

Primary Consideration Before Drafting a Patent Application: “Predicting Patentability through Prior Art Search”

WHAT IS PRIOR ART ?

- ❖ **INFORMATION existing before the effective filing date of a patent application**
- ❖ **PRIOR ART (*Section 24, IP Code*)**

Prior Art shall consist of:

24.1. Everything which has been available to the public anywhere in the world, before the filing date or priority date of the application claiming the invention;

24.2 The whole contents of an application for patent, utility model, or industrial design registration published, xxx filed or effective in the Philippines, with a filing or priority date earlier than the filing or priority date of the application xxx....

Patentability Requirements

❖ NOVELTY (*Section 23, IP Code*)

An invention shall not be considered new if it forms part of a prior art.

❖ INVENTIVE STEP (*Section 26.1, IP Code*)

An invention involves an inventive step if, having regard to prior art, it is not obvious to a person skilled in the art at the time of the filing date or priority date of the application claiming the invention.

❖ INDUSTRIAL APPLICABILITY (*Section 27, IP Code*)

An invention that can be produced and used in any industry shall be industrially applicable.

PRIOR ART

- ❖ ISSUED PATENTS
- ❖ TECHNICAL PAPERS
- ❖ SCIENTIFIC TREATIES/PUBLICATIONS
- ❖ TEXTBOOKS
- ❖ CONFERENCE PAPERS
- ❖ MARKETING BROCHURES
- ❖ PRODUCTS
- ❖ DEVICES
- ❖ EQUIPMENT
- ❖ PRIOR USE & ORAL DISCLOSURES (*Rule 204a, IRR*)
- ❖ *NON-PREJUDICIAL DISCLOSURE (Rule 205, IRR)*

WHAT IS EFFECTIVE FILING DATE?

- ❖ **“Effective Filing Date”** – it is the Earliest Filing Date that the pending patent application can claim
 - **Direct Route applications** - the actual filing date
 - **Foreign applications** - filing date of the foreign application, if priority right is claimed
 - **PCT applications** - the actual filing date or priority date
 - **Divisional applications** - the date of the parent application

PRIOR ART SEARCH

- ❖ **Prior Art Search - organized review of prior art contained in public documents**

- ❖ **Kinds of Prior Art Searches**
 - **Patentability Search**
 - **Invalidity Search**
 - **Patent Examination Search**
 - **State of the Art Search**
 - **Freedom to Operate (FTO) Search**

PRIOR ART SEARCH

❖ Databases for Prior Art Search

- Public Databases of issued patents in the internet

(IPPHL, WIPO-PCT with ISR, EPO, JPO, USPTO, Google Patent Search, Free Patent On-Line, etc.)

- Exhaustive Databases

(Patents + Non-Patent Literature)

- Scientific Databases

(Contain articles on technological advances in the field)

SIGNIFICANCE OF PRIOR ART SEARCHES

- ❖ Search results as a critical factor in deciding whether to file a patent application**
- ❖ To gauge prospects of obtaining broad claim coverage**
- ❖ To “design around” by drafting claims avoiding the prior art**
- ❖ In order to make an assessment of patentability**
- ❖ To get information on developments in the field of invention**

EXAMPLE

Inventor A - Pencil with a light attached

Patentability Search - Discovers unexpired patent in the country where A plans to sell and use the invention.

Recommendation - Can design around the patent or decide not to enter the pen-with-light market

How to Search Prior Art

- ❖ **Conduct actual search in the Patent Office library**
- ❖ **Conduct On-Line Search:**
 - **Keyword Search**
 - * **Appropriateness of words in the description and aspects of the invention is important**
 - * **Essential function of the invention**
 - * **Essential effect resulting from the invention**
 - * **Physical structure of the invention**
 - * **Intended use of the invention**
 - **Field Search**
 - To refine the results of the keyword search**

Classification System

- ❖ Review and sort out patent applications according to its technology type
- ❖ Routing and distribution for assignment to the proper examining divisions/groups
- ❖ Patent Examiner further classifies the application and conducts prior art search in the specific fields of classification

Classification System

1. International Patent Classification (IPC)

- updated editions (8th edition)

- e.g. B60R1/10

B - Section (performing operations, transporting etc.)

60 - Class (for “vehicles in general”)

R - Subclass (for “vehicle fittings or vehicle parts”)

1 - main group number (“optical viewing arrangement”)

10 - subgroup (“front view mirror arrangements”)

Classification System

2. USPTO Classification System

-Class/subclass

For example:

- Mouse Trap

(Class 43, subclass 52)

- Simple Mouse Trap with Door

(Class 43, subclass 62)

**THANK YOU FOR YOUR KIND
ATTENTION!**