



Dr. Volker Spitz

# Savings: Does outsourcing really save time and money?

If you have been thinking about outsourcing your trademark renewals to an external provider, there are a number of questions that need to be addressed reflecting the concerns that many trademark owners have about how outsourcing works in practice. Dr. Volker Spitz, Brandstock, has set out a selection of questions he most often encounters from clients in relation to this matter.

**W**hen renewals are managed in-house, one or more people are needed to follow up with agents, set reminders, monitor deadlines, and so on for multiple marks in multiple countries around the world. It makes sense to shift this administrative burden to an outside provider, freeing up in-house resources for higher value work, as long as there are measurable benefits.

Outsourcing can save you time in two principal ways:

- 1) Providing a single senior point of contact who takes an active role in managing your renewals and to whom you can delegate responsibility with confidence.
- 2) Giving an online platform that provides you with an 'at a glance' view of progress with all your renewals and from which reports can be generated easily.

You can save money as you benefit from the volume-based discounts negotiated with agent networks. Without exception, clients make an overall cost saving by moving their in-house renewals administration.

## **Cost transparency: How will you know whether you are being charged correctly?**

If invoices have a single amount for each renewal with no breakdown (into official fees; agent fees; and provider's

service fee) then how can you check whether a charge is correct?

For those clients who want to be able to audit invoicing, a complete breakdown of charges for each renewal should be provided. With regard to foreign exchange charges, agent and official fees are treated as disbursements and so the costs passed on to you are what are paid when those disbursements were settled.

## **Invoicing: How will we be billed for the work?**

When handling renewals in-house you must manage all the invoicing from agents for individual renewals. You want to know that invoicing from your renewals provider isn't just replacing one burden with another.

The vast majority of clients prefer to be billed quarterly and you should ask your provider to adjust to your billing cycle and format to suit your specific needs.

## **Documentation: Will the provider prepare all the documentation necessary for the renewals process?**

The document requirements for renewals vary, and this makes up a large part of the work involved. Preparing and executing powers of attorney and affidavits of use, as well as the legalization and notarization processes, can be incredibly time consuming; not least, because getting these documents right is vital.

All of this administrative burden should be taken from you.

## **Agents: Would the provider be willing to work with our agent network who already knows our portfolio?**

Each provider will of course have their trusted network of agents, but wouldn't that mean losing the investment made in educating firms you have been dealing with,

## Résumé

### Dr. Volker Spitz

Dr. Spitz is specialized in German, European and International trademark, design, patent, competition and contractual law. He founded his first company in 1993. Today the Brandstock Group of five companies provides services in Legal, IP-Services, Valuation and Domains. The Group has more than 150 employees in six different countries and a network of 250+ agents.



particularly those in key jurisdictions? Is it possible to keep some or all of your agents for renewals?

Many clients are happy for providers to work with their own network who are familiar with working standards and technologies. Others value the relationships they have with their agents and would prefer not to let that go, even for renewals, and so it should be possible for you to work with your preferred agents in territories that you choose.

**Access to data: If we use an outside provider are we still going to have ready access to documents and information?**

You never know when you may need a copy of a filing receipt or a certificate; for example, for litigation or customs purposes. You want to be sure that up to date information and documents are going to be available to you and without being charged to access it. Online platforms make all data available to you at all times, showing you the status of renewals and related documentation which can be downloaded as needed and without charge.

**Other services: Will the provider be pro-active in addressing additional tasks in the course of the renewal process?**

It is not uncommon at the time of renewal to find that a registration is not quite up-to-date. For example, a change in ownership may be

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missing or an address not recorded. You want to know that these things will not be missed. Problems are noted and providers will take the initiative when dealing with them. You should ask for a dedicated project manager who will alert you to issues and make costed recommendations as to how they can be dealt with.

**Managing risk: How confident can we be that renewals will not be missed?**

While it makes sense on a number of levels to outsource discreet and largely administrative procedures, you want to be sure that your chosen provider will take every precaution to ensure that not one of your trademarks is put at risk. Just because a provider deals in large volumes of renewals does not itself provide assurance. Providers should work to the most exacting standards. Renewals teams should be thoroughly trained and take the greatest care possible to prevent errors.

**Data transfer: How will we keep our in-house IP management system updated?**

If you have an in-house IP management system then you need to keep it up to date in relation to renewals, preferably without having to carry out the data entry. An optional part of a service should include updating your in-house system, either direct (with secure access allowed) or by delivery of compatible files which can be uploaded to your system.

**Onboarding: How will we manage the handover to an outside provider?**

This could be where things go awry, and the last thing you want is for anything to slip through the net while everything is passed across to your chosen renewals provider. How will this be handled and how can you be sure it has been done properly?

Maintaining a well tried and tested process for onboarding new clients, which ensures a smooth start to the renewals process.