Focus on This

If you can read this you are too damn close as this is eight font.
Searching patents: Background, careers and the future

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Why Patent Searching?

• A patent applicant must disclose all that is known about an invention at the time of filing an application
• In order to avoid surprises, the applicant conducts a search of the prior art to locate publications about similar inventions
• There is no legal requirement to do a search, but one must disclose all that is known about an invention
What is patent searching?

• The patent searcher looks at just about anything that was published prior to the application date, including:
  – older US and international patents
  – journals
  – book chapters
  – conference papers
  – newspaper articles
  – press releases
  – sales brochures, catalogs, etc. - anything published!
Types of patent searches

• Patentability (aka novelty, prior art)
• Equivalent (aka family search)
• Infringement
• Current awareness (manual and electronic)
• Validity (actually invalidity)
  – Used in litigation (nearly unlimited budget)
  – Also for in-licensing
How does it differ from literature searching?

- Involves retrospective searches of the literature to find *everything* about an invention...not just a quick answer
- Current awareness searches to keep apprised of what others are doing
- Involves an understanding of classification codes (US and International), cited patents, and patent families
What is a typical search?

• Starts with a search request
• Interview with researchers
• Guidance from attorneys
• Manual resources (Merck Index, Orange book, etc.)
• Internal resources (CDROM, network, etc.)
• Online
  – Internet
  – Vendor
What is a typical search?

- Use US and International class codes, manual codes, other special indexing
- Some drawing programs available for molecules
- Involves general knowledge of other, similar technologies
Why is patent searching different than other searching?

• Markush structures
• Almost anything can be “prior art” including verses from the bible
• Patents are written to be defended in court, not to be found by people like you
• Patentese abounds;
  – General terms vs. specific terms
  – Lexicography is up to the individual
  – Word order changes, familiar phrases are changed
Markush group

![Markush group structure](image)
Markush group

• DETAILED DESCRIPTION - 2,3-benzodiazepine derivatives of formula (I) and their acid addition salts are new.
  X=H, Cl or OCH3;
  Y=H or halo;
  Z=methyl or Cl;
  R=1-4C alkyl or NR1R2; and
  R1, R2 =H, 1-4C alkyl, 1-4C alkoxy or
• 3-6C cycloalkyl.
9. The cleansing and care agent according to claim 1, wherein the solid body comprises as surfactant for a predominant cleansing and wash function at least one anionic surfactant in the solid phase, taken from the group consisting of the C[sub]8 - to C[sub]22 - fatty alcohol sulfates and sulfonates, alkyl aryl (benzene) sulfates and sulfonates, their alkali (Na, K), earth alkaline (Mg), ammonium salts and their mono- and di-ethanol amides, of the customary soaps as well as of the C[sub]12 - to C[sub]20 - fatty acid mono- and di-ethanolamides, thio-succinic acid
Markush Claim

What is claimed is:

1. A sandwich comprising:
   two slices of bread, and
   an edible container inserted between said two slices of bread, said edible container housing a food therein and structured to have a V-shaped configuration and contain an outward bent circumferential end edge disposed along the top and a plate bottom thereof for causing the edible container to tightly adhere to the inner surfaces of two slices of bread wherein the food is a food selected from the group consisting of noodles, hot dog, cooked vegetable, fresh salad, cooked or fresh mushroom, barbecue foods, fruit jam, gel butter, and a mixture thereof, whereby the food is contained in a sufficient quantity therein while at the same time it is prevented from falling from the sandwich. (Main Claim)
Manual Searches

• Conducted at US Patent and Trademark Office
  – Just outside of Reagan National Airport (WDC)
  – Need class codes for invention
  – Pick up stack of paper and flip through it
  – Smaller collection located in Sunnyvale, CA
  – Often conducted by local searching organizations

• Help available at Patent and Trademark Depository Libraries (PTDLs) in every state
What is a typical day?

- You just finished a search, you have one more started and two more in the IN basket
- You spent a half hour online and two hours going over the output afterwards
- You met with several clients about a search
- You scanned newly published applications/patents for current awareness
- You were asked to find an English equivalent of a non-English publication, usually Japanese
What is a good day?

- A researcher client returns every week with a new search…and asks you to do it personally
- A client brings a friend to watch you work
- You save your company $49 million
- You meet with two researchers who share their ideas with you dealing with some new chemistry that you find fascinating
What is an excellent day?

• You’ve been named an inventor based upon your suggestion for a new use that the inventors did not think of but of which you knew of from another search

• A client brings a friend and his boss to see you work

• You get $100 for saving the company $49 million

• You just found something no one else found
A most excellent day

- You just saw a product on the shelf in which you knew about because you ran the search years ago
What is a bad day?

• The attorney to whom you gave your search results got $10,000 for helping to save the company $49 million
• You don’t find something that you know is there and the budget won’t allow you to look elsewhere
• Your network is down
What are the job requirements?

• No formal requirements
• Technical background
• Familiarity with computers
• Usually a scientific degree
  – Sometimes a library science degree
  – Sometimes an information science degree
  – Patent agents preferred in some locations
What is the difference between a patent agent and a patent attorney?

- A patent attorney is an attorney who has passed the patent bar exam
- A patent agent is a non-attorney who has passed the patent bar exam
What is the patent bar exam?

- Two three-hour tests with 100 multiple-choice questions each given twice/year
- Morning test covers patent law
- Afternoon test covers claim drafting
- Given in the fall and the spring in several major US cities at the same time
- Open to anyone with a scientific/engineering degree/experience (proven by transcripts/affidavit)
The patent bar exam

• Need to swear an oath, including “no crimes of moral turpitude”
• $300 to take the test
• $100 for certificate after you pass (no further fees for life)
• 25-60% pass rate
• Good to take a cram course (Patent Resources Group, Practising Law Institute)
• Again, not always necessary
Where do patent searchers fit into an organization?

- Some fit into legal
- Some stay in research
- Some fit in between the two
- Others work out of the library
- All are privy to leading edge research
Any chance for a patent searcher to make money?

- Overall average salary was $68,300 in 1999 (PIUG Salary Survey Report – 1999)
- $74,600 projected to 2002 with 3% raises
- Geographic ranges:
  - $60,800 – Mountain & Pacific
  - $63,000 – South Atlantic
  - $64,500 – East Central
  - $69,000 – West Central
  - $69,800 – New England
  - $76,800 – Middle Atlantic
Money, money, money…

• In PIUG survey, 10% of respondents made more than $100,000 in 1999
• 70% of respondents were chemists
• Patent agents did not make more money than others with similar backgrounds
• New data collected this summer and will be available in October
More money

- ACS Salary Survey (C&E News, Aug. 5, 2002)
  - Chemical Information (closest segment to patent searching) with bachelor’s degree made $71,500 vs. $56,600 for applied research, though for Master’s degree and Ph.D., reverse was true, but dollar figures were closer
  - All chemists median salary was $76,500
Are there any educational programs?

• Franklin Pierce Law Center has a program on patent searching
• Indiana University - Chemical Information
• University of Texas at Austin
• University of California, San Diego
• Vendor training - STN, Questel/Orbit, Dialog
Special desirable skills

- Lab experience is most critical
- Language skills, especially Japanese, followed by German, French
- Internet skills, especially advanced searching on various search engines
- Advanced degrees always useful
- Organizational skills, especially ability to handle multiple tasks for multiple “bosses”
Special skills

- Ability to work unsupervised, under deadline and must focus intensely
- Love of the hunt
- Tenacity
Bennies

- Some searchers can work at home - all that is needed is a telecom line (cable, DSL, phone/modem) and a computer
- Can sometimes juggle work around a schedule
- Knowledge of the passwords and the access method gives some job security
Reading materials

• “Patent it Yourself” by Michael Pressman, second edition, Nolo Press - plus other Nolo publications at www.nolo.com


• www.freepint.com/issues/100102.htm#tips
Organizations

- Patent Information User’s Group (PIUG) at www.piug.org
- ACS Chemical Information Division at www.lib.uchicago.edu/cinf/
- Association of Independent Information Professionals (AIIP) email AIIPinfo@aiip.org
- Pharmaceutical Education and Research Institute at www.peri.org
The future

• The USPTO now publishes an average of 3,500 documents weekly, up from 2,300 weekly in 1992
• Projected publication of 5,000 per week by 2005
• Overseas patent authorities see similar increases
• New provisional applications are inviting more independent inventors to file early, thus increasing demand for patent searches from a new base
• Patent litigation increased from 1270 cases filed in 1992 to 1871 filed in 2001
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