

How to evaluate new inventions and technology To Patent or Not

Pacyinz Lyfoung:

My name is Pacyinz Lyfoung, I'm the Executive Director for PIIPA, Public Interest Intellectual Property Advisors. This first session will discuss to patent or not.

So, this consists of three enquiries...

First, patentability.

Second, cost benefit analysis.

And third, an examination of several considerations.

Patentability:

This looks into whether there are enough claims to protect a product or product line.

The first step would be to search the literature (past and published pending patents) to make a determination with relative certainty.

For that purpose, a team consisting of a professional search librarian with one of the inventors working side-by-side would be helpful.

If potentially important prior art is found, then a patent agent can be added to the team to evaluate the significance of a prior art and the likely claims that would still be available.

It would be important to pay attention to dominant patents.

The process will also help to evaluate whether there will be broad claims.

The patentability search will also look at whether it is too early to patent, as the patent can expire before the product reaches the market.

In this process, an assessment will also be made whether the field is moving so fast that patenting is irrelevant as the innovation becomes obsolete.

Finally, it helps to assess whether the patent can be easily enforced, meaning: can infringement be easily detected?

The next step involves a cost benefit analysis

This will look at whether patenting would generate sufficient revenues to either attract an investor or justify the expenses of patenting. It will look for answers to questions such as:

Are there sufficient time and resources to complete a market study? Especially when, for example in academia there may be policies to not delay publication.

There may be confidentiality requirements before patenting that will limit the depth of the market research.

The more innovative the invention, the harder it will be to get good market feedback as it is not easy to judge the value of something that has never been seen before.

Finally, the last step of the patentability process involves looking at several considerations, such as:

Looking at the market:

What need is there for the invention? Is it a major or a minor need? Is it a small or a large market? Is the market established or will the market need to be developed? Is the invention going to be taking place in a growing field or in a dying field?

Another consideration would be to really look at the technology itself:

How would the new technology change how the market meets the need? Is it a new and better technology? Can there be a demonstration of the technology given to the investor or licensee? How long and how much money [is needed] to develop the invention into a commercial product?

The next consideration relates to the inventor:

Is the invention in her area of expertise? What are her business connections? Is she famous? Does she have realistic expectations? Can she handle working with investors/licensees without being too naïve or too paranoid?

Other considerations would include other factors, such as...

Social Responsibility:

Is it better to patent or leave the invention in the public domain? Would early IP protection mean more investment to develop the invention faster? Would early IP protection and related exclusivity prohibit exploring other applications for the invention?

Public Interest is also a consideration in patenting:

Is the invention self-evidently useful and widely used without patenting? Is there the dual option to get revenues from non-exclusive licensing and allow some public use? If patented to cover the costs of development and scaling up, is it possible to carve out affordable access for targeted beneficiaries? Could you require sublicensing to meet the needs of developing countries? Can aggregation through patenting and limited licenses create a sufficiently profitable market that will encourage development and clinical testing for drugs and vaccines?

Finally, there are many local considerations that depend on the institution and the geographic location:

Is the invention needed to promote local benefits, even if there are no global benefits? Does the invention meet local government objectives and funding priorities? Is it a decision about creating a new treatment even if the market is small and localized?

Note that sometimes a sin of omission might be worse than sin of commission, as it might chill innovation. This concludes the first session on whether to patent or not.

The next video will look at whether to use an existing company or a spin-off company.