



Attack your competitors' patent applications - before grant

Janni Wandahl Pedersen, HØIBERG A/S

April 2016

Third party observations

The validity of granted patents can be challenged e.g. by filing an opposition at the European Patent Office (EPO) or in national proceedings before a national patent office or court of law. However, such post-grant proceedings are often costly and time-consuming and may prevent you from exercising your planned commercial activities for an extended period of time for fear of infringing IP rights held by others.

As an alternative, or in addition to post-grant proceedings, you can consider challenging your competitors' patent applications before they are granted to prevent your competitors from ever obtaining a potentially problematic patent. In this way, you may be able to establish freedom to operate at an early time point before major investments are made in relation to new commercial activities.

Many patent offices around the world allow third parties to file observations on the allowability of pending patent applications. It is also possible to file observations in the PCT phase. Such observations are generally referred to as "third party observations" (TPOs). As a competitor - you are the third party. Although the ideal outcome of a TPO is that the challenged patent application never proceeds to grant, an equally effective outcome is that the claims are amended so that they no longer represent a problem.

Advantages of TPOs

Filing TPOs is a cost-effective and straightforward way to bring relevant prior art to a patent examiner's attention. In some jurisdictions (such as Europe) it is also possible to submit commentary on other requirements including sufficiency, added matter, unity and clarity.

Third party observations:

- Are cheap
- Can be filed anonymously
- Can potentially prevent grant of a problematic patent

If the prior art and/or arguments are considered relevant by the patent office, the filing of a TPO can prevent your competitor from ever obtaining a patent, which will be a problem for your commercial activities. Thus, TPOs can be used as a tactical tool to pre-empt problematic patents.

In contrast to an opposition, TPOs can be filed anonymously. This may be preferable if you want to keep your commercial interests in certain technological areas hidden from your competitors.

TPOs can also be an effective mechanism to bring prior art to the attention of the applicant, so that it has an obligation to disclose that prior art in certain other jurisdictions, notably the US.

If your TPO is unsuccessful, there is nothing precluding you from filing a further TPO or bringing forth the same prior art and arguments in post-grant proceedings. However, if you have several prior art documents to choose from, it may be advisable to save the strongest prior art for post-grant proceedings as it may be difficult to base an argument on prior art that has already been considered and rejected as irrelevant by the patent office.

Disadvantages of TPOs

Although the advantages of filing TPO's are obvious, there are also some disadvantages; in particular the lack of procedural rights for the party filing the TPO. If the patent office does not find the observations persuasive you have no rights to further argue your case or file an appeal. Consequently, TPOs are best suited if you have highly relevant prior art and the observations can be kept simple; TPO are generally less attractive if complex arguments are required.

Another potential disadvantage of filing TPOs during examination is that your competitor will learn of potential weaknesses in its patent application at a time when it has the greatest freedom for amendment to strengthen its position.

Finally, the filing of a TPO may also inform the applicant that the application contains commercially significant subject matter, which could encourage the applicant to continue with the application, when it may otherwise have abandoned it.

TPOs in Europe

TPOs may be filed in Europe at any time after the publication of a European patent application. TPOs may also be filed during opposition, appeal and post-grant limitation proceedings, although the identity of the submitter must be revealed if the TPO is to be considered by the EPO in post-grant proceedings.

This serves e.g. to prevent opponents from submitting further documents and/or arguments to the EPO after expiry of the opposition period. It is, however, still possible to file a TPO using a strawman during opposition to hide the true identity of the party behind the TPO.

In Europe, TPOs may relate to any requirements of patentability, although most often they are used to file prior art of relevance for novelty and inventive step.

Of particular interest is the ability to use TPOs to attack a patent application for lacking clarity as it is not possible to file an opposition against or request revocation of a granted patent because of lack of clarity.

Another interesting way of using TPOs is to challenge the enablement, i.e. sufficiency, of a patent application. For example, it is possible to file documentary evidence to show that the claimed invention cannot be performed as described in the

patent application. If such evidence is produced during examination, as opposed to at the opposition stage, the burden of proof rests with the applicant to show that the patent application contains an enabling disclosure.

TPOs in USA

In contrast to Europe, TPOs may only be used to submit prior art documents. In addition, the time limit for filing TPOs in the US is very restricted. A TPO in the US must be filed prior to the earlier of:

- (1) The date a notice of allowance; or
- (2) The later of:
 - (i) Six months after the date on which the application is first published by the USPTO, or
 - (ii) The date of the first office action on the merits.

Consequently, the period for filing TPOs may have expired at the time you realise that a pending US patent application is relevant for your planned commercial activities. A way to circumvent this, or if prior art of relevance for patentability is identified after the time limit for filing TPOs has expired, is to file a TPO in Europe with the relevant prior art, thereby establishing an obligation on the applicant to disclose that prior art to the US patent office.

Conclusion

A successful TPO can prevent a potentially problematic patent from being granted or at least granted with a scope of protection that does not prevent you from exercising your commercial activities. Thus, TPOs can be a powerful tool for attacking your competitors' patent application, but should also be used with caution.

If you want to know more about ways to challenge you competitors IP rights, you are welcome to contact us at HØIBERG A/S.



**Janni Wandahl
Pedersen**

European Patent Attorney,
CDPA

Contact information:

T: +45 3332 0337

jwp@hoiberg.com

[Learn more about Janni here.](#)