

Effective Outsourcing of Patent Searching

Steve Royle
Burlington House
25 November 2008

Agenda

- Introduction
- When to outsource
- Who to consider
- How to outsource effectively
- Summary
- Q&A

When to Outsource

- No internal search resource
- Internal resource is over subscribed
- Low value tasks
- Subject matter outside expert technical area
- Fresh Look

Who to Choose

- No professional certification (yet)
- Professional Indemnity
- Policy on conflicts of interest

Who to Choose

- Experience
 - Technical Area
 - Staff retention
 - Novelty vs Infringement

Who to Choose

- Flexibility of approach
 - Knowledge of resources, relative merits, filling the gaps
 - Willingness to partner
 - Balance budget, risk/quality/time available

Who to Choose

- Benchmarking
 - Create sample problems
 - Set the 'rules', ensure consistency
 - Carry out in the right spirit

Who to Choose

- Multi sourcing
 - Not over reliant on one source
 - Partners best suited to each type of work
 - Favoured partner & streamline later

How to Implement - Preliminaries

- Legal
 - Non Disclosure Agreement
 - Contract, including resolution of disputes
- Policy
 - What is 'fair game'
 - Communication path
 - Security of communication

How to Implement - Collaboration

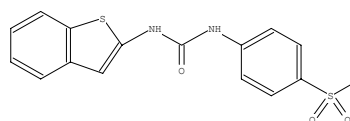
- Planning
- Interaction
- Coaching
- Internal resistance – time, know how
- Set aside time, how much are you prepared to give?

How to Implement - Planning

- Instruct with sufficient notice
- Detailed description of subject matter
- Specialist knowledge (keywords etc.)
- Known prior art
- Balance risk/budget – how broad?

How to Implement - Interaction

- Before search – defining scope
 - Example 1: FTO Search on following medicament



How to Implement - Interaction

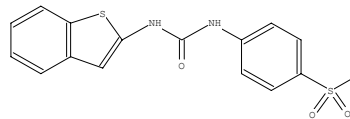
- Classification?

Medicinal preparations containing organic active ingredients

- Heterocyclic compounds
- • having sulfur as a ring hetero atom
- A61K 31/381 • • • having five-membered rings

>2000 PCT references

How to Implement - Interaction



- Structure Searches
 - How generic?
 - Use?
 - Synthesis?

How to Implement - Interaction

- Example 2: FTO Search on following formulation

Penfluron	Chitin Synthesis Inhibitor Insect Growth Regulator Chemisterilant Insecticide
Sipon LCS980 Methocel	Sodium Lauryl Sulfate MethylCellulose (or HPMC?)

- Application: Bathe? Spray? Spot-On?
- Use: Pets? Farm Animals?

How to Implement - Interaction

- During search – refining scope, report style
- After search - feedback

Summary

- Deloitte Consulting 'Calling a Change in the Outsourcing Market' (April 2005)
 - Contrary to the optimistic portrayal of outsourcing by vendors in the marketplace, outsourcing is a very complex process and anticipated benefits often fail to materialise
 - Instead of simplifying operations, outsourcing often introduces complexity, increased costs and friction into the value chain, requiring more senior management attention and deeper management skills than anticipated
 - Companies that apply strong skills in deal structuring and risk management together, with strong operational management skills to oversee deals from inception to execution, will be best positioned to reap the benefits of outsourcing.

Summary

- Outsell 'The Changing Roles of Content Deployment Functions: Outsourcing Secondary Research' (March 2004)
 - To establish the full cost to your organisation, it is important to estimate the full impact of the time and skills required to manage the contract, conduct quality assurance, monitor results, provide feedback and address any issues that may arise.
 - An outsourcing relationship is not a commodity – it is really a collaboration or partnership and will require 'care and feeding' to make it work. Building in sufficient management attention and effective communications into the relationship are key.
 - Ensure that the vendor has staff, who possess the appropriate skills and research knowledge to tackle the work to be outsourced. Strict confidentiality and non-disclosure agreements are *de rigueur* and take into account conflicts of interest.

Summary

- Outsell 'Information Management Best Practices: Navigating Outsourcing and Offshoring' (July 2005)
 - Provide the prospective firm with a variety of projects of the type they'd be expected to complete, and then evaluate their deliverables against your quality standard, before entering into any binding or long term contracts.
 - Expect to spend money and management time establishing the outsourcing relationship.
 - Be prepared to put a significant effort into getting offshore workers up to speed.
 - Clearly define quality expectations and service parameters (turn around times, degree of analysis vs data dump, look and feel of deliverables, usage reporting etc.)

Thank You

Questions?

sroyle@perquisitum.eu