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Protection by French Patent Law

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A. What is protected?

Patent Law protects a new invention involving an inventive step and susceptible of industrial application.

a) Invention

An invention is a product or a process.

Are not patentable inventions :

- discoveries, scientific theories, mathematical methods,
- esthetic creations (the creations can be protected by Copyright Law or Design Law),
- Schemes, rules and methods for performing intellectual activities, playing games or doing business,
- Software,

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- Presentations of information

However when these inventions include a practical application or a technical finding, they may patentable together.

b) Novelty

To be patentable, inventions has to be new and not already disclosed in the « prior art ».

The « prior art » encompasses information made available to the public in writing or orally, by use or any other way, before the filling date of the patent application, including French patent applications and European or International patent applications valid in France, which were filed before and published after the filing date of the patent application considered.

An invention lacks of novelty when all the elements claimed can be found in a single "prior art" reference.

The anticipation can result from events performed by the inventor himself. For this reason, the inventors have to keep secret theirs inventions by means of confidential agreements or confidential notices.

However if the disclosure of the invention is due to a fraud on the inventor (as a breach of the confidential agreement), the disclosure shall not be taken into account when it occurred within the six months preceding the filing of the patent application or when the disclosure is the result of the publication, after the filing date, of a patent previously filed.

c) Inventive step

To be patentable the invention must not have been obvious to the "man of the art".

The "man of the art" is a professional skilled in the technology field of the invention.

The invention is deemed obvious when all the claimed element of the invention can be found in a combination of different "prior art" references.

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Even if an invention is deemed "new" because none of "prior art" reference disclose all the claimed elements of the invention, the invention can still be considered obvious based on a combination of "prior art" references.

The "prior art" is the same "prior art" used for the novelty requirement except that it does not include patent applications filed before and published after the filing date of the patent application considered.

The determination of obviousness is often subjective and raises important litigation.

d) Industrial application

An invention has an industrial application if it can be made or used in any kind of industry, including agriculture.

B. **Who is the owner of the patent?**

The industrial property right belongs to the inventor. The applicant is deemed to be entitled to be the owner of the patent.

However it is only a presumption and the inventor who has not filed his invention can sue the applicant to take his place.

The inventions' ownership of employees or civil servant is subject to a specific regulation.

C. **How to obtain a patent in France?**

a) Filing a patent application in the French intellectual property office, the "Institut National de la Propriété Industrielle » (INPI)

The patentability study of the invention by the "Institut National de la Propriété Industrielle » (INPI) is limited. The INPI produces a "prior art" search. Only an obvious lack of novelty can prevent the patent application from being granted.

The validity of a granted patent can be contested before a judge. An infringement action is dismissed when based on an invalidated patent.

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For this reason the applicant is strongly recommended to conduct a patentability search before filing a patent application with the INPI.

It costs 36 Euros per claim for 10 claims and 40 Euros per claim up to 10 claims. The mandatory patentability search costs 500 Euros. An issuance fee of 86 Euros is due at the grant stage*.

b) Evidence of the invention

The patent application is an evidence of the invention. Other means exist to date an invention. The description of the invention can be filed in the INPI in an envelope called "enveloppe Soleau », in a notary office, or in a copyright licensing organization to date the invention and keep it secret. However these filings don't provide any intellectual property right in the invention.

D. **What are Patents rights?**

a) Term of the protection

The term of the protection is 20 years from the date on which the patent application was filed.

The publication of the patent application makes the invention available to the public. However the invention belongs to the public domain upon termination of the protection only.

b) Rights deriving from patents

The owner has a right to exclude others from making, using, offering for sale or importing the patented invention in or into France.

He is entitled to sue the counterfeiters infringing his rights.

A particular action exists to obtain a provisional order from the judge to stop suspected acts before the judge takes a definitive order concerning the infringement case.

c) Transfer of ownership of the patent

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The rights deriving from a patent application or a patent may be assignable in whole or in part. The patent owner can also grant an exclusive or non-exclusive license agreement concerning the patent.

After three years from the grant of the patent or four years from the filing date of the patent application, any person or any company may be granted a compulsory license of the patent if the owner did not commercialize his patent.

Protection in a foreign country (Example of the American patent)

A. Why to extend the protection abroad?

a) Territoriality

The patent is enforceable within the country in which a patent application was filed. For this reason a patent application has to be filed in all the countries in which a protection of the invention is sought.

b) Priority Date

1. International priority

The applicant of a patent application filed in a contracting party of the Paris Convention for the Protection of Industrial property or the World Trade Organization (WIPO), can extend the protection of the patent in a contracting party, within 12 months from the first filing, claiming the priority of the date of the first filing (the "priority date").

The disclosure of his invention and the patents filed after the "priority date" won't be considered as part of the "prior art" for the study of the patentability of the invention. During 12 months from the "priority date", the same invention can not be patented by someone else than the recipient of the "priority date".

2. Domestic priority

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If an inventor files successively two French patent applications within a period of 12 months, the applicant may request that the second application get the filing date of the first application for the elements common to both applications.

B. How to extend the protection abroad?

1. Filing national patent applications (example of the American patent application)

Patent applications can be filed at the same time in all of the countries in which the protection of an invention is sought.

The conditions of patentability and the patent prosecution differ between the countries. Thus, a patent application covering the same invention can be granted in a country and rejected in another.

Concerning the patent prosecution in the United-States, a patent application has to be filed in the United States Patent and Trademark Office (USPTO) and the patent is generally issued for 20 years from the date on which the application was filed.

As the European Patent Office (EPO), an Examiner of the United States Patent and Trademark Office (USPTO) does a substantive "prior art" search and reviews the application for patentability and compliance with various other requirements. If the Examiner deems the application defective or believes the invention to be unpatentable, the Examiner sends an Office Action to the applicant. The applicant can then respond by arguing that the Examiner is incorrect or he can amend the claims to address the merits of the Office Action.

The American patent prosecution is a long and expensive process and it is recommended to conduct a patentability search before filing a patent application with the United States Patent and Trademark Office (USPTO).

The United States Patent and Trademark Office (USPTO), is the only office to be based on a first-to-invent system, meaning that a patent is granted to the person who first conceived and practiced the invention, rather than to the person who first filed the invention with authorities as in France.

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Unlike the French Patent Law which requires an absolute novelty, the inventor is given a "grace period" of 12 months from the first non-confidential public disclosure, non-experimental use or offering for sale or sale of the invention by the inventor himself or by someone else. The applicant can still apply for the invention within this period without losing his patent right.

A « provisional patent application » can be filed in the United States Patent and Trademark Office (USPTO) to establish an effective filing date. Provisional patent applications cost less than utility patent application and are not examined on their merits. Within one year from the filing date of a provisional application, a utility patent application claiming the priority of the provisional application can be filed. The patent term of the granted patent claiming benefit of the filing date of the provisional application can up to 21 years from the provisional application filing date. An applicant can choose to file a provisional application to lower the initial investment and to assess the invention's commercial potential before committing higher cost for the protection of his invention.

Various international treaties provide mechanisms for facilitating a patent prosecution if the protection is sought in several countries.

1. European Patent application

The European Patent Convention provides a mechanism for simultaneously pursuing protection in countries members of the European Patent Organization (EPO). The organization has currently 36 members comprising all the member states of the European Union together with Croatia, the Former Yugoslav Republic of Macedonia, Iceland, Liechtenstein, Monaco, Norway, San Marino, Switzerland and Turkey.

A European Patent application can lead to a granted patent in each member states of the Convention from a single request and process before the European Patent Office.

The Office checks that the application meets all the formal requirements and prepares a search report listing documents relevant for the patentability of the invention. At the request's applicant, the Office investigates whether the invention meets the requirements of the European Patent Convention and can lead to the grant of a European patent.

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Up to nine months after publication of the mention that a European patent has been granted, any person may file a notice of opposition to the patent with the European Patent Organization (EPO).

At the post-grant stage, the European patent has to be validated in all the contracting states designated in the European patent and the competence is transferred to the contracting states designated in the European patent.

It currently costs on average 4,920 Euros* to take a patent application with seven or more designated states through to the grant stage. In some of the contracting states the requirements for validation of the European patent in the state may incur costs.

2. International Patent application

The Patent Cooperative Treaty (PCT) is administrated by the World Intellectual Property Organization (WIPO) and makes possible to seek protection for an invention simultaneously in currently 141 different countries by filing a single "international" patent application. The granting of patents remains under the control of the national or regional patent office during the "national phase" of the patent prosecution.

An "International Search Report" is carried out by an International Searching Authority. It is a listing of "prior art" references that might affect the patentability of the invention claimed in the international application. The report and a written opinion on patentability of the invention give to the applicant an analysis on the potential patentability of his invention in the PCT contracting states and the opportunity to amend the claims or withdraw the application.

After the publication of the international application, the applicant can request an "International Preliminary Examination" for an additional patentability analysis, usually on an amended version of the first application. The applicant can submit amendments and arguments to the Examiner.

The examination of the patentability is non-binding for the national offices. However it shall be considered by the national offices during the "national phase" and can be often persuasive in national applications. Thus, the applicant can evaluate with reasonable probability the chances of patentability of his invention before the national offices based upon the international examination process.

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Usually an applicant filed a national or regional application (EPO for example) and filed a PCT application within 12 months of the national or regional filing date claiming the "priority date" of the first filing. Then, the applicant has to decide whether, and in respect of which states, he wants to enter in "national phase" before the end of 30 months from the "priority date".

Thus, the PCT process postpones the deadline for the applicant for entering national applications. The applicant is given more time to reflect on desirability of seeking protection in foreign countries and to delay the fees associated with filing and prosecuting patent applications in several countries.

The applicant pays three types of fees: a PCT filing fee of 1400 Swiss francs (the equivalent of approximately 1100 US dollars depending of the exchange rate), a search fee which can vary from 180 to 1900 US dollars depending of the International Searching Authority chosen. The fees paid during the « national phase » represent the most significant pre-grant costs and vary depending of the country*.

**The fees are in force on April 1, 2009. The fees may not include fees due for the grant of the patent and the patent maintenance fees. The fees don't include the fees of a patent agent or patent attorney also.*

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