



**Ohio Patent Pro Bono Program**

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\_\_\_\_\_, 2018

[applicant's name and address]

**Re: Ohio Patent Pro Bono Program Engagement Letter**

Dear Ms./Mr. [applicant's name]:

This letter agreement confirms representation of you, [applicant name] (referred to in this letter agreement by the terms "you", "your" and "Client"), by the undersigned Attorney Volunteer (the "Attorney Volunteer") in connection with your "[title of invention]" invention as disclosed on the Ohio Patent Pro Bono Program Invention Disclosure Form submitted to the Ohio Patent Pro Bono Program on [IDF submission date], all on the terms set forth in this letter agreement.

We believe it is important that we explain in writing the responsibilities and expectations that will exist – once this letter agreement is executed – among the various parties identified by this letter agreement. This letter is the agreement that sets forth the terms of the relationships between you, the Attorney Volunteer, and the Ohio Patent Pro Bono Program. The Ohio Patent Pro Bono Program is acting only as a referral service in connection with your participation in our program. In other words, the Ohio Patent Pro Bono Program is not your attorney and does not represent you.

No work will be performed and no attorney-client relationship between you and the Attorney Volunteer will be established until this letter agreement has been signed and returned by you and the Attorney Volunteer. PLEASE READ THIS LETTER AGREEMENT CAREFULLY AND LET US KNOW IMMEDIATELY IF YOU HAVE ANY QUESTIONS OR CONCERNS by calling Scarlett White, Client Coordinator for the Ohio Patent Pro Bono Program, at (440) 745-4145.

**Project & Scope**

The Ohio Patent Pro Bono Program has identified the Attorney Volunteer to represent you in connection with the prosecution of a U.S. non-provisional patent application (the "Application") [edit if appropriate] before the U.S. Patent & Trademark Office for the "[title of invention]" invention you have disclosed on the Ohio Patent Pro Bono Program Invention Disclosure Form on [IDF submission date] (the "Representation").

This program attempts to offer flexibility to attorney volunteers. After making a filing in connection with the Application, the Attorney Volunteer may choose to disengage from the

Representation. If that occurs, you will receive a disengagement letter notifying you of the disengagement. AT THAT POINT, THE PATENT APPLICATION WILL BE YOUR RESPONSIBILITY. The Attorney Volunteer would then return your file to the Ohio Patent Pro Bono Program who would work with you to find another attorney volunteer to assume the representation. In that case, the Ohio Patent Pro Bono Program would not be your counsel and cannot guarantee that another attorney volunteer would be identified or available.

Where an attorney volunteer is engaged as your counsel, the Representation may continue until a Final Office Action is received or the Application issues as a patent, whichever occurs first. But in no case will the Representation extend beyond these events. If the Application issues as a patent, you will be responsible for docketing and making any maintenance fee payments by the appropriate deadline. No assistance with maintenance fee matters is included in the scope of the Representation.

### **Other Applications and Tasks Are Not Included**

The scope of the Representation is limited to what is identified above and does not include any other patent application(s), whether pending or merely contemplated, related to the Application or unrelated, and/or U.S. or foreign. Assistance with prior art searching, patentability analysis, clearance or freedom-to-operate studies, non-infringement analyses, marketing, business development, licensing, transfer, enforcement or disputes involving the invention or any patent rights resulting from the Application, and other such tasks are not included in the scope of the Representation. Foreign patent applications, whether pending or merely contemplated, formally related to the Application or not, are not included in the scope of the Representation. The scope of the Representation may be changed by the mutual written consent of you and the Attorney Volunteer, though the Attorney Volunteer may disengage or withdraw as indicated in this letter agreement.

### **Fees, Costs, & Disbursements**

The Attorney Volunteer will provide the services during the Representation free of charge. **You, however, shall pay directly to the U.S. Patent & Trademark Office, patent search services, drafting services and/or other providers, all costs or expenses incurred by you or on your behalf. Such expenses may include draftsperson charges, government and recording fees, computerized research charges, patent search charges, copying costs, and postage.** You will be advised of costs in advance. You will be required to make all such payments directly, such as by credit card or check made payable to the payee, without placing any funds in the Attorney Volunteer's possession and with any funds sent and payable to the Attorney Volunteer promptly returned. You will be informed of any exceptions to this requirement. Any exception must be in writing and signed by you and the Attorney Volunteer. The Attorney Volunteer reserves the right to discontinue all legal services and terminate the Representation if costs are not paid in a timely manner. The Attorney Volunteer will not, however, discontinue service without giving notice of such intention.

### **Mutual Communications**

The Attorney Volunteer and you each acknowledge that considerable time and effort by each party is required to form a successful attorney-client relationship. You and the Attorney Volunteer each agree to actively participate in and put forth good faith efforts in connection with the Application. Delays in your response time to the Attorney Volunteer's requests for information or assistance can necessitate payment of additional U.S. Patent & Trademark Office extension fees, the payment of which will be your sole responsibility. The Attorney Volunteer will promptly comply

with your reasonable requests for information regarding the status of the Representation. The Attorney Volunteer shall consult with you and shall abide by your decisions with respect to the objectives of the Representation, subject to the Attorney Volunteer's ethical and legal obligations and professional judgment. You will cooperate with the Attorney Volunteer in order to be effectively and efficiently served by the Attorney Volunteer during the course of the Representation. You agree to provide the Attorney Volunteer with any information or documents reasonably necessary or useful for the Representation, including any change in your contact information, address, or telephone numbers and any significant change in your financial or business condition. You will provide the Attorney Volunteer with any information or documents that may be related to compliance with the duty of disclosure and/or the duty of candor and good faith when practicing before the U.S. Patent & Trademark Office. Insufficient Client effort will be adequate cause for attorney withdrawal.

### **Sufficient Connection to Ohio & Financial Eligibility**

You have been accepted to the Ohio Patent Pro Bono Program based on your connection to Ohio and the program's financial eligibility criteria. You certify that your disclosures to the Ohio Patent Pro Bono Program and the Attorney Volunteer regarding your connection to Ohio and your financial information are complete and correct. The Attorney Volunteer may withdraw from the Representation if such disclosures made by you are not complete or correct, or if your condition changes so that you no longer meet the program's eligibility criteria. Further, if you obtain a licensee or sell the Application or any other patent or application, you must immediately inform the Ohio Patent Pro Bono Program and provide it with the terms of the license agreement and/or sale.

### **Attorney Withdrawal or Termination of Representation**

Pursuant to the Rules of Professional Conduct applicable to the Attorney Volunteer's practice, the Attorney Volunteer may withdraw from the Representation after taking reasonable steps to avoid prejudice to the Client. The Attorney Volunteer may withdraw if, in his/her judgment, you are not cooperating with the Attorney Volunteer, if you insist that the Attorney Volunteer engage in conduct that is contrary to the judgment or advice of the Attorney Volunteer or contrary to law or rule, if you do not comply with the terms set forth in this letter agreement, or for any other good reason. The Attorney Volunteer may also withdraw as specified in the paragraph titled Project & Scope. You will be notified of the Attorney Volunteer's withdrawal in writing. If withdrawal occurs under a condition specified in this paragraph, the Attorney Volunteer and/or the Ohio Patent Pro Bono Program may assist you in finding new counsel, at their discretion.

### **Role of the Ohio Patent Pro Bono Program**

THE OHIO PATENT PRO BONO PROGRAM IS ACTING AS A REFERRAL SERVICE IN CONNECTION WITH YOUR PARTICIPATION IN THE PROGRAM. YOU ACKNOWLEDGE THAT WHILE THE OHIO PATENT PRO BONO PROGRAM HAS ASSISTED IN ARRANGING FOR THE REPRESENTATION, IT HOLDS NO RESPONSIBILITY FOR THE PERFORMANCE OF THE REPRESENTATION, AND YOU HEREBY WAIVE ANY AND ALL CLAIMS AGAINST THEM.

### **Sharing of Information**

You authorize the Attorney Volunteer to report non-confidential data related to your representation to the Ohio Patent Pro Bono Program in order to assist the Ohio Patent Pro Bono Program with its obligations regarding the management and reporting of program activities.

**Informed Consent and Media Release**

By signing this Engagement Agreement, you give the Ohio Patent Pro Bono Program permission to use your your name and/or information related to your participation in the Ohio Patent Pro Bono Program. You acknowledge and understand that this information may be used or reproduced in a range of media, including electronic or online publications, promotional literature, advertising, and social media and other similar ways. You acknowledge that you will not receive any compensation for this use and hereby release the Ohio Patent Pro Bono Program and its officers, directors, employees, agents and assigns from any and all claims which arise out of or are in any way connected with such use. You agree that you have read and understood this consent and release. You also understand that you can revoke this release any time in writing and that any such use of your name or other information authorized by this release will immediately cease.

**Additional Terms and Conditions**

Any additional terms and conditions required by the Attorney Volunteer are attached to this letter agreement as Appendix A and are incorporated into and made a part of this letter agreement.

**Counterparts**

This letter agreement may be executed in counterparts, each of which when so executed and delivered shall be deemed an original for all purposes, and all such counterparts shall together constitute but one and the same instrument. A signed copy of this letter agreement delivered by either facsimile or e-mail shall be deemed to have the same legal effect as delivery of an original signed copy of this letter agreement.

AGREEMENT AND ACCEPTANCE: The parties to this letter agreement agree to the above terms and conditions as of the dates set forth by them below.

CLIENT:

\_\_\_\_\_  
Print Name

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date

ATTORNEY VOLUNTEER:

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Print Name

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Signature

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Date

## APPENDIX A

[Enter additional terms, if any, otherwise write "No Additional Terms."]