Selecting the Appropriate Patent Search for Your Client

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Introduction

Patent searching can be used as a valuable tool to ensure a productive and efficient route through the life cycle of a product. Unfortunately, there is no one-size-fits-all approach when it comes to patent searching. The different patent search types available can play a fundamental role in product development, drafting a patent application, and assessing infringement risk, helping to provide an unperturbed route to market. Additionally, prior art identified through a patent search can be used to invalidate a patent or provide the basis for analysis of the strength of a patent.

Understanding what patent search type is required for the various stages of a products life cycle can be a challenging and often confusing task. Furthermore, choosing the wrong search may have significant consequences, for example it may increase the risk of missing relevant patents for infringement analysis.

This article will help provide an insight into the relationship of patent searching and a product's life cycle and ensure that you are able to select the most appropriate search for your client's needs.

The Life Cycle of a Product and the Relationship with Patent Searches

Patent Search types relate to the life cycle of a product, of which there are at least four stages:

- Research Stage - Trying to come up with ideas for a product/invention
- Patent Stage - You have your invention and want to protect it with a patent
- Product Launch Stage – Manufacturing and/or selling into a market
- Defence Stage - You are worried about or being attacked by a third-party patent or want to attack someone with your patent

Research Stage

At the research stage, patent searching can be conducted to help focus Research and Development (R&D) and provide inventors with background technical information to help generate ideas for a product or invention. There are two search types that you should consider at the research stage; the first of which is a Landscape Mapping Search, also known as a White Space Search. This search sets out, in general terms, how highly patented areas are, how rapidly particular technology fields are expanding, who the main assignees are and where they are patenting. The data is presented in several charts that include a Technology Landscape Map, which groups patents by their key concepts to generate a contour map of the technology landscape, showing hills of high concentration of patents and valleys of low concentration. This is a useful tool to visualise groupings of assignees around key technology areas, or where there appears to be 'white space' in the area i.e. potential gaps in the market.

Patent Landscape Mapping searches have an intrinsic use in the research stage of a product. However, they are also a useful tool throughout the full life cycle of a product and can provide valuable insight into how your company fits into the patent landscape compared to your competitors and lets you know how patent portfolios are changing.

The second search type to consider at the research stage is a State-of-the-Art (SOA) search, also known as a Collection Search, which provides a collection of results derived from a broad trawl through the patent literature. This search is helpful in understanding how others have overcome a particular technical problem, as well as indicating avenues that could be advanced on, and those that may be dead ends. A SOA search offers a more technical overview of the inventions, while a Patent Landscape Mapping search is more of a business tool to decide where to focus R&D.

Patent Stage

Once an invention for a product has been developed, the next step is to consider drafting and filing for a patent. However, the patent will only be successful if the invention is novel and inventive. A patentability search, also known as a prior art, novelty, or pre-filing search, aims to determine this. It is run without date and territory limits (i.e., coverage is worldwide) and covers both patent and non-patent literature to ascertain whether the proposed novel and inventive details of the product have been disclosed in the public domain. The results can also help with drafting the patent application and ensure minimal delays in the examination process.

It should also be noted that the scale of the patentability search is limited as it needs to be significantly less expensive than drafting and filing the patent application.

Product Launch Stage

Once a final product has been developed and made ready for market, an infringement search can be used to identify whether the aspects of the product fall within the monopoly covered by one or more third party patents. Infringement searches can go by different names, most commonly Freedom-to-Operate (FTO) and Clearance Searches. They should be conducted prior to launching a product and depending on the stage of development of the product, they may also provide details of obstructive claims that could be fed into redevelopment to design around such obstructions.

Infringement searches are limited by date and territories; the date limit is usually set to twenty years to cover potentially 'alive' patents, however if the product is likely to infringe on patents that may be eligible for a grant extension then you should consider extending the date limitations accordingly. The territory limitations should be set to the countries in which you intend to manufacture and sell the product. Focusing the territories of a search can significantly reduce the search size and thus the costs associated.

An infringement search will differ from a patentability search in that the analysis will focus '*mainly'* on the claims of patents, while a patentability search will often overlook the claims in favour of more detailed disclosures listed in the description. Due to the difference in analysis and territory/date limitations, basing an infringement opinion on a patentability search may expose your client to greater risks of missing important patents. An infringement search will also be accompanied by a legal status report of the results identified. They are far more extensive and rigorous than a patentability search, which is reflected in the substantially higher costs, however a well-constructed infringement search can be a valuable tool in assessing one's risk of infringement in the marketplace.

It is also important to have an infringement search carried out if you are to be seen to be "due diligent" and not fall foul of being accused of "wilful infringement" (defined as a total disregard for third party patents) which can result in more extensive damages.

Defence Stage

During the defence stage, there are three main factors to consider:

I. Can I attack an obstructive patent that is preventing my freedom to operate?
II. Can I attack a third-party patent that I am being accused of infringing?
III. How strong is my own patent against an attack on its validity?

An invalidity search (opposition or patent busting search) aims to identify patent and non-patent literature that could be used to formulate an attack on a patent. To do this, the results generated will fall under two categories, based on their priority and publication dates.

The first category of results encompasses all prior art (patent and non-patent) published in the public domain before the filing date (or the priority date if it is entitled to it) of the patent in suit. A well-structured invalidity search will uncover documents that were not cited by the examiner at the time of patent office examination, that could be used to show a lack of novelty of the claims or may be used used in combination to generate an attack on the inventive step of the invention.

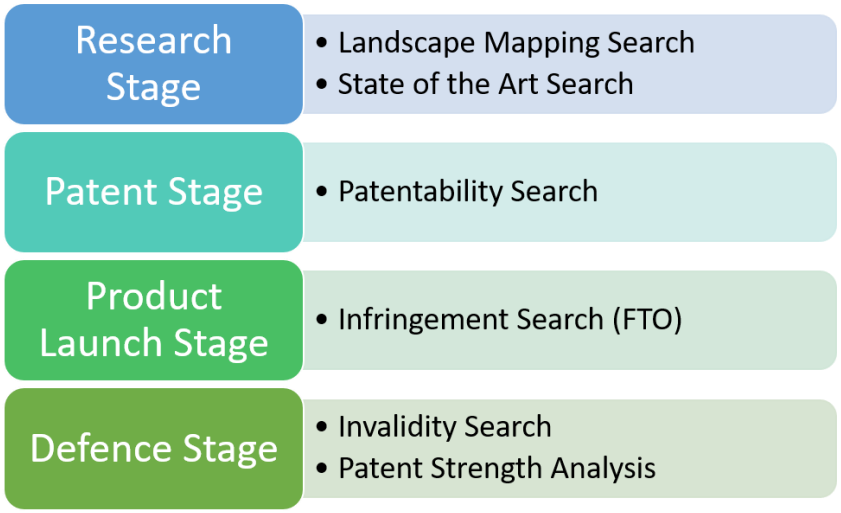
The second category of results would include patents found relating to novelty destroying art that fall into the "equivalent patent" category, i.e., equivalent patents on territory with earlier filing/priority but published later than filing/priority of the patent in suit. This art is also known as Section 2(3) art (UK Patents Act), Article 54(3) of the EPO Patents Act and similarly for other patent jurisdictions.

Similarly, a Patent Strength Analysis search can be used to compile an assessment of the vulnerability of a patent against an attack from a third party who may supply evidence against its validity. This is an important tool when looking to purchase or licence a third-party patent, or whether you are looking to increase the saleability and value of your own patent. A Patent Strength Analysis search will use the same search parameters and methodology as an Invalidity search.

It is important to use the correct invalidity or patent strength analysis search when looking to attack or test the strength of a patent over using a patentability search, as a well-structured invalidity search will consider the citations identified by the examiner at the time of examination to explore different avenues of searching that the examiner may not have investigated. The scale of these types of searches also goes way beyond the scale of a patentability search. The reason for this is that the losses from a failed patent application are dwarfed by the losses of failing to break a patent or giving misleading information on the strength of a patent.

Final Word

In conclusion, patent searching offers a powerful tool ensuring that an inventor or company monopolises the most from their product. The different search types are summarized below:



The plethora of patent search types available have an important role to play at the different stages of the life cycle of a product and selecting the most appropriate search for your client ensures that the results are as productive as possible. Selecting the incorrect search type could result in unwanted ramifications for the client and may, for example, increase your risk of infringement. A professional search team with a good communication link with the attorney will help ensure that the most appropriate search is conducted in tune with the client's needs.