

Patent Drafting for Beginners
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Lecture – 19
Limits of patentability search

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Limitations of search

- Availability of databases / records
- Negative approach in searching
- Input given to the searcher
- Absence of key references
- Restricted key words
- Inappropriate IPC Class



Limits of a patentability search. The patentability search has its own limitations. The very nature of search involves looking for prior art documents which are codified, or which are recorded in some form of a database. So, in practice when a search is being done we are referring to searching online databases. So, anything that is codified and searchable, and available to the searcher may catch the attention of the searcher. There could be a number of prior art material which are not codified or recorded or available on an online database for search.

All those prior art material will still be relevant can easily knock off the invention, but will not be available when a search is being done. For this reason, we say that no search is perfect. And there is no such thing as a perfect search, and a perfect search is not something which anybody should even endeavor to do. The reason being, in a search you would be trying to prove the negative. You would be looking for prior art to destroy the invention, or which can kill the novelty. Unless you find it, you will only return by saying that such a thing could not be found.

Secondly, the quality of a search depends on the quality of the input in the form of a disclosure that has been given. If the disclosure is not up to the mark, there are chances that the search will not yield the best results. Thirdly, there could be some key references that are missed out in certain databases or which do not throw up in certain databases, and it could be a reason for missing out something which was already there. Fourthly the keywords that you use may not cover all or capture all the variants in that particular field. And that could be a reason why you miss out a critical reference.

Fifthly, you could be searching in the wrong classes. Now for this and for many more reasons we do not consider a search to be a perfect reflection of patentability of our invention. If you require a more detailed analysis of the invention, then what is needed is what we called a validity search or a validity study. A validity study is much different from a patentability search, and it involves determining whether an invention is valid or not. So, these are the limitations of a patentability search. You would normally advise the client about the patentability search, because of these limitations so that there are no unreasonable expectations from the client.