

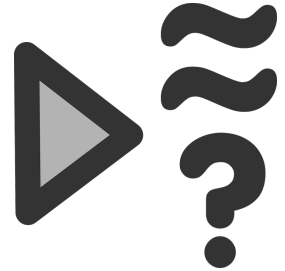
# Foreign Patent Prosecution Practices

Welcome to the Foreign Patent Prosecution Practices Results. This report reflects a diverse group of twenty-two patent-driven global companies.

Foreign patent applications may be filed in various ways, including national patent applications filed in each country, a regional European patent application covering certain designated European countries, filing under the Patent Cooperation Treaty (PCT) or European Patent Office (EPO), and various combinations thereof.

In addition to identifying advantageous jurisdictions to protect your inventions, there are many options for foreign filing. IP leaders must consider several factors when deciding their approach to handling their foreign prosecution. This survey was designed to explore the key considerations and identify the prevailing and best practices.

This foreign patent prosecution practices survey indicates that most participants seek protection in numerous jurisdictions. PCT and EPO filing options are increasingly being used.



## Report Outline

Introduction and Key Findings

### Participant Company Profiles

In which of the following industry categories does your company have a significant line of business?

How many original, priority patent applications are filed annually?

On average, in addition to your company's priority or original patent filings, for how many countries per patent case do you seek protection?

### Accelerated Examinations

What percentage of cases did you request/take to accelerated examination?

Which of the following accelerated examination programs do you use?

What are the common reasons you request an accelerated examination?

How often do you have your US or domestic law firm instruct foreign counsel to respond to a foreign office action?

Does your company review instructions developed by domestic outside counsel or provide instructions to foreign counsel to respond to an office action in a foreign country?

How often do you abandon (not respond to office action) a patent application during foreign prosecution?

How often do you use a third party to file your foreign applications where the third party differs from the foreign counsel prosecuting the foreign application?

Does your company's local/domestic IP law firm oversee foreign prosecution?

### PCT and EP Filing Strategy

Do you file PCT or EP applications?

What are your primary reasons for filing PCT/EP applications?

What percentage of your company's PCT cases entered the national phase?

What search authority do you use for your PCT applications?

What examination authority do you use for your PCT applications?

What is the primary reason for selecting a search/examining authority?

What are the most significant challenges you have faced in your foreign patent prosecution practices?

## Related Best Practices Studies and Materials

- Inventor Rewards and Recognition Programs
- International Inventor Remuneration Practices
- Invention Harvesting, Review, and IP Decisions
- Patent Intelligence (Research and Analytics–People, Processes, Tools, and Services)
- IP Strategy Development Practices and Performance Measures, Driving Business Results
- IP Law Department Budgeting and Cost Management
- Trade Secret Management and Protection Practices
- Intellectual Property Legal Process Outsourcing
- Patent Preparation and Prosecution Quality Practices
- Patent Translation Practices
- Foreign Prosecution Practice
- Intellectual Asset Management Software Satisfaction
- Intellectual Property Training Best Practices
- Intellectual Property Management Guidelines–Standard Operating Procedures
- Best Practices Videos and Templates
- Intellectual Property Technology Valuation Guidelines
- Developing an Inventor Rewards and Recognition Program (with templates)
- IP Training Courses
- IP Knowledge Diagnostic
- IP Culture Diagnostic
- IAM Program Proficiency

## About ipPerformance Group

ipPerformance Group, Inc. ([www.ipperform.com](http://www.ipperform.com)) is the leading intellectual property advisory and benchmarking firm. Drawing on the knowledge of over 550 intellectual property management benchmarks of Global 2000 companies, we help our corporate clients solve common and complex intellectual property business problems and measurably enhance their ability to build value, manage risk, and improve performance in intellectual property–driven world.

Our **technology solutions services** help clients improve their productivity and decision-making with management and analysis software. Our **strategy services** help clients assess their intellectual property management process, performance metrics, staffing (roles and responsibilities) against peers, and best practices to effect strategically business-aligned programs. Our **research services** conduct extensive benchmarks focused on intellectual property operations best practices. This research has enabled corporate leaders worldwide to measure performance and identify improvement opportunities.

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