

**Patent Drafting for Beginners**  
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**Lecture – 40**  
**How to order a Patentability search**

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### Factors considering the report

- Identify a searcher
- Furnish appropriate information
- Define the scope of search
  - Indian Filing
  - Foreign Filing / Country specific
  - Patent / Non-Patent Literature
- Define the Budget



How to order a Patentability search; there are certain factors you will consider before ordering a patentability search. The first thing will be in selecting a searcher. Now, you would normally select a searcher who is competent in a particular technology. Now, searchers specialized in different areas, they could be searchers who are specialized in electrical, chemical, metallurgical, or electronical, and biotechnology, or they could be specialized in computer related inventions or in mechanical inventions.

So, you would identify your searcher, so that because the searchers task is to be aware of the domain knowledge. And if a person has a background, then you could expect a better search from that person.

You could also have different searchers doing different parts of the job. For instance you could have one searcher to look at all the patent office files that is the prior art from the patent office. You could have another searcher who has the competence to look at non-pattern literature searchers. And you could also have another part searcher looking at a

foreign patents for the same invention. So, the results of a search could be product that comes out of the work of different searchers who have searched different categories.

Secondly, you will stipulate the information that needs to be included in the search request. Now, the search or the quality of the search will depend on the information that you have supplied. If you have drawings of the invention, then it becomes much easier for the person to understand the invention and to generate a report based on that. So, you would normally discuss with the searcher as to what are the things that the searcher should look for, and what is the time and resources that you will be putting into the search. So, there is a budget for the search, and you will describe within that budget what needs to be done.

Now, you would also say to the searcher whether the search should be confined to only materials that are patents; that is the patent literature or whether it could also go beyond the files of the patent office and which is what we call a non-patented literature search. There are different databases both free and paid which could be used for searching.

The third thing is to describe the scope of the search. Now, if you are filing an Indian patent, then you would normally want the search to cover the Indian patents and also prior art which could be relevant. So, or if your search is particularly to enter a particular jurisdiction say a foreign filing, then you would stipulate that you need to understand what is the patenting on this invention in a particular jurisdiction. So, or you could also stipulate whether the search should contain patent literature and non-patent literature. So, in all these cases, you would be describing the scope of the search based on which the search report will be generated.

Now, the fourth thing you would consider is the cost, normally the cost of a search is fixed, but in some cases where they could be field or the complexity of the field or the technology involves more time to be expended by the searcher, then you would have a variable component where depending on the number of hours extra hours that is being spent, the remuneration or the fees would change.

The fifth thing is to stipulate the mandate of the search through a request letter. Now, this is done by writing to the searcher stating what needs to be searched. If it is an Indian Patent Office, you would say that this invention is to be filed in the Indian patent office, and you would want to search all the patents in the Indian patent office. If there are some

further information like description or drawing that need, that can add further clarity then you would disclose that to the searcher. If there are classification that you know which needs to be searched, you would stipulate that to the searcher. And if there are novel features of your invention, the features which you considered to be inventive, you would also tell the searcher that these are the inventor features, so that the search is done comparing the inventor features and leaving of the non-patentable or the trivial features.

Now, you would in your request letter, you would also stipulate a deadline, so that the search is done within a time frame. And you would also stipulate in your search letter if the work involves further additional work, so that the terms are flexible. So, you would give further authorization for the person to do additional work in case it is required.