

Outsourcing

patent renewals

IPRIS The tale of our Swiss patent renewals provider, IPRIS, is something of a spin-out success story. It was founded in 2004 by IP experts based at the University of Basel who recognised the challenges faced by SMEs, university technology transfer departments and research councils. They identified a gap in the IP services market for a renewals company capable of providing competitive fee charges, at a fixed rate, along with direct and flexible expert client support.

With this model in mind, IPRIS formed a joint venture with IP Pragmatics in 2005 to further expand the service to the UK market. Today IPRIS has a global reach across Europe, the Middle East, New Zealand and Australia.

One of the greatest excitements of 2012 has been the approval of IPRIS to Public Limited Company status. The change from IPRIS GmbH to IPRIS AG was announced in June 2012. This progress added a further string to our bow in the development of a reliable and effective patent renewals business, and strengthened IPRIS' position within the renewals market.

Client: UCL Business
Sector: Universities
Service: Patent annuity services
Expertise: IP Management

IP Pragmatics worked with a leading UK university, University College London, and its commercialisation arm, UCL Business, to provide patent annuity services (patent renewals) for its portfolio of more than 500 patents. These patents, as is often the case with a university client, were spread amongst several different firms of patent attorneys and a similar number of disparate renewal providers. Some renewals had been outsourced by the attorney firms, some were handled in-house. The annual cost of carrying out renewals was over £100,000.

Objectives:

The university wanted to streamline its processes and reduce its costs without any risk to its patent portfolio.

Approach:

IP Pragmatics, through its renewals agency, IPRIS, worked with the IP Manager to create a Service Level

Agreement (SLA) for the provision of renewals. Key points included:

- IPP provided, free of charge, access to an online database that allows the university to easily see its patent estate and to instruct renewals directly
- The university was invoiced on a per project, or patent family basis to meet its accounting requirements
- Certain cornerstone technology patents, of huge commercial importance to the university, were placed on automatic renewal status. Other, more marginal technologies were placed on renew-on-demand status
- The university was assigned a single point of contact at IPRIS who knew the account intimately and was able to respond to late renewal instructions, without surcharges or urgency fees. All of the university's internal reference numbers were added to the database, providing quick identification of their cases.

Result:

By working with IP Pragmatics, the university considerably reduced its spend on renewals. This saving allowed the university to file more applications. Delivery on the key points in the SLA meant that the university considerably reduced the time involved to instruct and process renewals. Over the first year, the university assessed that it saved over £32,000 on its renewals budget.

Now:

Alex Weedon, Head of Business and Legal Affairs, said: "The initial attraction was the cost savings but you really can't beat it for customer service and flexibility. That is one thing they are head and shoulders above everyone else - that client relationship management. Whenever we want something we can just pick up the phone to Steffen. He is always calm and very "can-do" in his approach to solving problems. His suggestions, like pre-ordering renewals in advance and setting up a tailored method for our payments by monthly stipend to align with internal structure has been good for us all. He doesn't see any barriers and is very solution orientated. You really can't beat it and you certainly don't get it from CPA or some of the patent attorneys."

Client: MRC Technology
Sector: Research Institutes
Service: Patent annuity services
Expertise: IP Management

This year we worked with MRC Technology who manage IP for one of the UK's largest research councils, the Medical Research Council, as well as universities, charities and research organisations. They wanted to transfer the renewal duties of their patent portfolio, consisting of 75 families, to IPRIS. In similar format to many of our university clients, the patent renewals were spread across several attorney firms and providers.

Objectives:

They wanted a centralised online system for all of their cases in order for their nine business managers to access, review and renew the cases they were responsible for. Additionally they were looking to streamline patent costs with the IPRIS fixed fee and VAT free model.

Approach:

IP Pragmatics put together an IPRIS quote for 35 individual cases due for renewal across several jurisdictions so that they were able to directly compare IPRIS fees to that of their current provider.

We met with the staff from the Intellectual Property and Licensing Division to discuss organising the cases into separate online interfaces according to the IP owner. This meant allowing for different password/username combinations to access different parts of the organisation's portfolio as well as recording their internal reference numbers, and invoicing requirements.

MRC Technology were assigned a single IPRIS expert point of contact who was able to carry out this ongoing organisation of their portfolio, respond to late renewals without surcharge and answer any formalities or fee queries.

The invoicing was tailored to suit the internal department division on a per-case or per-family basis rather than upfront payment, allowing for more efficient patent cost management and internal administration.

Now:

The Associate Director of Intellectual Property, Pauline Stasiak, said: "Consolidating our annuity and maintenance fees with one provider has meant more efficient use of our resources as well as potential cost-savings. The ability to track renewals and payment via the IPRIS website is a distinct advantage over our previous process.

"IPRIS have been very helpful; queries are answered promptly and advice given where needed. IPRIS were also very patient when we were having teething problems at the start, during the process of transferring our patent cases to them."

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Alex Weedon, Head of Business and Legal Affairs, UCL Business

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Pauline Stasiak, Associate Director of Intellectual Property, MRC Technology

38%

of the research intensive universities known as the Russell Group are IPRIS clients