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Confessions of a "Recovering Patent Attorney" or Why I Have Joined the Growing Ranks of IP Strategists

I often facetiously refer to myself as a "recovering patent attorney." This somewhat tongue-in-cheek phrase seems appropriate to my present professional state of mind because, after many years of drafting and prosecuting patents for clients of all sizes and degrees of sophistication, in the end, I became disillusioned with the way the patent business traditionally operates.

Too often, I found that the patents I worked so hard (and was paid handsomely) to obtain failed to serve my client's business needs. In searching for the source of the disconnect between my efforts, the client's expenditures and the ultimate value of the patent to my client's business, I realized that those responsible for the client's business often did not participate adequately in the patenting process. Instead, at many organizations, inventors and patent attorneys served as the gatekeepers for most patent decisions. While the relevant client business unit typically held some say in patenting decisions, at many companies, the process effectively operated within a R&D/patent attorney "silo."

Upon reflection, I found this situation akin to the proverbial "fox guarding the hen house" because those with the most riding on the patenting process *i.e.*, R & D managers and patent attorneys, held *de facto* decision rights as to their company's patents. Patent decision-making at many corporations seemed therefore to often rest on the perceived

scientific value of the invention covered by the patent, not whether a patent for that invention served to effectively execute on the client's business strategy. In short, many patents that I obtained covered cool ideas, but were nonetheless effectively worthless to serve the client's business needs.

Unlike many who become disillusioned with their professions, I chose not to leave the patent business but, rather, to try to change the system from within. To this end, I joined the growing ranks of patent and intellectual property professionals who refer to themselves as "IP Strategists." In such a role, I now work closely with business and innovation managers to ensure that corporate patent decisions are based on whether a patent supports the business first, irrespective of how revolutionary the underlying invention might appear.

In contrast a traditional patent attorney role, an IP Strategist focuses not on the patentability of the invention and in reaching a successful endpoint to the patenting process. An IP Strategist instead focuses first on the business goals of the client. In this framework, if a patent indeed supports the client's business goals, the IP Strategist will work with them to effect cost appropriate patent protection. But, if a patent will not align with their articulated business strategy, the IP Strategist will recommend that the client pass on filing for protection, even if the issued patent would protect a "game-changing invention." Put simply, a game-changing invention that is not in alignment with the client's business results in a client wasting resources for a game in which the client does not play. Logic then dictates that the client has no business spending money to protect that invention.

When put in these terms, my clients quickly recognize that their organization likely wastes considerable corporate resources obtaining patents that do not ultimately provide payback to their business. Their decision to hire an IP Strategist therefore almost immediately results in cost savings typically far exceeding the modest cost of hiring someone like myself. Moreover, by making the threshold question in patenting "how would patenting this invention support our business strategy?," as opposed to "is

this invention patentable?," clients also quickly recognize that spending a bit on strategic patent planning better ensures maximum overall protection for their company's products and technology.

Please note that I do not wish to be seen as being critical of my patent attorney colleagues. I have the utmost respect for these highly trained professionals who work hard to obtain patents for their clients. Indeed, until recently, I made my living as a patent attorney and I still count a number of patent attorneys as among my closest friends. Nonetheless, a patent attorney's job is not to provide business advice to their clients. Rather, as a specialist operating in a complex business environment, and once the client directs them to move forward with obtaining a patent, a patent attorney must keep her eye on the patenting process. It is the client's role to provide business direction to their patent legal specialists, not the other way around.

By way of logistics, as an IP Strategist, I work with my corporate clients before the process gets under way to validate the business appropriateness of their organization's patenting decisions. Patent attorneys then handle the day-to-day process of preparing and prosecuting their clients' patents. My role does not end there, however. Because my clients' business strategy changes from time-to-time, I will also provide periodic oversight of ongoing patenting effects to confirm continued alignment of the patent attorney's activities with the current business strategy of my clients.

Admittedly, we IP Strategists are a new breed of patent professionals. But, many of us are blogging and speaking about our specialty and, fortunately, most of us do not appear shy about talking about the changes we believe needed to the patenting process at many organizations. As a result, I predict that IP Strategists will emerge as a critical first stop for forward-thinking corporations that seek to maximize the value obtained from their patents.