

## Fish & Associates Relies on TotalPatent™ to Support Accelerated Examinations of Patent Applications

### Overview

**Firm Name:** Fish & Associates

**Location:** Irvine, Calif.

**Industry:** Legal services

#### Customer Profile:

Fish & Associates is a 12-person boutique law firm specializing in intellectual property law. In addition to being registered with the United States Patent and Trademark Office (USPTO), the patent professionals at Fish & Associates have a wide range of valuable experience, including doctorates and/or master's degrees in chemistry, biochemistry, physics, software, and mechanical and electrical engineering, as well as practical industry experience developing products and patent portfolios that address market needs.

#### Business Situation:

Fish & Associates had been using a patent research service from another legal service company for many years. However, as the firm became more involved with conducting international patent searches to support accelerated patent examinations, they found their existing service was unable to meet their growing needs.

#### Solution:

After testing and evaluating other patent research options, Fish & Associates decided to switch to TotalPatent™ offered by LexisNexis®. While the firm found that TotalPatent has superior search capabilities and more robust features for supporting in-depth accelerated examination applications, the most compelling reason they selected TotalPatent was the exceptional focus on customer service and response time they experienced in discussions with the LexisNexis® IP Solutions team.

#### Benefits of TotalPatent:

- Attorneys and patent professionals are better equipped to conduct aggressive filing of accelerated examination applications with the USPTO by leveraging full-text content, including machine translations, and global breadth of the TotalPatent database.
- The search engine that powers the TotalPatent service processes complex search queries that could not be run on other patent database engines.
- With more than 38 million main patent families, TotalPatent offers the Fish & Associates team access to the most comprehensive online collection of patent information in the world.
- Attorneys are more confident of the accuracy of their search results since TotalPatent is updated daily by the dedicated LexisNexis editorial team.
- Fish & Associates is able to pass on significant cost savings to clients due to the enormous time savings achieved by using TotalPatent.

### Product Summary

- TotalPatent
- PatentOptimizer™

Fish & Associates is a 12-person boutique law firm specializing in intellectual property law. The firm's work is split about 50/40 between prosecution and litigation of patents and trademarks, with the balance of the work dealing with product and software licensing, work-for-hire agreements, ownership disputes, branding issues, intellectual property audits, trade secrets, confidentiality, unfair competition, and opinion work regarding patentability, infringement, validity, enforceability, and right-to-practice issues.

For a boutique firm, Fish & Associates has a very large experience base. At any given time, the firm's professionals handle about 1,500 foreign and domestic patent applications. Its experience spans a broad range of disciplines, including software, Internet and computer science, mechanical engineering, medical devices, chemistry and pharmacology, biochemistry, biology and life sciences, and electrical engineering. It also handles all manner of patent prosecution, including patent interference, reexamination, reissue, and appellate proceedings before the USPTO.

### Situation

In August 2006, the USPTO established procedures under which the examination of a patent application may be accelerated. Under one of these procedures, the USPTO agrees to advance an application out of turn for examination if the applicant files a grantable petition that meets very specific criteria. Since this "accelerated examination" program is very attractive to corporations that are seeking to fast-track patent applications, Fish & Associates made a concerted effort to make it a hallmark of their patent prosecution law practice.

"We had been using Delphion, a patent research service from another legal service company, for many years," explained Nicholas Witchey, Ph.D., a USPTO-registered patent agent at Fish & Associates and the inventor or co-inventor of over 10 patents and pending patents as a software developer himself. "But as our firm became more involved with conducting international patent research to support accelerated patent examinations, we found this service was just unable to meet our growing needs."

According to Dr. Witchey, these requirements include searching international patents and patent applications, non-patent literature sources, and detailed patent records across both broad and narrow search spectrums.

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Nicholas Witchev, Ph.D.,  
a USPTO-registered patent agent  
Fish & Associates

In 2008, the firm’s manager, Robert Fish, agreed to review TotalPatent from LexisNexis. For several months, the law firm put the product to the test by evaluating its ability to conduct the kind of precise research they would need in order to support their growing accelerated examination practice by—among other things—performing complex searches that integrate proximity searches with synonym searches across the extensive TotalPatent global patent records. The singular goal of this intensive due diligence process was to investigate the features and benefits of TotalPatent against other options on the market.

## Solution

After testing and evaluating many patent research options, Fish & Associates decided to switch to TotalPatent from LexisNexis. The firm’s patent professionals not only found that TotalPatent had superior search capabilities and more robust features for supporting in-depth accelerated examination applications, but also found LexisNexis® customer service to be exceptional and highly responsive whenever Fish & Associates staff needed assistance or required additional functionality.

“By far, the number-one selling point for TotalPatent was the team of people at LexisNexis who developed and stood behind the product,” said Dr. Witchev. “They were accessible to us, seemed to truly crave our feedback and suggestions, and were willing to actually go to work on specific ideas we brought to them for how to make the product better. In all of my years in the software and technology business, I’ve never seen that level of attentiveness in working with a customer and responsiveness to their comments.”

TotalPatent allows users to access extensive LexisNexis patent databases, including the full text from 22 authorities, bibliographic and abstract data from 96 authorities, searchable both in the language of publication and in English language machine translations, as well as images, legal status, citations and patent family data, and compressed and searchable PDFs. No other patent research solution in the world offers that level of comprehensive reach and international scope.

In addition, there are a number of unique features in TotalPatent that make it easier for users to obtain the precise documents they need in the patent research process. For example, robust language translation capabilities and the ability to search and download PDFs of patent records are both highly valuable.

***“The international scope of TotalPatent is turning out to be extremely valuable for us as our team of IP professionals has added confidence that their searches of patent records worldwide will be both comprehensive and accurate ... ”***

Nicholas Witchey, Ph.D.,  
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Still, for the team at Fish & Associates, it all came back to the people behind TotalPatent.

“There’s no doubt that TotalPatent is a terrific product and was a better solution for our law firm, but the important consideration for us was that we were impressed with how the LexisNexis team was interested in engaging with us, as a patent solutions partner,” recalled Dr. Witchey. “That connection gave us confidence that we were investing in a patent research service that we would be able to successfully implement in our firm, regardless of the inevitable bumps we would encounter during the adoption of a new product.”

## Results

Now that TotalPatent has been in use at Fish & Associates for several months, the law firm has begun to realize a number of important benefits from its implementation.

First of all, the TotalPatent international patent database gives Fish & Associates the global breadth they require from a patent research service in order to properly support their aggressive filing of accelerated examination applications with the USPTO.

“The international scope of TotalPatent is turning out to be extremely valuable for us as our team of IP professionals has added confidence that their searches of patent records worldwide will be both comprehensive and accurate,” explained Dr. Witchey. “This is crucial for us when it comes to meeting the key criteria required by the USPTO when filing for the accelerated examination of patent applications.”

Also supporting the firm’s focus on submitting accelerated examinations is the quality of the data they receive from their searches. TotalPatent gives Fish & Associates professionals access to a comprehensive collection of patent information through a single platform that combines first-level data coverage with user-friendly design and powerful search functionality. The combination of extensive full-text content from all the leading patent-issuing authorities and content from most of the smaller ones keeps the team updated faster than they were accustomed to with their prior service.

***“The efficiencies we’ve been able to realize by relying on PatentOptimizer to help us develop consistent and well-tailored patent applications are just extraordinary. In fact, we have been seeing a return on our investment each month within just the first few business days of the month.”***

Nicholas Witchey, Ph.D.,  
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#### About LexisNexis

LexisNexis® ([www.lexisnexis.com](http://www.lexisnexis.com)) is a leading global provider of business information solutions to a wide range of professionals in the legal, risk management, corporate, government, law enforcement, accounting and academic markets. LexisNexis originally pioneered online information with its *Lexis*® and *Nexis*® services. A member of Reed Elsevier [NYSE: ENL; NYSE: RUK] ([www.reedelsevier.com](http://www.reedelsevier.com)), LexisNexis serves customers in more than 100 countries with 13,000 employees worldwide.

#### For More Information

Visit [www.lexisnexis.com/ip](http://www.lexisnexis.com/ip)

#### Other key benefits include:

- The ability to process even the most complex search queries that are configured by the Fish & Associates lawyers, patent agents and paralegals—search queries that are often unable to be performed through a lesser database;
- Searchable PDF images in TotalPatent mean that the Fish & Associates professionals don’t need to OCR patent data in order to perform more targeted searches;
- “Fuzzy logic” searching by sentence or by paragraph, combined with highlighted results pages and custom-filtered views, reduces time and costs by streamlining the search process;
- Access to the most comprehensive online collection of patent information in the world, including more than 38 million main patent families, far more than any other patent research service; and
- The ability to cut and paste various document identifiers in TotalPatent, producing enormous time savings for Fish & Associates professionals, which translates into significant cost savings for their clients.

“We’ve been so pleased with TotalPatent in particular and the LexisNexis IP team in general that we recently agreed to expand our license for their *PatentOptimizer* product as well, which is another excellent component of the LexisNexis suite of IP solutions for legal professionals,” said Dr. Witchey. “The efficiencies we’ve been able to realize by relying on *PatentOptimizer* to help us develop consistent and well-tailored patent applications are just extraordinary. In fact, we have been seeing a return on our investment each month within just the first few business days of the month.”

Meanwhile, the team at Fish & Associates continues to work closely with the IP Solutions team at LexisNexis on ways to constantly improve the TotalPatent service, enhance its user interface, strengthen its search capabilities and deepen its database reach. What began as a conversation between a vendor and a law firm has grown into a successful collaboration in which both parties win.

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