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Independence Day

“Tip of the Month”

How to Spy on Your Competitor’s Patent Applications – Legally!

It is important to be on the cutting edge of technology for many companies. Companies that come in second place sometimes do not survive. Investment in research and development is an ongoing requirement. Most companies know that they need to protect that investment by filing patent applications.

Since the first patent law was enacted in the United States in 1790, patent applications were kept completely secret by the Patent Office until the day they issued. On that day they sprang forth with the full power of the law, much like the goddess Athena born by springing out of Zeus's head, fully formed and fully armed.

If a company could find out about a competitor's patent application while it was pending, it could avoid wasting research and development money on projects it will shortly be prohibited from pursuing. Alternatively, it could use the lead time to try to design around the competitor's invention.

It is tempting to employ spies to secretly enter the competitor's offices and laboratories under cover of darkness to secretly discover what they are up to. Fortunately, there is an easier way. And it's legal.

Since about 2001, the U.S. Patent and Trademark Office (“USPTO”) has been publishing most of the utility patent applications 18 months after their filing date. They are published in their entirety online for free. Nowadays, because the USPTO has adopted electronic record keeping, most of the file histories are also available online for free. Not all patent applications are published, however. If the applicant promises that it will not file a corresponding application in a country that also publishes applications after 18 months, or if the application is no longer pending at 18 months, then it will not be published until a patent issues.

A company that is aggressive about staying on the cutting edge should monitor these applications carefully. You can perform key word and patent classification searches to discover previously unknown competitors in your field. You can also search on a competitor's name to find all the patent applications that it has filed to find out the type of research and development the competitor is doing.

You might even find a competitor's patent application for which you have prior art records that could make the claims unpatentable. You are permitted under the patent regulations to send those prior art records to the USPTO for consideration in that application provided you 1) pay a fee; 2) serve a copy of them on the USPTO; 3) serve a copy of them to the applicant 4) do not make any comments about them. This is not the same as an opposition proceeding, like that which has long been a part of trademark law.

If you would like to set up a program to keep an eye on your competitor's intellectual property, please call us at 668-1971 or contact us through the Internet at Mailbox @ biz-patlaw.com.

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