



## A patent portal

Jeff Shieh and Cara Verwholt discuss how inovia can help life science companies to reduce their costs and increase efficiencies when filing foreign patents

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### What are the benefits of using inovia's web-based technology for patent filers?

**Jeff Shieh:** There are many benefits for patent filers who use inovia's online portal. The

first is reducing the cost of foreign filings. If you take a look at the international patenting process itself, you'll see that foreign filing is highly administrative yet quite expensive, especially if you're filing broadly.

If you've filed a Patent Cooperation Treaty

(PCT) application, for example, entering the national stage requires filling out the proper forms, submitting any necessary documents, and coordinating with the foreign associates. Since there is often no substantive work involved at this stage, there is actually not much added value by having your patent attorney

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handle this part of the process, especially when a paralegal or secretary would perform the bulk of the work. I think that’s the number one reason why more clients are gravitating towards IP portals, for the cost savings that they can offer. Typically, we see cost savings in the 20 to 50 percent range for our clients.

We have a network of agents around the globe and have negotiated fixed fees with them due to the volume of work we send, so even if you only file a few applications per year, you’re getting pulled into the inovia client base and benefitting from our overall bulk buying power. And while clients can work with us directly or through their patent attorney, many of our clients find that the best way to cut costs is to work with inovia directly, and then re-engage their patent attorney at the prosecution phase where there is substantive work.

It’s important to note that inovia is not a law firm, so we wouldn’t be replacing a client’s patent attorney for that sensitive work done during examination. We step in at the filing stage to reduce costs and increase efficiency there.

**How does this technology benefit the life science industry in particular?**

**Shieh:** I have a background in biology. Before joining inovia, I was a patent attorney representing biotechnology and pharmaceutical clients and it seems that as a general rule in that industry, whether you’re a start-up or a large multinational, everyone wants to file broadly. When you’re filing broadly, the costs do add up. So a web-based IP portal is particularly relevant to pharma and biotech applicants looking to maximise their patent protection while keeping costs under control.

**What are the processes of patent filers not using this technology?**

**Shieh:** There are two ways that they may be handling foreign filing. Some companies may work with a local counsel, so if they are US-based company, they will work with a US law firm that handles everything from drafting the application through to the grant. For the filing stage, they will contact their local attorney to tell them which countries they want to file in. The attorney would then compile the necessary forms and coordinate with the foreign associates to get that application filed abroad.

Alternatively, some companies have in-house IP departments and will go through the same stages of filling out the forms and sending instructions to the foreign associates. The work will just be handled in-house versus by an outside attorney.

**Do you have life science specialists in every region?**

**Shieh:** This is relevant for every technology, not just life sciences. When you’re selecting your foreign associates, you want them to be an expert in your technology. You want them to be able to understand it and be able to argue coherently with the foreign patent examiner. We have a large list of criteria that we apply when selecting foreign associates around the world. We file applications in every technology area from mechanical engineering to pharma and biotech, so we need to make sure that our foreign associates are capable of handling any type of invention that we send their way. Our foreign associates must also be proficient in speaking English, as a lot of our clients are in the UK and the US.

Most of our clients file fairly broadly. We’ve handled filings of 30 countries or more, especially as our base of pharma and biotech clients grows.

**Do you have multiple agents in each region?**

**Cara Verwholt:** When we were founded more than 11 years ago, we did have a one agent per country model, because that allowed us to negotiate a favourable fee with our foreign associates. As we have grown, we have added multiple agents in some of the more popular jurisdictions such as Europe and China, to ensure that our agents can handle our growing volume of work. We want to make sure that we are prepared in case of a conflict, too.

**What other developments can we expect from inovia in the future?**

**Verwholt:** Our platform has changed over the last few years to meet our clients’ needs. First, we’ve grown our agent network, which now covers 130 countries around the world. We also allow clients to nominate their own foreign associates that they would like to file through using our platform. This can be relevant to larger biopharma organisations,

especially if they handle the filings in-house, as they may have foreign associates around the world that they would prefer to work with. For clients looking to cut costs, they will often use inovia’s foreign associates, but if a client comes to us and says it has an associate in South Korea that it’d really like to continue working with, our platform is set up to allow that. Or they can mix and match, using some of inovia’s agents and some of their own.

If a client does come to us and tell us that it wants to use some of its own foreign associates, all it needs to do is provide its foreign associates’ contact information and we will contact them directly to obtain their fee schedules, and then load that information into the client’s system so that it can obtain quotes and place orders with its agents of choice. **IPPro**



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