

# BRIEFING: TO SEARCH OR NOT TO SEARCH?

A question we are frequently asked is “should an inventor carry out any searching prior to filing a patent application?” Unfortunately, there is no simple answer to this question because so much depends on the particular circumstances. The following article aims to highlight the main issues involved, to set out the pros and cons, and to provide some constructive assistance.

## The purpose of the search:

There are many reasons for carrying out a pre-filing search, chief amongst which is to provide an indication as to whether or not a particular invention is patentable - before the substantial cost of drafting and filing a patent application is incurred. In addition, the applicant may also want some reassurance that his invention has not already been patented by one of his/her competitors because this may present an obstacle to the commercial exploitation of the invention, whether or not it is patented. It is therefore important to be clear about the objectives, and limitations, of the search before going ahead.

If the purpose of the search is to ascertain whether or not an invention is likely to be deemed to be new or inventive (and hence, patentable), it is important to ensure that the search covers not only patent literature (i.e. published and granted patents/patent applications), but also non-patent literature, such as trade journals, periodicals, scientific papers, newspaper articles etc.. The reason for this is that the novelty of an invention is assessed with respect to the “state of the art”, which includes “*everything that has been made available to the public, by written or oral disclosure, by use, or in any other way*”, prior to the filing date of the patent application in question. As such, any search that is restricted to earlier patent documents will be inherently flawed because most potentially novelty-destroying disclosures are not described in patent applications. As such, a pre-filing patentability search must include a search of both patent and non-patent documents if it is to be of any real value.

On the other hand, if the purpose of the search is to check whether an invention that may be the subject of a patent application is free to use (also known as a “clearance search”), then the search can often be restricted to patent and design documents. Moreover, if the person commissioning the search knows where his/her invention is going to be made/sold/used/kept etc., it is possible to focus the search to particular geographic regions because IP rights are geographic in nature, that is they are usually only enforceable in particular countries/regions. Nevertheless, if the invention has any design features, then one should always try to include some non-patent material in the search to see whether there are any unregistered design rights that may be infringed by exploiting the invention concerned.

## The limitations of any search:

The main limitation of any search is that one is essentially trying to find documents that read onto a particular invention (either for novelty or infringement purposes). However, the fact that a document has not been found does not mean that it does not exist, but merely that the search has not located it. As such, a “nil” search result does NOT mean that an invention is new, or that it is OK

to exploit it, but merely that the search has not identified anything that may be relevant. Obviously, the more time and effort that is invested in the search, the greater confidence one can have in its results. However, the search results are asymptotic, that is, they may approach “certainty”, but will never be able to provide 100% confidence. Due to the asymptotic nature of the search “certainty”, the cost/benefit ratio tails off beyond a certain point, so one must, at some point, decide on a level of certainty/risk that they are comfortable with.

In addition, the phrase “rubbish in-rubbish out” is particularly relevant to searching because most searches necessarily involve keyword or classification searching. This relies on the data in the database being searched to be accurately and consistently entered, which, in practice, it is not due to human error and language problems. For example, you may be searching for patents relating to “plastic wheels”, but a document relating to that technology may have been indexed as a “non-metal wheel”, “plastics rollers” or some other such variation. A search that is restricted to “plastic” and “wheels” would not, therefore, locate this document, which may be very relevant to the technology concerned. The same goes for wrongly-classified documents, typographic errors, and of course, documents translated from foreign languages.

Patent applications are not usually published until around 18-months after their filing or priority date. This means that any patent applications that were filed a year or so prior to the search would not appear in any search as they would not yet appear in the patent databases, even though legally enforceable rights may exist and/or the underlying technology may already have been put in the public domain by the applicant of the unpublished patent application. As such, searching may need to be repeated at intervals to try to cover this “blind spot”.

Finally, there is the issue of deliberate concealment of published documents, that is the deliberate publication of documents in obscure journals to serve as “sleeper prior art” that can be invoked by the author at a later date. For example, an inventor may decide to publish his/her invention by taking out an advertisement in a foreign periodical that is unrelated to the subject of the invention – the idea being that if anyone tries to patent the same invention later, the original inventor can produce the article in question as evidence, which could be citeable prior art (because it was in the public domain regardless of whether or not anyone actually found or read the advertisement at the time). A similar strategy can also be employed by filing a patent application with a generic title, such as “apparatus” to make it difficult to find, but nonetheless citeable as prior art document against later applications for the same or similar technology.

### **The implications of searching:**

The results of a search can be used to improve a patent application because the patent attorney who drafts it will normally have a better idea of the relevant prior art and will thus be better placed to introduce and frame the invention in a way that it is more clearly distinguished over the prior art. In that regard, the patent attorney can highlight the prior art in the introduction to the patent application, describe the problems associated with it, and set-up the invention as a solution to a particular problem. Such an approach can greatly facilitate arguing for the presence of an inventive step later on in the patent application procedure, particularly in Patent Offices, such as the European Patent Office (EPO), which apply a somewhat formulaic, “problem-solution” approach to assessing inventiveness. This is the main advantage of a pre-filing search.

On the other hand, the existence of a search report can have implications, especially before the United States Patent and Trade Mark Office (USPTO), where there is a “duty of candour”. This means that applicants (and their patent attorneys) are required to disclose to the USPTO any and all prior art that may be prejudicial to the grant of a valid patent. Failure to disclose relevant prior art is deemed to be fraud on the USPTO, which has serious consequences, so one should always be aware that if a search does reveal some “knock-out” prior art, it is not a good idea to try to conceal the fact!

Finally, the validity of any patent is ultimately decided by a Court, so even though one may be able to “slip an application past” the relevant patent office by concealing, or failing to identify certain prior art, there is always a risk that the patent may be revoked or invalidated at a later date should the prior art in question be found later on (either by the Patent Office, or by a third party). This usually happens when a patentee tries to sue for infringement of the patent – the standard “defence” being a counter-attack that the patent is invalid, and so cannot be enforced. In such a situation, it is rare for the alleged infringer not to find new, and potentially relevant, prior art to attack the validity of the patent in suit.

### **To search or not to search?**

In many cases, the inventor is going to make, sell or otherwise exploit the invention regardless of its patentability, in which case, there is a strong argument for filing a patent application without carrying out any formal pre-filing searches. The inventor can usually provide the patent attorney with a reasonable account of the current “state of the art” in the industry concerned, which can form the basis of a perfectly acceptable patent application that is well drafted in good faith. In addition, if the patent application is filed at the United Kingdom Intellectual Property Office (UKIPO), then the official Search Report is usually drawn up within 3-6 months of the application's filing date, which gives a reasonable indication of the application's prospects of success and the likely scope of protection that may be obtainable fairly early on in the procedure. This “file and be damned” strategy avoids the cost of pre-filing searching, but risks the cost of a patent application for an invention that may later turn out to be unpatentable. However, commercial expediency, the need to obtain the earliest possible filing date and the straightforwardness of this approach is often attractive to businesses.

On the other hand, a pre-filing search, although increasing overall cost and potentially delaying the filing of a patent application, could improve the drafting of the patent application, provide greater certainty prior to filing and, if “knock-out” prior art is found, avoid the cost of applying for a patent altogether.

Ultimately, the decision regarding whether or not to carry out pre-filing searching will depend on the applicant's attitude to risk, his/her knowledge of the technical field in question, cost constraints, and the need for expediency. A patent attorney will be able to provide guidance, devise an appropriate search strategy, and crucially, prepare a “draft specification” of the inventive concept for the searcher to search against.

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