



Intellectual Property Law

Q My company just heard that our major competitor has a patent application that may relate to one of our products. What should we do?

A You should be concerned about a competitor obtaining a valid patent against your company's products. However, once you have knowledge of the application, you can act to minimize the risks and even to possibly create a competitive advantage.

Prior to generating any communication, internal or otherwise, regarding these concerns, you should consult with your IP counsel. Your course of action will depend on factors such as whether the competitor's application is public (whether it has been published or issued), how far along it is in the patent office examination process, the dates of product conception and development, and the extent to which the product development is documented. Your IP counsel can advise and assist you with a number of options, including:

- Scrutinizing a competitor's published articles, other documents and its products to determine

what their unpublished patent applications might cover,

- Monitoring the application examination process,
- Conducting patent and literature searches to possibly invalidate your competitor's patent claims,
- Considering design-around options,
- Reviewing your patent portfolio for defensive purposes,

- Possibly amending your company's patent claims to cover the competitor's products,

- Filing a protest in the patent office,
- Seeking reexamination or initiating an interference proceeding for issued patents, and
- Preparing a non-infringement or invalidity opinion of counsel (this may help your company later avoid increased damages if litigation occurs).

The availability and viability of these options are maximized by ongoing, careful monitoring of your competitor's patent and product activities, and by early involvement of IP counsel when concerns arise.

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