anyone involved with the application.

☐ Provided copies of all references.

Is participation in the Patent Prosecution Highway (PPH) possible due to a favorable report from a corresponding application (Written Opinion, IPRP, Notice of Allowance, etc…)? If so, does client want accelerated examination via PPH?

☐ Yes ☐ No

☐ If PPH is applicable, has OUS Counsel provided a copy of the favorable report.
Suggested Checklist for Workflow of US Counsel

☐ Docket new application.

☐ Check for missing application requirements. If Oath/Declaration, translation, or other required documents are missing at the time of receipt of the case, the US Counsel should inform OUS Counsel that a Notice of Missing Requirements will issue in their absence, and that a response to the Notice may be prepared at a later date, and may include incurring additional fees.

☐ Review translation, making sure it is of the entire application; review translation of Article 19 or 34 amendments and any annexes. If translation(s) are not acceptable, US Counsel should request new translations from OUS Counsel, or suggest a translation service.

☐ Review drawings; request new ones from OUS Counsel if sub-standard.

☐ Review claims, removing any and all multiple dependencies. The default should be to file a single patent application at USPTO with no more than three independent claims and no more than twenty claims total. If the US Counsel realizes that the default will be exceeded for a particular invention, the US Counsel should calculate the excess claims’ fees for filing as a single US National Stage patent application and the cost of filing as multiple US National Stage patent applications. The US Counsel should then contact the OUS attorney explaining the alternatives and costs. The US Counsel, however, is under no obligation to file more than a single application with the default claim counts.

  a. If the OUS Counsel is not satisfied with three independent claims and twenty claims total, and if the US Counsel is unwilling to file more claims than that, then the US Counsel may withdraw and the OUS attorney can contact a different US Counsel on the US Volunteer Counsel List.

  b. If the OUS attorney does not respond in time for US National Stage Entry, then the US Counsel, at his or her own discretion, may make the selections, or file all the claims, provided the excess claims’ fees have been paid in advance or the US Counsel has received reasonable assurances that he or she will be reimbursed for them.

☐ Make sure the fees have been paid in advance and for the correct amount.

  a. The US Counsel should require certain information from the OUS attorney as to the inventor’s entity size status in order for the US Counsel to calculate the correct fee amounts.

  b. If the fees are not paid in advance, the US Counsel may withdraw, but may choose to offer to file the patent application without payment of fees, which will result in a late fee by USPTO. The bill would be sent to the OUS attorney.

  c. It is recommended that the Client establish a sufficient retainer amount in escrow from which fees can be drawn. This is to safeguard against later Client insolvency or against other reasons for the Client not being able to timely pay, including incapacity.
Check the Written Opinion(s) and/or ask OUS Counsel if any positive examination reports exist that would qualify participation in the Patent Prosecution Highway (PPH) program. Advise OUS Counsel regarding if any are applicable and request advice whether applicant is interested in accelerating examination.

Review for any other applicable possible pilot programs or petitions for acceleration (Cancer Immunotherapy, Petitions to Make Special Base on Age/Health, etc...). Advise OUS Counsel regarding if any are applicable and request advice whether applicant is interested in accelerating examination.

File Application

Recommended Steps:

Prepare and file the application, including an Application Data Sheet designating the application as a National Stage filing. See, e.g., Transmittal Letter PTO-1390: https://www.uspto.gov/sites/default/files/documents/pto1390.pdf; and Application Data Sheet AIA0014: https://www.uspto.gov/sites/default/files/documents/aia0014.pdf.


File copies of any IPRP, IPER, or other documentation that includes amendments made during international phase, and English translations, if required.

Depending on the outcome of the dialogue between US & OUS Counsel, file preliminary amendment and/or substitute specifications, if needed.

Pay filing fees in accordance with the discussion between US & OUS Counsel.

File Information Disclosure Statement (required if filing PPH).


Report filing to OUS Counsel. The US Counsel should send the OUS Counsel a digital file including a .pdf copy of the USPTO filing, the WORD.doc copies, and any pertinent notes/materials received from the OUS Counsel or Client.

Complete case closing form and report to FCBA when US Counsel receives the US National Stage Filing Receipt and Notice of Acceptance of Application from the USPTO. In the instance that the US Counsel has agreed to prosecute the National Phase Application, then complete a status update form upon receipt of the US National Stage Filing Receipt and Notice of Acceptance of Application and report to FCBA, and upon conclusion of prosecution (e.g., abandonment or grant) complete case closing form and report to FCBA.