



Digital Transformation of the Legal Industry Webinar Series

SLW Digital Transformation Case Study: Prosecution I

**Receiving and Reporting PTO Correspondence -
Docketing, Data/Document Storage, Work
Packets, Drafting and Filing Papers and
Responses; Reporting to Clients**

8-Episode Webinar Series

Episode 01 – What is Digital Transformation for Law Practices?

Thursday, February 11th, 2021, at 12:00 PM CT

Episode 02 – SLW Digital Transformation Case Study: Overview of SLW systems, tools, data lake, processes, teams and personnel.

Thursday, March 11th, 2021, at 12:00 PM CT

Episode 03 – SLW Digital Transformation Case Study: Application Preparation – Disclosure intake and docketing, application drafting tools, production management

Thursday, April 13th, 2021, at 12:00 PM CT

Episode 04 – SLW Digital Transformation Case Study: Prosecution I – Receiving & Reporting PTO Correspondence – docketing, data/document storage, work packets, drafting and filing papers and responses; reporting to clients

Thursday, May 13th, 2021, at 12:00 PM CT

Episode 05 – SLW Digital Transformation Case Study: Prosecution II – Claim tracking, reference analysis tools and reports, prosecution landscape tools and reports, examiner/prosecution analytics, IDS management

Thursday, June 10th, 2021, at 12:00 PM CT

Episode 06 – SLW Digital Transformation Case Study: Due Diligence, Freedom to Operate Studies, Landscape Studies, Portfolio Curation, Portfolio Analytics, Landscape Analytics, Examiner and Attorney Analytics

Thursday, July 8th, 2021, at 12:00 PM CT

Episode 07 -- SLW Digital Transformation Case Study: Billing, Invoicing, Client Budgeting and Cost Projection

Thursday, August 12th, 2021, at 12:00 PM CT

Episode 08 -- SLW Digital Transformation Case Study: Recruiting, on-Boarding, Training, Firm Communications

Thursday, September 9th, 2021, at 12:00 PM CT

Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

Type in the question box and we will answer in real time or during the Q&A.



Social

Follow us on LinkedIn or go to slwip.com to see upcoming and on demand webinars.

Today's Presenters...



Steve Lundberg

Principal & Chief
Innovation Officer
Schwegman
Lundberg &
Woessner



Pamela Huff

Trademark Principal
Schwegman Lundberg
& Woessner



Janal Kalis

Principal
Schwegman
Lundberg &
Woessner
FTO and Patent
Analytics Expert



Thomas Marlow

President, Renewals
Former Chief Patent
Counsel of Fairchild
Semiconductor
Black Hills IP



Ann McCrackin

President,
Black Hills IP



Edward Sandor

Principal
Schwegman
Lundberg &
Woessner



Processing Incoming Docket Items US Items Big Picture

- Automated Data Collection
 - Download from USPTO into IP tools
 - E-mails from Trademark Office
- Docketing automatically processed into docket system
- Items are reported to attorneys/paralegals
- Items are automatically reported to clients

Processing Filed Docket Items Big Picture

- Docketing automatically processed into docket system
- Items are reported to attorneys/paralegals
- Items are automatically reported to client
- Items filed in patent center
- PAIR copy of filed items downloaded
- PAIR copy sent to IP tools
- Filed items automatically processed into docket system
- Filed items are automatically reported to clients



- Some items cannot be automatically reported
- These are treated as exceptions and manually completed
- Items are still queued for reporting, but wait for additional documents to be attached



Automatic Processing of Items 1 (Black Hills IP)

- Any additional documents downloaded (e.g., Trademark documents)
- PDF's and metadata from USPTO are OCR'd
- PAIR xml is obtained
- Key information is extracted from image
- Documents are identified
- Context is analyzed
- Proper action for context is determined




Automatic Processing of Items 2

- Parameters needed for IP system are retrieved
- IP system state is determined
- Action and system state are compared
- Docket is updated automatically
- Docket data is downloaded
- Verification rule set is executed to verify correct action taken

Example of handling office nonfinal office actions



- Office Action automatically processed into docket system
 - Software Downloads document
 - Software Identifies the document and determines what to docket
 - Software Loads docketing data into Docketing System with an API connection
 - Software verifies the docketing
- All without a person logging in to PAIR or the docketing system!



Automatic Reporting

- Identified document and parts are sent to reporting system
- Reporting system determines reporting rules and templates for client
- Items are reported using template



Reporting Items Received to Attorneys / Paralegals

- Automated Message (24 hours after receipt):
“Final/Non-Final Office Action Received For
Matter # XXX.XXXXX”
 - i. “We received an Office Action for the below
mentioned matter(s). Please let me know if you
would like assistance in scheduling an examiner
interview.”
 - ii. Client, Matter, Serial No., Action, Due Date,
Working Attorney
- Tasks Added Message (daily)
 - i. TASKS DUE TODAY
“Matter – Action – Working Attorney –
Title – Client – Status “(same for below)
 - i. TASKS DUE TOMORROW
 - ii. TASKS ADDED TODAY
 - iii. TASKS DUE IN TWO WEEKS



Office Action Response Packages

After Receipt and Reporting to Client:

- Office Actions and prior art are loaded into ClaimTracker
- ClaimTracker tracks all rejections and claim amendments

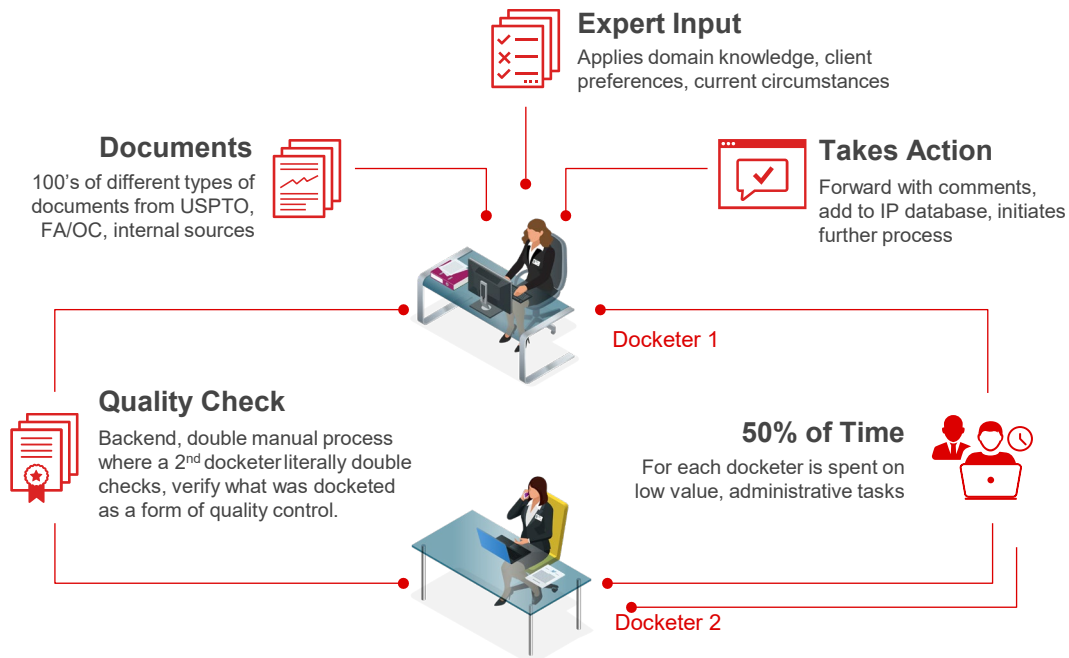
Response shell is merged from ClaimTracker with current set of claims and shell of rejection from USPTO



Response Package

ITEMS	INFORMATION
<ul style="list-style-type: none">• Common folder, cloud-based• Outlook Task with link to Common folder and separate items	<ul style="list-style-type: none">• Matter• Action• Due Date• Examiner• Previous Responses/RCEs
DOCUMENTS	ANALYTICS
<ul style="list-style-type: none">• Action• Response Shell• Prior Art• Previous Response• Application as filed• Analytics• ClaimTracker prosecution history	<ul style="list-style-type: none">• Claim History• Prosecution Analytics• Examiner/Art Unit stats• Next Action Prediction• Examiner Caseload• Pair History• Checklist items

Manual Docketing Approach



Automated Docketing Approach





Automatic Reporting in TM Context

- Encourages more immediate dialog with clients
- Results in more efficient and informed decisions
- Drives more competitive and predictable pricing

May 11, 2021

Results for

											CORRESPONDENCE CONTACT: PERSON NAME	ASSIGNED PERSONNEL: PERSON NAME
DUE DATE	DATE TYPE	FILE NUMBER	CLIENT REF NO	COUNTRY	APPLICATION NUMBER	ACTIVITY	ACTION	FILING DATE	STATUS	TITLE		
#####	Final Date	750.020US9		US		Meissner Bolte - PCT/EP2019/080516 - DUE 5/19/2021	US Filing Deadline		Unfiled	In-Coming Foreign Apps. Filed 1/1/2021-12/31/2021		Cheryl L Knapp
												Jonathan S. Ferguson
												Kasie A Grover
#####	Final Date	750.020US9		US		Meissner Bolte - PCT/EP2019/080568 - DUE 5/19/2021	US Filing Deadline		Unfiled	In-Coming Foreign Apps. Filed 1/1/2021-12/31/2021		Cheryl L Knapp
												Jonathan S. Ferguson
												Kasie A Grover
#####	Final Date	750.020US9		US		Meissner Bolte - PCT/EP2019/080597 - DUE 5/19/2021	US Filing Deadline		Unfiled	In-Coming Foreign Apps. Filed 1/1/2021-12/31/2021		Cheryl L Knapp
												Jonathan S. Ferguson
												Kasie A Grover
#####	Final Date	750.020US9		US		Meissner Bolte - PCT/EP2019/080610 - DUE 5/19/2021	US Filing Deadline		Unfiled	In-Coming Foreign Apps. Filed 1/1/2021-12/31/2021		Cheryl L Knapp

Downloaded from <http://ajph.org/> on November 10, 2015

705 Status Report

Status Report

May 11, 2021

Results for

File Number Starts with '750.'; Status With values 'Allowed;Issued;Pending;Registered;Unfiled'; Matter Type Category Description With values 'Copyright; Design Registration; Domain Name; Patent Application; State Trademark; Trademark; Trademark - Cancellation; Trademark -

SLW FILE NUMBER	CLIENT REF. NO.	MATTER TYPE	TITLE	COUNTRY	FILING DATE	LOCAL FILING DATE	APPLICATION NUMBER	STATUS	CUSTOM STATUS DESCRIPTION	PATENT NUMBER	GRANT DATE	PRIORITY DATE	PUBLICATION NUMBER	INVENTORS	WORKING ATTORNEY 1
750.001CA1		Trademark - ORG	PORTFOLIO	Canada			820,004	Registered							Steven W. Lundberg
750.002IN1		Trademark - ORG	SLWK	India				Unfiled							David D'Zurilla
750.002TN1		Trademark - ORG	SLWK: Tunisia Service Mark Registration	Tunisia	Nov 29, 1996		EE96.1553	Registered							Steven W. Lundberg
750.002US1		Trademark - ORG	SLWK	United States of America	May 30, 1996		75/111,783	Registered	Expired						David D'Zurilla
750.003CA1	750.003CA1	Trademark - ORG	PORTFOLIO	Canada	Aug 7, 1996		820,004	Registered							Steven W. Lundberg
750.016US1	750.016US1	Trademark - ORG	PATENT PROTECTION FOR HIGH TECHNOLOGY (tag line)	United States of America	Jun 27, 2003		78/268,083	Registered							David D'Zurilla
750.019US1		Utility - ORG	Daily Docket Reminder Emails Report (2019)	United States of America				Unfiled							
750.019US2		Utility - CON	Daily Docket Reminder Emails Report (2020)	United States of America				Unfiled							
750.019US21		Utility - CON	Daily Docket Reminder Emails Report (2021)	United States of America				Unfiled							
750.020US2		Utility - CON	In-Coming Foreign Apps. Filed 9/1/2014 - 12/31/2014	United States of America				Unfiled							
750.020US3		Utility - CON	In-Coming Foreign Apps. Filed 1/1/2015 - 12/31/2015	United States of America				Unfiled							
750.020US4		Utility - CON	In-Coming Foreign Apps. Filed 1/1/2016- 12/31/2016	United States of America				Unfiled							
750.020US5		Utility - CON	In-Coming Foreign Apps. Filed 1/1/2017- 12/31/2017	United States of America				Unfiled							
750.020US6		Utility - CON	In-Coming Foreign Apps. Filed 1/1/2018- 12/31/2018	United States of America				Unfiled							
750.020US7		Utility - CON	In-Coming Foreign Apps. Filed 1/1/2019- 12/31/2019	United States of America				Unfiled							
750.020US8		Utility - CON	In-Coming Foreign Apps. Filed 1/1/2020- 12/31/2020	United States of America				Unfiled							
750.020US9		Utility - CON	In-Coming Foreign Apps. Filed 1/1/2021- 12/31/2021	United States of America				Unfiled							
750.024US2	750.024US2	Utility - CON	PATENT CLAIM REFERENCE GENERATION	United States of America	Jun 8, 2015		14/733,387	Issued	Appeal Filed	10,902,042	Jan 26, 2021	Jun 7, 2006	US-2015-0278349-A1	Gary J. Speier	Joseph R Williams
750.029US1	750.029US1	Trademark - ORG	Para 4 Patents	United States of America				Unfiled							Steven W. Lundberg
750.041US1	750.041US1	Trademark - ORG	SLW Schwegman Lundberg Woessner Patent Protection For High Technology Design	United States of America	Sep 11, 2009		77/824,833	Registered	To Be Abandoned						David D'Zurilla
750.042US1	750.042US1	Trademark - ORG	SLW - SCHWEGMAN LUNDBERG WOESSNER PATENT PROTECTION FOR GREEN TECHNOLOGY - PROTECTION FOR GREEN TECH - SLWip.com - A Professional Association Design	United States of America	Sep 11, 2009		77/824,831	Registered	To Be Abandoned						David D'Zurilla
750.043US1	750.043US1	Trademark - ORG	SLW - SCHWEGMAN LUNDBERG WOESSNER PATENT PROTECTION FOR HIGH	United States of America	Sep 17, 2009		77/828,349	Registered	To Be Abandoned						David D'Zurilla



Thank you for your interest.

Questions?



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