

# SCHWEGMAN TERMS OF BUSINESS – INTERNATIONAL ASSOCIATES & CLIENTS

## Relationships

### CLIENT: *[[e.g. Assignee]]*

Schwegman represents CLIENT and will perform services on behalf of CLIENT. If Schwegman's representation includes patent prosecution, Schwegman will prosecute the application(s) and transact all business the U.S. Patent and Trademark Office (USPTO).

### AGENT: *[[Foreign Associate]]*

The person or firm who sent this matter to Schwegman is an AGENT of CLIENT.

Schwegman will act and rely on instructions from and communicate exclusively with AGENT until CLIENT and/or AGENT instructs Schwegman in writing to the contrary.

Schwegman will invoice AGENT and timely payment of Schwegman's invoice is the responsibility of AGENT.

If AGENT's representation of CLIENT ends, Schwegman's representation of CLIENT also ends unless CLIENT expressly contacts Schwegman and it is mutually agreed to continue the representation.

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## Expectations for Client

Schwegman's representation may include patent prosecution before the USPTO. CLIENT acknowledges the duty of candor (see below). The above-identified CLIENT may include inventor(s), assignee(s), or other entities with an interest in the patent prosecution. Inventor(s) are expected to review and understand the contents of the patent

application including the claims, believe they are an original or an original joint inventor of a claimed invention, confirm the application describes the best mode for carrying out the invention, and acknowledge the duty of candor with the USPTO (see below).

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## Expectations for Agent

AGENT is expected to keep Schwegman reasonably informed of: any information necessary to carry out legal services on behalf of CLIENT; changes to AGENT's contact information, including phone numbers, mailing and email addresses; changes in AGENT'S representation of CLIENT; changes in CLIENT'S business status including affecting CLIENT'S ability to pay Schwegman for services performed; and CLIENT's involvement in joint ventures or partnerships with other companies, universities, or other entities to jointly develop new products and offerings due to the potential impact on intellectual property rights.

AGENT is expected to keep CLIENT reasonably informed of communications from Schwegman.

AGENT acknowledges the Duty of Candor (see below).

AGENT is expected to timely pay Schwegman'S invoices. Amounts are in U.S. dollars and Schwegman expects to be paid in U.S. dollars. Payment is due and payable within ninety (90) days of the invoice date. If AGENT has a question regarding an invoice, Schwegman requests notice of the question within thirty (30) days of the invoice date.

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## Expectations for Schwegman

Schwegman will work diligently in representing CLIENT, exercise independent professional judgment, render candid advice, and keep AGENT informed regarding the progress of CLIENT'S matters. If Schwegman's representation of CLIENT includes patent prosecution, and unless otherwise instructed in writing, Schwegman will send AGENT copies of all correspondence from the United States Patent & Trademark Office (USPTO) and any other relevant governing body or third party.

Schwegman cannot guarantee the outcome of CLIENT'S legal matters. Schwegman will advise AGENT with regard to technical and tactical issues as they arise so that AGENT may continue to evaluate

whether and how to continue the legal representation.

Schwegman attorneys are subject to independent ethical obligations and an Schwegman attorney is not obligated to pursue objectives or employ means simply because AGENT / CLIENT may wish that the attorney do so, especially if the attorney would be violating another duty by pursuing the requested action. For example, Schwegman will maintain its duty of candor with the USPTO.

Schwegman will take reasonable business steps to protect the confidentiality of non-public information relating to CLIENT and the confidentiality of any communication with CLIENT, AGENT, or representatives of CLIENT or AGENT (see below).

Schwegman represents a variety of clients. It is possible that a conflict may arise between CLIENT and Schwegman's other clients during the course of our representation. Anyone of CLIENT, AGENT or Schwegman may determine that it is appropriate to end Schwegman's representation of CLIENT because of a conflict or potential conflict.

Should Schwegman discover such a conflict, Schwegman will inform AGENT of the circumstances and promptly discuss appropriate steps for addressing the conflict. If AGENT or CLIENT learn or know of a potential conflict or are troubled by Schwegman's association with a particular client, the AGENT is requested to bring this information to the attention of Schwegman as soon as possible.

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## Duration of Representation

CLIENT or AGENT has the right to discontinue the services of Schwegman at any time. However, Schwegman does not recommend termination when a response or filing with the USPTO or other governing body is due within one month and AGENT has not secured new representation. Failure to promptly respond or file could result in additional cost, delay, or possible loss of rights.

Schwegman's representation may terminate naturally upon completion of assigned matters. Schwegman reserves the right to withdraw from this representation if there has been a breakdown of the attorney-client relationship, including a breach of these terms of business, refusal to cooperate with Schwegman or to follow advice from Schwegman on a material matter, or any act or circumstance that would render continuing representation by Schwegman unlawful or unethical. Schwegman further reserves the right to withdraw from this representation if Schwegman's invoices are not paid on a timely basis (90 days from invoice date). Termination of services does not affect the responsibility to pay for the legal services rendered and the costs incurred up to the date of termination. Costs of collection efforts including, but not limited to, collection agency fees and attorney fees incurred during the collection process will be the responsibility of CLIENT and AGENT.

Schwegman also reserves the right to withdraw from representing CLIENT if there is a conflict or potential conflict, or if the only ongoing service that Schwegman is performing for CLIENT is the payment of USPTO maintenance fees. In the event that Schwegman withdraws from representation, Schwegman will provide AGENT with reasonable notice and will provide a recommendation of an alternative service provider.

To terminate representation, any of CLIENT, AGENT or Schwegman may send a disengagement letter by mail, fax, or email to the other parties. Upon termination, CLIENT or AGENT on behalf of CLIENT is entitled to all of CLIENT'S files and property in Schwegman's possession. Reasonable costs associated with duplicating, retrieving and transferring CLIENT'S papers and property after termination will be invoiced to AGENT. All files and property will be saved for a brief period of time and then destroyed under Schwegman'S document retention policy. Once representation by Schwegman is terminated, Schwegman is no longer responsible for taking any further action on CLIENT'S behalf, and Schwegman will request withdrawal as a representative in any related matter pending before the USPTO or other applicable governing body.

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## Duty of Candor

Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the USPTO, which includes a duty to disclose to the USPTO all information known to that individual to be material to patentability. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim.

The USPTO encourages applicants to carefully examine prior art cited in search reports of a foreign patent office in a counterpart application, and the closest information over which individuals associated with the filing or prosecution of a patent application

believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the USPTO.

Information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and it establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or it refutes, or is inconsistent with, a position the applicant takes in opposing an argument of unpatentability relied on by the USPTO, or asserting an argument of patentability.

Individuals associated with the filing or prosecution of a patent application within the meaning of this section are: each inventor named in the application; each attorney or agent who prepares or prosecutes the application; and every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.