

Innovation searches you should be aware of

A summary of common IP searches that business owners & entrepreneurs will come into contact with

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A business owner with a new innovation – whether it is an invention, a creative expression or a new marketing tag, among others – often receives prudent advice to have a search performed for comparable intellectual property. Intellectual property practice makes extensive use of searches. The more common searches that the business owner/entrepreneur will come into contact with or have occasion to use include:

Patent searches

There are different types of patent searches depending on what is being searched for.

Novelty or patentability searches

These searches help to answer the question: Can I get a patent on my invention? These searches encompass all prior art, whether dead, invalid, U.S. or foreign. These searches typically only answer the first of the two main patentability questions – that is, whether the invention is novel in light of the prior art. The second question, much more murky, is

whether the invention is obvious in light of the prior art. These searches cannot definitively answer that second question, but can give guidance to a patent professional, and perhaps suggest design around tactics.

Infringement searches

Infringement searches are also called right-to-use searches, clearance searches, or freedom of operation searches. Whether you wish to get a patent or not, you will wish to know if producing and marketing your invention may infringe the claims of someone else's patent. These searches are narrower because you don't care about dead or expired patents. The relevant date range is the last 20 years, and if you are only interested in the U.S. market, you don't care about foreign patents. These searches are also more narrow than novelty and invalidity searches in that you only care about patents, not other types of prior art. Like invalidity searches, these searches focus on individual claims of patents.

Invalidity searches

Invalidity searches seek to answer the question: Was the patent issued erroneously such that it should be invalidated? These searches, which focus on individual claims in a patent, are typically more time consuming than a novelty search. The focus is on finding prior art that existed before the patent application was filed, and which was not cited to or considered by the Patent Office during the examination of the patent application. Just like novelty searches, invalidity searches are not limited to patents and patent applications, but anything which may be prior art, such as an industry report, pre-existing apparatus or trade journal article.

State-of-the-art searches

These are very different types of patent searches. The point of these searches is to allow researchers and developers to see the current state of development in a particular field of endeavor.

Trademark searches

Also called trademark clearance searches and name availability searches, this type of

search is performed to see if a name is appropriable for use as a trademark, both from the perspective of eligibility for registration and from the perspective of avoiding using someone else's mark. These searches typically search not only state and federal trademark and corporate name databases, but also yellow pages, phone books and the Internet, among other sources. As might be expected, expanding the search beyond U.S. borders dramatically increases the cost of these searches.

Copyright searches

Copyright searches are often the hardest of all searches to be confident about. Searches may be performed for titles and authors at the Copyright Office, and searches can be performed on Google, Google/Scholar and Google/Book. There also exist specialty libraries for various types of artists that can and should be checked, such as for music and the visual arts. But any type of search will necessarily omit huge swaths of published material that simply (a) has not been registered for copyright (even though it is copyrighted) and/or (b) has never been put on the internet. Moreover, when searching for material copyrighted at the Copyright Office, primarily only the title and author can be found, not the actual material registered. To do that, you have to submit a request for a copy of the deposit material, which can be expensive and take a long and undeterminable amount of time.

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Comments

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