

IPREVIEW

A man in a pinstriped suit and blue shirt is leaning on a metal railing outdoors. He has a serious expression and is looking slightly to the left. The background shows bare trees and a building.

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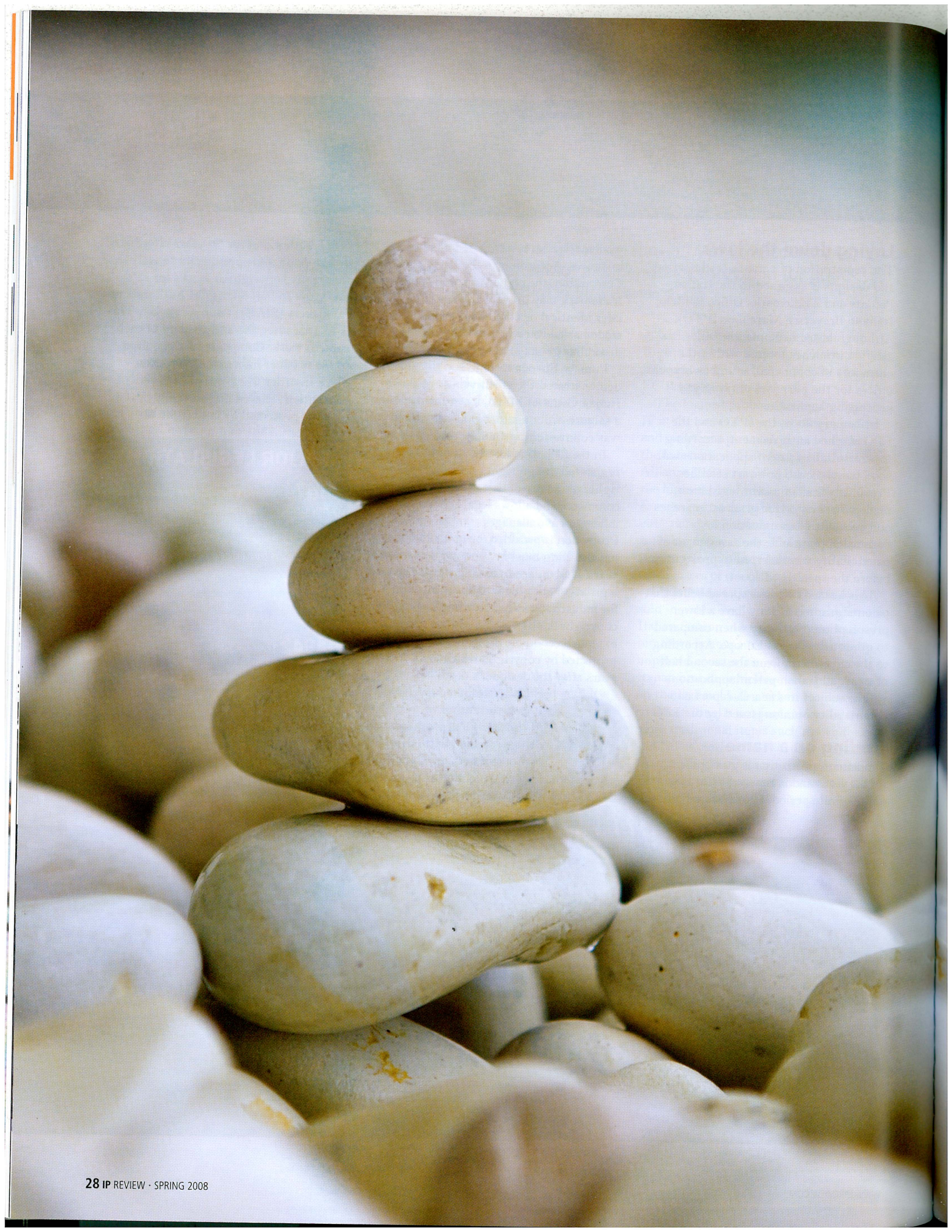
Outside the patent factory

Donal O'Connell, director of IP Rights
at Nokia, steps off the shop floor

Sign of the times Why it's time to sit up and take notice of your trademarks

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A foundation for IP

The last 10 years has seen a marked migration of patent litigation from specialised IP boutiques to general law firms. But that's only part of the picture, says Modern Times Legal's **Robert J Sayre**

Before Robert J Sayre set up

Modern Times Legal (MX Legal) in 2007, IP boutiques had faced a period of intense competition from full-service law firms looking to muscle in on the market. Many experts predicted that IP boutiques would be forced to merge with large general practice firms or enter into alliances with other boutiques in order to stay competitive. Instead, almost the reverse has become true.

'We're entering a new wave for patent practice,' explains Bob. 'The market has opened up considerably, allowing smaller firms like MX Legal to soak up the type of work that large firms may not be as prepared to do. It's also a period of intense uncertainty, due to current debates in the US around the future of patent legislation, which makes the ability to be fast-moving paramount.'

For a general practice firm that deals in multimillion-dollar litigation cases, the tens of thousands of fees generated by patent prosecution cases is, in comparison, relatively small fry. 'That raises the need for smaller specialists, who are tailored to provide better client service in this area,' says Bob. 'But it is also driven by the demands of the clients: billing rates have skyrocketed in larger firms, and clients are beginning to question these charges, particularly those associated with administrative functions, such as docketing.'

Tailoring to fit

'One of the most enjoyable aspects of moving from a larger firm to set up on my own has been the opportunity to model processes to fit client demands, but also to adapt to the changing face of the IP industry,' says Bob. 'The last few years have seen a step change in the way that IP is managed, as software systems become increasingly sophisticated and clients turn to email and the Internet to communicate and interact. Gone are the days when an attorney needs to "express mail" all of its filings; today, I can just generate a pdf and upload. It's so much more efficient.'

'Larger firms are much more risk-adverse and tend to shy away from making changes to established styles of workings. As a smaller operation, it's much easier to adapt,' says Bob, who cites the USPTO's move to a new e-filing system in 2006 as a key moment in his decision to open up his own firm.

'The move towards a paperless system benefits all concerned,' he adds. 'It allows patent and trademark offices to reduce the errors involved in processing applications; it allows clients to keep a virtual tab on all their cases and case histories; and, importantly, it allows small law firms, such as

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'I saw that FoundationIP's docketing system could become the very linchpin of my patent prosecution service.'

MX Legal, to manage a very lean operation, so long as they have an appropriate IP management system in place.

'My goal is to focus on great lawyering; it's not to nickel and dime my clients for every photocopy or fax I send,' he adds.

For Bob it's all part of being transparent and consistent in the service provided to clients. 'That's why I wanted an online docketing system that I could share with clients. Information didn't just have to be up-to-date, it had to be readily available for download. After all, what's the point of a client paying for my time to search out a paper file when they could just as well access it online? Clients want transparency in the process and ready access to data, so why not give it to them?'

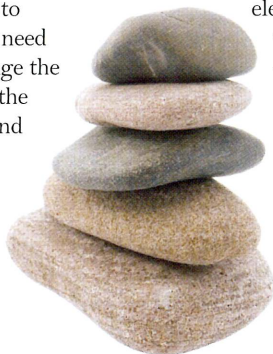
'The fact that FoundationIP was recommended to me by so many of my colleagues helped secure my decision,' adds Bob. 'But I'd used CPA's services in my previous role and was particularly taken by the potential of outsourcing to help me operate more effectively.'

'I saw that FoundationIP's docketing system could become the very linchpin of my patent prosecution service; I signed up within a month of starting my own practice.'

Choosing the right system

'In a typical law firm, you need to employ someone specifically to do docketing,' says Bob. 'But what happens if they are ill or leave? It makes much more business sense to outsource such functions to specialists. Similarly, I don't need to employ someone to manage the IT involved with operating the software: it's all backed up and supported by CPA.'

'FoundationIP took me a couple of months and a few training sessions to master. Now I can do all of it myself. That not only keeps



Developing skills overseas

Lack of patent drafting skills can prevent inventors in developing countries from fully benefiting from IP protection systems, which is why it is so important to pass on the requisite skills. In 2007, WIPO's Intellectual Property and New Technology Division organised six patent drafting workshops worldwide to do just that. These intensive two-week programmes were organised in collaboration with national governments and designed to teach local inventors and scientists the technical skills needed to prepare and file patent applications in the territory. Modern Times Legal's Robert J Sayre participated in one such programme in Zimbabwe in 2007. If you would like to find out more about the programme or how to participate in future workshops, visit www.wipo.int.



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the overheads down, it also means that I can operate my business like a virtual office.'

That came in handy when Bob was presented with the opportunity of participating in a WIPO patent-drafting programme for developing countries in Zimbabwe in September 2007. 'I had serious reservations about leaving my fledgling practice and my clients for a week and a half, but technology has evolved to such a level that even in locations as far away as Zimbabwe you're never that far from an Internet connection,' he says. 'It's at times like that when I really appreciate FoundationIP. I could stay in touch with my clients by email, access the USPTO electronic database and continue my work as normal using FoundationIP – all from the other side of the world.'

'It was a fantastic experience and I'm so glad I was able to participate,' says Bob. 'It really inspired me – and helped me to see our own patent system in a different way. Efforts to overhaul US patent law have stagnated due to the demands of conflicting lobbyists; my time in

Africa helped put that back into perspective and showed how IP, managed right, could promote progress and build economies. That's why strong patent rights are critical, and yet legislation that's currently in Congress could weaken them in the US.'

Bob also highlights how he thinks the current patent office has disadvantaged patent applicants with recently proposed and enacted rules. 'They want to reduce their backlog, which absolutely makes sense, but they have chosen to do it by pushing work, such as prior art searches, on to applicants. It's a lot of pressure for large companies, not to mention the lone inventor. In this environment, successful patent prosecution can require nimble action, adaptability and access to the automated tools that sophisticated software systems can provide. FoundationIP has been instrumental as a partner in helping to secure some of these advantages,' he says.

To find out more about FoundationIP, visit www.cpaglobal.com or email ebrace@cpaglobal.com. ■