



Case Study : Patent Invalidation Search Report

Recently we were hired by a large patent syndicate company to provide an invalidation search report for an asset. The requirement was urgent and we successfully completed the search report within one week.

This study is similar to a patentability search and encompasses valid and expired patents and applications and any published literature that make obvious the invention.

According to the US patent laws an issued patent can be invalidated as non-novel or anticipated if all elements of a claim are represented within the four walls of a prior document.

Under 35 US Code section 102(e) states that U.S. patents filed before the date of invention can be prior art. A requirement is that the U.S. patent in question is published, either as a granted patent or as a patent application. If this is the case, and the filing date is sufficiently early, the earlier patent or application counts as prior art and can be used to attack both novelty and obviousness of the later application.

Wikipedia (http://en.wikipedia.org/wiki/All_elements_test) defines anticipation as the following –

Under the all-elements rule, the claim is anticipated only if a single reference discloses each and every claimed element (or an equivalent of it). Under the more precise all-limitations rule now preferred in the United States Court of Appeals for the Federal Circuit, the claim is anticipated only if a single reference discloses each and every claimed limitation (or an equivalent of it).

A patent can be invalidated also under invention obviousness (<http://www.iusmentis.com/patents/obviousness/>). If a prior art document does not describe all the features of a claim, that claim is said to be novel compared to the document. The document can still be useful as prior art, but only to prove that the claimed invention is obvious. Usually, to establish that an invention is obvious, more than one prior art document is necessary.

For the study under consideration, we successfully searched for and identified two documents – a prior application and a prior printed literature as documents invalidating the patent. Pursuant to the search, we developed invalidation claim charts that clearly depicted that each and every element of an independent claim were described in the identified documents, thereby potentially invalidating the patent under the anticipation rule.

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