

# 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

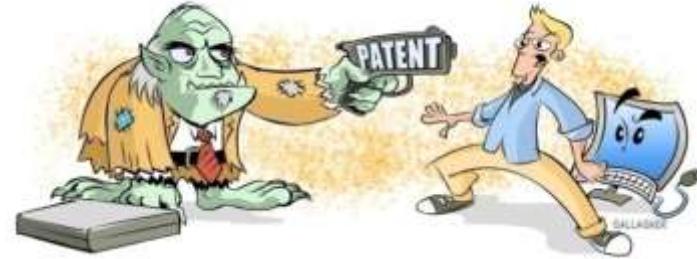
# Patentability assessment report

## 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



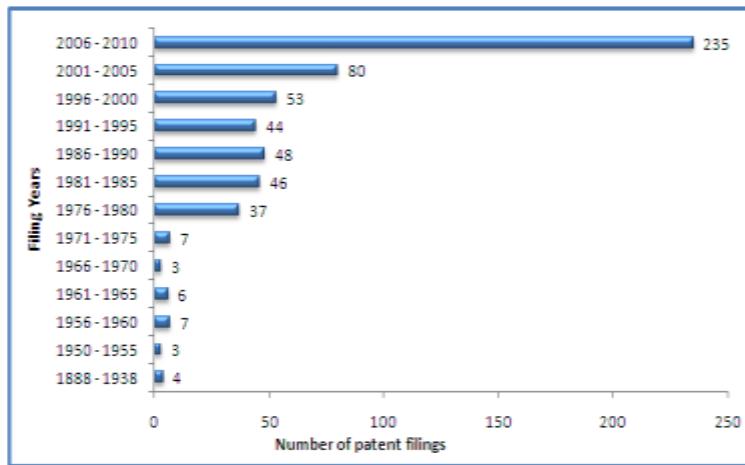
# Patent Landscape Report

## Components of Patent Landscape:

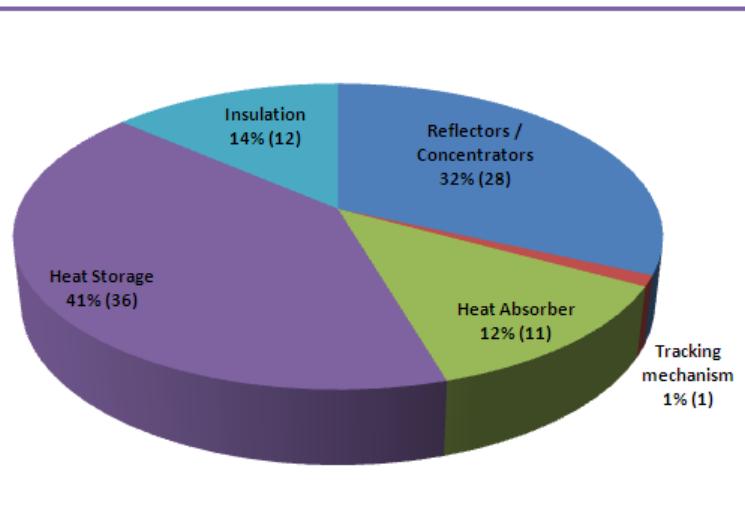
- **Background information** - definition of the technical problem , identification of keywords, IPCs
- **Patent search** - State of the art search (prior art) on patent database(s) with identified keywords, classification codes & setting of final strategy with optimum no. of relevant patent documents
- **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/](http://www.wipo.int/patentscope/en/programs/patent_landscapes/)

# What can a Patent Landscape show?

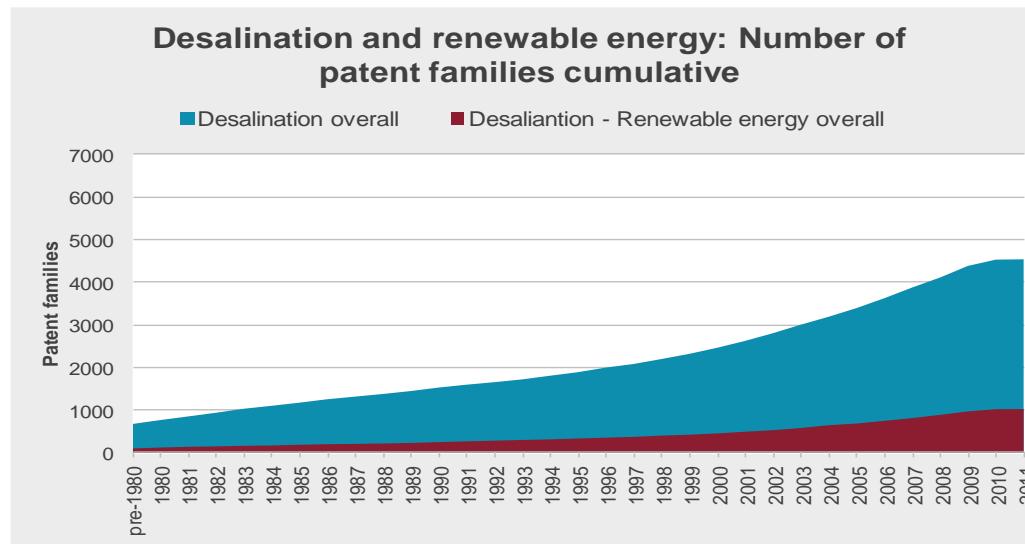


Year wise Patent filings



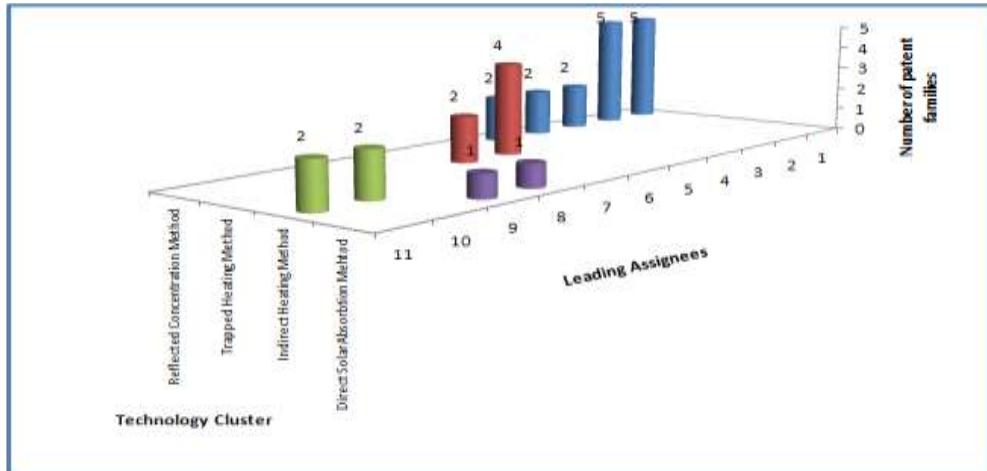
Break down of the results by Sub technologies/components

Source: WIPO PLR on Solar Cooking



Trends in technological (sub)sectors over time

Source: WIPO Landscape Report on Desalination



Technology clusters across leading assignees

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



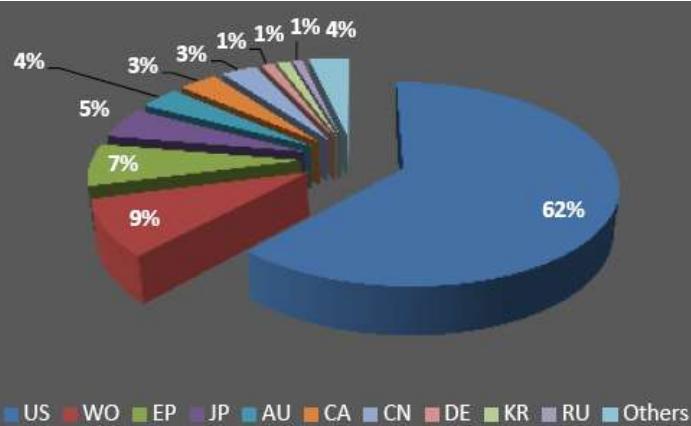
# Freedom to operate/Freedom to practice

- 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

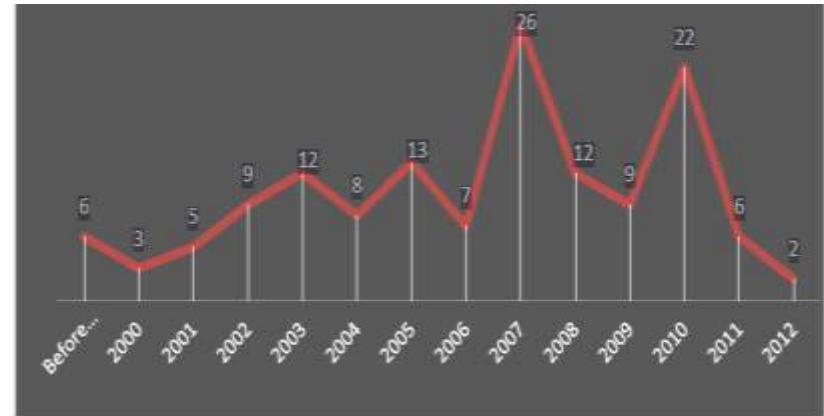
## In order to get freedom to practice

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

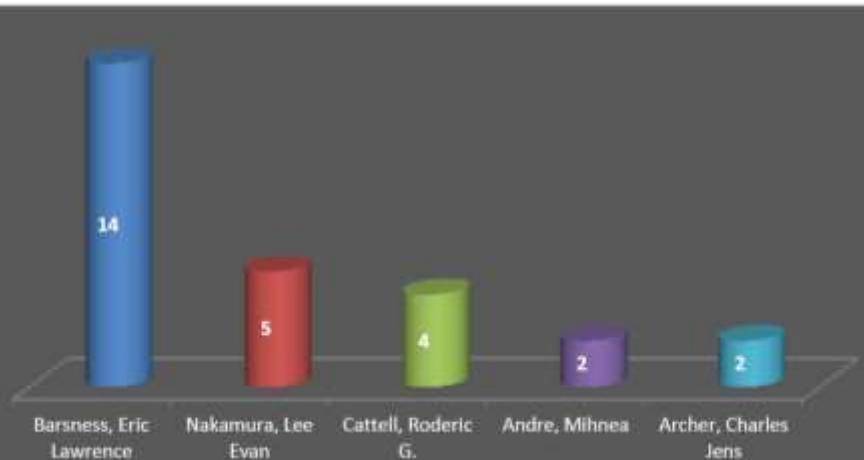
# Freedom to operate/Freedom to practice



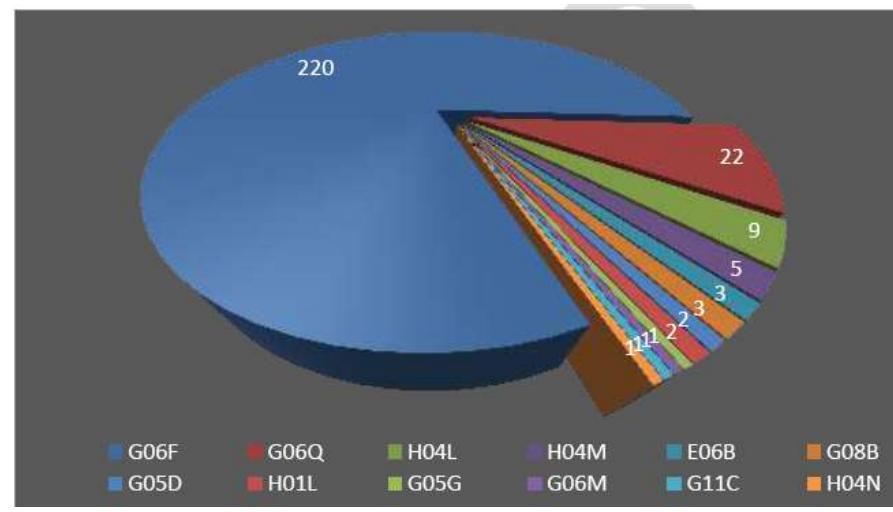
Country wise Patent filings in given technology



Year wise Patent filings



Assignee wise Analysis



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

