



## Patent Information Professional: Swiss army knife<sup>1</sup> chameleon?☆



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### ARTICLE INFO

#### Article history:

Received 13 May 2016

Accepted 26 September 2016

Available online 27 October 2016

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<sup>1</sup> [https://en.wikipedia.org/wiki/Swiss\\_Army\\_knife](https://en.wikipedia.org/wiki/Swiss_Army_knife).

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## 1. Introduction

There is not one but several Patent Information Professional's (PIP) definition of functions. Indeed, the so-called "PIP" name will cover different professional activities.

Even though freedom to operate (FTO) and patentability searches are at the heart of the PIP job, there are large variations depending on its employer's structure (industry, law firms, search brokers, academic, patent offices, independent ...), the size of corporation (larger corporations may have specialists per topic or activities, small organizations may have generalists doing everything or even pilot an outsourced activity).

As such, one needs also to emphasize PIP vs « General » Information Specialists such as Competitive Intelligence [1], Knowledge Manager [2], Librarians [3], etc.

The aim of this paper is to present the various aspects of the PIP's job, in different environments and within the different scopes of assignment, and to highlight training requirements.

## 2. Core activities

As PIP's, most common job is to support patent attorneys or IP professionals by providing them with the relevant documentation and information from searches carried out among all kinds of published documents. At this stage, we will present prior art searches, thus focusing on the first facet of the PIP's activities, including patentability searches, opposition and invalidation searches and finally, freedom-to-operate searches, the latter involving patent documents only.

### 2.1. Patentability search [4]

The goal of a patentability search is to retrieve the closest prior art documents (including patents and non-patent literature) for an invention, so that novelty or inventive activity/non-obvious aspects of the invention cannot be attacked.

### 2.2. Opposition/invalidation search [4]

A search in the context of a patent opposition/invalidation procedure aims at retrieving all third parties patent and non-patent documents that were potentially overlooked during prosecution in order to prove that an object or process does not match the patentability criteria at the date of filing.

### 2.3. Freedom to operate search (FTO) [4,5]

FTO searches are carried out in order to verify that the production, commercialization or the use of an object or a process does not infringe an in force third party's right (trademarks, designs ...).

Focusing on patent rights, a PIP searches in patent databases for

all granted patents, or utility models in force likely to present an infringement risk. Pending patent applications of interest are also highlighted and tracked. A FTO search often presents geographical restrictions according to the organization's activities and time limits related to the lifecycle of patents.

### 2.4. Skills and knowledge requirements

Hiring a new PIP who will carry out these types of searches raises some issues concerning qualification requirements. Among the key skills are scientific qualifications in the organization's domain (specialist/generalist), patent research skills and patent legal information knowledge.

#### 2.4.1. Research skills

Patent research obviously requires good search skills. PIP belong to a small community which is still not well known. Most of them are not patent attorneys and may have started their career as scientific librarian or R&D engineer. Others may have completed a scientific education followed by a Master's degree in scientific and technical information, technological intelligence and innovation ... None of them is specifically dedicated to PIP's needs.

Today's PIP has many search tools at their disposal. Raw patent data offers a free, easily accessible, well-structured source of information providing complementary search fields in other information sources such as patent classifications or free full text access. Information retrieved in patents can also be used to search in other, less structured, information sources thanks to, for example, names of inventors, companies or academic institutions (authors' websites, blogs, newsletters ...).

Over the past few years, following technological innovations, patent database providers have included more and more value-added functions (statistical analysis, semantic search ...) requiring PIPs to constantly train in order to become familiar with these new tools and keep updated research knowledge and skills. In that sense the PIP's job necessitates continuous training.

Moreover, knowledge of several foreign languages especially in certain technical fields is an asset even if automatic machine translation is now a service available in almost all patent databases.

#### 2.4.2. Legal knowledge

In the context of patentability, opposition or invalidation searches, crucial points to take into account include the definition of relevant prior art, potentially different according to the jurisdiction (language of documents ...), the correct date range to consider for the search, etc.

For FTO searches, basic legal knowledge is required concerning the kind of documents (application, granted patents), lifecycle, (patent, utility models), legal status determination (sources, office registers, interpretation of status data, reinstatement possibilities), interpretation of the claims and equivalents. As a researcher, a PIP should at least know where to find the relevant legal information (e.g. from a patent attorney, IP Office websites, etc.) and be conscious of the risk of missing information.

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