THE FUTURE OF EXPERT PATENT SEARCH

DEEP DIVE REPORT
A COLLABORATION OF CPA GLOBAL SEARCH EXPERTS
CONTENTS

Search Matters 4
- What Makes a Great Patent Search? 4
- Raising the Stakes 5
- The Cost of Getting it Wrong 8

The IP Landscape is Changing 9
- The Information Boom 10
- The Shifting Legal Landscape 12

A Different Future for Search? 14
- Past, Present and Future Strength 14
- Self-Service in Search 15
- Making Information Easier to Use 15
- Big Data = Big Benefit 16
- The Amazon Effect 16

The Change Imperative 17
- Catalysts for Change 18

Innovation, Collaboration and Empowerment 19

True Strength in Search 20

About the Authors 22
The expert user wants peace of mind that the information they are acting on is accurate, robust and complete. But what matters most is the quality of the judgement that is applied throughout the search process.
SEARCH MATTERS

Patent Search plays an influential role at pivotal points along the idea lifecycle, steering critical decisions, paving the way for valuable product launches and ensuring that IP owners are able to manage both their investment and risk with confidence.

But the IP landscape is evolving. Today’s ideas-based economy is putting the spotlight on IP decision-making – not only within IP departments and R&D functions – but also within board rooms and courtrooms around the world. It is in this high-stakes context that we ask search leaders at CPA Global to share their views on the current challenges faced by innovation decision-makers and their legal counsel as they form opinions and offer advice that can make or break the process of bringing game-changing ideas to life.

WHAT MAKES A GREAT PATENT SEARCH?

Patent search is an information process that must synthesise technical expertise, legal knowledge and business insight. Created by experts, for experts – typically the ‘consumers’ of a patent search report will be an attorney or IP counsel in a corporate setting (or in a law firm serving a corporate client).

Despite the inherent complexity of the search work product, the requirement is actually quite simple. The expert user wants peace of mind that the information they are acting on is accurate, robust and complete. But what matters most is the quality of the judgement that is applied throughout the search process.
RAISING THE STAKES

Developing and protecting products for long-term commercial success can be an expensive business. IP practitioners are faced with a host of high-stakes decisions, each having the potential to compound cost and risk if the chosen course of action is not backed by the most reliable and accurate information available.

There are many types of IP decisions to be made. Whether to file a patent application, launch a product, protect and retain IP or to litigate in the event of infringement, each decision comes with its own costs.

But that same decision can also trigger a host of additional financial commitments and liabilities with consequences that may stretch far into the future and across the business.

Internal and external IP counsel want to know that they are advising good decisions — ones that enable the wider business, create certainty around ownership of ideas, manage the risk inherent in innovation and guard commercial advantage by countering competitive threats. This kind of confidence doesn’t happen by accident; a number of conditions must be fulfilled:

Each search represents a series of thousands of judgement calls that are all governed by the scope of the search and the objectives to be fulfilled.

As diligent perfectionists, search customers want to be assured that their researcher is going to apply the same ‘judgement template’ that they would apply, if completing the task themselves. The judgment calls range from how to interpret a claim limitation, to how to decide whether a piece of literature meets a claim limitation, to whether a claim covers a product feature, to which resources to use.

A great patent search is underpinned by trust in the researcher’s judgement. As such, the relationship between producer and consumer is a meeting of minds - connected through the detail of the search report. The producer is entrusted to support and empower the consumer to act with confidence.
So how does a search buyer or user test the quality of their search? Matt Rodgers, Managing Director, Business Development, Patent Search and Innovation Intelligence at CPA Global and co-author of *Patent Searching: Tools & Techniques*, explains the buyer’s challenges when it comes to assessing patent search quality. “Buying a search is usually triggered by a specific event for an IP attorney with the requirement to deliver an answer to a deadline. Should we file this patent application and is it written with the correct coverage? Are we clear to launch this product or product feature? Is a competitor infringing and can we investigate with a view to litigation or enforcement? The search is performed, and the results come back. But in most cases there is no ready benchmark to compare the search results against, or the time to step away and conduct a lengthy validation of the search details. In other words, you can’t know what you don’t know. Essentially there comes a point where the buyer must proceed on trust.”

**SEARCH MUST-HAVES**

- A good search should be conducted with surgical precision – well-scoped and fully focused on the required outcome, whilst maintaining a clear view of the legal or business context. The quality of the briefing sets the exercise up for success.

- The search provider needs to have a deep, rich knowledge of the technology in question, including the evolution of the technology over time – not just the current state of the art.

- The global reach and local nature of intellectual property rights means that fluency in multiple languages may be a pre-requisite for successful search for many law firms and corporations, particularly for multi-national product clearance.

- The search strategy should be planned and executed to a flawless and repeatable quality standard with nothing left to chance. The provider should demonstrate exemplary research theory, process and practice.

- The research tools used should be carefully selected for each job and mitigate any limitations with individual data sets. Although the researcher will view these resources as a starting point, they know that creativity in identifying new resources during the project will be required.

- The work product should be constructed and presented in a way that tells the story and is easy to digest.
EVERY COMMERCIALISED IDEA IS POTENTIALLY THREATENED BY LITIGATION

“

When put in context, even the most expansive global product clearance searches cost a fraction of a percent of the potential commercial and legal costs of getting it wrong.

Matt Rodgers
Managing Director, Business Development
Patent Search and Innovation Intelligence

”
THE COST OF GETTING IT WRONG

It’s easy to see why search buyers need confidence in the product and process, as well as trust in the knowledge and expertise of the experts involved. But here’s the central issue: Every commercialised idea is potentially threatened by litigation. If there is a problem and the search fails to unearth a critical document, there is a chance that it won’t surface until much, much later. If a launched product faces an infringement challenge months or years down the line, the owner has to deal with the cost of a suit – plus the expense associated with any disruption to trade. In the worst case scenario, the company loses all of their market share forever.

Matt highlights the dangers of failing to take search seriously. “In recent years, some clients have come to view even mission-critical, multi-jurisdictional product clearance exercises through a lens of price sensitivity. But you have to stop and question the quality, the access to tools and the credentials of ‘budget’ search providers. Given the importance and value of IP, I’m surprised that organisations are prepared to take this kind of risk.”

“When put in context, even the most expansive global product clearance searches cost a fraction of a percent of the potential commercial and legal costs of getting it wrong. Not to mention the R&D investment, distribution and marketing costs of getting the product to market. That’s why we put the investment in search in context for our clients - to ensure that the work products we deliver will truly meet their business and legal objectives.”
THE IP LANDSCAPE IS CHANGING

Having worked in IP for over 15 years, Matt shares his insight on how the industry is evolving. “When I first began working in IP, patents were treated like something to be framed and displayed. A commercial status symbol. But today, patents are valuable assets and powerful weapons in an aggressive battle for competitive advantage.”

There are many reasons for this elevation in the importance of intellectual assets. Recent years have seen an explosion in technology advancement across every domain and in both traditional and emerging markets. Previously, products that might have taken 20-30 years to bring to market can now happen in five. Corporations are racing through research and new product development cycles at an accelerating pace. They seek first-mover advantage – but also need an army of new product ‘heroes’ to replace stars that fell out of favour thanks to swift obsolescence resulting from new technology and changing consumer behaviour.

This is nowhere more evident than in electronics and mobile technology, where battles are being fought over incremental advancements, and where some of the world’s most powerful brands go head-to-head. Pharmaceutical companies face major headaches. As their product stars and cash cows hit the ‘patent cliff’, they need new blockbuster drugs ready to replace those facing their patent expiration date. But each industry sector is subject to a particular set of IP issues that must be tackled.

No technology company is immune to a serious IP challenge. The world’s most powerful brands and biggest corporations hit the headlines with suits worth staggering sums. From Adidas and Apple, to Google, Microsoft, Intel and Sony, plus the likes of Glaxo SmithKline, Pfizer and Novartis - all have fought high-profile battles in recent years. Win or lose, there are always costs to be borne by both parties, and for companies without leviathan financial backing, such suits could mean ‘lights-out’ for the entire business.
THE INFORMATION BOOM

Companies face more competition, on more fronts and with more complexity than ever before in IP. But IP professionals also have to deal with the explosion of technology and communications in a different way. IP information has been subject to its own multiplier effect, meaning the wealth of IP information and documentation that can be brought to bear on a single matter is rising exponentially. Obviously, the base of patent information grows steadily as more patents are applied for and granted, but the growth is even more dramatic in the world of non-patent technical literature, encompassing everything from journal articles and conference proceedings to product manuals, websites and videos.

This escalation of information in the public IP domains brings with it an additional set of risks and fears. The search for prior art must go further and dive deeper in more languages than ever before, if IP counsel are to be able to offer opinions which inform big-ticket corporate decisions with confidence and integrity.

DID YOU KNOW?

• Global patents in force are running record numbers hitting 10.2 million in 2014 (WIPO data)

• The growth in scientific output doubles every 9 years. Read more...

• Over 9.4 million patents have been issued in the US alone since the US patent system started (USPTO data)

• 2.5 quintillion bytes of data are created every day. Read more...
QUALITY OF SEARCH
SUPPORTING IP DECISION-MAKING HAS NEVER BEEN MORE IMPORTANT

This escalation of information in the public IP domain brings with it an additional set of risks and fears. The search for prior art must go further and dive deeper in more languages than ever before.
IP advisors also have to deal with changes in the law itself. CPA Global’s Director of Planning and Insight, Haydn Evans, elaborates: “You need only to take a look at the recent reversal of the test coming out of the previous ‘Seagate’ ruling to see how IP practitioners have to navigate a complex and ever-shifting legal landscape.”

Read more...

“The standard for wilful infringement established in 2007 was overturned earlier this year. The Supreme Court has given greater latitude to district court judges – which in turn could lead to the award of enhanced damages in egregious cases. The test case – *Halo Electronics* v *Pulse Electronics* – gives little guidance to what ‘egregious’ means – putting extra pressure on IP practitioners when they offer opinions to the clients or businesses they serve. Our customers are acutely aware that their advice comes with a weighty burden of responsibility. This is why the quality of search undertaken in supporting IP decision-making has never been more important.”

Read more...
TECHNOLOGY ENABLEMENT WILL MAKE THE SEARCHES OF THE FUTURE MORE ROBUST AND PRECISE

“Presenting data in ways that surface or reveal insight and make it easy to share and apply to commercial decision-making has an immediate and tangible impact in any organisation.”

Esmaeil Khaksari
Product Manager for Patent Search and Innovation Intelligence
A DIFFERENT FUTURE FOR SEARCH?

It may be that the very technological and industrial developments that increase complexity in the IP world also provide the solutions to the challenges being faced.

Matt Rodgers gives us his perspective on the imminent evolution of search. “Human interpretation and judgement will be at the heart of patent search for the foreseeable future, but in the medium term, the value of human knowledge and expertise will be amplified by the increasing support of technology. Technology enablement will make the searches of the future more robust and precise, reducing the proportion of time spent ‘collecting’ data and increasing the proportion of time spent analysing and synthesising the judgements that add value to the search product.”

PAST, PRESENT AND FUTURE STRENGTH

With over 250 full-time, internal technology experts working from 12 global locations and in 35 local languages, the CPA Global search heritage and technology credentials are unrivalled.

We are evolving our business in IP decision support. Alongside the core search products - Patentability, Freedom-to-Operate and Invalidity - we now have an expanded offering of information products. These include software tools from Innography® that are perfectly suited for big organisations who want to begin their invention intelligence processes in house.
Esmaeil Khaksari, Product Manager for Patent Search and Innovation Intelligence, explains how the principles of self-service and information-on-demand can apply to search. “Today, once a search is delivered, it supports the matter at hand and will be filed for the record, but it begins to go out of date immediately. If a listed application grants the next day, how are you to know?”

“What if this wasn’t the case? If you could receive regular alerts as and when there are changes to the legal status of your in-scope patents? If your document could be delivered in a more dynamic digital format linked to additional pertinent data and supporting information? And if you could request to have your search results automatically updated monthly, quarterly or annually with revisions highlighted for easy reference - then the search would become a living, story-telling vehicle that evolves over time. Our search customers will be able to enjoy these kind of enhancements in the very near future.”

SELF-SERVICE IN SEARCH

Making Information Easier to Use

Esmaeil goes on to describe a future where the dynamism and currency of search reporting can be dramatically enhanced thanks to the data and technology behind CPA Global’s Innography® product suite. “The power of Innography to visualise data is set to permeate, integrate and transform our search capabilities in ways that deliver immediate benefits to information consumers. Presenting data in ways that surface or reveal insight and make it easy to share and apply to commercial decision-making has an immediate and tangible impact in any organisation. You can already see data visualisations transforming our Innovation Intelligence reports, such as our Technology Intelligence and Portfolio Diagnostics studies. The same principles will make our search reports easier for technical experts to navigate and digest in the future.”
BIG DATA = BIG BENEFIT

The potential for technology transformation is enormous within the work product itself but there are also opportunities for process enhancements that build in value from the second the search is initiated. CPA Global offers a 24 hour response to all search enquiries from receipt of request to statement of work. This includes a detailed scoping discussion prior to the search commencing to ensure that the customer’s precise legal and business requirements are fully understood.

Brad Buehler, Managing Director Operations, Patent Search and Innovation Intelligence, shares his insight on how these processes are set to evolve. “We have an opportunity provided by today’s technology to enhance the process by which each and every search is conducted, so that we’ll be gathering intelligence from the very first second a contact is made. Our technology can search semantically and filter patent records, so we will be able to present a small sample of relevant records to the customer in real time for their immediate review. This kind of light-touch interaction has the potential to create insight on what the customer wants and where their focus and interest lies – giving the analyst a head start on the search itself.”

THE AMAZON EFFECT

Intuitive, tech-enabled collaboration between the producer and consumer has applications throughout the life of every search project. Recently developed technologies can augment detailed information regarding customer preference. As consumers, we experience the benefits of big data day-in and day-out, from the TV programmes we watch, to the way we buy groceries and even the news we consume. Modern technology helps business and media to serve information that is both relevant and resonant, based on expressed consumer preferences.

So why has the IP industry been so slow to adopt the transformative technologies that touch us all in our day to day lives?
“To understand why the IP Industry is a late adopter for technology you need to look back in time.” Esmaeil explains, “The main players in the IP ecosystem have historically been disconnected. The Inventor, the IP Counsel, the IP Researcher and the PTO are geographically dispersed.”

“Traditionally each stakeholder is focused on their own business or function, but the process of moving product from idea to reality has always required lots of iteration – information moving to and fro, over and over again. In the past, these processes were manual by necessity. Today the flow of information happens faster and needs to cope with greater volumes. Technology-enabled collaboration tools are available and are accepted as standard in most industries, but they simply haven’t taken root in IP.”

IP also used to be a largely esoteric function that was left to its own devices. Now, there is a broader appreciation of the competitive advantage IP can bring to a business and with it, a higher expectation on the availability and reporting of IP data.

Esmaeil suggests that this resistance to digital technology is partly due to habit, but mostly founded in fear. IP professionals are naturally risk adverse, worried about the digital footprint of email correspondence and anxious about data and security. These fears are understandable...but they are not insurmountable. Other areas of industry, of finance and of international security have all developed failsafe digital systems to expedite progress and support their customers and stakeholders. For Esmaeil, the question is not if the IP community will follow suit, but when.
PRESSURE TO FILE MORE
The pace of technology development and today’s boom or bust commercial climate means that companies are looking to file more patents than ever before, as a route to securing and protecting long term competitive advantage.

THE RISING COST OF IP
More patents and the effects of globalisation means rising costs in filing, prosecuting, renewing and litigating IP. Customers want confidence that they are choosing and backing the right ideas - so the availability of good information to support decisions is critical, to maximise return and eliminate waste.

FEAR OF FAILURE
Poor IP decisions can come with a big ticket price and far-reaching implications. All stakeholders need confidence that they are founding opinions and decisions based on the very best information available.

SPEED OF RESPONSE
Organisations need to be increasingly agile, be that in the race to file, response to shifting market dynamics, or defence against direct attack. Having the agility to act quickly and with confidence is paramount.

ALIGNING IP WITH BUSINESS STRATEGY
Business leaders need assurance that their IP activities are aligned and well-directed throughout their organisation. Collaboration and integration of thinking and action is increasingly vital for more effective return on investment.

ACHIEVE MORE WITH LESS
IP departments and the law firms that support them are under pressure and scrutiny to increase efficiency and effectiveness, all the while driving cost, risk and resources down.
INNOVATION, COLLABORATION AND EMPOWERMENT

In 2008, we entered an era where fixed-fees and year-on-year savings were firmly placed on the IP agenda. Achieving more with less, therefore, may well be the hallmark of a new ideas economy. There really is no way back to a time when IP tasks were completed with law firm ‘meter running’ and no questions asked. Today, accountability is often equally as important as results.

Progressive organisations know that innovation holds the key to their own future success, and so they will ultimately expect IP departments and legal partners to demonstrate innovation in action in the drive for efficiency. IP owners are demanding that their future is characterised by collaboration and empowerment - better outcomes delivered faster and with greater accuracy against a backdrop of increasing complexity and competitive threat.

Our patent search team here at CPA Global is prepared for the next chapter in global IP management. Each and every member of our 250-strong group of search experts sees next-generation thinking crossing their desks day-in, day-out, across every technology domain you might care to imagine. They are inspired and motivated to re-imagine the future of search itself, safe in the knowledge that they have the backing of the world’s leading IP technology and management company.

As the world’s most established patent search provider, CPA Global has a reputation for delivering a precision product that is wholly aligned to each client’s requirements. Ours is a business that has the knowledge, resources, proven methods and global footprint to take search product and process innovation from theory to reality with quality, integrity and confidence.
TRUE STRENGTH IN SEARCH

PATENTABILITY
Extra confidence to invest in and prosecute your IP

FREEDOM-TO-OPERATE
Innovate with insight. Invest with confidence

INVALIDITY
The proof you need can lie much deeper than you think.

• 250+ full-time, in-house search experts in 12 global locations
• We are able to search in 35 different languages, and we cover all technology domains in 5 major languages
• Access to over 300 on-line and print information sources covering patent and non-patent literature
• Our researchers come from a broad range of backgrounds and include patent attorneys, ex-patent examiners, engineers and scientists
• We have been trusted by the USPTO to conduct search and preliminary examination of PCT applications since 2005
• We champion consistent best-practice in search processes, refined over decades of delivering searches to the world’s leading technology companies and IP law firms
• We offer a range of flexible engagement and charging options for higher volume search requirements
• Our local customer support is delivered via dedicated project managers with local language skills to ensure the search project is set up for success and delivers precision results
We champion consistent best-practice in search processes, refined over decades of delivering searches to the world’s leading technology companies and IP law firms.
DISCOVER THE BREADTH AND DEPTH OF CPA GLOBAL’S EXPERT PATENT SEARCH TEAM

Expert search is part of a comprehensive suite of information products and services from CPA Global, designed to support confident decision-making across the entire IP lifecycle for companies and for law firms.

For strategic business decision-making in IP, our Innovation Intelligence Services team produce commercial insight and powerful intelligence to help organisations navigate today’s ever-changing technology ecosystem.

For in-house IP research, we have IP analysis software from Innography® to guide commercial decisions from invention and product development through to portfolio optimisation.

All of our IP information products and services are underpinned by excellence in IP data management, the benefit of substantial investment and a mature approach that comes from over 45 years’ at the forefront of the IP industry.

THE AUTHORS

BRAD BUEHLER
Managing Director Operations, Patent Search and Innovation Intelligence

MATT RODGERS
Managing Director, Business Development, Patent Search and Innovation Intelligence

HAYDN EVANS
Director of Planning and Insight

ESMAEIL KHAKSARI
Product Manager, Patent Search and Innovation Intelligence
CPA Global is the world’s leading Intellectual Property management and technology company.

Trusted by many of the world’s most respected corporations and law firms, CPA Global empowers a global community to achieve excellence in IP management.

We support the day-to-day delivery of IP functions and provide the right information at the right time, enabling professionals to make better IP decisions for the future.

Our integrated suite of IP software, services and information is underpinned by an outstanding global team of IP people.

For further information please contact us at ipinfo@cpaglobal.com or visit us online at cpaglobal.com.