

ACPC 2022
Winter Meeting

January 23 – 26, 2022



Tools and Services for your IP Practice

Tuesday, January 25

Agenda

1. Introduction
2. What kinds of tools and services are out there?
3. How to find tools and services
4. Decision framework
5. Trends to look out for
6. Survey results

1. Introduction

Are we talking about Legal Ops?

“Legal operations” (or legal ops) describes **a set of business processes, activities, and the professionals** who enable legal departments to serve their clients more effectively by applying business and technical practices to the delivery of legal services. Legal ops provides the strategic planning, financial management, project management, and technology expertise that **enables legal professionals to focus on providing legal advice.**

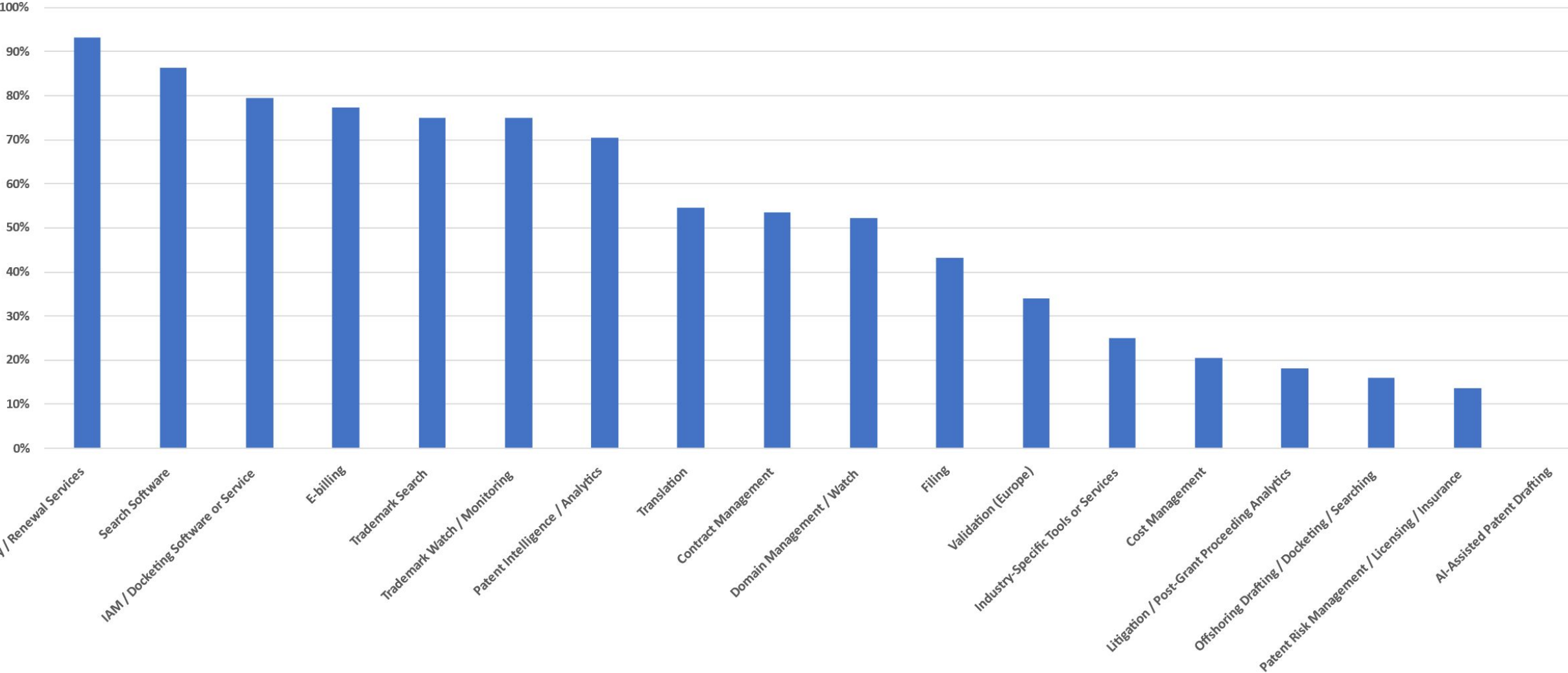
Corporate Legal Operations Consortium (CLOC)

The IP World was First in Legal Ops

- Thousands of new matters a year
- Matters stay open for as many as 20 years
- The first IP Legal Ops companies formed in the late 60s or early 70s
- Some of the early companies are now worth billions and held by private equity (we'll come back to this)

2. What kinds of tools and services are out there?

Currently Using



3. How to find tools and services

Never around when you need it?

- Referrals
- Conferences
- Internet searches
- They approach you (cold emails/calls)

4. Decision Framework

Insource vs. Outsource vs. Automate

- Insource

- Is it important to know field of technology?
- Is it important to know contractual arrangements around portfolio?
- Does bringing in-house increase consistency or reduce cost?

Insource vs. Outsource vs. Automate

- Outsource

- Can it be assigned to outside counsel in discrete packets?
- Can it be done by non-attorney under attorney guidance?
- Are they admin/paralegal skills that can be outsourced to non-attorneys?
- Does the overhead of insourcing outweigh cost of outsourcing?

- Is offshoring an option? -- labor-intensive tasks, but consider training investment, language/time zone barriers, export laws, and foreign filing license rules

Insource vs. Outsource vs. Automate

- Automate

- Does the task benefit from the advantages provided by a software system (data retention, organization, repeatability, efficiency, etc.)?
- Beware creating data silos (e.g., docketing system doesn't talk to e-billing)

Picking the right Tool/Service

- Who is currently providing this service to me and at what cost?
- Is the service digitized or is it a manual process? Depending on the answer, a specialist service company may be a better choice than a law firm.
- Does the company offer an API, data downloads, or data packets?
- Do you own your data? Will they provide it to you on termination?
- Talk to client references with similar sized portfolios.

Picking the right Tool/Service

- Listen to attorneys, but consider if they have a conflict of interest
- Are IP attorneys/administrators responsible for the product's: Design / Sales / Maintenance / Support
- Does the offeror really understand IP, or are they just applying general purpose algorithms to IP data?
- Are servers backed up and capable of replication instantly?
- Do they offer a service to operate their software for you?
- Is there a marketplace that rates products or a website that evaluates the competition?

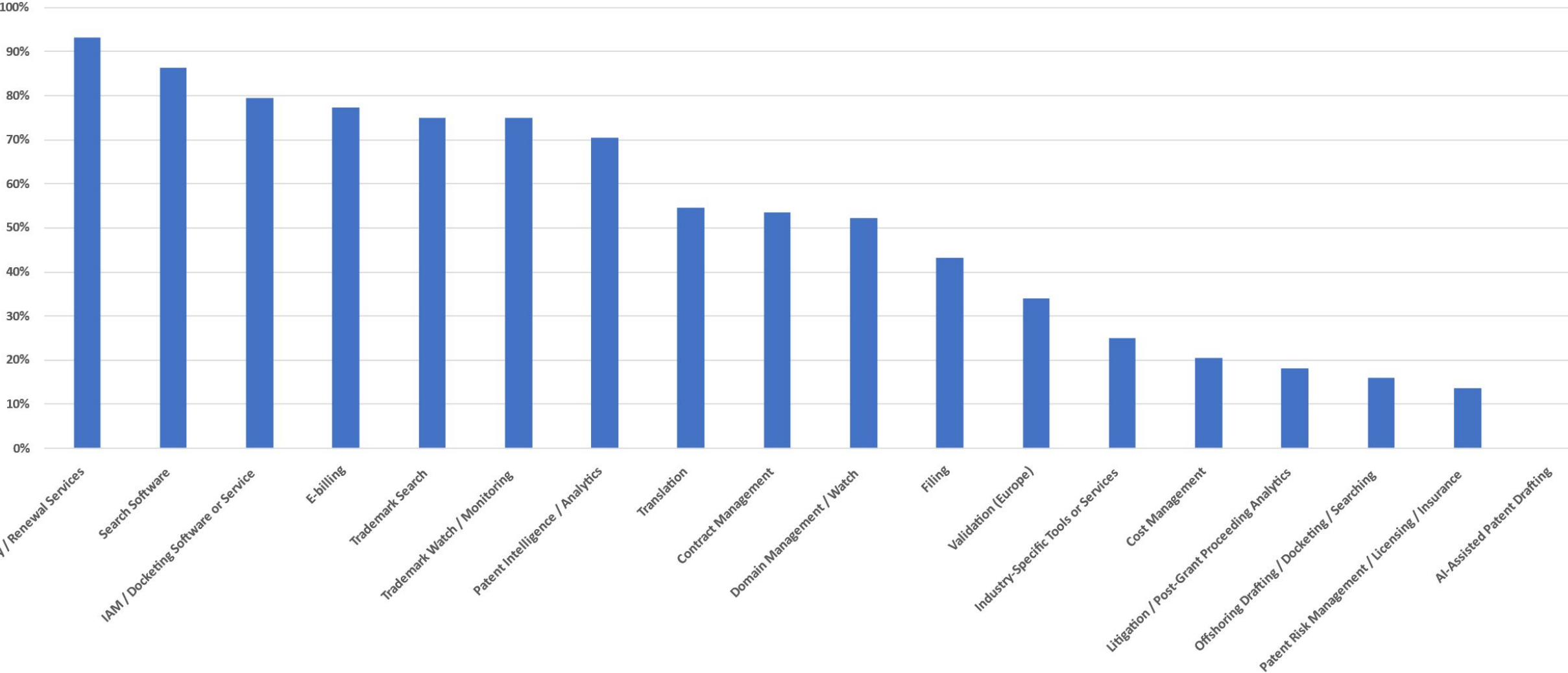
5. Trends to look out for

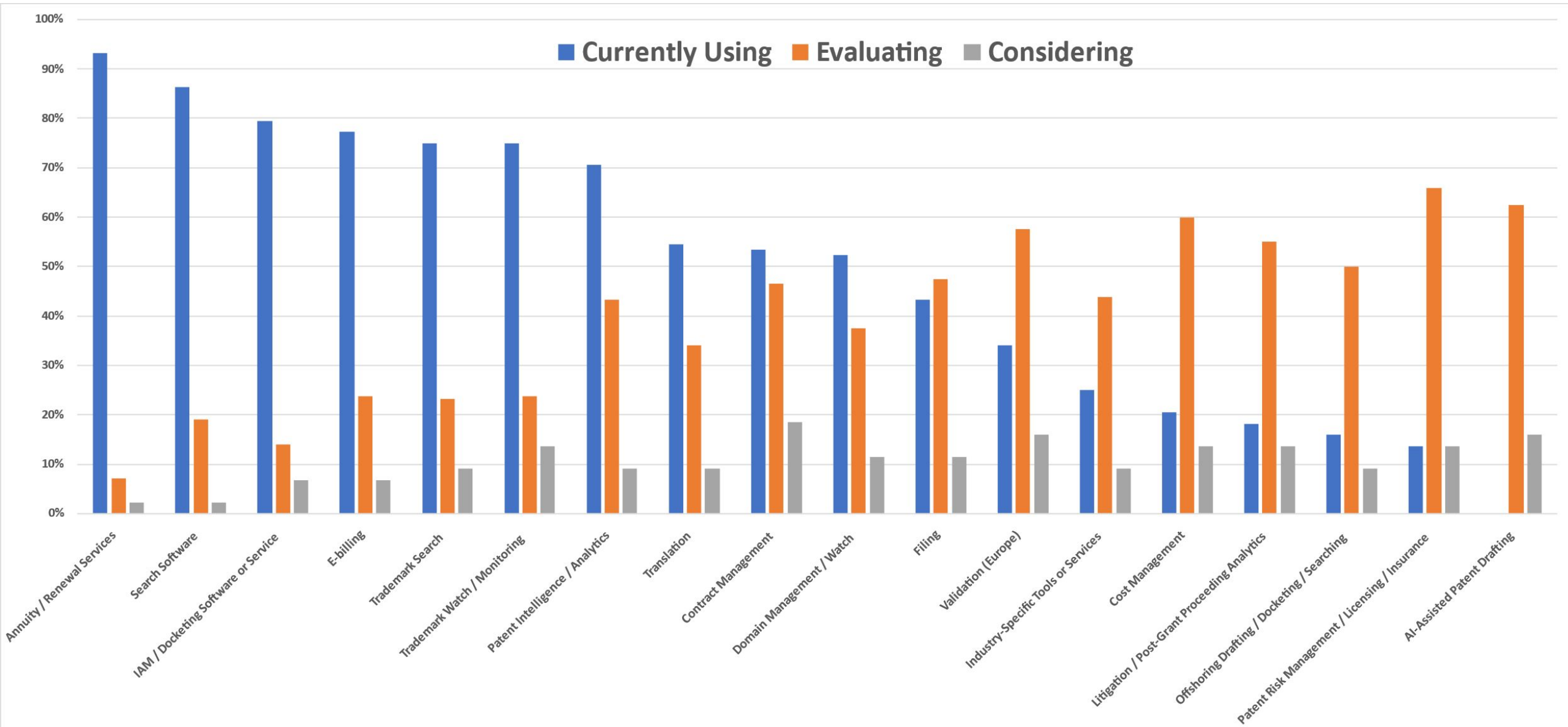
The changing landscape

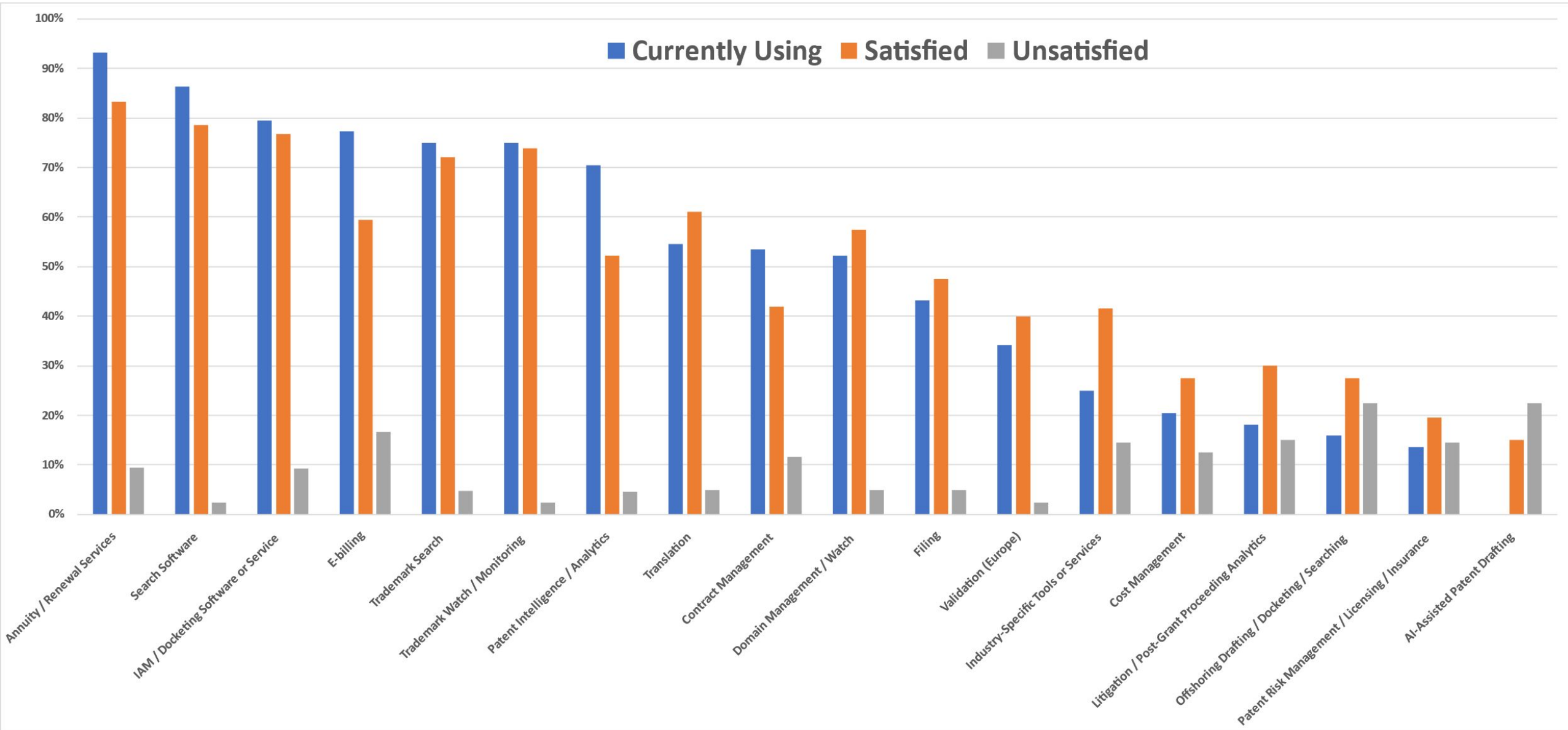
- IP services has become big business, with multi-billion dollar players
- Most offerings operate on a SaaS model with annual subscription contracts
- Strong consolidation trend in the past few years – many smaller vendors have been acquired
- Impact of increase in work-from-home and hybrid teams due after COVID
- General and non-IP offerings are trying to add IP intelligence to their platforms
 - Could this be a problem for Chief IP/Patent Counsel?

6. Survey Results

Currently Using







	Currently Using	Considering Using	Stopped Using	Have not Used	Satisfied	Evaluating	Unsatisfied
Search Software	86%	2%	0%	11%	79%	19%	2%
IAM / Docketing Software or Service	80%	7%	2%	11%	77%	14%	9%
Annuity / Renewal Services	93%	2%	0%	5%	83%	7%	10%
E-Billing	77%	7%	0%	16%	60%	24%	17%
Cost Management	20%	14%	0%	66%	28%	60%	13%
Validation (Europe)	34%	16%	0%	50%	40%	58%	3%
Filing	43%	11%	0%	45%	48%	48%	5%
Translation	55%	9%	0%	36%	61%	34%	5%
Patent Intelligence / Analytics	70%	9%	0%	20%	52%	43%	5%
Contract Management	53%	19%	0%	28%	42%	47%	12%
Patent Risk Management/ Licensing / Insurance	14%	14%	0%	73%	20%	66%	15%
Litigation / Post-Grant Proceeding Analytics	18%	14%	2%	66%	30%	55%	15%
Offshoring Drafting / Docketing / Searching	16%	9%	2%	73%	28%	50%	23%
AI-Assisted Patent Drafting	0%	16%	0%	84%	15%	63%	23%
Trademark Search	75%	9%	2%	14%	72%	23%	5%
Trademark Watch / Monitoring	75%	14%	0%	11%	74%	24%	2%
Domain Management / Watch	52%	11%	2%	34%	58%	38%	5%
Industry-Specific Tools or Services	25%	9%	0%	66%	41%	44%	15%

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Annuity / Renewal Services	93%	2%	0%	5%	83%	7%	10%
E-Billing	77%	7%	0%	16%	60%	24%	17%
Cost Management	20%	14%	0%	66%	28%	60%	13%
Validation (Europe)	34%	16%	0%	50%	40%	58%	3%
Filing	43%	11%	0%	45%	48%	48%	5%
Translation	55%	9%	0%	36%	61%	34%	5%
Patent Intelligence / Analytics	70%	9%	0%	20%	52%	43%	5%
Contract Management	53%	19%	0%	28%	42%	47%	12%
Patent Risk Management/ Licensing / Insurance	14%	14%	0%	73%	20%	66%	15%
Litigation / Post-Grant Proceeding Analytics	18%	14%	2%	66%	30%	55%	15%
Offshoring Drafting / Docketing / Searching	16%	9%	2%	73%	28%	50%	23%
AI-Assisted Patent Drafting	0%	16%	0%	84%	15%	63%	23%
Trademark Search	75%	9%	2%	14%	72%	23%	5%
Trademark Watch / Monitoring	75%	14%	0%	11%	74%	24%	2%
Domain Management / Watch	52%	11%	2%	34%	58%	38%	5%
Industry-Specific Tools or Services	25%	9%	0%	66%	41%	44%	15%

Thank You!



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