

# PATENTABILITY SEARCH PROCEDURE

## A. SCOPING

1. Read the disclosure. Look up any terms you do not understand using [www.whatis.com](http://www.whatis.com), [www.dictionary.com](http://www.dictionary.com) or Google.
2. Determine the scope of the invention. To help you properly and thoroughly scope the invention, you may use the "Scoping Invention Features" table at the end.
3. Write down the features which describe the invention. Call the client to introduce yourself as the analyst for this search and also to discuss your subject features. When speaking with client, ask any questions or address any concerns that you have with your subject features.
4. Enter the features in your search report under "Subject Features". If you have limitations in the disclosure which are not going to be used in the search, list these after the line which follows this section. It is a good idea to print out your subject features so you have it to glance at as you search.
5. Do a pointed search to identify similar patent documents which you can mine for classifications and good search words. It is a good idea to read or scan a few of the best documents to improve your understanding of the invention.
6. Check the classifications against the PTO classification descriptions and identify those core subclasses which seem to cover your invention. Also identify peripheral classifications which may contain the subject matter.
7. Call an examiner in each of the core classifications and discuss the invention with him/her. Amend your classification list using the examiner's input.
8. Find the IPC-8 equivalent classes using the PTO classification page and check those classification definitions using ECLA or Paterra.
9. Go over the classifications with your trainer.

## B. SEARCHING

10. Search each core classification using Micropat. If there are too many hits, use a broad text search to narrow the results. For each search, check the patents that seem to be relevant. Click "Order/download" to obtain a list of the patents that you checked. At this point you can obtain images of the patents or can just cut and paste the list to a Word or Excel document for further review. Remember, European classifications must be searched with limited text strings. You may want to translate some search words to get better results.
11. Search the peripheral classifications in groups and limited by text strings.
12. Put your classification search results aside.
13. Conduct a text search, starting with a broad search string and narrowing to get reasonable result sets. Search from different viewpoints until you are sure you have determined all the relevant documents. Don't forget to combine your search strings to eliminate those you have already looked at.

14. Search European search engines using a limited text search.
15. Compile your results and identify the documents you wish to include in your report.
16. Forward and backward citation search your best references.

### **C. ANALYSIS**

17. Enter each document in the central or peripheral table, using the format provided. Check off the features that each document covers. Use item-to-item matching (for example, "an LED bulb (light array 46, fig. 1) is disclosed which") to point out the way in which you interpreted the features.

### **D. NON-PATENT LITERATURE SEARCHING**

18. Search the non-patent literature databases listed on your order. You should generally search at least two to three search strings for each one. For GoogleScholar, you may find that you need to have more than three to narrow the search significantly. You cannot download any article which costs money, but if you think it is important, cut and paste the abstract into your "Non-Patent literature" table.

19. Be sure to cut and paste the link from the search bar into your document. If you find that it runs off the page, hit "Enter" at the end of each line to make the search string into lines. Highlight the whole string, right click "Edit Hyperlink" and then click "OK". The lines will be converted into a hyperlink.

20. No feature analysis is done for NPL. You may add notes if you think they are needed, or you can boldface the key words, but it is not required.

21. When cutting and pasting the NPL information, use PASTE SPECIAL/UNFORMATTED to paste. Make sure the font is Arial 10. The title should be in italics and the rest in normal case. Follow the instructions in your search template as to which information to include. Usually you can just cut and paste the whole description.

22. Fill out the appropriate boxes in your search report for each search engine. For this patentability report, you will not have to worry about the date column, unless you limited your search by date.

### **E. FILLING OUT THE SEARCH FORM**

23. Fill out the classification table. Use the USPTO classification site for the US classes/subclasses. Use Paterra or ECLA for the European classes.

24. Fill out the examiner information at the end of the search form.

25. List the features in the "Subject Features" part of the form if you have not already done so.

26. Write up your summary. The summary should include a brief description of the invention and then list your results. I will give you an example and you can copy the format.

27. Make sure that the case number is on the report on the front page and in the index list. Make sure the date is at the end of the report. The date must be the last Tuesday that you searched.

28. Done with the search report!

## **F. MICROPAT WORKSHEET**

29. Make a Micropat worksheet for all of the documents you reported in the central and peripheral tables. You will have an instruction guide for this.

## **G. COMPLETION**

30. Fill out your "Post Search Questions" and save it to a file which includes the case number.  
Ex: Post Search Questions 60489

31. Amend the "Search Procedure Checklist" for the searching you did. Put the case number at top and bottom and change the dates. Don't forget your name!  
Print out and sign. Give to your search manager.

32. Send the search report, Micropat worksheet and Post Search Questions to your search manager. Make sure that each of these documents is identified by the case number. Ex: Search Report 60489 or Spreadsheet 60489.

33. Congratulations! You are done!

# Scoping Invention Features

<b>Problem to be solved by the invention</b>	In words	
	Search String	
<b>Structure of the invention</b>	In words	
	Search String	
<b>Function of the invention</b>	In words	
	Search String	

