



## Best Practices for Conducting a Patent Invalidation Search

### Introduction:

Patent invalidation/validation searches are performed to assess the validity of a granted patent. In general, an invalidation search is sought by companies sued for infringing a granted patent claim(s), and a validation search is sought by an entity/individual before suing an infringer to assess the patent's validity. The procedure followed for performing both these searches is identical to a large extent. However, the terminology and preferences may vary depending whether the search is sought by a patent holder or an alleged infringer. Additionally, invalidation/validation searches may also be considered before seeking license for a patent, and in evaluating the strength and value of patent portfolio during mergers and acquisitions.

### Establishing priority date:

Before performing an invalidation search, one has to first establish the priority date of the claims in the patent which needs to be invalidated. In general, any disclosure that is available to the public before the date of filing of the patent to be invalidated is considered prior art. Also, even if a patent application is published after the filing date of the patent to be invalidated, but the published patent applications filing date is before the filing date of the patent in question, then the published patent application is considered to be a prior art.

That being said, there will be scenarios where the patent to be invalidated is a *continuation patent* or a *continuation-in-part patent* (referred to as *patent of addition* in some countries), which can claim priority from one or more patent applications. In such scenarios, it may be difficult to identify the exact priority date since the patent is claiming priority from multiple applications. A searcher has to analyze the claims of the patent to be invalidated to determine the



first patent application in the entire family, which discloses all the limitations in the claims (at least the independent claim) of the patent to be invalidated. In most of the cases, majority of the features may be disclosed in the previously filed patent applications, however there may be features which are disclosed only in the patent to be invalidated. In case such features/limitations are part of the claims of the patent in question, then it can be argued that the priority date for such claims should be the filing date of the patent to be invalidated.

In case a searcher faces any difficulty in identifying the priority date, it may be better to discuss the same with the attorney and the client. However, as a rule of thumb, it's always advisable to consider the filing date of the patent in performing an invalidated search, as an attorney can take the final decision and filter the references at a later stage, if required.

Additionally, in case a reference found to invalidate the patent is a PCT (Patent Cooperation Treaty) application or a national phase application claiming priority from different applications, a searcher should keep in mind that the effective date calculation for the reference may vary based on the jurisdiction of the patent to be invalidated. For example, in certain scenarios, as per US laws, a U.S. patent application publication of a National Stage application and a WIPO (World Intellectual Property Organization) publication of an international application are considered to be prior art as of the international filing date only if the international application was filed on or after November 29, 2000 designating the United States and was published in English.

#### Sources and strategies:

Once the priority date is established for the patent to be invalidated, the searchers next goal is to find references (non-patent literature or patent literature) which are available before the



established priority date and disclose the claimed limitations of the patent in question. Essentially, the main objective will be to find a single reference disclosing all the claimed limitations; however it may not always be possible.

A searcher in analyzing the claimed features must adopt broadest reasonable interpretation, and may also refer to the file history of the patent in order to identify the novel aspects of the claims. Such analysis may also provide an insight into keywords, key strings, and classification used by the examiner, references cited by examiner and applicant, arguments of both parties, and reasons for allowing claims, among others. Further, the searcher may have a clear idea about the aspects of the claims which are critical, and can layout strategies for finding references teaching such aspects. In some cases, analyzing the references cited by the examiner and there family members can be helpful, as it's always possible that the examiner may have missed out on few key excerpts which may help in invalidating the patent.

Paid patent databases usually enable identification of superior results as compared to free databases for various reasons such as, wide data coverage, abundant options to query the database, flexible search interface, and various additional features like similar patent search and citation analysis, among others. However, one may also consider free databases as they may also provide good results at times. Searchers should also focus on Non-Patent Literature (NPL) as not all examiners rely on them during prosecution. NPL includes any public document or disclosure other than patent literature. One common problem faced with NPL's is in determining the date they are made available to public, for example, disclosure on websites may sometime not include date on which it is made available. In such scenarios, searchers can utilize web archive resources like "waybackmachine.org" to check whether the disclosure is available before the established priority date.



Searcher should also keep in mind that every search is different and a single protocol for all searches does not exist. The keywords, key strings, classifications and search strategies used for a search should evolve with time based on the search results found.

To know more about general prior art search strategies [click here](#)

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