

Patent Searches and Patent Strategies

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Companies specializing in patent searches have increased in number and capability. But has the use of these services by patent attorneys kept up? New tools require new strategies.

In considering patent searching, a retrospective look at how patent searching was done only a few decades ago may be helpful. In the 1980's, if I wanted to have a patent search done, I prepared a description of the invention and mailed it to a professional searcher in Washington, DC. I never met any of the searchers I used; they were referrals from other patent attorneys. Many searchers were subject-matter generalists. They might consult with examiners for leads to relevant classes and subclasses but also relied on their own experience. They mailed the patents they found in their search to me. I would review these patents, prepare a letter summarizing the prior art, and draw a conclusion as to patentability. Later, in the mid-1990's, searching patents online became possible.

Currently, some of the commercially available patent searching products can search patent databases in 30 or more countries. Copies of the patents and machine translations are immediately available for download. Meanwhile, the cost of the patentability search opinions has increased significantly, as inventions have gotten more complex and there is more prior art to search through. In many cases, only one search is done – at the beginning of the process – to inform the applicant as to whether the particular invention is likely patentable.

Because the cost of patent searches by patent search service companies is now much lower than those done by US patent law firms, many patent attorneys view patent search services as a threat to legal fees and continue to perform searches themselves. However, low cost searches offer a way to provide a better value proposition to clients and can increase the value of the patent attorney who knows when and how to make use of them. Furthermore, as was done back in the 1980s, referrals to patent searchers are a great way to find those who are reliable and do great work even if you never get to meet them in person.

A significant problem with patent searches done the old way is that they provided only one snap shot in an otherwise motion picture world. Patent

databases around the world are all growing constantly. A single search can provide information only for a moment in time, and that information is incomplete because it is not possible to search everywhere instantly. New patents are issued even as the search is being done. Furthermore, because patent applications are not published immediately on filing, the information available when doing the search is not only incomplete but also out of date -- and a big problem in fast-moving technology art areas.

A solution is a series of patent search snapshots at key times over the process of getting a patent. With patent search services companies, each snapshot can be obtained at a much lower cost. A search can be done, for example, before each stage in the patent process, especially when the next stage has a significant cost associated with it. A first search can be done early, right after a potentially patentable concept is recognized, for example, in order to see if other inventors have been plowing that part of the relevant technology field. Another search can be done when the inventive concept has been clarified but before the patent application is prepared. Still another search can be done when it is time to file internationally. Several more searches can follow when the national phase begins, each one focused especially on the patents issued by the countries where national phase filing is to take place. In addition, periodic searches can be done before each maintenance fee is paid, before broadening reissue is attempted, and certainly before the patent is to be enforced.

These searches can start with previous search results and build forward and backward from there, and can scour the search results by patent examiners who have examined the patent application. Searching the same claims by different searchers may yield different prior art so several different patent search companies could be utilized to search in parallel for invalidating prior art.

There is still another value provided by low cost patent search service companies. Their searches typically include analyses comparing the prior art to the invention. Patent attorneys receiving these search results can look for "daylight" between the closest prior art and the client's invention and then use that daylight to broaden their claims. The existence of that daylight may potentially change their perspectives on what the invention is. Time spent in this way adds substantial value to the resulting patent.

What do these companies need from a patent attorney to find the most relevant prior art? The most helpful thing is a clear, concise, and precise disclosure of the invention. In addition, a descriptive title for the invention that points to the broad technology area helps them assign the right searcher for that invention. Searchers need to understand the problem to be solved and the features of the invention that are believed to be novel and likely to be claimed.

Search reports may include a matrix that maps the features of the disclosed invention to the prior art. Administrative information about the patents found and other displays of patent information are also available, such as image mapping.

Patent searches are inexpensive decision-making tools, they help to insure against invalidity, and they are value multipliers if used to broaden claims and to increase confidence in the robustness of patent claims against attack. Inexpensive patent searches done at intervals in the patent process can also alert the patent attorney to prior art issues not previously encountered while a mid-course correction can still salvage useful patent claims.

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