

CLIENT SPOTLIGHT

Five Minutes with Joshua Gibbs, DLA Piper

With more than two decades of intellectual property experience, Joshua Gibbs, National Intellectual Property Manager at DLA Piper, knows more than a thing or two about IP budgeting. Here, he shares the law firm perspective on the key challenge of estimating and budgeting IP costs for clients and explains how DLA Piper tackles this with help from Anaqua's Global IP Estimator™ software.

Please tell us about your career history and your current team.

When I turned 18, my mother (who worked at a law firm) told me I needed a full-time job. I became a patent records clerk for the next year and a half before I moved into helping the docketing department. In 2001, I joined the docketing team at Heller Ehrman LLP before joining Gray Cary Ware & Freidenrich LLP in 2004, where I was the docketing coordinator for San Diego. Gray Cary was one of three firms that merged to create DLA Piper in January 2005.

After two years in docketing, I moved into the role of IP coordinator for the better part of ten years. Then I became the regional supervisor for Palo Alto, San Francisco, San Diego, and Los Angeles in 2017. In the middle of last year, I became the National Intellectual Property Manager for DLA Piper, tasked with streamlining our practice and people.

We now have 50 staff members—including paralegals, IP specialists, docketing professionals, and supervisors—across five offices. We're prosecuting 19,000 active cases globally.

What type of clients do you file on behalf of?

We represent a diverse range of clients across multiple industries. In San Diego, we have a number of biotech clients. We also represent companies focused on computer software and hardware, design work, cryptocurrency, and universities. Some of our clients are what we call portfolio management clients. This is where the company files for a patent in the US and then files for patents in other countries, based on the US parent patent. We file the US patent and instruct foreign counsel to file in their own countries.



On the East Coast, we have a different type of client, where we act as the foreign associate. Foreign attorneys instruct us to file Patent Cooperation Treaty patent applications under the 35 U.S.C. 371 so that their clients can obtain US patents.

What do you see as the main challenge for IP budgeting?

The biggest challenge we see is producing all-inclusive IP budget numbers that are accurate. It can be difficult to provide precise numbers for the actual cost of filing in multiple countries. It's also crucial, but difficult, to make sure that clients understand the full picture of IP costs.

Some clients will want to file into four or five countries, and they only look at the initial costs of filing in these countries. Three to six months down the line, they wind up incurring further costs they didn't anticipate coming so soon in the process. This turns into another challenge for us—our clients want to proceed with a response to an action, but they don't necessarily have the capital to proceed at the time. This can put us in a difficult position: we can't use our own money but we want to maintain our client's rights.

How do you overcome this challenge?

We use Global IP Estimator to estimate the fees we provide to clients for filing new applications. Global IP Estimator is an IP cost estimating software provider acquired by Anaqua in February this year. It gives us a great starting point for fees. When the case moves into the prosecution stage, the estimates tend to be decided by our IP coordinators who have strong docketing and invoice processing backgrounds.

If you don't have tools like the Global IP Estimator or PATTSY WAVE for annuities, then you're stuck with going to foreign websites and looking up the costs for every single case. This process can be time consuming and brings with it a heightened risk of inaccuracy without a software like Global IP Estimator.

How has PATTSY WAVE helped your team?

One of the ways PATTSY WAVE helps is with the built-in interaction with the Anaqua Renewal Management Service. With annuity fees and maintenance fees due annually, clients want to know what the costs are. Traditionally, we've had to look this up manually, with our team then keeping a master spreadsheet of the fees. Both searching for the fees and maintaining the spreadsheet were very time consuming. Clients are not going to want to pay for the research or maintenance on this.

Now, Anaqua feeds this data into the docketing system. We can extract quick reports for anything due over the next quarter or year for all of our clients.

In terms of time savings, if you have 20 cases per patent family, it will take close to 30 minutes to look up estimates. For countries you don't regularly do business in, it can take up to an hour. With Global IP Estimator, all of this information can be categorized and extracted into spreadsheets in less than ten minutes.

All of our annuity, payment, and IP workflow processes go through our docketing software. We only need to click a few buttons to send the information to clients. Our clients can then pay and upload the annuity receipts to the docketing software. Essentially, Anaqua manages the whole administrative process.

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