

WISCONSIN INTELLECTUAL PROPERTY LAW ASSOCIATION

Chief Patent Counsel Roundtable: The View from In-house Counsel

Presented by Live WIPLA CLE

Speakers: Robert Deberardine – Abbott Laboratories
Walter Zimmerman – Johnson Controls, Inc.
Alyssa Dudkowski – Kimberly Clark Corp.
Jason Pauls – Quad / Graphics, Inc.

Moderator: John D’Antico – G.E. Healthcare

Date: Tuesday, August 21, 2007
11:30 a.m. – 1:15 p.m.

Location: Italian Community Center – Milwaukee, WI

Round-Table Discussion:

1. Introductions

- Name
- Employers (past & present)
- Undergrad & Grad School
- Revenues
- Size of IP Legal Team
- Approx. number of patent applications filed / year

2. How / When / Why did you transfer from Outside Counsel to Inside Counsel?

- What is the biggest difference in your personal practice since doing so?
- Is there a such thing as a typical day?

3. As an IP Manager, what keeps you up at night?

- Any worrisome trends you’ve noticed?

4. What is the #1 thing Business Leaders need from IP Legal Teams?

- How much time do you spend talking to General Counsels / Senior Leaders?
- Does IP Counsel make key decisions or ask aggressive questions?
- Is there tension between being a partner to Business Leaders & a Corporate Guardian of your company’s reputation? How can we resolve? Can IP Counsel act independently / aggressively?

5. As a percentage, how does your company split its IP work re: internal v. external preparation?

- How do you decide who will do what?

6. From Inside Counsel’s point of view, what is Outside Counsel’s single greatest value add?

- What can they do better?
 - Can they help determine IP strategy, or must that come from the inside out?
7. Do you rely heavily on opinion work?
8. Have you pursued alternative billing arrangements?
- Flat fee arrangements?
 - Fee caps / Not to Exceed arrangements?
 - Hourly rate discounts?
 - Blended rates?
 - Contingency fee arrangements?
 - Hybrid fee arrangements?
9. What is a main difference you expect from Inside Counsel versus Outside Counsel?
- How many external providers do you use?
 - Do Business Leaders perceive significant differences between hiring General Practice Firms w/ dedicated IP Teams versus IP Boutique Firms?
 - What qualities do you look for when you hire new Inside or Outside Counsel?
 - How do you choose new Outside Counsel
 - Pre-existing Relationships?
 - Referrals?
 - Firm websites?
 - Martindale Hubbel?
 - Lawyers.com / other on-line services?
10. What is something Outside Counsel can do that is particularly helpful?
11. What is something Outside Counsel does that isn't particularly helpful?
12. What steps can companies take to improve the quality of their IP portfolios?
- Are there tangible ways to measure IP Quality?
 - Are there specific best practices to developing / maintaining effective IP Programs?
13. Is the patent system broken?
- Do we need patent reform legislation at this time?
 - 1st to File
 - Publish all apps @ 18^{mo}
 - Revise willful infringement & inequitable conduct
 - Reform damage calculations
 - Post Grant Reviews
 - Why the sudden urgency? Why now? What is happening?
14. What are your principal sources of IP News?
- Are Firm Newsletters helpful? Do the substance and/or people stick with you?
15. Does your company rely heavily on Trademark Protection? Copyrights? Trade Secrets?
16. Have you used ADR to resolve IP Disputes?

17. Is IP Out-Sourcing real or chatter?

18. Do breaking cases – such as Phillips / Knorr-Bremse / KSR / Mediummune – effect day-to-day IP practices?

19. If your CEO gave you all the resources you wanted, what else would you have your IP Team do?

20. Closing Observations / Remarks