



What In-House Counsel Expects from Outside Counsel

**Dallas Bar Association
Intellectual Property Law Section**

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HALLIBURTON

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Familiar Definitions

- Patent Attorney
- “Introverted” Patent Attorney – Probably “In-House”
- “Extroverted” Patent Attorney – Probably “Outside Counsel”

Who is Halliburton?

- **Halliburton Energy Services Group**
 - Drilling, Evaluation, and Digital Solutions
 - Fluid Systems
 - Production Optimization
- **KBR**
 - Energy and Chemicals
 - Government and Infrastructure

Halliburton's IP Portfolio

- **The company regularly ranks among the top 100 companies receiving patents in the U.S. each year**
 - In 2005 we ranked 87th with 193
- **The company owns over 4000 active U.S. and foreign patents**
- **Halliburton owns over 1500 trademark registrations around the world**
- **Our IP databases include tens of thousands of individual records**

THE INTELLECTUAL PROPERTY PRACTICE GROUP

- **The intellectual property practice group handles IP legal matters affecting the company.**
- **The group includes 15 attorneys located in 5 offices in the company's 3 major technology centers.**

The IP attorneys are placed in or near the facilities housing the scientists and engineers who make up the bulk of this group's internal clients.

- **Houston – 7 Attorneys**
- **Dallas – 5 Attorneys (4 Patent, 1 Trademark)**
- **Duncan – 3 Attorneys**

The IP Practice Group primarily supports the Energy Services Group Product Service Lines and the KBR business units, and the technology and research groups associated with them.

The IP Attorneys Also Work With --

- **other Law Department groups**
- **F&A and M&A groups**
- **Business Development**
- **Information Technology**
- **Marketing and Communications**
- **Country and Regional Organizations**

Matters Handled by the IP Attorneys can be Broadly Classified as --

- **Portfolio Management**
- **Transactional Work**
- **Dispute Resolution**
- **Client Counseling and Education**
- **Review of Communications and Publications**

Halliburton Engages Outside Counsel to Help in Many of The Areas of IP Responsibility Outlined Above

- **Over the next half hour (or so) I will outline for you some of the things that I look for in the performance of outside counsel**

What We Don't Need, and Don't Want, in Outside Counsel

- **Don't Need –**
 - Red and blue body suit, cape, and a big “S” on your chest
 - Shining armor, lance, and a white horse
 - Boxing gloves in your briefcase
- **Don't Want --**
 - Horns, long pointy tail, and trident
 - A blank “What, Me Worry?” expression

My Personal Top Ten List

- **Caveat: This is my list. Other Halliburton attorneys might have their own, slightly different lists**
 - **Necessary, but not sufficient conditions!**
- **There is a Baseline, not really part of the list**
 - **Legal ability**
 - **Ethics**
 - **“The Martindale-Hubbell” factors**
 - **Be available!**

Here We Go

1. Be Prompt

Meet deadlines, return phone calls and respond to emails in a timely manner

The most frequent complaint we see from internal clients concerns perceived delays in responding to their requests and handling their legal matters

2. Be full, clear, concise, and exact in communications

If it's good enough for 35 USC §112, it's good enough for the Halliburton IP Law Practice Group

3. Communicate!

Copy us on patent office filings, pleadings, letters to third parties, etc.

We don't need a "duplicate file" in all cases, but we need the important or key documents

See above re: "Be Prompt," and below, "Be Proactive"

4. Be Realistic

In budgetary matters

In strategy discussions

In assessing legal positions

In predicting timing of events

5. Be Considerate

Of in-house counsel's time, availability, and workload

Of in-house counsel's inability always to control the time and availability of internal clients

Of our inability to always turn matters around on outside counsel's schedule

6. Avoid Conflicts

In technology as well as strictly “legal” interests

7. Be Cost Sensitive

Internal clients depend on projections of IP-related legal fees and expenses for preparing their business plans

There is always pressure to reduce the “burn rate,” and the projections as well

Reductions in the projections naturally result in ongoing scrutiny of fees and expenses incurred

8. Believe in the Legal Positions Taken on Our Behalf

This is really the “diligence and zeal” test.....

9. Be Proactive

In recommending courses of action when necessary or desirable

In communicating with inventors and others for required information, as long as you “communicate” “promptly” with in-house counsel

In taking care of routine matters without requiring in-house counsel’s intervention

10. Comply with Halliburton's Billing Requirements

Participate in the company's e-billing system

Other requirements – promptness, completeness, etc.

Questions?