A guide to patentability/novelty searching

Have you documented the existing relevant intellectual property (i.e. prior art or competing art) for your technology solution?

What is this tool?

This tool will guide you through the patentability/novelty search process to help you determine the novelty or newness of the intellectual property (IP) in your technology solution.

This search can also be referred to as a patentability search, novelty search or a prior art search.

What is a patentability/novelty search?

A patentability/novelty search is a process of evaluating the ability to protect your invention using a Patent. It answers the question *What patent protection has been done before*?

A patentability/novelty search can help you decide whether you should patent the intellectual property in your technology solution/invention.

Note

This tool builds on the State of the Art searches and lays the foundation for future Freedom to Operate searches (which focus on active patents). All of these searches are important parts of the evidence collection process to whether you can pursue a patent for the IP in your technology solution.

If you need help, refer to the **A guide to 'State of the Art' searching**.

Why use this tool?

Conducting a patentability search is one of the best ways to protect yourself from spending a lot of money on unsuccessful patents.

This search will help you to find the closest existing patents or idea/s which have been published anywhere in any format.

The patent process can be expensive, so it is important to prepare carefully to avoid wasting time and money.

A patent application will be rejected by any authoritative patent office if it does not meet the novelty criteria (i.e. a granted patent already exists).

Therefore, it is important to verify the originality of your invention before you invest too much time and money into the commercialisation process.

Caution

While this guide can help you conduct this search on your own, seeking out and paying for professional advice (if your budget permits) is always the best option as you will receive a much more detailed search result.

Checking if there is any protected IP that may impact your commercialisation journey early in the process has a number of benefits:

1. You will avoid submitting patent applications with claims that are not patentable and therefore easily rejected.

2. You will determine whether your invention is novel when compared to public 'prior art' or 'competing art'.

3. You can develop a strong IP strategy before you spend money filing for a patent or other IP protection applications (and thus reduce the chance of extensive amendments).

4. You will better understand how your idea fits into the technological field, including the advantages or improvements over relevant prior art. This can help persuade the patent office that your invention is 'non-obvious'.

5. You will be well prepared to discuss your invention with a patent attorney and explain what aspects of your work might be patentable.

Source: Michael K. Henry PhD (2017) How to do a Prior Art Search yourself. Blog *https:henry.law/blog/how-to-do-prior-art-search-yourself/*

Tip

Undertaking a patentability search will help you become familiar with what already exists (i.e. prior art and competing art), **so you can focus on what makes your invention unique.**

Note

Prior art is…

Any evidence that the IP in your technology solution is already known.

Competing art is…

An idea that may not be the same as the IP in your technology solution but does the same job.

Note

If something is patentable, it means that it meets the patenting criteria, including:

• **Novelty:** one of a kind

• **Non-obviousness:** no publications/patents have suggested it could be done, or the invention is not obvious to someone skilled in the field.

These are just two of the eligibility considerations of a patent.

How to use this tool?

The following steps provide general guidance for undertaking a patentability/novelty search yourself.
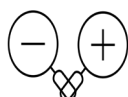
Step 1. Set the scope of the search

For example:

1. Take stock of what you already know and use this knowledge to help you start to define your search. If you completed a prior art search, refer back to the results.

2. Brainstorm keywords with your team to maximise your chances of finding relevant search results. Try and cover all possible descriptions by thinking about what the technology solution/invention does, not just what it is called.

Step 2. Develop a search strategy

For example:

1. Start with a free to use/publicly available patent database that is known to store a broad collection of patents such as **Google Patents**.

2. Where possible, use the Advanced Search function and search for keywords in the abstract or the full text description of the issued patents rather than just the patent titles.

3. Consider the timeframes that you are searching. Historical patents can be considered as prior art, as much as current patents.

4. Search at least one or two more databases. No single database is comprehensive; each one has its strengths and weaknesses.

Tip

Becoming familiar with the nuances of patent searching can take time, as there is more than one way to undertake a search.

Experience is a key advantage when undertaking a search.

So if you are struggling, don't hesitate to use the services of a professional.

Example: The Mouse Trap

Think about key words associated with this invention/ technology solution.

A search for 'mouse trap' produces more than two million hits; many of them irrelevant and an impossible number to search.

But a search of 'rodent trap' (what else is it called) and 'trapping mice' (what it does) produces 20,000 and 700 hits respectively.

These are still not small numbers but they are likely to be more relevant, so it is more useful to start your search with these results.

For more tips about searching go to **10 Tips for Patent Searching**

5. Read the patents and refine the search results using common references, patent classifications and patent authors.

6. If your search results are limited, consider expanding your search strategy to include a 'product' search. A product search explores what is already on the market. You can use a search engine (such as Google) to scan for images (not text), and can help you more easily discover what was, or is, available in the market than just using a text-based search.

Tip

For a novelty search you need to use databases that give you the widest possible coverage.

The Web of Science Derwent Innovation Index, Espacenet or Google Patents would be good places to start for this type of searching.

Avoid databases that are patents only.

Step 3. Implement the search

Follow your search strategy using free to use/publicly available patent databases. We recommend using the following patent search tools to kickstart your search:

- **Google Patents**
  https://patents.google.com/

- **Espacenet**
  https://worldwide.espacenet.com/

- **PatentScope**
  https://www.wipo.int/patentscope/en/

- **DepatisNet**
  https://www.dpma.de/english/search/depatisnet/index.html

- **Derwert World Patents**
  https://clarivate.com/derwent/solutions/derwent-world-patent-index-dwpi/

- **NOIP**
  https://www.noip.com/

Tip

Do not ignore evidence you do not like.

The purpose of this search is to go looking for evidence you do not like.

If you do not look for it, potential customers/clients or investors almost certainly will.

You are unlikely to get help or funding if they find crucial prior art that you have missed.

Step 4. Record your search criteria and results

All findings should be well documented and appropriately referenced so you can go back to them in future (or show to others).

Step 5. Taking action

If you cannot find any evidence of the same or similar IP in your technology solution, then you are in a good position to continue with your Commercialisation PLUS journey.

However, if you did find something it is best to speak to an experienced patent attorney for advice on how to handle the situation. Options that you can discuss with your IP specialist include:

1. how to disclose any relevant prior or competing art in your IP application.

2. how to develop 'design-around options' for your technology solution. Just because one or some claims have been invalidated doesn't mean that the entire patent is invalidated[1]. Further research may be required. Consequently it is recommended to delay continuing your Commercialisation PLUS journey until this process has been completed.

3. abandoning your Commercialisation PLUS journey and considering other non-commercial paths to impact for your solution.

4. abandoning your technology solution and focusing efforts on other solutions.

Tip

It is important to update your searches periodically.

Depending on the timing of your search, you may miss relevant patent applications that aren't published immediately after they are filed.

[1] *Michael K. Henry PhD (2018) When can Prior Art invalidate an issued Patent? Blog https://henry.law/blog/prior-art-invalidate-issued-patent/*

Note

This tool has been developed to help you complete your own patentability/novelty search.

However, engaging with an expert who specialises in IP searching can be very helpful as you can draw on their experience. They can also access additional databases, which enables a more comprehensive check.

Using their specialist experience expertise in IP data collection and interpretation can help ensure you overcome common search mistakes and interpret results within appropriate contexts.

Check with your university/research organisation's IP Office to see who they recommend to help with your search.

Caution

It is important to understand that no search—not even an official Patent Office examination—is regarded in law as conclusive proof of novelty. An absence of evidence of 'prior or competing art' at the time of your searches may not be a permanent absence. Depending on the timing of your search, you may miss relevant patent applications that aren't published immediately after they're filed.

It is recommended that you update your searches periodically to help manage this risk.