

# **Patentability Case Study: Mistakes Happen**

PIUG 2019 Northeast Regional Conference

Thomas E. Wolff, Ph.D.  
Wolff Information Consulting LLC

# Patentability Case Study: Mistakes Happen

- This is a true story.
- Mistakes were made.
- It could have happened to anyone: any inventor, any attorney, or any patent searcher.
- Or any service recipient or service provider.
- Lots of lessons were learned.

# The Invention: Trigger Clipper



- [Link](#)

- Two **arms**...
- A **spring** for storing energy, wherein the spring is energized by moving the two arms to the closed position...
- A **latch** for retaining the arms in the closed position and the cutting portions in the open position...
- A **trigger** mechanism for releasing the cutting portions...

# The Situation – 1

**Inventor:** Developed a trigger-activated animal nail clipper.

Found no prior art in USPTO PatFT search. Did not search in AppFT.

Engaged a patent attorney who hired search firm.

**Searcher:** PatBase search: 4 patents of no interest (2 on animal clippers, 1 each on hedge clippers or kitchen shears).

**Attorney:** Wrote search opinion, did not share search report.

Filed provisional patent application.

# The Situation – 2

Inventor: Developed prototype over 18 months.  
Found US2014250692A (Pressure activated clipper) via Espacenet.  
Abandoned provisional application.  
Received, reviewed search report.  
Engaged expert searcher for opinion.  
Anticipates arbitration.

# Lessons Learned – Searcher/Attorney

- Don't miss the obvious reference.
- Use the client's terminology.
- Understand the invention fully.
- Treat inventor with respect.
- Support the patenting process.
- Write a useful search report.
- Patentability search = invalidity search.
- Act with integrity, own up to mistakes.

# Don't Miss the Obvious Reference - 1

## On the basis of search strategy

US2014250692A found by:

- Espacenet: *trigger clipper* in TI or AB
- Google Patents: *animal nail trigger clipper*
- PatBase semantic search: *animal nail trigger clipper*

# Use the Client's Terminology

- Go for the jugular: use client's terms early.
- In this case, the searcher did not use ***trigger***.
- Searcher: PatBase answer set 36 (of 43):  
CPC=A45D29/02 and FT=((spring\* or bias\*)  
w40 (latch\* or lock\* or retain\* or retention\*)) (61  
records including '692)
- Alternative search terms, multiple databases,  
patent citation searching
  - Might overcome poor choice of search terms.
  - Could bury good results in large sets, late in the process.

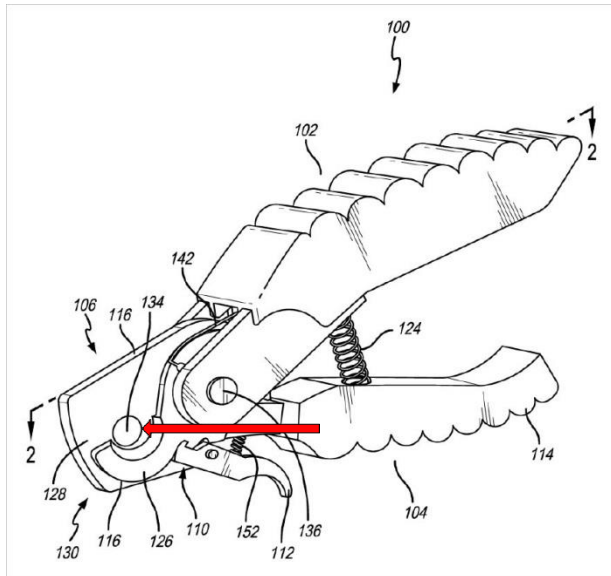


# Searcher's Key Answer Set

- Did the searcher review answer set 36?
  - No indication in search report.
  - Records of set 36 were removed (by NOT logic) from subsequent answer sets.
  - In subsequent communication, searcher was evasive about whether '692 was retrieved or reviewed and agreed it was better than reported patent art.
- If '692 was actually considered, was it correctly interpreted?

# Don't Miss the Obvious Reference - 2

## On the basis of Interpretation



From the provisional application

Insert claw

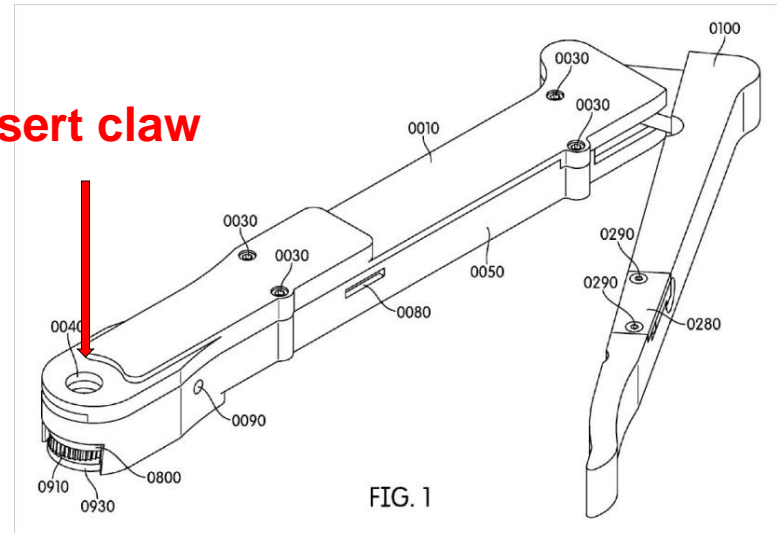


FIG. 1

US2014250692A

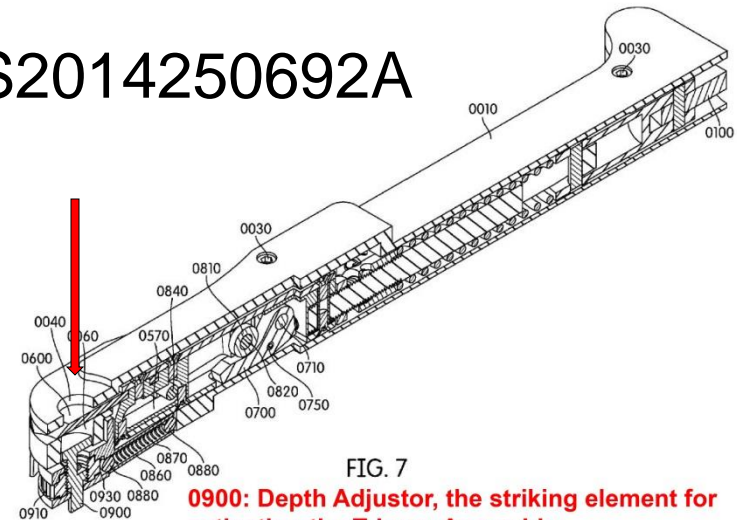


FIG. 7

0900: Depth Adjustor, the striking element for activating the Trigger Assembly

# Don't Miss the Obvious Reference - 3

## On the basis of '692 document language

1. An apparatus to prevent injury to user and subject when grooming **nails** or **claws** to an adjustable desired length, comprising: a **trigger** assembly having a **trigger** main body; a **trigger** ball bearing; a **trigger** ball bearing pin; a **trigger** ball bearing pin hole; a **trigger** pivot pin; a **trigger** pivot pin hole; a **trigger spring** hole; a **trigger spring**; a **trigger** bearing ball at each end of said **trigger spring**; a plurality of **trigger** bottom plate screw receptacles. ¶

10. An apparatus to prevent injury to user and subject when grooming **nails** or **claws** to an adjustable desired length, comprising: a **trigger** assembly; a **trigger** main body; a **trigger** ball bearing; a **trigger** ball bearing pin; a **trigger** ball bearing pin hole; a **trigger** pivot pin; a **trigger** pivot pin hole; a **trigger spring** hole; a **trigger spring**; a **trigger** bearing ball at each end of said **trigger spring**; a plurality of **trigger** bottom plate screw receptacles; a **clipper** body assembly; a **clipper** main body; a cover plate having a plurality of cover plate screw holes; a plurality of socket head screws received by said cover plate screw holes; a cover plate **nail** engagement receptacle connected to and located external to a **clipper** main body **nail** engagement receptacle; a connecting anchor connecting pin hole; a hook receptacle located in the **clipper** main body wall; a **clipper** main body **trigger** pivot pin hole for **trigger** articulation; a **clipper** handle assembly; a handle body; a handle connecting pin receptacle; a handle pivot pin receptacle; a handle connecting pin received by said handle connecting pivot pin receptacle; a handle pivot pin received by said handle pivot pin receptacle; a **clipper** handle **latch** assembly; a **spring** receptacle; a shaft receptacle; a hook cover plate screw receptacle; a shaft received by said shaft receptacle; a hook **spring** received by said

# Searcher and Attorney Responses

- Searcher: “No error was made.”
- Attorney: “The matter is closed.”
  - The search was directed to manual triggering to the exclusion of automatic triggering.
  - “Searches are of limited scope; a search that tracks down every lead would cost in the 6 figures.”
  - Invoked a “Notice Regarding Limitations” on patentability searches regularly sent to clients.

# Conclusion about '692

- It was not actually reviewed.
- Its omission was probably unintentional.

# Understand the Invention Fully

- Verify and re-verify the scope with the customer/inventor/attorney.
- Be sure you know why you are rejecting each reference and think twice about it.
- Inventor is the technical expert.
- Consultation: mutual learning opportunity.

# Searcher Has Supporting Role in the Patenting Process

- The searcher is not the attorney or agent.
- Be conservative – let the inventor or attorney be the final judge.
- Provide art useful for application drafting including counter-examples.
- Write a useful search report.
  - Explain what was done.
  - Rationale for strategy and interpretation.
  - Clarify which answer sets were reviewed.

# Patentability = Invalidity Search

- Support commercial opportunities

	Patentability	Invalidity
Timing	Early on	Later
Time period	All	Before priority date
Importance	High	Critical
Budget	Appropriate	High

- A patentability search is an early stage invalidity search. It is only useful if it is done well enough to be effective in warding off later efforts to invalidate an invention.



# How Comprehensive?

- Being less comprehensive is an option to be cleared with the client.
- In this case
  - Appropriate: the searcher did not expand coverage to general cutting tools.
  - Inappropriate: falsely claimed that broader coverage/budget would have been needed retrieve '692.

# Act with Integrity, Own Up to Mistakes

- Admit and apologize.
- Searcher offered no good rationalization.
  - Improper focus on manual triggers due to misinterpretation by the searcher, possibly with inadequate guidance by the attorney.
  - Additional searching would not helped.
- Attorney denied responsibility: hired searcher, did not review search report critically, shut down all future communication with the inventor.

# Be Well-informed and Proactive – Inventor/Attorney

- The first and least expensive step is a good patentability search.
  - Carry out preliminary search.
  - Hire a searcher, then share and question search strategy and report.
- No searches are guaranteed comprehensive.

# Getting Enforceable Patents is Hard – '692 offers its own case study

- Well engineered, ready to be manufactured.
- Abandoned after examiner search, first office action.
- 6 patent docs cited (not reported by searcher).
- 1<sup>st</sup> claim rejected based US4321764 (Hammer actuator in a gun).
- Granted patent still possible: the dependent claims, other independent claim were allowed.
- Why abandoned? Claims too narrow? Faulty prototype? Too expensive? Not profitable?

# Coulda, Shoulda, Woulda

- Client **coulda** been better prepared and proactive.
- Searcher and attorney **shoulda** done better on search and for client, **shoulda** had integrity, offered remediation or compensation.
- You **woulda** done better?

# Acknowledgment

Thank you to Matthew Michel for bringing me into his story and giving me permission to share his experience, the prototype photo and video, the provisional application diagram, and lessons that we learned.

# Bibliography

- Patentability Case Study: Mistakes Happen. *Online Searcher*, (November/December 2019)
- Enhanced Patent Search Systems Revolutionize Searching. *Online Searcher*, 43 (3) (May/June 2019): pp. 22-29
- Freedom-to-Operate Search Strategy: Hitting the Target. *Online Searcher*, 42 (4) (July/August 2018): pp. 31-42
- What's So Special about Patent Invalidity Searching? *ONLINE*, 36 (4) (July/August 2012): pp. 28-33
- Freedom-to-Operate Patent Searching: My Six Basic Rules. *Searcher. the Magazine for Database Professionals*, 16 (5) (May 2008): pp. 34-39

**Thank you!**

**Questions and Comments**