

## Client Service Lessons Learned Serving as Both In-House and Outside Counsel

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*By J. Baron Lesperance*

As a patent attorney who previously worked in-house, I've pretty much seen it all: the good, the bad, and even the ugly. I've worked against the limitations of time and resources and with several outside law firms. Now that I am a patent attorney in private practice, I can honestly say I've seen both sides of the coin ... and learned a few lessons along the way. Here is what being on both sides of the aisle (in-house & outside counsel) has taught me about how to better serve in-house counsel.

### **Cut to the Chase by Reversing the Order of Information**

Large law firms tend to produce an equally large amount of paperwork. In my experience as in-house counsel, it was not uncommon to receive a seemingly simple reporting of a USPTO Office Action that would total 10 pages or more. Most of that content is typical boilerplate language and form letter content, much of it containing basic background that I would flip right past to get to the final two pages of actual legal analysis and recommended courses of action. Once you've established a working relationship and comfort level with your client in-house, it's



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likely that they already know the basics of a filing or recurring matter, so all of the background information attorneys provide can sometimes be in the way of what in-house counsel truly wants: clear and concise answers and next steps, delivered quickly.

To better serve your clients, consider reversing the order of information, and lead with the actionable information first. Open your memo or letter with a brief abstract of the letter's larger intent, providing a quick breakdown of the next steps, recommended actions, due dates, and so on. You can always append background documents or relevant

case law, if necessary. But cutting to the chase saves the client corporation time, billable hours, and workload—all of which further endears you to your client and will result in greater loyalty and more work in the long run.

### **Let the Client Lead the Dance**

It's typical, especially at larger firms, for attorneys to be working from templates and boilerplate that the firm has developed to create consistency and lessen the administrative burden of applying the law and serving the client. But rather than reflexively and rotely relying on such template documents to com-

municate with your client, let the client establish the rules of engagement. Assuming your firm's methodology matches the preferences of a busy in-house attorney can create friction and frustration.

Ask the client how they like to be communicated with. Some might want traditional paper trails, while others may be modernizing and want everything submitted electronically so it is more easily indexed and referenced. Some want long, detailed letters; others want brief memos. I once had to break it to outside counsel that I got into the habit of ignoring all of his hard work because it was too much, too often. Your client may be experiencing the same, and the avalanche of paper may serve to annoy, not impress. Open a dialogue and go the extra mile to tailor your approach to match your client's preferences.

### **Establish Formal Reporting Protocols and Timelines**

Because so many client priorities are time-bound, time is truly of the essence when serving in-house counsel. When working in-house, it was critical for me to receive prompt and proactive information from my outside firm. In patent law, a typical reporting of an office action has a 90-day response window before extension-filing fees are incurred. If our law firm took three to four weeks to process a notice before it ever hit my inbox, half of our response time would already be gone.

Rather than accepting delays and long lead times as a standard practice, I worked with my firm to create a process and protocols we could both agree and live up to. I offer

such a timeline commitment to my in-house clients that I now serve from the outside. For example, once a report comes in from the patent office, we serve notice within one week to the client. Our recommendations come within a week of that submission. Then we work together with the client to set standards for when the draft of the documentation and response paperwork will be complete, as many as four weeks prior to the response deadline, giving in-house counsel plenty of time to think strategically, respond judiciously, and plan patiently. In short, don't turn a three-month window into five weeks if you can expedite the first step and commit to a reasonably rigid schedule thereafter.

### **Staff Up To Keep Up**

Dealing with law firm staff turnover, working around planned and unplanned attorney absences, and being served by junior associates is part of the reality of working as in-house counsel. I understood that it wasn't realistic to expect partner-level commitment to all of our routine matters. But it was nice to have access to partners, and to have senior associates proactively looking to schedule strategy meetings with me and our in-house engineers and inventors. To the extent you can plan, try to allocate sufficient resources (both high-level and junior) at all times—even as emergencies come up—and make sure in-house counsel has the strategic horsepower at his or her disposal, not just the legal manpower.

Again, consider discussing the client's preferences openly and

candidly. Ask in-house counsel if they feel your firm's billable hours are better spent making site visits (or video conferences nowadays) and interviewing inventors and engineers, rather than preparing extensive amounts of paperwork that could overwhelm the client, or give them the impression that you are overcharging. My experience has taught me that in-house counsel needs their outside representation to serve as an extension of the in-house team, not merely as a vendor of legal document preparation and filing services.

### **Closing Thoughts**

If you ask clients what they want, they will tell you. And if you can tailor your approach to match the preferences and demands of the in-house lawyers you serve, you'll end up with more work, longer-term relationships, and greater loyalty that is bound to bring in more work, referrals and clients.

I consider the optimal relationship with in-house patent counsel to be one who has been in your shoes, knows the challenges and constraints, how to get the most out of your legal services budget, and most importantly, how to stay ahead of the competition.

**Baron Lesperance** is an intellectual property attorney with the Washington, D.C. firm *Remenick Law*, who has worked both in-house and as outside counsel in specialized IP matters. He previously served as in-house patent counsel with *Amway*, where he managed a portfolio of more than 1,200 patents. He can be reached at [jblesperance@remenicklaw.com](mailto:jblesperance@remenicklaw.com).