

**WE
CAPTURE
WHAT
MOVES**



PATENTABILITY AND FREEDOM TO OPERATE STUDIES

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STUDY

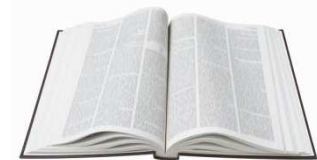
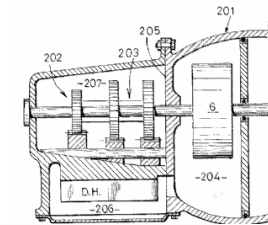
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REMINDERS

REMINDERS

A. Overview of industrial property

Legal right	What for?	How?
Patents	New inventions	Application and examination
Copyright	Original creative or artistic forms	Exists automatically
Trade marks	Distinctive identification of products or services	Use and/or registration
Registered designs	External appearance	Registration*
Trade secrets	Valuable information not known to the public	Reasonable efforts to keep secret



B. Rights conferred by a patent

- Prevent others from **making, using, offering for sale, selling or importing infringing products** in the country where the patent was granted.

 **LIMITED MONOPOLY**

- The patent does **not grant the right to use** the invention!

PATENT = RIGHT TO FORBID, NOT TO EXPLOIT

- For **up to 20 years** from the date of filing of the patent application.
- Right to assign or transfer ownership of a patent and to conclude licensing contracts.
- **Presumption of validity** of a granted patent until it is challenged in a court.

C. What is an invention or not?

- The following subject-matter can be considered as an **invention**:
 - a product, e.g. a composition, a chemical formula, a device etc;
 - a process, e.g. process of manufacturing something, the use of a specific composition or device, a method for increasing sweetness etc;
 - provided that it **is new, involves an inventive step and is susceptible of industrial application**;
 - in "all fields of technology".

 **An invention is a technical solution to a technical problem.**

- Are not considered as **inventions as such**:
 - discoveries, scientific theories and mathematical methods ;
 - aesthetic creations;
 - schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
 - presentations of information.

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PATENTABILITY STUDY

A. PATENTABILITY STUDY

■ Why assessing the patentability of an “innovation”?

- To check if said “innovation” is patentable.

- 2 points need to be studied:

- a) is said innovation a real “invention” ? This means that we need to check if the innovation of interest is something that can be considered as an invention or not (meaning excluded from the scope of patentability).

- b) is said innovation patentable, i.e. answers to the patentability requirements ?



Patentability study request form that you can find on our Legal and IP Sharepoint

<http://mosscorp.emea.sesam.mane.com/LegalIP/IP/Patents%20studies/Forms/AllItems.aspx>

PATENTABILITY STUDY

INTERNAL ONLY

CONFIDENTIAL

PATENTABILITY STUDY REQUEST

FROM (name, Mane entity & department)	ISSUANCE DATE	DEADLINE REQUIRED (if urgent please indicate why)

Please attach the documents relating to the innovation decision making process by the ComInnov or the Scientific Committee on the project:

- ✓ Innovation project opening
- ✓ Project presentation to the Committee
- ✓ Extract from the minutes of the Committee

DETAILED DESCRIPTION OF THE INVENTION: A good patent search may indicate that a new product and/or process is/are unlikely to infringe third party patents, but no patent search is perfect or full proof. There is a practical limit to the time and money that can be spent on a search.

Please describe the invention, its applications. Please indicate the advantages of the invention compared with existing prior art. Do not hesitate to provide more explicit documents (drawings, presentation...).

KNOWN PRIOR ART: Preliminary searches: technical or marketing elements and data in relation with field are gathered by the person in charge of the innovative project. Scientific publications and patent documents searches are done by the documentalist, using key words which are outlined by the project leaders. The questions to be answered are mainly "is the invention novel", and "is the invention non-obvious in view of prior art".

Please indicate below the references of any relevant prior art document (publication, patent...).

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B. Studying the patentability of an invention


- Studying the patentability of an invention means checking in 3 steps that the **3 conditions of patentability** are respected:

- Step 1: **Novelty** / *anticipation (US terminology)*;
- Step 2: **Inventive step** / *non-obviousness*;
- Step 3: **Industrial application** / *utility*

- In order to do so, it is necessary to have:

- a complete and detailed description of the invention, and;
- the relevant prior art

C. Detailed description of the invention

<p>DETAILED DESCRIPTION OF THE INVENTION: A good patent search may indicate that a new product and/or process is/are unlikely to infringe third party patents, but no patent search is perfect or full proof. There is a practical limit to the time and money that can be spent on a search.</p> <p><i>Please describe the invention, its applications. Please indicate the advantages of the invention compared with existing prior art. Do not hesitate to provide more explicit documents (drawings, presentation...).</i></p>	
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- Please describe as detailed as possible the invention:
 - its intrinsic **characteristics**;
 - **the technical effects** of the invention. For example, for a new captive, its olfactive description; for a new device, its utilization; for a process, its advantages in terms of yield or implementation; for a composition comprising a specific compound, its particular effect etc.;
 - its **advantages** compared with the existing prior art;
 - the **aimed applications or uses** of the invention;
 - add drawings if necessary;
 - for a composition, please indicate **each components, their nature and their level of use** (or a range of use). Please indicate also their use/action in said composition.
- *Feel free to add any other important information according to you*

D. Known prior art (1/2)

KNOWN PRIOR ART: Preliminary searches: technical or marketing elements and data in relation with field are gathered by the person in charge of the innovative project. Scientific publications and patent documents searches are done by the documentalist, using key words which are outlined by the project leaders. The questions to be answered are mainly "is the invention novel", and "is the invention non-obvious in view of prior art".

Please indicate below the references of any relevant prior art document (publication, patent...).

- Please indicate the references of any type of relevant prior art document.
- These searches allow you to check roughly if your invention does not exist already.
- Also, these searches will allow you to have an idea of the technical environment around said invention.
- You can perform any kind of prior art search using keywords related to your invention (patent database, patent offices websites, Google, books, publications...).

D. Known prior art (2/2)

KNOWN PRIOR ART: Preliminary searches: technical or marketing elements and data in relation with field are gathered by the person in charge of the innovative project. Scientific publications and patent documents searches are done by the documentalist, using key words which are outlined by the project leaders. The questions to be answered are mainly "is the invention novel", and "is the invention non-obvious in view of prior art".

Please indicate below the references of any relevant prior art document (publication, patent...).

- By prior art or "state of the art", we mean everything made available to the public (written or oral description, by use, or in any other way) **before the filing date** of the patent application:
 - "Public", means that a disclosure to only one person is novelty destroying (when there is no confidentiality agreement);
 - "Made available", means that the public must have the capacity to understand the information, or the product, or when the analysis of the invention allows a specialist to identify its essential characteristics.
- For a prior art disclosure:
 - there is **no limitation in time and space**;
 - there is **no limitation concerning the way the disclosure has occurred**;

E. Assessing the patentability of an invention (1/5)

■ Step 1: studying novelty of an invention (1/2)

- The purpose of the novelty requirement is to prevent the prior art from being patented again.
- In Europe and in the main countries, an invention must be **new at the date of filing a patent application (absolute novelty)**. An invention shall be considered as "novel" if it **does not form part of the "state of the art"**.
- To this end, it is thus necessary to have a **complete and detailed description of the invention** of interest and an as possible **complete state of the art**.
 - Additional prior art searches are asked to our Documentalist, using additional specific keywords. Indeed, often, new relevant documents are identified.



E. Assessing the patentability of an invention (2/5)

■ Step 1: studying novelty of an invention (2/2)

- Each element of the invention, each technical effect identified previously by the inventor(s) is compared to the disclosure of the prior art document.
- If the invention **taken as a whole** is not found in **one and unique disclosure**, clearly and explicitly, thus said invention is novel.

■ In order to be **novelty destroying**, a prior art disclosure must be:

- **complete**, meaning that all the elements of an invention must be found completely in said prior art disclosure;
 - **sufficient**, meaning that said disclosure should allow the man skilled in the art reproducing the invention;
 - **certain and sure**, regarding its content, its date, its existence;
 - **taken as such**, meaning that the disclosure must not be implicit.
- If the invention is novel (and only if it is the case) it is possible to go to step 2, i.e. studying the inventiveness of said invention.

E. Assessing the patentability of an invention (3/5)

■ Step 2: studying the inventiveness of an invention (1/2)

- The purpose of the inventiveness (or obviousness) requirement is to be sure that with respect to the prior art, an invention would not be obvious for a person skilled in the art.
- The final purpose of this requirement is to prevent rewarding a third party with an exclusive right (a patent) for a straightforward modification of the existing prior art.
- Any novel invention must be inventive, i.e. it must:
 - **Bring a solution to a technical problem**
 - **Not be obvious for the man skilled in the art**
- For any invention, and thus for any technical domain, there is a specific man or person skilled in the art.

E. Assessing the patentability of an invention (4/5)

■ Step 2: studying the inventiveness of an invention (2/2)

- For assessing the inventiveness of an invention, **each technical effects** (as provided previously by the inventor(s)) is evaluated in view of the closest prior art document.
- A specific approach, which is different depending on the country, is followed. For example, in Europe, the approach is called “problem-solution approach” and consists mainly in:
 - Identifying the closest prior art;
 - Determining the objective technical problem to be solved by the invention, and;
 - Examining whether or not the claimed solution to said objective technical problem is obvious for the person skilled in the art.
- If the person skilled in the art **would** have been prompted to modify the closest prior art in such a way as to arrive at something falling within the terms of the claims, then the invention does not involve an inventive step.
- Finally, if the invention is novel and inventive, utility (step 3) can be evaluated.

E. Assessing the patentability of an invention (5/5)

■ Step 3: studying the utility of an invention

- An invention must be capable of industrial application (utility), i.e., it must be made or used in any type of industry.
 - This condition avoids patenting theories.
 - Most of the time, there is no utility issue in our technical domain.

F. Results of the patentability study

- After assessing the novelty, inventiveness and utility of an invention, it is possible to conclude that:
 - The invention is **novel and inventive**. In this case, a patent application can be filed (before or after having reviewed our freedom to operate) and could be considered, a priori, as “strong”.
 - The invention is **novel, but not inventive**. In this case, the advice is not to patent. Indeed, the inventive step (or obviousness) bar is quite high in Europe, in the U.S., or in Japan, and the risk is to disclose our innovation for “nothing”.
- **MANE patents strategy is to file only “strong” (a priori) patent applications for protecting inventions that will be commercialized.**

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FREEDOM TO OPERATE STUDY

A. FREEDOM TO OPERATE STUDY

- Why assessing our freedom to operate (FTO) for an invention/project ?
 - To check if a product, process, device, or use is not within the scope of a third party patent or application, i.e. if we are not infringing any patent or application.
 - What is particularly studied is **the claims scope** of the relevant patents and/or applications.



Freedom to operate study request form that you can find on our Legal and IP Sharepoint

<http://mosscorp.emea.sesam.mane.com/LegalIP/IP/Patents%20studies/Forms/AllItems.aspx>

FREEDOM TO OPERATE STUDY

INTERNAL ONLY

CONFIDENTIAL

FREEDOM TO OPERATE STUDY REQUEST

FROM (name, Main entity & department)	ISSUANCE DATE	DEADLINE REQUIRED (if urgent please indicate why)

Please attach the documents relating to the innovation decision making process by the ComInnov or the Scientific Committee on the project:

- ✓ Innovation project opening
- ✓ Project presentation to the Committee
- ✓ Extract from the minutes of the Committee

BRIEF DESCRIPTION OF THE PROJECT: The purpose of a FTO study is to ensure that the commercial production, marketing and use of a new product or process does not infringe third parties' intellectual property rights.

Please describe the project, the applications, its benefits compared to prior art if any, etc...

DETAILED DESCRIPTION OF THE PROJECT: A good patent search may indicate that a new product and/or process is/are unlikely to infringe third party patents, but no patent search is perfect or full proof. There is a practical limit to the time and money that can be spent on a search.

For example, **for a formulation, please detail all the main components, their percentage of use...** Please specify the planned use of the composition, device etc. Do not hesitate to provide more explicit documents

1 / 2

FREEDOM TO OPERATE STUDY

GEOGRAPHICAL SCOPE: Patent protection is territorial. In many cases, protection is sought in a company's main markets and left in the public domain in other countries where commercialization is less likely. In the latter countries, no permission (or license) will be needed from the patent owner to commercialize the product.

By default, the FTO will be conducted for the territories of Europe and USA. If the project concerns specific countries, or there is a need to cover any other countries, in addition to or instead of Europe & USA, please specify.

KNOWN PRIOR ART: Patents have limits of scope and limited duration. The most important part of a patent document is probably the claims. The claims determine the scope of the patent, and all aspects of an invention that are not covered by the claims are not considered to be patented. It is important to bear in mind that it is not always easy to determine the scope of a patent. Patent protection lasts for a maximum period of 20 years, provided the patent is "maintained" for the entire period by timely payment of maintenance fees to the patent offices. After the expiry of the term of protection, a patent is considered to be in the public domain and may be freely used by anyone.

Please indicate a list of the relevant prior art patent documents.

B. Studying the FTO of a particular invention/project

- Studying the FTO of an invention, or for a project means interpreting the claims of the previously identified relevant patents and/or applications.
 - if necessary, the interpretation is made in light of the description of said relevant patents and/or applications.
- In order to do so, it is necessary to have:
 - a brief and a more detailed description of the invention/project;
 - a geographical scope and;
 - the relevant prior art.

C. Brief and detailed description of the project

BRIEF DESCRIPTION OF THE PROJECT: The purpose of a FTO study is to ensure that the commercial production, marketing and use of a new product or process does not infringe third parties' intellectual property rights.
Please describe the project, the applications, its benefits compared to prior art if any, etc...



- Please describe as detailed as possible the project of interest:
 - its intrinsic **characteristics**;
 - **the technical effects** of the invention. For example, for a new captive, its olfactive description; for a new device, its utilization; for a process, its advantages in terms of yield or implementation; for a composition comprising a specific compound, its particular effect etc.;
 - its **advantages** compared with the existing prior art;
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 - add drawings if necessary;
 - for a composition, please indicate **each components, their nature and their level of use** (or a range of use). Please indicate also **their use/action** in said composition.
- *Feel free to add any other important information according to you*

D. Geographical scope

GEOGRAPHICAL SCOPE: Patent protection is territorial. In many cases, protection is sought in a company's main markets and left in the public domain in other countries where commercialization is less likely. In the latter countries, no permission (or license) will be needed from the patent owner to commercialize the product.

By default, the FTO will be conducted for the territories of Europe and USA. If the project concerns specific countries, or there is a need to cover any other countries, in addition to or instead of Europe & USA, please specify.

- It is necessary to provide an exact **list of countries of interest** for the invention/project. Must be considered:
 - the countries where the invention will be produced, or a process implemented and;
 - the countries where the invention will be commercialized.
- Indeed, it is important to bear in mind that the **patent protection is territorial**. Thus, an invention could be patented (and the patent being in force) in France but not in Italy for example.

E. Known prior art

KNOWN PRIOR ART: Patents have limits of scope and limited duration. The most important part of a patent document is probably the claims. The claims determine the scope of the patent, and all aspects of an invention that are not covered by the claims are not considered to be patented. It is important to bear in mind that it is not always easy to determine the scope of a patent. Patent protection lasts for a maximum period of 20 years, provided the patent is "maintained" for the entire period by timely payment of maintenance fees to the patent offices. After the expiry of the term of protection, a patent is considered to be in the public domain and may be freely used by anyone.

Please indicate a list of the relevant prior art patent documents.

- For a FTO study, **only the patents and/or patent applications, respectively in force or pending are considered.**
- Thus, when doing your prior art searches, please focus on patents and/or applications only! These type of prior art searches can be done by the inventor(s) and/or our Documentalist on patent office databases or Google Patent.
- Please indicate in the FTO study request form, the references of any relevant patents and/or applications document.

F. Assessing the FTO of an invention/project (1/2)

■ Step 1: a complementary prior art search

- Additional prior art searches are asked to our Documentalist in order not to avoid any relevant patent and/or application which could be relevant. Indeed, the keywords used in the case of a FTO study are most of the times different from the ones used when performing a “classic” prior art search.
- Indeed, a patent or application could be relevant while the keywords directed to the invention/project are not the same.



This is
my job!

■ Step 2: checking the status of the relevant patents and/or applications

- Only the patents in force, i.e. not abandoned, refused, revoked, and not in the public domain (i.e. having more than 20 years), and the pending patent applications, i.e. currently under examination, are taken into account and studied.
- Each status is verified country by country.

F. Assessing the FTO of an invention/project (2/2)

■ Step 3: studying the relevant patents and/or applications

- Only the claims are analyzed when assessing a FTO study, always country by country. For your information, claim 1 of a patent or application always has the larger scope. However, all independent claims are studied in order to check all the “objects” (product, use, method...) protected by said patent or application.
 - In case of lack of clarity for example, the claims could be interpreted in light of the description.
 - In the case of granted patents, it is often necessary to review the complete examination history which has conducted the patent application to be granted.
- It is important to keep in mind that **a definitive FTO opinion can be given only when considering granted patents**. When the relevant document is a **patent application**, **only a preliminary FTO opinion** can be given. Indeed, the definitive scope of protection of the claims of a patent application will be known only at the end of the examination process by the patent office.

G. Results of the FTO study

- After assessing the FTO of an invention/project, one can conclude that:
 - The invention/project is **free to operate** and that no patents and/or patent applications hamper our right to exploit said invention.
 - The invention/project is **not free to operate** :
 - Because of relevant patent applications. In this case, it could be interesting to monitor said applications and check regularly if said applications are refused, or abandoned. In this case, said applications would not be anymore a bar to our FTO.
 - Because of relevant granted patents. In this case, it could be also interesting to monitor said patents and check regularly if said patents are challenged by third parties (through an opposition for example), or abandoned. As soon as said patents are no more in force because of an abandonment, said patents would not be anymore a bar to our FTO.
- **MANE FTO policy is to always respect third party patents and patent applications. It is not useful to say that “*said patent or application does not look strong, or novel, or inventive...*” just in order to avoid a negative FTO opinion.**

Thanks !