

Patent search options for technology firms

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Protection of intellectual property (IP) in the form of trademarks, copyrights and patents is on the rise, as greater awareness of IP laws in Thailand has led to increasing numbers of business proprietors seeking to safeguard their valuable IP assets.

In particular, patent protection has become hugely significant in technology-related businesses. It plays a major role in safeguarding newly invented technology. Since patents are protected on a country-by-country basis, it is essential to file a patent application in all countries in which protection is necessary.

To be patentable, an invention must be new (to the world), involve an inventive step (in view of what is already known) and be capable of industrial application. A patent search is a key tool in identifying whether the invention, for which you wish to seek patent protection, has already been made known to the public. The search may be classified into two main categories according to its purpose: (1) prior art search; and (2) non-infringement or freedom-to-operate search.

A prior art search is carried out to determine the patentability of an invention and the grounds for patent invalidation. Such searches are especially beneficial if you are a business owner seeking patent protection for your invention. The results derived from a prior art search provide information on relevant inventions that are known in any prior art documents, including patents, books, journal articles, publications, presentations and other forms of prior public use.

When you are applying for a patent, you can use such inventions as background art for your own invention. Furthermore, you can review similarities between your invention and known inventions, in order to accurately assess whether your invention is patentable (i.e., new and involving an inventive step). Otherwise, your invention may require further modification. It is also possible to use the disclosures on the known inventions to identify defects and undertake necessary improvements to enable your invention to obtain protection under patent law.

While many technology companies would like patent protection for their own invention, some merely wish to utilise their technology without infringing the patent rights of other businesses. If this applies to your business, you should conduct a patent search in the country where you intend to utilise your invention, and obtain a legal opinion on whether any valid patents exist that would encompass your invention. These opinions, referred to as either "non-infringement" or "freedom-to-operate" (FTO) opinions, can be classified into the second category.

The patent search for a non-infringement or FTO opinion is focused on the country where your invention is to be used or commercialised and includes only unexpired patents and patent applications that are under prosecution in that country.

The search duration is usually limited to the patent protection term, which means that it covers 20 years prior to the date the search is conducted. The search examines the language in claims of third-party patents and patent applications, to determine if the claims cover aspects of the invention in question or raise any risk of potential infringement.

Therefore, the keywords used in the search need to be carefully selected so that they encompass all the specific terms (and synonyms) to identify an existing invention in the claims. Once the search result is obtained, a non-infringement or FTO opinion can be prepared, depending on the purpose of the search.

While non-infringement and FTO opinions are very similar, there is one key distinction. On one hand, a non-infringement opinion focuses on a specific patent(s) that you, as the business owner, have become aware of and provides assurance that your invented technology will not infringe such patent(s). A non-infringement opinion is usually recommended when you plan to commercialise an invention that is similar to an existing patented one.

On the other hand, an FTO opinion has a broader scope and addresses the possibility of infringing any patents in force, regardless of whether these are known or unknown to the business owner. This opinion can offer you a degree of assurance that no relevant patents exist that will affect the commercialisation of your invention. This means you are "free to operate" without risk of infringing any third-party patents.

In Thailand, although a patent search can provide information on inventions that are publicly available, it cannot ensure that there are no other similar inventions, even if the search reveals zero hits. This is because the patent search does not reveal all the inventions filed with the Thai Patent Office; it only reveals those inventions that were allowed to proceed to publication in the official Patent Gazette.

Therefore, it is conceivable that some of the relevant inventions may not be uncovered by a patent search. Nevertheless, a search remains the most important and practical tool in assessing potential patentability and non-infringement of an invention. The scope and depth of the search must be properly determined and carried out in order to give effective and meaningful results that will help your business determine whether to patent.

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