

MORE OPTIONS RE COMPETING PATENTS

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What can you do if you encounter a patent application filed by someone else that appears to be too obvious or insufficiently novel to justify patent protection, and yet if issued, could affect your freedom to operate? Until recently, there was very little that you could do, except wait until the application issued as a patent and then challenge its validity.

However, thanks to the new "America Invents Act," this situation has radically changed. Under the new laws (35 U.S.C. 122(e)), a third party can submit prior art publications into a patent prosecution at any time up until six months after publication, or the issuing of the first substantive office action, whichever *comes later* (except that the submission cannot be after a notice of allowance).

Unlike the old procedure (37 CFR 1.99), the submitting third party is now *required* to submit written comments together with the prior art in the form of a "concise description of relevance" of the submitted prior art. In addition, the submission can be anonymous, and any number of items can be submitted.

This is a powerful and practical new tool for assisting patent examiners to block the allowance of low quality patent applications. It is also a powerful tool for helping to stop, or at least narrow, weak patent applications filed by your competitors.

If you haven't already done so, you may wish to increase the diligence with which you monitor the patent application filings of your competitors, so that you can take full advantage of these new procedures. Contact your patent counsel or this office for formal advice and specific guidance for exploiting this new capability.

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