

Patent Validity

When a company is accused of patent infringement or is seeking to acquire rights to a patent, the question typically arises: "Is the patent valid and enforceable?" In the case of a patent infringement, evidence of "invalidity" or "unenforceability" is an important defense. In license or acquisition situations, if the strength or validity of the patent is put in doubt, the value of the patent declines significantly.

The first step in determining the validity of a patent is to check if the patent term has expired or if the maintenance fees have not been paid. Provided the patent is still valid, a request for a "patent validity opinion" is typically lodged with the company's patent attorney or law firm. The attorney generally orders or obtains a copy of the patent's "file wrapper" from the patent office. The file wrapper is a complete copy of the prosecution history of the patent, the back and forth correspondence between the applicant (via the attorney) and the patent office from the filing of the original application to the issuance of the patent as well as any corrections submitted after the patent issued. The file wrapper is used to determine the scope of the claims by taking into account limitations within the file wrapper. The claims are analyzed in comparison to the alleged infringing product to assess the strength or merits of the suit.

The attorney may also arrange or conduct a "patent validity search" in an effort to find additional prior art that may not have been known to the Examiner or the Applicant at the time of the filing and prosecution. This is a search not unlike a patentability screening search for a new invention, except that it is based on the issued claims of the patent of interest rather than on a description of the invention. A patentability screening search and opinion is normally requested by the patent applicant, prior to filing an application. A patent validity search and opinion is normally requested by a third party interested in defeating an issued patent.

When the search is complete, the patent attorney, sometimes in collaboration with the client, will examine and compare the search results with the issued claims, and seek to determine if and to what degree it can be argued that the claims "read on" or were anticipated or made obvious by the prior art publications.

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In the case of an infringement challenge, a formal opinion as to the validity is usually combined with an analysis of the other possible defenses to infringement.

An independently rendered formal legal opinion on patent validity and infringement, that was favorable to the defendant's position, is an important legal device that may protect the defendant against an excessive damages award in the event there is a later judicial finding of infringement.

Patent law and the implications of a patent validity opinion are complex legal matters for which professional counseling is essential. Consult any of the registered patent attorneys at Maine Cernota & Rardin.