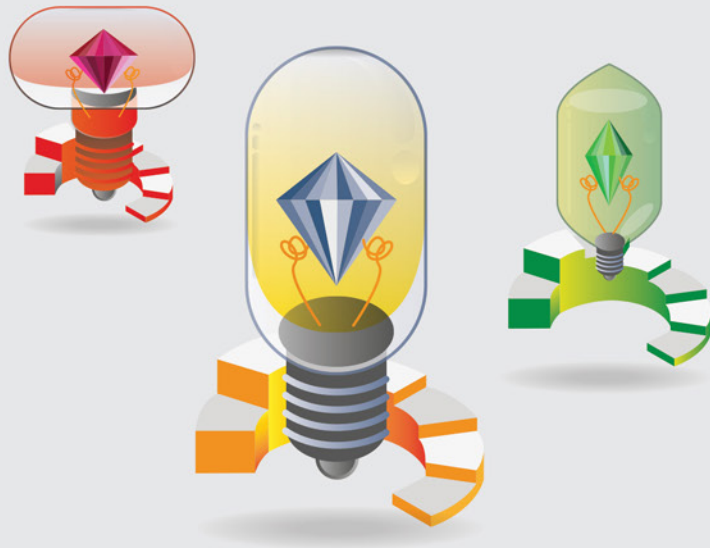


KNOWING YOUR COMPETITION

Tapping on intellectual property information for business intelligence





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Introduction

One of the core principles of intellectual property is that it should relate to a unique and individual creation. The international IP framework provides you with a means to reap the rewards of creative or inventive activity like this by providing you with monopolistic rights over the use of the asset you have devised. Whichever type of IP right you obtain, however, it may be open to challenge if it transpires that your creation or invention is not as unique or individual as you first thought.

When your company devises a new 'piece' of IP, whether it is a new potentially patentable solution to a problem, novel design, unique trading name/style or original copyright-protected content, it is important to know whether it is genuinely new or whether some other company has thought of the idea before. If your idea is not new, depending on the type of right and scope of protection, you may not have rights to use it.

It is best to know the facts as early as possible before significant sums have been invested in development so that you can decide whether to pursue your current line of activity or rethink it. This guide examines both freely available and paid commercial services for searching patent, trade mark and design databases (as copyright does not require official registration, similarly comprehensive databases do not exist for it).

As well as considering how you can use them to determine whether your idea is novel, what protection might be available for it and whether your activities might infringe anyone else's IP, the guide discusses strategies you can employ to determine if a third party is using your IP without permission.

Once you are familiar with database searching, you will find that these services can also be used strategically. They can help you identify new areas where your innovation efforts could be profitably focused, get a better idea of what your competitors are planning, and find new potential customers/suppliers or distributors for your products or services.

If any of the intellectual property terminology used in this report is unfamiliar, you may find it helpful to refer to another guide in this series —**Safeguarding Your Competitive Edge**.

Produced by IPOS International, these intellectual property management (IPM) business guides aim to deliver a suite of IP solutions for enterprises based on industry best practices. As the expertise and enterprise engagement arm of the Intellectual Property Office of Singapore (IPOS), IPOS International helps enterprises and industries use IP and intangible assets for business growth. Some of these engagements may be eligible for Enterprise Singapore (ESG) funding, such as the intangible asset audit and strategy development aligned with business goals. IPOS International's business portal www.iposinternational.com also contains case studies and videos of enterprises leveraging IP to gain a competitive edge in their innovations. Should you have questions on IPM matters or wish to speak with our Intellectual Property Strategists, do email us at enquiry@iposinternational.com or call +65 63308660.



Searching for patent information



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1. Searching for patent information

Why is patent searching important?

It's possible to file a patent application without conducting any searches at all—and sometimes, if matters suddenly become time-critical (for example, when an invention is about to be disclosed in a publication), it can make sense to

file quickly just to establish a priority date. However, there are a number of reasons why having a clear idea of where your invention sits in the patenting 'landscape' is advantageous; here are just three of them.

1.

The first reason is a simple budgetary one: the patenting process is quite expensive. After the initial filing, which will require the services of a patent agent, you will have to bear further costs for search and examination, prosecution, grant and renewal as well as applications to extend the scope of protection to other countries, together with any associated translations. There is usually little point in bearing these costs if there is no realistic prospect of obtaining protection, as any marketing benefit you can legitimately derive from 'patent pending' status is likely to be short-lived.

2.

The second reason relates to disclosure risk. When your patent is published which generally happens 18 months after filing (unless your application has been accelerated), anyone else in the world can find out about your invention. They can then challenge it if they consider it as infringing on their existing IP (NB in some countries this can be done pre-grant, however in most countries, it is linked to the patent grant procedure; in Singapore only after the patent is granted). If such a challenge is successful, you will lose the chance of obtaining a patent and no longer have the fall-back possibility of protecting your invention as a trade secret since it is already published.

3.

The third reason relates to litigation risk. Out of the entire IP family, patent infringement cases are generally the most expensive to defend (or to pursue), particularly if they involve the US market. It is difficult to win such cases if your adversary is large and well-funded (and not all territories always enable you to recoup your costs even if you do win). If you lose, you could find yourself facing an injunction that could prevent you from trading in the affected goods or services altogether in certain countries. So the 'stakes' are quite high.

“Searching can help you avoid unnecessary cost and reduce your business risk exposure”

Accordingly, while database searches cannot tell you everything—for example, you can't retrieve information about patent filings that are yet to be published—they can prevent you from running unnecessary business risks.

What types of patent searches are typically performed?

There are a number of different types of patent searches that can be conducted. Generally, these searches are divided into three categories (though the terms may vary a little): patentability/prior art, freedom to operate and patent landscaping.

Each of these search types has a different purpose. They will find different patents and cover different aspects in varying levels of detail. Sometimes the results are presented graphically and at other times in a table or free text format.

This range of searches exists because your motivation for performing them may vary quite widely. For example, you may want to know whether the idea you have had is new, whether you will be able to launch your new product or will need a licence or what patents your biggest competitor owns.

Figure 1 below lists some of the most common reasons for searching a patent database and the type of search that is normally performed in each case.

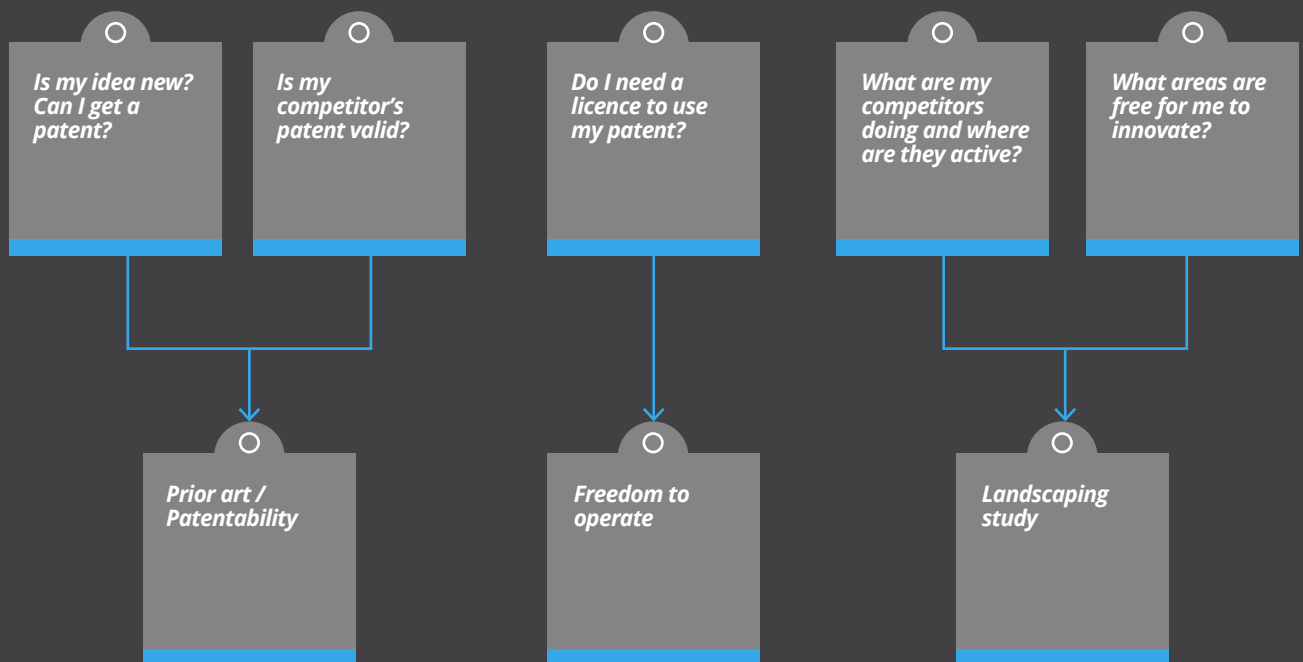


Figure 1. Reasons for conducting patent searches

What are the main differences between these types of searches?

The approaches used and results obtained from these three main types of search vary considerably. It's important to choose the right one in order to make sure that the information you obtain will answer your primary question as accurately as possible. This brief guide should help you make the correct choice.



Prior art

A prior art search (also sometimes called a patentability search) attempts to find other previously published material (usually amongst patent applications, scientific references and journal articles) that predates your application (i.e. they were filed before your priority date). It looks for material that may make the invention being searched invalid for

1. Searching for patent information



patent protection on the grounds that it is not novel (i.e. it is not totally new) or not inventive (i.e. it is obvious based on what has already been published).

This type of search is typically performed early on in the invention process, once an idea has been formulated and before a patent application has been filed, so that an assessment of the chances of obtaining a granted patent can be assessed. It is the type of search that a patent examiner will perform during the granting procedure. It can also be used to invalidate a competitor's patent by showing that it should not have been granted, due to existing prior art that was present when the patent was filed.

A **freedom to operate search** (also sometimes called an infringement search, a clearance search or a right to use search) is much more detailed, costly and complex to perform than a prior art search. It is sometimes needed owing to the fact that a patent is a negative right, in that it prevents a third party doing what is outlined in your patent claims. It is not a positive right—it does not give you any rights to do what is in your patent. Therefore, when you try to practise your invention in a particular country, you would need to check whether there are any patents that are preventing you from doing what is outlined in the claims of those patents.

It may be that you have a perfectly valid granted patent, but you are unable to practise your invention without accessing an invention belonging to a third party by means of taking out a licence. As a simple example, you might own a patent that describes a clever use of a widget of some type. However, a competitor holds a patent to the widget. Therefore, to be able to use the widget according to the manner outlined in your patent, you would need to legally obtain the widgets; this may require a licence from the competitor.

A freedom to operate search examines each aspect of your invention and assesses whether it is likely that you will be infringing another company's patent or whether you are free to practise the invention described in your patent claims. Unlike a prior art search, which looks at documents published across the world and looks for both patent and non-patent literature, a freedom to operate search focuses solely on patents (and sometimes pending patents) in a specific territory.

“Make sure you conduct or ask for the right type of patent search based on the question you need to answer”





Landscaping study

A **landscaping study** does not look at a specific invention but instead examines an entire technological area. It examines which companies are filing a lot of patents in a particular technological space; what aspects of this technology they appear to be focusing upon; and where 'hot-spots' lie compared with regions where there is little patenting activity.

A landscaping study is a strategic tool, useful for assessing your company's strengths and weaknesses compared with your competitors, finding areas where your innovation efforts should be focused and identifying areas where you and a competitor may be clashing.

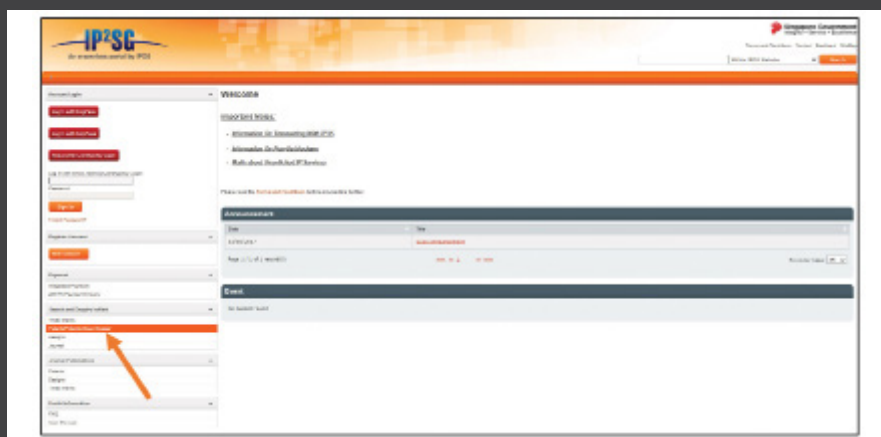
Which public patent databases are available and what information do they contain?

There are a number of patent databases available that are free for you to search. These databases allow you to find patents based on a range of criteria. These include keywords in the abstract or full text of the specification, the detailed classification of the subject matter of the patent specification, and the inventor or owner identity.



Patent owners are given rights that are sometimes described as 'monopolistic'. In fact what the patent provides is the right to stop others being allowed to practise the specific invention for a period (usually 20 years), in exchange for publicly disclosing how it works.

Public disclosure is thought to be beneficial for society in general because it allows others to improve and build upon an idea, and provides details that others can use once this 'monopoly' period is over.



“Espacenet, Patentscope and Google Patents are popular free sources of patent information”

For this reason, most countries have publicly accessible databases of patent specifications (whether they are in force, applied for or lapsed) that can be used to examine the content and legal status of patents in their jurisdiction. For example, to check the status of a patent application in Singapore, the Intellectual Property Office of Singapore (IPOS) provides its own *IP2SG* service; similarly, to check the status of a US patent, the US Patent and Trademark Office (USPTO) provide a service known as *PublicPair*.

1. Searching for patent information



“Work performed by agencies should be formally assigned to your company”

Perhaps the two best-known services, both of which offer access to data aggregated from many registering bodies are the Espacenet service and the Patentscope service. Espacenet is run by the European Patent Office (EPO) and hosted both directly by the EPO and by a number of contracting states; Patentscope is run by the World Intellectual Property Office, an executive body of the United Nations.

The Espacenet service contains full-text patents from a large number of countries, covering bibliographic details and abstracts from over 90 million patents and patent applications worldwide. It has sophisticated searching capabilities and links to the prosecution histories of the patents in a number of countries (known as the Global Dossier). It is relied on by patent professionals across the globe.

The Patentscope service began by listing international applications filed under Patent Cooperation Treaty (PCT) provisions but quickly moved to listing national phase applications derived from the PCT and other national filings. It now contains details of over 58 million patents and patent applications.

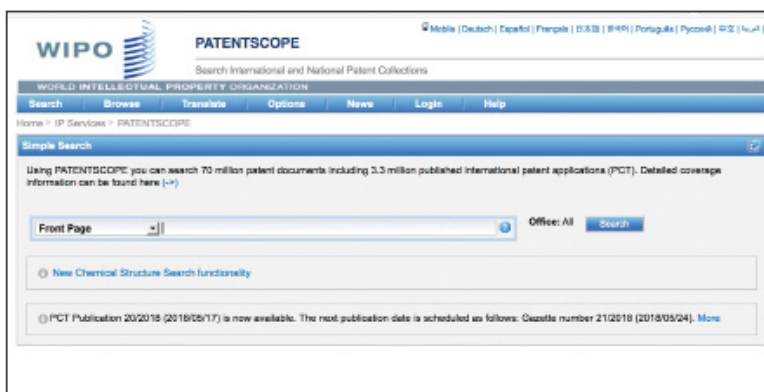
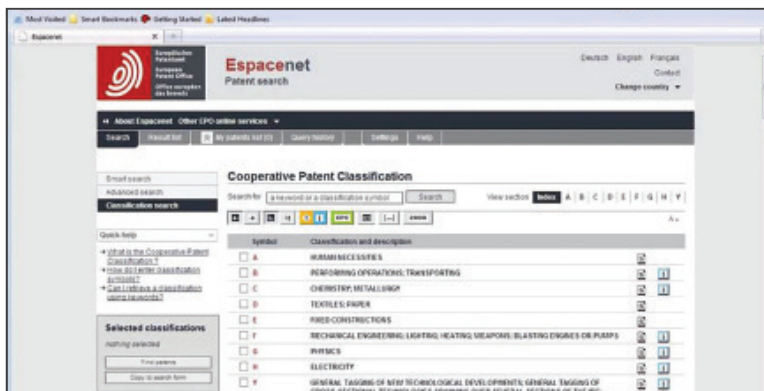


Figure 3. The Espacenet and Patentscope patent searching services

There are also a number of free patent databases available from the private sector. Probably the best known and most commonly used is the service offered by Google. At the time of writing, the Google Patents database contains full-text of 15 million patents from a number of countries and organisations including United States, Japan, China, South Korea, Germany, United Kingdom, France, Spain and a number of other European countries as well as EPO and WIPO.

The Google Patents interface is relatively simple to use and it allows searches based both on text and classification codes (see next section).



However, it should be noted that some professional search firms and patent examination offices avoid using Google; this is because previous search terms may, at times, be shown as suggested search terms to future users of the service, and this might, in some territories, be considered prior disclosure. Caution should, therefore, be exercised in using Google Patents if the search is sensitive.

How do you search a patent database using keywords or classification codes?

Efficiently finding the information you need in a large patent database requires a degree of skill and experience. It generally involves the use of complex queries containing logical operators, and the use of classification codes to narrow down the search. Various materials are available to help you.

Clearly, to find the relatively small number of patent specifications that are relevant to your business from a global database of over 90 million documents, you will need to use quite sophisticated search strategies. If a poor strategy is employed, either a large number of documents with little relevance will be returned from the search and will have to be filtered out, or a vital document will be excluded.

Fortunately, WIPO offers a number of detailed video tutorials on how to perform a simple, category-based and more advanced search of the Patentscope database. Similarly, Espacenet offers detailed tutorials on how to search its database. Both organisations also run regular training webinars to assist users in patent database searching techniques.

During the examination process, patents are allocated to one or more classes depending on the technology involved. These hierarchical classification systems, known as International Patent Classification (IPC) or Co-operative Patent Classification (CPC), allow patents to be categorised in detail according to the exact subject(s) of the invention. If you know the CPC or IPC code of a technological area you are interested in, it is often more efficient to search for patents in this area using that specific code than it is to rely on keywords.

“To efficiently find the most relevant information in a patent database often requires complex queries and the use of classification codes”



When keywords are used, it is important to think of as many synonyms as possible and to use ‘stemming’ (e.g. using the query term ‘rotat*’ to match the words ‘rotate’, ‘rotating’, ‘rotated’ and ‘rotator’) to ensure that relevant patent documents are not inadvertently excluded from the search results.

If a number of synonyms are discovered (for example, you may wish to use ‘rotating’, ‘turning’, ‘twisting’ and ‘spinning’), it is possible to combine these with ‘AND’, ‘OR’ or ‘NOT’ operators.

1. Searching for patent information



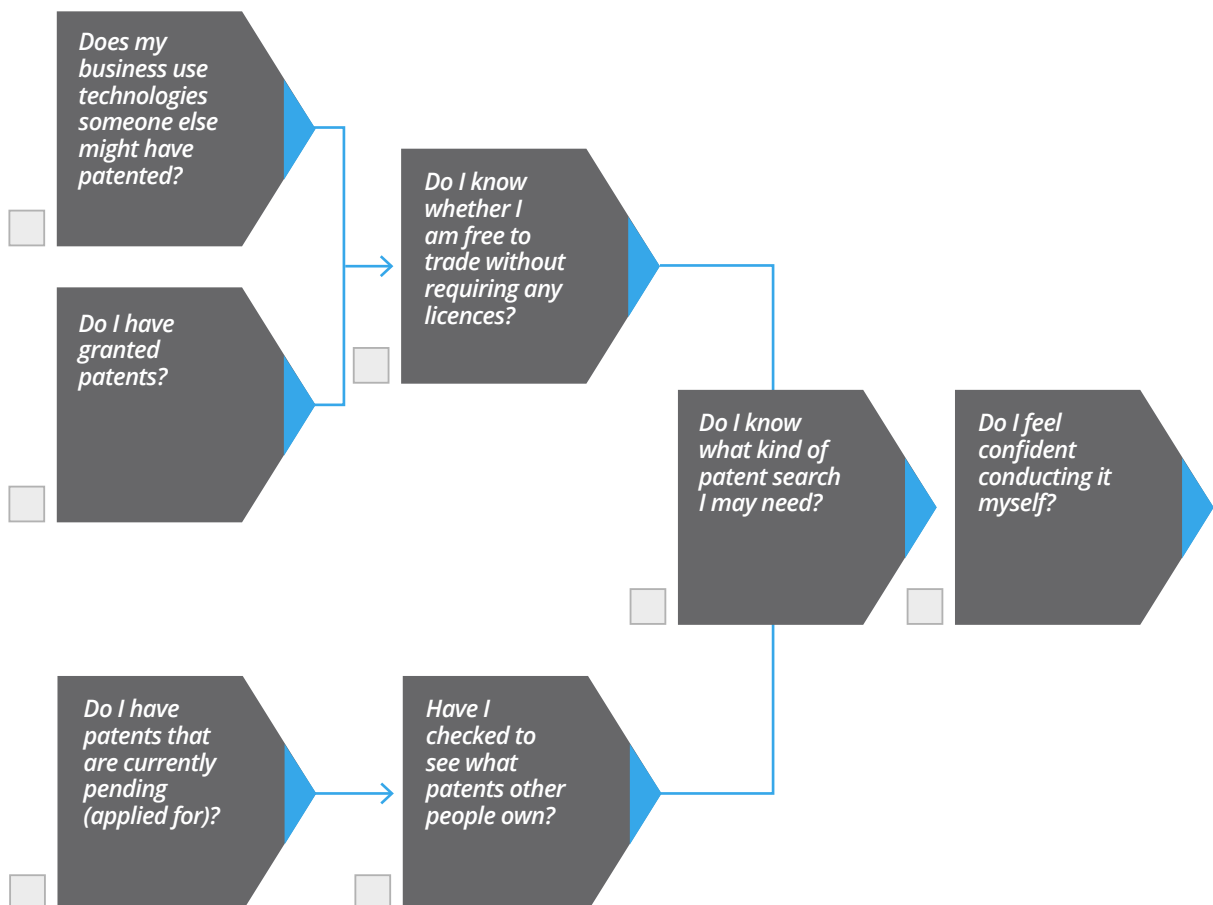
Another very useful operator is 'NEAR', which allows you to search for two words which are close to each other in the text—this can be used to exclude false positives where these two words appear in a patent document but are not related to each other. Separately, it is also possible to search for a number of words that are found in the same sentence or are adjacent to each other.

Using these advanced keyword searches increases the relevance of the results, though the search terms used can become quite complex.



SUMMARY

The following chart provides you with a set of high-level questions to help you determine whether patent searching is relevant for your business. And if so, how you might go about gathering the required information.





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