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Cooperation with Non-Lawyer Firms: Experiences and Lessons Learned

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“When you’re with [BoMc], it’s always a
great partnership.” – *IAM Patent 1000*

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Agenda



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- About BoMc
- Cooperation with non-lawyer firms
 - Practice Administration
 - Lessons Learned and Tips
 - Outsourcing of Some Activities
 - Lessons Learned and Tips
- Conclusion

About BoMc: Our Practice



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“A particular area of emphasis is the firm’s reasonable fee structure.”

Managing IP, IP Stars

- Patent Prosecution & Portfolio Management
- Due Diligence & IP Transactions
 - License agreements, patent assignments, joint development agreements, and consulting agreements
- Opinions & Counseling
 - Validity, infringement, and freedom-to-operate
- Contested Proceedings
 - *Inter Partes* Reviews (IPRs), Post Grant Reviews (PGRs), Covered Business Method reviews (CBMs), *Ex Parte* Reexaminations and Reissues

Our Legal Team



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- ~50% former patent examiners
- All with technical degrees; ~15% advanced degrees
- Extensive portfolio management expertise
- Wide-ranging technical expertise

The BoMc Code



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Teamwork

Our structure promotes sharing work and sharing credit. This encourages working as a team, and enables us to put our clients' interests first.

Value

We understand today's business realities. Our platform provides cost-effective solutions and consistent, efficient client teams.

Focus

We focus on patent counseling and prosecution. All of our attorneys and staff are dedicated to that one practice.

Balance

Proper balance in life leads to a more fulfilled, healthy individual, and thoughtful work product. We work hard, yet we encourage making time for outside interests.

Diversity

Our welcoming environment fosters and supports diversity. A diverse team is more interesting, fun, and enriching, and leads to better solutions.

Humility

Humility is part of a pleasant work environment. We're able to laugh at ourselves. We take our work seriously, without taking ourselves too seriously.

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Why Work with Practice Admin. Non-Lawyer Firms?



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- Reduce overhead and need for in-house special skills in each department
 - Real estate
 - Equipment
 - Headcount
- On demand and up-to-date expertise from specialists
 - Software updates, market trends, latest best practices crowd sourced from others
- Reduces overall management and administrative load
- Result: Better **value for money** passed onto clients

Example Non-Lawyer Service Providers



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- Information Technology (IT)
- Marketing, Accounting, and Insurance
- Practice Support Platforms
- Architects and other real estate professionals
- Legal Services Outsourcing

Information Technology (IT)



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- Managed IT Services & Cloud Practice Platform
- Benefits
 - Low overhead; per user costs
 - Up-to-date cybersecurity
 - Scalability and upgrades
 - On-demand service
 - Easy access to entire practice platform from anywhere in the world
- Drawbacks
 - Understanding the law firm's needs
 - Integration among various software: timekeeping, docketing, billing
 - Lack of flexibility or customization
 - Sometimes outdated software is only option

Marketing, Accounting, and Insurance



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- Entire suite of services as needed and without overhead
- Benefits
 - Expertise from various industries and legal practices – big help when audience is not lawyer or patent lawyer
 - Scalability
 - Fast turnaround times
 - Education
- Drawbacks
 - Lack of familiarity with firm, patent practice, technology
 - Volume of work not enough to command attention
- Consider hybrid model

Practice Support Platforms



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- Technology firms that offer software packages
 - E.g., Docketing, billing, etc.
- Benefits
 - Low overhead; per user cost
 - Specialists allow for customization as need or practice changes
- Drawbacks
 - Resources may not be tailored to intricacies of patent prosecution practice
 - These third party solutions sometimes may not work seamlessly within overall scheme of IT provider, or may require particular customizations

Real Estate Professionals



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- Work space that is cost efficient yet conducive to collaboration between lawyers
- Benefits
 - Leverage innovative solutions from other industries
 - Multi-generational work place appeal
 - Manage staffing considerations
 - Not tied to “tradition”
- Drawbacks
 - Lack of familiarity with legal practice, especially patent counseling practice
 - Too innovative

Example Outsourcing



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- Competitive Monitoring and Searching
- Preparation
 - Patent Application
 - Information Disclosure Statement (IDS)
- Administrative
 - Data collection
 - Annuities
 - Mass Name/Assignee Changes

Considerations When Outsourcing

- Quality
 - How to maintain high levels of quality?
- Cost
 - LSO cost + additional internal cost
- Time difference
 - Logistics
- Export control on technology
- Transparency to client
- Liability
- Maintaining Attorney Client Privilege

Competitive Monitoring



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- Patent Publication Monitoring
 - Alerts: U.S., CA, CN, EP, & WO
- Searching
 - portfolio mapping
 - landscape searches
 - Collection of metrics
- Strength of results will depend on upfront effort
 - Clear instructions
 - Identification of search terms/strings
 - Communicate technology and scope

Patent Prosecution



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- Patent Application Preparation

- ~USD \$2000 - \$4000
- Challenges
 - Technical description
 - Claim drafting
 - Technology or art specific terminology
 - Alternatives and expansion of embodiments
 - High drafter turnover

- Information Disclosure Statements

- Large IDSs
- Continuing applications and cross-citing across families



Administrative



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- Data Collection
 - E.g., All patents owned by Assignee “X”
 - Useful in evaluating sale of Assignee “X”
 - All patents naming Inventor “Ian”
- Annuity payments
- Mass name/assignee changes once provided with sample submission
- Patent Proofreading

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Conclusion



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- Cooperation with non-lawyer firms can bring diversity of thought
 - Fresh Ideas
- Some education or exposure to specifics of patent practice may be necessary
- Some legal outsourcing has a place in today's patent industry
- Can help to give patent firms edge in client services as well as recruiting and retention

Questions



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Speaker Information



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Dinesh Melwani works with startup and established companies to develop comprehensive patent strategies in concert with their business goals. He focuses on developing patent portfolios, securing freedom to operate for new technologies, positioning intellectual property to maximize investment and acquisition opportunities, and helping clients maintain an edge over competitors.

A Singular Focus on Strategic, High Quality Patent Counseling and Prosecution



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