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IP FRONTIERS

Blocking patents via third-party preissuance submissions

The America Invents Act introduced procedures that allow parties to submit prior art to challenge competitors' U.S. patent applications. Parties have already begun to advantageously incorporate these procedures into their intellectual property strategies.

Pre-AIA, prior art submission timing was considerably limiting, and parties were not permitted to include any explanation of art being submitted, which severely limited the potential benefit of pre-AIA third-party submissions. Under the AIA, however, expanded timeframes for submitting art are provided for, and in addition to submitting important art, parties also submit descriptions that inform examiners how submitted art is relevant to the claims of patent application.

Under the AIA, third-party preissuance submissions may be filed in connection with a patent application before the later of (i) six months after the date on which the application is published; and (ii) the date of the first rejection of a claim. However, in all circumstances, preissuance submissions must be filed before the date upon which a notice of allowance has been mailed.

As the current timeframes for submitting prior art can still be prohibitive, parties are electing to use monitoring services to help to ensure that they do not miss critical submission deadlines. For example, the monitoring services that HRFM offers allow clients to keep tabs on newly published applications and/or granted patents based on technology types, product(s), and/or competitors of interest.

Third parties may file preissuance submissions to submit prior art to the U.S. Patent and Trademark Office in connection with any pending, published, or abandoned non-provisional utility, design or plant patent application. The submissions, which may be made anonymously, may include patents, published patent applications, or other printed publications (e.g., articles, websites, presentations, foreign office actions, etc.) of potential relevance to the examination of a patent application.

Procedurally, preissuance submissions are first checked for compliance with the applicable rules. When compliant, preissuance submissions are entered into the file wrapper of an application for consideration by the examiner. The procedures are

particularly useful insofar as they provide an inexpensive vehicle by which third parties can anonymously submit art against competitors' applications, which can prevent the issuance of problematic patents that could impede third parties' businesses.

As we have already begun to realize and experience, the AIA's third-party preissuance submissions represent an economical option that may allow parties to prevent the issuance of competitors' patents, thereby avoiding future costly litigation. In addition to being inexpensive, other mentionable advantages of preissuance submissions include the fact that, unlike post-grant proceedings, preissuance submissions are quick, allow for anonymity, and create no estoppel. No threshold standard must be met for a submission, and no discovery or hearings are needed.

Further, unlike Post Grant Review, preissuance submissions may be made in all patent applications, not just AIA first-inventor-to-file applications. Even further, compared to litigation, preissuance submissions involve a reduced burden of proof of unpatentability. The burden of proof for a preissuance submission is a "preponderance of the evidence" that a claim is unpatentable in view of the submitted item(s), whereas in litigation, a defendant must prove unpatentability/invalidity by clear and convincing evidence, which is a much higher burden.

In determining whether it makes sense for a party to file a preissuance submission, a critical question will always be whether the economic and other advantages of submitting prior art against a patent application outweigh, inter alia, the inability to partake in proceedings and the fact that, once submitted, items will appear on the face of an issued patent.

However, the many advantages of preissuance submissions make them a valuable and desirable option in various situations. In such situations (which often include, for example, situations involving competitors' nuisance patent applications), filing submissions to block or inhibit patent issuance can be a very attractive option.

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