

## IPO Corporate IP Management Practices Project

### Software – Summary

What software solutions are used related to IP and which business processes are tracked?

#### Software Solutions

The sophistication of the software tools used by an entity varied, but all entities used some software tool beyond relying upon e-mail. Entities that use different software tools use them for different purposes, rather than a backup tool for redundancy. The software tools are local for some entities, but others authorized cloud based solutions as well if they offered a cheaper and better way to interface with outside counsel. Where possible, entities looked for synergy between a software tool and a pre-existing tool used for other purposes (e.g., a software tool that harmonizes with e-mail). Some entities rely on a third party for at least some of the management, and some entities used “home-grown” solutions or highly customizable solutions.

Overall, solutions from Thompson were used the most, as Thompson appears to provide the largest range of solutions. LexisNexis followed next with solutions for searching and proofing functionalities.

#### Searching and Monitoring

Most all of the interviewed entities used some software tool for searching of prior art, but also for monitoring competitor portfolios. The tools tended to be subscription based. Attorneys at many entities perform searches in-house rather than outsourcing searches.

#### Pre-Filing

Entities seemed to prefer using pre-filing tools that provide a variety of services. For example, some pre-filing tools that provide a repository for invention disclosure also provide interfaces to indicate internal decisions and mechanisms to incorporate data into a docketing system. Some, however, relied on e-mail as sufficient way to manage invention disclosures.

#### Post-Filing

An entity selected software tools to manage post-filing dates based on personal preferences rather than some common principle. Some entities preferred a more hands-off approach and used tools accordingly. Other entities relied on customizable tools for their particular needs.

#### Post-Issuance

Entities did not provide any particular guidance on post-issuance software tools other than that entities use them for payment purposes.

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### Software – Detailed Key Takeaways

- 1) Fortune 500 Energy Company
  - a. What software solutions do you employ related to IP and which business processes are tracked by these tools (invention disclosure, patent prosecution, docketing, maintenance fee payments, licensing, litigation, etc.)?
    - i. LexisNexis for searches and other uses
    - ii. Thomson IP Manager for management (invention disclosures, docketing, prosecution, trademarks, contracts)
- 2) Fortune 500 Chemical Company
  - a. What software solutions do you employ related to IP and which business processes are tracked by these tools (invention disclosure, patent prosecution, docketing, maintenance fee payments, licensing, litigation, etc.)?
    - i. Lecorpio – Modules for invention submissions (review and decision-making process), which is incorporated into docketing system after filing
      1. IDF / Invention report system provides input into docketing system
    - ii. NDA system to track NDAs with matter management
    - iii. Both systems tie into email for docketing items, due dates, etc.
    - iv. Lecorpio module for billing (invoice receipt, attorney authorization, email to billing manager, etc.)
- 3) Global Chemicals and Materials Company
  - a. What software solutions do you employ related to IP and which business processes are tracked by these tools (invention disclosure, patent prosecution, docketing, maintenance fee payments, licensing, litigation, etc.)?
    - i. For patent searching and monitoring of competitors, they use Total Patents.
      1. Patent dept. has subscription; a few people in the business have a subscription as well. The IP guardians do not have subscriptions (IP guardian is an added role)
    - ii. IP Folio
      1. Not a docketing system
        - a. This is a great system if you don't need docketing
      2. All patents are managed externally
      3. Murgitroyd & Company (UK company)
        - a. All cases managed by Murgitroyd
        - b. They manage foreign filing aspect
      4. US firms draft cases
      5. At PCT stage, Murgitroyd does the filings
      6. Managing IP counsel interfaces with US firms and Murgitroyd
        - a. The firms copy each other
        - b. However, Murgitroyd handles all other cases
          - i. So, Chinese firm interfaces with Murgitroyd, and Murgitroyd reports to IP counsel
      7. Top Feature
        - a. Instantaneous analytics
          - i. Main dashboard

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- ii. Dashboard for each business sector
        - 1. # of patents in each country
        - 2. How many filing decisions are open
        - 3. # invention records being drafted
        - 4. Who owns what, and what %
        - 5. Expiration by year for portfolio
      - 8. Web-based system
      - 9. They helped her set everything up
    - iii. Drafting
      - 1. They actively participate in the drafting process
      - 2. Go through invention disclosure with counsel
      - 3. Review drafts
      - 4. But, not overly involved
    - iv. Anything Notable
      - 1. B/c they are small, they have the ability to be flexible and make changes whenever they want. This is an advantage.
      - 2. IP risk management council
- 4) World-Wide Fortune 100 Industrial Company
  - a. What software solutions do you employ related to IP and which business processes are tracked by these tools (invention disclosure, patent prosecution, docketing, maintenance fee payments, licensing, litigation, etc.)?
    - i. Memotech for docketing, agreements, etc.
    - ii. LPO vendor – CPA – for annuities
    - iii. Thomson for searches
      - 1. They don't let their attorneys go to outside vendors for searches. Sometimes the Knowledge Center (BU search group) will outsource
- 5) Water and Wastewater Treatment Products/Systems Company
  - a. The Company utilizes a cloud-based version of Thomson IP Manager as its central docketing system for all business units world-wide.
  - b. The Company has a subscription to LexisNexis and its various patent tools including TotalPatent and PatentOptimizer to facilitate searching for prior art and researching IP issues
- 6) World-Wide Fortune 100 Industrial Company
  - a. What software solutions do you employ related to IP and which business processes are tracked by these tools (invention disclosure, patent prosecution, docketing, maintenance fee payments, licensing, litigation, etc.)?
    - i. Primary software—"IP Manager" and use "E-Counsel" (matter management); also use "Worksite" a document management system
    - ii. IP manager
      - 1. Separate website for WW submission of invention notifications—automatically populated with new matters—
      - 2. Docketing system—Affiliated with Master Data
      - 3. Maintenance fee payments
      - 4. Litigation—don't officially track litigation
        - a. Litigation tracked by litigation services

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- iii. Thompson Innovation
    - 1. Categorize COMPANY patents and competitors' patents
    - 2. Look at competitors' portfolios
  - iv. LexisNexis PatentOptimizer software—mandated for all applications—checks applications for:
    - 1. Common errors
    - 2. Patent “profanity”
    - 3. Correct reference numbers
    - 4. A lot of small errors that can cause problems
  - v. PatentOptimizer (this is not patent optimizer software – it is other other software but I can not remember its name) also provides:
    - 1. Data on patent examiners
    - 2. Success by classifications
    - 3. Information by examiner
    - 4. Appeal winning percentages
    - 5. Goal is to use it as part of the patent prosecution strategy
  - vi. IP legal pays the initial purchase cost and maintenance fees are also paid by IP legal(maintenance is paid by Legal IT group)
- 7) Large Company in the Automotive Industry that is a Wholly Owned Subsidiary of an International Parent Company
- a. What software solutions do you employ related to IP and which business processes are tracked by these tools (invention disclosure, patent prosecution, docketing, maintenance fee payments, licensing, litigation, etc.)?
    - i. An internal docketing software solution through Thomson (IP Master) is used for patent and trademark matters. Mostly managed by IP paralegals. Outside counsel handle external docketing of patents through their own solutions. Trademark matters are all typically handled in-house so all information should be in the docketing software. Trademark disputes are not tracked with the software. There is an internally developed electronic work flow, filing, and billing system.
    - ii. Maintenance fees are also handled through the use of Thomson's IP Master software.
    - iii. Invention disclosures are not managed via a software solution, the company uses an email system for scanned disclosures that are then stored electronically and alternatively hard copies of the disclosures.
- 8) Subsidiary of a Multi-National Industrial Conglomerate
- a. The Company has a subscription to TotalPatent and Innography for patent/prior art searching.
  - b. The Company is implementing CPA Memotech across most subsidiaries so that all businesses are on the same docketing system. This software has an invention submission module and module for patenting committee reviews. (One subsidiary uses a different system for trademarks; several are currently in the process of converting to Memotech.)
- 9) International Transaction Processing and Payment-Related Products and Services Company

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- a. The Company is implementing new software to facilitate communication between the IP legal team, the business units, and patent review committees for the assessment of new invention disclosures. The new software was purchased “off the shelf” but requires significant customization. The software will keep track of IP-related data.
  - b. The Company uses Thomson Innovation and Innography.
- 10) Fortune 500 Semiconductor Company
- a. What software solutions do you employ related to IP and which business processes are tracked by these tools (invention disclosure, patent prosecution, docketing, maintenance fee payments, licensing, litigation, etc.)?
    - i. Foundation IP is used for annuities and invention disclosure management.
    - ii. Home grown system is used for invention disclosures which populates Foundation IP.
    - iii. Case Track and Data Cert are also used.
- 11) Fortune 500 Energy Company
- a. IP assets generally obtained for freedom-to-operate and defensive purposes
  - b. For most units, licensing IP assets is a secondary factor but not a significant motivation. Some units have IP licensing as a core element of their business.
  - c. IP assets can be potentially useful in vendor or other business relationships to facilitate deals between organizations
  - d. IP strategy is more likely aligned with business strategy because IP management team works within business unit – also, business unit ultimately makes business decision regarding IP based on business strategy
  - e. AIA has not affected IP strategy; Alice decision is of some concern, but no significant affect to current IP strategy
- 12) Communications Equipment Company
- a. Switched from Anaqua to IP manager
    - i. Switched due to customization issues and difficulties in searching for items
    - ii. Employ an internal tool that allows attorneys to window into IP manager
- 13) High Tech Company
- a. No answer.
- 14) World-Wide Fortune 500 Drug Company
- a. They use CPI for keeping an internal shadow docket but it’s a “light” docket. More for keeping track of assets than for monitoring due dates.
    - i. CPI also pays the annuities
  - b. They do not do any patent prep or pros themselves. Exclusively OC
    - i. They have a single US OC coordinating prosecution for families
    - ii. But, they do have a EP agent for validations
    - iii. Also, thinking about using an agent for non-US filings
    - iv. Park IP for translations. Now using them for EP validations
  - c. Legal dept as a whole uses datacert for e-billing
    - i. Datacert coordinates with CPI and this is important – matters opened in CPI migrate to Datacert
  - d. Legal dept. uses I-Manage for document management
    - i. They use this for IP document management

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- e. Searching tools for internal prior art searches
    - i. There are some very specific tools for chemistry, biology. He doesn't know the names
  - f. They have subscription to Thomson
- 15) Aerospace and Defense Company
- a. Company uses CPI for docket and document management.
- 16) International Industrial Conglomerate
- a. Company uses own proprietary application for docket and document management. Europe and the US use the system differently, e.g. US uses the system to manage the file wrapper only whereas Europe will include additional information and documentation.
- 17) Multinational Manufacturing Company
- a. No answer.
- 18) Large IT services company
- a. The Company employs CPI for docketing. It is hosted externally (Cloud-based). The Company is considering going to an alternative. The company is interested in developing better analytics and metrics.
  - b. The Company allowed maintenance in a Cloud environment mainly because of outside counsel usage was in the Cloud already, and it was outside counsels' preferred way and the cheapest way.
  - c. The preference now is for the Company to have a better corporate control. And, the Company is weighing how to best control IT headcount.
  - d. The Company does not formally track trade secrets in a software system. If the Company determines it should be a secret after reviewing the invention disclosure, they will keep it as a trade secret. In most cases, we probably would file a patent application, particularly if it's going in a product.
  - e. As far trademarks, the Company has robust system. The system is capable of managing the Company's worldwide trademark filings (which is different from the patenting process which primarily US oriented).
- 19) Large Internet Software and Services Company
- a. The Company has many software tools and systems available to it and is willing to at least try most new tools that are developed and sold commercially. The Company is also willing to develop in-house tools and systems to facilitate effective IP management.
  - b. As examples, the Company uses Reed Tech Patent Advisor, Juristat, PAIR, Thomson Innovation, Innography, and others
  - c. Certain software tools allow the Company to efficiently analyze its own portfolio, competitor portfolios, and portfolios it may acquire or license. The Company receives over 1,000 solicitations per year to acquire portfolios and these tools help make decisions related to these opportunities.
- 20) Healthcare Equipment Company
- a. Company moved to Thomson IP Manager in 2014. This technology has been well received and will bring consistency to the organization.
  - b. Company uses "First to File" document management system from Hummingbird as of mid-2015. This system provides a virtual tri-fold patent prosecution folder. This is consistent across the globe and has streamlined processes.

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- i. Outside counsel does not have access to this system.
- ii. The IP group aspires to be “all electronic, all of the time”. It is moving away from physical files and will be a “paperless office” soon.

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