

PATENT SEARCHING



The advertisement features a background of various sized gears in shades of grey and blue. In the center, there is a smaller inset image showing a globe surrounded by several interlocking gears. Below this, a larger globe is shown with the text 'Bailey Walsh & Co. LLP' curved around it. At the bottom of the globe, the text 'Cost effective protection for your ideas™' is written. Below this, a horizontal line of small icons and text reads: 'PATENTS • TRADE MARKS • DESIGNS • COPYRIGHT'.

BAILEY WALSH & CO LLP, 5 YORK PLACE, LEEDS, LS1 2SD, UNITED KINGDOM

TEL: +44 (0)113 2433824

FAX: +44 (0)113 2445699

E-MAIL: mail@bailey-walsh.com



PATENT SEARCHING

In deciding to file a patent application or having made an application for a patent, you have taken the first step on a process which could be both expensive and long, and the process could be such that in the final analysis little or no benefit may result. On the other hand, making an application for a patent can be likened to a speculative investment in that if the patent application and the invention are successful, the financial rewards can be enormous.

The difficulty of the course of action on which you are about to embark or have embarked is that, generally speaking, for an invention to be patentable it must be both novel and involve an inventive step.

NOVELTY

For your invention to be novel it must relate to one or more features which have not been published prior to the earliest filing date of your patent application. Products, processes and/or the like which have been used or published prior to the earliest filing date of your application are often referred to as "prior art".

INVENTIVE STEP

Even if your invention is novel, the second hurdle to overcome is the question of whether or not your invention involves an inventive step. For example, patents are not awarded to inventions of which the one or more novel features comprise mere workshop modifications. As can be appreciated, there are always arguments for and against the question of inventive step and usually if an invention has particular advantages over the prior art, we can argue that the invention involves an inventive step.



REASONS TO SEARCH

The main expense involved in applying for a patent arises if protection is required for the invention in a number of countries in the world, as each country will have official fees and fees will be incurred by using a local advisor, which is compulsory in many countries. As the requirement to file in other countries does not arise until 12 months from the earliest application date, it is useful for applicants to endeavour to assess what is contained in the prior art before proceeding with the expensive stage of applying for foreign patents.

Furthermore, experience has shown us that many applicants are not particularly familiar with what other people have done in the field of the invention at the time of filing their application. As such, it is useful to know the state of the art as this enables the applicant to be in a better position to present and protect their invention.

A third reason for searching is that it will help identify any prior patents which cover your invention to such an extent that if you endeavour to manufacture, market and/or sell the invention in a particular country, you could find that such activity is prevented by the earlier patent.

Experience has also indicated to us that it is always advisable to consider searching the prior art before filing a patent application or soon after so that you do not become over committed in investment terms in the matter of promotion of the invention.

There is no single search available which meets the needs of each and every case and the type of search (or searches) which an applicant may perform is dependent to some extent upon the importance of the invention.

At one extreme, the applicant may decide not to perform any prior art search at all and simply proceed to market their invention accepting that they may possibly have to cease such marketing at some point in the future. At the other extreme, an applicant may intend to patent the invention Worldwide and to



spend substantial sums of money investing in plant and machinery in order to put the invention into effect and, in this event, the applicant almost certainly needs to conduct extensive searching.

Various types of search are available, and the type of search which an applicant might select to undertake depends upon a number of factors including the commercial position of the applicant, the nature of the invention, the nature of the investment required to put the invention into practice and/or the like. As this leaflet is general in its application, it is not possible to give costs based upon searches for individual inventions. However we would be pleased to assist you in assessing your invention and advising on the types of search available and the specific costs which would be involved in searching in relation to your invention.

We trust that this document will be of assistance to you and we look forward to hearing from you if you wish any searching to be conducted.

We recommend that at least some searching be undertaken before you embark on filing on completion of your patent application and before you make substantial investment in setting up to market your invention.

Please note that although searching is recommended it is to be pointed out that errors and omissions can occur and therefore no responsibility for accuracy and completeness of any search can be accepted.

MANUAL SEARCHES

Manual searching is typically conducted by a Patent Examiner who physically searches for and examines relevant patent documents. Manual patent searches include:



UNITED KINGDOM PATENT OFFICE SEARCH

This search is available before or after filing a patent application and covers UK patent documents dating from 1925 and European, US and International patent applications dating from 1970. The time required to complete a National Patent Office Search is approximately 20 working days.

Approximate cost for a search of average complexity:

Approx £1000

Additional cost is incurred if you require us to review the search report when issued.

COMPUTER SEARCH

A number of different types of computer search can be undertaken. These searches include:

1. Searching for a specific patent number or patent application number.
2. Searching for patents or applications for patents held in the name of a particular inventor, company name or third party name.
3. Searching for patents or applications for patents using:
 - a) One or more keyword terms pertinent to an invention; and/or
 - b) International Classification System.
4. Status searching of patents or applications for patents to determine whether a patent application is pending, lapsed or abandoned and/or whether a patent is in force.

These searches can be undertaken using our worldwide patent computer databases and can be undertaken within 1-5 working days.

The searches are available before or after filing a patent application and covers over 72 million patent documents from 52 countries some dating from 1942 (USA), 1969 (France), 1976 (Japan), 1981 (Germany), 1985 (China) and the majority dating from 1974.

Approximate cost for a search of average complexity:

Approx £500 -800

Additional cost is incurred if you require us to review the search report when issued.

Bailey Walsh & Co.

Cost effective protection for your ideas



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