Section 3

"Additional Guidance for Potential Applicants"

Chapter 26

Patentability Analysis Timeline

What's that first step to investigating whether an idea is patentable?

Great question. Recall from Chapter 6 that a patentable design must be **novel**. Is it new? Before declaring a definitive answer to such a question, one should consult with a patent attorney right out of the gate. Keep in mind, however that any given patent attorney, even if they've got technology background, or a masters or doctoral background in the subject of your invention that does not necessarily mean that they know all the latest technologies that are being invented at all times.

Most likely, the patent attorney may have been in practice a number of years and could very possibly be a little out of touch with the most current or pending patent technologies for their (or their client's) particular field. Not to worry—that's typical. It is not the patent attorney's job (at that moment, anyway) to know whether their client's idea is completely novel. What the patent attorney DOES know, however, is how to conduct a very thorough search and present an expertly informed opinion on whether or not their

client's invention is novel. The attorney conducts this search using a specific patentability search methodology. Doing this search is nearly always a good idea. It provides the inventor, business owner or entrepreneur with a set of the closest prior art.

As defined in Chapter 5, prior art works are the similar publications, prior patents that have already been granted and the pending applications that have filed with the USPTO before the new art in question, the prospective invention. Based on specific search terms and query methods—a precise description of which are outside the scope of this book—the patent attorney is able to find out the claims within each of those prior art references to see whether the hopeful invention does, in fact, boast novel claims or whether those prior art claims would potentially prevent the new design from being granted a patent.

The most valuable part of a professionally done patentability search for the inventor is the resulting meticulous and comprehensive expert opinion.

First and foremost, this legal opinion includes whether or not the lawyer recommends to file. Secondly, if they do recommend to file, they can explain the scope of the potential claims that the inventor could make, should the Office call it to issue, based on limitations from prior art.

In the "Real World": Let's use another example of a new invention. It's a different type of skateboard. Just for fun, let's say it has three axles: a front, middle and a rear axle. It's made to undulate with the ground as it shakes—plus, it is fun to ride! Time for the creator to call a patent attorney.

The creator calls a patent attorney that deals with mechanical devices…but they've never heard of this. They really haven't worked on any skateboard type devices before, which I'd say one would expect to hear from most patent attorneys. However, based simply on common knowledge, the attorney will most likely say that the new skateboard seems like a fair idea. They'd like to help with the patent search. The inventor gives them the go ahead and signs on, officially hiring the attorney. The patent attorney does the search…and, lo and behold, there are four different prior art references.

What next?

The attorney must then review these references.

He begins by examining the first three that might be already granted patents.

Two of the three prior art references are from the US and one is from Canada. The two from the US are both similar to the triple

axel board, although there are marked differences. The first, say from Orange County, CA only has two axles. However, they both have the same type of flexible board that moves with the ground. The board from Orange County uses the same type of rubber and accordion-like structure that the client described in his drawings, but it is still missing that third axle.

The second prior art reference comes out of San Antonio. It uses the same type of motion as the client's: the claims discuss it. It too, has three axles—but the top is rigid. Moreover, the third axle is not even a real full axle. The third axle in the middle does not touch the ground in normal operation. Instead the wheels on the middle axel are engaged only when performing tricks, like grinding on an edge or half-pipe.

The third example, the board from Canada has four axles, two on the front and two on the rear. The pairs of axels are very close to one another, so there's really no middle axle. Like the example from Texas, it too is made with a rigid top—unlike the client's board which uses flexible rubberized arching.

The last prior is a design application for different ways that the boards could look. One of the drawings is of the top view of a skateboard with a rubberized board feature. It looks to be flexible without the view of the bottom.

After making these comparisons, what might the attorney tell his client?

Truthfully, anything is possible as far as what the attorney could surmise. My goal in this chapter is to give the reader the most detailed possible scenario as a point of reference.

From my experience, with regard to the first two US examples, the attorney would likely conclude that some potentially limiting claims exist. The Californian example, i.e. the one that had the rubberized skateboard top, even though it doesn't have the third axle, seems to work on the same mechanical concepts that use the ground for motion and provide a shock absorption vehicle. The attorney should warn his client that the claims regarding the motion feature of the board may not be able to be patented.

If I were the attorney, I would tell my client to focus his patent goals on the third, center axel. It would also be wise to advise the client to recognize the other areas in which he or she might need to become more flexible, in terms of trying to stake a legal claim.

Then, I would run a search and analysis for each of the priors in order to judge what its effect on the inventors proposed application would be. This will help both attorney and client gain insight as to how broad the rights may be once the application gets to the patent office.

As I always say, it is extremely valuable to do ANY type of patent search.