

The Docketing Excellence Webinar Series



Corporate IP Departments that Outsource Prosecution: Options and Best Practices for Docketing

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INSTITUTE
Building Extraordinary IP Assets

Docketing for Corporate IP Departments

- **Presenters and Panelists:**

- Ann McCrackin, President, Black Hills IP, LLC
- Tom Marlow, President, Black Hills Renewals, LLC, and former Chief Patent Counsel of Fairchild Semiconductor
- Jacie Sprtel, Analytics Manager, Black Hills IP, LLC, and former patent counsel for Thomson Reuters
- Julie Gillespie, International Docketing Specialist, Black Hills IP, LLC
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Topics

- Common IP Department Configurations
- Requirements for corporate IP docketing that are typically not required for law firms
- Additional Requirements for corporate IP departments
- Different Approaches to Patent Docketing
- Transitioning Between the Different Approaches

Typical Configurations for Corporate IP Departments

- “In-House” – Most, if not all, functions are handled by the internal IP department (e.g. invention disclosures, patent drafting/filing, and general IP management)
- “External Prep & Prosecution” – Certain operational functions (e.g. invention disclosures, asset management) are handled internally while the majority of the patent prep and prosecution process is handled externally
- “Hybrid” – Some drafting/prosecution as well as operational functions handled internally, some outsourced to providers

Traditional Patent Docketing Requirements

- PTO Due Date Docketing
- Docketing Workflow
- Prior Art Tracking

Typical Corporate Patent Data Requirements other than Prosecution Docketing

- Invention disclosure workflow and decision management
- Monitoring authorized applications to filing
- Annuity tracking, budgeting and forecasting
- Remote access for data update by outside providers
- Inventor Awards Tracking
- Portfolio Management-categorization and reporting

Different Approaches to Patent “Docketing”

- “Comprehensive” tracking of all events and all docketing, including internal work flow tasks
- “Basic” tracking of major status changes of files and related data
- “Hybrid” some combination of Comprehensive and Basic depending on the needs of the Corporation, including custom patent data requirements

Different Approaches-Comprehensive

- Comprehensive

- Entering all bibliographic information
- Docketing each document as an event
- Creating internal workflows and processes around the Corp needs
- Docketing system is central to overall IP management

- Pros and Cons

- Allows for in-house docketing
- All data captured
- Customize workflows and docketing events
- Expensive
- May require more resources

Different Approaches-Basic

- Basic

- *Bibliographic Data*

- *Title*
 - *Application Number*
 - *Filing Date*
 - *Grant Date/Publication Date*
 - *Patent Number/Publication Number*
 - *Priority Information*

- *Status*

- Pros and Cons

- Tracks only information that is useful for management of process
 - Major status changes of files and related data
 - More cost effective and easier to maintain total data integrity
 - May not include enough information during corporate growth to determine value of IP

Different Approaches-Hybrid

- Hybrid

- *Bibliographic Data*
- *Status*
- *Key Prosecution Events*
 - *Defined by how you are using the system*
 - *E.g. Office Actions, Notices of Allowance, Issue Notifications*
- *Basic or Internal Workflows*
- *Corporations are starting to use the docketing system as an essential tool*

- Pros and Cons

- Includes bibliographic and prosecution information that is useful for management of process
- Have more awareness/control over the events and data that are in your system
- Takes time to develop internal processes and tools to sustain a successful hybrid system
- May require a few resources

Transitioning Between Different Approaches

- **Why Would a Corporation Transition?**
 - *IP Growth*
 - *Resources Strain*
 - *Budgetary Trends*
 - *Marketing/Public Relations*
 - *Standardizing Processes*
- ***Tips for Transitioning from Basic***
 - *Have a plan for which areas in the IP process will be the most effected by the changes*
 - *Start by adding more data and a few key events and work up from there*
- ***Tips for Transitioning away from Comprehensive***
 - *Assess which areas are ripe for pruning and discuss all options on where it is best to divide resources*
 - *Make sure budget constraints are not the only factor in the determination. Transitioning to less information can leave the corporation with less knowledge to act on its IP*

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Panel Discussion and Questions

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Docket Cross-Off Vulnerabilities and Best Practices

November 16, 1 PM Central