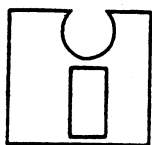


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USE OF THE STATE-OF-THE ART SEARCHES IN INVENTIVE AND INNOVATIVE
ACTIVITIES

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TABLE OF CONTENTS

	<u>Paragraphs</u>
INTRODUCTION	1 to 6
PATENTABILITY SEARCHES	7 to 10
STATE-OF-THE-ART SEARCHES	11 to 14
CONTINUING SEARCHES	15
INFRINGEMENT SEARCHES	16
VALIDITY SEARCHES	17 to 20
RIGHT-TO-MAKE SEARCH	21 to 23
INFORMATION SOURCES	24 to 3
FREE ACCESS SITES ON THE WORLD WIDE WEB	36
PUBLICATIONS	37 to 38
PROVIDING PATENT INFORMATION TO THE PUBLIC IN HUNGARY	39 to 47

INTRODUCTION

1. In considering the steps to take in developing and launching a new product, the key element for success is information:

- on the state of the art,
- emerging technologies,
- the strength of competitors` intellectual property rights and
- establishing your own proprietary intellectual property rights for the new product.

2. Information on these issues is essential not only

- for the inventors in relation to patent, trade mark and design protection; but also
- for the R&D and marketing personnel of a company involved in developing and launching the product.

3. Intellectual property information helps you:

- avoid “reinventing the wheel”;
- learn about emerging technologies before they appear in the scientific and technical literature and the market place;
- enhance the prospects for obtaining effective patent, trade mark and design protection;
- avoid unnecessary expense on unsuccessful patent, trade mark and design applications;
- monitor competitors` new product developments;
- obtain information about competitors` businesses; and
- anticipate and avoid conflict with competitors` intellectual property rights.

4. There are several stages in the innovation process at which the available literature should be searched. The first stage is before the beginning of any research programme. The second is the point at which an invention might have been made, and the third is the point at which commercialisation is being considered. The first two stages will involve searching any literature which seems appropriate: patents and academic literature, in any form and in any country and language. The third stage is quite different and involves patent infringement or “freedom to use” searching.

5. We could think that “search is search”, and it is true, that basically search is all the same in the sense that searchers are trying to find closely related documents. However, to make it effective, the ways of approach must be different from each other according to the aims of search. Searches can be classified, according to their aims, as follows:

BIBLIOGRAPHIC SEARCHES

6. This type of search is the easiest and the quickest because the searcher already has a patent number or an inventor`s name. The point of this type of search is to find out what was covered by a specific patent number or to find out what patents a particular inventor has to his

or her credit. Bibliographic searches can be done as a part of historical, biographical, or product research.

PATENTABILITY SEARCHES

7. The Patentability Search is directed to an entirely different goal. In a Patentability Search, the searcher attempts to determine whether there are previous patents or printed publication (prior art) that might prevent the searcher from patenting his idea. While Patentability Searches can be performed early in the development of an invention, they are more commonly done prior to submitting a patent application. Such a type of search may turn up prior art that might be useful in preparing the application, additionally a search can help the inventor determine just how original his idea is. Another benefit can be that an inventor can often locate evidence of unobviousness by finding previous patents that recommend against their product or method as a solution.

8. Because any reference, among others any patent reference is relevant in a Patentability Search regardless of its age, and because combinations of patents must be considered, the scope of such a search increases substantially over the so called State-of-the-Art Search we will speak about this type of search a little bit later). It is recommended to search the patent file back at least 50 years, preferably more, for mechanical inventions, technological fields which are often times more recently developed may require searching more than 25 years back.

9. Compared with the so called Infringement Search, Patentability Search may not permit much time or money on it. If the invention were known as to be breakthrough, pioneer, he may invest more time and money, but, in normal situation, patentability searcher must restrict the scope of the search. In some cases Patentability Search will not performed because of economical limitation.

10. Normally, Patentability Search is performed through free sources, such as in Patent Library of Patent Offices, in state libraries or in free Internet web sites (we will mention it later). If the invention is considered a "big one", search may exceptionally be performed through commercial online databases or CD-ROMs.

STATE-OF-THE-ART SEARCHES

11. The State-of-the-Art Search is the broadest and the most general of all the intellectual property searches. It is essentially a market survey that should ideally include a broad brush look at everything that has been done in a given art. State-of-the-Art Search results are invaluable in many situations. To an inventor, who is contemplating entry into a particular field of art, the State-of-the-Art Search results can provide concrete evidence of the advisability of such a decision. To an inventor who is currently active in a particular field of art, the State-of-the-Art Search results can lay out the path that must be followed to design around the current art.

12. In most cases, a thorough State-of-the-Art Search can save a great deal of time and money. Knowing what work has previously been done, what problems have been discovered and how they have been solved, who is active in the field of art, and the chronological

development of their work can prevent wasteful excursions into blind alleys and unnecessary expenditures of capital.

13. The scope of the State-of-the-Art Search should be broad enough to provide a complete picture of what is out there and, at the same time, should be narrow enough to limit the information gathered to what is truly relevant. A good State-of-the-Art Search should begin at the beginning. Producing a State-of-the-Art Search that is unlimited in time should provide you with a chronological history of the field of the art. You will certainly have access to the most recent developments in the field, however, it is not less important that you also have access to earlier developments. These earlier developments may provide you with information that will be critical to your decision making process. Therefore, unless it is impossible to sufficiently narrow your search by other means, the State-of-the-Art Search should not be limited by time period.

14. As it was mentioned earlier, the scope of the State-of-the-Art Search must be broad in order to give a complete picture of what is out there. The searcher must try to generate a search that includes everything that has happened in a particular field of art. The best way to be sure of including everything is to search a broad array of sources. This includes not only searching issued patents, but also searching field of art specific publications and even transcripts of important scientific meetings where technical papers may be presented before publication.

CONTINUING SEARCHES

15. A Continuing Search is nothing more than a current awareness search of recently issued patents. Generally these searches are of two types: keeping up with patent activity in areas of interest and keeping up with competitor's activities.

INFRINGEMENT SEARCHES

16. Prior to launching the product it is essential to be aware that the product will not infringe competitor's patents and designs and that the brand name selected for the product will not conflict with existing trade mark registrations. Patent and design infringement searching and trade mark searching is essential at this stage.

VALIDITY SEARCHES

17. Validity Searches are generally undertaken by companies or individuals trying to determine if it is possible to invalidate another's patent. The searcher is looking for issued patents or printed publications that anticipate or make obvious another issued patent. The searcher could also be looking for earlier public use of the invention, technical errors, fraud, or anything that would cause the patent to be declared invalid. As a result, a Validity Search is done to determine if an unexpired patent is valid and enforceable.

18. A Validity Search may also suggest strategies for avoiding the infringement of existing patent rights when seeking to enter a new market, but a Validity Search could be conducted as

well when litigation concerning infringement of a patent is on the horizon, and the defendant is trying to invalidate the plaintiff's patent.

19. Another example where a Validity Search proves useful is in licensing negotiations. In assessing the value of the licensed patent a licensee is about to receive, he may want to conduct a Validity Search to determine the strength of the patent.

20. A patent Validity Search is the most exhaustive search that can be undertaken, and often it may never end. If a corporation has a vested interest in invalidating a competitor's patent, it may continue searching until it finds something it feels will accomplish this. Prior art exist world-wide everywhere in so many different places, that it is often impossible to be sure that you have "covered all the bases" when conducting a search. An invented technology could exist in another country, but may not be patented. It may be in a remote trade publication or journal which is hard to find. Therefore, in approaching a patent Validity Search, there is no "set" or "right" time frame with which to complete such a search, but surely one has to weigh and balance the time spent with the importance of the search.

RIGHT-TO-MAKE SEARCH

21. A Right-to-Make Search concentrates on expired patents, unlike an Infringement Search, which concentrates on unexpired patents. These searches are done to determine if another company's process, product, or design has expired and can then be copied with impunity.

22. Before beginning any search, it is always a good idea to decide what type of search will produce the best results for the particular problem at hand. The particular problem, money, time may be the decision-making factors. The particular invention and the circumstances of the inventor will typically dictate the cost of the search. A sole inventor working in his garage on a better mouse trap will not be able to spend as much as a researcher for a large pharmaceutical company working on a cure for cancer. The cost of the search can be essentially irrelevant when someone is searching for prior art as a defendant in an infringement action. The potential damages facing defendants in such cases can be so high as to make search costs irrelevant.

23. The way in which a search is conducted depends somewhat on the goal to be achieved. The three most common types of searches are: State-of-the-Art Searches, Patentability or Novelty Searches, and Infringement Searches.

INFORMATION SOURCES

24. There are three main categories of information sources available:

- patents,
- publications, and
- other sources.

25. Each of these source categories has distinct characteristics and no one category is sufficient for a good search. Rather, all categories of information sources should be considered and used for each search.

26. Patent literature represents disclosures of technologies that are proposed for commercialisation. 70 % of the information in patents is disclosed nowhere else. For example, in the United States alone over 100000 patents are granted each year. It is impossible to carry out a completely comprehensive patentability or infringement search as this would entail a search of all documents published anywhere in the world at any time.

27. While issued patents can be a very good source of current information, publications are frequently a better source of very up to date information. Searching patent and scientific literature for a disclosure can be like “looking for a needle in a haystack” and thus cost effective techniques are essential to obtaining value from patent searching.

28. Successful searching is based on:

- knowing what to look for,
- knowing how to locate it.

29. In order to conduct a thorough search, it is necessary to search issued patents and published patent applications.

30. There are two main access points for searching patents:

- the national patent offices and
- the online services, both public and private.

Some words about public search rooms at national patent offices:

31. All national patent offices have public search rooms where you can get access to copies of issued patents. This may be a good place to do a search if you know that there is a particular class or subclass that completely describes your field of art. Patents in the public search rooms are filed by classification. Therefore, if you know what class you want to search (you determine the class you are interested in by looking it up in the International Patent Classification (IPC)) simply ask for the box containing that class and physically look through the patents contained in that box.

32. However, there are some problems with this method. First of all, the boxes are quite dirty so searching them may not be an enjoyable experience. Second, if your field of art requires that you search several classifications, the physical search may be too time consuming to be productive. Additionally, some percentage of patents may have been removed from the public search room, and there is no way to tell if patents are missing from the boxes you are searching. Finally, unless you are in the town where the national patent office is situated, this is probably not the best way to conduct a search.

And now a few words about online services:

33. There are many online services available. Several commercial vendors provide access to patent information. While these commercial services typically have very complete and up-to-date information, they are also expensive to use and require some skill to navigate. There are also patent searching resources available on the World Wide Web. There are currently no full text, free WWW searching sites, however, there are quite a few web sites that offer searching capabilities.

34. Now, we should like to give a brief summary of the available online services, both commercial and free access, and how they can be used to produce a good search.

35. There are a number of commercial vendors that offer access to patents and published patent applications. Each source has unique characteristics, and the most appropriate source for the situation should be chosen when planning a search.

- ◆ **Questel-Orbit** is a commercial vendor that specialised in intellectual property information. It supplies direct access to the most comprehensive collection of patent databases accessible online. Questel-orbit provides access to subject oriented and legal oriented databases. It has approximately 40 patent databases and supports single as well as multi-file searching of up to 8 databases at one time.

Questel-Orbit has a PowerIndex which allows users to use one of sixteen pre-defined file clusters or create their own groups of up to 40 databases. PowerIndex may be searched using full boolean and proximity searches and automatically ranks database lists. Files can be searched by patent number, inventor name, assignee name, abstract, classification, key words, or any combination of them.

Its service covers over 60 countries. United States coverage is provided by QPAT database, which provides the full text for all patents issued since 1974.

International coverage is given by

- Derwent's World Patent Index (WPAT covering 35 countries),
- INPADOC (INPD covering 50 countries with legal status information), and
- European Search Documentation (EDOC covering Japanese granted patents) all which can be accessed through Questel-Orbit.

Questel-Orbit has a very flexible search system that can be adapted to almost any type of patent searching.

- ◆ **Dialog** is a commercial vendor that offers approximately 14 patent databases. These databases are searchable by patent number, inventor name, assignee name, abstract, classification, key words, or any combination of them.

Through Dialog can be accessed among others the following databases:

- Derwent World Patents (it covers 35 patent issuing organisations world-wide),
- CLAIMS/US Patents (covers US patents going back to 1950),
- US Patents Fulltext (contains the best mode, invention background, and enabling disclosure),
- INPADOC (with legal status information).

Although Dialog has fewer patent specific databases than Questel-Orbit, it does provide access to many other useful publication databases, and also provides access to newspapers and magazines.

- ◆ **STN International**, the Science and Technical Information Network offers a fee based online search service that provides accurate, up-to-date, specific information from over 200 scientific, technical, business, and patent databases. STN also offers a fee based WWW access to selected databases via the STN EASY service. Information is offered on a broad range of scientific fields, including engineering, material science, physics, biotechnology, pharmacology, and chemistry.

STN offers features that include advanced chemical structure searching, easy cross-searching of complementary databases and chemical reaction information.

This database would be very valuable for a State-of-the-Art searcher interested in a very technical field.

- ◆ **MicroPatent** is a commercial vendor that provides a patent search and delivery service.

Their patent databases include

- US patents (dating back to 1975),
- European patent applications (dating back to 1978),
- WIPO applications (dating back to 1978), and
- unexamined Japanese patent applications (dating back to 1995).

These databases can be searched by any combination of approximately 20 different bibliographical fields including

- title,
- abstract,
- assignee,
- inventor,
- US and IPC classification numbers,
- priority data,
- application numbers, dates,
- inventor location or
- key words that appear in titles or abstracts.

This is not a full text site. All searching is done by bibliographic fields. Although this can be a good site when you know what you are looking for, it is not particularly well suited to state of art searching. However, if your field of art can be limited to a particular class, this site may provide some useful information.

- ◆ **European Patent Register** is a commercial site that can be found on the World Wide Web (<http://www.epo.co.at/epo/epidos>). The Register of European Patents provides detailed information on all European and Euro-PCT patent applications.

The Register provides bibliographic data such as

- title of the invention,
- classification,
- publication dates,
- name and address of the applicant, inventor, attorney, and
- the latest information about the status of the granting procedure of the patent application.

The Register is accessible in English, French and German and is updated daily. The database is limited to information on all published European patent application and PCT applications with designation of EPC Member States from first publication until grant.

This site can be searched using European application number, PCT application number, applicant's name, international patent classification, or priority number. The search capability that is most relevant to a State-of-the-Art searcher is the international patent classification. Since European and PCT applications are published after 18 months, this is a good site for up to date information on the state-of-the-art in a particular international class. Once you have identified art references that may be of interest, this site can also provide current information on the legal status of those references.

FREE ACCESS SITES ON THE WORLD WIDE WEB

36. There are many WWW sites that provide free access to some form of patents. It is difficult to provide an exhaustive current listing of these sites because new sites are being added all the time. However, let's have a look at some of the available free access sites and what they offer to the searchers:

- The Aids Patent Project: (<http://patents.cnidr.org/pto>)
- Biotechnology Patents:
(<http://www.inform.umd.edu/EdRes/Topic/AgrEnv/Biotech/BiotechPatents>)
- Electronic Data Systems Shadow Patent Office: (<http://www.spo.eds.com>)
- Sunsite's Patent Search: (<http://sunsite.unc.edu>)
- MicroPatent: (<http://www.micropat.com>)
- Chemical Patents Plus: (<http://casweb.cas.org/chempatplus>)
- Qpat-US: (<http://www.Qpat.com>)
- U.S. Patent and Trademark Office: (<http://www@pioneer.uspto.gov>)

- ◆ **The AIDS Patent Project:** This site is sponsored by CNIDR, USPTO, and the National Science Foundation. In addition to searching capabilities this site provides links to various points for AIDS patents and related databases. Full text and boolean searches allow you to search full text or to limit your search to the following fields:

- title,
- abstract,
- patent number,
- issue date,
- application number,
- application date,
- international class,
- inventor name or assignee.

This database is in English and includes over 2000 research oriented patents related to AIDS. Both the browsing function and the searching function can be included in a state-of-the-art searching plan, if the field of art you are searching is AIDS related.

- ◆ **Biotechnology Patents:** This site is sponsored by Biotechnology Information Centre; National Agricultural Library, National Science Foundation, WAIS, Inc., Sun Microsystems and the USPTO. This database is a compilation of all biotechnology patents granted in the last few years in alphabetical order by title. Patents are shown in full text form without images and there is no way to search full text without linking to the PTO Information Office which in turn refers users to WAIS source files.

This database is in English. The lack of a direct searching capability and the failure to include patent numbers with the title makes this site of little use to a state-of-the-art searcher.

- ◆ **Electronic Data System Shadow Patent Office:** This is a commercial vendor that provides some free services on its home page. This site allows you to browse through the last 52 weeks of patent titles and numbers organised by week issued, and listed by US class. This site is updated weekly, however the database is very limited, consequently, the results of this search will be of minimal value.
- ◆ **Sunsite's Patent Search:** This site is hosted by Source Translation and Optimisation, a commercial service. This site allows limited free searching by classification number and will return a list of titles and patent numbers. You can also retrieve abstracts if you know the patent number, but this site is of little use to a state-of-the-art searcher.
- ◆ **MicroPatent:** This site is hosted by MicroPatent, a commercial service. This site supports free full text searching of recent patents and front page viewing for patents back to 1974. All other searching and downloading of online patents is available as a commercial service. There is little of value here for a state-of-the-art searcher.
- ◆ **Chemical Patents Plus:** This site supports free searching of full text US patent documents from 1971, with complete patent page images from 1993. This site also includes many 3D chemical structures. This site provides free searching and all patent titles and abstracts can

be displayed for free. However, all other information, such as patent numbers, claims, etc. is offered for a price.

This is one of the few sites that offers 3D chemical structures. Although the drawbacks of this site include the lack of international coverage and the lack of pre- 1971 patent information, a state-of-the-art searcher in a chemical field of art should be able to find some useful information here.

- ◆ **Qpat-US:** This site is hosted by Questel-Orbit. This site allows the user to search the abstracts and bibliographic information of all US patents issued since 1974. This search capability is accessible at no cost to individuals who register with Qpat-US.
- ◆ **U.S.Patent and Trademark Office:** This site is sponsored by CNIDR, USPTO and MCNC. This is a free abstract searching service site which provides access to abstracts for patents in the U.S.Bibliographical Database /from 1976 to the present/. There are several search pages available:
 - The Patent Boolean Search Page provides an interface for two-term boolean searching of the U.S.Patent Database.
 - The Patent Advanced Search Page provides an interface for advanced searching of the U.S.Patent Database. You can search here by patent number, inventor name, patent abstract, inventor city, references, etc.
 - A patent number search page allows you to search by patent number.
 - There is also a page that allow you to search by U.S.Patent Classification.

This site does however charge for copies of patents. Although this site does not provide a full text search option, it can be very useful in a State-of-the-Art search.

PUBLICATIONS

37. As it was mentioned earlier, while issued patents can be very good source of current information, publications are frequently a better source of very up to date information.

38. It can take several years to get a patent granted. Even the best State-of-the-Art search of granted patents will not provide a clear picture of very recent developments or emerging technologies. Publications are an excellent source of the most recent information. There are several ways to get access to the publications of a particular field of art.

- ◆ **Public Library:** A public or university library is a good source of publication information. Most libraries have extensive collections of scientific or technological journals. However, manual searching of newspaper and magazine collections is rarely productive, and should probably be done electronically. Many libraries also have access to commercial databases .
- ◆ **Electronic Searching:** There are many ways to search publications electronically. Commercial vendors have a significant presence in this market. Additionally, there are several free access points through the World Wide Web.

- Dialog : This commercial online information vendor provides general company and business files as well as specialised field of art and technical databases. It also provides access to newspapers and magazines. All files are searchable.
- Lexis/Nexis: In addition to their extensive collection of legal databases, it also provides access to other types of databases. They have business, finance and news databases that provide a good source for non-patent publications and company information. They also provide access to specialised industry journals and newspapers. All of the libraries in the Lexis/Nexis system are searchable. Although there are other online services that provide access to more non-legal sources, Lexis/Nexis can be useful to a state-of-the-art searcher.
- STN International: It offers a fee based online search service that provides accurate, up-to-date, specific information from over 200 scientific, technical, business databases.
- National Science Foundation: It has a web page located at <http://www.nsf.gov>. The user can search related web site, NSF publications and the NSF grants and awards database. The information valuable to the state-of-the-art searchers is the NSF grants and awards database. This should provide the searcher with a truly state-of-the-art picture of what is currently happening in a particular field by allowing the searcher to examine the abstracts of research projects that have been recently funded by the National Science Foundation. This is a very good source for very current information.

PROVIDING PATENT INFORMATION TO THE PUBLIC IN HUNGARY

39. As this conference takes place especially here in Hungary, we should like to give you a brief overview of the conditions of giving patent information to the public in Hungary and at the same time to describe the infrastructure supporting official patentability or novelty search .

40. The work of the examiners is supported by the traditional paper collection and also by electronic tools.

- ◆ **Paper collection:** It comprises, in IPC order, the first publication of European and US patent documents and Hungarian documents relating to granted patent and utility model protection. The most recent technical information is grouped by special fields, retrospectively to 1990, the beginning of the fifth edition of IPC. From among the US, European and Hungarian patent specifications all documents that reflect the latest state-of-the-art may be quickly viewed by a one-step search. The possibility of going over and comparing the drawings rapidly is particularly important in the mechanical and electronic fields.
- ◆ **Electronic Search Tools:** Through the Novell network of the Office all the examiners having their own PCs get access to the CD-ROM and online databases. Four CD towers are intended for providing information for the patent, trademark and legal fields. The CD-ROM titles accessible through the network are the following:

For patent and utility model searches

- IPC:CLASS classification database;

- bibliographic optical disk databases of European, US and Hungarian patent (utility models) (SPACE-ACCESS, SPACE-BULLETIN, US PATENT SEARCH, HUNPATÉKA);
- JOPAL, an international database of non-patent technical literature.

For trademark searches:

- with simultaneous access to the bibliographic data and the figures
- ROMARIN database of trademarks registered under the Madrid Agreement;
- TRACES database of the national trademarks of Central and Eastern European countries.

For plant variety searches:

- UPOV-ROM international database.

For legal issues:

- international and Hungarian legal databases (IP-LEX, JOGTÁR).

Other special databases are also available through CD-ROM workstations, such for example:

- PAJ (Patent Abstract of Japan) bibliographic database containing abstracts in English and characteristic figures of Japanese patents;
- GENE THERAPY DATABASE supporting biotechnological searches;
- WHO Drug Index international database containing names of drugs;
- PATENT BIBLE database of tables making US bibliographic data more transparent;
- and some other databases that can be used in trademark searches (GTER, DEMAS, TM-ASSIGN etc.)

41. Search in online databases of commercial hosts has become part of the everyday work for the Office's novelty searchers.

The most frequently used online hosts are:

- EPIDOS/INPADOC: patent family and legal status database (PFS, PRS);
- STN International and Questel/Orbit: the most frequently searched databases are Derwent World Patent Index and Chemical Abstracts.

42. The juke-box system containing facsimile patent databases is also available from the desktops of the examiners. The system comprises the complete collection of

- the European patent documents (SPACE-EP-A) from 1978,
- the PCT documents (SPACE-WO) from 1991,
- the US documents (USAPAT) from 1994,
- the German patent documents (DEPAROM) from 1993 and
- the documents of the Central and Eastern European countries (SPACE-PRECES) from 1991.

43. In the Hungarian Patent Office public services are provided by the Patent Library. All those electronic search tools are available for the public which are used in the network by the examiners.

44. The archive of the Library consists of the documents of almost 30 countries and two international organisations. They are on various carriers: paper, microfiche, microfilm, CD-ROM. The Library provides the public with a rich collection of gazettes and annual indexes. As far as online services are concerned, EPIDOS/INPADOC, STN, QUESTEL-ORBIT and DIALOG are now run by the Library on a fee-based system. Access to the Internet is also possible.

45. The search rooms for trademarks and industrial designs are also available for the public in the headquarters of the Office.

46. And now some words about the so called HUNPATÉKA, the oldest electronic publication of the Hungarian Patent Office. The purpose of this publication is to store the total, more than 100-year old Hungarian patent registry, the 6-year old utility model registry and the data of pending applications, as well as to support searches.

47. We think that it can be very useful to become familiar with these searching possibilities, and what now follows is a presentation of an example how to use these databases.

[End of document]