

MANAGEMENT

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INTERNAL PATENT SEARCH

Abstract. §7 of act no.435/2001 from Codex involving patents, supplementary protection certifications and amendment and complement of other acts (further just “the patent act”) mentions that “the invention is considered as a new one if it’s not part of state of the art. Anything that has been made accessible to the public in any form or any place before the registered person claimed the right of priority is considered as state of the art.”

Keywords: patent search, intellectual property, World Intellectual Property Organization

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Introduction

Searches are made before registration of the application, launch of exploration, launch of new production program and so on; meanwhile they provide a whole overview of current state of the art for the person assigning research, which protects them from unnecessary investments into solutions that are already out of date. While resolving tasks related to discovering state of the art it may not be obvious at first, what information we’re going to search for. For that reason it’s important to first define objective and goal of the search and then identify which type of research is going to be conducted.

Search is a result of informational search and it provides a collection of information for given topic. Patent search is a collection of patent information, or more precisely of searched documents regarding certain topic or problem. The result of patent search is a list of relevant documents, including their evaluation.

Internal patent search and its importance

Regarding researcher’s job, any information stating that their idea or product is already well-known is crucial. Hence the objective of state of the art’s search is finding proof that solution whose author is confident about it being a new one, had been already described by someone else.

The pursuit of commercial use of university research results has led to many universities in Slovakia and abroad establishing Centers for technology transfer,

which should ensure effective interconnection of university research with commercial sphere. These centers provide support and counseling for researchers, university employees and students in the process of protection and commercialization of intellectual property that was created by them. Such support is provided by the Center for technology transfer of the University of Zilina as well and one of the provided services is also conducting of patent search.

Internal search at the UNIZA is based on:

- researcher's requirements – on account of directing their research or in relation to preparation of application before its registration and related definition of range of claims,
- guidelines for intellectual property manipulation under terms of the University of Zilina,
- for requirements of Evaluating commission of UNIZA while making a decision whether to claim/not claim a right for the subject of action – conducting search is part of methodical process (however it does not directly mention who is conducting the search, researcher can either conduct it on their own or have CTT UNIZA conduct the research, or in some cases it may be conducted by a patent assistant – only if UNIZA makes a contract with them that involves this activity),
- for requirements of Evaluating commission of UNIZA while making a decision about farther manipulation with the subject of action – search serves as a foundation for this decision. In annex no. 8 of Guidelines for intellectual property manipulation under terms of the University of Zilina is a description of a discussion of Evaluating commission of UNIZA, which results in a proposal for farther manipulation with the subject of action. Decisions of Evaluating commission of UNIZA are based on foundations, which include the search about state of the art from the ambit of subject of action.

Further bellow, there's a simplified process of conducting patent search of state of the art, which is also a summary of basic principles of making search about state of the art.

Procedure of making internal patent search about state of the art at the UNIZA

1. Definition of technical problem (search subject)

- formulation of invention's name/ technical solution in Slovak and also in English language (in interaction with the author/s),
- in case that author/s had already sent a Notification about making of subject of industrial property to CTT UNIZA, information about the name is available in this document.

2. Determination of key words (terms that perfectly describe fundamentals of invention/ technical solution or technical problem)

- a list of key words in Slovak, English, German and French language (for requirements of full-text search),
- in case that author/s had already sent a Notification about making of subject of industrial property to CTT UNIZA, list of key words in English and Slovak language is available in this document.

3. Classification of invention/technical solution

- classifying into symbols of patent classification according to International patent classification and Cooperative patent classification.

4. Making of research question/questions

- making a search chain while using patent classification and key words, or even other search criteria while utilizing logic operators. Option of using quick search by putting research question in one row or extended search while using research MASK. Modification of search question where necessary, or more precisely based on found results – their number and relevancy.

5. Systematic browsing of patent documentation and selection of relevant documents

Utilization of online research systems – available databases (particularly ESPACENET, Patentscope, Web registers of Industrial property office of the Slovak Republic) and research tools (e.g. GPI) during the progressive browsing of patent documents. It's necessary to add unpatented literature to the search. In this step there's also a reevaluation of the accuracy of selected classification according to found results, if necessary the classification is modified into symbols of patent classification.

6. Making a list of relevant documents

- evaluating of found patent documents and saving relevant documents into a list.

In this step, the list of documents that is being developed may be sent to the author for the checking of research process accuracy, after the confirmation, or more precisely correction by the author, they can continue in conducting the search (so called “two-round search”).

7. Making of search message

- search message is prepared in a template and its annex consists of the list of relevant documents with an option for access to full texts (either via links for database or full documentation makes up an individual annex of the message).

Search message is effective from a specific date, which is presented in it along with researcher's name and is instrumental to the authors (for direction of the research) but also presents a foundation for Evaluating commission's discussion. Evaluating commission writes a report based on search message. In case of agreeing to it, this fact is announced to authors via document called “Decision about claiming employer's right for solution of industrial property's subject.”

8. Feedback from authors

- reviewing of results by author/s during which relevant information are gained about “the usefulness” of results and potential collision of found documents with subject invention/technical solution.

9. Processing of search results from Industrial property office of the Slovak republic and feedback from authors

After delivering “official” search from Industrial property office of the Slovak republic to CTT UNIZA, search results are compared to internal search results made in CTT UNIZA for revaluation of chosen search approach and direction of employees of CTT UNIZA when conducting search in the future.

Then the search “is processed” for author/s needs and after sending processed search, feedback from authors is requested with regard to relevancy of documents presented in it that are necessary for UNIZA's decision-making and farther manipulation with the subject of action in the future.

These methods mostly serve for CTT UNIZA employees and that is for thorough development of internal patent search of state of the art for invention or technical solution, which is a result of inventive activity of employees, doctorates or students of UNIZA. The template of search message is supposed to provide foundations for Evaluating commission of UNIZA decision-making about the particular subject of action in a well-arranged way and it should consist of basic information about invention or technical solution, of range and area of search and list of search results along with researcher's commentary.

While making use of the institute of patent protection, inventions may be "transformed" into business assets with high commercial value. Patent and utility model present tools, which represent the university externally, but which also increase university's ability to benefit from results of research work. The value of patent protection depends on how well it is utilized. Hence it's important to opt for systematic approach for effective protection and commercialization of intellectual property made at the university including systematic research activity as well.

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2. Act No. 185/2015 Coll. on Copyright and related Rights as amended.
3. Act No. 435/2001 Coll. on Patents, supplementary protection certificates and on amendment of other acts (The Patent Act) as amended.

