Tips for Patentability Searching

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Persons new to filing patent applications often have basic questions regarding patent searches. Should an inventor do a patent search? Is a patent search required? Does it matter when a patent search is done? What happens when nothing is found? What should be done when the inventor finds out that the invention is not patentable?

Patent searches are optional. There is no requirement in the U.S. that an inventor perform a patentability search before filing a patent application. Some rookie inventors are confused by the requirement that IF a search is done and relevant prior art is discovered, that relevant prior art should usually be disclosed to the patent examiner or the inventor may be accused of fraud. Note that still, a prior art search is not required, just passing on known relevant prior art from an optional search is required.

Some inventors take the position that they do not want a search so that they don't find out any bad news. If they find out no bad news, there is nothing withheld from the patent office, as the inventor never had the bad news to reveal. Also, waiting for patent search results and later making needed invention changes, can delay a race to the patent office. Certainly, when the U.S. Patent Office switches to a first-to-file system on March 16, 2013, promptly filing patent applications will become more important.

However, the patent office does do its own patentability searches. So, at some point the inventor may find out the bad news that prior art bars getting a patent issued. By the time that the patent examiner conveys the bad news, the inventor has spent a considerable amount to prepare and file the patent application, waited several years for the first notice from the examiner, and invested funds on manufacturing and marketing the invention with an expectation of exclusivity. By the time that the inventor finds out that no patent will issue, the original patent application issues, telling the inventor's competitors how to make and use the invention. Once the competitor finds out that no patent will issue, then they can exploit the technology with impunity without paying one dime.

Certainly, an inventor should consider the patentability search as similar to having a mechanic review a used car before purchase. While the mechanic will not guarantee that the car will not break down, you will surely find out if there are any clear mechanical problems before you commit to buying the car, registering it, and maintaining it throughout its lifetime. In the same way, an inventor should want to know if there are any clear defects in the idea of patenting an invention before committing to filing a patent application (registering) and paying thousands of dollars in maintenance fees to maintain the life of the issued patent.

Just like the reviewing mechanic cannot guarantee that the car will last forever, a patent searcher cannot guarantee that no prior art exists that could block getting a patent. The mechanic looks for bad news that can be discovered without taking every bolt and washer apart on the car. The patent searcher can look for prior art, in the searcher's native language, on computer databases throughout the world. However, the patent searcher is not likely to be aware of a single copy of a Swahili-language doctoral thesis sitting on a library shelf in Tajikistan. Thus, care should be taken to have a very good searcher involved with an understanding that searching must reach as far as feasible but at some point must reach a limit.

Rookie inventors sometimes do their own patent search and claim that they found "nothing like it" regarding their invention. The reality that they are missing is that their search was not competent. While there is no way to find every single piece of prior art throughout the universe, there also is no way to search adequately and not find at least some things that are related to the invention.

Another issue for novice inventors is finding barring prior art after performing an adequate search before filing a patent application. The fact is that a patent searcher can only find what is publicly available. If a search is performed on February 1st and the patent application is filed on April 30th, the patent office examiner may come up with prior art that only published on February 2nd.

Unfortunately, it is rather common that a patentability search comes up with a ton of prior art such that there is no way to get a patent for the invention. The good news is that the bad news is discovered before spending time and money on preparing and filing the patent invention that would have been rejected promptly. The take home message for the inventor losing out on a patent search is that the inventor now has a thorough review of the prior art, which should be helpful to learn further aspects that can be incorporated into improving the invention. The inventor can now brainstorm with a focus on significant novel aspects of the invention above the prior art.

After further consideration of the unforeseen aspects of the prior art, the inventor should focus on noting what aspects are missing from the prior art so that the invention can contain several inventive steps above the general state of the prior art. To put it more bluntly, the inventor needs to get back to the drawing board and put more meat onto the present skeleton. The discovered pieces of prior art will help the inventor make progress.