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Business Viewpoint with David Woodral: When seeking a patent, communication is key

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Business Viewpoint by David G. Woodral

Businesses whose revenue streams depend at least in part on developing new or improved products are generally aware of the importance of protecting their intellectual property. Most also have a grasp that the utility patent, which grants a form of limited, legal monopoly for a limited period of time, offers the most protection for products that can be easily copied once they are on the market.

However, while a patent application is required by law to disclose all the important details of the product or invention, the actual scope of coverage provided by a utility patent can vary wildly.

The degree of involvement and communication between business units and those drafting the patent application can have a significant impact on the relevance of the protection ultimately afforded by a patent. If an idea or product is presented for consideration as an isolated event, divorced from context, a narrow patent directed only to the isolated disclosure is all that can reasonably be expected. It is currently quite difficult to convince the patent office to issue a broad patent based on a narrow application.

Some large corporations or those with substantial resources to expend on patent acquisition have made the decision that quantity trumps quality. That is, many patent applications will be filed and each individual patent application may be directed to a single facet of a product or product line. Many of these applications will not issue, and those that do issue will be of very limited scope. Nevertheless, the odds are that from time to time the planets will align and a truly valuable patent will arise from this process.

But, not every business has pockets deep enough to sustain this approach. Small to midsize companies, startups, and any company looking to maximize return on every dollar invested in the patent process may find that involving their patent attorney on a per-project or per-product basis rather than providing only sanitized disclosures can allow the attorney to use his or her best judgment to prepare an application that will encompass the finer points of the product as well as the big picture. Further, to the extent the patent attorney can be made to understand the business and marketing goals for the product at hand, the more likely the patent will be to serve the business well.

Once a patent application has been filed, new matter can no longer be added. This is one reason that competent counsel who are familiar with the business and its goals for the project can provide a patent application the best odds for success. Keeping patent counsel in the loop after filing can sometimes allow the scope of the patent to be altered favorably during the prosecution of the patent.

If a project alters course after an application reaches the fortunate position of having claims allowable, it may make more sense for patent counsel to file a continuation or divisional application to keep the most important subject matter within the scope of the application without abandoning any hard-won allowances.

A related benefit of a close working relationship with patent counsel is that, over time, the attorney or firm develops an "institutional knowledge" that is quite valuable to a client that regularly engages in the patent process. Costs for future patent applications can decrease without a commensurate degradation in quality as attorneys who have become familiar with the business and product lines can build upon this knowledge in preparing applications.

Protecting intellectual property via the patent process is neither an easy nor inexpensive endeavor. However, there is no more powerful way to protect most kinds of innovation and reach the highest level of IP protection than a well-crafted patent resulting from a detailed, yet broadly claimed application.

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The views expressed here are those of the author and not necessarily the Tulsa World. To inquire about writing a Business Viewpoint column, email a short outline to Business Editor Colleen Almeida Smith at business@tulsaworld.com. The column should focus on a business trend or outlook for the city, state or an industry.