Initial Patent/Trade Secret Evaluation

A reoccurring question in IP management involves the initial election between seeking patent protection on a given development and attempting to maintain trade secrecy in that development. To facilitate this initial election and to determine the center of gravity (often patents for products and trade secrets for processes) I developed the following "Initial Patent/Trade Secret Evaluation Questionnaire. To avoid the implications of "invention" and to cover the wide variety of innovations which may be addressed by this questionnaire, the term "development" is used in a generic sense.

INITIAL PATENT/TRADE SECRET EVALUATION QUESTIONNAIRE

		Scores
1)	Is development itself likely to be a commercial product or the subject of licensing?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ Likely Unlikely
2)	How much of a competitive advantage would be provided if the company maximized exclusivity?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ Very Great Very Little
3)	How much of a competitive disadvantage would it be if a competitor obtained exclusivity?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ Very Great Very Little
4)	Is it likely the commercial significance of the development would be limited in time?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ Yes-Limited No
5)	Is it likely one could develop alternatives ("design around")?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ Unlikely Likely
6)	Can nature of development be ascertained from commercial product ("Reverse Engineered")?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ Likely Unlikely
7)	Would disclosure of this development require or permit access to other, unprotectable information?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ No Yes
8)	Is it likely others will independently arrive at the same development?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ _ ___ Likely Unlikely
9)	If a patent were obtained what are the changes of validity being upheld by a court?	1 2 3 4 5 6 7 8 9 10 _ _ _ _ _ _ _ _ _ __ ___ High Low

10) Is it likely that dissemination of the development from within the company would be difficult to control?

1 2 3 4 5 6 7 8 9 10

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Yes-Difficult Not Difficult

11) Would it be difficult to determine if competitors are using the development?

1 2 3 4 5 6 7 8 9 10

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Not Difficult Difficult

Total _ _ _

The eleven questions in this questionnaire have been arranged not in the order of perceived importance but by "function," roughly following the areas of marketing (Questions 1-4), technical (Questions 5-8), and legal (Questions 9-11). Each question would be answered on a scale of 1 to 10. These values are then totaled. With the current number of questions, this sum would range from 11 to 110. The lower values have been assigned arbitrarily to patents, the higher to trade secrets. If the sum approached the higher end of the scale (above about 75), trade secret protection would appear to be favored; a sum at the lower end (below about 45), patent protection would appear to be preferred. Inevitably, values in the idle (45-75) would be encountered, which probably means it doesn't really matter which approach is followed initially as a possible center of gravity, as for example, trade secrets for manufacturing process technology, which it is easier to recreate, and patents for products that can be analyzed or reverse-engineered, without prejudice to resorting conversely to patents or trade secrets to protect collateral aspects and improvements.

The following notes for each question will be helpful in scoring answers.

Q1) If the development is likely to be commercialized or licensed, patent protection would seem preferable to trade secret protection. There might be some exceptions (such as the Coca-Cola® situation) but presumably these would be limited to situations where the nature of the product could not be easily ascertained by reverse engineering (see Question No. 6).

Note that the question pertains to commercialization of the development itself. Thus the mere use of a process to produce a commercial product is not commercialization of the process (cf Question No. 4 — "commercial significance"). The desirability of patenting the process itself would depend on answers to questions 2-11.

Q2) Question 2 attempts to ascertain whether exclusivity on the development would be meaningful commercially. A development of marginal commercial importance might be better kept as a trade secret. One which provided a significant commercial edge, however, probably should be patented.

Q3) This addresses the reverse problem, namely the defensive value of a patent publication. Hence while the development may be of minimum commercial advantage to the company, thereby favoring trade secrets, a patent (or publication) should be considered if a competitor's exclusivity would be disadvantageous.

Q4) This is a difficult question which might be eliminated. Some writers have suggested the short commercial life of a product favors patenting whereas a long life favors trade secrets. In the writer's view, this is not a particularly useful criterion since it depends on factors unrelated to the development itself. It also is extremely subjective.

Q5) The ability to "design around" is a function of how basic patent protection would be. If a claim is easily avoided, its value is considerably reduced. The destructive effect of trade secret protection by publication is unchanged. The relative value of the trade secret option thus is increased (as a result of the decrease in the value of patent protection).

Q6) Counterbalancing Question 5 is the consideration of whether, if the trade secret route is chosen, a competitor nevertheless will be able to ascertain the nature of the development from the product. If so, patent protection would be favored.

Q7) This is an often overlooked but important consideration. For example, a required disclosure of a culture collection deposit number could provide competitors with access to the culture itself which access might greatly outweigh the value of patent protection. A disclosure of an unclaimed process or intermediate on a final product similarly might have a bearing on whether the final product should be patented.

Q8) Evaluating this possibility could be extremely difficult in many cases. If, however, it is known that others are working in the field, it would seem quite probably that they will arrive at the same development, the consequence being possible exclusion if patent protection is not sought.

Q9) Even though patent protection might be indicated for other reasons, this could be counterbalanced by the fact that any coverage eventually obtained would be weak. A weak patent which is ignored by competitors and on which the company is not willing to sue is as good as no patent. In fact, it may be worse since the opportunity for trade secret protection has been irrevocably lost through publication.

Q10) Ideally, the dissemination of information from within the company is controllable. If not, however, a trade secret might be lost. If this risk exists, as for example where numerous employees, visitors, suppliers, etc. have access to the development, patent protection is more attractive. The same question arises with scientific publications.

Q11) This question is related to Question 9 but goes to the issue of inherent enforceability rather than patent strength. If detection of infringement would be extremely difficult, the ultimate value of a patent would be reduced and again that reduced value must be compared to trade secret destruction by the patent publication.