

Patent Drafting for Beginners
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Lecture – 39
When a patentability search is not needed

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Search report is not needed

- Cost on the client
- Time factor
- Vague Technology
- Obscurity in literature



When a patentability search is not needed; there are at least three cases where you will not need the patentability search or rather doing a patentability search would be counterproductive. The first instance is when the client cannot afford both a patentability search and the filing cost for filing and drafting a patent application, so that is something which will depend on the amount or the budget the client has for filing patents.

So, if the client operates on a tight budget, then it would not be advisable to go in for a patentability search report followed by the filing and drafting of a patent itself. And especially in a market like India where the cost of search can be substantial, it would put the client in a precarious position because the client would end up expending huge amount of money for the search, and then later on could eventually realise that there was nothing to patent at all.

So, the first thing to consider is the affordability or whether the client can afford a search report to be followed by the filing of a patent application itself. You would rather prepare and file the patent application itself. This could be a result of either the client wanting to

publish a paper like say if the client is a professor in university, he could be in a hurry to publish his paper. So, you would not then get into patentability search report, you would rather file a provisional if that is the best course to follow or the client would want to release the product or they could be some interest in filing abroad. In all these cases you would not going for a patentability search report, because timing could be critical.

In cases where there is a constraint of time, one approach you could follow is to prepare a search report, and simultaneously also draft the patent application. Now, this could be done simultaneously, so that time is saved and the objective of the patentability report improving the drafting process is also achieved by doing this. Which means as you draft the patent application the patentability search report will inform you how to claim, how to make changes, how to fine tune the application, how to get over prior art and various other things which we have seen could be the benefit that comes out of a patentability search report. So, one approach even if there is insufficient time is to do both the search and the drafting simultaneously.

The third reason why you would not going for a patentability search report is when there is nothing that will be achieved by generating a patentability search report. This is if the technology is very new, that there is no not much literature to be searched or traditionally the technology has been kept as a secret as it is in some fields or there are very few players in the field.

So, in all these cases you would not going for patentability search report because there is nothing much to be achieved by getting one. You would also not go in for a report when the client has enough knowledge which is not found in the field if you would do a search. For instance some university professors may have cutting a knowledge about their field which would be much better than what you would normally get by doing a search report.

So, these are the conditions in which you would not going for a search report, but the search report as we have already shown in our earlier lessons could bring substantial value into the drafting process.