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DO I NEED A PATENT SEARCH?

A patent search is a good idea but it costs money upfront. Deciding whether to spend the money on a patent search is a difficult decision to make. It depends on many factors. I will try to list some of the pros and cons and give you some practical advice to help you decide if a patent search makes sense for you.

1. A patent search keeps you from wasting a lot of time and money on an invention that would be not be patentable or at least very difficult to obtain meaningful patent protection for. A good search can turn up prior inventions that could potentially bar an inventor from obtaining a patent. Additionally, a good search will predict the objections that the patent office might raise against patentability and give you extra time to consider a proper response to an office action such as a rejection. If you are trying to form a new company around your invention, you need to be aware of all possible problems associated with your invention. In this case, in my opinion, it is well worth the added expense for the patent search to give yourself a "heads up" on your invention.
2. If you are not really starting a business and you are just interested in getting a patent on your invention you might want to skip the patent search. There is often something unique and patentable about your invention, although it might not be commercially significant.
3. If you find yourself in the position of really wanting to get the patent, but you have very limited capital, you might consider filing a provisional patent application and then taking the year that the application gives you to explore financing alternatives. There are dangers involved in provisional applications and you need to be very cautious that your provisional application will be enabling when it comes time to replace it with the utility application. If you do not have sufficient disclosure to support your future application, you could lose your patent rights. Some firms allow you to apply some or all of the fee you pay for drafting a provisional application to your utility application. Of course you have to use the same firm in order to get the credit. This means that you can gain a year to find extra financing without wasting much of your money. It is a good option for the inventor who is tight for money. Of course you could still benefit from a patent search, but if money is the reason for filing a provisional application, you will likely have to skip the search and just proceed with the provisional filing.

Some things to consider:

Q: Can't every patent be "written around", so isn't a patent search just a waste of money

A: Although this statement is too broad in my opinion, there is some truth to it. A good patent attorney is very likely to get you some patent protection for your invention if there is any patentable subject matter to your invention, but it may not be commercially significant. Just having a patent on something does not mean that it is valuable. There are many patents that never lead to any product being sold in the market. If your goal is just to have a patent, then you could reasonably skip the patent search and respond to the office actions when they come.

Q: Does a patent search guarantee that I have a patentable invention?

A: No, absolutely not. There is no way to guarantee that the patent office will conclude the same thing that your patent attorney or agent will conclude. Any company that would "guarantee" you a patent is not being honest. Although as stated above, it is often possible to get a patent even when there is a patent close to your invention, it is never possible to guarantee a patent will issue.

Q: If you can't guarantee a patent, isn't a search just a waste of time and money, won't the patent office perform a search anyway?

A: Again, the answer to this question is yes and no. It is true that if you file a patent application (non-provisional) the patent examiner will perform a search to see if your invention is patentable, however, you may have invested a lot of time, effort and money into your endeavor before learning of the potentially damaging search results. It can be very expensive to respond to office actions and to file continuing applications, etc. The pre-filing patent search can give you warning of the dangers ahead in obtaining patent protection and let you decide if you even want to pursue it.

Q: What if I am in a real hurry and don't want to waste the time?

A: There is no requirement to do a pre-filing search so if you are facing a real time pressure situation (i.e. time bar approaching etc.) then by all means, file without the search.

Q: Can't I do the search myself and save some money?

A: Yes, of course you can. Many inventor societies have wonderful resources to help inventors do their own searches. An internet search for resources should turn up some good search tips. The United States Patent Office also has some fairly easy to use resources for inventors along with tips on how to use them. Of course, unless you are experienced in the patent search field, your results will not be as comprehensive as a professional search, but it might give you an idea if your invention is worth pursuing.

The decision to have a pre-filing search is not an easy one unless money is not really an issue. Overall, I recommend a patent search, but there are situations as noted above where it makes sense to proceed without one. Many patent professionals offer a free consultation and you could bring up the search question with him or her at that time to get a personalized opinion based on your particular situation.

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