



Gaurav Sagarwal

Vice President (Paralegal & Trademark)

LexpertConsilium LLP (Back Office of Davé Law Group)

gaurav.sagarwal@davelawgroup.com

Areas of Focus

Intellectual Property Counseling
US Patent Filing & Prosecution
India Patent Filing & Prosecution
US Trademark Prosecution

Docketing
Data Quality
Data Verification
India Trademark Prosecution

Gaurav Sagarwal is Vice President (Paralegal & Trademark) in LexpertConsilium LLP, the India back office of Davé Law Group, LLC and a registered Indian Trademark Attorney.

Working with the practice group heads, Gaurav has overall responsibility for strategic guidance and operational management of the Intellectual Property (IP) practices. Gaurav focuses his practice on patent paralegal support, trademark filing and prosecution support and portfolio development for domestic and international clients. He oversees Paralegal Team for the Firm. Gaurav sets in motion the vision, strategic plan and goals for the business. He is responsible for making certain that necessary work is done properly and on time. Gaurav understands details of the IP business and has an enjoyment of handling details. As a Vice President, Gaurav handles external relations with clients and responsible for client onboarding by ensuring conflict clearance done and getting the engagement letters signed. He also coordinates with new Foreign Associates, Law Firms and other vendors to find out new associations for the Firm.

Gaurav has over 10 years of experience managing global patent & trademark portfolios for some of the world's leading companies. He has extensive experience clearing marks worldwide in a wide variety of industries and prosecuting trademark filings worldwide. Gaurav's unique background enables him to understand cultural nuances and helps him to advise a broad range of clients across the world.

His experience includes patent & trademark filing, prosecution and docketing management internationally, developing and implementing IP strategies tailored to business plans, worldwide patent portfolio management, trademark searches and advice on trademark infringement, data quality and data verification. His work has included advising clients in connection with IP rights across a broad array of

industry, including consumer products, internet & media, biotechnology, healthcare, hospitality, software and technology, entertainment, pharmaceuticals, chemical and hospitality.

His experience with a diverse range of global clients from start-ups to large corporations makes him well adept to understanding and meeting the different aims and requirements of each individual client. Working in collaboration with his clients, he implements filing strategies to develop comprehensive IP portfolios.

Gaurav aims to provide a practical advice and is particularly suited to finding creative solutions enabling businesses to meet their commercial objectives.

Prior to working with IP industry, he served as a customer care executive in the telecom industry.

Representative Patent Filing and Prosecution Experience

Corporations

- **BOE Technology Group Co., Ltd.** - one of the world's largest manufacturers of LCD, OLEDs and flexible displays. Gaurav is the point of contact for day-to-day operations for the client. He manages the Paralegal team who is responsible for monitoring the client due dates, get the appropriate response from the client, prepare and file the formal documents, patent applications, response to Office Actions, Information Disclosure Statement (IDS), prepare and file Response to formality notices, Issue Fee Payment, review Original Letters Patent and Prepare and file Certificate of Correction (COC) to correct typographical errors at the patent office. He also oversees reporting of the PTO correspondences, payment of Issue Fee, review original Letters Patent and prepare and file Certificate of Correction for typographical errors.
- **Cue Biopharma** – US biopharmaceutical company. Gaurav liaisons with the client to get the filing packages ready for filing their US and/or India national phase entry applications at the patent office. He is responsible to support the Attorneys to manage the patent prosecution for the client. He monitors, advises the client of the upcoming due dates and comply with the client requests.
- **FaceBook** - US social networking service company. Gaurav has successfully managed and delivered the data verification project for the client to verify the bibliographic details for around 6,000 patent records (published & granted) in 5 different jurisdictions and reported the anomalies in the client's patent data to the client.
- **Google** - US multinational technology company that specializes in Internet-related services and products, which include a search engine, cloud computing etc. Gaurav was a key member of a project for an assignment project for the client. His responsibilities were to get the chain of the assignment

title verified from the PTO websites and identify the break in chain of title, coordinate with Law Firms for the copy of documents to suffice as proof of ownership/assignment of rights, get the assignments prepared, executed and filed in US and other jurisdictions.

- **Immatics Biotechnologies GmbH** - a biopharmaceutical company active in the discovery and development of T-cell redirecting cancer immunotherapies. Gaurav ensures the filing and manage patent prosecution of India national phase application for the client. He handles the Paralegal team and support Attorneys by providing shell responses for Office Action, preparing formal documents and petitions for submission at the Indian Patent Office (IPO). He also takes care of the formality related objections raised by the Examiner in an Examination Report (similar to Office Action).
- **Intel Corporation** - US multinational corporation and technology company. Gaurav was handling the In-House Counsel Support for the client. The information was downloaded from a share-point site and instructions were entered in the IP management software of the client.
- **Koninklijke Philips N.V.** - Netherlands-based health technology company. Gaurav was responsible for audit of the daily docketing of the client, provide a feedback to the docketing specialist of the team and share the summary of the work on daily basis with the client.
- **Microsoft** - US multinational technology company, develops, manufactures, licenses, supports, and sells computer software, consumer electronics, personal computers, and related services. Gaurav has worked at different roles for this client. Gaurav has worked for the Foreign (Non-US) Docketing team which used to manage a monthly average volume of around 10,000 emails. He was part of the Family Linking team where the team used to verify and update the correct priority and parent relationship in the IP management software of the client. He has also worked on Helpdesk process where he used to coordinate with Attorneys for procedural activities and resolve Inventors' queries with respect to their patent rewards and recognition program. He was an active member of the data quality project for the client and to prepare data inconsistency dashboard based on IP logics.
- **Nouscom AG** - immunotherapy company developing engineered viral vectored vaccines for treatment of cancer. Gaurav ensures the filing and manage patent prosecution of India national phase application for the client. He handles the Paralegal team and support Attorneys by providing shell responses for Office Action, preparing formal documents and petitions for submission at the Indian Patent Office (IPO). He also takes care of the formality related objections raised by the Examiner in an Examination Report (similar to Office Action).
- **Shenzhen Mindray Bio-Medical Electronics Co., Ltd** - global medical instrumentation developer, manufacturer, and marketer. Gaurav ensures the filing and manage patent prosecution of US and/or India national phase application for the client. He handles the Paralegal team and support Attorneys by providing shell responses for Office Action, preparing formal documents and petitions for submission at USPTO and IPO. He also takes care of the formality related objections raised by the

patent office.

- **Supermax Personal Care Pvt Ltd** - personal care products manufacturer. Gaurav handles the US, India and other foreign filings and manage global patent prosecution for the client. He liaisons with various Foreign Law Firms to get status update on the client portfolio, report out the PTO correspondences, obtains cost estimates for application filings, prepare and file Office Action responses, annuity payments etc. He is also responsible to prepare and share periodic Patent Portfolio Review reports to the client and advise client to plan a yearly budget for the upcoming financial period. He also manages Information Disclosure Statement (IDS) preparation and submission, Assignments, Response to formality notices, preparation of petitions and requests for submission with patent office, prepare and file Response to PCT Article 19 or Article 34 Amendments, monitor activity and deadlines and advise client of same, Post-allowance Review, Issue Fee Payment, review Original Letters Patent and Prepare and file Certificate of Correction (COC) to correct typographical errors.
- **Toray Plastics (America), Inc.** - a subsidiary of Toray Industries Inc., the world leader in synthetic fibers and textiles, carbon fibers, plastics, chemicals, pharmaceuticals and high-performance films. Gaurav ensures the filing and manage global patent prosecution for the client. He handles the Paralegal team and support Attorneys by providing shell responses for Office Action, preparing formal documents and petitions for submission at USPTO, IPO and WIPO. He also takes care of the Information Disclosure Statement (IDS), prepare and file Assignments, prepare and file Response to formality notices, prepare petitions and requests for submission with patent office, Prepare and File Response to PCT Article 19 or Article 34 Amendments, monitor activity and deadlines and advise client of same, Post-allowance Review, Issue Fee Payment, review Original Letters Patent and Prepare and file Certificate of Correction (COC) to correct typographical errors.

Universities

- **Amrita Vishwa Vidyapeetham** (previously known as Amrita University) - a private deemed-to-be-university in India. Gaurav handled the US and India patent filings for the different schools and/or campuses. He used to support Attorneys by providing shell responses for Office Action, preparing formal documents and petitions for submission at USPTO and IPO. He used to maintain a docket, advise client of the upcoming due dates and take necessary action based on the client instructions. He also did Post-allowance Review, Issue Fee Payment, review Original Letters Patent and Prepare and file Certificate of Correction (COC) to correct typographical errors.
 - Amrita Center for Nanosciences and Molecular Medicine.
 - Amrita School of Biotechnology.
 - Amrita School of Engineering.
 - Amrita School of Medicine.

- **George Mason University** - a public research university in Fairfax County, Virginia, USA. Gaurav closely works with the client to ensure timely filings of US and PCT patent applications. He gets the formal documents prepared, signed and filed at the Patent Office. He also assists Attorneys in managing the patent prosecution by providing shell Office Action responses, prepare and file Assignments, prepare and file Response to formality notices, prepare petitions and requests for submission with patent office, Prepare and File Response to PCT Article 19 or Article 34 Amendments, monitor activity and deadlines and advise client of same. He also did Post-allowance Review, Issue Fee Payment, review Original Letters Patent and report out the same.
- **Indian Institute of Technology, Madras (IITM)** - an institute of national importance, IITM is a public technical and research university located in Chennai, Tamil Nadu, India. Gaurav handled the US, India and PCT filings for the client. He managed the Paralegal team and take care of Information Disclosure Statement (IDS), shell Office Action responses, prepare and file Assignments, prepare and file Response to formality notices, prepare petitions and requests for submission with patent office, Prepare and File Response to PCT Article 19 or Article 34 Amendments, monitor activity and deadlines and advise client of same, Post-allowance Review, Issue Fee Payment, review Original Letters Patent and report out the same.

Start-Ups

- **DeePath Medical Diagnostics, Inc.** - early-stage clinical diagnostics company developing novel technologies for detection, quantification, and characterization of hematologic cells that impact cancer. Gaurav handled US patent filings of the client, preparation and filing of assignment, providing shell Office Action response, Issue Fee payment and reporting out the original Letters Patent for the client.
- **Efemoral Medical LLC** - early-stage medical technology company developing durable, minimally invasive treatment solutions for patients suffering from peripheral vascular disease. Gaurav handled US patent filings of the client, preparation and filing of assignment, providing shell Office Action response, Issue Fee payment and reporting out the original Letters Patent for the client.

Others

- **GAVS Technologies Pvt. Ltd.** – artificial intelligence (AI), predictive analytics, internet of things (IOT). Gaurav handled India patent filings of the client. He assisted Attorneys by providing shell Office Action response. He was responsible for maintaining the docket for client due dates, advise client of the upcoming due dates and get the necessary information from the client and take required action on time.
- **Orient Bell Ltd.** - ceramic wall and floor tile manufacturing company. Gaurav handled India patent

filings of the client. He assisted Attorneys by providing shell Office Action response. He was responsible for maintaining the docket for client due dates, advise client of the upcoming due dates and get the necessary information from the client and take required action on time.

- **Pulmonx Corporation** - global leader in interventional pulmonology, planning tools, and treatments for obstructive lung disease. Gaurav handled US patent filings of the client, preparation and filing of assignment, providing shell Office Action response, Issue Fee payment and reporting out the original Letters Patent for the client.
- **Space Data Corporation** - Wireless Telecommunications Services provider. Gaurav ensures the filing and manage global patent prosecution for the client. He handles the Paralegal team and support Attorneys by providing shell responses for Office Action, preparing formal documents and petitions for submission at USPTO, IPO and WIPO. He also takes care of the Information Disclosure Statement (IDS), prepare and file Assignments, prepare and file Response to formality notices, prepare petitions and requests for submission with patent office, Prepare and File Response to PCT Article 19 or Article 34 Amendments, monitor activity and deadlines and advise client of same, Post-allowance Review, Issue Fee Payment, review Original Letters Patent.
- **Stellar IT Solutions** - tech/ implementation services company. Gaurav handled US patent filings of the client and preparation and filing of assignment for the client.
- **Touchmagix Media Pvt. Ltd.** - interactive projection system & interactive display technologies manufacturer. Gaurav ensures the filing and manage global patent prosecution for the client. He handles the Paralegal team and support Attorneys by providing shell responses for Office Action, preparing formal documents and petitions for submission at USPTO, IPO and WIPO. He also takes care of the Information Disclosure Statement (IDS), prepare and file Assignments, prepare and file Response to formality notices, prepare petitions and requests for submission with patent office, Prepare and File Response to PCT Article 19 or Article 34 Amendments, monitor activity and deadlines and advise client of same, Post-allowance Review, Issue Fee Payment, review Original Letters Patent.

Representative Trademark Filing and Prosecution Experience

Corporation

- **LABON PAINTS AND COATINGS PRIVATE LIMITED** – a Bengaluru, India based company. Gaurav did a comprehensive pre-filing search for the two trademarks. He prepared and filed two trademark applications at India Trademarks Office. He is managing the trademark prosecution for the client. He has also prepared and filed the response to Examination Report in one of the applications and the applications is now about to grant.

Start-ups

- **JUSTYOU VNO LLC** – a US based start-up company. Gaurav did a basic pre-filing search, prepared

a trademark application for filing by the US Attorney.

- **Stellar IT Solutions** - tech/ implementation services company. Gaurav handled US trademark filings of the client and preparation and filing of assignment for the client.

Individuals

- **LALIT K JHA** - Founder, New India Abroad and Chief US Correspondent, Press Trust of India. While doing the trademark pre-filing search for the mark, Gaurav found 2 pre-existing Live trademarks applications with the same name. As a part of the due diligence process, it was found that the status on the USPTO Trademark Status & Document Retrieval (TSDR) was incorrect. Gaurav contacted the patent office to update the status. This safeguarded the client interests and filed two trademark applications.
- **PIYUSH SAKHARELIYA** –a US based entrepreneur. He is working and developing some inventions in the automation area. Gaurav has done pre-filing search for 4 trademark application and 1 out of these 4 was a knock-out search. Gaurav also prepared 3 trademark applications for filing by the US Attorney.

Education

- Bachelor of Arts from Chaudhary Charan Singh University, India, 2007.
- LL. B from Chaudhary Charan Singh University, India, 2014.

Admissions

Bar Association, Uttar Pradesh, India

Languages

English and Hindi