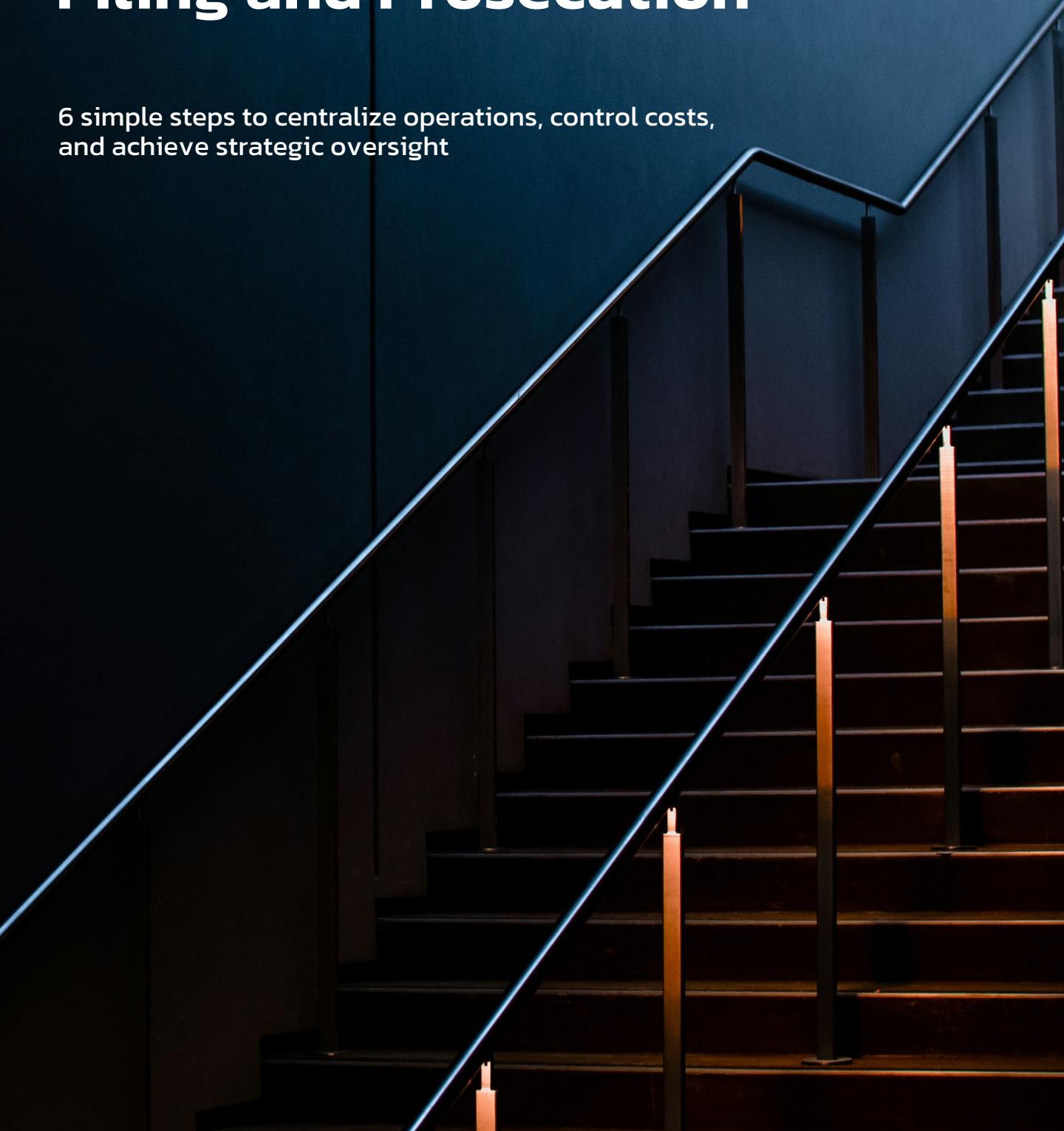




IP Guide

How to Modernize International Patent Filing and Prosecution

6 simple steps to centralize operations, control costs,
and achieve strategic oversight



Increasing digitalization and modernization of legal operations have disrupted traditional ways of managing international patent filing and prosecution. By seizing on the opportunities offered by new technologies, including integrated global services, IP leaders can save valuable time, budget, and resources.

The old ways of managing international patent filing and prosecution are becoming increasingly outdated in today's fast-paced, tech-driven work environments. As legal operations become ever more digitalized and modernized, IP teams that still rely on traditional networks and last-generation email processes risk expending precious time and internal resources managing routine but time-consuming administrative tasks, from docketing to invoice management.

By centralizing the patent filing process through one trusted IP support specialist, such as Questel, multinationals can save time, build consistency, minimize risk, optimize in-house resources, achieve strategic oversight—and realize immediate and significant cost savings.

Ready to Rethink Your International Patent Filing and Prosecution Process?

This IP Guide discusses six simple steps you can take to modernize and digitalize the international patent filing and prosecution process, including:

- 1. Why now is the right time to rethink your current processes and suppliers;**
- 2. Where to draw the line between legal and purely administrative tasks;**
- 3. How to set and achieve your operational objectives without disrupting day-to-day operations;**
- 4. Common obstacles to change and how to overcome them;**
- 5. What outcomes, including cost savings, to expect when switching processes or suppliers; and**
- 6. How to start your journey to modernize international patent filing and prosecution with Questel today.**

Questel's end-to-end international patent filing and cost-control solution supports IP teams to centralize operations, achieve strategic oversight, and control IP spend. Discover how we saved one client **€500,000** annually in international patent filing and prosecution costs on [page 16](#).



STEP 1: Assess the Need and Opportunities for Change

Patent drafting, translations, filing, prosecution, docketing, and annuities were once the sole responsibility of in-house IP professionals and their external legal advisors. However, over the past four decades, the administrative parts of these high-value but time-consuming tasks have been increasingly carved out and commoditized, thanks to specialist, technology-driven service providers.

Nowadays, it is commonplace for IP departments and their law firm advisors to outsource many routine and administrative IP matters to specialist providers. Yet, most providers focus purely on high-volume or discrete tasks, such as annuities or translations, meaning that in-house teams must use multiple suppliers for international patent filing, adding unnecessary time and complexity to the process.

As a result, many in-house teams are yet to consider the possibility of outsourcing many of the steps required for international patent filing despite the opportunities to cut costs and boost efficiency. Even if they have, existing processes and relationships may appear too engrained or risky to change, especially if there is no clear alternative model to adopt.

Introducing Questel's Comprehensive Solution

Questel's alternative model applies dedicated tools, robust processes, and centralized solutions to leverage the administrative processes of international patent filing to reduce costs, improve efficiency, and free up internal resources.

Traditionally, companies manage foreign filings either (1) directly with an in-house team in communication with various overseas law firms or (2) via an external local patent law firm partner (or a blend of the two).

The first model requires companies to invest in attorney resources and administrative expertise to manage such work in-house, including processing and overseeing all translations, correspondence, and invoicing that such an approach entails. The second requires them to pay two law firms to be involved in all activities related to foreign filings, including often paying hourly legal fees for simple administrative tasks.

Discover Our Alternative Approach

Questel's comprehensive solution offers companies a one-stop-shop for foreign filing that replaces the need to pay external law firm partners to act as a hub for national filings and translations and reduces the need to manage some or all work in-house.

We support our solution with a multi-pronged [IP cost management approach](#) to enable clients to achieve their specific cost control requirements, comprising the following key initiatives:

- Structured/Standardized Fee Schedule to provide cost consistency across various jurisdictions.

- Automated Invoice Review Management** to simplify the in-house invoice process.
- Invoice Audit and Compliance Monitoring** to ensure accuracy and ongoing adherence to fee schedules.
- Data Reporting and Benchmarking** to improve budget management and track IP-related expenditures.

STEP 2: Find the Right Balance Between Legal and Administrative Tasks

You may be surprised to discover the wide range of patent filing and prosecution tasks you could manage more efficiently and cost-effectively by partnering with an IP administration specialist, such as Questel.

While the laws and specific implementation mechanisms differ, most patent filing routes comprise a familiar set of administrative processes.

Take, for example, Patent Cooperation Treaty (PCT) National Phase Entry (Figure 1) and Paris Convention filing (Figure 2). Here, the following administrative tasks can be streamlined and optimized:

PCT International Application	National Phase Filing	Post Filing
<ul style="list-style-type: none">- Application subject matter set in stone once filed;- Key dates for protection are fixed;- Act of national phase filings is entirely administrative;- "By filing one international patent application under the PCT, applicants can simultaneously seek protection for an invention in a large number of countries." (WIPO)	<ul style="list-style-type: none">- Entering the national phase is a task ready for commoditization;- Filling out forms, paying fees, and submitting signed documents are all purely administrative;- Translations handled with filing;- Amendments can be made and filed, but the amendments are constrained by the original text;- Why pay legal fees for this formality?	<ul style="list-style-type: none">- Amendments can be made;- Substantive prosecution (optimized legal spend);- Minor revisions and amendments combined with substantive prosecution responses (best practice);- Leave the real work to the experts;- Other post-filing admin tasks already outsourced; e.g., annuities, form generation, etc.

Figure 1: PCT National Phase Entry as an administrative task.



Priority Application

- Application subject matter set in stone once non-provisional is filed;
- Key dates for protection are fixed;
- Localization of application is possible, although at what cost?
- With final version of application, filing internationally is entirely administrative.

Filing

- Entering the national phase is a task ready for commoditization;
- Filling out forms, paying fees, and submitting signed documents are all purely administrative;
- Translations handled with filing;
- Localization must be done before filing. Questel can coordinate and manage this.

Post Filing

- Amendments can be made;
- Substantive prosecution (optimized legal spend);
- Minor revisions and amendments combined with substantive prosecution responses (best practice);
- Leave the real work to the experts;
- Other post-filing admin tasks already outsourced; e.g., annuities, form generation, etc.

Figure 2: Paris Convention filing as an administrative task.

How Does This Look in Practice?

Questel's comprehensive translation, filing, and cost management solution enables clients and legal teams to focus on added-value legal advice, while Questel provides cost-effective technical and administrative support.

Depending on your specific needs, you can centralize the whole translation and filing process with us or choose only specific services. We provide our IP cost management services as part of our filing bundle to ensure you realize the benefits of whichever approach you take (see Figure 3, below).

Client "new" set up with Questel

Legal work

Agents focus on added-value legal advice: Drafting, PCT, national prosecution:

Administrative and technical work

Questel provides cost-effective technical and administrative support:

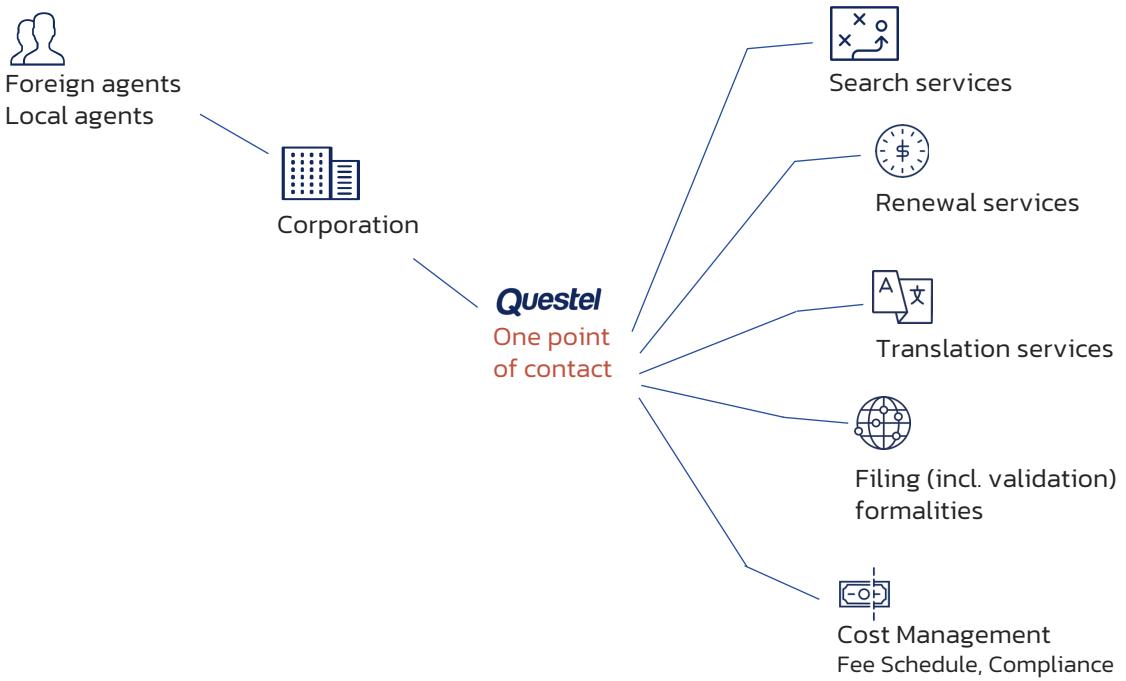


Figure 3: How Questel's solution works in practice.



Our filing services reduce the time burden on in-house teams, eliminate local attorney fees, apply a uniform filing process for all jurisdictions, and save money on foreign attorney filing fees. You can also choose to maintain relationships with existing attorneys while benefiting from our invoice audit and compliance monitoring service, if you prefer (see Figure 4, below).

Questel Filing Services

Filing by Questel Agent—Prosecution by Client Agent

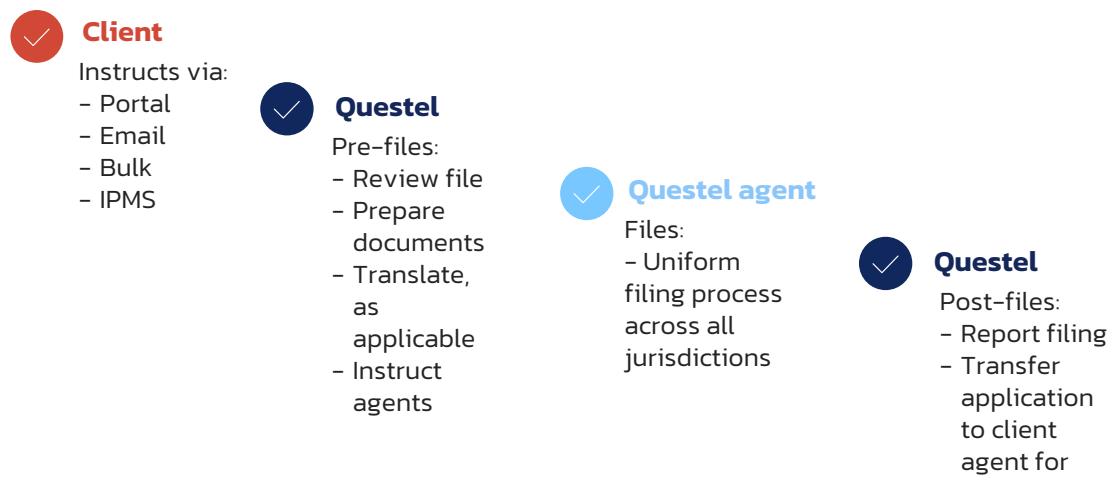


Figure 4: Questel filing process with preferred agents.

STEP 3: Set Your Operational Objectives

Cost savings may provide the original impetus for change, but modernizing and digitalizing your international patent filing and prosecution process can help you meet additional operational needs.

From maximizing internal resources to building consistency across business entities, rethinking your international filing processes can help prepare your organization and IP to thrive in the years to come. Here are six operational objectives to consider when selecting solutions and service providers:

- **Better Use of Internal Resources:**

By outsourcing menial but essential IP admin tasks, you can free up internal teams to concentrate on higher-value tasks.

- **Build and Empower In-House IP Teams:**

A reliable, proactive, and quality-driven external IP admin partner will enable you to bring strategic work and knowledge back in-house.

- **Centralize and Bring Consistency Across Organizations:**

By choosing a single partner, you can consolidate the entire international patent filing and prosecution process to achieve consistency, oversight, and cost control.

- **Modernize/Digitalize Existing Processes and Tools:**

Your chosen partner should not only support you with tech-driven solutions that reduce email correspondence, manual data entry, and duplication of effort but also enable you to centralize and automate IP docketing data and workflows in your preferred IP management system.

- **Create Immediate and Significant Cost Savings:**

Through economies of scale, transparent service charges, and proactive cost control, your chosen solution should deliver immediate and significant cost savings for your business.

- **Set Yourself Up for Future Success:**

Modernize and digitalize your processes today, and you will be ready to integrate and optimize future developments in technology and service delivery.



Why Select an End-to-End Partner for Foreign Filing and Prosecution?

Switching processes, suppliers, and technology should bring measurable outcomes, including but not limited to cost savings.

By choosing a single partner, you can centralize the entire international patent filing and prosecution process, saving you time and budget and delivering customer service, process, and risk mitigation benefits:

Customer service

- Single project manager per client supported by patent admin team;
- SLAs for response time, order confirmations, filing reports;
- Feedback is reviewed monthly for continuous improvement.

Robust process

- Flexible and adaptable internal client workflow;
- Repeatability, consistency, efficiency;
- Purpose-built docket with 20+ data points per filing.

Risk mitigation

- Three-eye policy for each filing instruction;
- Continuous docket monitoring (by automation and team members);
- Data verification and controlled process to verify filing and payment acceptance.



Reasons to Partner With Questel

Questel is a global leader in patent translation and foreign filing and a partner to the world's top applicants and IP law firms.

- **No. 1** foreign filer in the world;
- **50,000+** foreign filings/year;
- **15** of the top 25 PCT filers use Questel;
- **10%** of US priority filings by us;
- **50%** of top US PCT filers use us;
- **80%** of clients are Fortune 500.
- **No. 1** patent translator globally;
- **100,000+** patents translated/year;
- **1 billion+** words translated over the last three years alone;
- WIPO translator provider;
- ISO certified.

.....

- **96%** client retention rate for Questel's centralized model;
- **30%** cost saving, typically, on translation and foreign filings.



STEP 4: Overcome Common Obstacles to Change

Changing processes, suppliers, and technology can seem a challenging prospect to busy in-house teams. That's why it's so vital to work with a partner who can facilitate and support you through the transition and onboarding process.

We commonly see three main obstacles to change when working with clients:

- **Complexity:** Global operations are complex, so it's only natural to be risk-averse when changing the tools or suppliers you use to administer your valuable and sensitive IP rights. By taking the time upfront to select the right solution and service provider for your needs, you can be confident of a smooth and secure transition that enhances, rather than risks, your ability to efficiently manage your IP portfolio.
- **Fear of Change:** Clients may be dissatisfied with existing relationships/technology yet still rely on them to manage their day-to-day work. While it may feel tempting to put up with a familiar but far-from-ideal situation rather than risking the unknown of a new start, sticking to old-fashioned tools, processes, and suppliers will only damage productivity and performance in the longer term.
- **Time Concerns:** Busy IP departments and law firms may justifiably feel they don't have the time or resources to rethink or upgrade their international filing and prosecution processes. Antiquated and administration-heavy tools, processes, and suppliers can ravage available resources, leaving little time or appetite to onboard a new solution. However, this situation will never change if the root cause of administrative overload is not addressed.



Questel's Approach

Questel works with organizations like yours to help them overcome these and other challenges. We will support you in assessing your current operations, identifying potential hurdles in advance, and providing details on how to manage them effectively:

- **Complexity:**

With a long history of servicing demanding global patent departments, we understand the challenges of international patent management and will design a process for you that works to reduce this complexity while minimizing risk.

- **Fear of Change:**

This fear is valid in an industry where the loss of a patent right can have significant consequences. We can support you in administering the transition period in stages to reduce hesitation.

- **Time Concerns:**

The onboarding process is critical for managing this specific challenge. By including a discovery phase of your internal processes, you can ensure that your chosen service provider fits in with minimal or no disruption to your day-to-day operations.

STEP 5: Ensuring the Right Outcomes for Your Organization

From opportunities to make better use of internal resources to immediate and significant cost savings, global companies can realize substantial benefits by focusing on efficient resource allocation and proactive cost management.

Here are some of the key outcomes and benefits we provide to our international filing and prosecution clients:

- **1. Substantial Cost Savings and Greater Cost Control:**

Questel's cost containment initiatives for international patent filing and prosecution have resulted in **20-30%** cost savings for some clients without negatively impacting portfolio quality or existing agent relationships.

A Smooth, Secure Process

"Questel talked to me about foreign filings, how they could help me implement a worldwide flat fee schedule, and how they could audit once those fee schedules were in place. These were tasks I wasn't equipped to do myself, so I signed up!"

General Counsel, IP Operations

- **2. Consistency Through Centralization:**

Whether you consolidate the entire international patent filing process with Questel or specific services, such as patent translation, we help clients realize measurable consistency gains. Whichever partner you choose, make sure they help you to:

- Achieve consistent quality, rates, and service levels;
- Improve transparency, visibility, and tracking of expenditure;
- Reclaim decision-making control and oversight;
- Benefit from economies of scale; and
- Make significant cost savings.

We routinely save our large, multinational clients **20%+** in annual patent translation fees while maintaining patent translation quality at the same level.

– 3. Operational Efficiencies:

Our clients have realized major efficiency gains (and savings) by opting for Questel's comprehensive translation, filing, and cost management solution. By modernizing and digitalizing the entire workflow, internal teams can spend less time on administrative tasks, with team efficiency improved, in some cases, by a multiple of four.

Ease of Onboarding

"Onboarding was easy, with the introduction phase of the new process pretty smooth. The Questel team is highly skilled and very well structured to configure the transfer and provide ongoing support."

Choose a Flexible Partner Who Will Design a Solution for You

While modernizing and digitalizing your international filing and prosecution process will enable you to review and rethink your current workflows, you shouldn't have to adopt an off-the-shelf solution without room for customization.

The right partner should service your specific requirements—including integrating your preferred workflows, invoice formats/timings, and existing agent network securely into its processes—while still providing a single point of contact for translations and filing instructions.

Look out for an IP administrative specialist with change management experience, a dedicated client support team, and demonstrable experience coordinating international filing services to simplify and unlock added value for organizations.

Questel provides a complete range of IP services via a single point of contact in your time zone to streamline processes, optimize delivery, and improve quality and efficiency.

Thanks to our size and range of services, we can onboard large corporations and IP volumes, offer and integrate complementary services to our delivery model, and tailor-make solutions just for you. [Contact us to find out more](#)

A Case Study in Process Optimization and Cost Control

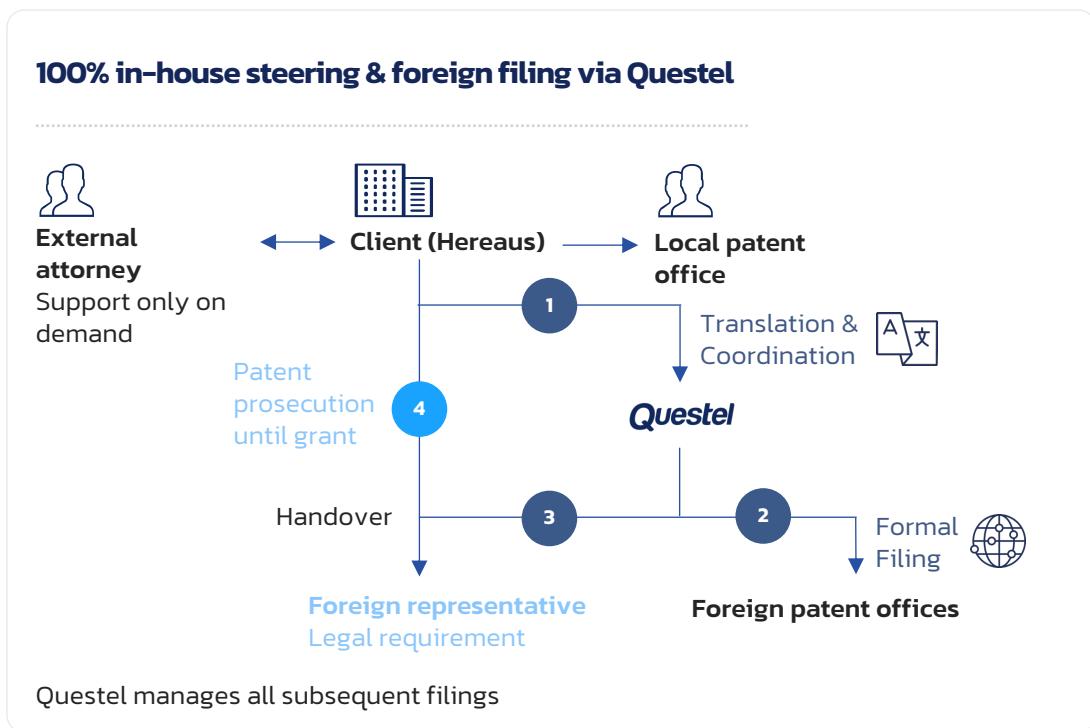
Discover how Questel's IP Cost Management solution enabled one client to save €500,000 in foreign patent filing and prosecution fees.

Global technology group Heraeus previously used external patent law firms to manage most of the international filing process for its sophisticated global patent portfolio. As bringing responsibility for foreign filing management back in-house was not a viable option for the company, it began to seek a different model that would enable it to control costs without increasing headcount or the demands on its internal team.

Solution: Efficient Resource Allocation and Proactive Cost Management

Questel tailored our comprehensive international filing services and proactive IP cost management solution for prosecution to enable Heraeus to achieve its objectives of efficient resource allocation and proactive cost management.

We created a one-stop-shop for formal filing so internal teams could focus on additional substantive work and supported cost-effective delivery through a multi-pronged cost management approach:



- **Structured/standardized Fee Schedule** to provide cost consistency across various jurisdictions, while seamlessly integrating with Heraeus's existing law firm relationships.
- **Automated Invoice Review Management** to simplify the in-house invoice process, so that IP Counsel only need to review half the number of invoices as before.
- **Invoice Audit and Compliance Monitoring** to ensure accuracy and ongoing adherence to fee schedules.
- **Data Reporting and Benchmarking** to improve budget management and deliver a comprehensive understanding of IP-related expenditures.

Result: Significant Cost and Time Savings

Heraeus was able to save €500,000 in annual foreign patent prosecution costs, including translations, by outsourcing its international patent filing program to Questel. This included saving €200,000 a year by successfully transitioning from full external representation without increasing headcount.

A Model for the Future That Was Over a Decade in the Making

The Heraeus–Questel collaboration offers companies a glimpse into an effective alternative to costly and resource-heavy approaches to international filing and prosecution that Questel has fine-tuned for over a decade. Through strategic planning and the application of innovative solutions, Heraeus not only realized significant cost savings but also improved its operational efficiency when managing international patent filings.

Find out more:

Discover more about Heraeus's journey to cost transparency by:

- [Reading the case study in full](#), or
- [Watching our joint presentation at IP Service World 2023](#).

STEP 6: Schedule a Call with a Subject Matter Expert

Find out how Questel's integrated IP Cost Management and International Patent Filing & Prosecution solution could also save you time and money.

Here are some of the key outcomes and benefits we provide to our international filing and prosecution clients:

- Read more about our [IP Cost Management](#) and [International Patent Filing Support](#) services.
- [Speak to a Questel Subject Matter Expert](#) about how to achieve substantial cost reductions for your own organization while maintaining superior patent quality.

Questel

Questel is an end-to-end IP solutions provider to more than 20,000 clients and 1.5 million users across 30 countries. Alongside our comprehensive software suite for searching, analyzing, and managing inventions, patents, designs, trademarks, and domain names, Questel also provides services supporting the IP lifecycle, including searching, watching, international filing, translation, renewals, and recordals. These solutions, when combined with our IP cost management platform, deliver clients an average savings of 30–60% across the entire prosecution budget.

www.questel.com