



MODIANO & PARTNERS
European Patent and Trademark Attorneys

Patent basic 3

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October 9, 2018

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preliminary risk evaluation

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independent claim of the patent divided by features	your product features
FEATURE 1	Y/N
FEATURE 2	Y/N
FEATURE 3	Y/N
FEATURE 4	Y/N

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claim 1

a vehicle comprising a first wheel, a frame and a seat and a couple of pedals coupled to the wheel for propelling the vehicle

drawing of the patent



your product



risk?

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independent claim of the patent divided by features	your product features
a <u>vehicle</u> comprising a	YES
a <u>first wheel</u> ,	YES
a <u>frame</u>	YES
and a <u>seat</u>	YES
a <u>couple of pedals</u>	YES
<u>coupled</u> to the wheel for propelling the vehicle	YES



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claim 1

a vehicle comprising two wheel, a frame and a seat and a couple of pedals coupled to one wheel for propelling the vehicle

drawing of the patent



your product



risk?

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independent claim of the patent divided by features	your product features
a <u>vehicle</u> comprising a	YES
a <u>two wheel</u> ,	<u>NO</u>
a <u>frame</u>	YES
and a <u>seat</u>	YES
a <u>couple of pedals</u>	YES
<u>coupled to one wheel for propelling the vehicle</u>	YES



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claim 1

a vehicle consisting in a first wheel, a frame and a seat and a couple of pedals coupled to the wheel for propelling the vehicle

drawing of the patent



risk?

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independent claim of the patent divided by features	your product features
a <u>vehicle</u> consisting a	YES
a <u>first wheel</u> ,	NO
a <u>frame</u>	YES
and a <u>seat</u>	YES
a <u>couple of pedals</u>	YES
<u>coupled</u> to the wheel for propelling the vehicle	YES

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PATENT SEARCH

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FREE of charge engines:***ESPACENET (by EPO)***

<https://worldwide.espacenet.com>

PATENT SCOPE (by WIPO)

<https://patentscope.wipo.int/search/en/search.jsf>

GOOGLE PATENTS (by Google)

<https://patents.google.com/>

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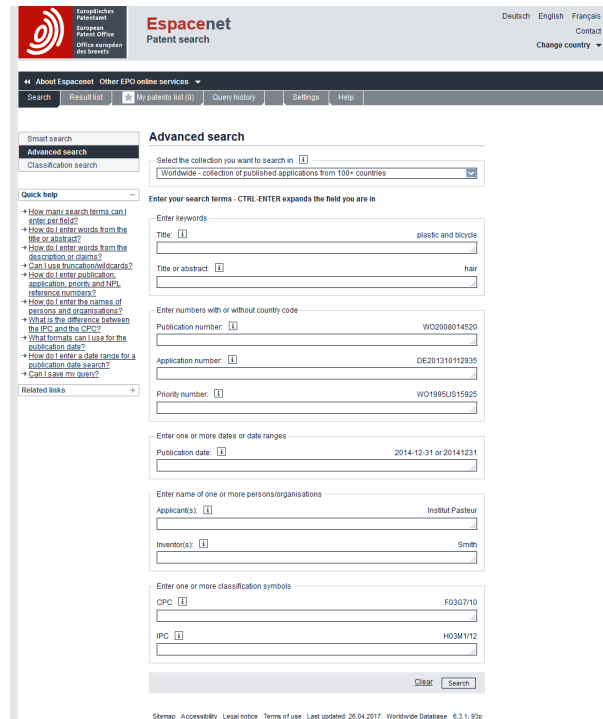
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ESPACENET (by EPO)

<https://worldwide.espacenet.com>

TIP: always use «advanced» search



The screenshot shows the Espacenet Patent search interface. The top navigation bar includes the Espacenet logo, language options (Deutsch, English, Français), and a 'Change country' dropdown. Below the navigation bar, there are tabs for 'Search', 'Request', 'My patents list (0)', 'Query history', 'Settings', and 'Help'. The main content area is divided into 'Smart search' and 'Advanced search' sections. The 'Advanced search' section is active and contains several input fields for search criteria:

- Collection:** A dropdown menu set to 'Worldwide - collection of published applications from 100+ countries'.
- Enter your search terms - CTRL ENTER expands the field you are in:**
 - Title:** Input field containing 'plastic and bicycle'.
 - Title or abstract:** Input field containing 'hair'.
- Enter numbers with or without country code:**
 - Publication number:** Input field containing 'WO2008014520'.
 - Application number:** Input field containing 'DE20131012935'.
 - Priority number:** Input field containing 'WO1995US15925'.
- Enter one or more dates or date ranges:**
 - Publication date:** Input field containing '2014-12-31 or 20141231'.
- Enter name of one or more persons/organisations:**
 - Applicant(s):** Input field containing 'Institut Pasteur'.
 - Inventor(s):** Input field containing 'Smith'.
- Enter one or more classification symbols:**
 - CPC:** Input field containing 'F03G7/10'.
 - IPC:** Input field containing 'H03M1/12'.

At the bottom of the form, there are 'Clear' and 'Search' buttons. The footer of the page contains links for 'Sitemap', 'Accessibility', 'Legal notice', and 'Terms of Use', along with the text 'Last updated: 26.04.2017' and 'Worldwide Database: 6.3.1.956'.

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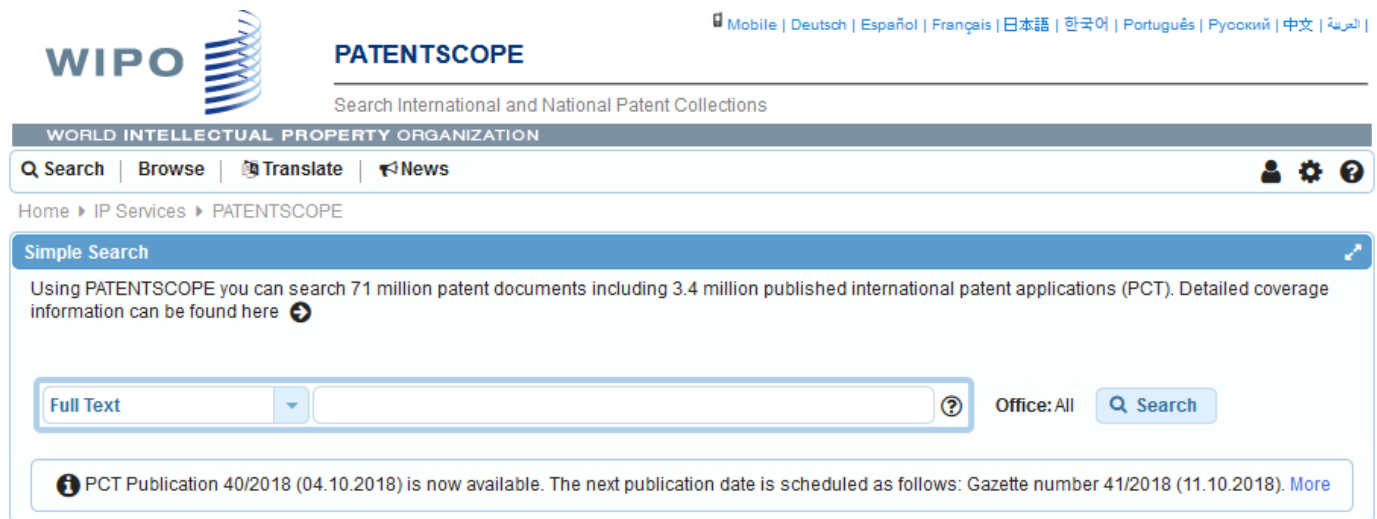
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PATENT SCOPE (by WIPO)

<https://patentscope.wipo.int/search/en/search.jsf>

TIP: *always use «advanced» search*



The screenshot shows the WIPO PATENTSCOPE website. At the top, there is the WIPO logo and the text "PATENTSCOPE" with the tagline "Search International and National Patent Collections". A navigation bar includes "WORLD INTELLECTUAL PROPERTY ORGANIZATION" and links for "Search", "Browse", "Translate", and "News". The main content area is titled "Simple Search" and contains a search box with a dropdown menu set to "Full Text" and a "Search" button. A notification at the bottom states: "PCT Publication 40/2018 (04.10.2018) is now available. The next publication date is scheduled as follows: Gazette number 41/2018 (11.10.2018). More".

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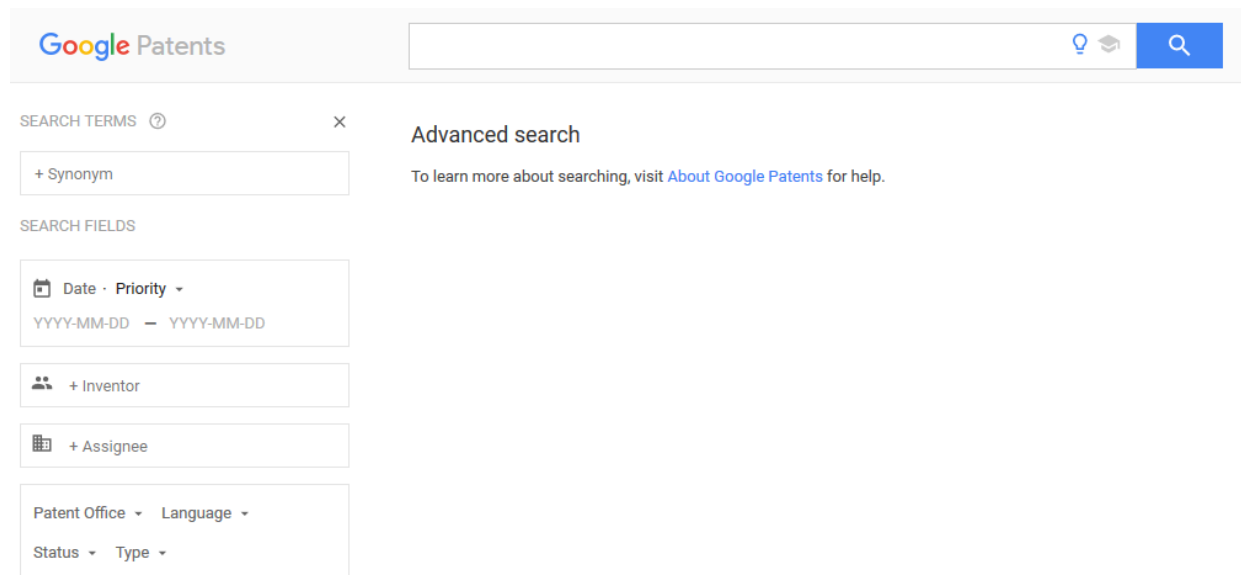
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GOOGLE PATENTS (by Google)

<https://patents.google.com/>

TIP: always use «advanced» search

<https://patents.google.com/advanced>



The screenshot shows the Google Patents advanced search interface. At the top, there is a search bar with the Google Patents logo on the left and a search icon on the right. Below the search bar, the page is divided into two main sections: "SEARCH TERMS" and "Advanced search".

SEARCH TERMS (with a close icon 'x') contains a text input field with the placeholder "+ Synonym".

SEARCH FIELDS section includes several filter options:

- Date · Priority** (with a calendar icon): A date range selector showing "YYYY-MM-DD - YYYY-MM-DD".
- + Inventor** (with a person icon): A text input field.
- + Assignee** (with a grid icon): A text input field.
- Patent Office** and **Language**: Dropdown menus.
- Status** and **Type**: Dropdown menus.

On the right side, under **Advanced search**, there is a link: "To learn more about searching, visit [About Google Patents](#) for help."

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Different searches for:

- prior art assessment

- infringement analysis

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Searches for prior art assessment

Main **Objective**:

find closest prior art documents so as to evaluate
novelty and
inventive step of the invention

SCOPE

evaluate PATENTABILITY of the invention.

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Searches for prior art assessment

requirements recap

1. novelty
2. inventive step

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Searches for prior art assessment

When:

no age limit, search must cover all published documents

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Searches for prior art assessment

where to search:
virtually, everywhere.

Patents databases, scientific databases, web, seminars
publication, scientific books etc etc.

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Searches for prior art assessment

searching in Patents databases, why?

- patent examiner will look extensively in those databases
- useful source of up-to-date info

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Searches for prior art assessment

searching in Patents databases, what document to care mainly about:

- published patent applications

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Searches for prior art assessment

searching in Patents document: which part to care mainly about:

- description

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Searches for prior art assessment

searching in Patents databases, by means of:

1. free searching tools
2. commercial tools

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Searches for prior art assessment

main search criteria:

- **keywords (with boolean op.)**
- **applicant/inventor names**
 - **classification**
 - **cited/citing doc.**
- **“concepts” (when enabled)**

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Searches for prior art assessment

**searching only by keywords:
- difficult,
- limiting or too broad list of results**

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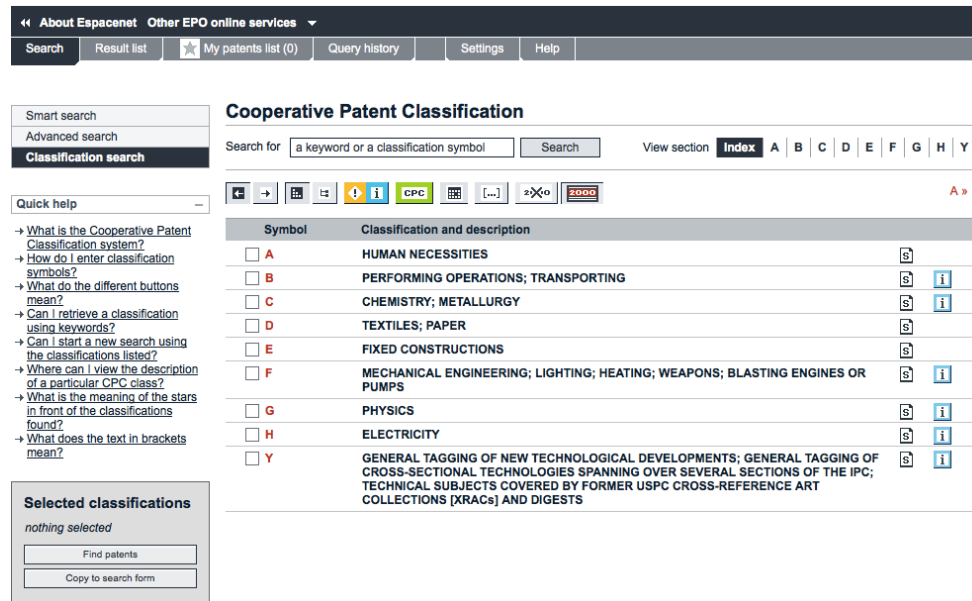
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Searches for prior art assessment

searching in Patents databases ESPACENET “classification search”



The screenshot shows the Espacenet Cooperative Patent Classification (CPC) search interface. At the top, there are navigation links: "About Espacenet", "Other EPO online services", "Search", "Result list", "My patents list (0)", "Query history", "Settings", and "Help". Below this is a search bar with the text "a keyword or a classification symbol" and a "Search" button. To the right of the search bar are tabs for "View section" and "Index", with "Index" selected. Below the search bar are several icons for navigation and search options, including "CPC" and "ZOOM".

The main content area is titled "Cooperative Patent Classification" and displays a list of classification symbols and their descriptions. The list is as follows:

Symbol	Classification and description	Search	Info
<input type="checkbox"/> A	HUMAN NECESSITIES	S	
<input type="checkbox"/> B	PERFORMING OPERATIONS; TRANSPORTING	S	i
<input type="checkbox"/> C	CHEMISTRY; METALLURGY	S	i
<input type="checkbox"/> D	TEXTILES; PAPER	S	
<input type="checkbox"/> E	FIXED CONSTRUCTIONS	S	
<input type="checkbox"/> F	MECHANICAL ENGINEERING; LIGHTING; HEATING; WEAPONS; BLASTING ENGINES OR PUMPS	S	i
<input type="checkbox"/> G	PHYSICS	S	i
<input type="checkbox"/> H	ELECTRICITY	S	i
<input type="checkbox"/> Y	GENERAL TAGGING OF NEW TECHNOLOGICAL DEVELOPMENTS; GENERAL TAGGING OF CROSS-SECTIONAL TECHNOLOGIES SPANNING OVER SEVERAL SECTIONS OF THE IPC; TECHNICAL SUBJECTS COVERED BY FORMER USPC CROSS-REFERENCE ART COLLECTIONS [XRACS] AND DIGESTS	S	i

At the bottom left of the interface, there is a "Selected classifications" section with the text "nothing selected" and two buttons: "Find patents" and "Copy to search form".

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Searches for prior art assessment

**searching for concepts is not available in the search engine,
you can try by the operator “near” or “within” and combination
of keywords for defining the concept (beware of synonyms)**

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Searches for prior art assessment

define strategy —>
use search engine —>
feedback —>
update strategy —>

repeat

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Searches for prior art assessment

STRATEGY 1st step

1. try to write down essential features of the invention
2. find synonyms
3. find different wordings for expressing the same concept

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Searches for prior art assessment

feedback and hints

- > too many results: try restricting by classification
- > once found a relevant document, look at its classification and if necessary upgrade strategy
- > once found a relevant document, look at its keywords or wording and if necessary upgrade strategy
- trace repeating competitor/inventor names, try a name search for completing the task
- when found an interesting doc, use citing/cited function to explore very neighboring doc already found by examiner/applicant

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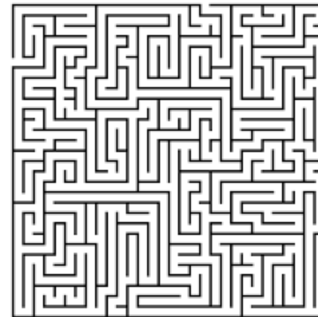
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Searches for prior art assessment

**remember:
millions of patents**



too many results = no results

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Searches for prior art assessment

usually, a well performed search would show up to 5 to 10 documents of particular relevance.

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Searches for prior art assessment different approaches



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Searches for infringement analysis

**Main Objective:
find existing patents so as to evaluate
if infringement risks are present**

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Searches for infringement analysis

When:

- limit the search to “alive” patents or patents application
- limit the search to “relevant” countries (marketing, production site etc)

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Searches for infringement analysis

**where to search:
Patents databases**

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Searches for infringement analysis

how to search:

**free tools are generally not well suited for this task, but
can help in a first preliminary search**

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Searches for infringement analysis

beware of the “family” and the certainty of the “legal status”

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Searches for infringement analysis

**beware of the patent application:
scope of protection can change in certain cases**

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Searches for infringement analysis

beware of the grace period for paying renewal fees or completing omitted acts: sometimes a safety windows can be still opened, so what seems to be “dead” can be revived.

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Searches for infringement analysis

beware of divisional applications deriving from one parent application, seeking protection for independent features of the invention, described in the description

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Searches for infringement analysis

searching in Patents document: which part to care mainly about:

- claims

- description (search for independent features)

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Searches for infringement analysis

understand clearly the product/process of the invention

**define strategy —>
use search engine —>
feedback —>
update strategy —>**

repeat)

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Searches for infringement analysis

STRATEGY 1st step

- 1. try to write down essential features of the product/process**
- 2. find synonyms**
- 3. find different wordings for expressing the same concept**

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Searches for infringement analysis

once found a relevant document, look at the independent claims and try to read the product/process in those; if every feature of the product/process can be seen in the independent claim then a risk could be present

->

a patent professional “freedom to operate” opinion should be requested, an infringement risk must be analyzed.

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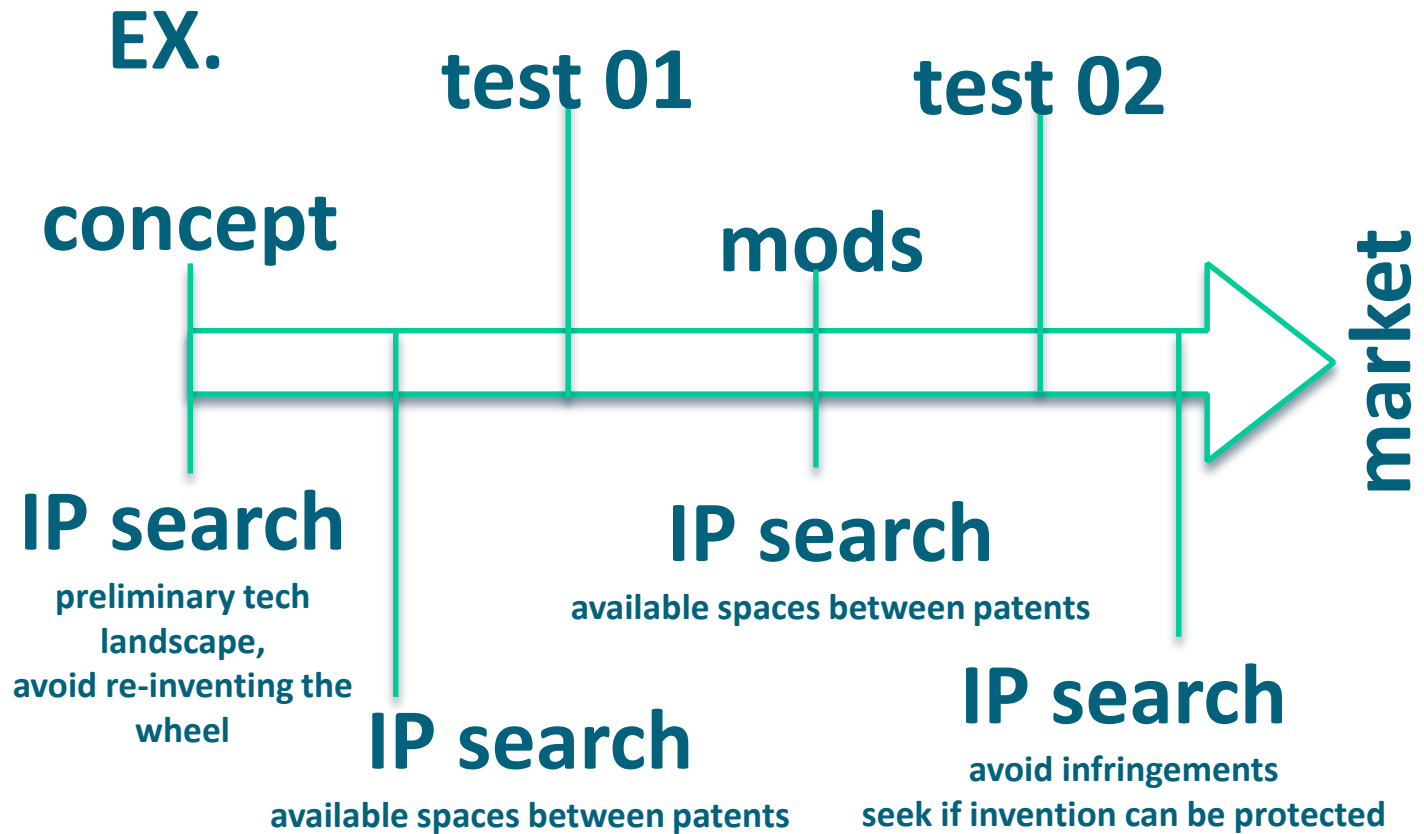
For a new product development process

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Concept analysis -> invention identification:

- **Re-write the *idea* in terms of its *features*;**
- **Delete non technical features and advantages;**
- **Analyse if it does not pertain to an *exclusion* from patentability or an *exception*;**

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Invention check over existing IP documents:

- Perform a *prior art search* using keywords;
- Use the prior documents found to assess patentability requirements (novelty, inventive step);
- Perform a *freedom to operate* search;
- Perform a preliminary risk evaluation with respect to existing «alive» patents;

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Last step:

A) If the invention seems to be patentable AND if it does not seem to infringe existing patents

-> draft an IP strategy (what can be patented, filing strategy)

B) If the invention seems to be anticipated AND if it does not seem to infringe existing patents

-> consider other way to protect IP (Secrets? Trademarks? Designs?)

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OR

C) If the invention seems to be anticipated AND if it does seem to infringe existing patents

-> step back to the original idea and perform a «*design around*» in order -at least- to avoid infringement

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Free patent search engines

deeper knowledge

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ex. 01

try a patentability search keywords for your invention (pedal assisted cycle)



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ex. 02

concentrate on the position of the motor (front wheel)

try a patentability search for discovering if the position can be patented

front?

rear?

central?

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EX. 03

IDEA

a wearable ballon that, during immersions underwater, inflates under command, so as to bring the user on the surface in a very short time and avoiding to swim to that extent.

What is needed for going on the market?