

**Patent Drafting for Beginners**  
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**Lecture – 16**  
**Reasons for ordering a Patentability Search**

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### Why Patentability search?

- Save Cost
- Increase the chances of getting a grant
- Improves the quality of drafting
- Analyse Patentable and Non-Patentable features
- Use Prior art references in the application



Reasons for ordering a patentability search. Since a patentability search is undertaken to determine whether to file a patent or not, there could be at least 5 reasons why you should order a patentability search. The first one is the cost. The cost of generating a patentability search is much less than the cost of filing a patent application. The patentability search gives you an indication as to the chances of getting a grant. So, it is kind of a wrist risk mitigating effort. By generating a patentability search, you would know the chances of a patent being granted.

So, if you are operating in a heavily crowded field, where there are other patents, or if your invention is an invention that would not be granted a patent due to certain objections or exceptions in the patent law, then you would save much more in costs if you get a patentability search done rather than filing a patent, and then realizing through office objections that your invention cannot be patented. So, there is a cost factor involved. The first reason why you would engage or order a patentability search is to save costs.

The second reason is that a patentability search which generates a report can help you to prepare a better application. The drafting can be improved, because once you generate a patentability search you would know what are the features of the invention the inventive features we had already discussed that in one of our earlier lessons, what are the inventive features that can be patentable. Because the prior art search or the search report will tell you the earlier inventions of a similar nature. And what were the features of those inventions that were patentable.

Now, this report will help you to determine the patentable features from the non-patentable or the trivial features. Now this is important in drafting. So, in cases where the patent attorney does not have a fair understanding of the field, then this will be critical in helping the patent agent to determine what should be the inventive features that are claimed, and what are the non-inventive or non-patentable features that should not figure in the claim. Now there is also another advantage in generating a patentability search report.

Now, in preparing an application, if there are portions of the prior art which could be reproduced into your patent application while drafting your patent specification, you could kind of copy and paste those prior art references with proper by giving the proper reference, and that could save quite a lot of time and effort in drafting. So, if there are prior art disclosures which forms a background for your invention, you could just use them from other patent applications, provided you give the references to it.

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## Commercial Reasons

- Achieving Exclusivity
- Overcome through alternatives
- Add value to your invention



Now, the third reason could be reasons pertaining to commerce. Now the reason why people file patents are to get a exclusivity in the field. Now a prior art report or a patentability search report will tell you whether you can achieve exclusivity by filing a patent. It can also tell you what are the alternates or or what are the possible ways in which a invention can be overcome through alternatives. Now this will give a fair chance of getting a patent or what are the chances of others imitating your invention, because if it is a crowded field then it is quite possible that a a a competitor could license another invention from and from another granted patent, and still be in the market with the product.

So, the chances of obtaining a patent as well as the chances of getting an exclusive marketplace for your invention will be the commercial reasons that will come out of a patentability search. Now because filing patents involves a substantial investment in terms of money a patentability report can tell you whether you have to make that invention, a substantial investment is involved in patenting and if the value of the invention is critical for the inventor, then the inventor may choose to go beyond a patentability search and ask for a validity search or a validity study.

We had already brought out the distinction between these 2 reports. The 4th reason could be a patentability report can help in avoiding what is called prosecution history estoppel.

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## Prosecution history estoppel

- Prosecution history estoppel
  - Narrowing down the claim
- Festo Principle
  - Understanding the field through the patentability search
- Festo Case: *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*
- Patentability report will help in taking decisions regarding International filing



Now, prosecution history estoppel is during the course of prosecution, you may give up or you may narrow down a claim in order to avoid a prior art. Now when you narrow down a claim, there are some principles like the doctrine of equivalence, which will not have an application when you narrow down a claim in the course of prosecution.

The principle that is the doctrine of equivalence will have a limited application. Now by performing a prior art search, and by generating a patentability search report, you would understand as to how to draft a claim in such a manner that you can protect yourself, or safeguard yourself from a future amendment. Now how is this done? This is done by understanding the field through the patentability search. So, this principle was established in the festo case in the united states.

So, a patentability report can help you to avoid a future amendment, and a future amendment as I just mentioned could be hit by the prosecution history estoppel, whereby if you give up something during the course of prosecution, the benefit of a broader interpretation which is what was referred to as the doctrine of equivalence will not be extended to the patent applicant. The fifth reason could be that the patentability search report can help you to determine whether to file foreign applications. Usually, the cost of filing international applications is very high. So, a patentability report would let you know what are the chances of an objection that could come. Because, the patentability

search report depending on the mandate you give to the searcher can also search for jurisdictions where you want to enter eventually.