



Challenging a Competitor's Patent Application to Prevent Grant

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If a competitor files a patent application in the patent office on an unpatentable invention, the patent office should do its job and reject the patent application. However, patent examiners are working with limited time and resources for prior art searching and examination. Often, examiners are not aware of all the potentially relevant prior art. It is possible for a third party to assist the patent office to invalidate a competitor's patent application before it becomes a granted patent that could be used to start a nuisance patent infringement lawsuit. In this article, we outline mechanisms for third parties to file prior art while a patent application is pending in Canada, the United States, Europe and internationally. The intention of this article is not to be exhaustive but to provide a high level overview of advantages and disadvantages of such mechanisms.

Major patent offices allow a challenger to file prior art and supporting arguments against a competitor's patent application. There is often no government fee to file prior art in the patent offices.

The types of arguments that can be made may be broad or narrow, depending on the patent office. In the narrowest systems, the arguments must be confined to novelty and inventiveness. For instance, the PCT Office takes a narrow approach, only permitting submissions (known as "third-party observations" or "TPOs") on novelty and obviousness to be filed against published Patent Cooperation Treaty ("PCT") applications. Submissions can include a brief explanation of relevance of the cited documents. A maximum of ten documents can be cited per observation (multiple observations are permitted). This mechanism has been used in a very limited manner to challenge patents to date, partly because the PCT Office cannot make final decisions that patent claims are not patentable.

In other offices, any issues relating to patentability may be raised. In the European Patent Office ("EPO"), third parties may make submissions (also known as "third-party observations") on all aspects of validity including sufficiency, added matter, unity and clarity. Unlike TPOs filed against PCT applications, TPOs filed against EPO applications has grown in popularity.^[2] Canada also has broad grounds to challenge a pending application. Prior art may be filed, along with an explanation of pertinence. As well, a challenger can file a protest attacking non-prior art aspects, such as lack of Canadian utility.

The United States Patent Office ("USPTO") also does not limit pre-issuance submissions to novelty and non-obviousness arguments – submissions of any printed publication with a concise description of the asserted relevance can be considered in the examination of the application. At the USPTO, the regular undiscounted fee for every 10 references filed for a patent application or fractions thereof is currently set to \$180 (USD). There is no fee required if the first-time submission by a challenger lists three or fewer references. In some cases, challengers to US patents take an alternate route by sending prior art to the U.S. attorney of record, knowing that the attorney will most likely feel compelled to submit it to the USPTO in an information disclosure statement, due to the strict USPTO rules requiring disclosure of prior art (particularly a good strategy if a potential challenger finds themselves outside the USPTO time windows discussed below). With this strategy however, the challenger will not be able explain the relevance of the prior art to the Examiner.

There may be timing limitations when a third party can submit prior art. For example in the USPTO, submissions can be filed from the publication date until the later of 6 months after the publication or when the first Office Action on merits is issued. The PCT Office requires observations to be filed at any time after the date of publication of the international application and before the expiration of 28 months from the priority date. Canada and Europe are more liberal, permitting comments to be filed any time after publication, even after allowance. In Europe this is permitted as long as a final decision



on the case has not yet been made.

The filing of prior art can be made anonymously. Submitting prior art in one jurisdiction may also be useful in parallel proceedings elsewhere in the world, especially where there are strict disclosure requirements (as mentioned above, the U.S. attorney of record is likely to take prior art filed in another patent office and file it in the USPTO in an information disclosure statement). A downside of these mechanisms is that in all jurisdictions discussed above, the challenger is excluded from discussion of the prior art after the initial filing. The Applicant is able to argue against any Examiner objections, without being countered by the challenger. **Therefore, the prior art should be very close to the patent claims to be challenged, or the arguments on other grounds very strong, prior to using these mechanisms.**

In summary, filing very close prior art during the pendency of an application can be a useful and low cost method to put forward patent-killing evidence to ensure it is drawn to the attention of examiners.

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[1] WIPO Circular 1527, "Invitation to provide comments on the Report on Third Party Observations in the PCT", January 31, 2018, online: WIPO < <http://www.wipo.int/pct/en/circulars/>>.

[2] De Clercq A., Wright S. "Minutes of EPO/epi Meeting (held on 6 November 2012 at the EPO, Room BT7, Bayerstrasse 115, Munich)". epi Information 1/2013. Carl Heymanns Verlag.

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