

## **Searching Prior Art**

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When a client indicates an interest in applying for a utility patent, I will almost always recommend that the client pay to have a novelty or patentability search undertaken in connection with the invention. Note, that such a search is not a prerequisite to filing a regular patent application<sup>1</sup>, however, it can provide valuable cost-saving information as to whether the claimed invention is already patented. In such a case, the search results can be used to decide whether to apply for a patent. It can also indicate to the patent attorney and inventor where patent protection is available and how an invention can be modified to obtain patent protection. Knowing what is in the prior art is a great advantage when drafting a patent application.

Undertaking such a novelty or patentability search typically involves engaging a third-party search firm to research patent office files and publication databases and determine if there are any published patents, patent applications or literature that could impact obtaining a patent. The cost for such a search typically ranges in the area of \$1,500 to \$3,000 depending upon how extensive a search is requested. In order to commission a search that will yield pertinent results the patent attorney needs to understand the essence of the invention so that the search firm can narrow its search inquiry to relevant subject matter. For example, if the client's invention pertains to an improvement for a car engine muffler, researching engines or even exhaust systems in general will yield an over-abundance of search results.

Once the search results are obtained they should be reviewed by a patent attorney to determine their scope and effect on the subject invention. Typical attorney's fees for reviewing a standard patent search range from \$1,000 to \$1,500. Hence, a good rule of thumb is that a patent search along with attorney review of the results will cost at least \$3,000. For chemical and software based inventions the search costs can be significantly higher. Filing a patent application in the United States requires paying the PTO a fee of between \$500 and \$1,000. Initial attorney's fees for getting a United States patent application on file for an uncomplicated invention range between \$6,000 and \$10,000. The back and forth briefing with the patent office

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<sup>1</sup> Such a search is a requirement if one wants the PTO to undertake expedited examination of the patent application.

may run another \$1,000 to \$5,000 in attorney's fees for such an invention. Then, if you are lucky the patent office will issue you a patent and you get to spend another \$500 to \$1,000 as an "issue fee" to the patent office just so you can get your patent certificate. Accordingly, in view of these other expenses opting for a novelty or patentability search is often a good step toward avoiding or reducing significantly higher fees and costs in pursuing patenting in the patent office. For this reason, I typically always recommend my clients undertake a search prior to filing a utility patent application.

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