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Can I Challenge My Competitor's Patent?

Yes, you can challenge a patent or patent publication. Before challenging a patent or patent publication, an analysis should be conducted by a registered patent attorney to determine if challenging a patent or patent publication is necessary, and to evaluate the legal grounds for challenging the patent or patent publication. As a registered patent attorney, I evaluate patents and patent applications to determine the risk of developing competing goods. Below are three important questions that must be answered by a registered patent attorney to evaluate the risk of competing against a patented good.

1. Does a particular good infringe on a patent?

Typically, a registered patent attorney will conduct a “freedom to operate” opinion to determine if a business owner can commercialize a particular good without infringing on another's patent. First, a patent attorney will determine if the patent is enforceable. Next, a patent attorney will perform an infringement analysis to determine if a particular good infringes on any of a patent's claims.

To perform an infringement analysis of a patent and a possibly infringing product, first, the patent's scope must be analyzed. Second, the patent's claim terms must be interpreted using the specification, prosecution history and extrinsic evidence to understand and construe the meaning of the claim terms. After the claim terms have been construed, then the elements of a particular good must be analyzed to determine if the particular good practices each and every claim element taught by a patent's claim. If a good practices each and every claim element, or one of its equivalents, taught by a patent's claim, then infringement exists. If the good does not practice at least one claim term, then no infringement exists. Additionally, a patent attorney may also conduct an analysis to determine if the patent is valid or if there is a possibility the patent can be invalidated.

2. Is the Patent Valid?

Patent validity opinions are a patent attorney's opinion as to the probability that a patent's or patent publication's claims are valid and enforceable. A patent attorney analyzes the prior art, or any evidence related to an invention known before the filing date of a patent, and the circumstances surrounding the prosecution of the patent to render a patent validity opinion. Typically, a search is also performed to find relevant prior art that was publicly known before the filing date of the patent that may not have been considered in the prosecution of a patent at the United States Patent and Trademark Office (the "USPTO"). A patent attorney will analyze the patent and the prior art to determine the probability that a patent or patent claim will be invalidated because in light of the prior art the claims of the patent are not obvious or not novel.

3. Can I challenge a patent?

Depending on the answers to the questions above, a business may decide to challenge a patent or patent application. Several options exist for a business to challenge a patent application. These options include pre-issuance submissions filed

with the USPTO, post grant reviews filed with the Patent Trial and Appeal Board (the “PTAB”), inter partes reviews filed with the PTAB, ex-parte reexamination filed with the USPTO, covered business method patent reviews filed with the PTAB, and filing legal action seeking a declaration of non-infringement in a United States District Court. My next post will more fully explain the options for challenging a patent.

There are several different legal proceedings for challenging a patent or patent publication. The list below explains those different legal proceedings.

1. Pre-issuance submissions

A pre-issuance submission can be used to challenge a patent publication or patent application that has not been granted or issued a patent. If a patent has not been issued by the United States Patent and Trademark Office (“USPTO”), then you can challenge the patent application by submitting “prior art” to the USPTO before a patent issues. Prior art is evidence that an element of an invention was publically known before a patent application was filed with the USPTO. After the prior art has been submitted, an examining patent attorney at the USPTO will determine if a patent should be issued in light of the newly submitted prior art.

2. Post Grant Review

A post grant review can be used to challenge an issued patent within nine months after the grant of a patent. A post grant review can be filed by any person who is not the patent owner and has not filed a civil action challenging the validity of a claim of the patent. A post grant review is filed with the Patent Trial and Appeal Board (the “PTAB”). The PTAB will review the patentability of one or more of a patent’s claims. In reviewing the patentability during a post grant review, the PTAB will consider if a patent claims are valid in light of 35 U.S.C. § 101 (patentable subject matter issues), 35 U.S.C. § 102 (novelty issues), 35 U.S.C. § 103 (obviousness issues) and 35 U.S.C. §

112 (adequate disclosure/definiteness issues).

3. Inter Partes Review

An inter partes review can be used to challenge an issued patent after nine months after the grant of a patent. The process begins by a third party filing a petition for inter partes review with the PTAB. The patent owner may file a preliminary response to the petition. In reviewing the patentability during an inter partes review, the PTAB will consider if the patent claims are valid in light of 35 U.S.C. § 102 (novelty issues) and 35 U.S.C. § 103 (obviousness issues).

4. Ex Parte Reexamination

An ex parte reexamination can be used to challenge an issued patent during the term of a patent. If the patent has already been issued by the USPTO, then a third party can challenge the patent at the USPTO by filing a request for reexamination of the patent. An ex parte reexamination can be filed by any person. A request for reexamination requests that the patent office reexamine a patent in light of newly submitted prior art that was not considered during the prosecution of the patent, or in light of prior art that was considered, but now is to be considered in a new way. Ex parte reexaminations require documents that include legal arguments drafted according to very specific formats and administrative rules. It is well advised to seek the help of a registered patent attorney for assistance in preparing and filing a request for reexamination with the USPTO.

5. Covered Business Method Patent Review

A covered business method patent review proceeding can be used to challenge business method patents, including software related patents. The covered business method patent review proceeding is only available to a party that has been sued or charged with patent infringement. The proceedings are conducted by the PTAB to

review the patentability of one or more claims in a covered business method patent. These proceedings are very similar to the to the Post Grant Review proceeding with some differences related to how and what prior art the PTAB will consider during the process.

The patent attorneys at The Plus IP Firm help businesses and inventors compete against their competitors in the marketplace. The patent attorneys at The Plus IP Firm have helped numerous clients develop goods and services to increase their market share in highly competitive markets.

"We co-labored with Derek Fahey for 3 months on a patent application. Derek has the perfect blend of technical and legal prowess. He is detail-oriented, responsive, proactive, and flexible. The experience was awesome." - Steven, a devoted and satisfied client.



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Derek Fahey, a registered patent attorney at The Plus IP Firm, PLLC helps innovators concerned about protecting the time, money and resources spent in developing their concepts, brands, ideas and innovations.