

NEIFELD IP Law, PLLC

9112 Shearman Street
Fairfax, Virginia 22032-1479

Web: <http://www.Neifeld.com>

REQUIREMENTS, PRACTICES, FEES, RATES, AND MODEL ENGAGEMENT AGREEMENT

EFFECTIVE 3/1/2024

PRECONDITIONS TO ACT ON INSTRUCTIONS

Neifeld IP Law (“NL”; “I”; “my”; “me”) generally requires receipt from you of both your instruction and funds sufficient to pay any outstanding balance and anticipated charge for the service you request, before acting.

RISK OF LOSS DUE TO DELAY, NEW MATTER

Instruction and corresponding payments received within one month of a deadline result in a risk of loss. The risk arises because I may not be able to effect your filing before the legal deadline, and because rushing to attempt to meet a short deadline may result in errors in the filing. Those risks increase as the deadline approaches. Accordingly, if you intend to delay to within one month of a deadline, please seek other counsel. I only agree to go forward with a new application filing (new matter) on your behalf, if you provide required information and instructions and any required fees for that work more than one month in advance of a deadline.

RISK OF LOSS DUE TO DELAY, ONGOING MATTER

If you delay providing the information, instructions, and required fees to within one month of a deadline in an ongoing matter, keep in mind that there is a risk which is beyond our control of loss of all rights relating to that matter due to factors that are foreseeable, that could prevent me from effecting a timely and proper filing. For example, power failures, equipment failures, Internet outages, and personal illness are factors that are foreseeable and beyond our control. These foreseeable events may delay any filing. I will use my best efforts to effect timely and proper filings. However, you need to understand that you are risking loss of all of your rights if you delay responding to any deadline to within one month of that deadline.

NORMAL PRACTICES

Reporting

Unless I expressly agree otherwise, I will report out all significant correspondence relating to your legal matters to you, via email.

You must reply by email, confirming your receipt of any email I send to you requesting your instructions.

You must notify me of your new email address, if your email address changes.

You must ensure that you do not block emails from the “richardneifeld@gmail.com” and from any email address from the domain “@neifeld.com” (Whitelist “@neifeld.com” and “richardneifeld@gmail.com.”)

Trust deposits

You may maintain a sufficient deposit in my firm’s trust account, from which I can pay your invoices, to avoid having to frequently send funds to me. I normally require you to maintain a trust deposit balance. The amount I initially require to accept you as a new client will be specified in my engagement offer to you.

Billing

I normally provide clients an invoice when quoting the cost for a service. The quote includes cost for my fees and disbursements. Unless I expressly agree otherwise in writing, I require a deposit in the amount of your outstanding balance and newly invoiced charges, before performing the quoted service.

For certain clients with whom I have an ongoing stream of business activity, I invoice monthly, instead of on a per service basis.

I charge interest at 2 percent per month for invoiced debits outstanding greater than 60 days from date of invoice.

Rates, Fees, and Time Charges

My default rates and fees are specified below.

The fees listed below are exclusive all disbursements on your behalf (such as payment of government fees and payment of vendors providing us work on your legal matter). These fixed fees are minimum charges for the specified service. In large or complicated matters, I will notify you if anticipated costs are likely to exceed the fixed fee, and obtain your agreement to proceed, before acting. In those circumstances, I normally charge actual paralegal and attorney time in addition to my specified minimum charge.

Billing - Fixed Fee Charges

Work for which I charge a fixed fee, organized by type of activity, appear below. (This fee is my professional fee and does not include any corresponding government fees.)

Professional Fixed Fees For Patent Application Filings

These fees depend upon whether an application is (1) “ready-to-file” and (2) “limited” application.

(1) A “ready-to-file” application means the specification, abstract, and claims to be filed, are provided to me in a text editable format, such as “.txt”; “.wpd”; “.doc”; or “.docx” file format; the figures, if any, are provided to me in either “.pdf” format or generic “.docx” format in compliance with USPTO formatting requirements, and any mathematical equations and chemical formulas are either in plain text format, or embedded as images objects.

(2) A “limited” application means an application consisting of: not more than 100 pages;

not more than 20 claims; no sequence listing; no computer program appendix; no color drawings; no photographic drawings; and not more than 20 reference citations.

For applications that are not ready-to-file, hourly rate time charges apply for actions required to place the application in condition for filing.

For applications that are not limited applications, the following additional fees apply.

More than 100 pages (spec+abstract+claims+drawings); each additional page. \$50

More than 20 claims; each additional claim. \$50

More than 20 IDS reference citations; each additional citation \$20

For applications containing a sequence listing; computer program appendix; color drawing; or a photographic drawings, *request a quote* minimum \$400

Docketing/filing a (1) “ready-to-file” and (2) “limited” patent application: \$1400

Applies to US Provisional; US Non Provisional utility; US continuation; US division; US reissue; US plant; US design; PCT US national stage entry; Hague design; PCT international. This charge includes preparing and filing of: Inventor declaration; Assignment; Power of attorney; Small entity certification; Micro entity certification; Application Data Sheet (including claiming priority); Assignment; first Information Disclosure Statement (IDS) citing up to 20 references; revising specification, abstract, claims, to US format.

Application Data Sheet for patent application filings - You must review and confirm the data in my draft Application Data Sheet is accurate, in advance of filing, or accept the risk of costs for correction in case this data is inaccurate.

Government Fees for Patent Application Filings

(Including basic, search, US or PCT examination fees; late filing surcharge; application size fee; excess independent and total claims fees; filing in a language other than English; sequence listing fees; and petitions for non black and white drawings; and applicable small and micro entity discounts thereto; and PCT/ISA fee; and in case of PCT filed in the US/RO, the US/RO transmittal fee.) See the following USPTO URL for details:

<https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>

As of March 2024:

The typical government fees (Basic, Search, Exam, Late, and Non-DOCX) for filing a **US utility patent application** are \$2380.

The typical government fees (Basic, Search, Exam, and Late) for filing a **US national stage entry of a PCT application** are \$1980.

The typical government fees (Transmittal, Search, Filing) for filing a PCT international application are \$2800.

Professional Fixed Fees For US Patent Application Prosecution

Docketing and reporting each USPTO correspondence, requiring action \$100

Sending each monthly reminder for instructions/funds. \$50

Preparing and filing an IDS, after application filing, base fee \$600

Each additional new IDS citation in excess of 20 \$20

Preparing and filing a petition for Patent Prosecution Highway (PPH). \$600

Paying any required government fee on your behalf. \$400
 Preparing and filing remarks, amendments, evidence Per attorney time
 Approximate attorney times incorporated into the estimate are shown below:
 Preparation and filing a response to a miscellaneous formal requirement 1.2 Hrs
 Preparation and filing a response to an election/restriction requirement 2 Hrs
 Filing remarks in response to rejections, based upon your comments 2 Hrs
 Filing claim amendments 3 Hrs
 Filing of replacement drawing sheets 0.5 Hrs/sheet
 Filing of substitute paragraphs in the specification 0.5 HRS/paragraph
 Preparation and filing a substitute specification and marked up copy 2 Hrs
 Preparation and filing declaration and evidence in support of patentability 5 Hrs
 Drafting a proposed response for your review, without instructions from you 8 Hrs

Fixed Fees For US Patent Application Allowance and Issuance

In response to a Notice of Allowance, by default, I will charge you for the following services, and perform the services after receipt of your instructions and deposit of funds:

1. Preparing and filing an issue fee transmittal, and paying the issue fee. \$600
2. Docketing sending you reminders for paying maintenance fees \$500
4. Instructing the USPTO to send maintenance fee notifications to you (No charge)
5. Changing entity status. (No charge)

Fixed Fees for Optional Services, Upon Patent Application Allowance and Issuance

I can provide these optional services in connection with allowance and issuance of a patent. Please request these services, in response to a Notice of Allowance.

6. Review and advise on reasons for filing a continuing/division application \$400
7. Recording an assignment/license/beneficial interest in the patent \$400
8. Reviewing the USPTO's patent term adjustment determination, for errors, and determining the term of the patent \$400
9. Reviewing the printed patent document for errors. \$1200
10. Preparing and filing a Certificate of Correction, and reporting on its grant or denial . . . \$1000

Professional Fixed Fees For Foreign Patent Application Filing

Docketing a foreign patent application and instructing a foreign agent to file the application in their country, per country \$900

Professional Fixed Fees For Foreign Patent Application Prosecution

Docketing and reporting foreign patent office correspondence forwarded by the foreign agent, per correspondence \$200

Professional Fixed Fees For Docketing Foreign Patent Application Annuities, per patent

Docketing to remind you in advance of when foreign patent annuities come due \$500

Professional Fixed Fees For US Trademark Application Filing

Docketing and filing a US TM application using TEAS Plus (limited to joint filings with the

presence of clients to provide real time input during filing) \$1200

Professional Fixed Fees For US Trademark Registration and Maintenance

Docketing sending email reminders to your email address on file, reminding you for declarations of continuing use and incontestability, due 5 years after registration \$500
Filing a request to record an assignment of a US trademark registration \$400
Preparing and filing declaration of use & incontestability under Sections 8 & 15 (due 5-6 years after registration). \$1200
Preparing and filing declaration of use and application for renewal under Sections 8 & 9 (due 10 years after registration) \$1200
Monthly trademark watch (monthly charge, limited to USPTO and web data). \$120/month
Paying any government fee after application filing. \$400

Professional Fixed Fees For International And Foreign Trademark Applications

Docketing and instructing a foreign agent to file a TM application \$700
Docketing and filing a Madrid Protocol TM application . . . \$1200 + \$100 per designated country
Paying a foreign annuity (in addition to foreign agent and government fees) \$400
Docketing and reporting of foreign trademark office/foreign agent correspondence: \$100

Copyright Registration

Docketing and filing an application to register a copyright \$600
Filing a request to record a US copyright assignment \$600

Miscellaneous

Making any payment on your behalf (Including and not limited to paying US and foreign government administrative charges, court charges, agent and vendor charges such as but not limited to foreign agents, translators, court reporters, and documents production and e-discovery vendors). \$400
Bulk photocopying charges (per pound, rounded down) \$400
Obtaining a paper certified copy of any document. \$400
Docketing a legal matter transferred to me, minimum charge (application, registration, litigation) \$400

Billing - Time Charges

I charge attorney time for all work on your behalf that is not specified by a fixed fee, unless our engagement agreement specifies otherwise. These time charges are separate from the fixed fee charges noted below. A non exhaustive list of types of work which I charge attorney time includes: all communications with you; all communications on your behalf with other entities including US and foreign patent examiners, and your agents for legal matters in other countries, draftspersons, payment service providers, and other vendors providing services on your behalf; application drafting; drafting and filing responses in applications before all government organizations (USPTO, WIPO, Copyright Office, Customs, foreign IP offices, and Courts); and providing your foreign legal agents instructions.

RATES

Richard Neifeld, Ph.D., Patent Attorney	\$500.00/hr
Contract Attorneys and Agents	\$300/hr +\$400/per invoice
Contract Paralegals	\$200.00/hr +\$400/per invoice

My billing rates are adjusted from time to time. I will notify you in advance of when I make any adjustment to billing rates. Contract attorneys, agents, and paralegals are paid based upon their time charges, billed to my firm, my \$400 administrative fee for paying their invoices, and my time involved in reviewing and paying their invoices.

MODEL ENGAGEMENT AGREEMENT

The terms of the following model engagement agreement govern our relationship, unless otherwise specified.

NEIFELD IP Law, PLLC
9112 Shearman Street
Fairfax, Virginia 22032-1479

Tel: 1-703-415-0012
Fax: 1-571-281-0045
Web: <http://www.Neifeld.com>
Email: general@Neifeld.com

ENGAGEMENT AGREEMENT

[DATE]

TO: [EXACT NAME OF LEGAL ENTITY]

Primary Contact: name, email, phone, postal address:

Secondary Contact: name, email, phone, postal address:

Re: THIS FORM IS NOT AN ACTUAL
ENGAGEMENT AGREEMENT. THIS FORM
PROVIDES THE STANDARD TERMS OF OUR
ENGAGEMENTS. EACH ENGAGEMENT
REQUIRES AN AGREEMENT TAILORED TO
THE SPECIFICS OF THE ENGAGEMENT

Dear:

I. Introduction

I welcome the opportunity to serve you, and I am pleased to provide you this engagement offer. If at any time you have any issues or concerns about my service please let me know. Legal services are based upon communications and I want to have clear and open channels of communication with you at all times.

You have the right to any attorney, other than me, advise you regarding this engagement offer. This offer defines the general parameters of the business relationship into which we are entering.

You (**YOUR EXACT LEGAL ENTITY NAME**) are retaining the services of Neifeld IP

Law, PLLC (herein after "NL"; "I"; "me"; or "my"). This engagement is with you, and not with any parent, subsidiary, partner, or affiliate.

I agree to assist you in certain legal matters. Specifically, in the following legal matter [SPECIFIED LEGAL MATTER].

I cannot make any promises or guarantees regarding the outcome of a matter. Statements by any of my attorneys are not intended, and should not be construed by you, to imply a guarantee of an outcome of a matter.

I confirm that I have no conflict with respect to the matter you initially discussed. This engagement is limited to that initially discussed matter.

You may request that I perform additional legal services beyond the matter you initially discussed. If I agree to perform those services, then the terms and conditions set forth herein will apply to those matters unless you and I otherwise agree in writing. Please note that I may require a separate deposit for each new matter, as a condition of acceptance of that matter.

II. Potential Legal and Business Conflicts

I note any concerns or limitations that I may have, regarding my representation of you, in this section.

I do not foresee any potential legal or business conflicts. [SPECIFY FORESEEABLE BUSINESS OR LEGAL CONFLICTS, HERE. SPECIFY, AND SPECIFIC WAIVER REQUIRED FOR THE ENGAGEMENT, HERE.]

In any case, you agree that I can represent another entity in a matter, unless: (1) I reasonably believe that I will not be able to provide competent and diligent representation of you; (2) the representation of the other entity is prohibited by law; or (3) the representation of the other entity involves the assertion of a claim against you in a litigation or other proceeding before a tribunal in which I represent you.

III. Duty to Communicate

To enable me to effectively serve you, I need you to timely disclose all facts and developments that may be relevant to the matters in which I represent you, and to otherwise cooperate in my representation of you.

I will keep you apprised of the status of your matters that I am handling. You agree to timely review all written communications from me and promptly note any concerns or apparent errors in those communications.

Emails, Confidentiality, and Privilege: My emails are encrypted; I advise you to use encrypted email. Your use of non-encrypted electronic communications may void attorney client privilege, in addition to allowing unintended recipients to receive your communications.

IV. Rates, Fees, Disbursements, Invoicing, and Payment

RATES AND FEES

I previously provided you with my current billing rates and administrative fee schedule. My bills are generally rendered either upon completion of an activity on your behalf, or monthly.

FIXED CHARGE INVOICES, PAYABLE IN ADVANCE

I may provide you invoices, payable to NL's trust account, in advance of providing services specified in the invoice. I require payment of these invoices in advance of providing the service specified in the invoice.

INVOICES AFTER PRE-AUTHORIZED SERVICES

I may also invoice you after providing services you previously authorized. For these invoices, unless agreed upon otherwise in advance, I charge for attorney time for reviewing correspondence, docketing, reporting, requesting instructions, reminding you of deadlines, and all other attorney work on your matters. My billing rates and fees are reviewed and revised from time to time. I will notify you of these changes in advance of the changes, typically in December of each year, for rate changes effective for January 1 of the next year.

My rate and fee changes apply to all matters, including pre-existing matters.

TIME CHARGES INFORMATION

If your bill includes time charges, then the billing rates of all individuals working on a matter, the time that each individual has expended on that matter, and disbursements on your behalf will appear on my bill.

I deliver invoices to you via email, as email attachments, in one of pdf, rtf, and txt document file formats.

ADDITIONAL CHARGES FOR ADDITIONAL ACCOUNTING REQUIREMENTS

If you require me to invoice you using software other than my standard accounting software, then you agree to pay me for the time spent learning to use that other software, for the time to enter accounting data into that software. If you have any other accounting requirements, such as bill format changes, uploading of documents, or the like, then you agree to pay me for the time to comply with those accounting requirements.

ADDITIONAL CHARGES FOR WITHHOLDING TAX COMPLIANCE

If you are subject to a withholding tax that requires you to withhold a fraction "x" of our invoiced amount, then you agree to pay me an amount of $1/(1-x)$ times what I would otherwise invoice in order to compensate for this withholding.

ADDITIONAL CHARGES FOR CERTIFICATIONS

If you require a certificate of residency or a certificate of incorporation from me, for any purpose, then you agree to pay me for the attorney time and government fees for attempting to acquire and provide to you such a certificate.

DISBURSEMENTS

You are responsible for paying, in advance, all expenses you instruct me to incur on your behalf, such as, but not limited to, government fees and outside vendor and agent charges. If I waive this advance payment requirement in any instance, that does not constitute a general waiver. Any expense I incur on your behalf that you have not paid in advance will appear as charges on a subsequent bill. These expenses for example include but are not limited to telecommunication charges, photocopying, facsimile charges, disbursements to contractors and

your agents. Please note that some contractors and agents do not bill NL promptly, and in such cases I may not be able to invoice their charges to you promptly.

INVOICING AND PAYMENT

My payment terms are payment on demand, and 2% interest per month on debts older than 30 days. I expect to be paid within a 30 days of the receipt by you of an invoice. You agree to promptly review my invoices and timely identify any charge you question, so that accounting disputes can promptly be identified and resolved. If you question any charge on any bill, please contact me immediately so I can address your question. I presume that you accept and do not dispute any charge not questioned within 30 days after the date of an invoice.

For funds transfers of any kind, I only credit funds *actually received* in NL's bank account. The sender is responsible for the cost of postage, bank wire fees, and all other transmission costs.

V. Deposit

I require a deposit before beginning work on behalf of a new client.

For drafting and filing of a US nonprovisional patent application, that amount is \$15,000.00.

For appearing in a PTAB inter partes proceeding (IPR, PGR, Interference, Derivation), that amount is \$40,000.

For other matters, I will specify an amount suitable for the particular representation. I may require a larger deposit balance if that becomes necessary to cover anticipated expenses on your behalf. I will hold deposited funds in a trust account. Interest on that trust account is the property of the Virginia State Bar by operation of Virginia law.

I may apply the amount of your trust funds on deposit to pay invoices, disbursements, and attorney fees, for work on your behalf.

I may require you to replenish your trust deposit before performing work, to cover anticipated charges and expenses.

If funds remain in trust upon payment of a final invoice, I will return those funds in trust for you, to you.

VI. Insurance, Accounting, and Retention of Evidence

My services do not include rendering advice regarding advertising injury and intellectual property infringement claims, and tax implications. I recommend that you review your insurance policies with your insurance broker to determine whether your insurance may cover advertising injury and intellectual property infringement claims, and review with your tax attorney any tax implications of your IP.

Under US law, you have a duty to retain evidence relevant to reasonably foreseeable litigation from the time when litigation becomes reasonably foreseeable. I advise you to have a plan in place to fulfill this duty, in case the duty arises, and then to promptly inform me whenever you reasonably foresee litigation, so I can help you comply with this duty.

VII. Termination

I may terminate this engagement and withdraw from representing you in legal matters upon reasonable notice to you. I may terminate this engagement if you fail to pay on your financial obligations to me or if you fail to make deposits when due. I must, and will, withdraw, from any proceeding in which you or your other counsel act contrary to 37 CFR 11.18(b), that is: (1) presenting material factual assertions that I do not believe to be true; (2) presenting unwarranted legal contentions; or (3) acting for the purpose of harassing, causing unnecessary delay, or needlessly increase cost.

You may terminate my representation at any time, with or without cause, by notifying me. If you or I terminate our engagement, I will return all documents and other material that you organization supplied to me upon your request and at your expense for any shipment costs. I will retain documents in matters in which our engagement has been terminated for what I believe to be a reasonable period of time. My policy is to destroy documents in terminated matters within a reasonable time.

VIII. Dispute Resolution

You and I jointly agree that for any dispute, controversy, or claim between us arising out of, or relating in any way, to this engagement agreement the choice of laws will be the substantive law of the Commonwealth of Virginia; that the courts in Virginia shall have personal jurisdiction over both parties; and that the exclusive venue for any court action will be in Fairfax County, Virginia.

IX. Timing of Instructions

You should always plan on sending your instructions as soon as possible, so that I have time to reliably, and in an orderly manner, act on your instructions.

I advise you to send all instructions via email, and to confirm I timely received your instruction. I will confirm receipt by email.

For a new application filing, I agree to go forward with the filing, only if you provide the required funds, information, and executed forms to me, not later than one month prior to any legal deadline for the application filing. If you do not believe you can comply, seek other counsel.

Regarding ongoing matters for you that I am handling, I will always make a best effort to implement any instruction you provide once I have received your instruction and the required funds for implementing your instruction.

However, computer malfunction, power failure, network disruption, filing systems glitches, and personal illness are generally beyond my control and could delay my acting after receipt of your instruction. Consequently, there is a foreseeable risk, which increases as a legal deadline approaches, that I will not be able to properly act on instructions you send to me within one month of the deadline. That risk rises rapidly from near zero probability at one month prior to the deadline until the deadline.

The consequences of failing to meet a deadline may be irrevocable loss of all your rights for the application and claims. Therefore, by delaying your instructions (and any required funds therefore) to within one month of any deadline results in a risk that you will lose all of rights due to my inability to properly meet the deadline.

Plan on sending all instructions and required funds not later than one month prior to any deadline.

X. Acceptance of Transferred Legal Matters

I will normally accept responsibility for an existing legal matter being handled by another lawyer or law firm, if:

(1) you have provided me with an identification of the matter (or identification of a list of matters) being transferred which identifying them uniquely by government identifier (application number, filing date, type of matter);

(2) you have provided me a docket sheet listing legal deadlines coming due within at least 90 days from date of transfer of responsibility;

(3) you have provided to me powers of attorney authorizing me to represent you in each of the matters to be transferred;

(4) you have provided me with access to files for the matters to be transferred;

(5) you have instructed your existing lawyer in the matter to respond to all items docketed for response within thirty (30) days after the date of your instruction to transfer (unless I specifically agree to accept responsibility to respond), on a docket item by docket item basis;

(6) you have no outstanding amount owed to the existing lawyer in the matter of fee dispute with the existing lawyer; and

(7) after I have had a chance to inspect the docket sheet, case identifiers, and files, I have provided you my new identifier for the matter, and I have indicated to you in writing that I agree to accept responsibility for identified cases.

XI. Federal Tax Identification Number and Banking Information

Neifeld IP Law, PLLC's tax ID number, for 1099 reporting purposes, is: 154445958

XII. Trust Deposits and Payments

To make a trust deposit or pay an invoice for service rendered, either wire advanced funds, send us a paper check, or send funds by Zelle. After performing the service specified in an invoice, NL will disburse funds held in trust for you, from NL's trust account, to NL's operating account, to pay for the invoiced services. Upon termination of my representation of you, NL will disburse any remaining trust deposit back to you.

NL's trust account and operating account details for wire transfer purposes appear in our invoices.

You can also pay up to \$3000 by Zelle, designating the payment for: rneifeld@neifeld.com

You can also pay by mailing a paper check to: Neifeld IP Law, PLLC, 9112 Shearman Street, Fairfax, VA 22032-1479

NOTE: Always confirm any change in our banking payment information by an alternate channel of communication, before paying, as a protection against fraud.

XIII. Special Notice For Agents that Provide NL Instructions On behalf of Clients

If you are an agent for your client and provide instructions to NL on behalf of your client, then:

(1) you agree that you are directly responsible for paying for timely NL's legal services (regardless whether or when your client pays you);

(2) you represent that your client has authorized you to provide NL instructions on their behalf; and

(3) you agree to pass on NL's charges, without surcharge on NL's legal services, to your client, however, nothing in this provision precludes you from billing your client for your own services.

XIV. Agreement

Please execute this agreement, and return a copy of the executed agreement to me, or reply in an email specifying that you accept the terms of the agreement and send us the specified trust deposit. No engagement exists until:

(1) funds for the specified trust deposit have been deposited into NL's trust bank account and have been cleared by the originating bank; and

(2) you have agreed in writing to this engagement offer.

This engagement offer expires two weeks from the date of this letter.

Very truly yours,

FOR NEIFELD IP LAW:

Date: March 1, 2024 (10:55am)

Signature: _____
Richard Neifeld

FOR [EXACT NAME OF LEGAL ENTITY]:

Date: _____

Signature: _____
Name and Title:

/ran

Printed: March 1, 2024 (10:55am)

Y:\FirmRatesFeesAndFormEngagementContracts\2024\Requirements, Practices, Fees, Rates, Sample Engagement.wpd

