IP Decision Tree Example

Does the discovery relate to what is of current or reasonably foreseeable commercial interest to midsize, e.g.,

(1) Is it a big enough opportunity,

(2) Is the need sufficient to drive commercially profitable sales, and

(3) Can MIDSIZE win, or is it commercially attractive enough to easily license?

NO → **Release**

YES ↓

Does the discovery relate to a current or reasonably foreseeable commercial activity of MIDSIZE?

NO → **Release**

YES ↓

Do IP rights enhance MIDSIZE's marketplace competitive position?

NO → **Publish**

YES ↓

Does analysis of factors (See VI. Patent vs. Trade Secret) indicate patent rights are preferred?

NO → **Trade Secret**

YES ↓

Suggested patent use should be investigated (See B. Patent Uses, next page) by answering the following questions:

(a) Have product(s) been identified? (is it a real solution to a real problem that is not too expensive and strongly driven),

(b) Is the US market sufficient to support your enforcement strategy? (See C. Patent Costs, next page), and

NO → **License Or Sell**

(c) Whether MIDSIZE has resources or desire to win on own?

NOTE: These questions are difficult to answer in the early stages of discovery.

NO → **License, Sell Or Partner**

YES ↓

Determine if any countries other than the U.S. are of interest as commercial markets of MIDSIZE, either directly or through a local distributor?

NO → **File In U.S. Only**

YES ↓

Are potential sales in any individual countries expected to be sufficient to support litigation costs to defined patent or is OUS manufacturing localized?

NO → **File In U.S. Only**

YES ↓

File In U.S. & OUS