



Importance of Prior Art search in Patenting

Any new product or process involving an inventive step and having industrial applicability can be categorized as an “invention.” An invention is eligible for patent protection only if it satisfies the criteria of novelty, inventive step, and industrial applicability.

An invention is considered novel when it has not been anticipated by publication in any document, nor used in the country or elsewhere in the world, before the date of filing of the patent application. The novelty of an invention is determined based on the availability of prior art and the degree of similarity between the prior art and the subject invention. If a single prior art document discloses all the features of the invention as such, the novelty of the invention is deemed to be lost.

Prior art refers to any publicly available information that demonstrates that an invention is already known or obvious to the public. This may include granted patents, published patent applications, journal articles, research papers, webpages, books, social media disclosures, presentations, videos, or any other publicly accessible material.

It is always recommended to conduct a comprehensive prior art search before filing a patent application to assess the patentability of an invention. Patent filing and prosecution involve significant financial and administrative resources, and an effective prior art search helps in identifying the grey areas of the invention and drafting the application more precisely. Identifying the gap between the subject invention and the existing prior art is crucial for defining the scope of claims and helps prevent potential invalidation of claims in the future.

Prior art searches can be conducted using both paid and free patent databases. Freely accessible databases such as **Google Patents**, **Espacenet**, **PATENTSCOPE**, and the official websites of patent offices like the **USPTO**, **IPO**, and **JPO** provide valuable resources for conducting preliminary searches. Regular access to these databases—similar to non-patent literature sources—is essential for understanding patentability at the early stages of research itself.

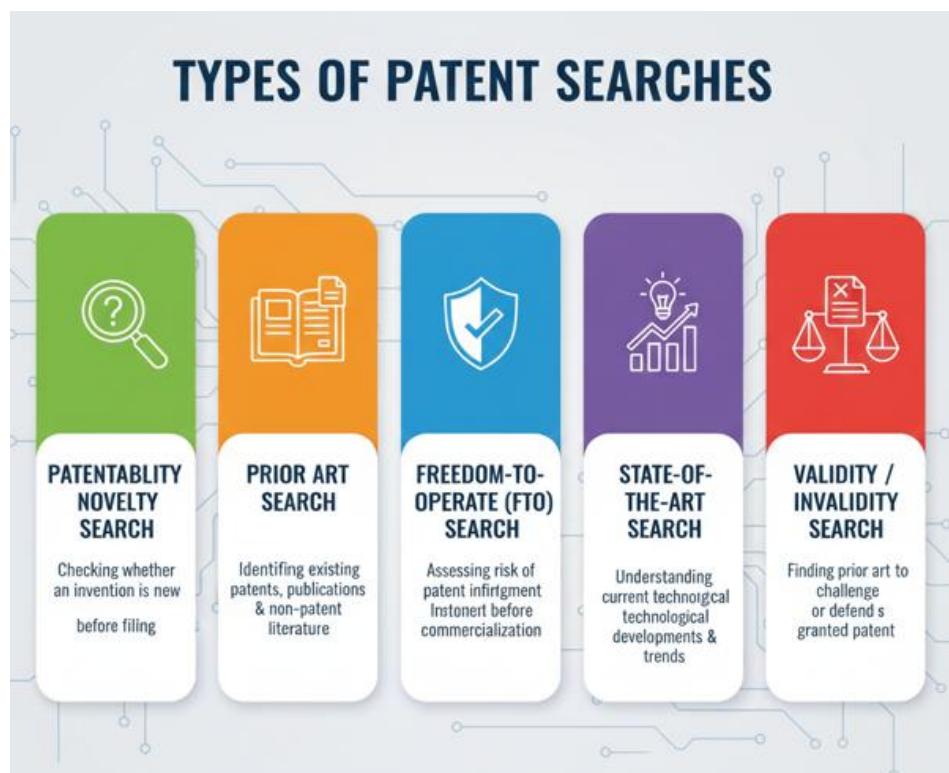
Although no prior art search can be 100% effective, the benefits of conducting a proper search are substantial. In addition to assessing novelty and inventive step, prior art searches help

identifying potential future licensees and provide insights into existing competitors and technological trends in the relevant field.

Types of Prior Art Searches

1. Novelty Search

A novelty search is conducted to determine whether a given invention is new. It checks if the invention, as a whole, has already been disclosed anywhere in the world before the filing date. Novelty is lost if all essential features of the invention are disclosed in a single prior art reference. It should be ideally conducted before filing a provisional or complete specification. However, conducting a novelty search at the early stages of research will help to avoid reinventing the wheel.



2. Prior Art Search

Prior art search is usually conducted to assess whether the invention satisfies the patentability criteria of novelty and inventive step. It identifies relevant documents or disclosures (patented, non-patented, any published article, website, literatures etc) affecting patentability and helps refining the claims in order to reduce the risk of rejection during examination. It also protects the claims from invalidation that may happen in future.

3. Freedom to Operate

A Freedom to Operate (FTO) search is conducted to determine whether a product or process can be commercially used, manufactured, or sold without infringing existing active patent rights in a specific jurisdiction. It helps in identifying patents in force that may pose a risk of patent infringement before product launch or commercialization. Only granted patents and claims are taken for analysis and conducted in a jurisdiction specific manner.

4. Invalidity Search

Invalidity search is a type of patent search conducted to challenge the validity of a granted patent by identifying prior art that can invalidate one or more of its claims. A detailed claim by claim analysis is performed in a broader way by Patent/legal Professionals. Invalidity search is valid especially during the Patent Revocation Proceedings or Infringement suits. It is also conducted just before licensing, to understand the strength of the claims and to compare with the competitor's patent.

Conclusion

Patent search is not just a formality to complete before patent drafting. By identifying existing technologies and publications early on, informed decisions can be made, avoid legal pitfalls, and strengthen the patent portfolio.

A well conducted prior art search allows the Applicant to draft a specification much stronger, addressing the potential challenges of the prior arts and hence increasing the chances of being granted. It helps in avoiding direct prior art hit during the examination and allows one to easily overcome the objections raised by the Patent office. A well-defined patent claims enhances the value of the patent by increasing the scope and its enforceability. This is particularly important in negotiating the licensing terms.