

# The Limited Monopoly™

## Seek and Ye Shall Find: Online Searching for Business Information in the USPTO

by John Hammond PE and Robert Gunderman PE

### A Spectrum of Subject Matter

Many engineers and scientists are aware of the United States Patent and Trademark Office website, <http://patft.uspto.gov/>, that is available for online searching of patents and published applications. It is quite common for inventors to perform preliminary searches even before meeting with a patent practitioner. Seasoned inventors will frequently use searching to help guide their design and product development efforts.

The capability to search the U.S. patent literature (as well as foreign and international patents and applications in other databases) is a valuable business tool. Often the cost of filing a patent application with potentially little or no value can be avoided by a search which reveals that the subject invention is “already out there.” Moreover, discovering relevant prior art in advance of filing can stimulate an inventor to further refine the invention, making it more valuable to the end customer, more marketable, and more likely to be patentable.

Less well known is that the USPTO website contains much more than just a searchable database of patents and published patent applications. There is a wealth of critical business information that extends well beyond the basic prior art or technology search. So this month we present a brief primer on the various types of other searches that can be done online in the USPTO. We'll cover the subject matter in the simple format of *What*, *Why*, *Where*, and *How*: *What* the search seeks to find; *Why* the information is useful to know; *Where* to search in the USPTO website; and *How* to search.

### Competitive Surveillance – Got Patents?

*What*: Let's say you know of a specific company, and you want to find information regarding its patent activities.

*“There is a wealth of critical business information on the USPTO website that extends well beyond the basic prior art or technology search of patents and published applications.”*

*Why*: Perhaps the company is a competitor, a candidate for acquisition, or an opportunity for investment. You need to know as much as possible regarding its portfolio of issued patents and published patent applications.

may affect search results, particularly for published applications. It is important to always confirm current ownership by searching the Assignment records, as described below. What is printed on the patent or published application may not reflect the current assignee.



*Where*: For patent searching, go to <http://patft.uspto.gov/netahtml/PTO/search-adv.htm>. For published application searching, go to <http://appft.uspto.gov/netahtml/PTO/search-adv.html>.

*How*: Use the Assignee Name field, AN. For example, if we wish to search for patents assigned to Bokshed Inc., we enter “AN/bokshed” (sans quotation marks) in the search box and click “Search.” If we know that there may be a Bokshed Corp. or a Bokshed Ltd. that are different companies, patents and published applications of these companies can be screened out with Boolean logic using additional fields. For example, knowing that Bokshed Inc. is headquartered in Rochester, we can add the Assignee City field, by searching “AN/bokshed and AC/rochester.” Caveats: Be aware of alternative entity names that could be listed as Assignee, such as subsidiary or parent corporations. Additionally, assignees are not always identified at the time of patent application filing; this

### Assignments – Who Owns It?

*What*: You learn of a specific patent or published application. You want to know if an Assignment has been recorded in the USPTO, and if there are any other legal instruments that affect Title to the patent.

*Why*: Perhaps you are interested in licensing the patent, acquiring it and/or the company that owns it, or investing in the company. You need to perform due diligence, finding answers to questions such as the following: Is there a recorded assignment? Is it proper and complete – did *all* of the named inventors assign to the company? Is there anything else recorded – has the patent been used as collateral in a security agreement? Are there any liens placed on the patent? Caveat: If you have any questions regarding the significance of the information that you find, consult a qualified attorney.

*Where*: Go to the Assignment search page at <http://assignments.uspto.gov/assignments/q?db=pat>.

*How*: Enter the patent number or the published application number in the appropriate field and click “Search.” Caveat: In the U.S., patent applications are published 18 months after the effective filing date. Assignment data for pending applications that have *not* yet been published are unavailable.

## Public PAIR<sup>2</sup> – How’s It Going?

*What:* You discover a published patent application that is pending, i.e., it has not yet issued as a patent. You want to check the prosecution<sup>3</sup> status of the application.

*Why:* Perhaps the pending application belongs to a competitor. Or again, perhaps the company is a candidate for acquisition, or for investment, and the CEO says, “We have a pending patent application,” and nothing more. Bottom line: you want to know how the prosecution is going, and how likely it is that the application will eventually issue as a patent. You can learn a variety of critical information, such as: a.) Has the application been examined yet, and has an Office Action issued? b.) Were the claims rejected in the Office Action, and if so, what prior art was cited against them? c.) Has the Applicant filed a response to the Office Action including an amendment of the claims? d.) Has the Examiner issued a second (and probably “Final”) Office Action, again rejecting some or all of the claims? e.) Is the application under Appeal? f.) Has the application been abandoned? g.) Has the application been allowed, and if so, what claims have been allowed, and when will the patent likely issue?

*Caveat:* Patent prosecution is a complex process. If you have any questions regarding the significance of the information that you find, consult a qualified patent practitioner.

*Where:* Go to the Public PAIR login screen at <http://portal.uspto.gov/external/portal/pair>. Enter the anti-bot password and proceed to the “Select New Case” screen.

*How:* Enter the Application Number or the Publication Number into the search box, select the correct radio button, and click “Search.” Study the Application Data to be sure you have the right case, then immediately consider the “Status” field. Then click the “Image File Wrapper” to see the entire application prosecution history, item by item. All of the entries are viewable and/or downloadable as pdf files, except perhaps for some non-patent literature references submitted in Information Disclosure Statements.

## Maintenance – Still in Force?

*What:* You discover an issued patent. In the U.S., maintenance fees<sup>4</sup> are due at 3½, 7½, and 11½ years from the issue date of the patent. You want to know if these maintenance fees have been timely paid, or if the patent has been allowed to expire before the end of its twenty year term from date of filing.

*Why:* Perhaps the patent belongs to a competitor, and you would like to offer a product covered by the patent, but don’t want to risk an infringement lawsuit. Or again, perhaps the company is a candidate for acquisition, or for investment, and the CEO says “We have six patents on this technology.” You need to determine that they are still in force and have not expired.

*Where:* Go to the Patent Maintenance Fees screen at <https://ramps.uspto.gov/eram/patentMaintFees.do>.

*How:* Enter the seven digit Patent Number and the eight digit Application Number (available on the cover page of the issued patent), and click the “Get Bibliographic Data” button. The maintenance fee history of the patent will appear, with an indication that all fees to date have been paid, or that a fee is currently due or past due, or that the patent has expired for non-payment of a maintenance fee.

## The Big Picture

Additional information gleaned from the above searches can paint a detailed picture of the patent landscape of a competitor, acquisition target, or investment candidate. Within Public PAIR, this includes the level of detail in the written specification and drawings of an application, the quality of the drawings, and whether or not the applicant retained a licensed practitioner to prepare, file, and/or prosecute the application, or is proceeding *pro se* (representing himself). Another important criterion is whether the application claims priority to a provisional application, and if so, what is the quality of that provisional application<sup>5</sup>. The validity of any patent to issue could eventually

depend entirely on the soundness of that provisional application in the event of litigation.

This information, together with the Assignment and Title search, can provide an indication of the applicant’s state of research and development, as well as the applicant’s financial backing and resources at the time the application was filed, and during prosecution. Secondary web searches on the inventors, the assignee, and the overall technology can fill out the big picture, providing you with key insights on that competitor, acquisition candidate, or investment opportunity.

10/305,814		Minimally invasive percutaneous ventricular assist device			
Select New Case	Application Data	Transaction History	Image File Wrapper	Published Documents	Address & Attorney/Agent
<b>Bibliographic Data</b>					
Application Number:	10/305,814	Customer Number:	-		
Filing or 371 (c) Date:	11-26-2002	Status:	Abandoned -- Failure to Respond to an Office Action		
Application Type:	Utility	Status Date:	03-05-2007		
Examiner Name:	KRAMER, NICOLE R	Location:	ELECTRONIC		
Group Art Unit:	3762	Location Date:	-		
Confirmation Number:	6496	Earliest Publication No:	US 2004-0102674 A1		
Attorney Docket Number:	-	Earliest Publication Date:	05-27-2004		
Class / Subclass:	600/016	Patent Number:	-		
First Named Inventor:	Filiberto P. Zadini, Camarillo, CA (US)	Issue Date of Patent:	-		

1. See also “Have Brain, Will Invent: Who Owns Your Inventions?” March 2006 issue of The Limited Monopoly™, available at [www.patenteducation.com/patentarticles.html](http://www.patenteducation.com/patentarticles.html).
2. See also “Public PAIR: Accessing Records on Pending Patent Applications,” May 2006, *Id.*
3. See also “Building the Case For Patentability: Prosecution in the USPTO,” March 2009, *Id.*
4. See also “Basic Maintenance – Keeping Patents in Force After Issue,” January 2010, *Id.*
5. See also “Structural Weaknesses of the ‘Quick and Dirty’ Provisional Patent Application,” January 2010, *Id.*

Authors John M. Hammond P.E. (Patent Innovations, LLC [www.patent-innovations.com](http://www.patent-innovations.com)) and Robert D. Gunderman P.E. (Patent Technologies, LLC [www.patenttechnologies.com](http://www.patenttechnologies.com)) are both registered patent agents and licensed professional engineers. They offer several courses that qualify for PDH credits. More information can be found at [www.patenteducation.com](http://www.patenteducation.com). Copyright 2010 John Hammond and Robert Gunderman, Jr.



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