

The Limited Monopoly

Public PAIR: Accessing Records on Pending Patent Applications

Kate is a co-founder and CTO of Diamondback Abrasives, LLC, a tech start-up that has invented and is presently manufacturing a line of synthetic microstructured diamond dust. In an on-line search, she recently discovered a journal article by a senior engineer at Bokshedd, Inc., a competitor she was not previously aware of. The article describes a new method and apparatus for making a composition of diamond nanoparticles. This could be a direct threat to Diamondback's product line. The article is very detailed, suggesting that research has been going on for some time. She wonders if there might be a pending patent application on the inventions described in the article. Kate logs into the U.S. Patent Office web site to have a look in Public PAIR.

Availability of Patent Applications

In the United States, a utility patent application is published after 18 months from its earliest effective filing date.¹ The application can then be read by anyone in the world (unless the inventor or owner knows that a corresponding foreign patent application will not be filed, and opts out of automatic publication). Finding a published patent application is fairly easy using the USPTO electronic search tools at www.USPTO.gov. The ability to electronically search for published patent applications and issued patents is well known, and the USPTO does a great job explaining how to use their on-line search tools. However, there is considerable additional information about patents and published applications that can be retrieved electronically using Public PAIR, the Patent Application Information Retrieval system. In this system, the scanned images of many application documents are contained in the USPTO Image File Wrapper, and can easily be viewed by the public. These documents can provide a wealth of information about a patent pending that is being touted by your competitor.

How to Access Public PAIR

Public PAIR can be accessed from the USPTO web site www.USPTO.gov. On the left hand side of the USPTO home page, under e-business, select patents, and then Status & View. From there, you can navigate through Public PAIR. You can even download a computer based training course if you want to become an expert. The course can be downloaded at www.uspto.gov/ebc/pair/cbt.htm. Public PAIR is fairly easy to use, and for the typical reader of the "Rochester Engineer," it should not present many difficulties.

What sort of Information is available in Public PAIR

So, why would you want to access Public PAIR? The Image File Wrapper of a patent application contains all of the file history related to a given patent or published application. This includes information on the inventors, correspondence between the patent practitioner and the patent office on matters related to the patent application, prosecution history that could include information such as any grounds for rejection of the patent application, and even a complete copy of any provisional application for patent if

the utility application claims priority to the provisional application. (So if you think that a quick and dirty provisional application for patent will never get seen in public, think again.) You can also view fees that have been paid, foreign priority information, and continuity data that describes related patent applications.

You can often infer a lot of indirect information from the information file wrapper as well. For example, if a company has filed a series of patent applications on a certain technology, and has also requested foreign filing, it has probably made a sizeable investment in the patent applications alone, giving some weight to the importance of the subject technology to its business. You can also make an educated guess at whether the invention disclosed in the patent application has actually been built. Are the drawings in the application rudimentary and basic, or do they appear to be derived from a highly detailed SolidWorks™ or Autodesk Inventor™ three dimensional model? If they are the latter, there's a good chance that at least some prototyping was done.

You can also view all of the inventors on a patent application. Are they employees of the company? Are they consultants? Who are they? Google their names to learn more. You can look at an Information Disclosure Statement (IDS) that may be in the file wrapper to see what the inventors may have considered information that is material to patentability, such as earlier patents, competitive product information, etc. You may also want to investigate the current status of the patent application. Has it been examined by the patent office, is it about to go abandoned, has it been allowed and is about to issue as a patent? How far along in the patent process is it?

From the Public PAIR portal, you can also go to the left hand side of the page and select the patent ownership heading. From there, you can view patent assignments to see who owns a certain patent or published application. You can also select fees to

see if the maintenance fees have been paid on a patent, and who is paying them.

So give it a try

Pick a competitor, a customer, or a supplier, do an assignee search in patents and/or published applications, and then see what's in Public PAIR. A little detective work may provide you with some valuable business information. Need some help? Hold on – we'll be adding a Public PAIR course to our PatentEducation series in the near future.

1. 35 U.S.C. 122

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