

Glimpses of different types of reports



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SEARCHES...Why?

- To generate ideas for R&D
- To avoid duplicate of research
- To reduce significantly R&D investment
- To develop new technical solutions to problems
- To plan new products
- To market for commercialization
- To update new technological trends
- To monitor competitor's research activities
- To prevent infringement actions (validity, ownership etc.)

Prior art

Definition: Prior art is all information that has been disclosed to the public in any form about an invention before a given date.

It can be any type of information available to the public

e. g.: Patents,

Technical publications,

conference, papers,

marketing brochures, devices,

equipment, processes and materials

Prior-Art Search – When & Which???

Types of Prior-Art Searches

Activity/Situation (when)	Prior art search (which)
Thought to innovate something	Patentability search
Planning/Completed a product launch	Freedom-to-Operate Search
Accused of Patent Infringement Plan to License a Patent Involved in a Litigation concerning IP	Invalidity/ Validity Search
Planning to Innovate Planning Business Expansion Planning a Business Strategy	IP Landscape Studies

Patentability assessment report

Sometimes referred to as a “**novelty** search

Can I Patent my invention?

To evaluate the chances of obtaining a patent for a determined invention / development

When?:

- Once a solution is defined
- Before filing a patent application



Patentability assessment report

What?:

- Any publication (patent or non-patent documents)
- Invention should be Novel (not disclosed to public)
- Invention should involve an invention step
- Invention should be useful
- Invention should be a patentable subject matter(should not fall under Sec. 3 and 4 of Indian patent act)

How?

- Free and paid databases are used in order to cover patents around the globe
- Search report cites details of the relevant patent/prior art documents, along with detailed analysis and opinion of patentability on the same
- Typically looking for references that were published before filing date of the invention in question

Patentability assessment report

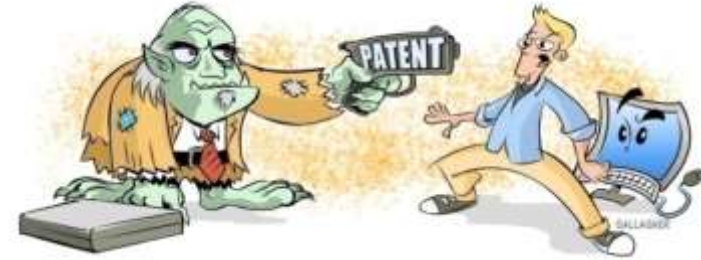
Patentability assessment report helps :

- In determining whether any similar invention already exist in the prior art
- In making the final decision of filing for patent
- In drafting a patent specification in highlighting the true novelty of the invention
- To ascertain the probability of a patent grant to an invention.
- If not patentable inventor can use it as a trade secret and license it to others and gain revenue

Infringement analysis report

Unauthorized making, using, offering for sale, importing or selling any patented invention within a particular territory of any patented invention during the term of the patent

Generally, two types of infringements



LITERAL/Direct infringement: If *each* properly construed claim *element* is found in the accused device, the claim of the patent is said to be literally infringed .

DOCTRINE OF EQUIVALENCE /Indirect infringement : If a claim of the patent is *NOT literally infringed* but the accused device performs **substantially the same function in substantially the same way to obtain the same result** as that of the patented device, the claim is said to be infringed under DOCTRINE OF EQUIVALENCE.

Infringement analysis report

- Scope of the claim should be determined first
- Claim interpretation from a legal stand-point
- Analysis of features of proposed product against broader claims of patents
- Must be done before launching a product or process in a particular Country or for litigation proceedings

Defenses to patent infringement:

- To claim that the activity of the respondent does not violate the patent rights of the complainant.
- By counterclaiming that the patent is invalid due to existing prior art.
(relevant prior art may be cited to indicate that a patent should not have been granted to the complainant in the first place)

Infringement analysis report

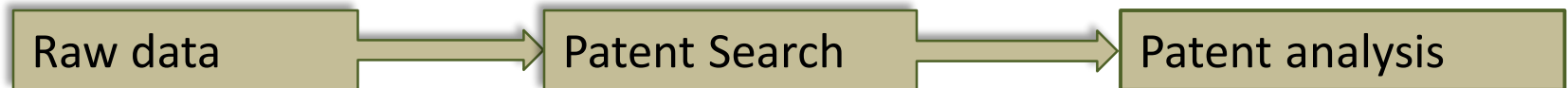
The infringement analysis report helps:

To make appropriate business decision. In the event of an infringement one may perform the following:

- Make changes in design of product to be out of scope of claims within the patent
- Consider licensing the technology in question
- propose sale/assignment of the technology
- propose a cross-licensing of technology or some other collaborative arrangement

What is a Patent Landscape Report?

- Research and analysis of patenting activity and innovation trends in a specific technological field/geographical area using patent information
- Transformation of raw patent data through patent search (patent databases) into comprehensive patent analysis (breakdown and analysis of the results, visualization and conclusions)
- The analysis and insights from the report can be used as inputs to guide your R&D and IP strategy



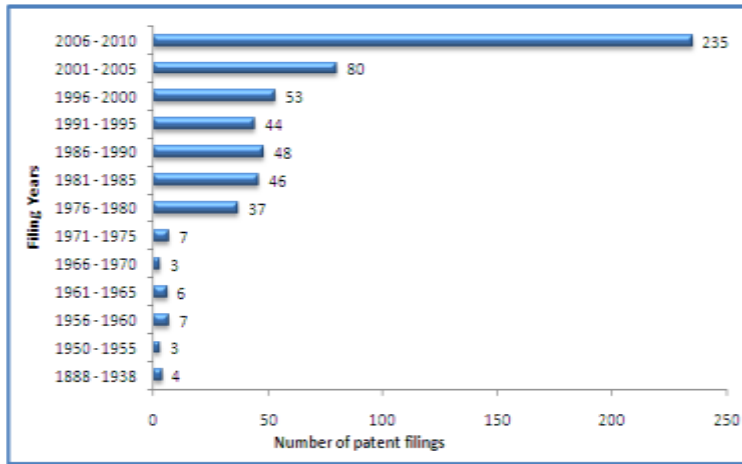
Patent Landscape Report

Components of Patent Landscape:

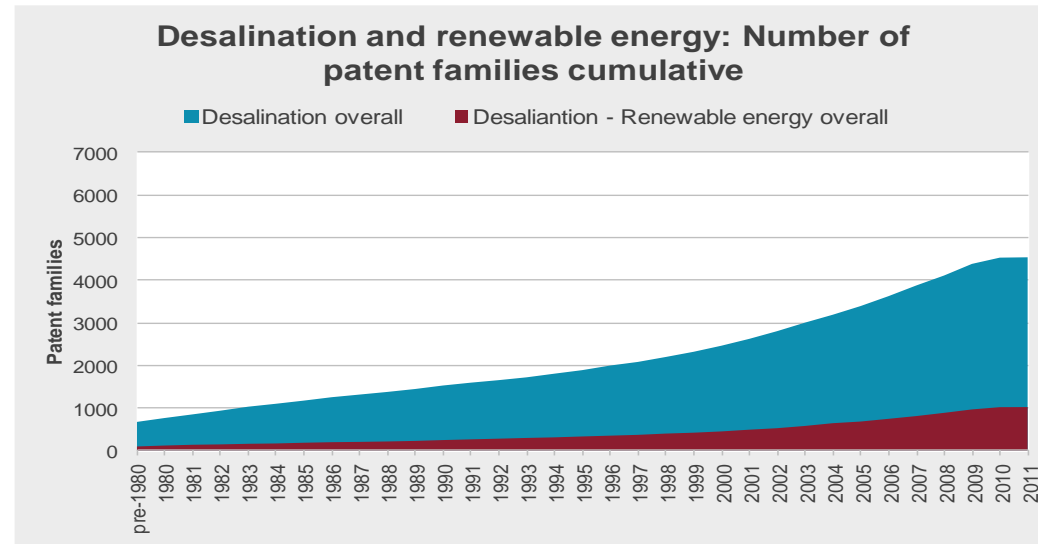
- **Background information** - definition of the technical problem , identification of keywords, IPCs
- **Patent search** - State of the art search (prior art) on patent database(s) with identified keywords, classification codes & setting of final strategy with optimum no. of relevant patent documents
- **Statistical analysis and visualization:** (The organizations involved and the time periods in which they operated)
- **Interpretation/evaluation/recommendations** (possibly with correlation with non-patent data)

http://www.wipo.int/patentscope/en/programs/patent_landscapes/

What can a Patent Landscape show?

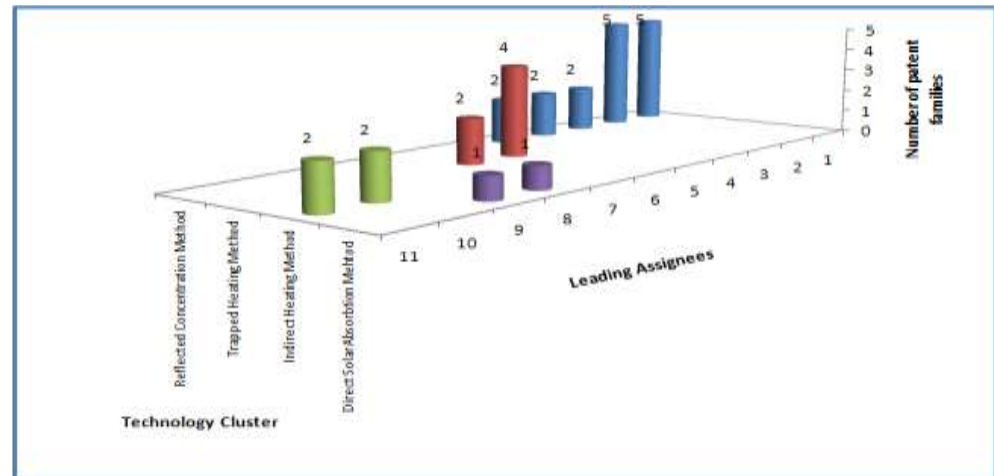


Year wise Patent filings



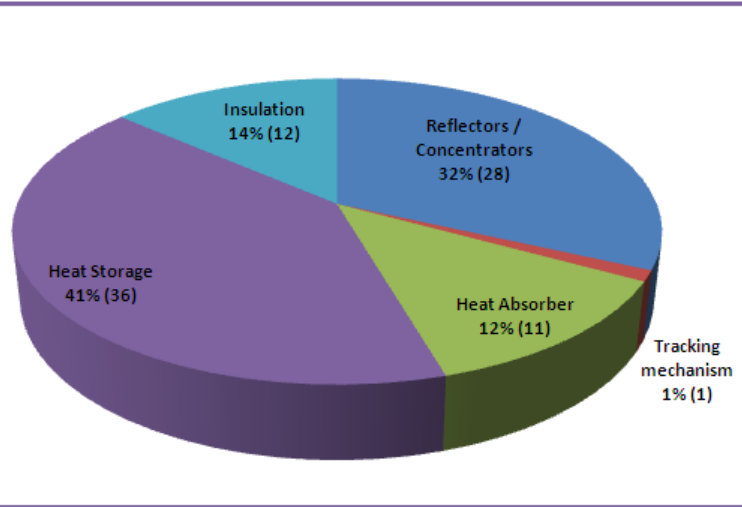
Trends in technological (sub)sectors over time

Source: WIPO Landscape Report on Desalination



Technology clusters across leading assignees

Source: WIPO PLR on Solar Cooking



Break down of the results by Sub technologies/components

Source: WIPO PLR on Solar Cooking

Freedom to operate/Freedom to practice

Definition:

- The ability to perform a particular commercial activity(e.g. commercialize a product, provide a service, perform a manufacturing process or use a product)without “infringing” 3rd party’s valid IP rights
- Territorial search (region specific)

Useful for

- Product launch by identifying infringing patent and potential losses which may happen
- Claims modification according to prior arts found
- Saving billions of dollars which can lose in potential infringement

Freedom to operate/Freedom to practice

Search involves :

- Identify key elements of the product
- Collection of keywords & develop a search strategy
- Define geographical boundaries
- Patent screening
- Determine patent ownership and status (assignments, licences etc.)
- Patent analysis Report based on free and paid databases
- Includes graphs, charts, tables



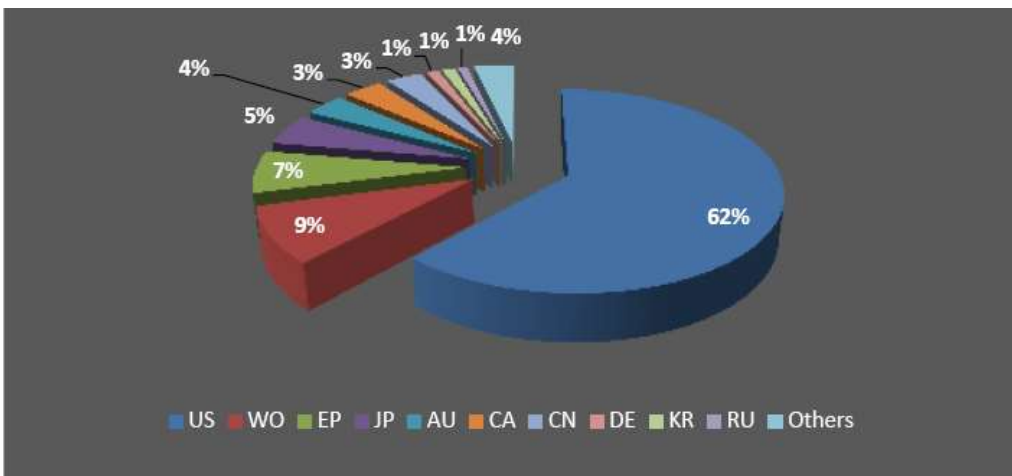
Freedom to operate/Freedom to practice

- The claimed matter is protected only where there is **a patent**;
- Patents that were issued may not still be in force if the patentee has not made regular payments due.
- Patents are a limited monopoly and they do expire

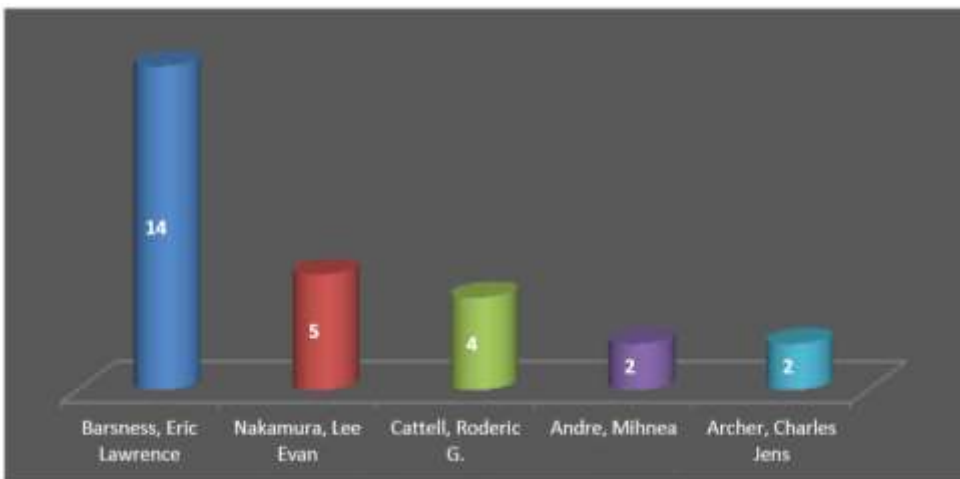
In order to get freedom to practice

- Design around to avoid infringement
- Wait for patent to expire
- Carry out activity in another, patent free, territory
- Argue non-infringement or potential invalidity

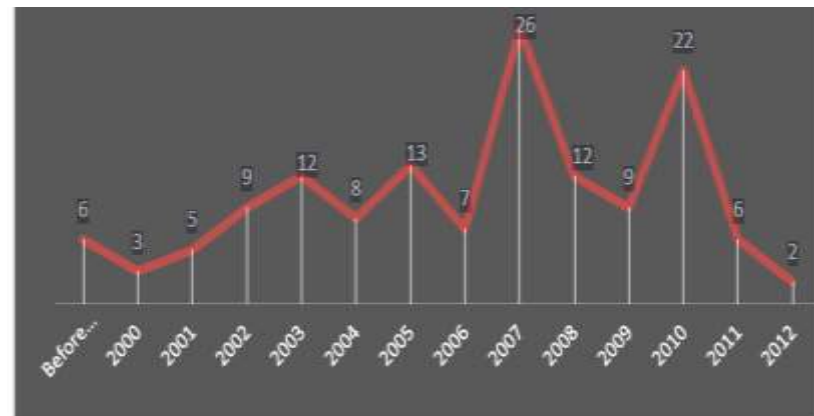
Freedom to operate/Freedom to practice



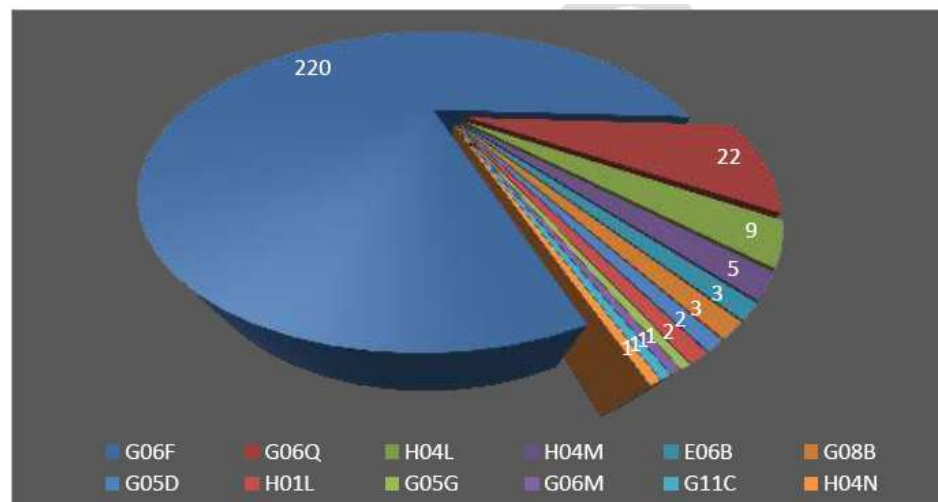
Country wise Patent filings in given technology



Assignee wise Analysis



Year wise Patent filings



IPC code wise analysis

Patent validity/invalidity report

- Detailed research to determine whether the claims of a particular patent are valid or invalid when analyzed and compared to the prior art available on the date of filing. Search is conducted after patent issuance.
- The aim of the search is to uncover prior art or prior use which limits the scope of the granted patent
- Purpose of the search is either to validate the enforceability of a patent's claims or to invalidate one or more claims of a patent, respectively.
- These two searches are identical except for the desired outcome

Patent validity/invalidity report

- Search include patent and non-patent literature ,various publications, journals and databases for relevant art
- The search determines prior inventorship
- When a client is licensing, buying, or selling a patent and wants to confirm that the patent is enforceable.Search will help the inventor to determine wheather he can withstand in the court or not?
- Save time & money as patent litigation is expensive & time consuming
- Search helps to determine strength of the patent for licensing negotiations. (If the patent is weak then licensee can negotiate for low royalty cost or vise versa)

Important Tips for relevant searching

- Be specific about what you are looking for
- Familiarize the keywords and concepts using background information i.e. Dictionary, reference books etc.
- Divide the query into concepts for searching
- Think about & look for alternative search terms
- Review the strategy and refine results
- Perform a search on the inventor name to get an idea of the person's core research interests

