

INTELLECTUAL PROPERTY LAW PARALEGAL

2007 revision and update by Carol Werner, RP, of Sheridan Ross P.C., and Cheryl Arnold Ferne of Dorsey & Whitney, LLP. 2007 revision and update reviewed by Jennifer M. McCallum, Ph.D. Esq., of The McCallum Law Firm, LLC., Paul J. Prendergast, Ph.D., Esq., of Dorsey & Whitney LLP, and David L. Walker, Esq., of Sheridan Ross P.C.

Originally drafted by Patricia Jeffryes and Peggy West. Originally reviewed by Ralph F. Crandell, Esq., of Holland & Hart, LLP.

ALL OF THE BELOW DUTIES ARE ASSUMED TO, AND MUST BE, UNDER THE DIRECTION AND SUPERVISION OF A LICENSED ATTORNEY.

A. PATENT

1. U.S. Patent Prosecution:
 - a. Assemble disclosure data, drawings, and other material needed to prepare patent applications.
 - b. Draft formal papers (*i.e.*, power of attorney, assignment, oath, *etc.*).
 - c. Draft preliminary amendments for continuation and divisional patent applications.
 - d. Draft Application Disclosure Statement.
 - e. Prepare transmittal documentation for USPTO filings.
 - f. Prepare on-line application.
 - e. File provisional, utility, continuation, divisional, continuation-in-part, and design patent applications in United States Patent and Trademark Office.
 - f. Review Filing Receipt and notify attorney of any corrections needed.
 - g. Gather information and prepare Response to Notice to File Missing Parts.
 - h. Prepare Information Disclosure Statements and accompanying documents, including art cited in foreign applications.

i. Conduct assignee and patent family equivalent searches and obtain copies of English translations to foreign references using databases.

j. Review published patent applications; prepare memorandum report to attorney, and draft needed Requests for Correction, Preliminary Amendment or Amendment.

k. Prepare and record assignment documentation.

l. Review Notice of Recordation of Assignment Document for accuracy and prepare documents to correct, if needed.

m. Prepare Statement under 3.73 (b) certificates and review chain of title for accuracy.

n. Order certified copies of foreign applications, assignments, mergers, and name change documents.

o. Correspond with draftsman regarding drawings; proof drawings for accuracy.

p. Research pertinent issues regarding the preparation or prosecution of patent applications.

q. Review office actions and patent office directives; assist attorney with drafting responses, affidavits and petitions.

r. Prepare listing of pending claims at any time during prosecution.

s. Review Notice of Allowance and confirm accuracy of allowed claims, approval of prior art, assignment data, *etc.* prior to issuance of patent.

t. Request application status and notify client of same.

u. Proof original Letters Patent and draft needed Requests for Certificates of Correction.

v. prepare Sequence Listings and documentation for submission thereof.

2. Foreign Patent Prosecution:

a. Prepare foreign filing cost estimates and prepare correspondence to clients summarizing same.

b. Research filing requirements.

- c. Draft instruction letters to foreign associates.
 - d. Prepare PCT applications and transmittal documents.
 - e. Prepare various responses to PCT invitations.
 - f. Prepare demands.
 - g. Assist in the preparation of the comments on abstract.
 - h. Prepare replacement pages for PCT applications.
 - i. Review published application for accuracy.
 - j. Draft correspondence to clients regarding international search report, international preliminary examination report, and written opinion.
 - k. Compile documentation required for national phase foreign filings.
 - l. Prepare and/or obtain documents for legalization, including affidavits, certificates and apostilles, through state, national and international agencies.
 - m. Review chain-of-title for accuracy and continuity.
 - n. Obtain certified copies of U.S. or foreign applications when needed.
 - o. Compile art cited in related cases and forward to proper associates.
 - p. Proof documentation received from foreign associates.
 - q. Prepare Sequence Listings and documentation for submission thereof.
3. Ongoing U.S./Foreign Procedures:
- a. Maintain files of invention disclosures.
 - b. Review periodicals and services for changes in patent laws and regulations affecting intellectual property in the United States and foreign countries.
 - c. Coordinate docket system.
 - d. Maintain docketing system.

- e. Prepare and execute on-line filings with U.S. Patent Office.
- f. Database administration for docket and forms.
- g. Proof docketing.
- h. Coordinate patent annuity payments, payment of fees and invoices.
- i. Coordinate invention classification meetings, *i.e.*, set up meetings, draft agenda, letters, minutes, follow-ups.
- j. Prepare patent portfolio reports.
- k. Draft licenses and agreements regarding proprietary information and technology.
- l. Review license agreement clauses.
- m. Maintain U.S. Patent & Trademark Office Deposit Account.
- n. Maintain prior art libraries.
- o. Audit transfer files or participate in annual file audits.
- p. Compile documentation to support litigation requests, including preparing listing of production documents or privilege logs.
- q. Research case law using Westlaw or other appropriate database(s).
- r. Correspond with clients and associates regarding various issues, *e.g.*, assignments, powers of attorney, status checks, request for examination, *etc.*
- s. Attend client meetings with attorney.

B. TRADEMARK/SERVICE MARKS

- 1. U.S. Prosecution:
 - a. Conduct trademark searches and prepare reports.
 - b. Prepare trademark status summary reports.
 - c. Prepare and file trademark application and accompanying correspondence (state and federal).

- d. Assist attorney with drafting responses to office actions, notices of opposition, petitions to cancel, extension requests, statements of use, *etc.*
- e. Draft license agreements.
- f. Prepare declarations of use and incontestability (sections 8 and 15).
- g. Prepare trademark renewal applications and accompanying correspondence.
- h. Prepare and record assignment documentation.
- i. Review Notice of Recordation of Assignment Document for accuracy and prepare documents to correct, if needed.
- j. Proof all USPTO documentation (*e.g.*, filing receipt, notice of publication, publication in Official Gazette, Notice of Allowance, Certificate of Registration, *etc.*).
- k. Prepare documentation to correct errors (*e.g.*, filing receipt, *etc.*).

2. Foreign Prosecution:

- a. Prepare foreign filing cost estimates.
- b. Compile documentation required for foreign filings.
- c. Draft instruction letter to foreign associate.
- d. Prepare and/or obtain documents for legalization, including certificates and apostilles, through state, national and international agencies.
- e. Proof all documentation received from foreign associates.

3. Ongoing U.S./Foreign Procedures:

- a. Conduct trademark searches; investigate facts using articles in magazines and trade publications.
- b. Inform client of status.
- c. Proof docket.
- e. Coordinate with mark watch services to ensure marks are being protected.

- f. Inform client of status.
- g. Research trademark issues, *i.e.*, review trademark gazettes concerning potentially conflicting trademarks.
- h. Review periodicals and services for changes in trademark laws and regulations affecting intellectual property in the United States and foreign countries.
- i. Correspond with clients and associates regarding various issues, *e.g.*, assignments, power of attorneys, status checks, request for examination, *etc.*

C. COPYRIGHT

- 1. Registration:
 - a. Gather data for copyright registration application and determine correct classification for the application.
 - b. Draft application to register copyright with Register of Copyrights and correspond with Copyright Office while application is pending.
- 2. Ongoing Procedures:
 - a. Inform client of status.
 - b. Maintain docket.
 - c. Proof original copyright certificate and send to client.
 - d. Draft assignments and releases.
 - e. Research copyright issues.