

*This document of FAQs serves as a brief introduction to the basic process for securing patent rights. It is intended to provide only a short introduction to the patenting process at MANE. Any specific questions should be referred to MANE's Legal and IP Department.*

For more general information on patents and patent rights, see our general FAQ:  
<https://mosscorp.emea.sesam.mane.com/LegalIP/IP/Patents%20useful%20information/FAQs> .

**1. How is a patent application created?**

At MANE, the patenting process begins with obtaining approval for a Patentability Study from one of the following committees:

**ComInnov** - Innovation, Valorization and Transfer Committee - SP-DG-001/01

**ComSci** - Conception, Development and Industrialization Committee - SP-DS-001/04

**2. What information is necessary for initiating a patentability study?**

The purpose of a patentability study is to assess the likelihood of obtaining a granted patent having meaningful protection. Thus, in order to assess patentability of a new product or process, the inventors/contributors must provide patent counsel with specific details of the product or process, including an explanation of the technical problem being solved, successful and unsuccessful experiments, known prior art, and how the new product or process is different from old or known products or processes.

After studying the provided details, the new product or process is defined by one or more hypothetical claims, which are then evaluated by comparing the hypothetical claim(s) to the prior art. Prior art is any evidence (information) that the invention was already publicly known or available, in whole or in part, before the effective filing date of the patent application, and includes publicly available information, such as published patent documents, scientific journal articles, web pages, technical data sheets, etc.

**3. What happens after a patentability study?**

At the conclusion of the patentability study, patent counsel will prepare a final written patentability report, which shall include a description of the invention, the hypothetical claim(s), a listing of the relevant prior art document(s) found in the prior art search, and an analysis as to the novelty and inventiveness of the hypothetical claim(s) vis-à-vis the relevant prior art document(s). The report will conclude with a recommendation to proceed (or not) with the preparation and filing of patent application.

Because the patenting system requires disclosure of the technical details of the invention in exchange for a chance at obtaining patent rights, there is a risk of disclosure without any patent rights. As such, in some instances and prior to making a favorable recommendation, R&D may be asked to perform additional testing or experiments to enhance MANE's chances for obtaining a granted patent.

**4. What is involved with preparing a patent application?**

The process for preparing a patent application involves a collaboration between patent counsel and the inventor(s). Patent counsel will generally begin the process by preparing

a set of claims describing the metes and bounds of the invention, and then build the remaining sections of the patent application therefrom to provide the requisite antecedent basis for the claims. In order to correct any errors and/or provide missing or supplemental information, the initial draft application must be reviewed by the inventors. While rare at this stage, R&D may be asked to perform additional experiments, but only if absolutely necessary prior to filing. At the end of the review/revision process, a final draft of the patent application must be approved by the inventor(s) prior to filing.

Since the draft patent application needs to be approved by the inventor(s), another important piece of information that should accompany the invention disclosure is a listing of persons who materially contributed to the creation of the invention. From the listing of contributors, MANE patent counsel will conduct an inquiry into the nature of each contributor's involvement and make a legal determination as to whose contribution rises to the level of "inventorship." It is globally accepted that an inventor must have contributed to the conception of some aspect of the inventive features (i.e., novel and/or non-obvious) of the invention. Conception, which is the key to inventorship, may be defined as the formation in the mind of an inventor of a definite and permanent idea of the complete and operative invention as it is thereafter put into practice. And because inventions are defined by the claims, an inventor must be able to point to at least one element in at least one claim that (s)he conceived. Additionally, those claim element(s) must be one of the inventive elements.

To be co-inventors, the contributions of each person need not be equal or the same. All that is required is collaboration and contribution to the conception of at least one of the claims in the patent application. Please note that being present during a meeting, providing research support, setting up experiments at the instruction of another, or sensory/analytical testing, does not by itself indicate a contribution to the conception of the invention.

#### **5. What parts make up a patent application?**

Since a patent application serves to provide a written description describing and enabling others to practice and use the invention, the inventors must provide patent counsel with sufficient details to create the application. The detailed invention disclosure provided to patent counsel will be used to create the basic parts (sections) of a patent application, which include **Title, Abstract, Background, Summary of the Invention, Brief Description of the Drawings (if applicable), Detailed Description of the Invention, and the Claims.**

#### **6. Where is the initial patent application filed?**

The initial filing (or so-called "priority filing") is typically performed where the invention is made.

#### **7. What happens after a patent application is filed?**

The filing of a patent application is not the end of the process, but really the beginning of a formal examination process. Moreover, it is necessary to make decisions regarding the filing of one or more foreign patent applications.

Under the Paris Convention (an international treaty created in 1883 requiring member countries to adopt certain minimum protections for industrial property), the priority filing permits the applicant to file one or more corresponding patent application in additional countries, within 12 months from the priority filing date.

Under the Patent Cooperation Treaty (PCT), which is another international treaty concluded in 1970, a single filing of a PCT application may be made with a Receiving Office (RO) in one language. A PCT application does not itself result in the grant of a patent, since there is no such thing as an "international patent." Instead, a PCT application serves to establish a filing date in all contracting states, and must be followed up one or more national or regional phase applications to proceed towards grant of one or more patents. The PCT procedure essentially leads to a standard national or regional patent application, which may be granted or rejected according to applicable law, in each jurisdiction in which a patent is desired. If a PCT application is desired, then it must be filed within 12 months from the priority filing date, i.e., the same deadline under the Paris Convention. However, the deadline for filing National Phase applications from the PCT application varies from member states, but is generally 30 months from the priority filing date. So, in essence, the PCT serves as a mechanism to delay the decision for filing patent applications from 12 months to about 30 months, but only in the 153 member countries.

In each jurisdiction, the claims of the patent application are evaluated for clarity, novelty, and inventiveness.

After 18 months from the earliest priority date, the application publishes and thus the invention is available to the public.

**8. What to expect during examination of a patent application?**

The examination of a patent application begins with an examiner reviewing the clarity, novelty, and inventiveness of the claims vis-à-vis the prior art. The examiner then issues an office action, which in most cases includes a rejection/objection of one or more of the pending claims. An applicant is given a limited period of time (e.g., 3-4 months) to respond to the office action, which may include arguments, claim amendments, and/or evidence supporting the patentability of the pending claims.

Depending on the nature of the rejection/objection, the inventor(s) may be consulted for technical input to assist patent counsel with developing claim amendments/rebuttal arguments to overcome the examiner's rejection(s)/objection(s). Ideally, the inventor(s) should also be aware of what embodiments are being utilized in MANE's commercial product/process. Thus, this collaboration between patent counsel and the inventor(s) should provide MANE the best opportunity to obtain commercially-relevant granted patents.