

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

### Abstract

Currently, different sizes of enterprises need proper counseling and representation by external patent attorney. This is true not only for enterprises' administrative questions and processes in intellectual property IP (industrial property, especially 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 managers, should have proper training in certain skills and functions.

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 techniques and the processes concerning acquisition of IP rights, defense of IP rights, and operational issues such as maintenance and restoration of IP-rights.
- ii) **IP-management** comprises all the activities necessary to lead and guide a company. 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 independent expert;
- Use empirical and scientific findings, but remain as much as possible practically oriented;
- Place emphasis on the following topics: strategy, decision, implementation, organization and IP-business development;
- Connect to an international network of IP-managing specialists while remaining organized and permanently trained within patent attorneys' professional organizations.

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

#### **a) Technical understanding**

The external patent attorney must have a good relevant education and understanding in the client's respective technical field. The attorney's skills must 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 consequent protection or infringement proceedings.

#### **b) General IP law and practice**

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

The most important law related skills are:

- Research capabilities for updating-type prior art searches (e.g., Auto-alert searches = SDI-searches for systematic observation of global development in the art);
- Research capabilities for conducting IP searches to provide prior art knowledge and to disclose patent-free areas;
- Research capabilities for conducting freedom-to-operate searches to avoid collision with existing IP rights and consequent 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 where the client is active;
- Negotiation capabilities for defending clients' applications before the respective 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 clients' businesses, insofar 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. Simultaneously, 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 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**

Receiving such general and specific training in all kind of business management questions (for example via CEIPI [www.ceipi.edu](http://www.ceipi.edu) ) assists patent attorneys to better understand the business needs of clients and enables attorneys to better tailor the IP activities for which they are 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;
- Seek to extract the business value out of IP-rights.

**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 and possibilities, e.g. decision trees (visualization);
- IP-meetings (between external patent attorney and the company's top management);
- Design organizational structures;
- Suggestion tables 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 environment of their clients and 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 similitude to an internal IP service department. Such a partnership and strong connection are necessary in order to optimally leverage the IP potential of an enterprise.