

# THE NOVELTY PATENT SEARCH

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The novelty or patentability patent search is often taken for granted and its importance often misunderstood. Many inventors forgo a novelty search or perform themselves what they believe is an adequate investigation. This approach can provide a danger that may not be appreciated until it is too late.

A variety of patent-related searches are available to intellectual property attorneys and their clients. These include the state of the art search, the novelty search, the validity search, the infringement search, and the freedom to operate clearance search. Each serves a unique function and each provides information that can be quite valuable. This article will examine the novelty patent search.

Why perform a novelty search? There are several answers that justify its being done. The novelty search helps with the decision on whether the costs associated with the filing of a patent application for the invention are justified. It may show whether the invention has been patented or disclosed by another party.

It may narrow the extent of novelty of the invention. Its results may serve to invalidate one or more other issued patents. It will assist the attorney in drafting and defining the scope of claims in a patent application, in order to broaden the claims without their scope being invalid based on prior art.

These are but a few of the reasons to conduct a novelty search, and an open and frank discussion of these issues between the attorney and client is important.

Essential to patent searches is an invention disclosure prepared by or for the inventor(s). Without an adequate invention disclosure, the attorney is hampered and will be unable to provide a meaningful opinion. An adequate invention disclosure will include a preliminary descriptive title of the invention, the names of all co-inventors known at the time, when and how the invention came about, a thorough description of the invention and how it is to be used, advantages of the invention over known prior art, and a description of known problem(s) sought to be overcome by the invention and how they are overcome.

A patent attorney, or a retained third party private search firm, may conduct the search. Such firms are quite skilled and they possess a superior familiarity with the US Patent and Trademark Office (USPTO) classification system. Clients often conduct their own online searches, using keywords and phrases, although the results of client searches leave much to be desired. They may, however, provide a starting point for a more meaningful search.

I have found it invaluable to conduct searches personally, and these often include a discussion with a USPTO examiner whose technical area of expertise coincides with the area that I am searching. Examiners

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may make available their own informal records. This highly valuable interaction with a patent examiner is not normally available to non-attorneys.

The search results most often will include the identity of US and foreign patents, published patent applications, and other publications such as technical literature. These are screened for relevance, analysed in comparison to the invention disclosure, and a search report is generated. This report will include an opinion on whether the invention is patentable, and possibly the scope of patent protection available, although the opinion will not guarantee that a patent will be granted.

## No result

It is also essential to keep the following in mind: favourable search results must be viewed solely in the context of the absence of unfavourable results. A novel patentable invention and an inadequate novelty search will yield the same results—nothing was found.

The novelty search provides an attorney with the state of the relevant art, and will often assist the preparer of patent applications with specification terminology and the available scope of protection. It does not, however, qualify as an infringement or freedom to operate search.

These latter searches are specifically directed to unexpired patents and published patent applications, the claims of which may cover the invention described in the invention disclosure. While unexpired patents may be uncovered during a novelty search and may be analysed, infringement decisions must be based upon the more rigorous types of searching.

Whether to conduct a novelty search before incurring the cost of a patent application is a decision that is up to the client. The relatively small costs of a novelty search are a worthwhile investment when compared to the greater costs of the application. Failure to conduct a search may result in wasting money on the application. ■

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