

Get a Patentability Search Before Filing Your Patent Application

by Paul Norton

You are going on a 2-year trip, and it's going to cost you about \$20,000. If you don't know what it's going to look like when you get there, how are you going to know what to pack? It's hard to prepare for something when you don't know what to expect. So it makes sense to read travel guides, talk to people who have traveled there before, and perhaps even consult an expert—anything to give you the lay of the land.

The patent process is similar. It's time consuming and expensive, and you are much better off being prepared for the journey than just winging it. This is where a patentability search can come in handy.

The average patent application is pending at the Patent Office for 2 years before it is either allowed or abandoned. During that time, you can expect to spend thousands of dollars on drafting and prosecuting the application, not to mention all the government fees along the way. If you aren't prepared before filing your application, you may not get the best scope of protection in the end and it may cost you more time and money to get there.

As an inventor, you probably have a pretty good handle on what has been commercialized in your focused area of invention, but keep in mind, not every invention makes it to market. With over 10 million issued patents (in addition to about the same number of unpatented applications), you can bet there is something out there you haven't seen before. A patentability search performed by an expert can help you to efficiently wade through those references and help you uncover those already conceived inventions to help paint a picture of the landscape of inventions related to your idea. It can help you get a feel for the scope of protection available and help you make a better-informed decision as to the value of what may end up being a potentially narrow patent.

Patentability searches can also help to key you in on what makes your idea new and non-obvious—two of the essential hurdles to patentability that are likely to be the focus of discussion when your application is being considered. Knowing what differentiates your invention from everything that came before allows you to draft an application and patent claims that emphasize the unique and patentable aspects of your invention. This can include,

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for example, drafting a clearer picture of *why* your invention is better than other, related solutions to a similar problem and *how* aspects of your invention make it unique and patentable. It's better to know what that is before you file rather than dealing with it two years down the road. By homing in on and emphasizing the patentable aspects of your invention earlier in the process, you can streamline prosecution at the Patent Office and potentially get a broader scope of protection. That equates to less time waiting around, stronger rights, and more money in your pocket.

You can, of course, attempt your own search, but patent searching is an art. If you are not intimately familiar with how the Patent Office classifies inventions and how patent practitioners characterize things, then you would be hard pressed to find what you are looking for—even if there is a patent reference that discusses exactly what you've invented. Professional search firms are the preferred way to go. The national average for a patentability search, including a discussion with your patent attorney regarding the search results, is between \$1,000 – \$3,000, depending on the technology and number of references.

It's hard to prepare for something when you don't know what to expect. If you are going to devote this much time, money, and energy into protecting your invention, the initial investment in a patentability search is almost certainly worth it, and it can end up paying for itself in the end. Like a good travel blog, though, a patentability search probably isn't going to catch everything every time, but it will still help you to know what is out there. And knowing is half the battle.