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The Art behind a Prior Art Search and Patentability Opinion

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The Art behind a Prior Art Search and Patentability Opinion

Speakers:

Christopher McKinney, *Georgia Regents University*
Andrew Rapacke, *Registered Patent Agent*

Feb. 5, 2015

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Questions?

We look forward to answering your questions today.

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Christopher McKinney

Georgia Regents University

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Andrew Rapacke

Registered Patent Agent

The Art Behind a Prior Art Search and Patentability Opinion

Andrew Rapacke
USPatentsNMore

Christopher McKinney
Georgia Regents University

Overview

- Why care?
- What is prior art?
- Why conduct a prior art search?
- Understanding the ‘Big Picture’
- Patents in a nutshell
- Creating a search methodology
- Knowing your duties in conducting a search
- Claim drafting basic based on search results
- Special topic: freedom to operate
- Closing thoughts

Why care?

If you work in a technology transfer office, you should care about:

Meaningful patentability

↓

Commercial potential

What is prior art?

- Any information in the public domain in any form before a given date that might be relevant to potential features and embodiments of your invention.

- *Remember:* If the features of your invention have been described or claimed in the prior art, you will not meet the statutory requirements of 35 U.S.C. § 101.

Why conduct a prior art search?

- Identify if you may be able to patent your invention based on what is found in the public domain (patentability).

- Understand the distinguishing features of available relevant art when you draft claims.

- Prior art is generally expected to provide a description sufficient to inform *one skilled in the art* of whether there is art that falls within the scope of your potential claims.

Understanding the 'Big Picture'

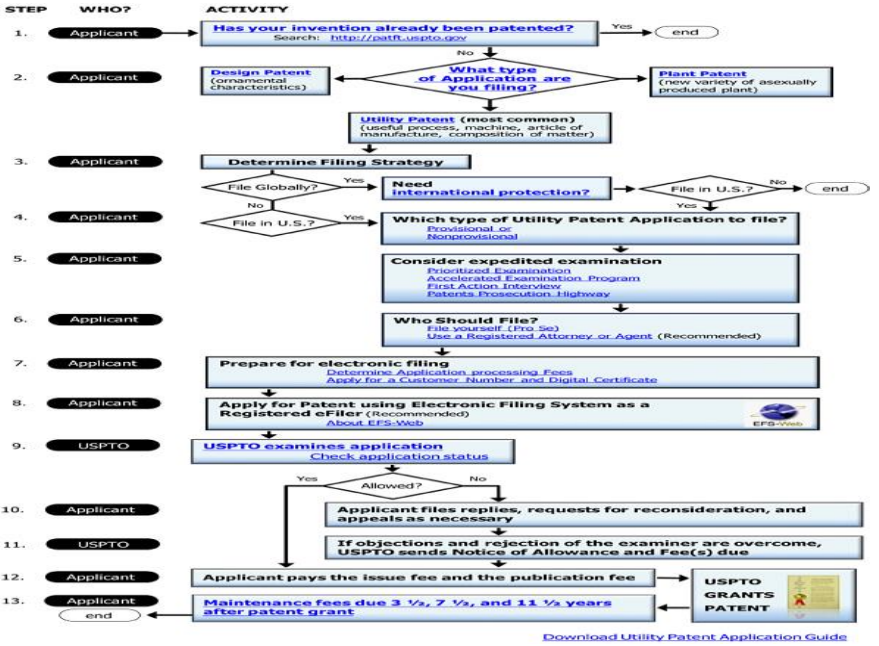
- Identify why you want to do a prior art search.
- Understand that prior art searching can be a cost-effective tool if used efficiently
  - "The better the invention disclosure, the more efficiently you can search."
- Understand the advantages and limitations of a "do-it yourself" search
  - Advantage: Most inventors and offices are experts or specialists in a narrow field and may understand the nuances of an invention, technical materials, publications, and relevant art better than a third-party search firm.
  - Disadvantages: Detaching yourself from the invention and being able to give an unbiased assessment and not understanding "the duty to disclose" or "what's close enough?"
- Third-party resources
  - In-house attorneys
  - Registered patent agent or attorneys
  - Search firms

Patents in a nutshell

First-to-file

- **What?**
  - process
  - machine
  - product
  - composition of matter (includes software)
- **Patentability**
  - novel
  - useful
  - non-obvious
- **<u>Exclusive</u> right – not an <u>affirmative</u> one!**
- **Term**
  - 20 years from filing
- **Challenges** – must file within **one year** of public use, offer for sale, sale, or publication; and, even that isn't so safe under first-to-file; enters **public domain** after expiration of patent
- **Variations**
  - **plant patent** (asexual reproduction)
  - **design patent** (ornamental - 14 years)

Complex process!



Creating a search methodology

Have a plan…

1. Identify the *keywords* from your invention
2. Set-up and *implement* a search term strategy based on the keywords
3. Then, *compare* keywords and search terms on multiple databases
4. Identify patterns and begin *eliminating*
5. Finally, *score* the prior art and summarize

Keywords

- Identifying key words is the foundation to a diligent prior art search
- Think of keyword alternatives for your invention and specifically the novel features of your invention
- How do you know what's a keyword?
  - Create a list of novel features of your invention and then identify those elements
  - Use google and search engines to find similar elements and even use a thesaurus for similar words and concepts

Search terms

- Start a broad search and narrow it down as you eliminate possible search terms
- "Funnel down" your research as irrelevant art is returned

Select databases

Cost/benefit analysis

- You must balance how much searching to do given available financial and human resources

Minimum search should include a search of issued patents and abandoned applications

- USPTO Database (http://www.uspto.gov/patft/index.html)
- European Patent Office (http://www.epo.org/searching.html)
- Google Patents (www.google.com/patents)

Recommended subscription-required search database

- Thomson Innovation (http://info.thomsoninnovation.com/)
- PatBase (http://www.patbase.com/login.asp)

Search recap

- Start a broad search (200-300 results)
- Try to identify families of patents and look for patterns
- Create a “score card” of each patent and include notes
- Identify your highest scoring prior art and begin an in-depth analysis
- Identify distinguishing features in the prior art
- **Remember - Don’t confuse search results with patentability!**

USPTO Seven Step Method

1. Brainstorm terms to describe the invention
2. Use these terms to find an initial USPC class/subclass in the US Patent Classification Index
3. Verify the relevancy of the USPC class/subclass in the US Patent Classification Schedules
4. Confirm scope of subclass using U.S. Patent Classification Definitions
5. Retrieve and review complete US Patent documents and published applications
6. Using the USPC classification you previously identified, find relevant Cooperative Patent Classifications
7. Conduct a classification Search of CPC Class Schedules on the EPO’s website

For more information please visit:
http://www.uspto.gov/products/library/ptdl/services/step7.jsp

Knowing your duties in conducting a search

Duty to Disclose

37 C.F.R. 1.56 Duty to disclose information material to patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

Duty of Candor and Good Faith

37 CFR § 1.56 (1977), commonly referred to as Rule 56.
(a) failure to submit *material* prior art known by the applicant;
(b) failure to explain references in a foreign language or submit pre-existing full or partial translations of the references;
(c) misstatements of fact, including misstatements in affidavits concerning patentability; and
(d) Inaccurate authorship.

- A reference is material if "there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent." *Therasense, Inc. v. Becton*

Inequitable Conduct

37 C.F.R. 1.56 Duty to disclose information material to patentability

- "no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct."

Claim drafting based on search results

- Claims constitute the most crucial part of a patent and should allow one skilled in the art to understand the invention based solely on the claims.
- The language of claims determines if your patent application will be granted or not.
- Terms must be neither too broad nor narrow, but the usage of the words must be justified and the words must adequately describe the patented subject matter.
- Claims differentiate the invention from past inventions and thereby affirm the novelty of the proposed invention.
- The more accurate the prior art search, the more easily the patent drafter will be able to identify and understand what claims and features already exist.

Special topic: freedom to operate

What is Freedom to Operate?
Freedom to Operate (FTO) is an evaluation of whether you infringe the patent, design or trademark rights of another entity.

Freedom to Operate from a patent perspective
Freedom to Operate (FTO) from a patent perspective means that you have diligently searched and concluded that your product does not infringe the intellectual property and patent rights of another. Freedom to operate can never be determined with absolute certainty due to inherent features of the patent system.

Closing thoughts

Discussion and Q&A

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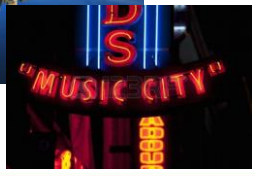

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Watch for more details!

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