

Why search prior art before drafting patent applications

Jonah Probell

One common way that law firms disserve their patent prosecution clients who don't know any better is to advise against searching prior art. It is bad for the client's budget, bad for their resulting patents, bad for the patent system in general, but good for billing hours.

Searching before preparing a patent application is a way for inventors to check their enthusiasm and get a sense for what patent they could get before spending their precious startup time and money. For stable companies trying to rationally optimize the conversion of a patenting budget to portfolio value, searching is also a simple step for avoiding waste.

In this author's opinion, a diligent searcher (company employee, search firm, or prosecutor) should thoroughly search patents and non-patent literature prior art in view of a proposed claim set as part of due diligence before deciding whether to draft a patent application. The searcher should keep track of patent numbers, save copies of non-patent literature for the best reference disclosing each relevant concept around the claims, and submit those to the patent office. A searcher should err on the side of citing more references than necessary. A typical good patent application might cite 5 to 15 prior art references. Far more is too much for the examiner to fully consider and indicates a misuse of the system.

A pre-drafting search on a claim set provides for discarding claims that are unreasonably broad. As a result, the patent office is likely to allow the application with fewer office actions. A benefit of that is that there are fewer intrinsic statements on the record that could create an estoppel in litigation.

Furthermore, having art cited in the application filings diminishes those references, and others with the same teachings, as grounds for challenging validity in litigation and post-grant challenges.

Those reasons increase the monetary value of the patent for purposes of licensing or sale.

Another benefit of proper claim scope before drafting is that it allows for focusing the specification on novel aspects, which saves drafting time and avoids unnecessary disclosures of trade secrets.

Furthermore, some patent examiners appreciate a head start on their own search and prefer working with diligent applicants. This might contribute to more congenial, productive examinations.

Most patent offices around the world do not require but do accept applicant prior art citations. Prior art submission to all offices is a good practice for the reasons above. It improves patent quality, strength, and value.



Arguments for not searching in the US

Willfulness

If a company loses a lawsuit about infringing some other owner's patent and the company should have known that its products infringe that patent and the company infringed anyway then the infringement was intentional, and judges have discretion to enhance damages up to 3x. This, as a reason not to search, is bad advice.

First, a search of non-patent literature cannot discover others' patents.

Second, in *Halo*, the Supreme Court instructed that behavior warranting enhanced damages must be "egregious". Patent prior art searchers usually ignore claims because they are uninteresting as prior art. It would be unreasonably burdensome for a searcher to investigate the company's products for infringement of every potentially relevant prior art patent. The argument that a company's pre-filing prior art search having encountered another owner's infringed patent brings the infringement to a level of egregiousness for enhanced damages has persuaded judges approximately zero times in the entire history of patenting.

If concerned by this minuscule risk, a company should assign a searcher who is not involved in product development and instruct the searcher to not read claims of others' patents. If the only employees competent to search are ones involved in development than an outside search firm is appropriate.

"Freedom to operate", "clearance", or "field of use" prior art searches, which are unrelated to patent prosecution, can create more significant risks of a finding of willfulness, but that is outside the scope of this article.

Inequitable conduct

The Court of Appeals for the Federal Circuit opined in *Therasense* that if a company, with intent to deceive, withheld "material" information from the USPTO that would have warranted a rejection and the USPTO granted the claim then the company acted with inequitable conduct, and the entire patent is invalid. This is a reason to search diligently. This, as a reason not to search, is bad advice.

A diligent searcher assists the USPTO in a more thorough examination, which is the opposite of inequitable conduct. A diligent searcher should keep track of patent numbers, save copies of non-patent literature for the best reference disclosing each relevant concept around the claims, and submit those to the USPTO with an information disclosure statement. Even an incompetent searcher who forgets to submit material references doesn't meet the intent requirement of *Therasense*.

Unless the company tries to deceive the USPTO, there is no significant risk of a loss of the patent due to inequitable conduct.

Conclusion

Many attorneys live in fear of accusations of malpractice. Advising not to search ensures that an eventual finding of willfulness or inequitable conduct against their client cannot constitute malpractice. Advising unnecessary office actions and producing low-quality patents are not grounds for malpractice.

Not searching prior art has become dogma at large law firms such that many attorneys advise clients against prior art searches without knowing why. Clients encountering patent prosecutors who advise against prior art searching would be wise to seek counsel from someone else who understands the business implications and takes the risk of giving good advice.

About the author

Jonah Probell develops a high-value patent portfolio for a small company. He also organizes a free monthly meetup in Silicon Valley for inventor-entrepreneurs to learn about patenting.