



NEGATIVES

Patentability searching – pros and cons

James Cross of RGC Jenkins & Co examines the pros and cons of patentability searching from the applicant's perspective

positives

Improving patent quality is a current policy objective of patent offices worldwide, and effective prior art searching is the key to achieving this objective.

Applicants, patent offices and third parties each have a part to play in identifying prior art, but each may have different interests in doing so. In this article, we review the advantages and disadvantages of patentability searching from the applicant's perspective.

Pre-filing searches

There is no obligation on patent applicants to carry out patentability searches before filing, but at least some prior art searching is necessary to avoid the wasted cost of filing patent applications which have little or no chance of being granted. That cost must be balanced against the cost of patentability searches themselves: searching patent databases and the web is cheap, but reading obscure journals in a library is expensive. In some countries such as the UK, the first filing can be searched cheaply by the patent office within the first year, so the risk of wasting subsequent costs is reduced. Hence, purely based on a cost/benefit analysis, there is a limit to how much pre-filing searching an applicant can be expected to do.

Another factor that encourages applicants towards more thorough pre-filing searches is the prohibition on adding subject matter after filing. The application when filed should therefore contain enough relevant detail to distinguish the invention over prior art that might be cited during prosecution or litigation. One approach is to include in the patent application, any detail that might be relevant, but this can lead to lengthy, expensive and unfocused patent applications. A reasonably thorough prior art search will allow the patent drafter to avoid wasting time on features that are known in the art, and focus on the novel features. This point is well made in an article by Paul Cole¹ in which

he speculates how the Windsurfer UK patent might have survived litigation had it been drafted with better, though not complete, knowledge of the prior art.

The strict approach to amendment taken by the European and Chinese patent offices provides a further incentive for pre-filing searches. These offices do not allow the claims to be amended after filing to cover a scope of invention that was not envisaged in the original application. Hence, applicants planning to file in Europe or China must try to 'get the claims right' from the outset; in other words, to identify as far as possible the closest prior art, clearly identify the distinctions over that prior art, and draft a strong set of dependent claims to fall back on.

Similar considerations apply to priority applications, since an amendment with a scope unsupported by a priority application may result in loss of priority which could be fatal to validity, if the invention was publicly disclosed in the intervening period between priority and filing. This is a point often overlooked when filing priority applications that do not require claims, such as US provisional applications – a 'quick and dirty' filing without a full disclosure and analysis of the invention can lead to difficulties later on.

The European exclusion of patentability for 'non-technical' inventions, such as computer programs and business methods, provides yet another incentive. Under the current approach taken by the European Patent Office (EPO), the technical nature of the invention is considered in comparison with the closest prior art. Hence, an invention that seemed technical when the application was filed may turn out not to be, in view of new prior art found in a patent office search. A pre-filing search would allow the applicant to better assess the technical nature of the invention and emphasise this in drafting the application.

So far, it would appear that patent applicants should carry out as much prior art searching as their budgets will allow, but there are reasons for applicants to avoid or limit their patentability searching, as we will see below.

Duty of disclosure

Both the US and the Japanese patent offices impose a duty on applicants to disclose all relevant prior art of which they are aware, including the results of pre-filing patentability searches. The consequence of failure to disclose in the US can be unenforceability of the patent, and this duty extends beyond prosecuting attorneys and inventors to anyone substantively involved in the preparation or prosecution of the application².

Although apparently an effective way to ensure patent quality, the US duty of disclosure can have the opposite effect. The consequences of failure to disclose are so extreme that applicants may prefer to

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limit or avoid prior art searching, so that the risk of failing to disclose relevant prior art is reduced. Of course, that risk can be reduced by careful documentation of patentability searches and avoiding wide-ranging discussions about the relevance of the results. Fortunately, the US Court of Appeals for the Federal Circuit (CAFC) has recently held³ that the defendant must show specific inequitable conduct on the part of the patentee, and not merely an inadvertent failure to disclose prior art.

A more limited duty of disclosure exists before the UK and European patent offices, but this extends only to search results from other patent offices, and not to pre-filing searches carried out by the applicant. This more limited duty is becoming largely redundant, in view of information sharing arrangements between patent offices, and the publication of search results. Nevertheless, if a corresponding US application has been filed and published, then any prior art disclosed to the US Patent and Trademark Office (USPTO) will be easily available to examiners in other patent offices, and to third parties, by inspecting the US file online. So there is a likelihood that any prior art found by applicants may be cited by other patent offices, not just the US.

Falling allowance rates

Patent allowance rates fell sharply in the period 2007-9, and have only recently begun to rise again. In 2009, the allowance rates at the US, European and Japanese patent offices all fell below 50%, while in 2007, the US figure was nearly 80%. This development can be seen as a conscious reaction to public criticism of patent quality, or ‘Quality not Quantity’, as expressed by the past EPO president Alison Brimelow in a presentation to the Trilateral User Conference in 2007.

Another factor was the KSR decision of the Supreme Court of the United States⁴, which followed by revised US examination guidelines undermining the traditional ‘Teaching, Suggestion or Motivation’ test for non-obviousness.

However, the need for quality was not met by a corresponding investment in patent office search and examination, and led instead, to examiners applying a higher threshold for inventive step or non-obviousness. As US patent office director David Kappos observed in an email to examiners in 2009, “patent quality does not equal rejection”. Faced with such a dramatic increase in the likelihood of rejection, applicants became less motivated to carry out prior art searching and consequential disclosure to the patent office, on the basis that it is better to have a patent of weaker validity, than no patent at all.

Post-grant amendment

If an applicant does obtain a patent that later turns out to be partially invalid due to newly discovered prior art, this can be addressed by a centralised amendment before the EPO, or re-examination at the USPTO. In none of these cases can the patent office refuse the request for amendment on the basis that the applicant knew, or should have known, of the prior art during examination. At the EPO, the amendment is not subject to re-examination for inventive step in the light of the new prior art. This liberal approach to post-grant amendment can be contrasted to the UK regime pre-2007, in which amendment was at the discretion of the patent office, and the conduct of the patentee in seeking the amendment could be scrutinised. In view of the post-grant safety net, there is now less incentive for the patent applicant to try to identify the most relevant prior art during examination.

Summary

In the interests of effective drafting, applicants should conduct as effective a pre-filing patentability search as their budget allows, bearing in mind the cost and difficulty of amendment after filing. Care should be taken to document the results of the patent searches, so that a complete disclosure can be made in a timely manner to the USPTO. It is hoped that applicants’ concerns about unfair rejections during examination can be addressed by a focus on quality of examination by the patent offices, not just on rejection rates.

Footnotes

1. ‘Effective specification drafting – a case study based on the Windsurfer Patent’, Paul Cole, IpFrontline practice management paper 2003
2. 37 CFR 1.56
3. In *Exergen Corp v Wal-Mart Stores Inc and S A A T Systems*
4. *KSR Int’l Co v Teleflex, Inc*, 550 US 398 (2007)

Author



James Cross is a partner of RGC Jenkins & Co, specialising in electronics, telecoms and engineering. His practice focuses on patent prosecution and strategic advice for local clients in the UK, including four FTSE 100 companies. He is also active in litigation support, and has an LLM in IP litigation.