



**SLW INSTITUTE**  
**GLOBAL IP CONFERENCE**  
with Advanced PCT Training | 2018

Track III: Strategic IP Management

**STREAMLINING LEGAL OPERATIONS**

# Presenters



**Liz Fortier**

General Counsel, *Lucid*



**Peter Rebuffoni**

Legal Process Manager, *Schwegman*



# Operational Challenges faced by Corporate and Outside Counsel?

- Electronic Filing and PTO Communications
- AIA and First-to-File in the US
- Global IP Portfolios
- Client Data Security
- Evolving Case Law w/ Employee Agreements and Assignments



# Effects of the switch to E-filing

- Despite USPTO closures, items can now be filed 24 hours a day / 7 days a week. Creates pressures on in-house counsel and outside law firms to be ever available and willing to file
- Document properties (type, size, naming convention, corruption, storage capacity) of greater importance
- Need for tools/programs to handle higher capacity filing and storage of documents
- Additionally, electronic correspondence received from patent office(s) require specialized procedures and capacity



# Solutions to the demands of e-filing

- Identification and commitment to maintaining core business hours and communication of expectations to clients/employees
- Pool of after-hour paralegals/e-filers or on-call personnel to handle 11<sup>th</sup> hour filings
- Electronic signature programs/electronic stamps for executing by multiple devices
- Automated scraping/docketing of USPTO correspondence



# Demands of a First-to-File System

- Coupled with 24/7 electronic filing, FTF systems creates a heightened rush to the patent office
- Pressure on in-house patent departments to timely harvest invention disclosures and make decisions directing filings
- Unknown initially whether you beat the competition to the patent office
- Tracking unfiled application requires robust processes



# Solutions to a First-to-File System

- Identification of client expectations regarding filing timeline
- Defined disclosure intake process and custom templates for docketing progress
- Reporting mechanism for unfiled cases so that cases facing filing delays can be reassigned as needed
- Identification of delays in application preparation and engaging client in discussions regarding progress or lack of progress
- Specialized personnel (meeting scheduler, docketing manager) to help facilitate disclosure meetings and draft preparation



# The Rise of Global IP Portfolios

- Inventor nationality/residence can impact filing decisions
- Location where the invention was conceived becomes more important
- Filing strategies could revolve around inventor nationality / location instead of product or manufacturing decisions
- Foreign filing license / foreign filing first create new issues regarding export control and timing of filings





# Handling Global IP Portfolios

- Process for identifying inventor nationality/location details early in the disclosure process (docket separately)
- Need access to details regarding first-to-file countries and filing requirements for specific technologies
- Maintain close relationships with foreign agents for queries/assistance with filing considerations
- Discuss filing strategies in view of foreign filing license/country law requirements early in the process



# Data security: Ongoing Challenge to Keep Pace with Innovation and a Globalized Environment

- Restricting access to data within your company / law firm
- NDAs in place with any third party vendors
- Use of third party applications (Box, DropBox, etc.) to share documents with clients and export control / data security considerations
- GDPR and inventor/client data privacy



# Managing Data Access & Security

- Systems with multiple access levels (matter-level, client-level, export restrictions)
- Identify all employees within your organization needing access and what level of access they should be given
- Engage third-party application providers in determining acceptable level of security/access
- Engage foreign agents to understand data security directives aimed at protecting inventor privacy



# Evolving Employee Agreements & Assignments

- Use of employee agreements as the basis for filing in the name of the company (substitute statement, etc.)
- What's in the employee agreement (present tense language, agreement to assign all rights, including right to claim priority)
- Non-employee inventors
- Multiple assignees (joint research projects, etc.)



# Streamlining assignments

- Define process for obtaining inventor signature and standardize steps necessary before proceeding without inventor signature
- Prioritize obtaining assignments on original applications and recording early
- Docket/track obtaining inventor signature and involve client legal departments/client contacts early for non-signing inventors
- Leverage document signing software (DocuSign, etc.) to make it easy for inventors to sign and to speed up return time



# Questions?



**Liz Fortier**

[efortier@luc.id](mailto:efortier@luc.id)



**Peter Rebuffoni**

[prebuffoni@slwip.com](mailto:prebuffoni@slwip.com)

