

POTENTIAL PATENT APPLICATION QUESTIONNAIRE

Prepared by: _____

Date: _____

Your reference for this matter: _____

Correspondence information (Questions 1-2)

1. Please provide the correspondence information of the person(s) to whom we should direct all correspondence regarding the application. This will also be the person(s) from whom we will receive instructions regarding the application.

Name: _____

Address: _____

Telephone: _____

Email: _____

2. If different than the person(s) to whom we should direct all correspondence regarding the application, please provide the correspondence information for the party(ies) to whom we should address and direct any invoices for the application. *Please be advised the listed party(ies) will be responsible for payment of any invoice for the application.*

Name: _____

Address: _____

Telephone: _____

Email: _____

The Invention (Questions 3-5)

3. Please list the title of the invention in the space below.

4. Please briefly describe the invention or attach a description. If you are attaching a description, please write "see attached" in the space below.

5. Please list and attach any other disclosure materials for the invention (e.g. photographs, schematics, published paper, prototype, etc.).

Inventor(s) and Owner(s) (Questions 6-7)

6. Please list the name, residence address, citizenship, and contact information for each inventor. With regard to the inventor name, please list the family or surname in ALL CAPS (e.g. John SMITH).

Inventor 1

Name: _____

Residence Address: _____

Country of Citizenship: _____

Telephone: _____

Email: _____

Inventor 2

Name: _____
Residence Address: _____
Country of Citizenship: _____
Telephone: _____
Email: _____

Inventor 3

Name: _____
Residence Address: _____
Country of Citizenship: _____
Telephone: _____
Email: _____

☐ Please check this box if you are attaching additional inventor information.

7. If any inventor has transferred ownership of the invention, will transfer ownership, or is under an obligation to transfer ownership, please provide the name, correspondence information, and nature of ownership (e.g. all inventors assigned to owner, inventor 1 is under an obligation to assign to owner pursuant to an employee agreement, inventor 1 is licensing the invention to owner, etc.).

Owner 1

Name: _____
Address: _____
If corporation, state of incorporation: _____
Telephone: _____
Email: _____
Nature of ownership: _____

Owner 2

Name: _____
Address: _____
If corporation, state of incorporation: _____
Telephone: _____
Email: _____
Nature of ownership: _____

☐ Please check this box if you are attaching additional owner information.

Potential Reduction in Government Fees for Small and Micro Entities (Questions 8-10)

8. If any owner is an organization, is the organization a non-profit organization (e.g. university)? _____
9. If any owner is an organization, does the organization have 500 or less full and part time employees? _____
10. If you answered yes to Question 8 or 9, would you like more information about an opportunity to receive a reduction in certain government fees for a U.S. patent application by designating the application as a small entity or micro entity? _____

Prior Application(s) and Disclosure (Questions 11-14)

11. Have you already filed a patent application for the invention in the United States or a foreign country? _____

If so, please provide the application information for each application in the space below, including the country of filing, date of filing, type of application (e.g. Community Design, provisional, etc.), application number, and status of application (e.g. pending, expired, expressly abandoned, etc.).

☐ Please check this box if you are attaching additional application information.

12. If you have previously filed a patent application, would you like to base this application on the earlier filed application by including a claim of priority to the earlier application? _____

If yes, does the present invention include additional features that are not disclosed in the prior-filed application? _____

13. Have you publically used or disclosed the invention in the United States or a foreign country? _____

If so, please describe any such disclosure in the space below, including the date of disclosure, country of disclosure, and nature of disclosure (e.g. paper presentation at a conference, published in journal, demonstrated invention to investors, etc.)

☐ Please check this box if you are attaching additional disclosure information.

14. Have you sold or offered for sale the invention in the United States or a foreign country?

If so, please describe any such sale or offer for sale in the space below, including the date of sale or offer for sale, country of sale or offer for sale, and nature of sale (e.g. solicit government funding, sold to investor, selling online, etc.)

☐ Please check this box if you are attaching additional sale or offer for sale information.

Federal Funding (Question 15)

15. Was the invention made by an Agency of the United States Government or pursuant to a contract with an Agency of the United States Government? _____

If so, please provide the Agency and the contract number in the space below.

Prior Search and Prior Art (Questions 16-19)

16. Have you conducted or had conducted a patentability search for the invention?

If so, please describe the nature of the search in the space below (e.g. searched Google®, paid a third party to do a patentability search at the United States Patent and Trademark Office, etc.)

17. Are you aware of any patent, patent publication, or any other reference that discloses a similar invention? _____

If so, please list any such patent or patent publication in the space below.

18. Are you aware of any similar invention? _____

If so, please describe any such invention and how you became aware of it (e.g. saw similar invention at a trade show, based invention off of a competitor's device, etc.)

19. Are you interested in having Dowell & Dowell, P.C. conduct a patentability or infringement search for the invention? _____

Application Information (Questions 20-25)

20. Are you considering patent protection outside the United States? _____

If so, please list the foreign countries in which you are considering filing patent applications in the space below.

21. Are you considering filing a design or utility application for the invention? _____

22. If you are considering filing a utility application, would you like to file a provisional application or non-provisional application? _____

23. Would you like the U.S. Patent and Trademark Office to publish the application? There are legal fees associated with publication, and publication is required to file any foreign patent application claiming priority to a U.S. application. _____

24. If we file a foreign application based on and claiming priority to a U.S. application, there is likely a requirement to file a certified copy of the U.S. application in the foreign patent office. There are concurrently government and legal fees associated with obtaining a certified copy of a U.S. application. We may be able to avoid the need for filing a certified copy, if we agree to allow a foreign patent office access to the U.S. application. Would you like to authorize such access by a foreign patent office? _____

25. Are you interested in expediting the prosecution of the application? _____

Time Line (Questions 26-27)

26. Do you have any upcoming public disclosure date for the invention? _____

If so, when? _____

27. When would you like a draft application? _____

Miscellaneous (Question 28)

28. Are you interesting in obtaining trademark protection for a product or service associate with your invention? _____

Acknowledgment of Confidentiality of Communications

At Dowell & Dowell, P.C., we take the protection of our client's and potential client's intellectual property seriously. Since there are dangers in communicating sensitive and/or proprietary information by email, we would like to provide you with the following information.

Please read each of the items listed below carefully and then initial each item to indicate you understand and acknowledge each item. *Please note your failure to initial and acknowledge each item may limit our ability to communication with you regarding this matter.*

- _____ I understand that communications between myself and an attorney which would normally be subject to attorney-client privilege may be waived if a third party gains access to those communications.
- _____ I understand that third parties may have access to my attorney-client emails when I send or receive emails via a public computer, such as a library or hotel computer, or via a borrowed computer.
- _____ I understand that a third party (i.e. my employer) may have access to my attorney-client emails when I utilize my work computer.
- _____ If I must communicate with an attorney via a public computer or a work computer, I will only send confidential information via encrypted or password-protected documents, such as a password protected Word® document or a password protected .pdf document.
- _____ If I must communicate with an attorney via a public computer or a work computer, I will alert the attorney accordingly and request that the attorney only send confidential information via encrypted or password-protected documents.

THANK YOU FOR CHOOSING DOWELL & DOWELL, P.C.!