



## The search is over. Oppenheimer finds a way to provide better client service – and cut costs



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### OPPENHEIMER

OPPENHEIMER WOLFF & DONNELLY LLP

#### Summary

##### Offices

Minneapolis, MN

##### Personnel

211

##### Clients

Approx. 900

##### Size of portfolio

2,500 active cases

##### CPA Global Solution

Accelerated Examination Patent Research

##### The bottom line

- Improved access to technical expertise
- Time and cost savings
- Attorneys free to work on key projects
- Better workflow and turnaround times
- Comprehensive, collaborative service

With a demanding client requiring a large number of accelerated examination patent applications every month, Oppenheimer's attorneys were spending too much of their time on searches. It was clear that the firm had to find a better way to get things done. Taking advantage of CPA Global's research services, Oppenheimer was able to meet the demand, free its attorneys to concentrate on more productive activities – and reduce costs.

#### The Firm

Founded in 1886, Minneapolis-based Oppenheimer Wolff & Donnelly LLP is a well-established business law firm with a very healthy IP practice. The firm's clients include some of the largest and most successful companies in the technology and medical device sectors. To serve the needs of one of its premier clients in the information technology industry, Oppenheimer had to prepare and file a high volume of Accelerated Examination (AE) patent applications in a short period of time each month.

#### The Challenges

To handle the high volume of AE searches that comply with the USPTO's new procedures for accelerated patent examination, the firm had shifted its resources, re-allocating attorney time to prepare the applications and analyse the search results. A sizeable proportion of this time was spent on the AE Support Documents, which include a detailed analysis of the search results. Problems arose during rush periods when everything got stretched – and the firm found it difficult to satisfy the demands of all of its clients.

Simply outsourcing the work didn't provide all of the answers either, as attorney Chris Hilberg explains: "We were using an outside provider to perform the searching for all of our AE patent applications. But we would receive a list of numerous references, with minimal guidance or commentary describing the relevance of the references to the claimed invention."

Because of this, Oppenheimer had to analyse the references from scratch to assess their potential relevance. They were essentially repeating portions of the reference analysis that were already performed by outside researchers. With some cases, the attorneys had to spend more time researching the references than they did drafting the application in order to meet the AE Support Document requirements.

It was clear that they needed a more efficient way to get the work done and make better use of attorneys' time. Assessing what was required, Oppenheimer set out a list of the essential elements that any search partner would need to provide. These included quality of work, expertise

within a number of technology areas, price, turnaround time, and the ability to handle volume.

### **The Solution**

CPA Global has a suite of patent search services, delivered by technical experts in a wide range of fields. These experts are trained to determine optimal search strategies, conduct exhaustive but cost effective patent searches and meaningfully interpret the data. They are experts in classifications, keywords and patent terminology, and understand how best to exploit the search tools available to them.

Critically, CPA Global's research services are immensely flexible – and the CPA Global team worked closely with Oppenheimer to establish a strategy that made best use of the existing resources within the firm's structure. As Chris describes: "It was key to the success of this program to first identify the requirements at both ends, in order to set expectations. The accelerated examination procedures at the USPTO are a relatively new process so we worked in with our client and CPA Global to identify how best to handle it."

### **The Benefits**

Working with CPA Global has brought a number of benefits to Oppenheimer, including:

#### **Cost savings**

CPA Global's pricing was very competitive, but the knock-on effect of freeing up attorneys was even more dramatic. Attorneys had more time to devote to these aspects of patent preparation where they added the most value, rather than spending hours on activities where they provided less value or repeated work already performed by outside researchers.

Good deliverables are the bottom line, and working with CPA Global helped Oppenheimer make this work profitable – allowing the firm to achieve its business goals and keep clients happy.

**“By using CPA Global research services, we estimate that we saved as much as 50 percent on total time and costs expended for completing the accelerated examination requirements, including attorney time gained and the total price paid for the search. This is an enormously cost effective solution, with high quality deliverables.”**

#### **Technical expertise**

CPA Global's technical search experts cover every industry sector and have a very strong understanding of how to search within their field and what references are truly relevant. Understanding the technology yields better results, and the breadth of technical knowledge is vital, as few projects fall solely within just one area. Oppenheimer, for example, needed searchers with an excellent knowledge of IT, but many of the searches strayed into other areas.

“The breadth and depth of expertise among the team of searchers at CPA Global is such that we were always confident that they could handle a search in whatever area we needed. The results were consistently first class,” explained Hilberg.

#### **Quality of service**

The search team looked at AE processes to find trends in the dismissals then speak to the examiners directly in order to advise on best practices for Oppenheimer.

The firm's client also had access to the searchers and could communicate directly if anything had to be tweaked along the way. “The CPA Global team goes way beyond being responsive. If there are questions or concerns they are very accessible and communication is always effective. But more importantly, they can also draw upon their experience and knowledge of the workings of the USPTO to advise on how to get the very best results for the AE applications.”

#### **Turnaround time**

Turnaround time on searches was always quick and consistent. Oppenheimer could rely on searches coming back in full and on time which meant it could plan its workload more effectively.

“CPA Global's collaborative approach ensured that client deadlines and USPTO requirements are met on time so we can file more AE searches in a shorter period. When we handle large volumes of AE applications, we need to be able to schedule our people efficiently, which requires that we know when to expect deliverables from CPA. We can rely on CPA's quick and consistent turnaround, which allows us to plan economically, and this process has a huge impact on our bottom line and our client service.”

#### **The Impact**

By removing the search requirements from attorneys, Oppenheimer was able to meet tight deadlines, reduce costs and focus on more valuable activities for clients, as well as demonstrating a capacity to take on more work – ultimately benefiting the firm's bottom line.