



Cost-effective Strategies for Working with Patent Counsel

Welcoming remarks will begin at
11:55 a.m. Eastern Time.

The formal presentation will begin at noon.

For audio, dial in by phone:

+1-866-365-4406

Access code 5627649



Cost-effective Strategies for Working with Patent Counsel

Presented by:

**Laura McKnight, *University of Rochester*
Khera Douglas, *Arizona Tech Enterprises (AzTE)***

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Questions?

We will be taking questions during a designated question and answer period at the conclusion of the presentation. Please hold all questions until this designated period.



Operator Assistance

Audio difficulties: Dial 0 0

Other issues: +1-847-559-0846



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Thank You!



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Laura McKnight
Intellectual Property
Paralegal
University of Rochester



Khera Douglas
Director of Support
Operations
Arizona Tech Enterprises
(AzTE)

Cost Effective Strategies for Working with Patent Counsel

- **Khera Douglass**
- **Arizona Technology Enterprises**

- **Laura McKnight**
- **University of Rochester**

Title here

The following presentation reflects the personal views and thoughts of Khera Douglass and Laura McKnight, and is not to be construed as representing in any way the corporate views or advice of the Arizona Technology Enterprises or the University of Rochester and their Affiliates, Subsidiaries or Divisions, nor the views or advice of the Association of University Technology Managers (AUTM). The content is solely for purposes of discussion and illustration, and is not to be considered legal advice.

Cost Effective Strategies for Working with Patent Counsel

- Expectations
- Communication
- Opportunities
- Examples

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POLL

1. Do you manage, docket, disseminate, or otherwise work with patent prosecution matters?
2. Do you currently use at least one outside law firm for patent prosecution?
3. How many years experience do you have in tech transfer altogether (including your current role).

PRACTICE SIZE



Practice Size

- **Sole Practitioners**
 - **Direct relationship**
 - **Lower fees and costs**
 - **Less formality**

- **Small Law Firms**
 - **Aka “boutique”**
 - **Specializations**
 - **Availability**

Practice Size

- **Mid-Sized Law Offices**
 - Full service
 - More contacts
 - Better known

- **Large Law Offices**
 - High levels of expertise
 - Broad range of matters
 - Multiple locations

PERSONNEL



Personnel

- **Partners**
 - **Owners-shareholders**
 - **Most experience**
 - **Highest fees**

- **Associates**
 - **Employees**
 - **Less experience**
 - **Lower billing rates**

Personnel

- **Contract Lawyers**
 - **Independent contractors**

- **“Of Counsel”**
 - **Affiliates**
 - **Semi-retired**
 - **Contract**

Personnel

- **Law Clerks**
 - Law students
 - Legal research and assistance
 - Recruits

- **Paralegals**
 - Legal training
 - Supervised
 - Contract

Personnel

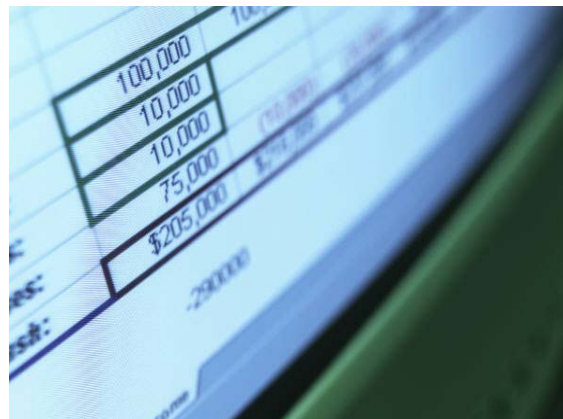
- **Legal Assistants**
 - Paralegals
 - Secretaries
 - Support staff

- **Secretaries & Receptionists**
 - Assist with administrative & procedural details
 - Initial contact with clients

Personnel

- **Investigators**
 - **Some types of law**
 - **Gather background information**
- **Administrative Personnel**
 - **Internal operations**
 - **Constitutes overhead cost**
 - **Librarian, human resources, finance**

BUSINESS MODEL



Practice Areas



***Antitrust ● Alternative Dispute Resolution Corporate ●
Copyright ● Industrial Design International ● IP
Asset Management & Licensing ● Patents ●
Trademarks ● ● Trade Secrets***

Patent Terminology



**Prosecution ● Application ● Examination
Amendments ● Interviews ● Issue ● Grant
Register ● Utility ● Design ● Interference
Infringement**

Patent Practitioners



● Attorneys ● Patent Agents ●
Foreign Associates ● Examiners

Patent Prosecution

- Process of obtaining a patent for an inventor
- Preparing an application with claims
- Examination by the USPTO
- Allowance or Actions
- Issuance, Continuations, Appeals

Something helpful....

Patent Prosecution Type	Country	Prosecution Schedule-Due Date(days-months-years) after OA date
30 Month National Phase Filing	PCT	30 months after Priority Date
1 Year Provisional Conversion	US	1 year after provisional Filing Date
Office Action	US	3 months after mailing date of OA (<i>shortened statutory period</i> ; can be extended to <i>maximum statutory period</i> -6 months)
1 Year Foreign Filing Deadline	US	1 year after Utility (or Provisional) filing date (if wish to claim priority)
IDS	US	3 months after filing date (variable until issue-post issue with fees-statements)
Filing Receipt Received	US	3 months after filing date
Notice to File Missing Parts	US	2 months after mailing date of Notice (extendable to 6 months)

Patent Prosecution Type	Country	Prosecution Schedule-Due Date(days-months-years) after OA date
Restriction Requirement	US	30 days after mailing date of RR (extendable to 6 months)
Final Office Action	US	2 months after mailing date to receive Advisory Action (otherwise 3 months after mailing date, extendable to 6 months). If no Advisory Action, reply must either put the application in a condition for allowance, or be a Notice of Appeal, and RCE, etc. Max Stat Period = 6 months *if file a response to the FOA, clock continues to run until you file: a Notice of Appeal, an RCE, a continuation/divisional or CIP application (or receive a Notice of Allowance)

Patent Prosecution Type	Country	Prosecution Schedule-Due Date(days-months-years) after OA date
Advisory Action	US	3 months after mailing date of FOA, extendable to 6 months [if the AA is not mailed before 3 months after date of FOA, then extension of time fees are calculated from the mailing date of the AA, but original 3 and 6 month response deadline periods –from mailing date of FOA – still hold] Requires response to AA, a notice of Appeal, an RCE, within 6 months of mailing of FOA.
Publication	US	18 months from earliest priority date

Patent Prosecution Type	Country	Prosecution Schedule-Due Date(days-months-years) after OA date
Publication Fee	US	3 months from date of mailing of Notice of Allowance- not extendable
Issue Fee	US	3 months from date of mailing of Notice of Allowance – non extendable
Notice of Allowance	US	3 month deadline to file a divisional, continuation or CIP
Notice of Appeal	US	3 months from date of mailing of Final Office Action – extendable to 6 months max
Appeal Brief	US	2 months from filing Notice of Appeal-extendable to 7 months note: two month (extendable) deadline to file Appeal brief is measured from the date of Receipt by the PTO of the NOA.
Reply Brief	US	2 months from date of mailing of Examiner's Answer to the Appeal Brief (if no Answer, case goes on to the BPAI)
Oral Hearing	US	2 months from date of mailing of Examiner's Answer

Getting Started

Producing a SOP Document

CHECKLIST

- ✓ Review existing procedures
- ✓ Develop an outline
- ✓ Verify with “subject matter experts”
- ✓ Create – Revise – Clarify

Drafting

Development and Writing Style

- ❖ User friendly
- ❖ Concise
- ❖ Not overly restrictive

Design and Layout

- Easy on the eyes
- Structured
- Easily modified
- Make clear the date of the revisions

Ownership

- ▶ Timely review, updates, dissemination
- ▶ Authorizing modifications
- ▶ Notifications
- ▶ Accessibility

Tailor to Audience

- External vs. internal
- Stick to most important
- Engage outside counsel in the process
- Streamline

Communications

- Transmittal
- Formats
- Contacts
- Frequency
- Type

Prosecution

- Dockets, Deadlines & Reminders
- Drafting, Reviewing, Deciding
- Strategy and Filings
- Notifications, Invitations, Responses

Etc.....

- Responses
- IDS
- Annuities
- Forms and Signature

Ready to go....





ITEM General Correspondence

- **DEFAULT/EXCEPTIONS/COMMENTS**
- Email all communications; no hard copies necessary. Send email to case manager and cc: Tech Transfer at techtransfer@urmc.rochester.edu . Always include the UR reference number (tech id) 6-XXXX in the subject line. The email communication should indicate what is being sent; only the cover (client) letter should be attached to the email, and all enclosures and other supporting documents should be posted to the extranet (indicated as such in the email and letter). At the end of the letter, please list to whom copies of the communication were sent by cc: list. The inventors and licensees do not have access to the extranet; please send emails separately to those individuals, with the letter and all supporting documents attached.

Assignments & Declarations

- **Outside Counsel to send assignments & declarations to investigators/inventors directly for execution.** Assignments for all cases, both Medical Center and River Campus are made to the **University of Rochester (not “University of Rochester Medical Center”)** at the following addresses (**Med Center**) 601 Elmwood Avenue, Box OTT, Rochester, NY 14642 and (**River Campus**) 611 Hylan Building, P.O. Box 270142, Rochester, NY 14627-0142.
- Send/upload to extranet a copy when recorded & notify OTT via email
- n.b. **New assignments are necessary when there is new matter.**

Assignments & Declarations

- We no longer require Assignments and Declarations for our provisional patent applications. PCT, Non-Provisional and National Phase Assignments should include a Notary Block with an exception for Inventors living outside of the United States.

IDS References

- First, ask investigators to provide copies (include gentle reminder of time sensitivity and cost); **if still need references after (*time frame to be determined*)**: OC will obtain the references if there are less than 15 total needed. If more than 15 references are needed, OC will email the list of references to OTT to obtain. Exceptions: If there is a shortened deadline, OC and OTT will determine how to proceed.

Conversion Deadline Reminders

- **Provisional:** Needed at 10th month only via email
- **PCT:** Needed at 28th month only via email

Who is the Client?

- ...Application filing should be reported directly to AzTE and not to the inventors
- ...AzTE has oversight responsibility for managing use of outside counsel....Accordingly, an AzTE attorney must approve all requests from ASU inventors for work by outside counsel.

Formal Letters?

- New Email Sample

- Dear **(Manager via email @urmc.rochester.edu)**:
- This is to confirm that the above-identified provisional patent application was filed in the Patent and Trademark Office on March 23, 2011. A copy of the application, as filed, along with the Electronic Acknowledgement Receipt is available at the **Extranet/EROOM**. We will provide you with additional details on the filing particulars as soon as they are received.

cc: **Inventor name (via email - under separate cover enclosures attached)**
Tech Transfer (via email- enclosures at Extranet/EROOM)

Sender name,
"Signature block"

Attachments

- Each document should be included as a separate attachment (*e.g.* a Notice of Missing Parts and a Restriction Requirement should be considered separate attachments, even if reported in the same email); and
- Each attachment should be labeled with an identifier and a simple descriptive phrase.

Subject Line Formats

Due Dates	Our Ref. #	Law Firm Ref. #	DUE DATE [date]
Reminders	Our Ref. #	Law Firm Ref. #	REMINDER RESPONSE DUE [date]
Final Due Dates	Our Ref. #	Law Firm Ref. #	FINAL DUE DATE of [date]
No Action Required	Our Ref. #	Law Firm Ref. #	NO ACTION REQUIRED

Speaking of reminders.....

Docket Reports

We request that outside counsel provide us with a 60 day docket of matters with open deadlines every other Monday. The dockets should be received in our offices no later than 9:00 a.m. MST. Your firm name and the name of responsible attorneys should clearly appear on the docket which should also include the following information:

Case #; firm docket #; application/patent #; country; title; inventors names; action due; due date; final due date; comments on status of response (draft sent, waiting for executed documents, etc.)

some easy ones.....

- Status inquiry:
 - do not file unless OTT requests
- Chapter II demand letters:
 - OTT will not request examination under Ch.II.
- Invitation to Pay Additional Search Fees:
 - Do not pay additional search fees

Just to be clear.....

- *...default instructions should be used only after every effort has been made to obtain instruction from one of the following.....*

Resort to default

- In the absence of other instructions, take all necessary actions to keep a pending application alive or an issued patent in force.
- Replies to official correspondence should be filed on a timely basis to eliminate extensions and preserve patent term. All extensions must be approved in writing by an OTT attorney.
- In-person Examiner's interviews must be approved in writing by an OTT attorney.
- Except in the case of an emergency, (e.g. filing an application to avoid a statutory bar), an OTT attorney must approve all requests for legal work.

For example...

- Pay issue fee within statutory period
- Paris Convention deadlines:
 - If a US application was filed, file a PCT application designating all states
- National Phase deadlines:
 - Reduce the no. of claims to minimize filing fees
 - Amend claims as necessary to conform to national practice
 - Nationalize in US, Canada, Europe, Japan, Mexico

Routine Prosecution Matters

- Office Actions (US Only):
 - Report occurrence and provide brief analysis (of less than one hour's time). Have paralegals send reminders. Proceed with response only after receive instructions from manager to respond.

More routine matters....

- PCT Search Report/Written Opinion
 - Report occurrence only. Do not review/analyze; do not reply; no reminders necessary; do not copy inventors. Except: compare art and add to IDS in US if necessary. Paralegal time when possible.

- PCT Invitation to Pay Additional Fees:
 - Do not pay additional fees; search the claim group selected by examiner unless OTT manager instructs otherwise.

Resources

- <http://portal.uspto.gov/external/portal/pair>
- <http://patentscope.wipo.int/search/en/search.jsf>
- http://www.wipo.int/patentscope/en/search/national_databases.html
- <http://www.autm.net/Home.htm>

Thank you for participating!

Contact Information:

Khera Douglass ~ Khera.Douglass@azte.com

Laura McKnight ~ Laura_McKnight@urmc.rochester.edu



Discussion and Q&A

Click the raise hand button.

When called on, press * 7 on your telephone keypad to un-mute your phone.

Press * 6 to re-mute your phone.



Thank you for your participation.

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Webinar Recordings

Basics of Technology Transfer for Licensing Professionals
Basic Patenting 101
Copyright Law and Content/Software Licensing
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Financial Conflicts of Interest
Marketing: Whether By Traditional or Social Media, the Value
Need to Know Basics of Technology Transfer for Support Staff
Negotiation of License Agreements
Nuts and Bolts for Compliance Under Federal Funding Awards
The Basics of Open Source Licensing
Tips for Managing MTAs
Triage
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Save the
Date!