

Ridout & Maybee LLP

CANADA'S INTELLECTUAL PROPERTY AND TECHNOLOGY LAW FIRM

3 / 29 / 2011

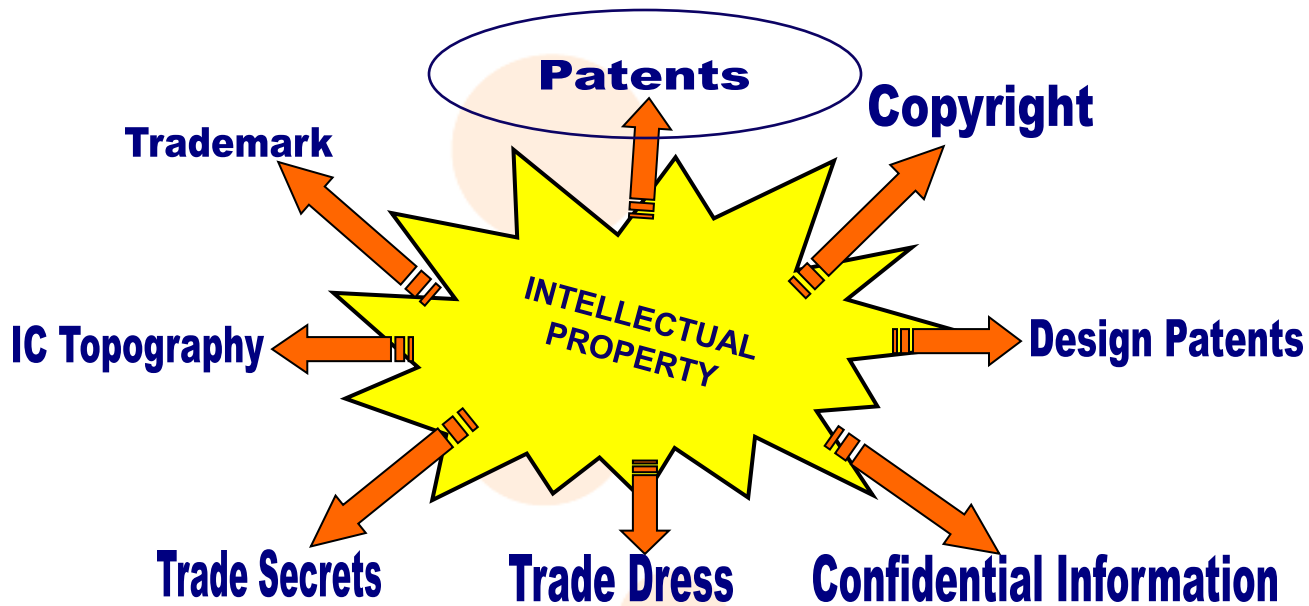
Identifying and Obtaining Patents for SR&ED Practitioners

it all starts somewhere

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Introduction



it all starts somewhere

1) Introduction to Patents

WHAT IS A PATENT?

An exclusive right to prevent others from making, selling or using an invention.

Patent term is 20 years from the filing date.

To promote investment in research and encourage sharing of information:
"Patents fuel progress - Technologically sophisticated nations like Canada depend on the patent system for both scientific advancement and economic strength." - *Canadian Patent Office*

Patent must be new and non-obvious

→ Keep your invention confidential until filing

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Patent Offices

Country	Website
Canada	http://strategis.ic.gc.ca/sc_mrksv/cipo/welcome/welcome-e.html
U.S. (*)	http://www.uspto.gov/patft/index.html
Europe (*)	http://ep.espacenet.com/?locale=EN_ep

2) Tools and Searching Methods

Third Party Searching Tools

Name	Website
Google US patents (*)	http://www.google.com/patents
Delphion (\$)	http://www.delphion.com/

Patent Download Websites

Name	Website
Google US patents	http://www.google.com/patents
Patent Fetcher (*)	http://sughrue.patentfetcher.com/
Pat2Pdf	http://www.pat2pdf.org/

2) Tools and Searching Methods

1) Patent Offices

Source websites for searching of a particular country or region's Patent Office records

Advantages

- Database is based on the official Patent Office records

Disadvantages

- Limited to specific country (except Europe P.O.)
- Some search fields are limited or hard to use
- Basic search engine algorithms (boolean)
- Page-by-page downloading of patents is cumbersome
- US database separates patents from applications

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2) Tools and Searching Methods

1) Patent Offices (U.S. Patent Office)

US PATENT & TRADEMARK OFFICE
PATENT APPLICATION FULL TEXT AND IMAGE DATABASE

[Help](#) [Home](#) [Boolean](#) [Manual](#) [Number](#) [PTDLs](#)
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Data current through September 11, 2008.

Query [\[Help\]](#)

Term 1: in Field 1:

Term 2: in Field 2:

Select years [\[Help\]](#)

2) Tools and Searching Methods

2) Third Party Searching Tools

Proprietary software or websites which allow searching of different country databases

Advantages

- Flexibility and natural language searching e.g. Google patents
- Good litmus test approach
- One source may be able to search multiple databases – one stop shop

Disadvantages

- Possibly additional \$
- Reliant on the source databases
- Broad search results may not give you the answer

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2) Tools and Searching Methods

2) Third Party Searching Tools (e.g. Google patents)

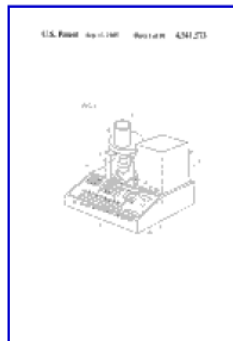
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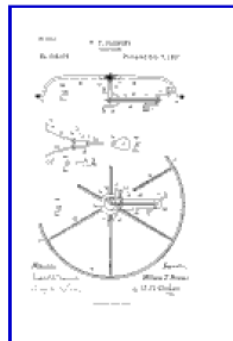


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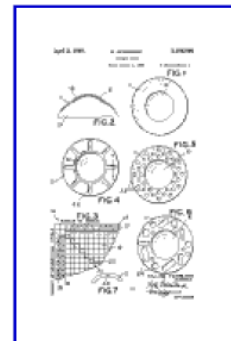
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[ARTIFICIAL FLOWER](#)

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2) Tools and Searching Methods

3) Patent Download Websites

Provide full pdf versions of patents

Advantages

- Does not require page-by-page downloading
- Time-saving
- Should be used once searching is done to obtain patents

Disadvantages

- Poor search functionality – only accepts the patent number
- Additional logos added to documents

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3) Identifying the invention

Functional Analysis

Structural Analysis

Other Approaches

it all starts somewhere

3) Identifying the invention

Functional Analysis vs. Structural Analysis

Functional Analysis

- Identifying features by their function rather than structure
- Requires broader thinking
- Allows you to understand the invention
- Better results down the road

Structural Analysis

- Identifying features by their structure rather than function
- Good litmus test - Easier to perform initially
- May not cover equivalents
- May miss important results

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3) Identifying the invention

Step 1: Functional Analysis

- Make a chart
- List all the functions or actions that are happening in the invention
- Use "action" words (gerunds, i.e. words that end in "ing")
- Ask yourself what manipulative steps are occurring
 - e.g. - what is it doing?
 - what are we doing to it?
 - what is happening or going on?
 - how/why is it working?
 - what actions are need to make it work?
 - what are the advantages of the invention
- Write down everything you can think of without considering its importance at this point
- Avoid the use of structural terms such as the names of components – a structural term is a physical item or thing, e.g. a member, a housing, a lever

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3) Identifying the invention

Step 2: Compare functions with the prior art

- For each prior art reference, check off the functions that are and are not found in the references
- If you are not sure, put a question mark beside the function and come back to it later
- After comparing and eliminating, all that you should have remaining are the unique functional features of your invention.

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3) Identifying the invention

Function (e.g. a bicycle)	Prior art A
Rolling/Rotating	
Pedaling	
Leveraging (Mechanical advantage)	
Steering	



It all starts somewhere

3) Identifying the invention

Function (e.g. a bicycle)	Prior art A
Rolling/Rotating	√
Pedaling	√
Leveraging (Mechanical advantage)	X
Steering	√



here

3) Identifying the invention

Function (e.g. a bicycle)	Prior art A
Rolling/Rotating	√
Pedaling	√
Leveraging (Mechanical advantage)	X
Steering	√

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3) Identifying the invention

Other Approaches

- Search by competitor name

Keep tabs on what competitors are doing

Look for holes in their technology

Patent around their technology and “fence in” competitor

- Patent mining

Starting your research using a general field of search

Look for holes in the prior art

Don't exactly know what you are inventing

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Concluding Remarks

How do I get a patent?

Invent something!

Identify that you invented something

Avoid prior public disclosure

Don't assume that it's not patentable or not valuable

Perform preliminary searching

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Concluding Remarks

How do I get a patent?

COST OF OBTAINING A PATENT IN UNITED STATES

Steps	Timing	Total
Search	3 - 4 weeks after receiving instructions	\$ 1,500 to \$ 2,500
Preparing & filing application - if filed first in U.S. (preferred)	1 - 2 months after receiving instructions	\$ 9,500 to \$ 15,000
Meeting objections raised by Patent Office examiners	2.5 - 3 years after filing application	\$ 800 to \$ 5,000
Issue	4 years after filing application	\$ 2,200 to \$ 2,600
Total cost		\$ 14,000 to \$ 25,100

Thank You

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