

Building a Ready for Action Intellectual Property Portfolio Strategy for In-House Counsel

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In-house counsel and clients would have a better relationship if attorneys sent clients Intellectual Property (IP) reports on a more regular basis, according to Jeffrey Scott Leaning and Timothy B. Donaldson, Partners, at [MH2 Technology Law Group](#). “This partnership makes for the ideal management of an IP portfolio,” they add.

[Jeffrey Scott Leaning](#) and [Timothy B. Donaldson](#) share their thoughts with Maria Gregoriou on why the managed legal services approach is mutually beneficial for attorneys and clients.

How can legal department management increase operational efficiency?

Timothy B. Donaldson: Open communication between attorneys and clients is key to building a strong business partnership. One way to keep clients informed about ongoing IP prosecution is through the use of regular status reports. These reports can include budgetary information issues, upcoming due dates, a summary of actions performed, or a projection of future action items, and can be customized to a client’s specific needs. Fostering this business partnership through open communication and recognizing a client’s specific needs makes for the ideal management of an IP portfolio.

Under a flat or fixed-fee arrangement, a team of attorneys can be assembled to review and share expertise on individual cases. Each team member brings his or her own technical, legal, and professional experiences to the table, making IP analysis more efficient and productive. In addition, each team member becomes familiar with a client’s technology and can be ready to respond as needs arise.

In view of the American Invents Act, what patent filing strategies can you recommend?

Jeffrey Scott Leaning: Clients should approach patent filing as if the US was an absolute novel country in this area. The ideal situation is that people who receive a disclosure should be under a confidentiality agreement. If this is not possible, the client should know who is going to be in the audience during disclosure.

What should legal departments keep in mind when dealing with pharmaceutical patents?

Timothy B. Donaldson: Patent term adjustments (PTAs) must not be overlooked when it comes to the pharmaceutical field. Unlike other technologies, the term of a pharmaceutical patent, including any PTA accrued during prosecution, can be critical to the patent's ultimate value. Thus, the practitioner must keep up with current case law, like the recent Exelixis cases, as well as changes in United States Patent and Trademark Office policy and rules, to maximize any potential PTA and avoid unnecessarily losing valuable patent term during the course of prosecution.

Do you have any final thoughts?

Jeffrey Scott Leaning: Managed legal services approaches are currently being preferred as the law firm is closer in style to an in-house attorney, where a partnership is formed between the client and the law firm. A certain number of hours that expert attorneys should be on call every month for a fixed fee, would be part of the agreement. A good relationship is vital here as more time may be put into legal matters than was originally thought. Having this partnership model in place would be mutually beneficial and ensure that the client's expectations are met.

About MH2 Technology Law Group

[MH2 Technology Law Group LLP](#) is an intellectual property law firm specializing in practice before the US Patent and Trademark Office, strategic counselling, and patent portfolio management. We are committed to developing long-term, mutually beneficial relationships with our clients through the use of seasoned attorneys, client-focused pricing, and a deep understanding of our clients' technologies and businesses.

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National Law Review, Volume III, Number 48

Source URL: <https://natlawreview.com/article/building-ready-action-intellectual-property-portfolio-strategy-house-counsel>