

What are my Competitors Patenting?

The owner of a patent is called an assignee, and an **Assignee Search** identifies all of the patents owned by that person or organization. Many systems around the world publish patent applications before they become granted patents, so an **Assignee Search** may also uncover new technologies your competitors are creating before they are awarded patent rights.

You may combine an **Assignee Search** with a **State-of-the-Art Search** and conduct a **Landscape Search** to understand what your competitors are doing, find out who your next competitors are going to be, and extrapolate where your market is heading.

Patents are often applied for to obtain an advantage in the marketplace, and a **Landscape Search** can "map the market" and provide valuable insight to your organization when developing business plans. The patent literature uncovered by this type of search is also very useful for brainstorming and conducting design-around sessions when looking for your next product evolution and breakthrough.

Who Can Help?

Many service providers specialize in providing the patent searches described in this pamphlet. For example, there are law firms that specialize in intellectual property protection and specialized search firms that employ technical specialists trained to perform patent searching. Larger companies may have in-house specialists

Costs and offering will vary from provider to provider, so use this pamphlet to speak the "language" of the patent searcher. Speaking the same language as a professional searcher will help you get the results you are looking for.

Use this pamphlet to help you order the right kind of search, and to ask the right kind of questions.

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Patent Searching

An Introduction

By the IPO Patent Search Committee



Serving the Global
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Patent Searching

Does Anyone Else have a Patent Covering my Idea?

A good development strategy for a new product or process includes a **State-of-the-Art Search**. A **State-of-the-Art Search** identifies recent patents and patent applications published within a specific technology area.

The best time to pursue a **State-of-the-Art Search** is at the front-end of a development project, when adjustments to the design plan are most feasible. A **State-of-the-Art Search** can identify potential patent barriers to the commercialization of products, processes or technologies early in the development, which can bring about significant cost savings.

There are several other benefits to a **State-of-the-Art Search**, including: (i) gaining knowledge of the patent owners that exist in the same arena, (ii) reducing the risk of infringing a competitor's patented intellectual property, (iii) improving intelligence of the competitive landscape, and (iv) uncovering patents to potentially purchase or license.

Is my Idea Patentable?

It depends upon whether or not your idea is *novel* and *non-obvious*. A **Patentability Search** can be conducted to identify prior ideas that may be relevant to determining *novelty* and *non-obviousness* of your potentially patentable idea. A **Patentability Search** is also commonly referred to as a **Prior Art Search** or a **Novelty Search**.

The goal of the **Patentability Search** is to understand if and how the potentially patentable idea differs from prior ideas, to help you decide whether to pursue patent protection, to determine the potential scope of your patent, and to help establish the business value of your idea.

Both patent and non-patent literature should be searched, and materials related to your idea should be evaluated to determine the *novelty* and *non-obviousness*.

Can I Get Around my Competitor's Patent?

A **Freedom-to-Operate Search** (or **Clearance Search**) gathers the information needed to obtain a legal opinion assessing the risk of infringement of existing patents and pending patent applications. A **Freedom-to-Operate Search** involves a full review of potentially blocking patents in all countries in which the manufacture, use, or sale of the proposed product or process is expected to occur.

A **Freedom-to-Operate Search** identifies specific rights, jurisdictions, expiry dates and other pertinent information. This data can be analyzed to determine how the potentially blocking patents are to be construed and how broad or narrow the issued claims may be.

Patent claims may be construed to cover some products or processes and not others because of definitions in the patent specification or admissions made by the patentee during patent prosecution.

Patent rights are country-specific; a patent that blocks introduction of a product or process in one country may not have a counterpart patent in other commercially desirable countries. Similarly, issued patents in different countries may have broader or narrower claims.

Lastly, a **Freedom-to-Operate Search** can identify patents that may have expired or may not still be in force if the assignee has not paid required maintenance fees.

How Can I Tell if a Patent is Valid?

An **Invalidity Search** (also commonly called a **Validity Search**) is a search of prior art to assess one or more claims of a target patent to determine if the claims were properly allowed. You might run an **Invalidity Search** to evaluate the strength of one of your own patents.

An **Invalidity Search** may include a review of the file history (the correspondence between the patent owner and the Patent Office during prosecution) of the target patent and other closely related patents.

An **Invalidity Search** considers granted patents, published patent applications, and non-patent literature such as technical publications, and other public documents that can be used as prior art against a potentially blocking patent. Claims in a patent could be invalid if there is prior art that the patent examination process didn't consider. Prior art generally must have been made public before the date of the original patent filing to be effective prior art.