



Protecting offshore innovations

It takes a lot of innovation to make things happen offshore. Simplicity and cleverness are often the difference between success and failure. With limited resources offshore, and high costs to deploy even simple devices, ideas drive the noncommercial to commercial. The problem with offshore innovations, however, is it is a big world

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out there and few seek to adequately protect innovations while in the idea, development or even manufacturing stage. It is often too late to protect an idea once it is proved commercially successful.

One of the perplexing issues with technology developed for use offshore is the technology will be used around the world under many different legal jurisdictions. There is no such thing as an “international

patent,” but there are mechanisms to coordinate patent and/or trademark protection in multiple countries. Another problem is the early stages of an idea are when the value of an idea is most uncertain. Seeking patent protection can be very costly for ideas that do not ultimately generate commercial return. However, most countries are “first-to-file” countries — meaning an application has to be on file before the invention is used, sold or made publically known. A few countries, including the United States, provide inventors with a one-year grace period in which to file their applications. This creates a balancing act: how to select those ideas being developed by employees that may be worth protecting and fit the company’s commercial strategic direction — without wasting money. Part of this balancing act includes whether to seek patent and/or trademark protection and, if so, to what extent and in which countries.

A portfolio strategy is used to overcome innovation and protection barriers. An innovation discipline is created and managed. This discipline uses active and continual refocusing of development efforts back to

the larger commercial goals — essentially defining invention and protection goals even before the inventions are made. In this way, protection strategies are integrated into — and influence — the development process.

Regardless of the source or method of innovation, there are strategic and tactical options for those innovations worthy of seeking protection. In many countries, the Patent Cooperation Treaty provides a way to keep the option of filing open for patent protection in those treaty countries. A single “international” filing is made, but the selection and filing in specific countries are deferred for many months, typically two-and-one-half years. The “international” filing itself never becomes a patent, but does provide a way to get an early filing date.

One interesting protection strategy involves the use of a United States statute. If even a portion of the patented invention is “supplied” from the United States, it may create an infringement enforceable in the United States. Although some courts have limited its use in certain situations (such as those including process patents or copies of

software), this statute, however, remains a useful tool for both protection and assertion in a wide range of other circumstances.

These are just a small sample of the options available in developing an intellectual property strategy to protect offshore innovations. The important message is protection strategies can be developed early in the development process, even if your technology will be cast into the far reaches of the world.

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