

**Patent Search For Engineers and Lawyers**  
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**Lecture – 19**  
**Types of patent Search, Validity Search**

Welcome to the lecture on the Types of Patent Search. Today we will be dealing with the aspects of Validity Search.

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The aspects that we will be covering in this particular lecture are invalidation of patents, the concept in relation to that what constitutes a validity search, and what are the differences with respect to patentability search.

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So, validity or invalidity search is one of the type of patents searches undertaken by different searchers and essentially it is to look at whether a granted patent is valid or not. So, let us first understand the concept of patent validity from the standpoint of the grant and post grant of the patent.

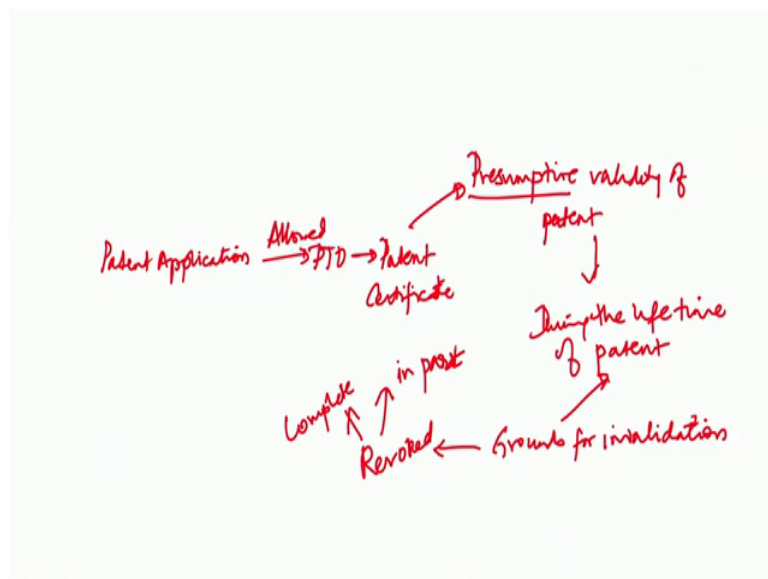
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So, validity or invalidity search means one and the same, but the context could be different. Validity search could be in relation to when you are looking at post grant assessing one's own patent for the validity. So, in that context also one can look at

validity. Invalidation search is typically done when in a case of a patent infringement suit when the defendant is looking at invalidating the plaintiff's patent. So, and then of course, there are other areas of importance where the invalidity search comes into picture, particularly in the area of patent transactions. When you are looking at buying out and selling out patents we would like to be certain on the strength of a particular patent. So, in that sense one would be interested in looking at the validity of a particular patent. So, let us look at what are the, what is the concept in relation to validity of patents.

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So, once the patent application is filed at the patent office, and assuming that it actually goes through the entire phase of the patent office and is allowed you get a patent grant or a patent certificate. Now, this patent certificate brings in the aspect of what we call presumptive validity of patent. Now, it is called presumptive validity of patent because the patent application has been assessed in relation to the criteria as given under the specific patent act.

And so, the examiner of a particular patent application has considered the aspects of anticipation, the aspects of inventive step, the aspects of patent eligibility and other conditions as imposed under the particular law to clear a particular patent application towards the in the order of grant. So, with the limited amount of information that has been available to the examiner, examiner has assessed the patent application and it put it

and as put it to the order of grant. So, this does not mean that the patent is valid in the real sense, because when the patent works that is the time when you get to know, but the whether the particular patent is actually valid or not.

Now, the validity of a patent can be realized when it is actually used or it is manufactured or its implementation can be realized. So, an evidence of use is a requirement to really look at the context of patent validity from the real context of the public use. So therefore, presumptive validity is a concept, wherein the examiner is clearing the patent application as per the conditions laid down under the act. So, all patents are presumptively valid when they are actually grant it out through the patent office.

It is possible that the examiner may have missed certain prior art one because of the non availability of the prior art and another because of the need for an exhaustive and a comprehensive prior art search. It is also possible that the examiner may not get a particular hit in relation to a public use of an invention. For instance: under the Indian patent act to have this category of publically worked in India. Now, the examiner may not get the evidence right away at the stage of examining the patent application in relation to public use.

So, due to some of these constraints that are there in the patent examination system, it is possible that some of the claims of a particular patent application or in some cases patents may be inherently not valid. So, therefore, the challenge to the patent comes post the grant where a case of invalidation of a patent may arise normally when we go through the patent prosecution at the patent office.

Particularly, if you look at it from the context of India we have what you call the pre-grant phase then we have the post-grant phase. At two stages you can actually oppose, the patent one is at the pre-grant where submissions could be made by any one. And at the post-grant phase by party interested can oppose the patent. Now, once the post-grant phase is also over during the time of the lifetime of the entire patent that is during the entire 20 years monopoly period, patent can a patent can be challenged and that is where the context of invalidation comes into picture.

So, during the lifetime of the pa patent, there could be several grounds for invalidation. What happens when a patent is invalidated, it is actually revoked. So, such a revocation

of a patent can happen either complete, which means the entire claims of the patent fall or it could be impart, it could be impart. So, there are several grounds for invalidation of patents available under the patent law which can be taken up for revoking patents.

Some of the grounds for invalidation are not available under the opposition procedure. Some of the grounds are similar in relation to the opposition procedure. So, for instance under a pre grant or a post grant opposition one can take up the aspects of no novelty, lack of novelty, lack of non-obviousness and some of the other aspects of lack of the other aspects under the pre-grant and the post-grant.

Similarly, under the grounds for invalidation also the aspect of the lack of novelty and lack of inventive step is available, but the other several grounds of invalidation which are not available in the pre-ground. For instance, since the patent act very clearly indicates that patents need to be new and not obvious, and are to be capable of industrial application, so which clearly indicates that they only capable of industrial application which means the patent act does not mandate a patent application to show industrial use. So, once you get the proof of concept or let us say the prototype, the patent application goes through subject to the clearing of the criteria and eligibility.

So, the real use of the invention comes actually in the post grant phase when most likely the manufacturing of that particular patent is done by the owner or it could be by way of licensing that the invention is implemented in the public. Taking this into consideration, the lack of utility is a ground for invalidation a ground for revocation of a patent. It is never, it never comes up in the pre grant or the post grant opposition phase. So, this is something we need to keep in mind. Besides this there are many other grounds for invalidation. Let us look at some of those and understand how the different grounds of invalidation are available under the Indian patent act.

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There are different grounds of invalidation that are available under the patent law. The provisions under each type of a patent act vary, what are the grounds for invalidation India can be certainly different from what are the grants for invalidation in the case of other countries.

But generally speaking patent invalidity comes into picture when a claim subject matter is not eligible for a patent under the law, when a claim subject matter is not novel, when it is not obvious, when it is inadequately described, when it is not enabled and also in case when the claims do not have priority that is the invention does not seek priority or rather has a false priority. So, these are some of the grounds which are generally there in most of the patent acts in different jurisdictions. But if you look at the individual statute, one can see the differences in each of the jurisdictions.

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Grounds for revocation of a patent in India

- Anticipation
- Obviousness
- Claims of a patent do not constitute an invention
- Patent that is obtained wrongfully
- Insufficiency in disclosure norms
- Failure to disclose information related to the details of the foreign application

In case of India, there are different grounds of revocation for a patent in India. One is on the grounds of anticipation that is by public by knowledge, prior publication, by prior claims and patents, prior knowledge. So, there are different grounds of anticipation which are laid down under the India patent act, all of which are applicable has ground for revocation of a patent.

If a patent is obvious in light of the prior art this can be one ground for revocation of a patent. When the claims of a patent do not constitute an invention that is they are not eligible as subject matter, which means if you look a if you remember the earlier lecture we discussed about the aspects of section 3 of the Indian patent act which indicates to what are not inventions, what will not be allowed as invention under the Indian patent act. Those are applicable in the case of revocation as well.

If a patent is obtained wrongfully that is the case of inventorship is an issue in which case, yes, this becomes a ground for revocation. And wherever the patent specification requirements are not been met that is in case of the Indian patent act it means that anything which is not in compliant with the section 10 of the Indian patent act which basically talks about the norms in relation to complete specification, that is in case the claims are not clearly concisely presented and the claims are not sufficiently described then this can become a potential ground for revocation of a patent. So, therefore, we have claims is one part of the document in case of a patent, the specification is the other kind

of a part in relation to the patent. So, if the patent specification norms are not met again this can become a potential case for revocation.

Also in relation to applications which are filed in other countries, there is a requirement under the Indian patent act of a statement of undertaking and the information needs to be provided to the controller on the prosecution of those patents in other countries. So, failure to disclose information coming under the purview of what we call section 8, can be again a ground for revocation. So, this is, so there are several grounds which are substantive in nature one with respect to criteria and then of course, you find there are other grounds which are also equally applicable in case of the revocation.

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**Grounds for revocation of a patent in India**

- Invention is not useful
- Scope of the claim is not sufficiently and clearly defined or not fairly based on matter disclosed in the specification
- Patent was obtained on a false suggestion or representation
- Contravention of secrecy provision
- Wrong mention of the source or geographical origin of biological material used for the invention
- Invention anticipated due to knowledge in oral or other form available in local or indigenous community in India or elsewhere

Section 64 of the Indian Patents Act 1970

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When an invention is not useful, then again a case of revocation can be made. And how do you assess this aspect of usefulness in relation to an invention? Normally, under the Indian patent act 3 years is the time period available for a working of a patent. So, if the patent owner who has been granted the monopoly of 20 year term period is actually not practicing the invention by either manufacturing by himself or herself or not even licensing out the invention, then the idea of promoting patents for public cause can does not come into picture. So, therefore, the context of the lack of utility as a ground for revocation comes under the provision of revocation under the Indian patent act.

So, licensing out of an invention is also one way of the determining or providing the evidence of the use of a particular invention. And wherever the scope of a claim is not



clearly defined in that case also a case of revocation can be made. What does that mean? In case with claims do not have the matching description in that case you can have the context of insufficiency which can be brought in; also if the claims are not fairly based on the matter disclosed in the specification. Now, there are two states of filing of a patent application in India, one is what we call the provisional specification and the post filing of the provisional the 12 month is the time period available for the filing of the complete details of the invention in the form of a complete specification.

So, by getting the head and queue by using the provisional route you are securing the what we call the date of filing. When the complete specification is filed it is treated as though it is filed on the date of filing. Hence the complete specification is read in light of the matter fairly disclosed in the earlier application which is the provisional specification. If there is a difference between the context claimed in the provisional specification and the complete specification then the question of a clash of subject matter comes in, clash of claims comes in, so therefore, that can become a potential issue in relation to revocation.

Now, there are certain patents which come under the purview of secrecy provisions, those which are of national security purpose; for instance, atomic energy invention, space inventions. Whenever a patent application is filed in relation to these it is necessary that the government of India clearance has to be taken. So, normally these applications will be sent by the patent office to the relevant agency under the law either with respect to the atomic energy or with respect to space inventions and once the secrecy provisions are revoked the patent goes to what we call the next steps in the patent prosecution, examination and going on into the next steps.

If the applicant contravenes the secrecy provisions again this becomes a potential ground for revocation of patents. Another ground for revocation of patents is the wrong source mention of source. Particularly, this is valid for the case of inventions that arise out of bio resources. So, those inventions which are used in relation to bio resources where they derived from let us say micro organisms or the invention is based on some extract out of a plant, the need for mentioning the source of the biological material is important. This is again in compliance with the India signing up with the Budapest treaty.

So, the source and the details of the geographical origin of the biological material needs to be provided, which is again the compliance which comes under the purview of section 10 of the Indian patent act. So, if there is a wrong mention of such a source and detail again this becomes a potential ground for revocation of a patent.

One of the other important grounds for revocation which is very unique again to the Indian patent act is this aspect of oral knowledge. So, it is at this stage where we really give the importance of traditional knowledge and its importance of relation to the patent act. So, wherever the communities possess the knowledge, which can actually interfere with the novelty of the grant of a patent, so a patent grant is actually already, the patent is already covered by the knowledge available either in the oral form or any other form in a local community or indigenous community in India or elsewhere in the world then this becomes a matter for revocation for patents.

So, there are several grounds with respect to which can be taken up either in single, either alone or together to actually revoke patents. Some exceptions are available, where the case of grace period is applicable with the case of secret trials are available in terms of clinical trials, where the applicability of revocation does not come into picture. Again the context of governmental use of inventions will not invalidate the patent on the context of what we call novelty. So, there are certain exceptions, but largely these are the grounds available under the Indian patent act for revoking patents. So, section 64 is the basic provision under the Indian patent act which lays down the basic grounds for the invalidation of patents.

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Grounds for revocation of a patent in India

- Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy
- under sub-section (1) of section 20 of the Atomic Energy Act, 1962

Section 65 of the Indian Patents Act 1970

Now, in specifically there is also section 65 which is in relation to the governmental purview in relation to revocation of patents. And this is applicable in relation to all inventions which come under the purview of the atomic energy act. So, this is one clause which is there with available under the Indian patent act.

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Grounds for revocation of a patent in India

- Revocation of a patent in public interest
- When the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard revoke the patent

Section 66 of the Indian Patents Act 1970

Those inventions which are not in public interest can be revoked in India under the purview of section 66 of the Indian patent act. So, whenever the central government is of an opinion or a representation of the central government in the form of the public interest

comes into picture in that case wherever the patents are mischievous to state or generally harmful to the public or generally not in public interest then the government will give a notice to the patentee and so that the opportunity to be heard is available and a patent may be revoked in such a context. So, this is another provision which is specifically again in relation to public interest and revocation under the Indian patent act.

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**How to perform a Validity search?**

**Patent Enforcement - when conducted by an assignee/plaintiff**

**Step 1 : Identify the claims of the patent that are in the scope of the purpose of the search**

- Do the claims direct to a product/process/system or a combination of any of these?

**Step 2: Identify the prior art for the claims that are challenged**

- In depth search for prior art from patents (not identified by the patent examiner)
- In depth search for prior art from non patent literature and other relevant sources

Identify the claims of the patent(s) which could be potentially an issue

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So, we come to the important context of understanding why a validity or invalidity search is important. Today largely when we look at patent litigation it essentially revolves around invalidation of patents. So, post the grant of patents many patents are litigated in court and often patents are invalidated, either in part or in full. So, patent offices there are, so there are two ways in which generally patents get invalidated post the grant at the patent office. One is the immediate step that is available at the patent office in the form of what we call administrative review of patents.

So, there are post grant proceedings which are available at the patent offices, which provide for the review of patents. Revocation is one such available. And in many other jurisdictions there are many other proceedings that are available under the purview of the patent office. So, the patent office proceedings are one set of proceedings which are available for invalidation of patents. And of and in many cases due to infringement issues most of this patents are taken up by courts and where again you have the context of validity of patents being challenged in a case of an infringement.

So, typically in a case of a infringement of a patent the defense is the defendant would actually bring in the case of invalidity of a patent. So, when a patent is invalid there is no question of infringing. So, that is the powerful defense, that is a powerful point that the defendant brings in in the case of a infringement suit.

So, these two instances becomes when an important stand point from the point of your understanding patent invalidity. So, looking at patent validity or invalidity at a search is actually a strategy. So, if you are looking at it from the point of your the patent office, it is less expensive, less time taking, evidentiary concentrations are different. If you look at it from the point of view of court and litigation, courts and litigation, more certain evidential standards are different and again timelines are again different and obviously, most court litigations are quite expensive.

So, most of the time the a lot of the invalidity proceedings generally are taken up first at the patent office stage. And today patent offices are now expanding to provide for including pre issuance submissions. So, what happens is even before the patent is issued one can actually submit observations in relation to novelty or non-obviousness. And so with the elaboration of those proceedings available under the patent offices, hopefully more patents are put through the equality check and so most likely the patents had come out from the patent office are going to be of good quality.

So, there are different reasons for why a validity search is undertaken or an invalidity search is undertaken. For instance, let us look at one particular context from the point of view of a patent owner. So, once the patent certificate is given, there is a patent grant and the monopoly period starts. It is possible as we have discussed earlier that certain prior art has been missed during the patent prosecution period. So, therefore, a patent validity question comes into picture. Now, when an owner is looking at the value of a patent or a strength of a patent then one undertakes a patent validity search. So, that is one part of the reason for why a patent validity search is done.

Another reason why a patent owner would like to look at a patent validity search is all to look at it and from a scenario of a possible licensing of that invention. What happens is post grant it is possible that some part of the invention may not be implementable that may be a potentially a reason why a licensee will look at a non-working of a patent claim. So, in order to avoid potential issues in future, one with the licensee and of course,

further on a litigation it may be good for the patentee to do a validity search to ascertain the strength of the claims of a given patent application.

So, what are the steps that are involved in the validity search? First step is actually identifying the claims of the patent which are at the, which are at issue or which need to be relooked at. So, identifying the claims is the first step. Those claims could be belonging to different types of subject matter whether it is product process or a system. So, selecting out the claims is the first step. And then the step two comes into picture where we are looking at for that particular claim or claims we are looking at the relevant prior art. So, identifying prior art is very important in relation to those specific claims.

Now, the question that arises is if the examiner is conducted a prior art search how is this search different from what the examiner has searched during the prosecution history of that particular patent. This search is going to be in depth search which will avoid the examiner search; that means, these are not to be identifying the same patent prior art in relation to what the examiner has done this will be beyond that. So, going into an in depth patent search, similarly going into an in depth non-patent literature search is important, so that is beyond the examiner search is what you listing the prior art. So, that is the second step in relation to a validity search.

So, identification of claims of a patent is important. So, therefore, one needs to keep in mind that the scope of the search should be in relation to the claims which are actually doubtful, from the point of view of what we discussed a licensee or when the patent owner himself wants to implement the invention.

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**How to perform a validity search?**

- Step 3: Identify the keywords to carry out search.  
Keyword combinations may be used, concept search can also be undertaken; IPC search may also be built in combination with keyword search
- Step 4: Develop a search strategy for identification of prior art
  - Patent literature, Non patent literature
  - Public use
  - Selection of a database
  - Field of search

Callout box:  
• Identify if there are priority issues in relation to the invention  
• Identify if patent family members come under the purview of the search

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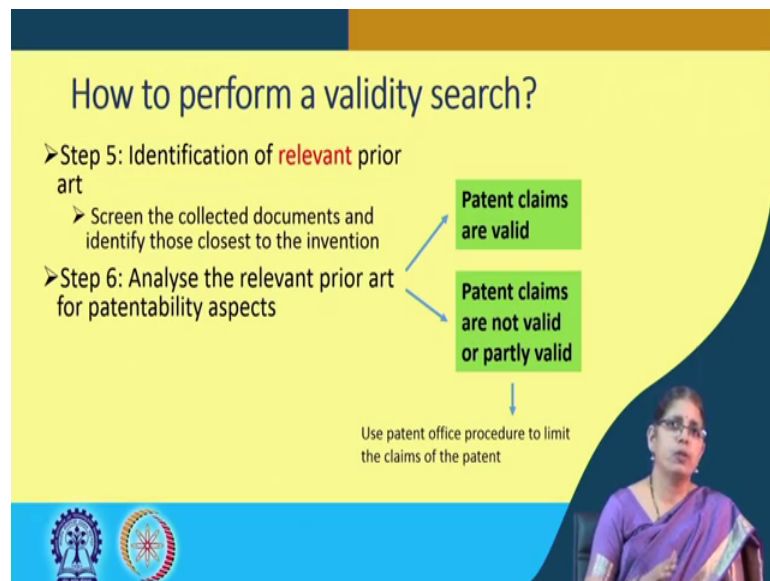
The third step is the identification of key words to carry out the search. Now, here the key words are derived from the claim terms. So, to that extent we were not looking at the invention as a whole, but the specific claim into consideration. One may also combine this well with an IPC search where we are looking at specific areas in relation to that particular invention. Then the step 4 comes into picture where we looking at the developing a strategy in order to look for the search. It is here that you need to really go beyond just the prior art search.

In many cases you need to really go a go into a thorough search from the public use that is it is possible that the product is already available in the market. To what extent do the claims does that product read on to the claims of your patent, understanding that is very important. Sometimes selection of a database is also important because you are aware that these sort of inventions are taken in those particular jurisdictions most of the time in which case your upfront search in relation to prior art must be those specific jurisdictions. Field of search again is important from the point of view of understanding the application of the invention.

So, therefore, there are certain considerations when we conduct the validity search. Sometimes the priority date itself is a question. So, the questioning of validity of a priority date comes into picture in which case you must go back to the date of filing and then take that as the starting point.

Often it is also possible, today litigation is not about single patent it is about a set of patents which are part of a litigation. So, therefore, understanding the relative presence of this particular patent in the patent family may also become an important thing for looking at a validity search. For instance, a substantially similar invention could be dragged into potential litigation in future if this particular patent in question is invalid. So, therefore, taking into consideration the number of patent family members and the relevance of that to validity search also becomes important.

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The identification of relevant prior art is important from the point of view of assembling the prior art. The next step is what we call the mapping of the claim to the prior art. So, looking at the scope of the claim term and the interpretation in the context of the prior art. So, what happens when we analyze the relevant prior art? Two options come up, one is that the analysis reveals that patent claims are valid well and fine. Sometimes it is possible also that patent claims may not be valid or may be partly valid. So, this is an important stage when a decision should be taken by the patent owner on how they could salvage the patent.

Patent office is provide procedures for where limiting of limitation, limiting of claims can be done at the patent office. So, a patent owner can actually call for a re-exam of a patent in which case one can limit the scope of the patent, so that the validity issue does not arise in future. So, patent owners are known to limit their own claims. And this gets



into the prosecution history of the patents and there is a greater certainty in now transacting with that particular patent. So, it also avoids future litigation and potential issues of patents being dragged into the court, not only that you may be also securing the patent family in question. So, one could step for all patent owners is to limit the claims in case they find that certain, some the some of the subject matter in relation to those patents are actually not valid.

So, we have understood the aspect of performing validity search in relation to the context of where a patent owner is limiting his own claims.

Thank you.