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### Intellectual Property: Dynamic Intellectual Property Strategy: The Telescopic View (6/06)

By: William Greener, *Ithaca Business Journal*, (6/21/06)

This is the first in a series of articles about Dynamic Intellectual Property (IP) Strategy. By this I mean formulating an IP strategy in relation to business objectives rather than performing singular transactional events, like filing a late-stage patent application. To keep things simple, let's limit our IP to patents, with the understanding that the intellectual property field covers trade secrets, trademarks, copyright, technology transfer, licensing and other legal areas.

Let me introduce my telescopic view of patents. To aim and shoot effectively, you have to know where to look and how to obtain a crisp image of what you are looking at. Should we approach our business strategy any differently?

Focus your telescope on two important business considerations: the competitive landscape and prospective customers. If you believe that customers need a new or improved product, it makes economic sense to be able to control as much of that market as you can. This, of course, requires knowing what the competition controls and where there is white space. Once you collect and analyze this data, it can be used for all aspects of business planning including building a patent portfolio.

A patent attorney should be a team member of a burgeoning business. A patent expert can perform competitive surveillance to identify the other players' strengths, and analyze the scope and boundaries of their proprietary interests and exclusive footholds in the market place. One useful tool of the patent lawyer is a state-of-the-art search. This can be geared to a general class of goods and/or services, or be focused on a particular product area. The subsequent report is akin to a map that identifies product landmarks.

If you suspect that a particular customer base needs a new product or improvement, the patent lawyer may suggest conducting a patentability search. A patentability legal opinion will inform management whether your new or improved product is patentable, and if not, how it might be redesigned to make it patentable. The value of a patent is in its use to exclude others from making, using or selling the patented product. If it is the customer's product of choice, then the patent holder has economic control. A planned patent portfolio can extend the scope of that control.

Having a patent, however, does not give the owner any right to make, use or sell the patented invention since it provides no shield against infringing someone else's patent. Another tool to consider is an infringement search and opinion from your patent attorney. This opinion will advise you of the infringement risk (i.e., potential lawsuit liability) associated with your product.

These important tools can (and should) be used before significant money and resources are committed to product or market development that seems so clear in the distant view of the telescope. Of course, these activities have their own significant costs. We all know that patent attorneys, like precision telescopes, do not come cheap. The take away point, though, is that this kind of early stage activity will inform an intellectual property strategy that drives a sustainable business. In part this means that these costs can be integrated into sales that generate a net profit. The telescope allows your business to keep its other eye on the bottom line.

In the next article I will talk about how much these IP tools cost, and why. Future topics will include US and international patent strategies, the effects of the changing US patent policies, and other topical aspects of dynamic intellectual property strategy.

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