

# What's So Special about Invalidity Searching?

PIUG 2011 Annual Conference

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# Leading Questions

1. Where should we focus our research and development efforts to gain competitive advantage?

State-of-the-art

2. May we obtain a patent to keep others from practicing our invention?

Novelty / Patentability

3. May we practice a technology, i.e., manufacture or sell a product, or carry out a process, without fear of being sued for infringing a patent?

Infringement / Freedom-to-operate (FTO) / Freedom-to-practice (FTP)

4. Do we need to be concerned about another's patent, perhaps found in an FTO search, that relates to our technology and business plans?

Invalidity

5. May we enforce our patent, i.e. win a litigation proceeding if necessary to keep others from practicing our technology?

Validity

# Invalidity or Validity Search?

- The same search process
- Find critical prior art (“magic bullet”) to demonstrate that the patent should not have been granted in the first place
  - Invalidate another’s patent
  - Validate client’s patent
- A matter of perspective

# What is an Invalidity Search?

- A novelty search with time constraints
- Ideal finding to “invalidate” the patent
  - A single document
  - Pre-dates the relevant priority date
  - Not considered by patent examiner
- Obviousness, utility or patentable subject matter are much harder to support

# Characteristics of Invalidity Searches

- Supports legal opinion of patent attorney for
  - Pre- or post-grant ex-parte proceedings
  - Litigation
  - Knowledge just in case of potential conflict
- Done in context of prior searches
- In-depth scrutiny of documents

# Key Practices

- Understand the subject and claims to be invalidated
- Search broadly
- Concentrate on the details
- Know when to stop
- Report what the client needs

# What's to be Invalidated?

- All claims in subject patent?
- Specific claims?
- Subject matter that could be claimed?
- From what patent authorities?
- Be cognizant of priority dates for each claim

# Search Broadly

- Start with search reports, prosecution histories, reason for allowance, opposition proceedings, litigation proceedings
- Use every tool: patent classifications, database indexing, free text, citation searching



# Concentrate on the Details

- All content of candidate references is subject to intense review – full-text
- Examine text and pdf
  - Diagrams, chemical structures, tables
  - Examples
- Understand terminology
- Convert units of measure, analytical methodologies and other test results
- Report and do calculations on spreadsheet

# Know When to Stop

- Based on budget and customer input
- Don't stop prematurely
- Don't continue indefinitely

# Report What the Client Needs

- Lists of prior art references – search reports and new findings
- Claim chart – one-to-one correlation between subject patent and prior art
- Details of actual findings from prior art
- Full search strategy

# So What is So Special?

- The thrill of the hunt, finding the “prey”
- High creativity
- Requires high technical expertise
- Patience required
- High reward – monetary, psychic
- Risk - low (invalidity), high (validity)
- Expectations – low / high

# Successes

1. Compositions with
  - Specific additives with specific properties
  - Target physical properties
  - Target ratios of additives
  - Target elemental analytical ratios
2. Review of documents in prosecution history that were found to be missing critical pages

# Conclusion

- Are invalidity searches my favorite?
- Are they yours?