The Patentability Search Question: “Do I Search The Prior Art Before Patenting, Or Not?”

Initial Considerations, And How They Tend To Answer The Patentability Search Question

Patent Introductions ™

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Introduction

So, you have an invention, and are considering getting it patented.

The next question you face is: “Do I search the prior art before patenting, or not?” That search would be called a “patentability” search. This question is asked so often, that some patent attorneys call it “the Patentability Search Question”.

Do As Your Employer Says

Importantly, if you are employed, first ask how your employer answers the Patentability Search Question. They likely have good reasons for answering it the way they do. Regardless of their reasons, do as they say, and you need not read this any longer. Read on only if they are vague, or leave the decision up to you.

If You Own The Decision

The Patentability Search Question is asked for a good reason. Having a patent application prepared and filed is a large investment of your time and of funds. In contrast, the patentability search requires a smaller investment. If a patent application is indeed filed, it will be examined, one day, by a Patent Examiner. As part of examining, the Examiner will search the prior art anyway, an activity called “examination search”. If he finds prior art in which your invention was described by someone else, he will rightly not allow your application to become issued as a patent. In that case, the investment in patenting will not result in any long term value. Some of this loss is unavoidable – it is part of the risk inherent in innovation.

The Key Understanding About Patentability Searching

A patentability search can cause you to nix an idea early, and not even try to patent it. The reason stems from your duties to the Patent Office. If you apply for a patent, you have a duty to also report the relevant prior art references that you know about. So, if you search, and then apply, then along with your application, you would report the relevant prior art references that your search found. If these would be enough to eventually reject the patent application, then it would be wholly pointless to apply in the first place. So, realistically, searching means being ready for a negative result, i.e. that there could be no patent application.

The possibility of a negative result, and of its consequences, is not alone a caveat against searching. An examination search will happen anyway, later in time.

The Basic Reason For Doing The Prior Art Patentability Search

So, the basic reason for doing a prior art patentability search is that, if you could have found that on-point prior art before the Examiner would, you could have prevented wasting the investment of patenting. Instead, you could have spent your efforts in an idea with better prospects. And the patentability search would have cost much less than the investment in applying.

This basic reason for doing a prior art patentability search applies to corporate inventors. Even though they do not pay for the patent application to be drafted and filed, they still have to spend time for it, e.g. explaining it, submitting it, proofreading patent application drafts, and so on. This basic reason applies to independent inventors even more, since they have to pay the cost of patenting themselves, out of limited resources.

The Main Caveat of Patentability Searching

The main caveat about the patentability search is that it cannot be as thorough as the examination search, which the Examiner will eventually do for the pending patent application. Indeed, the patentability search would be now, before filing, and only looking at prior art that is findable now. But the examination search will be later, when the application is examined, and will consider additional prior art, which is not available now.

More particularly, there are types of prior art that no patentability search could be expected to reveal. For example, no patentability search can be expected to reveal another patent application that was filed too recently. Even when a patent application is allowed to publish while pending, it generally takes 18 months to do that, or 6 months if the application is a follow-up type application. Yes, in rare cases, their owner asks for earlier publication, but you cannot count on that. Plus, no patentability search by you can be expected to reveal a U.S. patent application that has not issued into a patent, if its owner has not allowed it to publish while pending.

So, even if a prior art patentability search shows that the invention is clear from prior art today, that will never guarantee that the future examination search will also be clear, and that therefore you will receive a

patent. Accordingly, every time such a patentability search is made, it is always understood that its positive results cannot be counted on as a guarantee.

This caveat erodes some of the basic reason for doing a prior art patentability search, discussed in the previous section. Still, this erosion is only partial – even though a patentability search will not necessarily find everything, it can still reveal a lot, and more economically than applying for the patent. Often it will find enough for a more intelligent patenting decision, and an improved patenting approach. So, this main caveat should not be mischaracterized as a reason for not performing the patentability search.

General Reasons For NOT Searching

In a number of instances, there are reasons for NOT doing the patentability prior art search. We discuss some.

A Company Is A Genuine Pioneer

In some instances, a company is a genuine pioneer in its space. It can have applied for patents on earlier concepts in this space, gotten some allowed, and its new proposed inventions are in the same space. In such cases, patentability searches could be consistently clear, and therefore one is reasonably inclined to stop doing them.

A Company Values Having A Lot Of Filed Applications

In some circumstances, a company can value having a lot of filed applications, even if it can be eventually wasteful to not search them first. This approach can serve a purpose – for example a company might want to cross-license, sometimes before even the patent applications are examined. This is a perfectly legal practice.

Last Millennium's Reasons For NOT Searching

In the last millennium patentability prior art searches were not performed for legitimate reasons of inefficiency, inconvenience & cost. For historical interest, it is interesting to note some of these reasons:

The only prior art findable by a patent search was limited: Before 2001, the only documents published by the US Patent Office were issued patents and the more obscure defensive publications. A patent application that did not mature into a patent did not become published, and thus was not findable.

The only way to search the prior art was manual, which was grueling or subcontracted to paid searchers: Before the internet in the mid-1990s, issued patents could be searched in Patent Office Depository Libraries. There are such Libraries around the US, where one can go and search. In older days, the searches used to be manual, and time consuming. Some cost-minded individuals searched by themselves. Otherwise patent attorneys would be engaged, who in turn would hire specialized patent searchers, and describe the invention to them. The searchers would analyze the expected classification of a proposed new invention, search for it, compile a report, etc. Late in the last millennium, the Depository Libraries started carrying CD-ROMs, where patents could be searched electronically. At about the same time, commercial CD-ROMs also appeared.

Some of the Reasons For Not Searching Are Becoming Less Valid In The New Millennium

The new Millennium has seen watershed changes for answering the Patentability Search Question.

The amount of prior art findable by a patent search has increased dramatically: Since 2001, the US Patent Office also publishes many patent applications while pending, which are therefore findable. Suddenly, there are a lot more documents available to find, regardless of how anyone searches. So, it is a lot more likely that relevant prior art will be found, and the larger investment of filing will not be wasted.

The patent prior art can be searched electronically, economically by keywords, by anyone, and from anywhere: Near the end of the last millennium, the USPTO started publishing issued patents and patent applications in the World Wide Web. True, they do not cover all their old records, but other service providers are starting to cover those, often for free. A search using combinations of keywords can be performed from any public library. It can reveal volumes in a few minutes, without needing an expert, which is very helpful. Older patents can still be searched in the Depository Libraries. But then again, other services have stepped up, often supported by advertising, and are making even the older patents available for search.

Today's General Practice

Many employers today request that the inventor do a "quick" patentability search, by trying keywords in the website of the Patent Office. This should be distinguished from the patent clearance search, when a proposed product design is to be cleared from infringement. For a clearance search, an employer may have different guidelines.

For a patentability search, the employer does not realistically expect that the inventor will perform a professional-grade search, but knows that its results will be usable. Indeed, if an idea is exposed early as unpatentable, not patenting it will spare a lot of effort and funds.

If a patentability search is made, its results should be forwarded to the patent attorney responsible for drafting the patent application. These will streamline the patenting effort later, resulting in savings.

To Investigate Further

This White Paper only explored initial considerations for answering the Patentability Search Question. It does not describe how to do prior art searches, or how to interpret their results. For interpreting, one should read the prior art references they find, and try to understand them; and then they should take these references to their patent attorney for discussion.

About this White Paper

This White Paper is not legal advice. If one has questions about this White Paper, or needs any legal advice about their situation, they should contact their patent attorney. This White Paper was first published on 2009-12-01 at: http://www.patent-introductions.com

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