Basics of

Patent Search

Edition 1.0
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Section 1: Patent and novelty

Patent is a set of exclusive rights granted by the government to a patent holder (or “patentee”) for a limited period of time in exchange for a public disclosure of the invention. Patent rights are territorial i.e. the patent granted in one country is valid only in that particular country. To have patent protection in other countries, a separate patent application has to be filed in other countries as well.

Life of a patent is 20 years from the date of filing.

The aim of the patent system is to:

- Encourage industrial development
- Encourage complete disclosure of invention
- Prevent duplication of research
- Focus on commercial relevance of the invention
- Prevent exploitation of researchers by giving them recognition as inventor and providing them royalty upon commercialization
- Generate revenue on commercialization of the invention
- Provide a source of technical information
- Protect the invention from copying by others without consent of patent owner

A. What is an invention?

“An invention is a novel device, method, composition or process involving an inventive step and capable of industrial application or utility”

This means that in order for an invention to be patentable, the invention has to fulfil the following three conditions:

- Novelty
- Inventive step/non obviousness
- Industrial application or Utility
a) Novelty

A patent cannot claim anything (a technical solution) that already exists in the form of a patent or a paper publication, available in the public domain or is already in use. Novelty of an invention is a very critical aspect of the patent system. An invention is considered novel if it does not form a part of the general state of the art which is the highest level of development, as of a device, or a process or a technique in the scientific/technical field, achieved at a particular time.

Novelty is assessed in a global context. An invention ceases to be novel if it has been disclosed in the public through any type of publication, anywhere in the world before filing a patent application with respect to the invention. Please refer to the laws of individual countries for further details on how long an invention can be treated as novel. This particular period of novelty differs from jurisdiction to jurisdiction.

Information appearing in magazines, brochures at technical exhibitions, technical journals, books, newspapers etc. also spoils the novelty and constitutes anticipation. Oral description of the invention in a seminar/conference also accounts for loss of novelty requirement under patent law. However, there are certain exceptions wherein prior disclosure, publication or use of the invention does not amount to lack of novelty.

Prior use of the invention before the filing date can also destroy the novelty. Novelty is determined through extensive literature and patent searches. It should be realized that patent search is essential and critical for ascertaining novelty as patent documents are a source of tremendous knowledge that does not get published anywhere else other than as patent documents.

An invention is not considered to be novel, if it has been:
a. Anticipated by publication before the date of filing of the application in any of the specifications filed or

Anticipated by publication which are published on or after the date of filing of the applicant’s complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date

In order to determine novelty of an invention, a standard method is to perform prior art search which is often conducted by Patent Attorneys, Patent Agents or Patent searchers. It is also conducted by Patent Examiners of Patent Office during the process of examination of patent application. The patent search may include searching through patent databases, patent applications and other documents such as utility models and scientific literature.

To determine whether a document is prior art or not, the filing date of the patent application or patent in question is crucial. If the publication (which is being considered as prior art) was made before the day of filing of the patent or before the disclosure of a new invention, it counts as prior art. It doesn’t matter how long before the day of filing the publication (prior art) was made. It is important, however, that the publication date (of prior art) can be established with sufficient accuracy.

For example, if a patent application is filed on March 1st, 2000, a book published in 1999 counts as prior art. Its second edition from 2001 does not constitute as prior art because patent was filed before publication of the same. An issue of a journal from "March 2000" may or may not be prior art, depending on the publication date of the journal.

When an inventor files a patent application for an invention, other patent applications for the same invention may have been filed earlier but not published. If the patent application was filed before the inventor files his application or published before the inventor’s patent application but not yet granted, count as prior art in the normal sense, else this would lead to the situation that two people would obtain a patent on the same invention, which is undesirable. For this reason, many countries have special provisions for earlier filed patent applications that were not published before the day of filing of the later application. Such patent applications are sometimes referred to as "prior rights".

A prior art will be considered as anticipatory if all the essential features of the invention under examination are present in the cited prior art document.

b) Inventiveness or non-obviousness or Inventive Step

Inventive step (non-obviousness) means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and
that makes the invention non-obvious to a person skilled in the art. The invention should take technology one-step ahead and should not be replication or repetition of some previous inventions. Or we can say that invention must be non-obvious to a person skilled in the art.

The term "obvious" means that the invention does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. For this purpose, a person skilled in the art is presumed to be an ordinary practitioner aware of what was general common knowledge in the relevant art at the relevant date. In some cases, the person skilled in the art may be thought of as a group or team of persons rather than as a single person.

The question of inventive step arises only if there is novelty in the invention. If the invention makes available to the person skilled in the art something that he would not reach by normal exercise of his skill, then the inventor has made a contribution to the art which justifies the grant of a patent. This does not mean that an invention has to be technically complex. This can be very simple too.

One of the examples for a simple invention is Gem Clip

Invention: paper clip in 1899
Definition: paper clip, gem clip, paperclip
Function: A paper clip is a device which holds several sheets of paper together by means of pressure: it leaves the paper intact and can be easily removed.
Patent: 636,272 (US) issued on November 7, 1899
Inventor: William D. Middlebrook

Here are some examples to illustrate the points mentioned above:

The Supreme Court laid down the following criteria for assessing inventive step in M/s. Bishwanath Prasad Radhey Shyam Appellant v. M/s. Hindustan Metal Industries, “It is important that in order to be patentable, an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an ‘inventive step’. To be patentable, the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old known integers may be so combined that by their working interrelation they produce a new process or
improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent.”

c) Industrial use or Utility

The main aim of patent law is to boost industrial growth in the country and therefore, it is essential for the invention to have industrial use. Invention is said to be capable of industrial application, if it is capable of being made or used in an industry. For example, a drug is capable of being made in the industry and a machine is capable of being used in the industry. An invention must possess utility for the grant of patent. No valid patent can be granted for an invention devoid of utility.
Section 2: What is Prior Art Search?

The word prior-art in patent law means any information which has been made available in the public domain and that relates to the knowledge existing prior to the date of invention. This knowledge may be in any form such as patent, scientific literature, publications (such as journal articles, proceedings of conferences, data books and display information from technical exhibitions), public discussions or news from anywhere in the world. The prior-art search is performed by a patent attorney or a patent agent or a patent searcher and it is conducted in various patent and non-patent databases and other relevant technological websites to identify the prior-arts.

A. Objectives of Prior Art Search

Prior art search is performed at various levels and the purpose of doing it may vary depending upon the requirements. The main reasons for which prior art search is done are:

Before filing patent

Inventor may wish to perform prior art search for his invention before filing a patent to make sure that on the day of filing patent application, his invention is novel and there is no existing patent or publication of the invention before his date of filing.

During examination of patent application

After the patent application has been filed, it is examined by the examiners at Patent Office. The examiner performs prior art search before a patent is granted to make sure that it is not granted to an invention which is not novel. Therefore, a thorough novelty and patentability search is performed. If the invention is found to be novel on the date of filing patent, a patent may be granted, provided the invention fulfils other criteria of patentability such as inventive step and industrial use.

During opposition or revocation

If anyone wants to oppose or revoke the patent application or a granted patent on the ground of “Lack of novelty”, a novelty search is performed. If any publication or the patent is found to exist before the date of filing a patent, such patent may be opposed before or after grant.

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1 Check Section 13 of the Act
2 Check Section 25 and 64 of the Act
Therefore, novelty search is important to oppose the patent application or revoke or invalidate a granted patent.

**Before planning R & D**

Due to heavy competition, today companies spend lots of time and resources for Research and Development. Novelty search is done by researchers in a particular area of technology to assess the work already done and based on the existing knowledge they can plan R & D in a better and effective manner. Thorough prior art search prevents reinventing the wheel. Prior art search gives fair idea on the research already done in a particular area of technology and the inventor can work further on it, instead of working again on the same area. Prior art search also provides ideas to refine and improve the invention by identifying whether the invention has significant improvement over existing inventions. It also point out the boundary of the invention which will protect an inventor from infringing or copying other patented inventions.

**Before product launch**

The companies may perform prior art searches before launching product in specific markets to make sure that they are not infringing the rights of any third parties that may be having a patent likely to be infringed by product launch. Hence, prior art search helps to reduce the risk of infringing the patent rights of the third parties. This search is called “freedom to operate search”
Section 3: Types of prior art Searches

There are different types of prior art searches for different purposes, done at different stages. Generally prior art search can be classified into five main categories namely:

a) Patentability or Novelty search (PAS)
b) Freedom To Operate (FTO) or Clearance Search or Right to Use Search
c) Validity or Invalidity or Enforcement Readiness Search
d) State of the Art Search
e) Technology Landscape Analysis

A. Patentability search (PAS)

Patentability search, also known as “Novelty search” is probably the most common type of patent search. The search attempts to determine whether a specific invention is within the scope of the patentable subject matter i.e., useful, novel and non-obvious. While patentability search can be performed much earlier during the development of an invention, it is more commonly performed prior to submitting a patent application. The purpose of this type of search is to determine whether there are any previous patents (prior art) that might prevent the inventor from patenting his or her idea. Another benefit is that the inventor can be spared the expense of filing a patent application, since the filing fee is not refunded, if the application is rejected. A search may also turn up prior art that might be useful in preparing the application.

PAS usually does not have any time limitation; the period varies from yesterday to years back till one can find prior art, because any existing knowledge is considered as prior art irrespective of the date of publication or disclosure. Abandoned or expired patents also form part of prior art.

Please note that patentability search includes searching in non-patent literature also, for any information available in public domain.

To learn more about Patentability search (including the process flow for the search and a demo) join Origiin IP Academy courses by clicking here
B. Freedom to operate (FTO)

FTO search is also known as “Clearance search” or “Right to use searches”. This search is conducted prior to launching a new product. For example, if a company plans to launch a new product in UK region, there may be relevant patent which the company is likely to infringe by commercialising the product (may or may not be patented). If the company launches the product without FTO, it may infringe the patent of third party, the consequences of the same may be fatal leading to court litigation and subsequent loss of finances and reputation. FTO is done under such circumstance to check patents that are in force in a country to ensure that the company is not infringing any patent(s) of third party.

In September 2003, three pharmaceutical companies, Cambridge Antibody Technology, Micromet AG, and Enzon Pharmaceuticals, announced that they had signed a non-exclusive cross-license agreement. In the agreement, all three parties obtained substantial “freedom to operate” under some of each other’s intellectual property, to conduct research and develop a defined number of therapeutic and diagnostic antibody-based products.2

Agreements of this kind have become common practice in certain sectors, as companies seek to ensure that their products, processes and services do not infringe on patent rights of others. Patent litigation can be an expensive, uncertain and risky affair, and, as the saying goes, prevention is always better than cure. (Source: New Product Launch: Evaluating Your Freedom to Operate, Esteban Burrone, Consultant, SMEs Division, WIPO)

To learn more about FTO search (including the process flow for the search and a demo) join Origiin IP Academy courses by clicking here.

C. Invalidity/Validity Search

Patent Validity search or Patent Invalidity Search is a comprehensive prior-art search performed after a patent is issued. The purpose of validity/invalidity search is to determine whether a patent issued on an invention is valid or not in view of prior art that was already published as of the priority/filing date of the patent application. The main reason behind the search is to either validate or invalidate one or more claims of a patent. In other words, when a search is conducted to validate the claims of a given patent, it is called Patent Validity Search and when it is done to invalidate the claims of a given patent then it is called Patent Invalidity Search. Both searches are identical except for the desired outcome. This search
also includes the non-patent literature. Patent invalidity/validity search is mainly conducted during infringement litigation or in order to overcome the possible risk of infringement.

For example, Company A has a product which infringes patent of company B. Company B sued Company A for infringement. Hence, Company A conducted invalidity search to invalidate the Company B’s patent. In another case, an applicant or patentee who has the concern that their patent may infringe another patent shall conduct a validity/invalidity search to validate their patent or invalidate the concerned patent.

Another example where Validity Search proves useful is during licensing negotiations. In order to assess the value of a patent, an interested party may want to conduct a validity search to determine the strength of a patent. Upon receiving results, minimum royalty payments can be adjusted according to the findings before entering into a license agreement.

To learn more about Validity/Invalidity search (including the process flow for the search with an example) join Origiin IP Academy courses by clicking here.

D. State of the Art search

The State of the Art patent search is the broadest and most general of all types of patent searches. It is essentially a market survey that ideally finds out what technology already exists. State of the Art search results are valuable in many situations. To a client who is contemplating entry into a particular field of art, the State of the Art search results can provide concrete evidence of the advisability of such a decision. To a client who is currently active in a particular field of art, the State of the Art search results can lay out the path that must be followed to design around the current art.

In most cases, a thorough State of the Art search can save a great deal of time and money. Knowing what work has previously been done, what problems have been discovered and how they have been solved, who is active in the field of art and the chronological development of their work can prevent wasteful excursions into blind alleys and unnecessary expenditures of capital. This search also helps in identifying the competitors and also shows the trend of technology in a specific area identified. The search is performed to gather and categorize the patents in the specific area.
E. Technology landscape

Technology landscape is a continuation search of State of the Art which required further deep analysis to understand the technology evolution, major players, current and upcoming competitors and changes in the timeline trend. The main purpose of technology landscape is to identify the white space or gap in the technology. This type of search provides a comprehensive scope to plan the future R & D, leading to innovative projects to bring out new products/process in an industry. The main purpose of technology landscapes study is to understand the technology trend, strength of competitors, to learn latest technology advancement and analyze the patent activity related to technology of interest. Based on technology landscape analysis, appropriate IP strategy, complaint with business strategy is devised for the companies because a good IP strategy is a critical part of business plan and growth at any stage.

Technology landscape is not limited to patent activities, but also includes non-patent literature and other market information. There is no time limitation on this type of search as it is technology specific.

Learn more about Patent/Technology landscape search join Origiin IP Academy courses by clicking here.
Section 4: Patents and Patent search

Patent databases are the collection of patents/applications usually maintained by national patent offices, for example, USPTO (United States Patent and Trademark Office), IPO (Indian Patent Office), JPO (Japanese Patent Office) etc. Such databases are usually available free of cost, however, there are a number of paid databases also such as Delphion, Micropat etc., which have collection of patents and applications from several countries and have advanced search options.

A. Types of Patent databases:

The patent databases can be classified mainly into three types:

a) Government based patent databases
b) Free patent databases
c) Paid patent databases

a) Government based patent databases

Government based patent databases are the databases which belongs to the Intellectual Property Office of respective country. Such databases are primary source of patent related information and contain patents/applications which have been published or granted by Intellectual Property Office of the respective country. For example, USPTO covers the patents/applications published by US patent office.

Indian Patent Office is in a process of creating online database containing granted patents\(^3\) and patent applications published upon expiry of 18 months\(^4\).

b) Free patent databases

There are several free patent databases available to search the patent/applications.

c) Paid patent databases

The paid databases have information on patents/application from various countries and such databases are usually accompanied by additional features to facilitate a better patent search.

\(^3\) http://www.pindia.nic.in/ipirs1/patentsearch.htm

\(^4\) http://www.pindia.nic.in/ipirs1/patentsearch.htm
B. Before performing prior art search

a) Parts of a Patent

i) Patent

Patent is a legal document pertaining to an invention and is granted by the government. It grants exclusive rights to prevent others from making, using, selling, offering for sale, or importing the invention, without permission of the patent holder. A patent is granted either for a product or process which is novel, has inventive step and industrial application. The term of a patent is 20 years from the date on which the patent application was filed at respective patent office.

A patent document has three main sections:

- Cover page which presents bibliographic information,
- Specification, which describes the invention, and
- One or more claims that define the scope of protection given to the owner of the patent.

ii) Patent Number

The patent number is the number assigned to a GRANTED patent. The patent number appears on every page of the granted patent. Patent numbering formats vary depending upon the country granting the patent.

<table>
<thead>
<tr>
<th>Countries</th>
<th>Patent Number Format</th>
</tr>
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</table>
| United States (U.S.), EPO (EP), Canada (CA), Australia (AU), Germany (DE) | Patent Number Formatting: CCXXXXXXXXXX  
  - CC = ISO country code  
  - XXXXXXXX = 1-8-digit number, without spaces or punctuation |
| Brazil (BR), Korea (KR), The Netherlands (NL), South Africa (ZA), WIPO (WO) | Patent Number Formatting: CCYYYYYYYYY  
  - CC = 2-letter ISO country code  
  - YYYY = 4-digit publication year  
  - XXXXXX = 6-digit number (exactly 6), without spaces or punctuation (add leading zeroes, if needed, to make a total of 6 digits) |
iii) Patent Fields

A patent document contains several sections which include an abstract, summary, detailed description, figures, claims and bibliographic data. The detailed main body of the patent is called as patent specification. It describes the invention as to how to make and use it. Specification is used in conjunction with the patent drawings to aid in

iv) Patent Cover Page

The cover page mainly contains bibliographic information related to a patent/application. None of this information, including the abstract, has any legal importance for interpreting the patent document. The data provides notice mainly of historical facts and identifying elements, such as application filing date and serial number.

Patent cover page contains the abstract and bibliographic data that includes the patent number, title, assignee, priority date, grant date, inventor name, classification codes, reference cited and reference citing.

A cover page is shown in Figure 1 below:
Abstract: Abstract contains a concise summary of the matter contained in the specification. It indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention. Abstract may contain the chemical formula, which characterises the invention. The abstract may not contain more than one hundred and fifty words. If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings which may accompany the abstract when published. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing. The abstract constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

Assignee: The person or entity to which the inventor assigns the patent rights is called as Assignee. If a patent document shows no assignee, this means the ownership of the patent was retained by the inventor. Ownership rights can also be assigned after a patent is issued. If this is the case, the assignee may not be present in the patent document but will be recorded in the Patent Office prosecution history file.

Citations: A list of prior art cited by the Patent Office during patent examination. This includes earlier patent and publications disclosing inventions similar to the one claimed.

Classification code: Patent classification codes are used to organize and index the technical content of patent specifications so that specifications on a specific topic or in a given area of technology can be identified easily and accurately.

Date of grant: The date when the patent office issues a patent to the applicant.

Filing date: The filing date is the date when a patent application is first filed at a patent office.

Foreign references: A field that contains the list of foreign patents and foreign applications cited as references by the subject patent

Inventor: Person who contributes to the concept of an invention and is true and first inventor of the invention.

Patent number: Unique number assigned to a patent application when it is issued as a patent
Priority Date: The date which, for patent law purposes, is assumed to be the date of invention. This is often the same as the application date, but often may be up to one year earlier due to foreign patent applications which may serve as proof of date of invention.

Title: Title of the patent

b) Specification - description of the invention

The specification is also called the disclosure. It contains a description of the invention that must satisfy certain writing requirements. The layout of a specification varies from country to country depending upon national laws. It is relatively consistent between the US and Europe, except that few are unique to U.S..

c) Claims

The claims must "particularly point out and distinctly claim the subject matter which the applicant regards as his invention." The reason for this is that possible infringers must be able to understand what is protected and what is not. There must be at least one claim in a patent.

- An independent claim: This is a claim that stands by itself and must be so read in terms of infringement and validity evaluations. This is contrasted with a dependent claim. It includes all the necessary limitations and does not depend on or include limitations from any other claim. The first claim in a patent is usually an independent claim, however, one patent may have more than one independent claims.

- A dependent claim: Refers back to and further limits another claim or claims. Moreover, a dependent claim includes all the limitations of the claim incorporated by reference.

C. Use of patent fields in prior art search

For all patent databases, the fields of a patent document can be searched separately or in combination. For example, one may look for one of the keywords in the title, while searching for a more narrow word in the description or search a certain keyword in just one patent classification.

Patent search by field helps to perform quick search. In other words, patent search by field helps to narrow down the patents in the relevant technology.
Section 5: Case History

A) Patentability of an invention (falls within PAS search)

There was a scientist who invented an inoculum containing multiple strains of nitrogen-fixing bacteria. This type of microorganism metabolizes hydrocarbons and that was why this was created. Biochemical pathways responsible for this type of metabolism did not exist naturally. The invention was based on artificially introducing the pathways for this type of metabolism to the bacteria. The invented bacterium was to be used for consuming petroleum spills. Multiple components of crude oil can be broken down by the bacterium and that is why the bacterium was created. This property was not possessed by any known naturally occurring bacteria. When the inventor tried to patent the bacteria, his application was rejected by the patent examiner.

Did the examiner take the correct decision in this case; is the newly invented bacterium patentable? Learn in our PAS course. Click here to know more.

B) FTO: POLAROID CORPORATION vs EASTMAN KODAK COMPANY

Background

On April 26, 1976, Polaroid Corporation ("Polaroid") filed its complaint charging that Eastman Kodak Company ("Kodak") had infringed twelve Polaroid patents relating to integral instant cameras and film. On September 13, 1985, Judge Zobel, in a comprehensive and carefully detailed Memorandum of Decision, found Kodak had infringed twenty claims of seven valid Polaroid patents. Two patents were found invalid. One was found not infringed. One was found invalid before trial and Polaroid withdrew its claims on another patent before trial.

Judge Zobel did not assign to any single patent credit for the success of integral instant cameras and film, but found that integral instant photography, as commercialized by Polaroid and Kodak, relied on the inventions of the seven patents held valid and infringed. Judgment was entered on October 11, 1985, and, on January 8, 1986, Kodak was enjoined from further infringement of the five patents which had not yet expired.

Issues
1. Whether Kodak's infringement of any one or more of the patents in suit was willful and deliberate.

2. The amount of damages adequate to compensate Polaroid for Kodak's infringement, together with interest, and whether such damages should be increased up to three times the amount found.

3. Whether costs shall be taxed against either party.

4. Whether Polaroid is entitled to its reasonable attorneys' fees.

**Willfulness**

This section addresses the question of whether Kodak willfully infringed the seven patents at issue, thus permitting "increased damages up to three times the amount found or assessed" above, pursuant to 35 U.S.C. 284. The answer requires a patent-by-patent analysis in light of the applicable legal standards.

**Legal Principles**

1. One important factor courts consider is whether the infringer timely obtained, and took into account, the opinion of qualified patent counsel before taking the actions eventually found infringing.

2. Simply obtaining an opinion of counsel, however, will not insulate the infringer.

3. In order to recover damages, the patentee must prove wilful infringement by clear and convincing evidence.

4. Wilfulness is evidence that the infringer deliberately disregarded the patent or disregarded the patent laws.

According to Polaroid, no skilled attorney would have advised Kodak that the patents in suit were invalid or not infringed by Kodak's instant film and cameras.

In its turn, Kodak states that, as it developed its integral instant photography system, it repeatedly obtained validity and infringement opinions from Francis T. Carr, a leading national expert in patent clearance.
Polaroid asks the Court to believe that Kodak somehow either manipulated Mr. Carr, or the information Carr received, in order to reach a result desired by Kodak, namely, various opinions of counsel that ratified and masked Kodak's willful infringement of Polaroid's patents. Polaroid has failed to produce a single shred of evidence that supports this claim, as the following review of the record demonstrates.

Findings of fact

Mr. Carr reviewed over 250 Polaroid and non-Polaroid patents (containing literally hundreds of claims) and rendered countless oral and 67 written opinions on the entire range of products Kodak developed as part of its instant photography program.

(a) The ‘821 Patent: Polymeric Acid Layer

Mr. Carr compared ‘821 to the prior art, reviewed the file wrapper and prosecution history and gave his considered advice well before Kodak began manufacturing the film unit.

Mr. Carr advised Kodak that its product did not infringe ‘821 and further advised that ‘821 was obvious in view of prior art.

Judge Zobel determined that ‘821 was valid and infringed by Kodak's PR-10 film unit, rejected obviousness based on prior art.

Polaroid could uncover no irregularities in Kodak's actions in obtaining Mr. Carr's opinion on ‘821, or in Mr. Carr's actions in formulating the advice he gave Kodak. That advice simply turned out to be wrong.

(b) The ‘789 Patent: Dye Developers

Mr. Carr gave an opinion that Kodak's dye releasing chemistry did not infringe ‘789 patent and if at all it is found to infringe ‘789, Mr. Carr believed that a prior Canadian patent also infringed and would, therefore, constitute anticipation of and invalidate ‘789.

Judge Zobel concluded, however, that Kodak's chemistry and the ‘789 chemistry were functionally identical and that ‘789 was valid in view of prior art.

Mr. Carr's opinion turned out to be mistaken; Polaroid has shown no reason why Kodak should have considered the opinion unreasonable or unreliable in these circumstances.

(c) The ‘165 - ‘262 Patents: Opacification/Format
The patent examiner initially rejected '165 for obviousness based on the prior art. Polaroid then amended the application and the patent issued. In reviewing the prior art and the ‘165 - '262 patents, Mr. Carr agreed with the patent examiner’s original assessment. Polaroid has not in any way shown that Mr. Carr’s opinion was unreasonable or unreliable.

Polaroid’s arguments fail on all counts. Mr. Carr initially did not know of the Cole’s application (from Kodak) because his duties involved patent clearance, not patent prosecution. When Mr. Carr did learn of Cole’s application, he advised Kodak to abandon it both because it suffered from the same infirmities as ‘165 and because it forced Kodak into the inconsistent position of seeking a patent on the same invention Mr. Carr advised them was unpatentable. Kodak was reluctant to abandon the Cole application but, based on Mr. Carr’s advice and after receiving a report from a separate task force which investigated the matter, eventually did so. If there can be found any attempt to manipulate Mr. Carr on these facts, clearly it failed.

(d) The ‘540 Patent: Polyester Supports

Mr. Carr advised Kodak that the only innovation contained in ‘540 was the use of polyester for the supports. Given that polyester was already being used in film and that DuPont was aggressively marketing its invention as a useful photographic material, Mr. Carr believed that ‘540 was invalid based on obviousness.

Judge Zobel, and later Professor Adelman, described the system as truly “inventive.” Again, although Mr. Carr proved to be mistaken, Polaroid can point to no evidence that his opinion was unreasonable or unreliable.

(e) The ‘392 Patent: Rear Pick

Mr. Carr advised Kodak that ‘392 was obvious and invalid.

Judge Zobel reached a different conclusion.

(f) The ‘211 Patent: Light Shield Deflector

Mr. Carr reviewed the ‘211 claims and determined that squaring the wave front was not one of the benefits claimed by the patent. He advised against using roof bumps in the Kodak EK-4 and EK-6 cameras and Kodak followed this advice. Because of the prior art and the failure of the patent to claim the coating benefits caused by the bend, Mr. Carr believed that ‘211 was invalid and not infringed.
Judge Zobel disagreed, but there is no evidence that Mr. Carr's advice was unreasonable.

**The Totality of the Circumstances**

Polaroid's counsel and Professor Adelman praised Mr. Carr, acknowledged his pre-eminence and expertise in the field of patent clearance, and never questioned his good faith in rendering the opinions and advice he gave Kodak over the years.

Throughout Professor Adelman's testimony, however, two different themes have emerged.

1. First, Professor Adelman stated, repeatedly and without qualification as to each of the patents in suit that any "skilled attorney" would have recognized that the Polaroid patents were valid and that Kodak's products infringed.

2. Second, Polaroid suggests that Mr. Carr's opinions were flawed because Kodak simply used him to ratify their knowing and wilful infringement. The record clearly contradicts the first claim, as it shows a patent clearance process that could serve as a model for what the law requires. On the second claim, Polaroid has produced not a shred of evidence. The wilfulness claim therefore fails.

However, the Court found no wilful infringement in the totality of the circumstances even though patent counsel did not review the file wrapper or prior art before advising the defendant, orally, that the patent was invalid.

The uncontroverted facts demonstrate that Kodak consulted Mr. Carr early and often as it developed its instant integral photography system. Mr. Carr examined Kodak's products, sometimes even requesting additional tests in order to understand how the technology worked, and carefully studied any related Polaroid patents. The patent clearance process involved review of the file wrapper, the prosecution history, and the prior art.

In the totality of these circumstances, Mr. Carr's advice simply turned out to be incorrect concerning the relatively few patents eventually found infringed.

Polaroid would have the Court believe that Mr. Carr's advice was mistaken on these patents because Kodak manipulated the information he received in order to have a handy file of opinions which would protect the company from later charges of wilful infringement. Nothing in the record supports this claim nor was Kodak facing enormous "market pressure and urgency" that may have made reliance on counsel's inadequate opinion unreasonable. Mr. Carr monitored the field for years, had access to Kodak records, reports, and personnel, and was placed under no financial constraints by Kodak. His opinions, although later shown to be
incorrect, contained significant, scientifically based objective factors to justify [defendant's] conclusion of no infringement.

In conclusion, Polaroid has failed to show any deliberate or willful infringement of its patents by Kodak.

**Attorney fee**

This section examines whether this is an "exceptional" case within the meaning of 35 U.S.C. 285, thus permitting the award of attorneys' fees. The answer requires an overall assessment of Kodak's conduct, both during the infringement period and as a party to this litigation. Counsel have stipulated and agreed that if the Court decides to award Polaroid its reasonable attorneys' fees, $48,000,000 would constitute the amount of those fees for the period 1976 through 1989.

As a general matter, counsel fees are not awarded in patent cases. The case must be truly extraordinary and requires a finding of unfairness or bad faith in the conduct of the losing party, or some other equitable consideration of similar force, which makes it grossly unfair that the winner of the particular law suit be left to bear the burden of his counsel fees which prevailing litigants normally bear.

Even in the absence of wilful, intentional infringement, however, "misconduct during litigation, vexatious or unjustified litigation, or a frivolous suit" may warrant the award of attorney's fees.

**Conclusion**

1. Kodak's infringement of any one or more of the patents in suit was not willful and deliberate.

2. In accordance with 35 U.S.C. 284, the amount of damages adequate to compensate Polaroid for Kodak's infringement is $454,205,801.00. The prejudgment and post judgment interest award to date is $455,251,766.00. The total award is $909,457,567.00.

3. Costs will not be taxed against either party.

4. Polaroid is not entitled to its reasonable attorneys' fees because this is not an "exceptional case" within the meaning of 35 U.S.C. 285.

**C) Another Interesting Case**
A company patented a design for a home-use 3D printer. The plaintiff's printer allowed home users to produce small, 3D objects from smaller space. The printer was designed to work with a number of design programs, allowing individuals/home users to share designs that could be printed. The company filed for, and received, a patent for the design. About a month later the patent was granted, the defendant (did not know about the patent) (when the defendant started making the printers the patent application has not been published) finished producing a similar, home-use printer. The second company began selling their printers to consumers and marketing it in a similar manner. The plaintiff discovered the defendant's actions and sued for patent infringement.

In this type of technology several factors have to be analysed. The patent, itself, as originally filed has to be analysed, most importantly 'claims' of the patent should be compared to the defendant's printer. Since 3D printing is a new technology, analysing any similarities is difficult to do. In printer technology for 3D printing there could be either SLS, or FDM or SLA could be used. Determining which technology plaintiff's and defendant's printers use, and the resolution at which they can produce, and the size of the objects they can produce, will help to determine the similarity of the printers. While an examination of the patent will highlight any violations by the defendant, the specific uses of the defendant's printer (the home-use feature, along with resolution capabilities) have to be examined for similarity, in order to determine if there is infringement.

To learn how to conduct FTO search to counter the law suits such as above, learn FTO search here or here

**D) Validity/Invalidity Search Example**

This is an interesting little lesson for people to take to heart: the world does not necessarily work the way you think it does. More specifically, the laws in other places and countries can be very different indeed from what you think they are. This little example is that Steve Jobs managed to invalidate a European patent of Apple's AAPL -0.24% through showing off the product on stage. This was held to be prior art: and the point is that in the US it would not be so considered, here in Europe it is so considered.

So be warned: the law is not the same everywhere and you should never make the assumption that things work elsewhere like they do at home.

"Steve Jobs is a named inventor of more than 300 Apple patents, and when he presented the original iPhone in January 2007, he said, "boy have we patented it!"

But Apple forgot about an important difference between U.S. patent law at the time and the patent laws of the rest of the world, especially Europe. In the United States in the pre-America Invents Act days, innovators had a twelve-month grace period to file for inventions after making an invention, and during those twelve months nothing that anyone would show
Basics of Patent Search

publicly or publish would be eligible as prior art. In Europe, however, there never was such a
grace period for patent applications, and even an inventor’s own public demos could always
be held against his own patents if they took place before the filing of an application.

patent-over-prior-art/

Join our validity invalidity search and learn the points to consider before starting the search
and how to conduct the search including the steps to be followed.
Section 6: Search Courses offered by Origiin IP Academy

A) About Origiin IP Academy

Origiin IP Academy (OIPA), founded in the year 2008, is India's premier institute for IP (Intellectual Property) learning. Main objective of OIPA is to provide a platform for domain experts to learn various skills needed to work in the field of IP, such as various types of Patent Searches, Patent Specification Drafting, as well as training for Indian Patent Agent Examination (IPAE). Further, we also offer advanced IP courses such as Patent Valuation, Evidence of Use and Office Action/Examination Report Analysis.

All the courses are offered in various modes such as Classroom (at our location), Live online (live sessions by an expert), E-Learning (online self-learning), On-site (at your premises), Distance education (printed study material).

The curriculum of the courses is carefully designed by IP experts including academicians, IP attorneys, patent agents and industry professionals keeping in view the needs of the industry.

B) Our mission and vision

Our mission is to provide a wholesome IP education by giving an insight into the practical applications of IP practices and enable the participants to work independently and immediately after completion of the course.

C) Courses Offered

1. Introductory course in Intellectual Property Rights
2. Certificate Course in Patenability Search
3. Certificate Course in Freedom to Operate Analysis
4. Certificate Course in Validity/Invalidity Search
5. Integrated certificate course in Patenability search, Freedom to Operate Analysis and Validity/Invalidity Search
6. Certificate Course in EOU (Evidence of Use)
7. Certificate Course in Patent Landscape Analysis
9. Certificate Course in Responding to Office Action/Examination Report
10. Training for Indian Patent Agent Examination

D) Who may join?

Any science or engineering graduate, keen to pursue career in IPR or practicing IP professionals willing to improve their skills or wish to learn new skills may join the courses.

We highly recommend these courses to:

- Fresh graduates (Science or Engineering graduates)
- IP Professionals working in companies or law firms
- Inventors, Scientists or Researchers

E) Modes of study

At OIPA, we understand that the requirement, comfort level and time available for learning differs from individual to individual, hence, we offer various modes of learning such as:

Classroom - at our location
Face to face classroom training at the OIPS Bangalore center.

Live online - interactive online learning
Includes interactive live online sessions by experts and can be attended by participants by logging into the website at predefined time from any location. Personal requests for classes with timings that will work for you (including weekends and weekday evenings) will be accommodated on first come first serve basis.

E-Learning - learn at your place and space
Includes recorded sessions by experts and may be accessed by participants anytime by logging into the website.

Distance education - includes printed study material
Includes printed study material, assignments and project work, all sent to the participants via post.

On-site - at your premises*
Sessions will be conducted at your premises upon request.

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