



MODIANO & PARTNERS
European Patent and Trademark Attorneys

Patent Basic 1

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IP basics

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«Intellectual Property»

Intellectual property are intellectual intangible results of the creativity the human mind considered to be the property of its creator.

Intellectual property rights are normally recognized and protected under the corresponding fields of intellectual property law briefly by granting to owners exclusive rights.

Why do we have to care about I.P. ?

- protects important assets from theft, exploitation or abuse
- identifies contributions by the Company/University or inventors to the field
- secures monetary compensation for the Company/University (and sometimes the inventor)
- sometimes all a Company/ University has to leverage is it's IP
- Can create a «virtue circle» by which an inventor (or company) can pay back R&D efforts

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Other reason for protecting and using IPR

It is very difficult to license technology that is not protected.

Makes the technology available to the public and provides reward for the creator.

IP is a marketable commodity that can be used to leverage additional research dollars and income to support the inventors and the university, and help in the formation of new companies and jobs.

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Main IP rights

Trademarks

Patents

Utility Models

Industrial design rights

Trade secrets

Copyrights

Plant varieties

Supplementary protection certificates (*pharma*)

Database right

Mask works

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A distinction between IPR

Some IPR need an “*active*” action by the creator to be protected (TITLED RIGHTS):

Registered trademarks

Patents

Utility Models

Registered Industrial Designs

Plant Variety

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Some IPR does not need such an “active” action, and they born **together** with the creation (NON-TITLED RIGHTS):

Secret information (of technical and trade nature)

Geographical Indications

Non registered trademarks

Non registered Industrial Design (ie. EC)

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PRELIMINARY SUMMARY OF TITLED RIGHTS

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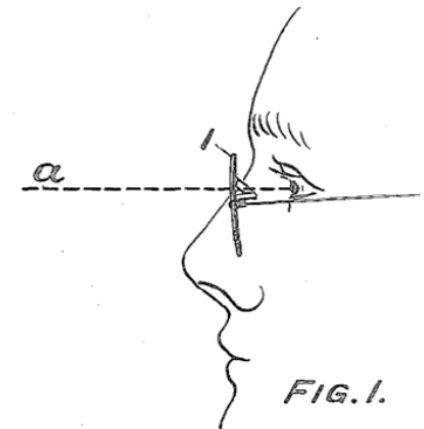
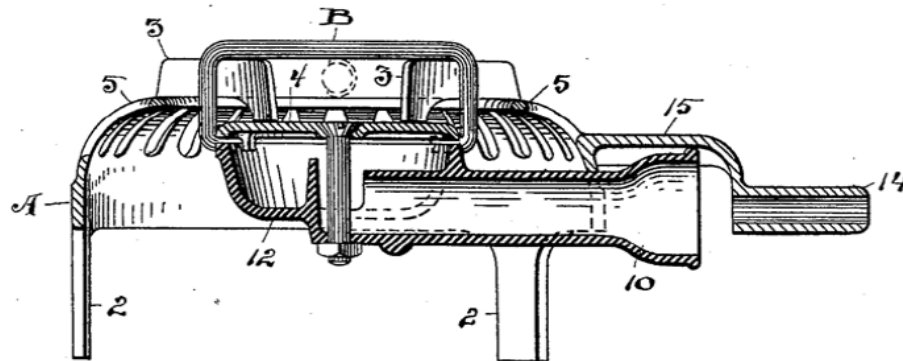
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Patents

Used for inventions, processes, machines, improvements, and composition of matter in the technological field.

Does not apply to scientific principles, methods of doing business or most naturally occurring articles.



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Definition: «Invention»

Source Wikipedia:

*An invention is a **unique or novel device, method, composition or process.***

*It may be an **improvement** upon a machine or product, or a **new process** for creating an object or a result.*

An invention that achieves a completely unique function or result may be a radical breakthrough.

*Such works are **novel and not obvious** to others skilled in the **same field.***

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Definition: «Invention»

Source: Dictionary.com

in·ven·tion: noun

1.

*the act of **inventing**.*

2.

U.S. Patent Law

*a **new, useful process, machine, improvement, etc.**, that did not exist previously and that is recognized as the **product of some unique intuition or genius, as distinguished from ordinary mechanical skill or craftsmanship.***

3.

*anything **invented** or **devised**.*

4.

*the power or faculty of **inventing, devising, or originating**.*

5.

*an act or instance of **creating** or **producing by exercise of the imagination, especially in art, music, etc.***

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EPC definition?

Art. 52(1) EPC

European patents shall be granted for any **inventions**, in **all fields of technology**, provided that they are **new**, **involve an inventive step** and **are susceptible of industrial application**.

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Note

There is a really close link in this definition to the definition of an “invention” and its requirements in the IP field.

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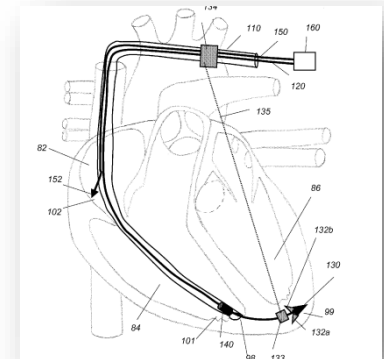
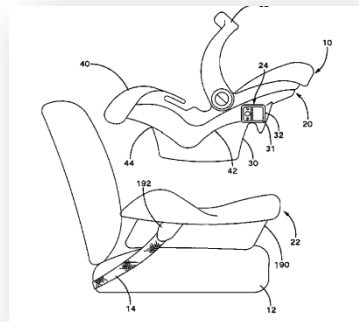
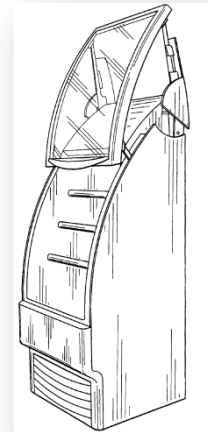
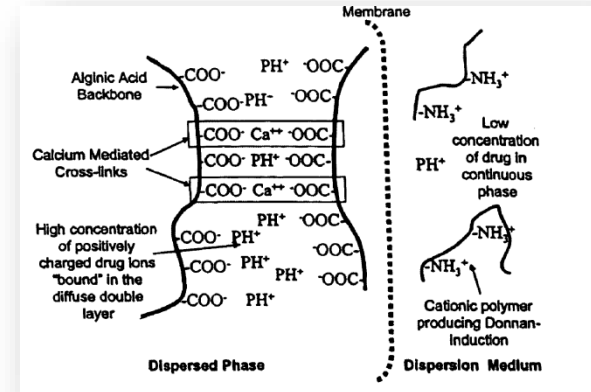
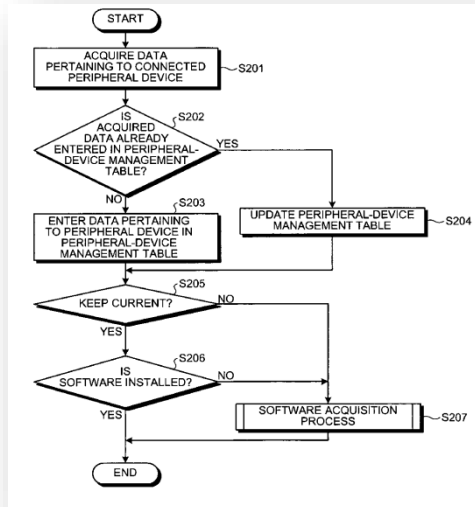
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Other examples



Trademarks

Generally speaking :
a sign (word, name, symbol, device) on a good or relating to a service.

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Definition: trademark

Source Wikipedia

*A trademark, trade mark, or trade-mark is a **distinctive sign or indicator** used by an individual, business organization, or other legal entity to **identify for consumers that the products or services on or with which the trademark appears originate from a unique source**, designated for a specific market, and to **distinguish its products or services from those of other entities.***

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Definition: trademark

Source OAMI Regulations:

*A Community trade mark may consist of any **signs capable of being represented graphically**, particularly words, including personal names, designs, letters, numerals, the **shape of goods** or of **their packaging**, provided that such signs are **capable of distinguishing the goods or services of one undertaking from those of other undertakings**.*

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Note

Again, there is a really close link definition of a “trademark” between common knowledge and in the IP field.

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Designs

An industrial design right is an intellectual property right that protects the visual design of objects that are not purely utilitarian.

Consists of the creation of a shape, configuration or composition of pattern or color, or combination of pattern and color and materials in three dimensional form containing aesthetic value. Can be a two- or three-dimensional pattern used to produce a product, industrial commodity or handicraft.

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Plant Variety Certification

Used for plants that reproduce sexually making it illegal to sell and propagate them commercially.

Development of a new plant cultivar or variety, either by "traditional" breeding methods or by "modern" molecular modification.

The breeder may seek to obtain exclusive marketing rights for the new variety.

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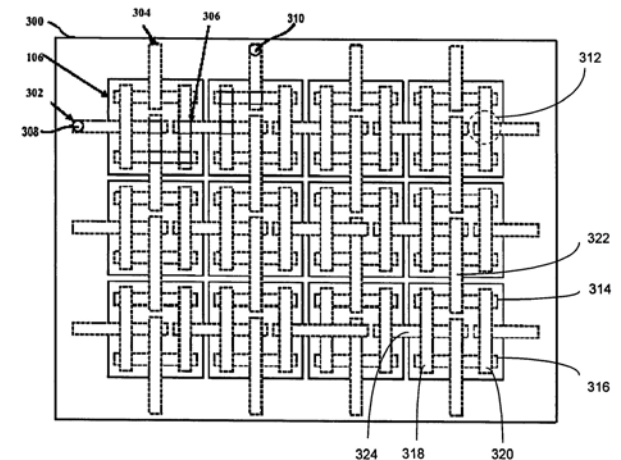
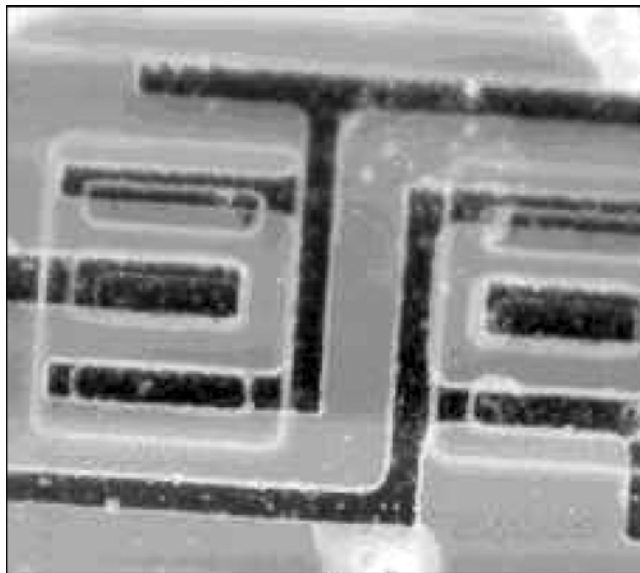
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Mask works

Layout designs (topographies) of integrated circuits.



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FOCUS ON PATENTS

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Patents

What is a Patent?

A right to **exclude** others from:
making,
using,
offering for sale,
selling
importing
the patented invention.

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Where?

Where the corresponding patent is in force

National protection in the Country in which the patent is in force

→ Filing strategy is fundamental to obtain protection

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How a patent is made?

Is a text, sometimes accompanied by drawings.

Main parts:

- Description
- Claims
- Drawings (if any)

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Invention

GOOD definition for IP purposes

«Technical Solution to a technical problem»

So called «*problem-solution approach*», *basic for EPO practice*

This solution *must* be advantageous?

NO, not necessarily...it can also be an alternative to known solutions

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Quid Pro Quo

sufficient (*enabling*) disclosure

VS

protection for 20 years from date of filing

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Patents inhibit free exchange of information!

Is it really true??

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in my opinion NO!

The patent laws require **disclosure** of the structure of the invention, how to make and use it and preferably the best mode of carrying out the invention.

Patent applications became **public** 18 months after filing.

An applicant is free to **disclose** the invention any time after the application is filed without jeopardizing patentability.

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Point to be stressed

A patent must not, in any event, be seen as an «authorization» to use, sell, produce, import the invention!

Other patents may exists!

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Invention

The EPC does **not** define what is meant by "invention", but Art. 52(2) contains a non-exhaustive list of things which are not regarded as inventions.

It will be noted that the items on this list are all either abstract (e.g. discoveries, scientific theories, etc.) and/or non technical (e.g. aesthetic creations or presentations of information).

In contrast to this, an "invention" within the meaning of Art. 52(1) must be of both a concrete and a technical character (see IV, 1.2(ii)). It may be in any field of technology.

Exclusion from patentability (EPO)

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Art. 52 EPC

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

- (a) **discoveries**, scientific theories and mathematical methods;
- (b) **aesthetic** creations;
- (c) schemes, rules and methods for performing mental acts, playing **games** or **doing business**, and **programs for computers**;
- (d) presentations of information.

(3) Paragraph 2 shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities **as such**.

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Programs for computers

Programs for computers are a form of "computer-implemented invention", an expression intended to cover claims which involve computers, computer networks or other programmable apparatus whereby prima facie one or more of the features of the claimed invention are realized by means of a program or programs.

Such claims may e.g. take the form of a method of operating said apparatus, the apparatus set up to execute the method, or, following T 1173/97 (OJ 10/1999, 609), the program itself.

Insofar as the scheme for examination is concerned, **no distinctions are made on the basis of the overall purpose of the invention, i.e. whether it is intended to fill a business niche, to provide some new entertainment, etc.**

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Programs for computers

The basic patentability considerations in respect of claims for computer programs are in principle the same as for other subject-matter.

While "programs for computers" are included among the items listed in Art. 52(2), **if the claimed subject-matter has a technical character it is not excluded from patentability** by the provisions of Art. 52(2) and (3).

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Programs for computers: further technical effect

A **further technical** effect which lends technical character to a computer program **may be found e.g. in the control of an industrial process** or in **processing data which represent physical entities** or in the **internal functioning of the computer itself** or its interfaces under the influence of the program and could, for example, affect the efficiency or security of a process, the management of computer resources required or the rate of data transfer in a communication link. **As a consequence, a computer program may be considered as an invention within the meaning of Art. 52(1) if the program has the potential to bring about, when running on a computer, a further technical effect** which goes beyond the normal physical interactions between the program and the computer.

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KIND OF PATENTS

NATIONAL (IT, DE, US, RU etc)

REGIONAL (EPO, ARIPO etc)

INTERNATIONAL (PCT: Patent Cooperation Treaty)

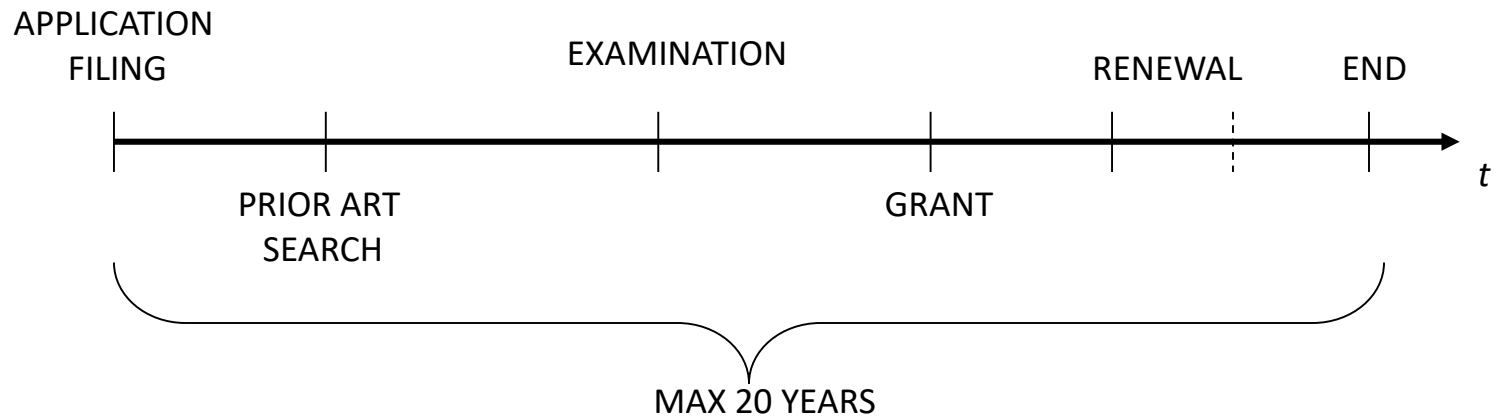
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Requirements

Art. 52EPC Patentable inventions

European patents shall be granted for any inventions, in all fields of technology, provided that they are

new,

involve an inventive step and are

susceptible of industrial application.

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NOVELTY

NOVELTY

Art. 54(1) EPC

An invention is considered to be **new** if it does not form part of the **state of the art**.

...

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INVENTIVE STEP

INVENTIVE STEP: ART.56EPC

An invention is considered as involving an inventive step if, having regard to the **state of the art**, it is not obvious to a person skilled in the art.

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State of the art

Art. 54(2) EPC

The state of the art shall be held to comprise **everything made available to the public** by means of a **written** or **oral** description, by **use**, or in **any other way**, before the date of filing of the European patent application.

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State of the art

The width of this definition should be noted.

There are **no restrictions** whatever as to the **geographical location** where or

the **language** or

manner in which the relevant information was made available to the public;

also **no age limit** is stipulated for the documents or other sources of the information.

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State of the art

A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was **no bar of confidentiality** restricting the use or dissemination of such knowledge.

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Enabling disclosures

Subject-matter can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1), **if the information given to the skilled person is sufficient to enable him, at the relevant date (see IV, 9.3), to practise the technical teaching which is the subject of the disclosure**, taking into account also the general knowledge at that time in the field to be expected of him.

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Self anticipation

Own applicant disclosure is considered (when available to the public) state of the art.

So, file a patent application BEFORE your disclosure.

Only few Countries allows a «grace period» for the inventor.

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Exercise

Company A find a new umbrella.

Company A produces those umbrellas, and put them on the market.

Afterwards company A file a patent application.

Any problem seen?

What, if company B wish to file a patent?

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NOVELTY

An invention is considered to be new if it does not form part of the state of the art.

It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together.

It is also not permissible to combine **separate items belonging to different embodiments described in one and the same document**, unless such combination has specifically been suggested.

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INVENTIVE STEP

An invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

Novelty and inventive step are different criteria.

The question – "is there inventive step?" – only arises if the invention is novel.

INVENTIVE STEP: the «person skilled in the art»

The "person skilled in the art" should be presumed to be a **skilled practitioner in the relevant field**, who is possessed of **average knowledge** and **ability** and is **aware of what was common general knowledge in the art** at the relevant date.

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INVENTIVE STEP: obviousness

The question to consider is whether before the filing or priority date valid for a claim, having regard to the art known at the time, it would have been **obvious to the person skilled in the art to arrive at something falling within the terms of the claim.**

If so, the claim is not allowable for lack of inventive step.

The term "**obvious**" means that **which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art,**

i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.

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INVENTIVE STEP: problem&solution approach

In the problem-and-solution approach, there are three main stages:

- (i) determining the "closest prior art",
- (ii) establishing the "objective technical problem" to be solved, and
- (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

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PRIORITY

It is possible to **claim the priority of the first, prior patent application filed in one of the member states of the Paris Convention within 12 months running from the date of that first application.**

More than one priority is permitted.

A first application for a patent may be the basis for a priority claim when subsequent applications are filed for the same invention in other states party to the Paris Convention.

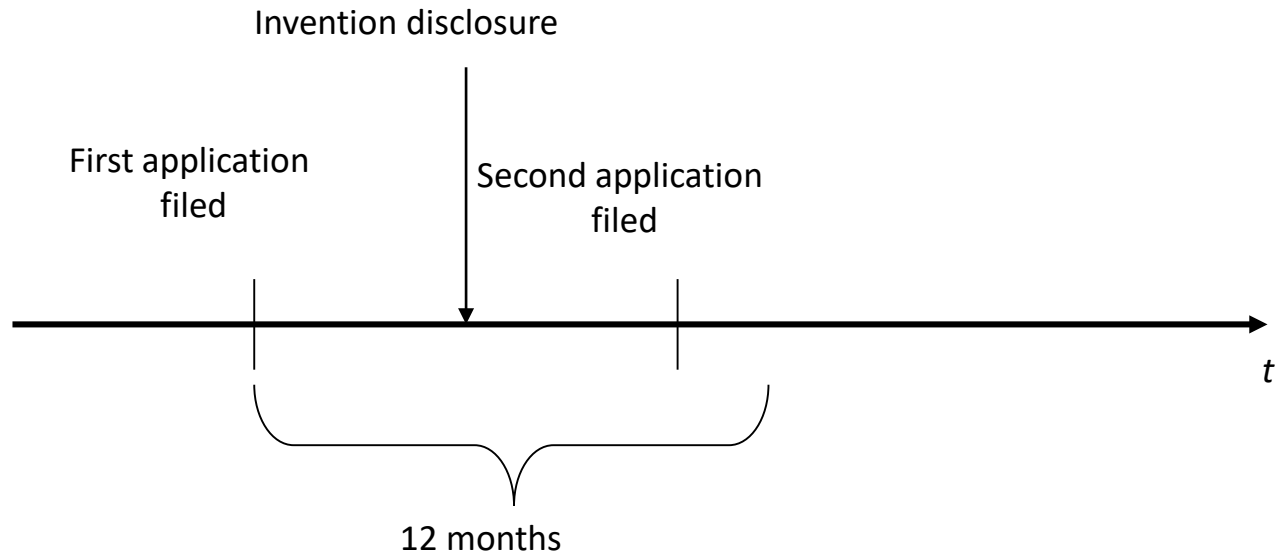
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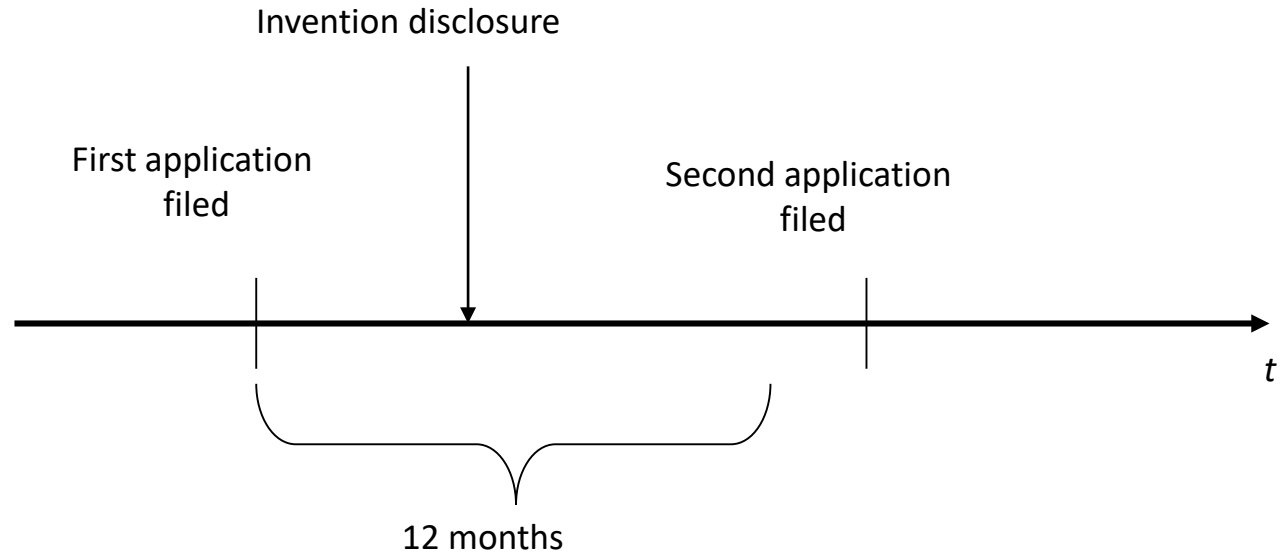
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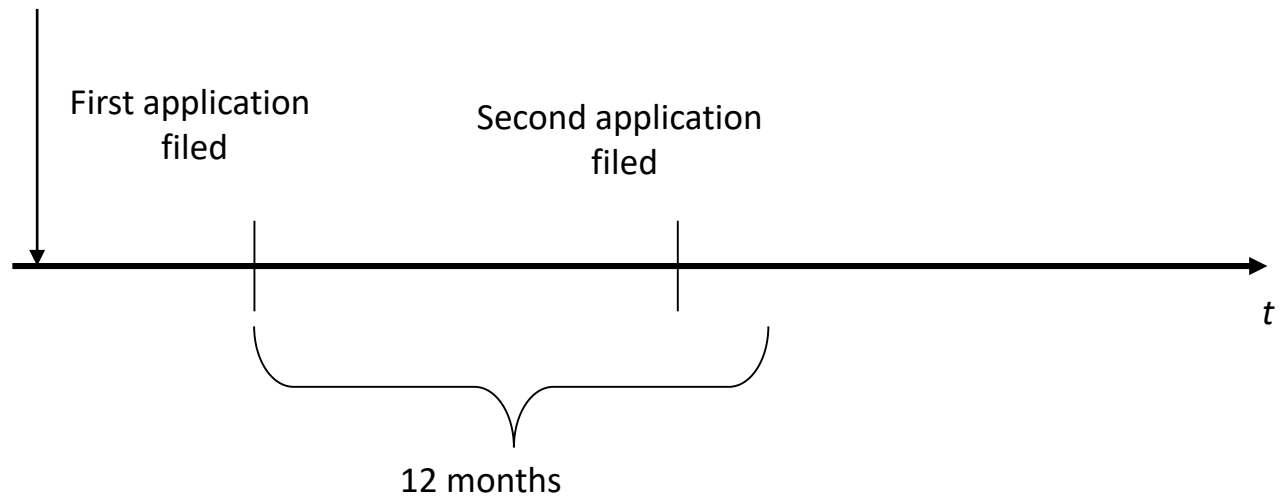
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EX. 3

Invention disclosure



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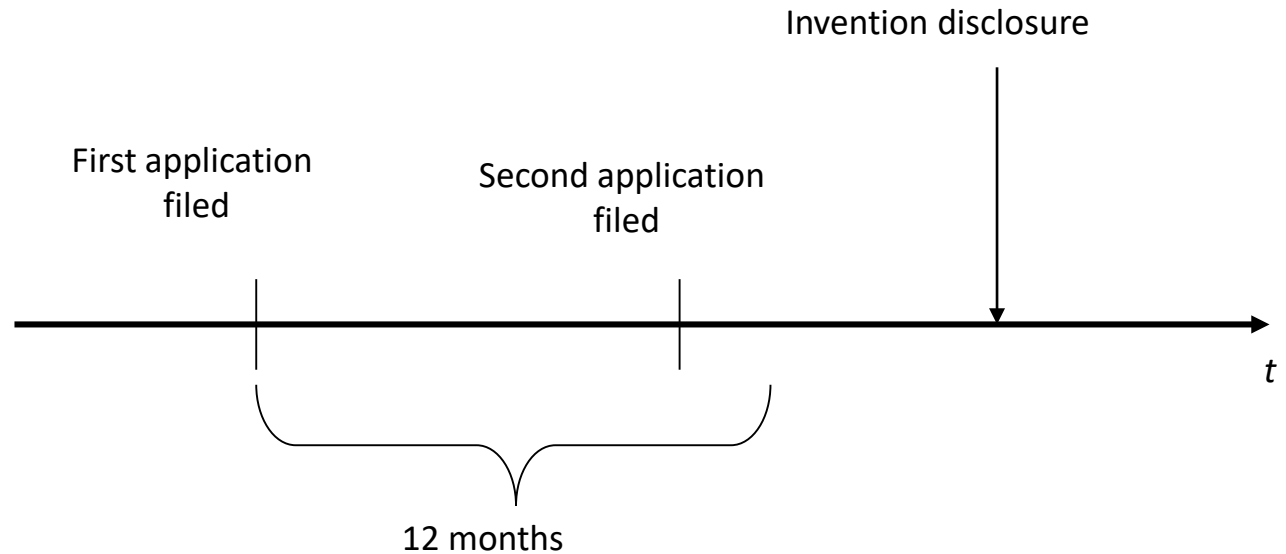
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