

Efficiency and Transparency through Automation in IP Prosecution

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Do more with less.

We may be years past the economic downturn of 2008, but echoes of its effects on the legal industry are still being felt by law firms of all sizes. The “do more with less” constraints placed on internal legal departments intensified the leverage companies had when shopping for legal services. The transactional nature of IP prosecution made it possible for companies to shop around and reallocate IP portfolios across multiple firms seeking to maximize the return on their shrinking outside counsel budgets. A 2014 survey by Altman Weil of Chief Legal Officers indicated that 40% of respondents had already shifted work to an internal attorney and 36% had transferred work to lower priced firms.

In the years since the recession, many firms have seen an increased use of outside counsel guidelines by legal departments, more scrutiny of the law firm’s processes, and more stringent guidelines governing expectations like the speed and cost of reporting PTO correspondence and receipt of draft responses. Outside counsel guidelines are quickly becoming the new normal in the law department-law firm relationship. These governing documents, sometimes lengthy, outline the client’s expectation of continued high level service while also documenting the services they will no longer pay for, along with any cost consequences associated for failing to meet these standards. In order to meet client demands to balance quality and value, many of the most successful IP firms and departments have turned to technology to increase their efficiency, lower their cost of providing services, and increase transparency of operations.

Automation of an IP practice offers several benefits: reduced risk, enhanced client services, reduced expenses, client-facing transparency, improved collaboration between personnel in multi-office firms, and the ability to react quickly to changing client demands. There are several key areas of automation that IP firms can implement to gain efficiencies: document intake; electronic prosecution workflows; automated email reporting; self-maintaining client portals; client-based rule-sets to automate the creation and tracking of non-statutory deadlines mandated by outside counsel guidelines; and aggregating data in real time from existing firm systems into a single interface that gives practitioners access to key information, when they need it, while eliminating the “noise”.

The automation of document intake from official, federal systems of record can be accomplished using one of several available document download tools that identify and pull newly added correspondence from the electronic prosecution files accessible to registered IP practitioners. As those documents are downloaded, attributes related to those documents such as Patent Application Number, Trademark Serial Number, Document Type, and Document Name can be captured along with the related document. This information can be used to place the document in the firm’s document management system in the correct electronic matter file without having a staff member physically involved. This



simple automation can save hours of time daily and increase the efficiency and availability of the documents which you wish to share with clients. Many systems offer varying levels of auto-docketing functionality as well, based on the PTO metadata associated with the downloaded documents, freeing up docketing personnel to spend more time reviewing and focusing on the myriad of foreign deadlines.

As new prosecution documents arrive, reporting emails can also be automatically generated for legal assistants, paralegals, or attorneys to report newly received correspondence to the client. Some documents, like filing receipts, could be reported automatically without any intervention. Within minutes of a document's arrival at the firm it can be reported with little or no involvement or time spent by matter personnel to report the document. Reporting templates can be created at the client level and leverage all of the document metadata, application details, and even upcoming docket deadlines that already exists in firm systems. Similarly, self-maintaining client portals can leverage the same document in the electronic prosecution file, application details, and docket data to give clients real-time access to their prosecution portfolio.

Outside counsel guidelines frequently dictate the turnaround time for reporting actions and submitting draft responses and recommendations to legal departments. Tracking these non-statutory deadlines across all clients and firm attorneys can be a cumbersome and time consuming process. It can also be an expensive one when there are cost consequences to incorrectly following client guidelines. The ability to automatically create and monitor these client-enforced dates and automatically remind personnel of impending OCG-related deadlines frees up other personnel, such as docketing departments, to focus on higher risk functions like monitoring bar dates.

Transitioning to an electronic workflow and automating key aspects of the IP prosecution practice can greatly reduce risk for the firm. It eliminates bottlenecks, lost documents, and opens up multi-office firms to staff matters more easily with appropriate personnel regardless of office. A study by Gartner Research indicated that professionals spend 50% of their time searching for information and take 18 minutes, on average, to locate each document. As a firm's integration between systems becomes stronger, the ability to present data and documents in a concise format and targeted specifically for the consumer of the information, whether matter personnel or client-facing, provides enormous, controlled transparency and ease of access.

As a whole, much of the legal industry has been slow to adopt to a changing marketplace. Like any business, law firms need to closely examine their operational paradigm and regularly evaluate their strengths and weaknesses against their peers in the industry. It is no longer enough to be competent, successful prosecutors...firms must also be innovators and adopters of new technologies and processes in order to meet clients' demands, survive in a changing marketplace, and *do more with less*.

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