

PRIOR ART TECHNOLOGY SEARCHES

WHY ARE SEARCHES NEEDED?

Often in patent application preparation, patent litigation or development of technology, it is important to **investigate** what prior work may exist or have been patented, what information about a technology may have been published, or what companies are active in a particular technical field. Much of this information can often be obtained by **prior art** searches.

WHAT ARE PRIOR ART SEARCHES?

Collectively, **prior art** means prior public documents such as patents, technical articles, advertising and commercial brochures, both U.S. and foreign, as well as products, equipment, materials, devices and processes which may at some time have been publicly disclosed, sold or used. Each country's patent laws define what is "prior art" for the purpose of obtaining, enforcing or attacking patents in that country.

A **search** is an organized review of collections of patents, technical literature or other public information to identify prior art. A search's scope and focus will depend on the particular technology and the information sought. The principal types of searches are **patentability** searches, **infringement** searches, **validity** searches and **state-of-the-art** searches.

A **patentability search** is made **before** filing a patent application on a new invention. Its purpose is to identify prior art which describes products or processes related to the new invention. Since any prior art, regardless of age, may be relevant to patentability, significant prior art may be many years old. Also, a prior art document may be significant even if only part of it is relevant to the current invention and whether or not the technology described in it was ever commercialized. From an analysis of the prior art found, the Gordon & Rees attorney can help the client assess the potential for patentability of the new invention. A patentability search is not considered part of a patent application itself, and is quoted and billed for **separately** from any quote or billing for a patent application.

Since only proprietary rights claimed in a currently active patent can be infringed, and since a patent is enforceable only in the country that issues it, an **infringement search** focuses on unexpired patents in the countries in which the client's products or processes may be made, used or sold. The search looks not only for patents claiming the product or process as a whole, but also for ones claiming individual components or process steps, since a single part of a product or process may, by itself, infringe a patent. From the results of this search, the attorney can advise the client about the extent to which a product or process may infringe any of the patents identified in the search. The results also sometimes suggest possible changes for a client to consider making in the product or process which

might avoid such infringement.

A **validity search** is made in conjunction with a client's current or potential litigation over a patent. It covers a wide range of prior art, similar to a patentability search. The purpose is to assess all prior art considered by the Patent Examiner prior to issuance of the patent and determine whether significant prior art documents and public information were overlooked. Any overlooked prior art may be sufficient to invalidate the patent if, had the Examiner been aware of it, the patent would not have been issued. A patent which is invalid cannot be infringed.

State-of-the-art searches may cover a variety of subjects. Some searches look for prior patents about a specific technology or type of product or process. Others look for patents issued to specific companies or inventors. Still others look for trends in technical developments. The subject, time period and scope of a state-of-the-art search will be defined by the client, based on the information in which the client is interested.

WHERE ARE SEARCHES DONE? WHO DOES THEM?

Our firm recommends that **searches for U.S. patents** be done at the **U.S. Patent and Trademark Office** (the **USPTO**) near Washington, D.C., since USPTO is the only organization which keeps U.S. patents collected, indexed and available by subject matter categories. A searcher can use the USPTO's collection to conveniently review the U.S. patents in a particular category. Also, the USPTO has copies of some foreign patents, although most of those are not indexed and filed at the USPTO by subject matter.

When authorized by a client, Gordon & Rees attorneys will travel to Washington, D.C. to make USPTO searches for that client. However, we normally retain **technically trained professional patent searchers** based in the Washington D.C. area who use the USPTO's search facilities. The searcher selected will have the appropriate technical expertise for the client's technology. The patents identified by the searcher are analyzed **by a Gordon & Rees attorney** to determine their legal significance with respect to the issues of importance to the client.

Literature searches may be done wherever relevant publications are kept. For instance, in San Diego such locations include UCSD and SDSU libraries as well as the San Diego municipal and county library systems. In some cases, Gordon & Rees attorneys will conduct a literature search, although usually it is more effective and economical for the client's in-house technical people to conduct the search, particularly where the technology is highly specialized.

In recent years, use of the **Internet** for searching has become common. Internet searches may identify information which is not disclosed either in patents or in library literature collections.

WHAT ARE COMMON LIMITATIONS ON SEARCHES?

The results of any search will depend on how much **time** is authorized by the client to be devoted to the search. It will be evident that **no** search can ever be absolutely "complete," since no one can guarantee that all possible prior art has been identified, regardless of how much time has been devoted to the search. The **practical extent** of a search is normally determined by the amount of attorney's and searcher's time that the client is willing to pay for. Usually only a few hours of search and analysis time are authorized for patentability searches, since a client usually wants to make a decision quickly on whether to apply for a patent. Infringement and validity searches are more extensive, since litigation is usually involved. State-of-the-art searches may be short or extensive, depending on the nature of the technology and the type of information the client is seeking.

The **nature of the technology** also has an effect on the type of search. Some technologies (such as biotechnology and medicine) usually involve both technical literature and patents. Technical literature, being much more extensive, is more difficult to search, and many collections are simply unknown or inaccessible to a searcher. Other types of technology may have important aspects embodied in commercial products or proprietary processes, but for which detailed descriptions are not published or patented; this is often encountered when searching computer technology and software.

Some aspects of a technology may be **too new** to be available for searching. The examination period for a patent application in the USPTO is commonly 18 to 30 months, extended USPTO proceedings (an appeal of an adverse decision, refiling of an application to add new information, etc.) can add substantially to that time. The USPTO, by law, keeps pending applications confidential. An application's content is not made public until a patent is actually issued. Thus, a recent development may be under examination at the USPTO, but it would not be available for a searcher to identify. The same situation exists with information databases; it often takes a number of months before issued patents or published articles are indexed and incorporated into commercial databases for access by searchers.

Specific **omissions** or **gaps** are inevitably present in all information collections. The USPTO works to keep its public patent collection as complete as possible for searchers' use. However, since many people use the collection, individual patent copies can get lost, destroyed, misfiled, or even stolen, and subsequent review of a patent category may not reveal that copies of some of the patents are missing. Similarly, operators of computer databases seek to provide reliable information, but individual data items can be incorrectly or incompletely indexed and therefore be inaccessible when searching that database.

Also, information on many **Internet** and **on-line** sites may be available only in summary form or available only to those who pay substantial fees for access to such sites. This is particularly true of many of the commercial on-line databases.

WHAT ABOUT COMPUTERIZED SEARCHING?

Computer searching of patents is increasingly useful. Full-text databases are available for U.S. patents issued within the last 80-100 years. The USPTO database is a good starting point (www.uspto.gov) and is often useful to inventors to obtain a sense of the state-of-the-

art.

WHAT ABOUT FOREIGN PRIOR ART?

Some searching of **foreign patents** in the U.S. can be done through outside services which have databases and record collections which include patents of selected foreign countries. More comprehensive searching of foreign patents may require retaining searchers abroad who are familiar with their countries' information systems. Useful Internet searching sites include www.european-patent-office.org; www.epo.jp/homee.htm; and <http://pctgazette.wipo.int> (published PCT applications)

WILL A SEARCH BE WORTHWHILE TO ME?

All searches are **optional**; no patent office or court requires that a search of the prior art be made. Patent applications can be filed without any previous search. However, the information from a search is valuable for tailoring a patent application to emphasize distinguishing features of the invention or anticipating issues which an opponent in negotiations or litigation may raise.

In the U.S. and most other countries, the Patent Examiner makes an **independent** search of the prior art when examining a patent application and deciding whether to grant or refuse a patent. The inventor is obligated to bring to the Examiner's attention (usually at, or soon after, filing of the application) any prior art information actually **known** to the inventor, his company and his patent attorney. In the U.S., it is also required that the inventor provide the Examiner with copies of that known prior art, where possible. Failure to make this information known to the Examiner may result in later invalidation of any patent the Examiner might issue.

Each client must decide for himself whether it will be **cost effective** to have a search performed, given the nature of the technology, the client's knowledge of that technology, and the practical results which can be anticipated. The Gordon & Rees attorney should be closely consulted, both when initially defining the scope of any search and also when anticipating what resulting prior art documents, products, etc., are likely to be identified, before making a final decision. The attorney can advise what information sources may be available, how long it will take to search such sources, what costs and fees can be estimated, what scope of prior art may be found, and what disadvantages there may be if a search is not undertaken.

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