



CORPORATE COUNSELLOR

Using patent searches to add commercial value

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A patent is a type of intellectual property that can provide protection for a design, the invention of a product, or the process of making an invention. For a patent to be granted, one of the key requirements is that it must be new or novel. But beyond its novelty, a patent also has commercial value.



As innovation and technology development gain more prominence in today's world, individuals and companies are focusing more of their attention on developing and commercialising inventions and are becoming more aware of the importance of patents and their potential to add value to their businesses and products.

A patent application represents the forefront of design and technology. Each year, Thailand's Department of Intellectual Property (DIP) receives an increasing number of patent applications, most of which have been filed first in another country, with the Thai application claiming priority from the original application.

A patent application submitted to the DIP is not disclosed until it has been published. Therefore, the department hosts a library of published patent applications that is accessible to anyone and does not require a membership fee. Other patent offices around the world, including those in Europe, Japan and the United States, have similar databases you

can search free of charge. However, the scope of your search will depend on your objectives. At Tilleke & Gibbins, our clients typically ask us to conduct three very different types of searches:

1. Prior art search: You should conduct a prior art search before drafting the specification for your new patent. The prior art search report consists of worldwide patents or published applications obtained from various databases and other relevant publications, scientific journals and other media existing in the public domain. The objective is to evaluate the novelty of your invention and whether it can be protected as a patent.

When conducting a prior art search, you need to have the design or know the invention in detail in order to create the key strings used in the search. Because you want to ascertain the novelty of the design or invention, you need to conduct this search worldwide. Most worldwide database search engines require membership fees, though this additional cost can be avoided by conducting patent searches in multiple databases.

Importantly, not all designs or inventions may be disclosed in databases of published patent applications, so you should also search non-patent literature.

2. Patent search: This is the most customised type of search, in which you can set the search on a particular applicant, the inventor's name, or the date the patent was filed, published or granted. Businesses usually focus these searches on the name of the applicant in order to keep an eye on the activities of their competitors.

Another objective is to understand the number of published patent applications in a certain time span or to understand which applicant has been active in that field.

It is crucial you determine the right search strings to meet your objectives. A patent agent well-trained in your specific design or invention can accurately help you determine the search strings.

3. Freedom-to-operate search: If you want to import, manufacture, sell or offer for sale an unpatented invention, you should conduct a freedom-to-operate (FTO) search before introducing the product. This search, which needs to be conducted country-by-country, lists designs or inventions protected in each country.

Because patents have tremendous commercial value, many patent owners are prepared to take aggressive action against any infringers, so it is important to conduct an FTO search for the countries where the unpatented invention will be manufactured, sold and imported.

The FTO search strings will be based on the unpatented invention and searched in the databases of the selected countries. Thus, the unpatented invention must be well defined. It will cover patent applications that are active and will not include those whose period of protection has already lapsed. In Thailand, for example, the FTO search will cover applications filed within the past 10 years for designs, 10 years for petty patents and 20 years for invention patents. Once the search has been completed, further analysis of the risk of infringing any registered patents or published applications will be required.

Patent searching on a well-defined subject is not difficult. In fact, you can get started by trying to conduct a patent search on your own, using any of the free patent databases offered by various patent offices around the world.

Reading the existing patents and published applications can provide insight for your business on how to obtain value around your innovations or make you aware of the risk of infringing a possible patent. It may even spark a new idea that will lead to an invention for your company.

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