

Strategy for external patent attorneys serving internal IP-management and acting as IP- managers

Abstract

Currently, different sizes of enterprises have a need for proper counseling and representation by an external patent attorney. This is true not only for enterprises' administrative questions and processes in intellectual property IP (sometimes referred to also as industrial property, especially, when it comes to inventions (patents), trademarks, industrial designs, and geographic indications of source or the like), but also for practical and operational questions and processes in IP management. An attorney undertaking such a role as an IP manager, or as a partner for his clients' own IP grantmanagers, should have proper training in certain skills and needs.

Patent Attorneys may assume two functions that differ fundamentally from each other:

i) **IP-administration** is the core business of patent attorneys, as they understand the law, the technique and the processes concerning acquisition of IP rights, defense of IP rights, and operational issues such as the filing, grant, maintenance and restoration of IP-rights (e.g. paying of annuity fees etc.).

ii) **IP-management** comprises all the activities necessary to guide a company in the "mine field of IP". It is responsible for companies' IP policies, their IP strategies, the coordination of work related to IP within a company and the external interface with third parties.

IP managers' tasks are:

- Meet the challenges of high-level IP management
- Operate as IP professionals at a firm level, even when being an external patent attorney and as an independent expert
- Use empirical and scientific findings, but remain practically oriented as much as possible
- Place emphasis on the following topics: strategy, decision, implementation, organization and IP-business development
- Connect to an international network of IP-managing specialists while equally being organized and permanently trained within patent attorneys' organizations and skills.

Requirements and necessary skills for the external patent attorney who should also assume IP- management-responsibilities

a) Technical understanding

The external patent attorney is supposed to have a good actual education and understanding in the client's respective technical field. These skills also include the ability to listen well and to understand clients' inventions and technical explanations, as well as the ability to extract the important technical elements which play a role in the consequent protection or infringement proceedings.

b) General IP law and practice

The external patent attorney needs a thorough and comprehensive knowledge in the actual national, European, and international patent and trademark laws and in those other national IP laws which might be of particular interest for the client.

The most important law related skills are:

- Searching capabilities for updating-type prior art searches (e.g. Auto-alert searches = SDI-searches for systematic observation of global development in the art);
- Searching capabilities for conducting IP searches to provide prior art knowledge and to disclose patent-free areas;
- Searching and analyzing capabilities for conducting freedom-to-operate searches to avoid collision with existing IP rights and hence avoiding litigation;
- Analysis capabilities for patent documents to explain the scope of protection and potential threats for clients own products/processes;

- Drafting capabilities for broad IP applications that consider the needs and national specialties of different legal situations in different countries worldwide wherever the client is active.
- Negotiation capabilities for defending clients' applications before the respective examiner or examining authority;
- Defensive capabilities for clients' IP rights involved in opposition proceedings through all instances (also used to attack foreign IP-rights).
- Strong capability for defending or counseling defense of clients rights in national nullification proceedings.
- Capabilities for conducting the process of due diligence for the acquisition of foreign IP or foreign entities having IP, or for assisting in evaluation of the value of the clients' firm – as far as it is based on IP-rights, e.g. for mergers or for obtaining of bank loans etc.

c) Specific IP-law understanding for relevant geographical areas

The external patent attorney should have some specific understanding of the legal setup of particular national situations, where the client has its business interest. On the other hand, the external patent attorney should have a sound, experienced relationship with other external patent attorneys knowledgeable in the other national legislations of interest.

d) Licensing Practice

The external patent attorney should have sound training and expertise in all questions of national and international licensing, including some understanding of antitrust laws' regional or national provisions pertaining to license agreements.

e) Understanding of Management Tasks in R&D and Product Management

The external patent attorney should have a good understanding of the management tasks and mechanisms inside an enterprise, especially when it comes to questions of R&D (research & development) and product management.

f) IP Management

Having received such general and specific training in all kind of business management (CEIPI www.ceipi.edu) questions shall assist every patent attorney to better understand the business needs of the clients and shall enable the attorney to better tailor the IP activities for which the attorney is responsible.

Some considerations for the external patent attorney, when a new client approaches to ask for counseling

- Understand the client's objective problem
- differentiate between singular questions and requests for permanent assistance
- question the business value out of IP-rights. What is client's business model?

Some tools the external patent attorney employs in order to better connect to the business managers or similar clients' decision makers

- Personal discussions with clients' employees
- Power of Attorney
- Searching (or, generally, collecting Information)
- Valuation of IP-rights
- Presentations of facts and data in diagrams (visualization)
- Presentations of probabilities, e.g. decision trees (visualization)
- IP-meetings (between external patent attorney and the company's (top) management)
- Design organizational structures
- Suggestion-table for participation of patent attorney in the course of product/process development
- Training and education for client

Conclusion

External patent attorneys who adapt themselves to think like an internal IP manager and who have additional education in IP management are proper partners for small or medium sized enterprises, as well as for independent inventors. In this capacity, external patent attorneys need to understand fully the goals and business environment of their clients. They need to leave the purely academic, legal point of view behind. Behaving as proposed within this article allows full integration with the client and the formation of a similarity to an internal IP service department. Such a partnership and strong connection are necessary in order to best leverage the IP potential of an enterprise.

