



ALL ABOUT PATENT SEARCHING AND PATENTABILITY OPINIONS

If you not getting both your not getting the whole story.

• CALL US TO SCHEDULE A FREE INITIAL CONSULTATION at 303.768.0123

Questions:

- 1. Should we have a patent search performed before moving forward with a patent application?**
- 2. Why should we use you for our patent search instead of the many less expensive searches available on the internet?**
- 3. Is there anything I should do before hiring you to perform a patent search and patentability opinion?**
- 4. Are there any guarantees with your search and opinion?**
- 5. Do you do your own searching?**
- 6. What is the difference between a Patent Search and an Infringement Search?**
- 7. What other issues should I beware of concerning patent searches?**
- 8. How do I order a search and opinion?**

Answers:

- 1. Should we have a patent search performed before moving forward with a patent application?**

In our opinion for but a few exceptional circumstances, there is absolutely no good reason for an independent inventor not to have a patent search done. The reason is extremely simple: a quality patent search and accompanying patentability opinion could save you from spending \$5,000-15,000 of your hard earned



money on a patent application that will either never issue or if it does issue will be extremely narrow (and by that we mean it will have very limited value).

The statistics tell the story best. Of the inventions we have seen over the last few years, we are confident that we could get patent protection for 90-95% of them if they hired us to draft, file and procure a patent. However, just because we can procure a patent on an invention does not mean we should! You see, if we had moved forward with many of these inventions, the resulting patent would be so narrow in scope and protection as to make it effectively worthless. At Leyendecker & Lemire, we are not about just getting you a patent. Rather, we want to give you a quality patent. Accordingly, in our patentability opinions, we try our best to fully inform you of the scope of protection you can reasonably expect in a patent concerning your invention.

But we are getting ahead of ourselves; let's get back to the statistics. Of the searches we have performed for our clients over the last couple of years, only about 35% of the clients have move forward to the next stage; that is having us draft a patent. Why? After reviewing the prior art patent and other references identified in the patent search, reading our patentability report, and in many cases, talking with us about the results, the clients come to an informed and reasonable decision not to proceed.

2. Why should we use you for our patent search instead of the many less expensive searches available on the internet?

If you read between the lines of the previous paragraph, you will realize that we do not push patent applications or any of our other patent services. The truth of the matter is we have enough work so we don't have to pressure our clients to proceed with patent applications on inventions of having minimal protectability. There is another reason why we don't push patent applications: we have consciences and we like to sleep at night. We aren't comfortable with you giving us thousands of dollars to draft a patent application unless you are reasonably informed of the risks associated therewith.

This more than can be said for the so-called invention promotion companies. They will smile at you and gladly take your money knowing full well in most instances that their services are not worth nearly what



they are charging you and that the services will likely never help you make any money from your invention. If you want to more about these types of companies, peruse our blog. Again, we digress.

Getting back to topic, there are plenty of patent attorneys, as well, that will gladly take your money for inventions they believe or know might be difficult to strongly protect. We have had several clients indicate that an attorney they had visited prior to us had downplayed the need for a search. The only reason to downplay the need for a search is because the patent attorney wants the money for drafting a patent and the search will likely show the invention has already been patented. Realize that your patent attorney is required to act in your best interests: he or she is not supposed to withhold relevant information from you that might negatively impact his or her earning potential. It is no wonder attorneys, in general, have the reputation they have.

Perhaps even worse than the attorney (or patent agent) that suggests no search is necessary, is the attorney who recommends and performs a search but then doesn't provide you with much of an analysis. Unfortunately, there are far too many of these guys (and gals). After the search is complete, they merely present you with the patent references identified in the search with a one or two sentence conclusion that your invention is or is not patentable. The beauty of limiting the analysis is beneficial to the attorney because as we indicated above, most inventions have something about them that is potentially patentable. Incidentally, on occasion we have had clients bring in the results of such a search and ask us to analyze it for them. This often requires several hours of our time and in the end they have spent more than if they had just ordered the search and opinion from us in the first place.

For most inventions, our fee for a patent search and patentability opinion is \$795. For business method and computer-related inventions which require a more time to review the search results, the price is \$995. On very rare occasions, an invention will comprise many unique aspects and will require multiple searches or the search may need to be quoted on a custom basis. These prices are generally inline with what other attorneys charge and a bit more than a patent search alone without any analysis. Incidentally, these fees are often much less by a factor of two or three compared to what you should expect to pay a big national law firm.



Compared to lower cost providers, keep in mind that **our package includes not only the patent search but also a patentability opinion that tells you not only whether your invention is patentable but also gives you an idea of the level of protection you can reasonably expect to receive in a patent.**

Remember, that with this information, about 60-65% of our clients decide not to go forward with a patent application because the coverage offered by the patent would likely be very narrow. Further, with any of our search and opinions, the client is free to call us to discuss the results.

Now, we could offer less expensive searches with purposely skimpy opinions: they would take much less time for us to prepare, and more clients would go forward with the patent application thereby netting us more revenue. But as we indicated above, we would just not feel right about that. So while we may charge more than some charge for a patent search, we believe that our combined search and opinion offers great value for the client and would continue to offer great value even if we charged hundreds more.

3. Is there anything I should do before hiring you to perform a patent search and patentability opinion?

Yes, perform your own informal search. If you find something similar to your invention without requiring us to do the search, than you will have saved at least \$795. Incidentally, if you bring the closest prior art you can find to the free initial consultation, we will often take a quick look at it and tell you right there whether there is any value in proceeding.

Here are the steps you should take in conducting your own search (although not necessarily in order):

1. Research what is already available in the relevant marketplace related to your invention. This may mean checking related catalogs and industry trade magazines.
2. Go to your favorite search engine (Google, Yahoo or another) and type in as many keywords and keyword phrases that relate to your invention to see if anything like your invention is returned in the results.
3. Perform a search of the patent records. Two great sites for this are www.google.com/patents and www.uspto.gov, but there are others and a few our listed in our Patent Resources page. Both



allow for keyword searching although the Google site can search the patent records further back. The USPTO site, however, also allows for searching of published but non-issued patent applications. We suggest using Google Patents to search the patent records and then going to the USPTO site to search published applications. If you are really adventurous, you may want to search some foreign databases as well.

4. As you go, print out, copy or make note of anything that is close to your invention either in the way it work or the problem it solves.

If in the end you have not found anything like your invention, come see us with the most relevant information in tow. At this point, our professional search and opinion will be recommended. **Now, some clients have in the past inquired about whether our professional search and opinion is necessary after their searches. The fact of the matter is that our searcher almost always comes up with relevant prior art references that the client missed in his/her search.** So yes, you should have a professional search done no matter what. But if you disagree, we will still prepare your application after reviewing your search results as long as you realize the risks.

4. Are there any guarantees with your search and opinion?

Nothing in the inventing game is guaranteed. As discussed in our Virtual Patent Consultation, inventing is risky business. We do our very best, however, to provide you with a reasonably complete and accurate search and patentability opinion for a reasonable price but our searcher is human and on occasion, he may miss something relevant. Or a relevant piece of prior art may be misclassified and therefore not readily discoverable in a typical search. The results of our search and opinion are probably about 90% accurate in our estimate although we have never performed any statistic analysis.

More expensive searches can be performed to achieve greater degrees of confidence in the search results but as the confidence level is increased, the time and consequently the cost of the search also increases exponentially. In other words, the searcher has to turn over more figurative rocks with the chance that he will find something under those rocks decreasing with each rock turned. At some point, it does not



make sense to do a search as the price of the search approaches the cost of filing a patent application. We believe that our search represents an appropriate middle ground: the search is comprehensive enough to provide the client with a high degree of confidence in the result but it is not so pricey as to consider foregoing the search altogether.

There is at least one other area of risk that cannot be mitigated by us or any other law firm or search professional. Simply, we cannot search unpublished patent applications. These days most patent applications are published about 18 months after they are filed and in some cases when requested by the applicant, they are never published. So there is a risk, albeit generally small, that an application was filed within 18 months of a search being performed on your behalf. We may come back with a stellar patentability opinion only to find out a year or two down the line that your patent is rejected because of this previously unknowable prior art. Unfortunately, there is absolutely nothing we or anyone else can do about it. Fortunately, this situation is very rare and does not present itself often.

One final thing you must know about a patent search. The searcher primarily searches published patent applications and issued patents. He does not search extensively in the relevant marketplace to uncover prior art that may be on the market or was once on the market that could prevent you from getting a patent even though the relevant device or method was never patented itself. Accordingly, it behooves you to understand the marketplace to which your invention pertains.

5. Do you do your own searching?

No, we do not do the searching. We leave that up to a search professional. Patent Searching is his livelihood and he is very good at it. We have gone through other searchers in the past and he offers by far the best quality and value. Our searchers search includes U.S. and foreign patents and patent applications although the focus is rightly on the United States patent database. Further, our searcher typically consults with a United States Patent Examiner to determine the relative field of search for your invention (although he does not disclose the invention to the Patent Examiner). By the way, our searcher is under a blanket non-disclosure agreement with us to keep anything we send him completely confidential.



We could do the searching ourselves but our hourly rates do not permit us to do as through a search as our search professional can. What our search professional is not trained at doing is analyzing the prior art. Our attorneys review the material he identifies and draft a patentability opinion that give you an idea of what scope of patent protection you can reasonably expect for your invention as well as the chances of getting the patent application through the patent office to eventually issue as a patent.

6. What is the difference between a Patent Search and an Infringement Search?

Simply, an infringement search seeks to identify patents that have not expired that you would infringe if you make, use or sell your invention in the United States. In contrast, a patent search seeks to identify all patent references, in force, pending or expired, that would prevent you from receiving a patent on your invention.

Infringement searches will not identify all relevant patent prior art that could prevent you from getting a patent: they are only concerned with patents that are not expired. Further, infringement searches require that a searcher review of each identified patents' claims, which means, of course, additional cost.

When performing a patent search, the searcher is not concerned with whether the patent reference is expired or not. They are not concerned with the patent claims. Rather, they are only concerned with whether the material disclosed in the patent teaches or renders obvious the invention being searched. Accordingly, the search process is less expensive as is the process of preparing a patentability opinion. While a quality patent search and opinion can be had for \$795, infringement searches and opinions can run in the many thousands of dollars with about \$5000-8000 being typical for an average invention.

However, just because our patent search and opinion isn't intended to identify patents that your invention might infringe, we do not bury our heads in the sand if the search uncovers a patent that might be problematic. In fact, we make it a point to quickly review all unexpired patents to determine whether your invention might infringe the patents if made, used or sold. If there is a potential issue of infringement, we will let you know, so that you may consult with us in greater depth about your options. Truth be told,



situations where the patents identified in the search present a potential issue of infringement only occur in a small percentage of the search and opinions we perform.

7. What other issues should I beware of concerning patent searches?

Remember that the search and opinion we provide for you can only be as good as the information that you provide to us about your invention. Occasionally, a client does not inform us of a key aspect of an invention and the search is performed without this critical knowledge. As you can suspect, the quality of the final product is not as good as it could be. Accordingly, we want to provide us with as much information about your invention that you have. Let us decide whether or not it is relevant. One of the most important things you can provide is a sketch, photo, video or other rendering of your invention. A bad sketch is always better than no sketch at all. If we cannot figure out what you have drawn when taken in combination with your written disclosure, we will call or email you to clarify.

8. How do I order a search and opinion?

That's an easy question. Just call and make an appointment for a free half hour consultation OR click on the Free Patent Evaluation link, fill out the provided disclosure form and send us \$795 (or \$995 for business method and computer related) inventions. FYI, we do take most major credit cards to make it convenient for those of you who cannot make it into the office or don't have the cash handy.