



## Patent Prosecution Deliverable / Fixed Fee Framework

### Introduction

With sample contributions from over 60 companies across multiple industries, we are proud to announce the Patent Prosecution Deliverable / Fixed Fee Framework. This framework is the result of strong collaboration across the legal ecosystem including numerous corporate legal operations teams, in-house counsel, law firms, alternative service providers, and IP technology vendors.

### What is the Patent Prosecution Deliverable Framework?

The tool aims to establish a common language and framework for in-house legal departments to use when defining scope for patent prosecution work with outside counsel, particularly if establishing fixed fee categories. The framework introduces the concept of deliverables and categories that corresponds to commonly encountered activity in patent prosecution work. These deliverables can be either core or optional. Hence, the framework provides a comprehensive list of core deliverables and optional deliverables with a list of corresponding, recommended UTBMS codes. These deliverables and respective UTBMS codes are categorized by major patent prosecution phases and grouped by commonalities.

The deliverable framework serves as point of reference for the engagement discussion between in-house legal departments and outside counsel, particularly useful if establishing fixed fee categories. Core and optional categories of work enable flexible and creative engagement terms, minimizing time spent defining the statement of work; this allows organizations to more readily customize service solutions, and promotes a focus on the business goals of an engagement.

### How do I use this tool?

This framework provides a common language about deliverables that can be used to have a conversation with outside counsel and other patent prosecution vendors. It is intended to be adapted to your company's individual needs when designing and structuring legal services engagement arrangements, including project scope and fee arrangements. The framework can be adapted to current e-billing systems.

### Definitions

Phases	Phases of a patent application
Categories	Types of tasks related to a patent application
Core Deliverables	Work product that are presumed within scope of the phase category of tasks related to preparing, filing and prosecuting a patent application.
Add-on Deliverables	Optional deliverables of tasks related to a patent application
UTBMS Codes	Suggested mapping of the Framework to UTBMS codes. UTBMS is an industry standard for e-billing codes. The Framework is intended for other related business processes but can be integrated with a UTBMS implementation.

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Be sure to share this spreadsheet with your colleagues and other industry members!

<https://cloc.org/industry-guidelines>

**Questions?** Contact: [info@cloc.org](mailto:info@cloc.org)

*Tool updated as of 4/27/2017 (v.3)*



## Patent Prosecution Deliverable / Fixed Fee Framework

Phase	Category	Core Deliverable	Add-on Deliverable (options)	Suggested UTBMS Code Mapping
Evaluation	Pre-filing Assessment	Invention analysis disclosure assessment (patent mining/scrub) - have meeting and summary memo with outline of potentially claimable features of the invention.	Follow-up investigation and assessment.	PA200 Family
	Search & Analysis	Basic novelty search - results and summary (oral or written)	Additional investigation and assessment of potential prior art identified relative to the invention disclosure.	PA200 Family
Preparation & Filing	Provisional Application	Application Data Sheet, Specification, Drawings, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	Formal Drawings, US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers	PA310
Preparation & Filing	Conversion of Provisional Application	Application Data Sheet, Specification, Drawings, Declaration, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	Formal Drawings, US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers, and initial Information Disclosure Statement	PA300 Family
Preparation & Filing	Non-Provisional Application	Application Data Sheet, Specification, Formal Drawings, Declaration, Assignment, Power of Attorney, Letter(s) reporting filing, Official Filing Receipt, and Recordation of Assignment	Formal Drawings, US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers, and Information Disclosure Statement	PA320
Preparation & Filing	Continuation Application	Application Data Sheet, Specification, Formal Drawings, Declaration, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers, and initial Information Disclosure Statement	PA350
Preparation & Filing	Divisional Application	Application Data Sheet, Specification, Formal Drawings, Declaration, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers	PA350
Preparation & Filing	Continuation in Part Application	Application Data Sheet, Specification, Formal Drawings, Declaration, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers	PA350
Preparation & Filing	Original Design Application	Application Data Sheet, Specification, Formal Drawings, Declaration, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers, and initial Information Disclosure Statement	PA330
Preparation & Filing	Utility Model Application	Application Data Sheet, Specification, Formal Drawings, Declaration, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers	PA320
Preparation & Filing	Defensive Publication	Defensive publication, letter(s) reporting publication		PA320
Preparation & Filing	Plant Patent Application	Application Data Sheet, Specification, Formal Drawings, Declaration, Assignment, Power of Attorney, and Letter(s) reporting: filing, Official Filing Receipt, and Recordation of Assignment	US Foreign Filing License or Foreign Licenses, Responses to Notices of Missing Parts or Notices of Corrected Application Papers	PA340
US Prosecution	CON/DIV/FF Filing Recommendation	Review of file history; identify and propose claim/claim framework; provide recommendation	Continuation Filing claim set (Full) and preparing, filing, and reporting of continuation application Divisional Filing claim set (Full) and preparing, filing, and reporting of divisional application Foreign Filing Recommendation and preparing, filing, and reporting of PCT and/or national phase application (any type (PCT or National)) (identify claims for filing and/or search)	PA100 Family
US Prosecution	Information Disclosure Statement	Preparation of IDS (up to 5 references); executing and filing of IDS; reporting of same	References Range, e.g., 6-10 References 11-15 References 16-20 References etc.	PA410
US Prosecution	Office Action Response	Non-Final Office Action Response; or Final Office Action Response	Request for Continued Examination (RCE) Terminal Disclaimer Restriction Requirement (with traverse) Restriction Requirement (without traverse) Ex: Parte Quayle AFCP Request	PA430
US Prosecution	Supplemental Amendments	(see add-ons)	Preliminary Amendment; or Examiner Amendment; or Advisory Action/Follow-up Supplementary Amendments; or Amendment after Allowance	PA400 Family
US Prosecution	Interview	Applicant-Initiated Interview or Examiner-Initiated: Interview scheduling / request; interview agenda; claim(s) for discussion; argument outline; interview; review of examiner interview summary; file applicant interview summary	Post interview claim update (claim scope/direction change) First Action Interview Pilot - Virtual (Telephonic / Video) First Action Interview Pilot - In-person P3 - Virtual (Telephonic / Video) P3 - In-person	PA400 Family
US Prosecution	Allowance	Review Notice of Allowance; Issue Fee Checklist review; Filing of Issue Fee Transmittal	Supplemental Notice of Allowance QPIDS Supplemental IDS (triggered within 3 months) RCE + IDS	PA400 Family
US Prosecution	Issuance	Issue Fee Transmittal review; review of claims;	Patent Term Adjustment Certificate of Correction Proofreading - Specification Proofreading - Claims	PA400 Family
US Prosecution	Appeal	Notice of Appeal	Pre-Appeal Brief Appeal Brief Reply Brief Oral Arguments Post-decision analysis or recommendation	PA400 Family
US Prosecution	Miscellaneous USPTO Papers		Revive Application Notice of Abandonment	PA300 Family or items related to Application Preparation PA400 Family for items related to Prosecution