

Outsmart the Competition: 10 Patent Research Tips

IEEE Consultant's Network

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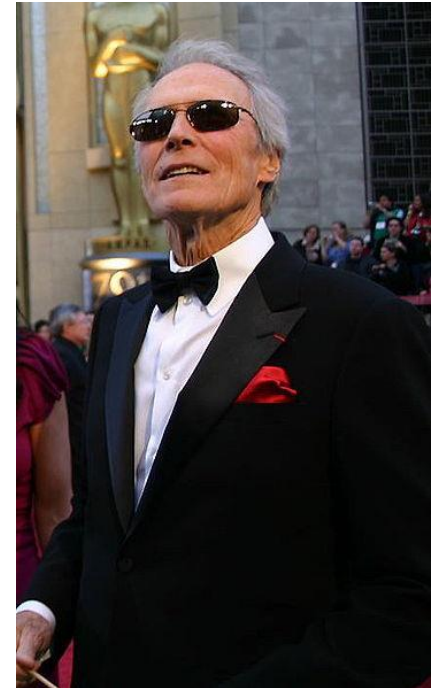
The Pearson Strategy Group, LLC

Abstract

Researching patents is an important step in evaluating your position in a marketplace and establishing your long-term strategy. You can learn where competitors are spending their R&D money, which new technologies are headed for the marketplace and discover business opportunities or threats. This discussion will cover these topics as well as how to use targeted alerts to keep up with your competitor's activities in real time.

Agenda

- Whose picture is this?
- Background
- About the Pearson Strategy
- Information about information
- 10 patent research tips
- Summary



Background

- This presentation is not about the legal process for patenting an idea.
- Future markets can be revealed by recently filed **Intellectual Property**.
- I'm not a patent attorney or agent (and I don't play one on TV!).
- Large companies often have internal people/groups dedicated to the topics described in this presentation.
- Questions and comments are always welcome (except from the guy in the back corner).

About Pearson Strategy



- The Pearson Strategy Group is an on-call Research, Intellectual Property and Strategy team for companies wanting to accelerate innovation or product development.
- Our clients want to make money, not waste it on trial and error.
- Our flexible suite of services includes concurrent expertise in technology, patent research and markets.
- Consider us your personal R&D department.

Contact PSG when you need:

- To shorten your R&D cycle time and reduce risks.
- Competitor information, including those you don't know exist.
- To identify and prioritize new opportunities.
- Intellectual property help:
 - Has anyone thought of this before?
 - Can you manufacture a new or modified widget without being sued?
 - Does it makes sense to patent my new idea?
- To find out if there is a market for your new idea and how to sell into it.
- To develop and maintain a long-term strategy.

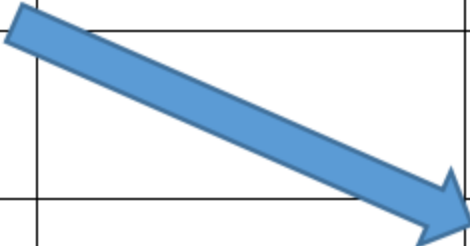
The Information Funnel

- Balance your costs, time, risk tolerance, industry competitiveness and how much information you really need.
 - (Top of funnel) Do you need a lot of information so that you don't miss anything important?
 - (Bottom of funnel) Do you need some “perfect” information that misses some critical information?
 - A high-level/statistical approach may reduce the size of your funnel.



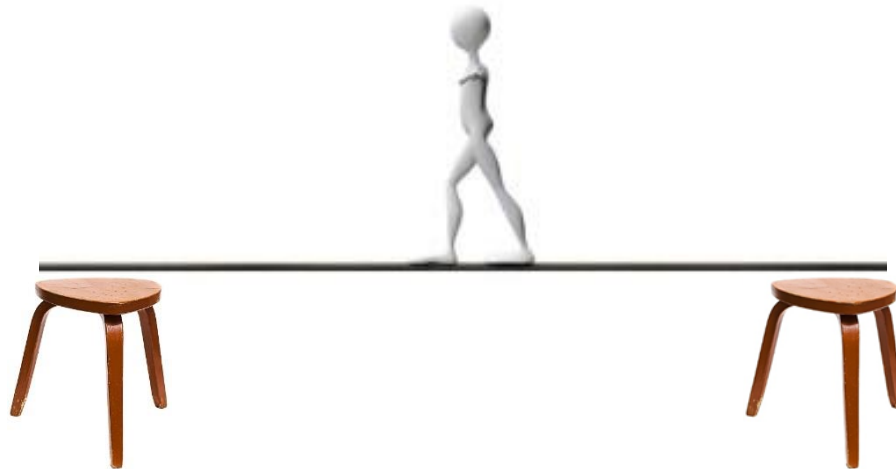
Internal v. External Resources

Internal Resources	Information Needed		
	Minimal (Low Risk)	Some	All Available (High Risk)
Many	Handle Internally		
Some			
Few			Use External Resources



Today's Focus

	Competitive Intelligence	Innovation	Strategy
IP	X	X	
Market			
Technology			



Tip #1

- Don't invest your time and money to get a patent unless you can justify the financial return. (Do market and customer research.)
- Conduct some cursory due diligence before making large investments; set a lower threshold, perhaps \$1,000, before any big spending.
- For small entities, start with these utility patent cost estimates:
 - ~\$10k for attorney, prior art research, drawings, USPTO filing and publication fees*
 - ~\$10k for effective marketing and licensing*



* This amount will vary for many reasons.

Photo credit: Rugby471 (Wikimedia)

Tip #2

- Many IP Attorneys and law firms do not have an in-house specialist for IP research.
- Bring your prior art research to your attorney/agent so they can better define the claims of your patent application.
- Scale the dollars spent on prior art research according to your risk and gain.



Tip #3

- Every prior art researcher will deliver different data.
 - Part science/part art.
 - Differing resources, methodologies and tenacity levels.
 - How close is close enough to your needs?



Tip #4

- Prior art may not be obvious or published (yet).
 - Patentability is determined by prior IP in any country and other publicly available information.
 - An 18 month publication lag after filing is typical for most of the world's patent authorities; conduct thorough research today and then do a quick refresh in 18 months.
 - Don't apply for a patent only to find out published prior art exists. This wastes your time and money.
 - Don't get a patent only to find out later that published prior art exists when a competitor initiates a re-exam. Re-examinations can remove/alter your patent's claims, wasting significant amounts of your time and money while annoying your customers.

Tip #5

- Start Early with Freedom to Operate research for new products or product revisions.

“Discourage litigation. Persuade your neighbors to compromise whenever you can. Point out to them how the nominal winner is often a real loser—in fees, expenses, and waste of time. As a peacemaker the lawyer has a superior opportunity of being a good man. There will still be business enough.”

—Abraham Lincoln

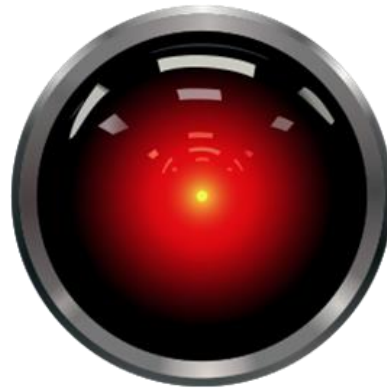
Tip #6

- Alerts monitor information resources in real-time using your criteria and then notify you when those criteria are met.
- Types of alerts:
 - Automated
 - People
 - Hybrid
- Monitor for opportunities, threats or interesting subjects (even when you don't have specifics in mind).
- Stay ahead of the competition.
- Examples of Google, Apple and 3D-printing patent application alerts can be found at <http://pearsonstrategy.com/alert-demonstration/>



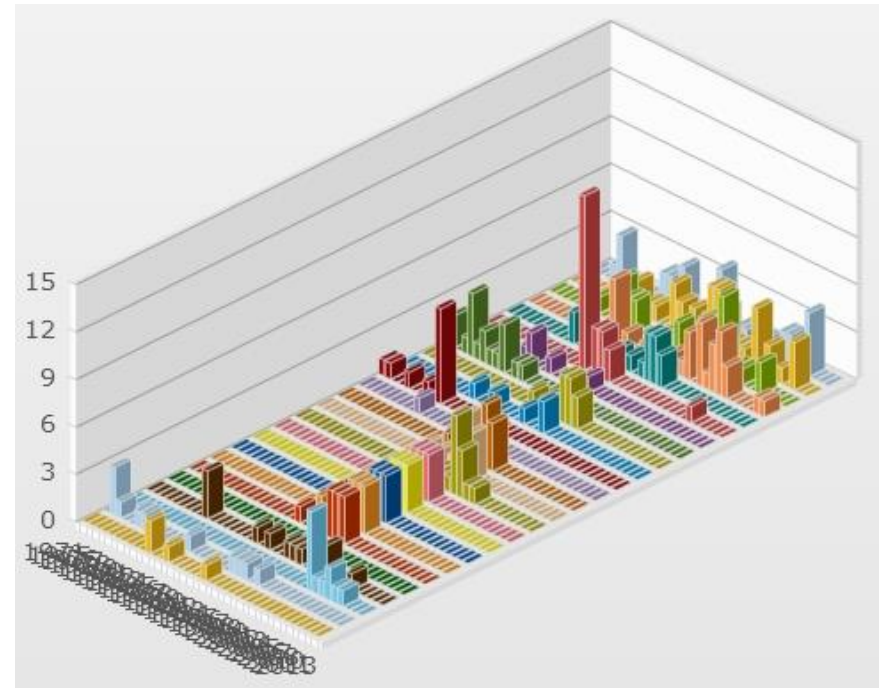
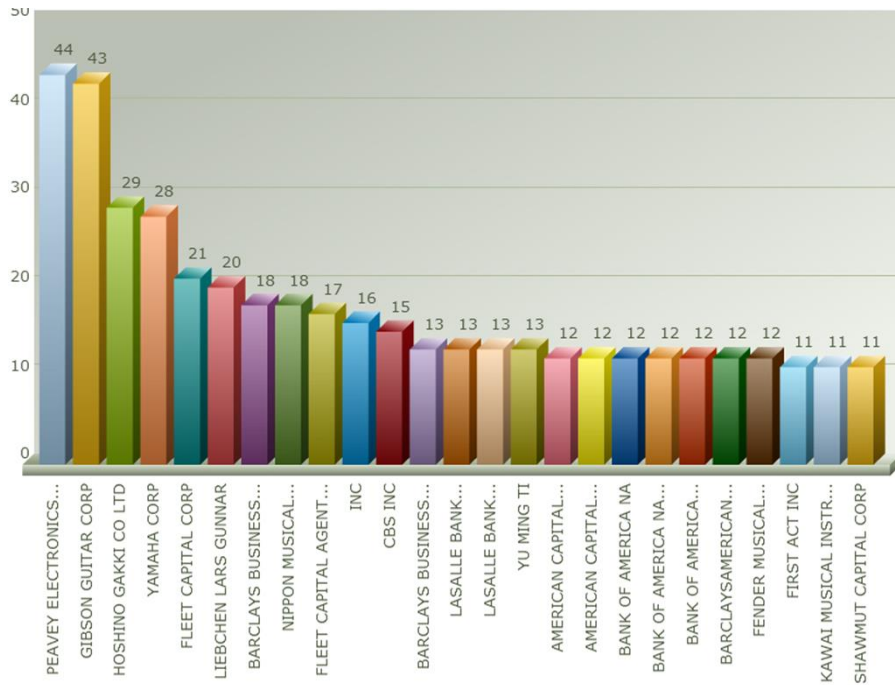
Tip #7

- Monitor for citations to your IP. The applicant might be blocking the advancement of your technology and IP (and market).



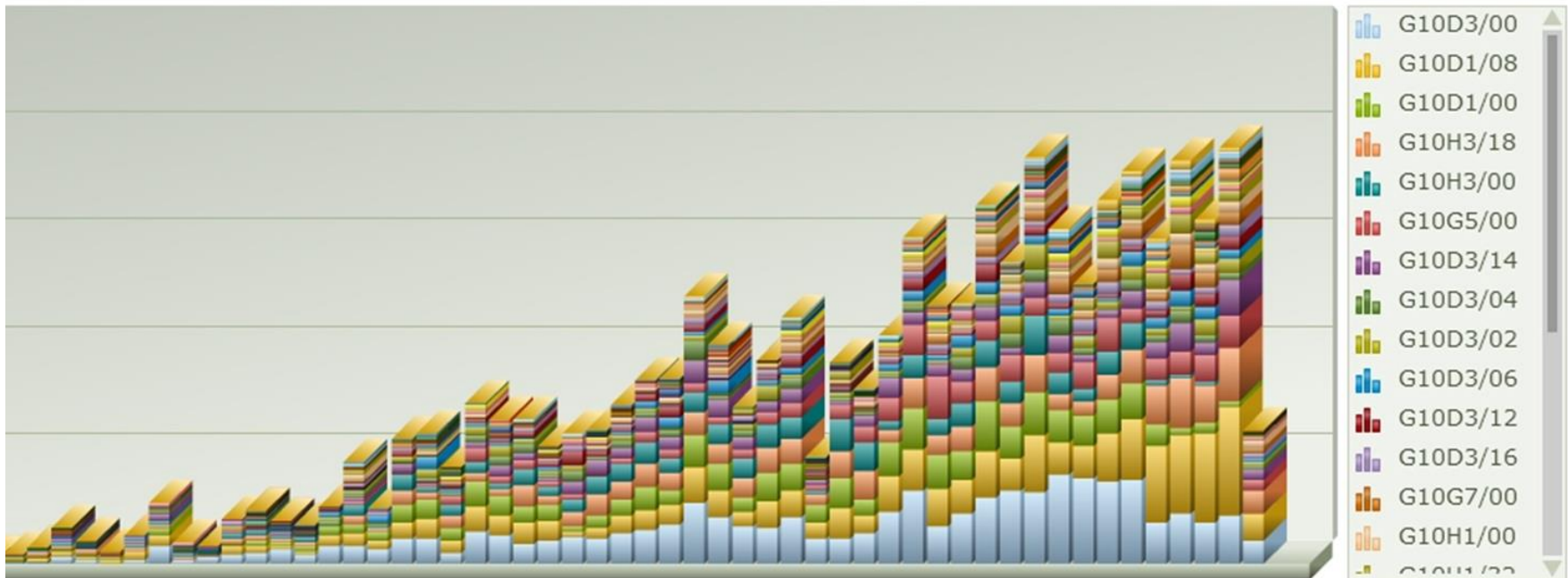
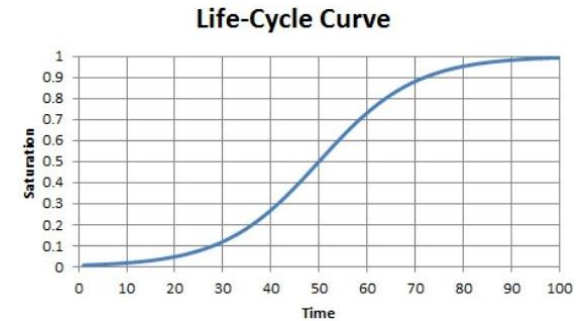
Tip #8

- Use Patent Analytics to gain a high-level perspective.



Tip #9

- Use Analytics to scout for future opportunities



Tip #10

- You can, and should, use free research services.
- But NOT for making significant decisions or legal activities.
- Free services include:
 - Google Patents
http://www.google.com/advanced_patent_search
 - Google Scholar Alerts can include patents and/or technical publications <http://scholar.google.com>
 - Espacenet is best for world-wide information that is organized by patent family and has PDF downloads.
<http://worldwide.espacenet.com/advancedSearch>

Closing Remarks

- Start early.
- Know your information load.
- Know your risks.
- Think worldwide (most of the time).
- Patent authorities of the world have created huge databases for you to leverage in accelerating your innovation cycle.

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