SAMPLE PATENTABILITY OPINION

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PATENTABILITY OPINION

PRIVILEGED STATUS OF THIS REPORT

In order to preserve the privileged and non-discoverable status of this opinion we advise you to limit its distribution to those persons who participate substantially in decisions regarding any action to be taken on our legal advice.

[date]

by

[law firm]
Dear Inventor or Invention Owner:

Thank you for authorizing that a patentability search and opinion be performed for the above-identified invention. We have now completed the prior art search to evaluate the probability of obtaining a patent for the above-identified invention.

Search Criteria

From our discussions, and the written materials you have provided, we understand the subject matter of the invention for which the prior search was performed was [insert description of inventions searched].

We arranged to obtain a search of prior art patents relating to the invention that was carried out in the public search library maintained by the U.S. Patent and Trademark Office.

Search Results

As a result of this search, the following patents (copies enclosed) were noted as a results of the search:

[List Patents]

<table>
<thead>
<tr>
<th>Patent Number</th>
<th>Inventor</th>
</tr>
</thead>
<tbody>
<tr>
<td>X,XXX,XXX</td>
<td>Doe, et al.</td>
</tr>
<tr>
<td>X,XXX,XXX</td>
<td>Smith, et al.</td>
</tr>
</tbody>
</table>
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Discussion of Interesting Patents

Patent No. X,XXX,XXX describes [insert description]

Patent No. X,XXX,XXX describes [insert description]

1. Field of Search

The search was performed at the U. S. Patent and Trademark Office in the following subject matter classification areas:

<table>
<thead>
<tr>
<th>Class</th>
<th>Subclasses</th>
</tr>
</thead>
<tbody>
<tr>
<td>XXX</td>
<td>XXX, XXX, XXX</td>
</tr>
</tbody>
</table>

Additionally, a computer search was conducted using appropriate keywords for U. S. Patents. Integrity checks were not performed for this search. The results, therefore, are dependent upon the completeness and the accuracy of the U.S. Patent and Trademark Office records at the time the search was conducted. In addition, we have not searched foreign patent offices and/or databases consisting of foreign patents and/or publication.

Furthermore, although we believe we have searched the most relevant classes and subclasses, the scope of the search is limited by cost and other practical considerations. It may be possible to extend the search to other classes and/or subclasses at additional cost. In addition, the search could also be extended to foreign patents, technical publications and/or literature. Upon your request, we can extend the search into any of these additional areas/fields.
Analysis and Conclusion

Obtaining patent protection for the invention depends on the extent to which the invention can be distinguished over all of the prior art that existed at the time the invention was created.

Patents are granted by the U.S. Patent Office as a result of a rigid examination procedure carried out by a Patent Examiner assigned the task of evaluating the patentability of the invention. The Patent Examiner will conduct an independent search of prior art documents, in particular previously granted patents, to determine the novelty and the non-obviousness of the invention in view of such prior art. If the patent application is not immediately approved, and most are in this category, the negotiation process begins with the Patent Examiner, also called the “prosecution” phase of the examination process. During the negotiation process, an attempt will be made to persuade the Patent Examiner of the novelty and non-obviousness of the invention and, if successful, the Examiner will withdraw any objections or rejections that have been raised. The patent application will then be approved for the grant of a patent.

For an invention to be patentable, the invention must include one or more features and/or combination thereof that are not shown or suggested in the prior art, i.e., that the identified prior art references do not anticipate or render obvious the invention.

Unpatentability based on lack of novelty (also known as anticipation) requires that the same invention was publicly available, published, known or used by others before the invention for which the patentability search is being performed.\(^1\) For anticipation to be present, the prior art must be identical to the invention. In other words, the invention must be the same as that disclosed in a single prior art reference.\(^2\)

Even if the invention satisfies the novelty requirement, the invention may still be unpatentable for obviousness “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”\(^3\) The issue of obviousness typically arises when all the aspects of the invention are found in two or more prior art references. The issue then becomes whether one of ordinary skill would, at the time of the invention, have been motivated or suggested to combine the prior art references in a manner that produces the invention, thereby rendering the invention unpatentable.\(^4\)

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\(^1\)Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995).


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The motivation or suggestion may take the form of an explicit teaching or suggestion contained in the prior art of the desirability of such a combination. An obviousness determination also considers, when present, objective evidence of secondary considerations, including commercial success due to the invention, failure of others, long felt need, skepticism of experts, copying the invention in preference over the prior art, and the like.\(^5\)

The prior art references uncovered during the search do not appear to show or suggest at least some of the features of the invention, as described below.

The closest prior art patent, but not particularly relevant, appears to be U.S. Patent X,XXX,XXX that discusses [insert description]

Another prior art patent is U.S. Patent X,XXX,XXX that discusses [insert description].

However, none of the prior art references appear to show or suggest the combination of features of the [invention]. For example, none of the prior art references relate to [insert distinguishing feature or features of the invention]. In addition, other features of the invention that may be patentable include [insert additional features].

Based upon the above, we are of the opinion that useful patent protection is likely available for your [invention].

Please understand that there is the possibility that the Patent Examiner in conducting an independent search of the prior art may locate additional relevant documents and information that could have a bearing on the patentability of your invention, but which has not been considered in preparing this opinion.

If the invention is to be commercialized, we recommend that a clearance investigation be conducted to avoid conflicts with other patents. This will be particularly important because if your invention infringes another issued patent, you may be enjoined or prevented from using your invention and/or subject to damages for infringement.

The U.S. patent laws provide a grace period of one year for an inventor to file a patent application after publishing or commercializing the invention, but foreign countries do not generally provide such a grace period. We recommend that you reach a decision whether to file a patent application for this invention as promptly as possible, and before the invention is offered for sale, sold and/or disclosed publicly.

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If you desire to file foreign applications, including subject matter disclosed in the U.S. patent application, the foreign application must typically be filed within one year from the U.S. patent application filing date to obtain the earlier priority/filing date of this patent application. Finally, if you are interested in filing this Patent Application in Canada, such a filing must also be made in Canada within one year from any offer for sale, sale and/or non-confidential disclosure of your invention.

We are available to discuss the invention and prior art in greater detail, at your request. Please do not hesitate to contact us for any questions and/or comments you may have.

Very truly yours,

[signed]