



Reinventing the Patent Prosecution Process

Focusing spend, reducing office actions and driving successful patent prosecution for 25 years.



Bradley D. Lytle
Managing Partner

An electrical patent prosecution attorney, Mr. Lytle is the firm's managing partner, co-chairs the firm's Patent Prosecution group, chairs the Electrical Patent Prosecution Group and is a member of Oblon's Management Committee.

- **Company:** Oblon, McClelland, Maier & Neustadt, LLP (aka, "Oblon")
- **Customers:** Leading technology and innovation companies worldwide in electronics, automotive, software, consumer goods, life sciences and industrial chemicals
- **Headquarters:** Alexandria, VA
- **Number of Employee:** Total 420, including 120 attorneys and other IP professionals
- **Industry:** Intellectual Property Law
- **Featured Services:** Search (Prior Art, Freedom to Operate, Validity, Infringement); Technology Landscaping, Patent to Product mapping

Oblon, McClelland, Maier & Neustadt, LLP is one of the world's largest law firms dedicated exclusively to the practice of intellectual property law. Founded in 1968 with headquarters in Alexandria, VA, a few steps from the USPTO, Oblon has obtained more U.S. utility patents than any other firm in the world for 25 consecutive years.

Introduction

The economic downturn of 2008 and subsequent cost pressures made many companies re-think their approach to protecting innovation. Oblon had to examine how these companies were going to operate more efficiently by reinventing the processes Oblon used to provide legal services to their clients who want to conduct their patent operations more effectively. Oblon realizes that not all patents are created equal, which creates the need to manage portfolios more strategically.

This shift in thinking has led to a change in process at Oblon by placing patents into "lanes" that divide them into high, medium and low priority streams. This way, inventions are rated on the basis of patentability and future value, so they can be prioritized accordingly.

As a leader in IP law, Oblon was well positioned to take advantage of these new market opportunities and bring new value to customers in partnership with Clarivate Analytics.

Oblon took an early decision to respond to the changing IP environment by reinventing the way we deliver legal services. Clarivate Analytics has helped us with doing the search and getting the awareness that has helped the clients place the patents into the different lanes.

Bradley D. Lytle, Managing Partner, Oblon

How Did Oblon Address These Market Opportunities?

Patent Filing Strategy

To help companies prioritize their patent filings and apply their finite budgets, Oblon evaluates the market and technology landscape to determine how an invention fits into a client's portfolio and overall IP and business strategy.

By identifying which ideas have the most commercial value worth protecting, Oblon determines which application should be filed to help defend the client's patent portfolio and which should be dropped. Presenting clients with recommendations based on reliable data and insights from Clarivate Analytics gives companies the confidence to make the hard decisions on patent prioritization, thereby "getting the biggest bang for their buck out of their patent portfolio."

“Companies want to know which are the ‘must protect’ inventions based on their technology direction and where markets are heading. But figuring out how patents align with future markets is not easy. Attorneys are good at patent work but aren’t necessarily so good at keeping an eye on market trends. We didn’t have a solution for this so we reached out to Clarivate.”

Bradley D. Lytle

Improving Efficiency in the Patent Prosecution Process

For Oblon, efficiency relates to several areas of their IP practice. Firstly, the decision to file or not can avoid inefficiencies spent in seeking patent protection on something that just won't pan out commercially. Efficiency also relates to the patent prosecution process itself, the shortening of the cycle

and therefore the cost. Using its office location (right opposite the USPTO) as a strategic advantage, Oblon aims to reduce the number of office actions by hosting personal interviews with patent examiners with the most complete view of prior art using data from Clarivate Analytics's Derwent World Patents Index.

"What [clients] want is 'compact prosecution.' That means, don't drag things on and on. Get it done efficiently. We've developed some techniques including interviewing before the examiner has made a rejection. If we have very good awareness of what the best prior art is that the examiner's going to find, it gives us the opportunity to collaborate with them to get the cases through efficiently and get applications allowed many times, without even getting a rejection. That's hugely valuable to companies."

To support the Compact Prosecution process, Clarivate Analytics conducts an initial search citing pertinent prior art based on the invention disclosure; thus improving the arguments with examiners and making the patent more defensible during PTAB (US Patent Trial and Appeal Board). Overall, this also increases the timeliness of examination which enables the client to make better decisions on whether to continue or abandon the prosecution.

Conclusion

The collaboration with Clarivate has enabled Oblon to create efficiencies in their patent prosecution process, improve filing strategies by identifying the most valuable patent and as a result manage cost and client satisfaction. In addition, Oblon is able to provide strategic counsel through the use of patent analytics services and scale their team on demand to match the workload and number of cases in the event of big acquisitions for example.

The result is also based on the trust and partnership that Oblon and Clarivate have built so that they are able to operate in a team approach, trusting each other's expertise.

Clarivate Analytics Virtual IP Office

Clarivate provides a team of IP search specialists who operates as an extension to the Oblon in-house team. Drawing on a global team of highly experienced subject matter experts, including former patent examiners and registered patent agents, Clarivate is able to respond quickly to demand while maintaining the highest quality standards.

The Clarivate team uses Thomson Innovation, powered by Derwent World Patents Index (DWPI), the world's most comprehensive patent solution covering more than 50 patent issuing authorities.

Oblon also has access to the specialist consulting team at Clarivate who has deep domain expertise and uses ground-breaking tools, such as ThemeScape Maps, to help companies visualize and quickly understand the patent landscape.

Alexandria | New Delhi | London | Minneapolis | Mumbai | Tokyo | Beijing

Components

Scalable Search Function

- Prior Art, Freedom to Operate, Validity, Infringement
- Patent experts familiar with specific technology areas
- Rapid resource scaling to meet peaks in demand

Who we are

Clarivate Analytics accelerates the pace of innovation by providing trusted insights and analytics to customers around the world, enabling them to discover, protect and commercialize new ideas, faster.

By working with Clarivate's Virtual IP Office, you can reduce the management overhead and costs associated with patent drafting, patent search, patent prosecution and docketing services, while improving efficiency and quality of your IP practice.

For more information:

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