



How to select your outside IP counsel

Mattijs van Merle, managing director of Van Merle IP Counsel Select, explains how to select your outside IP counsel in eight steps

It is our vision that you must be globally served by patent attorneys who have experience and knowledge in your area of technology, who are not working for your competitors, and who are able to communicate fluently in your language. This stresses the importance of a careful selection process. The objective of such a selection process is to find outside counsel who best fulfils your selection criteria and who will charge you the lowest fees. This article focuses on how industrial companies can select patent firms in a particular country or region. At the end of this article we will briefly discuss how to select other IP service providers.

By following these eight steps, you will be able to select the best patent firm for you, anywhere in the world.

Step 1: Analyse your needs

The first step consists of a detailed analysis of your patent prosecution needs. Several questions need to be answered. What services do you need in the particular country: just prosecution, or do you also need patent monitoring, prior art search, patent translation, trademark services or other IP services? How many firms and how many attorneys would you need? What type of firm do you need: a general practice law firm, a patent boutique or a patent attorney operating as solo practitioner? What are your key technologies? Who are your competitors?

Step 2: Create your shortlist

After the analysis phase it is time to set up a shortlist with all candidate firms in the particular country. You may want to contact colleagues inside and outside your company, and to look at preferred lists published in IP magazines and on the internet. As a more objective method, we advise that you carry out a search to find all firms which meet your needs in the relevant country. This may range from fifty firms or less in smaller countries to hundreds of firms in larger countries.

Step 3: Contact some shortlisted firms

Now it is time to contact some of the shortlisted firms and assemble information about the profiles of the patent attorneys, eg, their professional experiences, academic background and language capabilities. When selecting patent firms in Asia, it is critical that you analyse the translation capabilities of the shortlisted firms. Some firms have a wide-ranging translation methodology, relying for instance on a combination of human and machine translation and using client-confidential terminology databases. Other firms outsource translations to anonymous freelancers without experience in your area of technology.

Step 4: Meet the candidate attorneys

In most cases you are looking for the best patent attorney, not necessarily for the best firm. It is our vision that you should always know which patent attorneys are working on your cases. As part of the selection process, you should speak with the candidate attorneys, preferably in face-to-face meetings, or possibly via conference calls. By speaking with the patent attorneys you will be able to test his or her language capabilities. You should also discuss in detail conflicts of interest. We advise organising semi-structured interviews with all candidate attorneys, in order to be able to make an objective comparison.

Step 5: Assign preliminary work

In larger selection projects we advise assigning some preliminary work to the candidate attorneys, hence you will be able to judge the quality of the attorneys by outsourcing some complicated cases to them. This might be office actions, appeal cases or counselling about the preferred continuation of a case. You will also experience the quality of the communication. Is the outside attorney able to communicate clearly and to the point in your language?

Step 6: Negotiate fees

Now it is time to agree on the best price level for your company. During steps 1 to 5 we have only investigated quality issues and not discussed any pricing issues. Now it is time to discuss pricing issues with the remaining firms. First you should define your negotiation strategy,

depending on your workload or other relevant issues. In cases of smaller patent portfolios, you may decide to just accept the hourly fees or schedule of charges offered by the patent firm.

In the case of larger patent portfolios, we recommend that you set up your own template of requested patent services. This means that you have to define what kind of services you will need and inform the patent firms of your estimated annual workload. Depending on the variety in the complexity of the requested services, you may opt for hourly fees or fixed fees. When agreeing on fixed fees, we generally advise striving for a fixed price period of around three years.

Japanese Patent Prosecution Service Items (Example)

Filing of application
Filing of divisional application
Filing of request for substantive examination
Filing of request for accelerated prosecution
Reporting and responding to office action during examination
Filing of appeal
Reporting and responding to office action during appeal
Translation from English into Japanese
Translation from Japanese into English
Patent registration

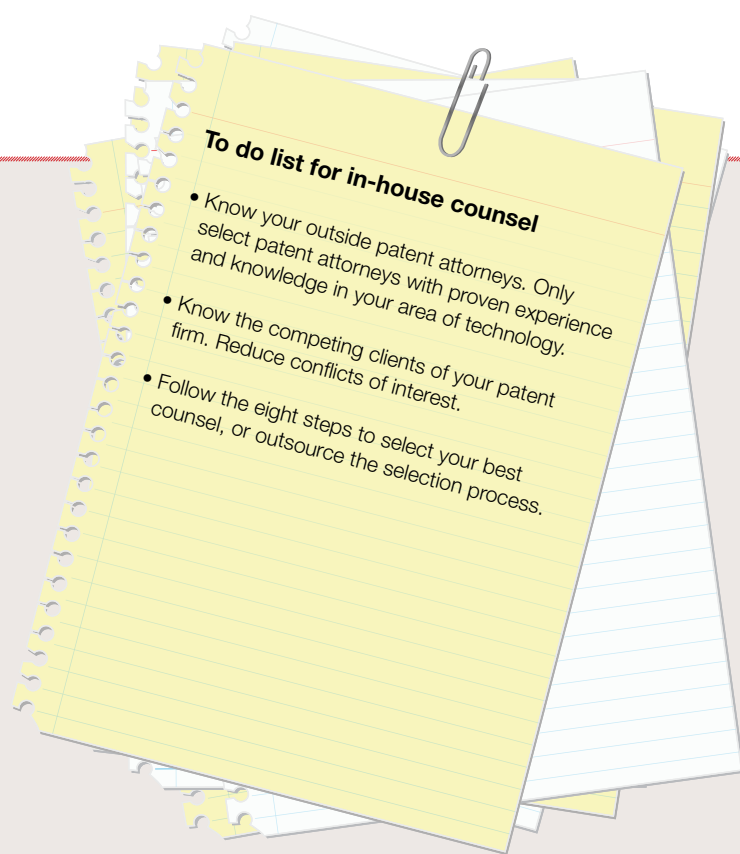
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Step 7: Sign contract

After agreeing on the fees, you are ready to conclude the contract with the preferred firms. Basically this contract will consist of various legal and operational paragraphs. Your company may have general conditions for the purchase of services, which can be used as the backbone of the legal paragraphs in the contract. The operational paragraphs will include drafting, prosecution and billing guidelines.

Step 8: Implement

The last step is the implementation phase. The preceding steps may have cost you more time than expected but the introduction of the new patent firms to your company is the most important phase. You have to arrange for the newly appointed patent



firms to be engaged by your in-house attorneys. Especially for companies with decentralised patent departments, this may mean a lot of communication.

Some additional implementation decisions have to be made. If you have selected more than one firm, how will you divide the workload among the new firms? How will you organise the transit phase: transfer all open cases at once or assign only new cases to the new firms? In the case of larger patent portfolios you will need to discuss workload capabilities with the newly selected firms. They may not be able to accept your new workload all at once. Finally (and this is beyond the scope of this article), you should measure the quality of the newly selected firms.

How to select other IP service providers

This article has focused on selecting patent firms. You may need to select other IP service providers, eg, patent translation agencies, prior art search firms, EPO opposition experts or annuity payment providers. Basically you may follow the same steps, although some steps are more important than others. For example, when selecting prior art search firms, it is very efficient to assign some preliminary work in order to observe the quality of the candidate firms. When selecting annuity payment providers, the template for the price negotiations is very important.

Author



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