

Paperless IP – How IP Practices Benefit From Leveraging Web-based Extranets

BY CHRISTY BURKE

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Intellectual property has traditionally been about advancement and the elite lawyers practicing in the field are always one step ahead. Glen E. Schumann, an IP attorney with Minnesota, MN-based Moss & Barnett, is planning to transform his practice with that concept in mind. The practical patent and trademark lawyer is attempting to introduce an extranet to his colleagues to better serve his clients and, in the process, he will propel the management of IP transactions at the firm forward.

Clients appreciate the technology and Schumann recognizes the advantages of allowing his them to see real-time progress on certain projects. Providing immediate 24/7 access to an entire file is client service at its finest. An extranet that offers a secure web-based forum for authorized users to access documents and other information at any time is exactly what Schumann requires. In addition, “physical space is an issue, so electronic storage would be helpful,” he says. Ultimately, Moss & Barnett selected AMS-Legal’s Collaborator extranet product to meet these challenges head-on.

Professor Justin Hughes, Director of the Intellectual Property Law Program at the Benjamin N. Cardozo School of Law in New York City, highlights that IP groups are particularly suited for extranet usage. In a patent prosecution, for example, there are many levels of input required from the client - the inventors, the technology transfer personnel, the marketing staff – and online collaboration allows them to engage more easily. “The extranet phenomenon is useful where the interface between the client and the law firm is broader or more variable,” he says.

That variability is what is also motivating Schumann to harness his team’s research into a searchable extranet. For example, in connection with patent filings, his clients uncover prior art or non-patent literature (both of which provide evidence of an existing idea in the marketplace). “It is a mini-library that is very useful for a particular technology,” he says. That searchable archive concept can be adapted to the actual issued patents and trademarks, as well as deposited patentability opinions, invalidity opinions and non-infringement opinions.

Modernization is driving this trend as well. “Since so much filing and other information is publicly available on the U.S. Patent & Trademark Office’s website, it just makes sense that a client’s related legal documents are available for review at its law firm’s website,” comments legal technology expert Dennis Kennedy. Clients also tend to be more receptive to novel ways of accessing their information. “In an intellectual property practice, you are likely to find technologically savvy clients who are comfortable using the Internet,” Kennedy adds.

Savvy appropriately describes Christopher J. Reckamp, an IP principal with Vedder Price in Chicago, who has also implemented the Collaborator extranet for the benefit of a number of clients. Prior to going digital, he and his team manually reported developments to clients and e-mailed scanned documents. The volume of work was substantial and Reckamp wanted to offer his clients more cost-effective representation. A single project assistant now manages all correspondence and documentation, which can easily be accessed via the extranet following e-mail notifications and reminders. “This is especially useful for clients that have multiple offices across the US and Canada,” says Reckamp. “They can also use it for accessing large files, which would not be practical or possible to send via e-mail due to client/firm firewall issues,” he adds.

Clients benefit tremendously. They appreciate the accessibility and are impressed with the ease of use and notification features. Secretaries have more time to do administrative work and assist the attorneys since the project assistants now scan and enter data into the extranet.

Perhaps more important than management of the work is the fact that the extranet improves client relationships because they are paying less and getting information on a timely basis in multiple offices at the same time. “Every client that has been involved on an extranet site has loved it,” says Noam Raz, a partner with Southfield, MI-based Jaffe, Raitt, Heuer & Weiss, P.C. “They like being able to follow the pace and development of the transaction on their own. Our clients are much happier because they feel much more involved and more empowered,” he adds.

In addition to the day-to-day IP application processes, extranets are an essential tool for litigation as well. Schumann and his team collect specimens for their clients. In protecting a client’s service mark, lawyers must produce specimens of use, which are advertising items such as brochures, flyers, billboards or internet usage. If that trademark is used on a product, the holder of the mark must provide packaging. Schumann scans photos of these specimens and electronically stores them internally, but to date had not collected them in a centralized external location. That could all change shortly and when it does, his data will be searchable for use when confronting future infringers. “By having a searchable database, we will have all of the specimens that are helpful and relevant for a dispute,” he says. “To me it is a classic example of how one would use an extranet,” notes Kennedy.

In-house attorneys greatly benefit from the user-friendly nature of the tool. That user-friendly nature is particularly useful in docket control, which is unique to the field of intellectual property. Most lawyers have a separate system for patent and trademark deadlines, but that system is not always accessible to a client. When a client looks at a particular patent or trademark, its management wants to know the next maintenance date. This is especially important for owners of a large IP portfolio. “You have to calendar all of these things and sometimes a client would like to check on


it,” says Schumann, but with an extranet the client will have immediate access to this data. “It is really a self-service concept,” Kennedy adds.

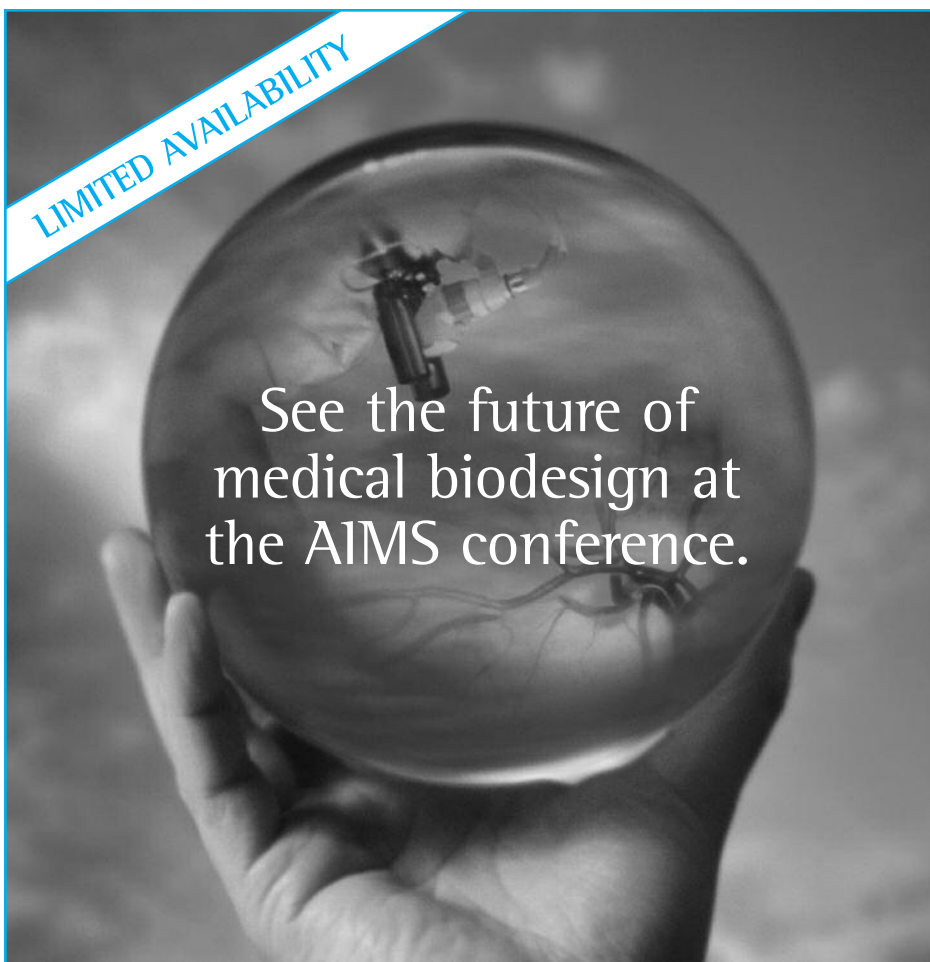
That concept describes one of Schumann’s clients. It has a large number of form contracts that it modifies and uses in deals with certain vendors in order to protect its intellectual property and preserve confidentiality. The extranet will enable Schumann and his team to maintain an archive of all of the client’s contracts and update the forms as necessary, with access by the client granted immediately upon completion of the any modifications.

From the IT perspective, Maureen Durack, Vedder’s Director of Management Information Systems, says that by using an extranet, “the client gets a better bang for the buck.” The firm’s extranet, referred to as Client Connect at the 220 attorney firm with over five hundred users, is one of her most popular products within the firm because attorneys “appreciate it” right away. “The extranet is easy to explain to attorneys and they can demo the system to their clients easily,” she notes.

The online tool also gives the firm the ability to showcase a paralegal’s or assistant’s skills, which are critically important in IP transactions, but have historically been “behind the scenes,” Durack says. “Now, clients can see the performance of paralegals and assistants, and can see their organizational skills in action,” she highlights. “It is our most effective client-facing technology.”

Vedder Price provides WebEx training on Client Connect and has three trainers who teach the attorneys and clients. They also train clients on that client’s own custom-built extranet system; the clients appreciate the attention.

Ultimately, the drive to modernize is client-focused. Kennedy highlights “once clients routinely use the Internet for monitoring and searching for information about patents and trademarks, they ask themselves “why can’t I check my other legal files on that same trip out to the Internet? Meeting that client expectation is why extranets are especially interesting for IP firms,” he concludes. Schumann would certainly agree. 



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