



OMTEC 2014

Effective Tools for Patent Searches

Management has given the go-ahead to design a new device. As an engineer, you'll now conduct a patent search to ensure that your technology won't infringe upon other patents. What tools—free or otherwise—should you use to ensure that your patent search is comprehensive?

Jeff Tyber, President and CEO of Tyber Medical, posed that question to the intellectual property due diligence panel he moderated at OMTEC 2014. The experts weigh in below:

Diane Dobrea, Legal Counsel, Kapstone Medical: I have a database that we pay for, and it's a great place to capture, analyze and print out results that you can use to review. I use Google Patents; I use the U.S. Patent and Trademark Office (USPTO) search engine. I also do sideways searches. By that I mean, if I do a search and get a result and find a patent of interest, I also search by inventor or by family member. A lot of times I'll find an equally relevant patent that is part of the family of the one I pulled up. No search is perfect. You don't always pick the right terms. Different patent attorneys use different parlance, even within the same family, and will evolve their portfolio and start using different terms that will appear in the patent application that didn't appear in the claims in an earlier filed case. It's a process of digging and peeling apart.

David W. Meibos, Founder, Maywood IP Law: Keyword searching in Google is a great tool. Also, you can use classification codes; you can use citations where examiners have found similar art. There's a tool I like for that called AmberScope. It shows you graphically what patents are related and linked to the ones you've already found.

John Boger, Partner, Heslin Rothenberg Farley & Mesiti P.C.: As an engineer, when you're looking at the face sheet of the patents, you will see classifications underneath that, so you don't have to reinvent the wheel. They'll actually list it on the face of the patent. Use that as your starting point when you find an on-point piece of prior art. Take that classification and plug it into the USPTO database. Also, when you're using the USPTO database, don't search the entire patent, because you'll get a lot of garbage. Focus on the abstract. Understand that the USPTO database is constructed by Federal employees and those are the same people employed by the IRS. It's not the greatest tool out there. Google Patents, like Diane and David mentioned, are much better.



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