

PATENT LAW YOU CAN USE™

Patentability Searching

Howard M. Eisenberg

© 2000

Howard M. Eisenberg is a biotechnology patent attorney with the firm of Chernoff, Vilhauer, McClung & Stenzel, LLP. His address is 1600 ODS Tower, 601 SW Second Avenue, Portland, OR 97204. (503) 227-5631, fax - (503) 228-4373, email - heisenberg@chernofflaw.com.

PATENT LAW YOU CAN USE™
Patentability Searching

Abstract - In most instances, it is advisable to conduct a thorough patentability search before incurring the expense in time and money to draft and file a patent application. The patentability search provides useful information to help determine whether or not to file a patent application and how best to write the application. Much of the initial searching can be done by the inventor but usually it is best to have a search performed by a professional searcher.

In order for an invention to be patentable, it must be novel¹ and unobvious² as to anything that has been described in a written publication more than one year before the date that a patent application is filed claiming the invention. A patentability search, also referred to as a prior art search, is a search of published literature for the purpose of determining if an invention is likely to be found by a Patent Office examiner to be novel and unobvious. Although it is not a requirement to perform a patentability search before filing a patent application, there are several reasons why it is generally advisable to do so.

One very important reason to do a patentability search is that you might find a “knockout” piece of prior art. If the invention, or an obvious variant of it, was previously described, you will avoid wasting additional time and money in further developing or trying to patent the invention.

Aside from the determination whether the invention has or has not been described before, there are other reasons to do a prior art search. A search will help the inventor, and the patent

¹ 35 U.S.C. 102(b)

² 35 U.S.C. 103

attorney, to more fully understand the field of the invention, which will be useful when drafting the application. Awareness of the prior art helps the attorney broaden the description of the invention to the fullest extent possible. What I often tell my clients is that we try to have our invention snuggle up right next to the prior art without actually touching it. In this way, we attempt to build a protective wall around the claimed invention to make it more difficult for our competitors to design around our patent and to make a competitive product that does not infringe our patent.

Knowledge of the prior art also permits a patent attorney to provide a narrowing description of the invention if needed to distinguish over the prior art. For example, let's say that a researcher has developed a new cosmetic that is spread onto the skin of a user's face. The new cosmetic is nicely spreadable on the skin. The prior art found by the patent examiner during prosecution describes a similar, although not identical, cosmetic formulation. The prior art further discloses that a surfactant is present to enhance spreadability of the cosmetic on the skin. The new cosmetic invention is made without a surfactant. The examiner rejects the application based on this prior art.

If the patent attorney had been aware of the importance of the surfactant as described in the prior art, the specification could have been written to state that the cosmetic formulation preferably does not contain a surfactant. Then, the claims could be amended to overcome the rejection by inserting the feature that the formulation is substantially free of surfactant. Without this disclosure in the specification, however, the claims cannot be amended in this way and the rejection on this basis would stand, or would have to be overcome in some other manner. This unfortunate result could have been prevented by a prior art search conducted before drafting the application.

A prior art search will often result in a stronger patent. Prior art references that are brought to the attention of the Examiner during prosecution of an application are listed on the cover sheet of a patent. The burden on a future litigant to invalidate a patent on the basis of information contained in the listed references is very high. This is because the issued patent

carries a legal presumption of validity in view of the prior art examined during the application process.

Another reason to do a prior art search is that often the search will reveal new uses or new markets that the inventor did not consider for the invention.

Much of the patentability search can be done by the inventor. University or corporate researchers often are familiar with research that is being done by competitors. Articles published by competitor colleagues can be searched in libraries or on electronic databases, such as Medline. Guides to periodicals, such as Index Medicus or the Reader's Guide to Periodical Literature provide access to non-patent literature. Issued U.S. patents can be searched by name of inventor, assignee, or by keyword at the web site of the U.S. Patent Office³ or at the IBM web site.⁴ European, PCT, and Japanese patent publications are more difficult to find but a limited search can be performed at the European Patent Office web site⁵.

Issued U.S. patents may also be searched at the U.S. Patent Office or at a patent depository library. The location of these libraries is listed on the U.S. Patent Office web site. The mechanics of searching at the Patent Office or at a depository library are too complex to detail in this article. However, these searches are relatively easy to perform with the assistance of a helpful librarian.

Most often, it is advisable to enlist the aid of a professional patent searcher to perform the prior art search. Patent search firms may be found in the yellow pages of the telephone directory or by searching with an internet search engine. The cost of a patentability search will vary depending on the complexity and field of the invention. The cost for a search for a simple mechanical invention may be as little as \$200 to \$400. For a complex invention involving chemistry or biotechnology, the cost may be \$1000 or higher.

³ <http://www.uspto.gov>

⁴ <http://www.patents.ibm.com>

⁵ <http://ep.espacenet.com>

Because a search firm has an obligation of confidentiality, it is advised to provide as much information as possible about the invention to enable the searcher to do an accurate and complete search. Summarize the invention in one or two sentences, then more fully describe the invention in a few paragraphs. Speak to the searcher and ask what information he or she would like you to provide. Provide drawings if needed to understand the invention.

The search report should be analyzed to determine what the art is that relates to the field of your invention, if there is analogous prior art in a different field, and what the similarities and differences are between the prior art and the invention. The prior art should also be examined for any disclosure that would lead one to believe that your invention would not work or that would lead the reader towards the same conclusions that you had that led you to develop your invention.

I suggest that both the inventor and a patent attorney should analyze the prior art search report. The analysis of a prior art search report is often a complex matter involving complex legal principles. Because a patent attorney is unbiased towards the invention and is more knowledgeable concerning the legal issues concerning patentability, the opinion of a patent attorney should be sought.

It is important to keep in mind the limitations of a patentability search. No prior art search should ever be considered to be definitive. Computerized patent searches usually only contain the last 25 years of issued patents. Obscure articles, especially foreign articles, may not be uncovered during a search. Pending United States applications filed before November 2000 and not filed in any foreign countries, are not published until they issue as patents. Foreign patent applications are not published until 18 months after filing. Therefore, it is possible that these documents exist but it is often impossible to learn of their existence until after you've already filed a patent application. Also, unpublished prior art, such as the prior sale or use of an invention, may be impossible to find.

Even with these limitations, it is suggested to perform a prior art search before the decision to patent is made, and at least before drafting the application. Only if a researcher is

intimately familiar with all of the ongoing research in the field of the invention should the decision be made not to perform a prior art search. Even in these situations, it is still a good idea to perform a search of the applicable patent and scientific literature.