Ruff | Wilhelm | Beier | Dauster
& Partner

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A Powerful Defense Against Patent Lawsuits

In my last 8 years acting for the remanufacturing industry, patents have been repeatedly granted by the European Patent Office (EPO) to OEMs related to methods for remanufacturing cartridges. Those methods, according to the remanufacturing industry, simply describe what the industry has done for years and, thus, are not new. Novelty over the prior art is a basic requirement for patentability, but nevertheless patents were granted. Why is this the case and what can the industry do about it?

Often, all the fuss over an "unlawfully granted patent" was for nothing, because the "patent" turns out to be an abandoned application or the scope of the patent appears to be much narrower than assumed. Always remember, the core of a patent lies in the claims, because the claims define the scope of the patent. Notwithstanding the above, patents troubling the industry are granted. One reason is that the examiner is simply not aware of this common-practice method or in the worse case, the method carried out by the industry does not form part of the prior art.

Many Examiners' Searches Are Limited

The prior art documents considered by the examiner are primarily patent documents. However, prior art is not limited to patent documents. Any product or process may form part of the "prior art" provided that it has been made available to the public before the effective date. An internal commercial use of a method or a product is not prior art. Public availability may be achieved in any way or through any medium, including a written or an oral description or use.

Creating Defensive Prior Art

Obviously creating defensive prior art is an important measure for avoiding (potentially) troubling patents. In order to create successful defensive publications, one should take into consideration that the questions to be answered to prove public availability are: where, when, and what was disclosed and to whom?

Prior art could be created by publishing in a periodical, at a conference or on the internet. When publishing in a periodical, the date and the content of the publication can in most cases be very easily determined. However, in other cases one has to rely on people's memory. Very often the importance of a publication only becomes apparent many years after it took place. In many cases, persons involved with a publication have changed ed jobs and/or can no longer remember the detail or circumstances of the "public use" or the oral description. The same applies when publishing on the internet. The content of a website may change. However, for assessing novelty and/or inventive step only the content published before the effective date is relevant.

Bringing The Prior Art to the Examiner's attention
The prior art created by such publications could be brought to the attention of the Examiner, either by filing a Third Party observation during examination, or, preferably, by filing an opposition to the grant of a patent. However, one should always bear in mind that practising a method is not sufficient *per se* to create prior art. If the question of public availability is doubtful, the prior art item showing the internal commercial use will not be considered by the EPO when assessing novelty and/or inventive step.

Apply for a Patent
Another effective way generate publications in the public domain is to apply for a patent. In general, a patent application is published 18 months after its filing date. Furthermore, granted patents may improve one's own standing within negotiations. Smaller companies may group together when applying for patents or may establish an IP-pool, into which every member brings his or her own knowledge, patent application or patent, and, in return, gets a royalty-free licence for the use of the patents and/or the knowledge of other members. This will allow the members to gain good protection, while keeping the costs per member reasonable.

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