

Los Angeles Intellectual Property Law Association
Washington in the West

Selecting Outside Prosecution Counsel

Speakers

- Oral Caglar, Associate General Counsel, California Institute of Technology
- Agnes Juang, Partner, Knobbe Martens
- Keith Newburry, VP, Chief Intellectual Property Counsel, Edwards Lifesciences

Goals

The panel will be providing an interactive discussion about the types of considerations and the process for selecting outside prosecution counsel based on the different sizes and nature of the client.

Factors Considered By Large Corporations

- Quality
- Attorney locations
- Client need for small number of outside firms
- Work Volume
- Effective manager inside of law firm
- Timeliness for completion of work
- Cost - Low or high overhead firms – when to use which
- Proactivity in inventor communications
- eBilling compatibility

Factors Considered By Universities

- Cost, both from fee structure and efforts appropriate to each patent
- Technical expertise in what are often exotic, incipient fields
- Relationship with key faculty inventors
- Ability to take on all or part of file management duties
- Ability to be a strategic partner in a holistic approach to portfolio filing and management
- Physical proximity to encourage face-to-face meetings
- Understand value of each patent (key technology v. “courtesy filing”) with appropriate effort/billing for each

Factors Considered By Small Businesses

- Quality
- Attorney location
- Cost
- Responsiveness
- Understanding of business objectives
- Ability to make recommendations in view of the business goal – acting as in-house IP counsel
- Ability to provide assistance with presentations to investors/board members