

#### Michael White

Michael White is the librarian for research services in the Engineering and Science Library at Queen's University. He is also the subject specialist for chemistry, chemical engineering, patents and electrical and computer engineering. Prior to joining Queen's in January 2005, Mike was a librarian for seven years at the U.S. Patent and Trademark Office in Washington, D.C. He has conducted numerous patent research seminars for librarians, inventors, attorneys and the general public.

#### **Abstract**

In 2006, inventors filed more than 1.5 million new patent applications worldwide. The U.S. Patent and Trademark Office alone received a record-breaking 445,000 new applications. Patents are an increasingly important source of information on emerging technologies and new applications of old technologies. Patents are international and interdisciplinary, representing innovations in every field of technology during the last two hundred years. Whether you work with independent inventors or research scientists, entrepreneurs or R&D executives, patent attorneys or paralegals, patents are an indispensable source of scientific, technical, business and legal information. Patents can also be a useful resource for genealogists, journalists, teachers, students and historians. This session will cover the basics of patent terminology, documents and databases, explore online search tools and strategies, and explain the role of patent information in scientific research and business decision making using examples from public patent databases.

All graphics are from the author's collection or Microsoft Clip Art Online, unless otherwise noted.

#1803-3

# **Topics**

- Why patents?
- Patent data and documents
- Number searching
- Inventor and company searching
- Patentability searching
- Patent status
- Statistics

# Business & Entrepreneurship

Image:

**Globe and Mail** 

Biovail Hammered by patent ruling.

In August 2006 Biovail's stock lost 33% of its value after a negative patent ruling.

Photos: Globe and Mail and CLA

#1803-5

Image:

Photo of Sam Holman, owner of the Original Maple Bat Co.

Sam Holman, owner of the Original Maple Bat Company, esearched 225 baseball bat patents before patenting his own improved design.

# Science & Technology

#### Image:

Globe and Mail headline:

Edmonton researchers patent new technology used to regrow teeth.

- New technological innovations.
- New uses for old technologies.
- Research not published in scientific journals.
- Bridge between basic and applied science.
- Research originating in developing countries.

Photo: Globe and Mail

### 2004

- 1.5 million new applications worldwide. (WIPO)
- 700K STM articles. (NSF/ISI)
- 5.5 million patents in force.
- International filings:
- Patent applications per million pop.:
  - Canada 125Korea, Rep. 2,189USA 645
- Patent maintenance (50% reach x years):
  - Japan 17 yearsEurope 11 yearsUSA 11 years

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### Other Uses

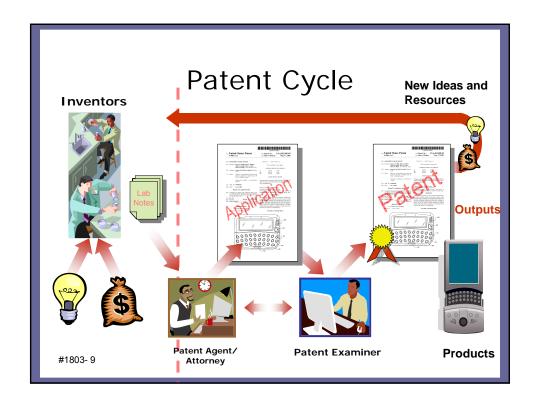
- Economic development.
- Genealogical research.
- History of technology.
- History of art and design.





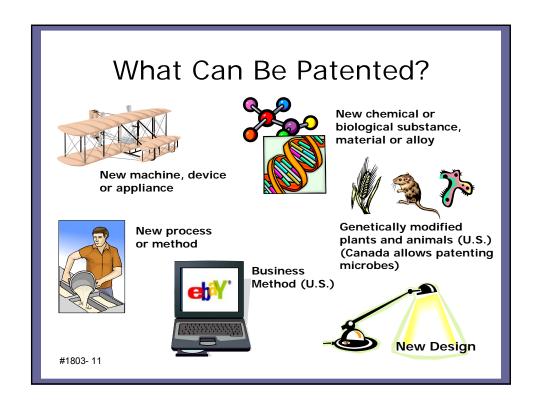


19th century ceiling plate designs.



# Patentability Criteria

- 1. Allowable subject matter
  - Invention meets statutory requirements.
- 2. Useful
  - Invention performs a useful function.
- 3. Novel
  - Invention has never before been published or patented.
  - Invention is not obvious to someone of average expertise in the art.
- 4. Fully Disclosed
  - Patent describes how to make and use the invention.
     No "black boxes" or secret ingredients.



#### Not Patentable

- Inventions disclosed to the public.
- Laws of nature, equations, abstract ideas.
- Printed matter.
- Inventions harmful to the public morality or good.
- Atomic weapons (U.S.)
- Human-animal hybrids. (U.S.)
- Medical procedures. (Canada)
- Non-useful inventions (perpetual motion machines)

### **Improvements**

#### Image:

Photo of man wearing a Utilikilt kilt.

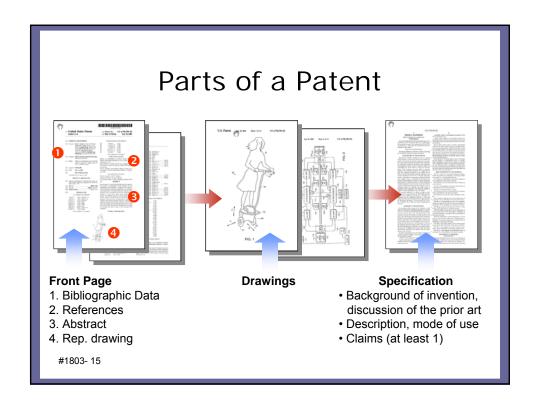
Symmetrical Pleated Skirt U.S. 6,282,723 Sept. 4, 2001 Steve Villegas, Seattle, WA

Photo: Utilikits www.utilikilts.com

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# Patent Rights

- Prevent others from making, using, selling or importing patented invention.
- Based on jurisdiction.
- Not renewable; inventions become public domain after 20 years.
- Require payment of maintenance fees (in most countries).
- May be sold, licensed, bequeathed, etc.



# Scenario 1: Locating a Patent



I need a copy of a U.S. patent. The number? I think it's 6,483,388.

#### Patent Data

#### Searchers beware!

- Patent offices publish patent data "warts and all."
- Not all patent databases are created equal.
- Commercial database vendors "clean up" and enhance patent data.



Eastman Xodak Eastman Kodal Eastman Kokak Eastman Kdak

The USPTO patent database has 15 different misspellings for Eastman Kodak.

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#### Patent Office Databases

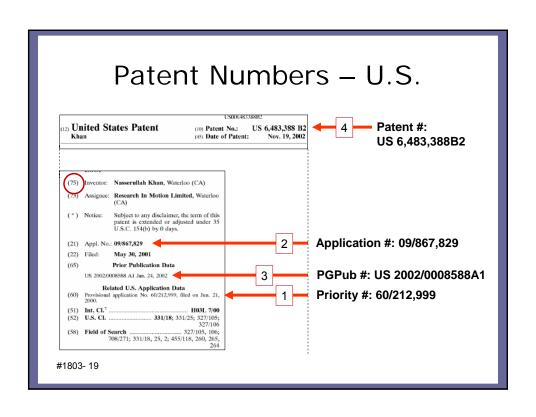
- ✓ Free
- ✓ Comprehensive
- ✓ Authoritative
- ✓ Stable
- ✓ Current (updated weekly)
- ✓ Classification search tools

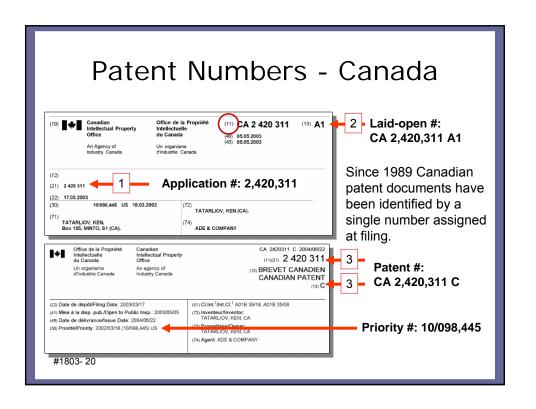




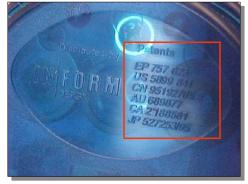


- Limited search, display and download options
- Multi-page printing difficult
- TIFF image format (USPTO)
- Dirty data





# Scenario 2: Product Searching





Look for patent numbers on product packaging, labels or the product itself. If number is not present, look for the manufacturer's name.

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# Identifying the Manufacturer

#### Image:

#### **Toronto Star**

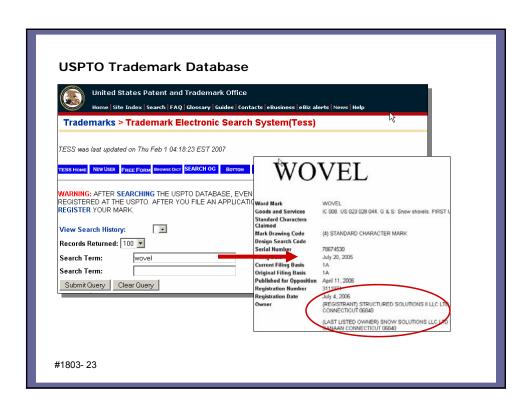
Photo of man using a Wovel, or wheeled shovel.

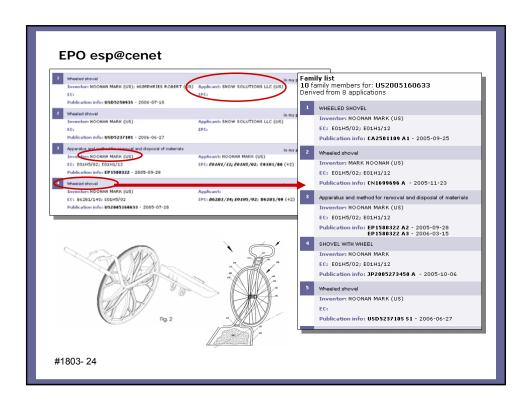
Search the product name.

- Trademark database:
  - CIPO CA TMs
  - USPTO US TMs
  - WIPO International TMs
- Newspaper database
- Web search engine

← "Wovel"

Photo: Toronto Star





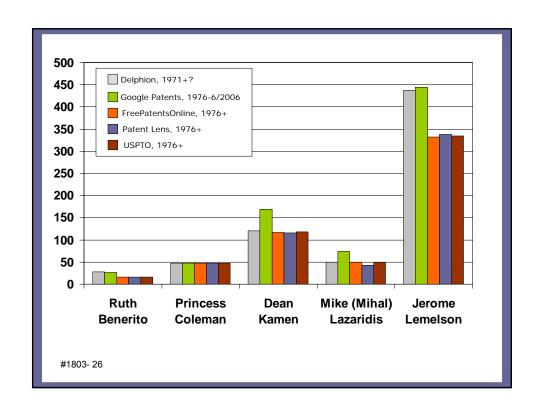
# **Inventor Searching**

- Middle initials:
  - Dean Kamen, Dean L. Kamen
- Name variations:
  - Susan Smith, Susan Smith Jones
- Nicknames:
  - Burt Ratan = Elburt Ratan
- Foreign names:
  - Mike Lazaridis = Mihal Lazaridis

#### Image:

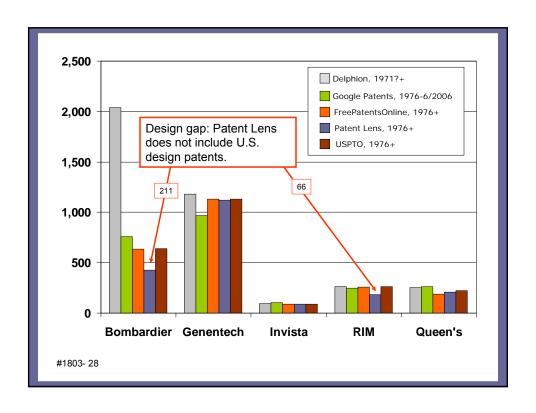
Photo of Michael Lazaridis, inventor of the Blackberry and CEO of Research in Motion.

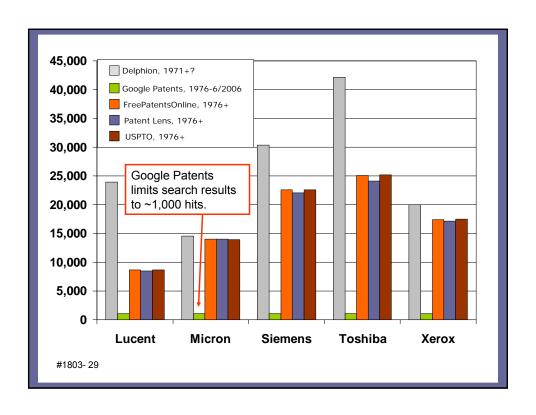
Mike Lazaridis uses his given name "Mihal" on patent applications.

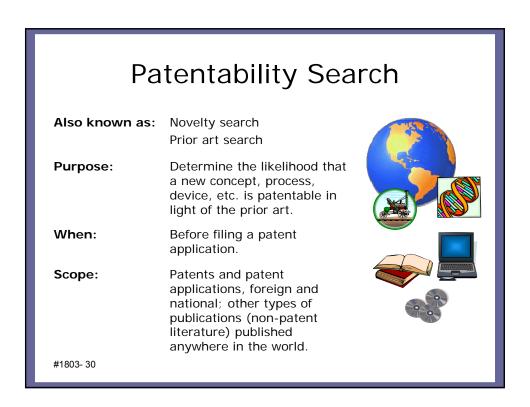


# Company Searching

- Subsidiaries and affiliates:
  - Dupont Canada
  - Wisconsin Alumni Research Foundation (Univ. of Wisconsin)
- Nicknames:
  - RIM = Research in Motion
- Name changes and Spin-offs:
  - 3M = Minnesota Mining and Manufacturing
  - Bell Labs = Lucent
  - ALCAN = Novelis
- Mergers and Acquisitions
  - Lucent = Alcatel-Lucent







# Infringement Search

Also known as: Freedom-to-operate search

Clearance search Right-to-use search

**Purpose:** Discover patents and

patent applications that may pose a potential infringement risk.

When: Before a product is

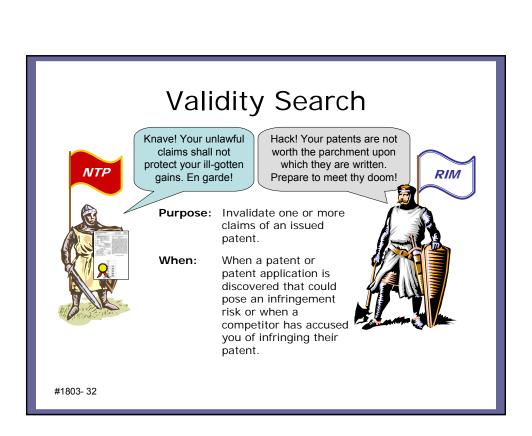
released or a process is

used.

**Scope:** Patents issued within the

last 20 years. May be limited to a specific

jurisdiction.



# Other Types of Searches

#### State of the Art

- Purpose: Monitor technological developments in a given industry or
- Scope: Usually limited to a specific technology.
- Frequency: Ongoing.

#### Market Research (Competitive intelligence)

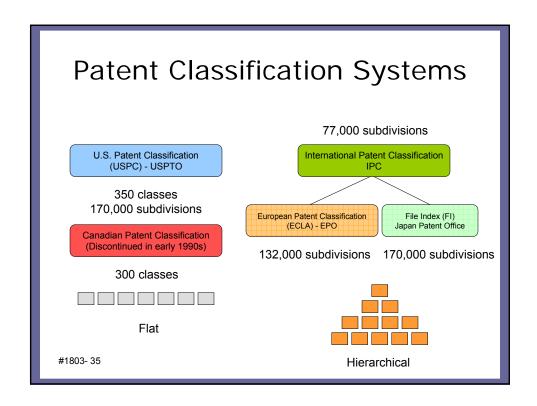
- Purpose: Uncover patents and applications owned by competitors.
- Scope: May be limited to a geographic area, technology or set of companies.
- Frequency: Ongoing.



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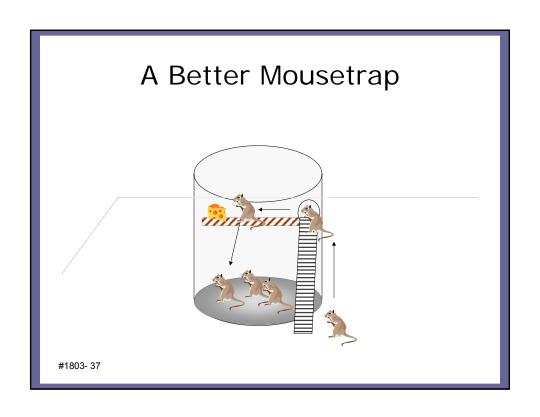
# **Basic Patentability Search**

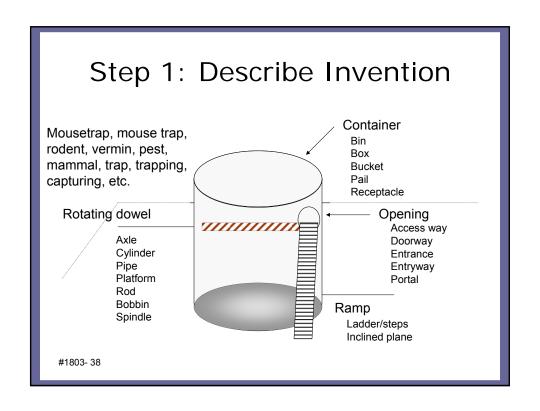
- 1. Describe the invention; note keywords.
- 2. Search keywords in classification index.
- Scan classification schedule.
- 4. Search selected classification(s). (Search both ECLA and IPC)
- 5. Study retrieved patents.
- 6. Check references of closely related patents.



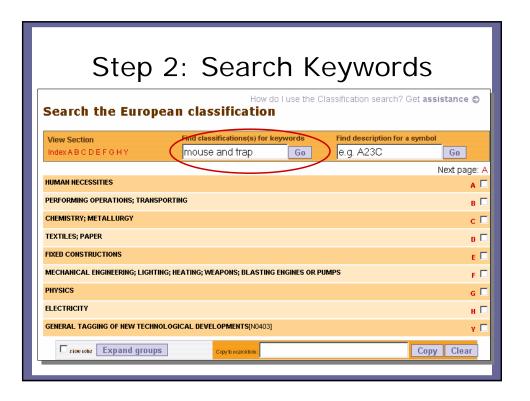
### **Keyword Searching Pitfalls**

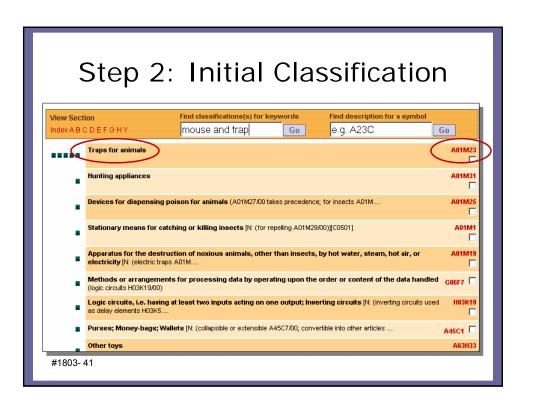
- Languages:
  - multi-language databases (esp@cenet)
  - American vs. British/Canadian spellings
- Limited search capabilities.
- Limited to title and abstract.
- Titles and abstracts not available.
- Synonyms, abbreviations, chemical nomenclature, etc.

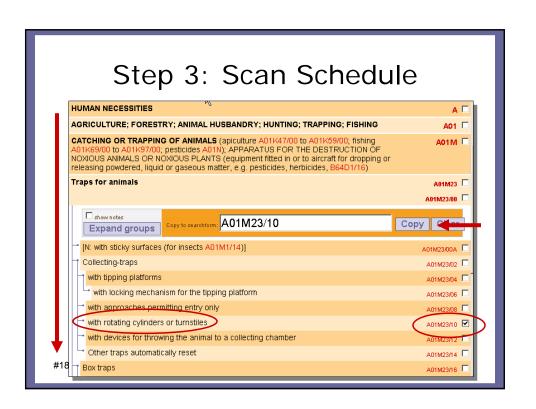




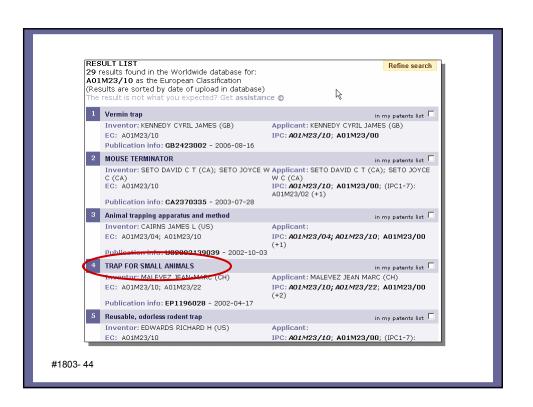


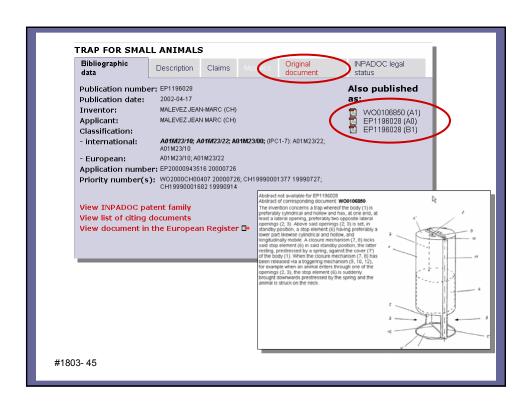


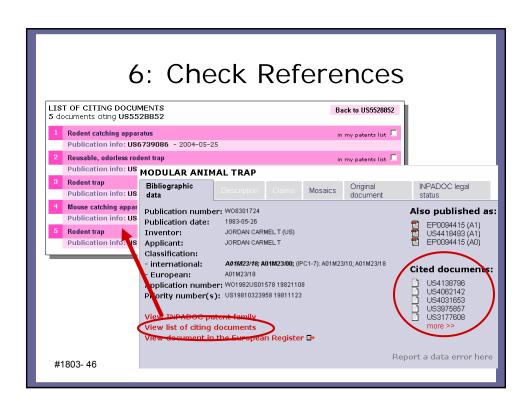


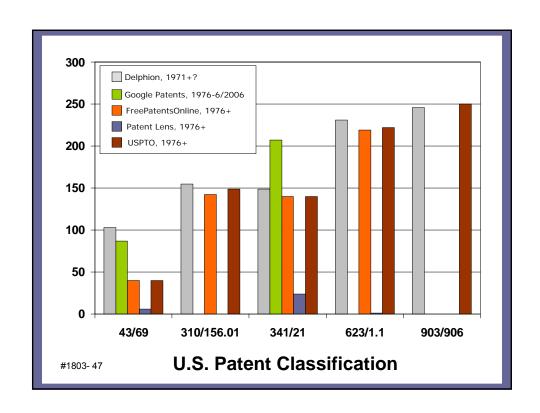


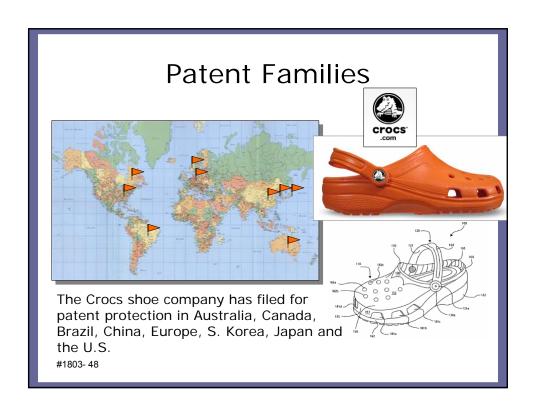
2. Search terms	Ľ¢
Enter keywords in English	
Keyword(s) in title:	plastic and bicycle
Keyword(s) in title or abstract:	hair
Publication number:	WO03075629
Application number:	DE19971031696
Priority number:	WO1995US15925
Publication date:	yyyymmdd
Applicant(s):	Institut Pasteur
Inventor(s):	Smith
European Classification A01M23/10 (ECLA):	F03G7/10 29
International Patent Classification (IPC):	H03M1/12 117

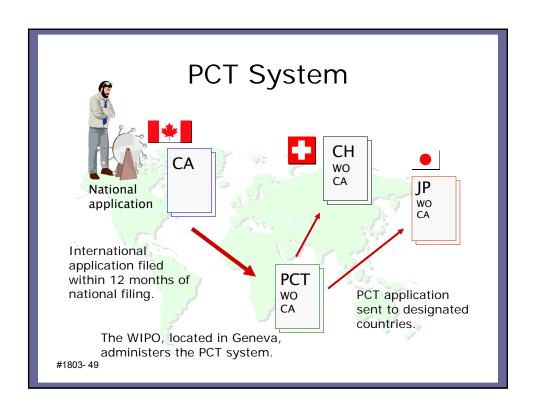










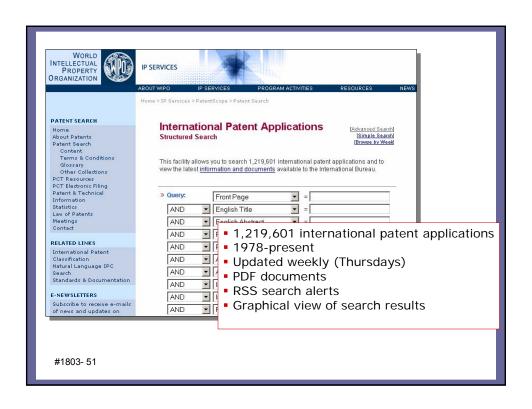


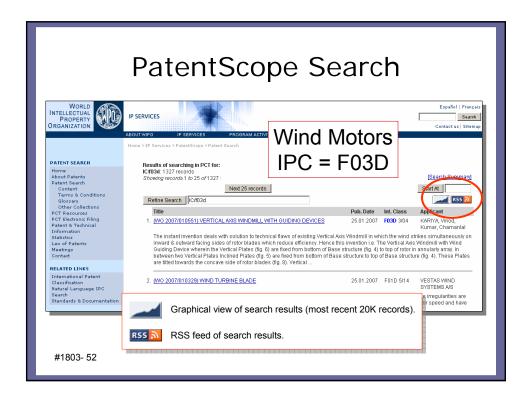
### Scenario 4: Market Research

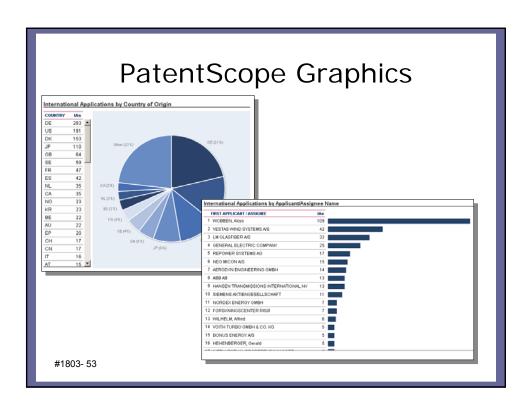


Q: What countries and companies worldwide are active in wind turbine technology?

A: Consult WIPO PatentScope database of international applications.







### **Patent Status**

- Assignment changes
- Expired, Corrected, Withdrawn, Extended, etc.
- EPO
  - esp@cenet INPADOC Legal Status
- USPTO
  - PAIR System, 2003-
  - Assignment Database, 1980-

# Top Ten Patenting Organizations in the U.S. and Canada (2004)

Canada			USA		
1. 2. 3.	Proctor & Gamble Lucent Honda	205 138 122	1. 2. 3.	IBM Canon HP	2,941 1,828 1,797
4.	Baker Hughes	95	4.	Matsushita	1,688
5.	3M	85	5.	Samsung	1,641
6.	Illinois Tool Works	83	6.	Micron	1,561
7.	L'Oreal	80	7.	Intel	1,549
8.	Deere & Co.	78	8.	Hitachi	1,271
9.	Schlumberger Canada	74	9.	Toshiba	1,258
10.	Dupont	73	10.	Fujitsu	1,154

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Sources: Canadian Intellectual Property Office, U.S. Patent and Trademark Office.

