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**RE: YOUR OBLIGATIONS TO PRESERVE RIGHTS FOR SUBSEQUENT IP  
FILINGS BASED UPON AN ORIGINAL IP FILING**

Dear Colleague:

**I. YOUR OBLIGATIONS TO PRESERVE RIGHTS**

If you have recently filed an original application for intellectual property (IP) rights, this notice applies to you. An original application filing for IP triggers filing deadlines for subsequent IP filings under US law and international treaties. By filing deadline, we mean a legal deadline for subsequent application filings for the same subject matter as an original filing. These filing deadlines exist for US nonprovisional patent applications, foreign national patent, design, and trademark applications, Hague design applications, and PCT utility applications.

To minimize the risk of failing to effect these subsequent IP filings by their filing deadlines, you need to calendar taking the following actions at 6 months; 3 months; 3 weeks; and 1 week prior to any filing deadline, or entry deadline arising due to your recent filing

For trademark, US design, and Hague design applications, the filing deadline is 6 months from the original filing for the same subject matter.

For utility patents, the filing deadline is 12 months from the original filing for the same subject matter.

By entry deadline, we mean a deadline for regional and national stage entries of a PCT application. For PCT applications, the national stage entry deadline is 30 months from the original filing date for the same subject matter claimed in a PCT application.

What follows in red are the deadlines and actions keyed to the filing deadline or national stage entry deadline, for your original application.

**At 6 months prior to the deadline/entry date**, you must provide Neifeld IP Law (herein after "us" or "we") with the following information: a tentative list of countries (including the United States) and agents in the countries other than the United States that you want engage. If you have no agent for a particular country, we will contact one and provide you their estimate, and you are then free to accept or reject that agent. We will obtain estimates of the filing costs from your agents and you can then decide on a final list of countries in which to file.

**At 3 months prior to the deadline/entry date**, you must provide us with a final instruction specifying (1) countries/regions you selected for application filings; (2) the agents you selected to file those applications; and (3) funds in the amount we specify. The amount of funds will generally be our *estimate* to cover filing costs our per country; plus our per country service charges for filings; plus our time charges for effecting these filings; and additional funds to be retained by us in escrow as security against the ongoing charges from your agents for their work on your applications.

**If, by 1 month prior to the deadline/entry date, you have not provided us with both final instructions and the funds noted above, we will assume you either cannot proceed due to lack of funds or have decided not to proceed.**

**At 3 week prior to the deadline/entry date, you must request that we confirm that we have instructed your agents to effect your filings, if we have not yet provided that confirmation to you.**

**At 1 week prior to the deadline/entry date, you must request that we confirm that your agents have confirmed they filed your applications, if we have not yet provided that confirmation to you.**

The way to immediately contact us to request confirmations is by an email to [general@neifeld.com](mailto:general@neifeld.com). In your email, specify (1) the application by our reference number and application title or mark; (2) country or region; and (3) the deadline for the filing, and (4) request confirmation of the filing.

If you do not timely provide the information; funds; and requests for confirmations, then we disclaim any liability for a missed deadline for any filing. If this is not acceptable to you, then you should retain another firm, now, to proceed with filings and instruct our firm to transfer responsibility for this matter to that other firm.

If you do timely provide the information, funds, and request for confirmations, and we timely follow up with your agents, but for whatever reason your agents still fails to file an application by a legal deadline, then you agree that we are not liable for your agent's failure. We will assist and provide our expertise, but ultimately, these are your foreign agents, not ours.

## **II. RISK OF LOSS FOR UNTIMELY INSTRUCTIONS**

Finally, note that factors beyond our control may prevent us from effecting a timely filing for instructions received from you less than one month prior to a legal deadline. Moreover, there is a risk that what we initially file may not comply with government requirements, and we may not know that until the government notifies us of the issue. That notification normally occurs within a couple of weeks from initial filing, and based upon that notification we can normally correct the filing before the legal deadline passes. Consequently, the risks of failing to timely and properly file an application by the legal deadline increases as the deadline approaches. The same holds true for your foreign agents. This is why we must have your instructions and funds not later than one month from the legal deadline. If you provide instructions after that date, you are risking loss of rights due to filing failures generally beyond the control of us, and of your foreign agents.

## **III. BUDGETING FOR AND AUTHORIZATION TO PAY FOR ONGOING PROSECUTION IN FOREIGN FILINGS**

Patent prosecution costs are highly variable. After an application is filed, you are at the mercy of the government patent offices when they will issue office actions requiring your action.

When an office action issues in a foreign application, you will automatically incur your foreign agent's charges for receiving, reviewing, and reporting that office action to us; and our costs for reviewing, reporting that action to you, and paying your foreign agent's fees on your behalf. ....

In addition, if the country is a non-English language country, your foreign agent will also charge for translating the office action to the extent required to report and advise us. By filing a foreign application, you are agreeing to pay these charges in addition to our charges for analyzing and advising you, and, acting on your instructions and instructing your foreign agent to respond to the office action, and costs of the foreign agent in actually responding to the office action.

Very truly yours,

Richard A. Neifeld, Neifeld IP Law, PLLC

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