

## More Than Smart

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Remember Bill Clinton? Maybe the smartest President in living memory, ex-Rhodes scholar, ex-Yale Law School – brilliant. Yet he nearly lost his presidency because of an incredibly stupid act with an office intern. Among other things, that act demonstrated the difference between intelligence and good judgment.

Being smart is not the same as having good judgment. The inventors of a fabulous new invention are very likely very smart. And hopefully their patent attorney is smart in his own way about patent things. But between them somewhere good judgment needs to come into play.

What is good judgment? I think it means making good decisions. A good decision demonstrates and is an act of good judgment. And over the life of a patent, there are, as we say, “a plurality of decisions” that arise.

The first decision and the first opportunity to demonstrate good judgment is whether and when to file a patent application in the first place. That simple question can involve a lot of factors, each of which needs to be considered and given appropriate weight in order to make a good decision and demonstrate good judgment. And the issue really is not about how smart the inventor is, that can be accepted as a given based on this brilliant new invention in the first place. Instead, the question is, does it make sense to seek a patent for the invention?

So, how new is the invention? If it is not new enough, everyone is wasting time and money on a patent. And what is a reasonable guess as to the potential value of a patent on the new invention? Would the patent be directed at blocking competition? Or at creating licensing revenues? How hard is it going to be to prepare claims, a description, and drawings for a patent application? Is there an appropriate budget for such an exercise? Unless the answers to these questions are reasonable, seeking a patent may be just an expensive waste of time and money.

Another test of judgment around this time is where to get a patent: just the United States? How about Europe, too? Japan? What about Canada and Australia? China? Fortunately, the United States, Europe, and most other countries are members of the Patent Cooperation Treaty which permits a single patent application to serve as the basis for a patent in the member countries. But it is a long expensive process and it quickly costs several thousands of dollars in fees just to file a treaty application. Moreover, once the treaty application enters into the various national patent offices, foreign patent attorneys need to become involved and a lot more fees.

So the question is, what is your best judgment as to the potential value of a patent on a given new invention? Is it worth increasing your costs many times over to get patent protection outside the United States? If you believe that the invention is really valuable, it makes it easier to swallow those foreign filing costs. But often the potential value of a patent for a new invention is hard to know early on. Preparing and filing a U.S. patent application can be a reasonable cost option under those circumstances, but is it really worthwhile to commit to all those foreign costs? If the invention turns out to be really valuable, you'll be wishing you had protection in Europe and Japan (and maybe elsewhere, too). But if it turns out that the invention never really amounted to much, you'll be regretting those foreign costs a lot. It's a tough call. There are no simple thumb rules, but whatever decision you take reflects your best judgment at the time and you are stuck with the consequences.

The point is that this whole process is not really about intelligence so much as judgment—the ability to make good decisions about whether, when and how to file and pursue a patent application. In fact, most patent-seeking businesses inherently understand and respect this dichotomy between intelligence and judgment in that the smart guys who are the inventors are typically not the decision-makers about handling patent applications. Rather, the patent decision-making falls to other internal positions set up for the express purpose of using good judgment and making good decisions—in-house lawyers and financial types.

So, dealing with patents intelligently is about more than being intelligent, more than understanding complicated new technology. It is also about weighing many complicated and inter-related factors to make good decisions that reflect good judgment.

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