Rational Decision-Making in Protecting an Invention

by Ray Meiers

An idea that appears new and commercially valuable should be evaluated for intellectual property protection. A patent is one example of intellectual property protection available for ideas that have been put into practice; an idea becomes an "invention" by being put into practice. Unfortunately, the owners of inventions are often encouraged to seek a patent without a rational basis for doing so. This article provides counsel to assist the owner of an invention in determining if pursuing a patent on an invention is economically justified.

Step 1: Confirming the State of Technology

Existing technology in the field of your invention is referred to as "prior art." Searching the prior art for previous technology that is similar to your invention should be the first step when deciding whether or not to seek a patent. In particular, you should be able to identify the exact differences between the prior art and your invention. Why search first?

- You may discover that your invention has already been invented.
- Even if your invention is not precisely found in the prior art, you will likely find technology that is similar to your invention. This knowledge will help you develop a more pragmatic appreciation of the extent that your invention improves existing technology.

- The previous technology you discover during searching will inform subsequent actions, such as determining how economically valuable the invention might be.

The prior art search can be carried out in numerous ways.

- Lowest Cost Level: Self-searching on the Internet. Search engines are available at the U.S. Patent and Trademark Office and Google™.
- Intermediate Cost Level: Hiring a non-legal search professional. These professionals can be found on the Internet. The most cost-effective search strategy is to retain a search professional.
- Highest Cost Level: Retain a patent attorney.

Step 2: Commissioning a Useful Patentability Opinion

If the results of the search indicate that your invention is not disclosed in the prior art, the scope of possible patent coverage for the invention should be determined. A patent attorney is required for this task. The patent attorney reviews the prior art found in the search (by you or your search professional) and identifies the scope of possible patent coverage in a "patentability opinion" including a representative patent claim to the invention.

A patentability opinion that merely states "the invention is patentable" or that the invention is "broadly patentable", without providing a representative patent claim, fails to facilitate a business analysis of whether or not to seek the patent. A patentable invention is not necessarily a valuable invention. For example, if a broad patent covers an invention that cannot be manufactured within commercially acceptable costs, it is not especially valuable. On the other hand, a narrow patent covering an invention that yields a small cost savings on a product that is manufactured in high volumes could be very valuable.

The scope of possible patent coverage, within the context of the market conditions, drives the economic value of the

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invention. Both factors cooperate with one another like lenses of a telescope to enable you to see how valuable the invention might be. Apart from one another, neither factor is useful in deciding if a patent is economically justified. Only a representative patent claim can indicate the scope of possible patent coverage with sufficient precision to assist you in a business analysis of whether or not to seek the patent.

Step 3: Identifying the Limits of Patent Protection

The representative patent claim provided by the patent attorney should be tested for the potential that competitors can "design around" your patent. A competitor designs around your patent by producing a product or process that does not fall under the language of the representative patent claim, but is an acceptable substitute to your invention in the eyes of the customer. In a worst case scenario, the competitor's design-around product fulfills the customer need just as well as, or better than, your patented invention.

You can test the likelihood that a competitor could design-around your patent by carefully examining every word in the representative patent claim. Certain words that may be necessary to obtain a patent may not be necessary for making an acceptable substitute for your invention. If such words exist in the representative patent claim, a patent would not adequately preclude competition and is not worth pursuing.

Conclusion

A patent can be a powerful business tool, but should not be pursued without due diligence. You can carry out a reasonably precise analysis for determining whether to seek a patent in order to avoid wasting resources. Understanding what the invention adds to existing technology, obtaining a precise opinion on the scope of possible patent coverage, and then testing the limits of the possible patent coverage represents a metered and cost-effective business approach towards assessing patent protection for an invention.

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