**Start-Up Tip # 5**

**Note: This is the fifth in a series on IP for Startups. To view previous articles please click**[**here**](https://www.jmbdavis.com/category/ip-tips-for-startups/)**.**

3 Things You Should Know About Patentability Searches

**Patentability Search**

What is it (and what is it not)?

* A patentability search **is** a search of the prior art intended to establish the probability of successfully registering a patent for your invention. While the main data sources searched by both Patent Attorneys and Examiners are patent databases generally; and scientific journal databases for inventions in biotech and chemistry, this is mainly for convenience. There are vast sources of knowledge other than these databases. All publicly available information can be used to establish the patentability of your invention.
* A patentability search **is not** a ‘freedom to operate’ search and should not be confused with such a search. (This will be discussed later in this series).

Why is it important? A patentability search is important not merely to assess the likelihood of obtaining a patent for your invention, but, equally significant, as a way of improving and strengthening your patent application. Discovering which parts of your invention may already have been thought of by others, will often cause you to rethink part of your invention and to improve it substantially.

When should I do it? As mentioned above, doing a patentability search may bring to light parts of your invention that have been thought of by others, in response to which you may come up with new and sometimes better solutions. Therefore, the best time to do a search is before preparing a patent application.

JMB’s extra Q & A

Q: I was told that when a patent application is examined, a search will be done and the Patent Examiner will send me the results. If that’s the case, why should I spend the extra money on a separate search?

A: ***No***. It’s true that you are not required to do a search, but you don’t want to wait for a Patent Examiner to inform you of the prior art. At that stage, which will probably be at least a couple of years after filing the application, you will have invested time and money, only to discover that your invention isn’t quite as patentable as you thought (and told your investors!). To make matters worse, once a patent application has been filed, it’s not possible to add information about variations and additions to what was initially described and shown. The bottom line is that the more you can find out about the prior art, the better prepared you’ll be, and the better will be the chances of receiving a valuable patent.

Do you have questions about the above information? Are there subjects that you would like to hear about? [Let me know](mailto:jeremy.ben-davis@jmbdavis.com)!