



Boult Wade Tennant

European Patent and Trade Mark Attorneys
Chartered Patent Attorneys

Freedom to Operate Searching

by

Dr Michelle Pratt

28 October 2009

© Boult Wade Tennant 2009

mpratt@boult.com

0207 430 7500



Freedom to Operate

- “Freedom” from the threat of an infringement suit under a granted and valid patent owned by a third party to make, use or sell products and to use processes.
- The term “freedom” does not imply an absolute freedom or guarantee, but instead indicates a carefully executed analysis leading to a reasoned opinion in a given jurisdiction at a given point of time for a given product/process.





The Law

- A person infringes an in-force patent in the UK, if in the UK, without the consent of the proprietor, he/she makes, disposes, offers to dispose of, uses, imports, or keeps a product uses or offers to use process disposes or offers to dispose of, use, import or keeps any product obtained directly by means of that process.



But I have a patent....

 Europäisches Patentamt European Patent Office Office européen des brevets		 (11) EP 1 357 801 B1
(12) EUROPEAN PATENT SPECIFICATION		
(45) Date of publication and mention of the grant of the patent: 25.10.2006 Bulletin 2006/43	(51) Int. Cl. A23D 3/20 (2006.01) A23D 4/00 (2006.01)	
(21) Application number: 02732098.5	(86) International application number: PCT/IB2002/000011	
(22) Date of filing: 03.01.2002	(87) International publication number: WO 2002/058698 (25.07.2002 Gazette 2002/30)	
(54) THREE PHASE CONFECTIONARY MADE BY EXTRUSION DREI-PHASIGES EXTRUDIERTES KONFENKT EXTRUSION MULTIPLE HAUTE PRECISION DE PRODUITS DE CONFISERIE		
(84) Designated Contracting States: AT BE CH CY DE DK ES FI FR GB GR IE IT LI LU MC NL PT SE TR	<ul style="list-style-type: none"> JANI, Bharat, Pfizer Inc. Morris Plains, NJ 07950 (US) KNEBL, Leslie, Frank Sarasota, Florida 34236 (US) 	
(30) Priority: 19.01.2001 US 282919 P	(74) Representative: Hill, Richard Wilson Gunn Charles House 148/9 Great Charles Street Birmingham B3 3HT (GB)	
(43) Date of publication of application: 05.11.2003 Bulletin 2003/45	(56) References cited: EP-A- 0 601 194 EP-A- 0 775 448 US-A- 5 019 404	
(73) Proprietor: Cadbury Adams USA LLC Wilmington, DE 19808, (US)		
(72) Inventor: • DESADAY, Marc, Pfizer Inc. Morris Plains, NJ 07950 (US)		

A patent right is a negative right – it can be used by the owner to stop others once granted. It does not give the owner the right to commercialise the product/process.

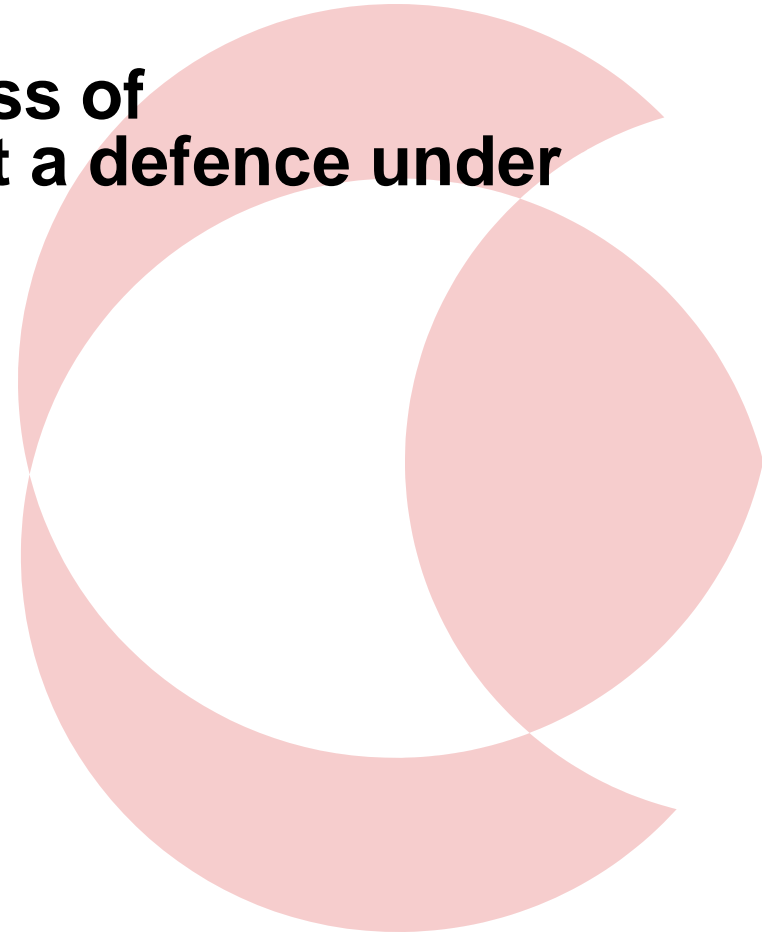


Boult Wade Tennant

European Patent and Trade Mark Attorneys
Chartered Patent Attorneys

Ignorance is no defence

- **Innocence of the awareness of patents/applications is not a defence under UK Law.**





Your Product

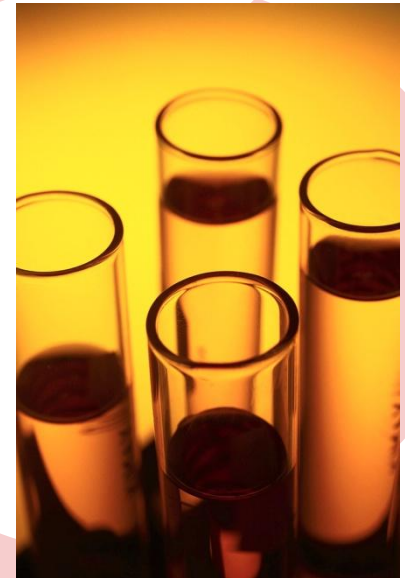
- **Can sell/market your product without the risk of infringement?**
- **Do you know chemical compounds/details of your product?**





Pharma product considerations - 1

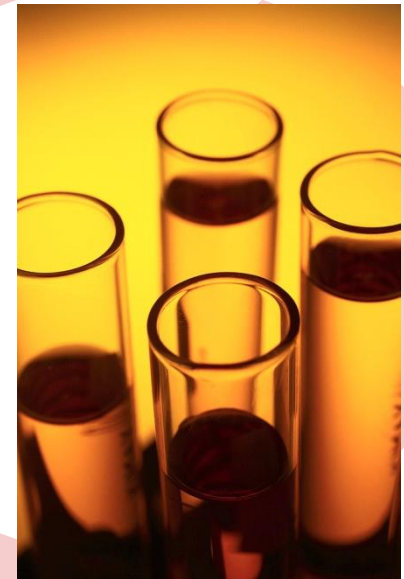
- **The compound itself must be considered:**
 - Crystalline form
 - Amorphous form
 - Enantiomers
 - Metabolites
 - Prodrugs
- **The types of pharmaceutical compositions**
- **must also be considered:**
 - Delivery systems
 - Vehicles
 - Adjuvants





Pharma product considerations - 2

- **The methods and components of the product synthesis are also important considerations:**
 - Reagents
 - Intermediates
 - Method steps
 - Purification techniques and products
 - Handling techniques and procedures
- **Methods of Use of the product:**
 - Mode of treatment
 - Doses



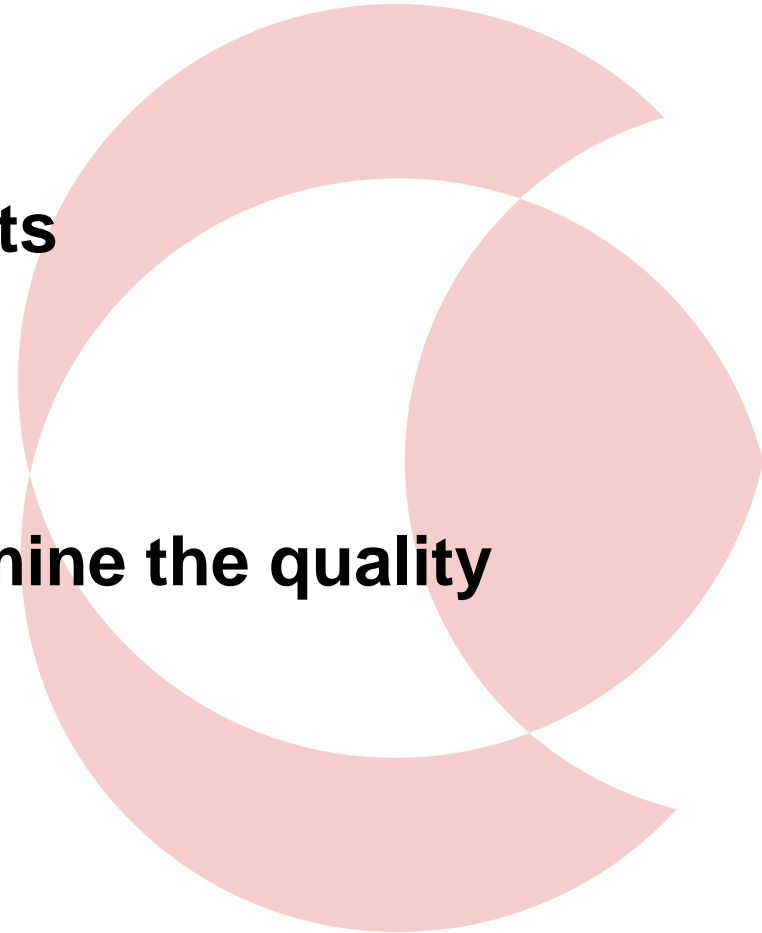


Assessing Freedom to Operate

- 1) Carry out Search
- 2) Analyse Search Results

- Note

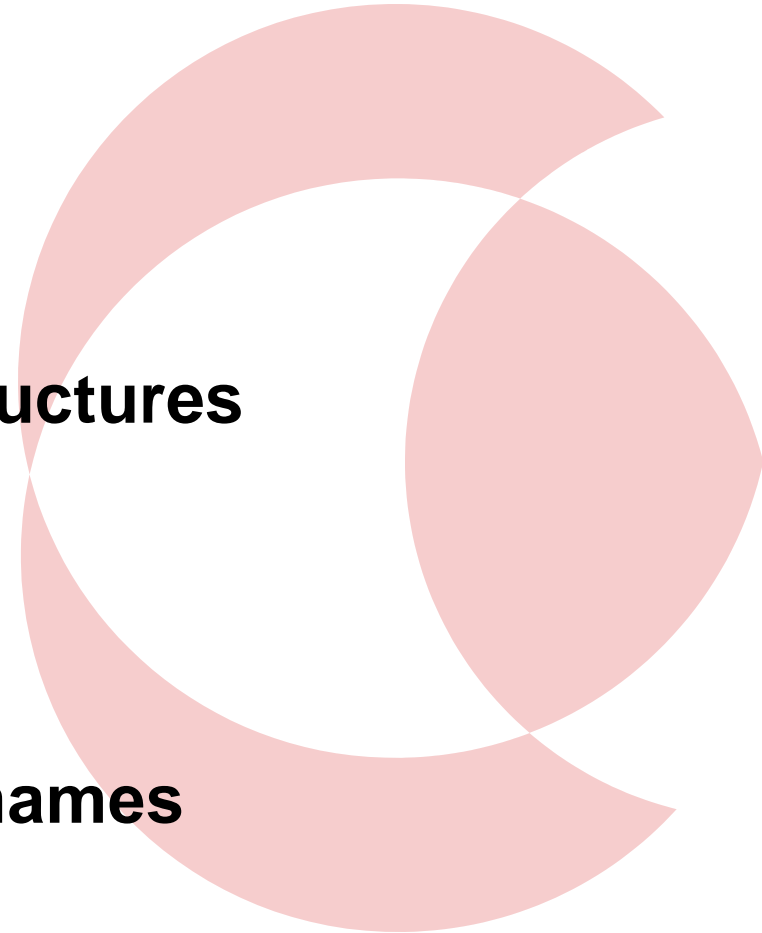
Quality of input will determine the quality of the output.





Search

- **Scope determined by cost**
- **Novelty search**
- **Search databases**
- **By chemical/biological structures**
- **Keywords**
- **Classification codes**
- **Company and inventor's names**





Boult Wade Tennant

European Patent and Trade Mark Attorneys
Chartered Patent Attorneys

Search Strategy

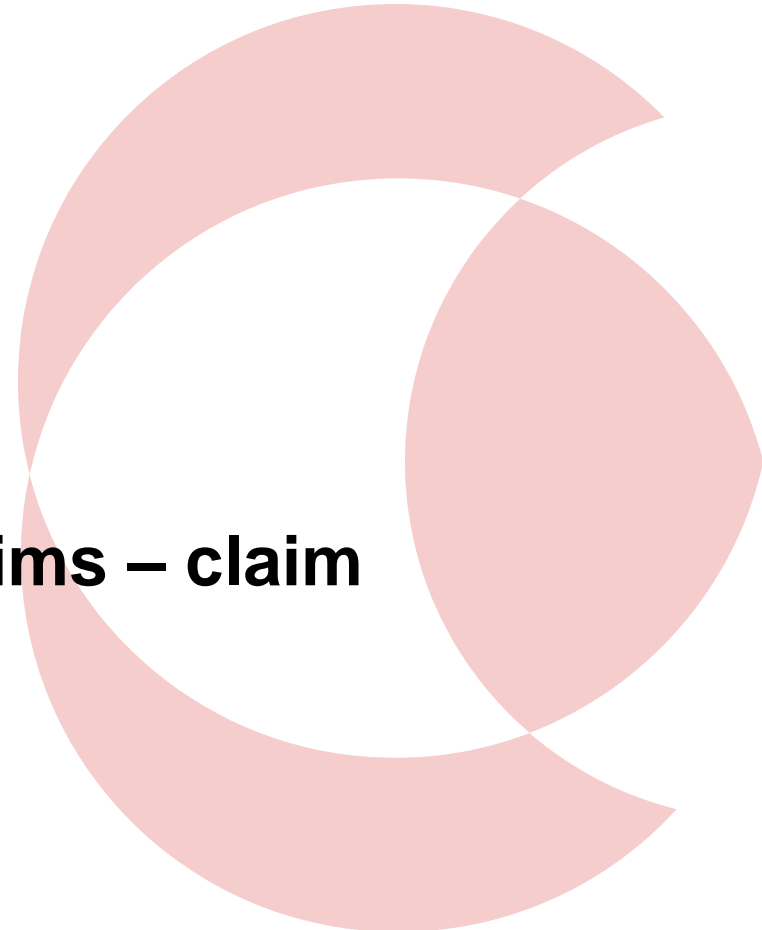
- **Determine search strategy**
- **Get quotes from quality search companies**
- **Consider using UKIPO**





Analysis of Search Results

- **Check term of patents**
- **Check status of patents**
- **Check territorial scope**
- **Examine impact of the claims – claim construction**
- **Assess Validity**





Infringement?

- **To determine infringement, a court must construe the claims and compare the allegedly infringing product/process to the claims.**
- **Claims contain limitations.**

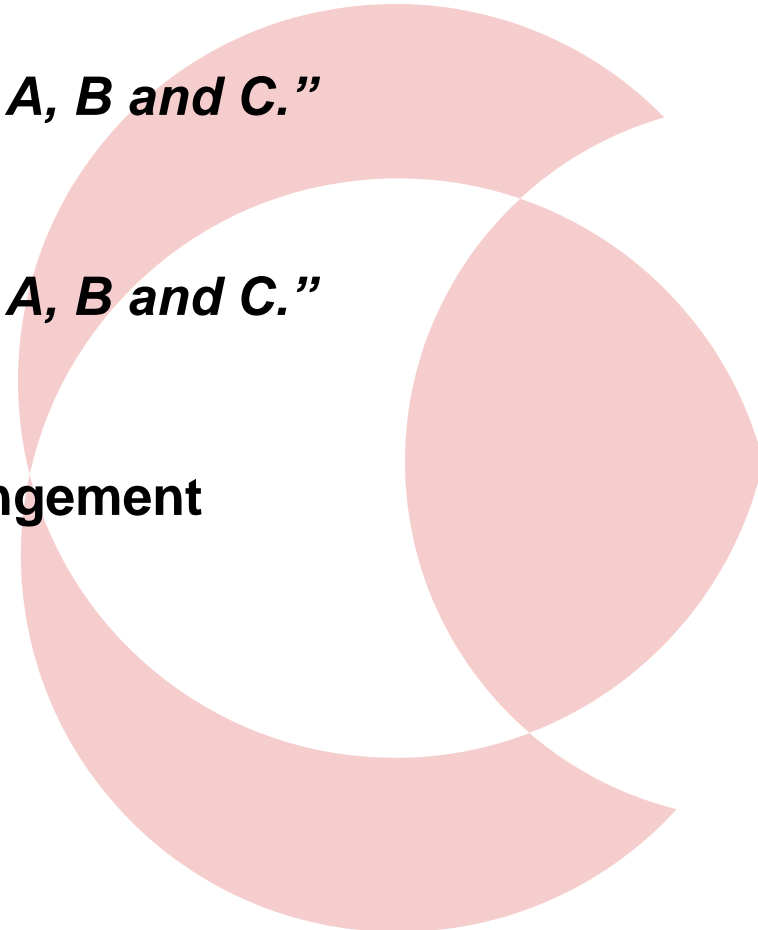


Example - 1

- ***Claim 1 reads:***
“A product X comprising features A, B and C.”
- ***Your product is :***
“A product X comprising features A, B and C.”



Literal infringement





Example - 2

- ***Claim 1 reads:***
“A product X comprising features A, B and C.”
- ***Your product is :***
“A product X comprising features A, B and D.”



Can C be construed to cover D?

Must construe the claims



Validity

- **Is the claimed invention....**
 - **Novel?**
 - **Inventive?**
 - **Sufficient?**
 - **[Is the patentee entitled to the invention?]**
- **In US/UK claim interpretation is different**



Blocking Patent

- **What if you perform a Clearance Search and you find that you would infringe an existing patent?**



Don't despair....

You have options



What if a blocking patent has been identified?

- **Attack Validity?**
- **Can you design around the patent?**
- **Purchase the patent?**
- **Negotiate/license?**
- **Cross-license?**
 - Two companies come to a legal agreement entitling one another to use technologies for which the other holds a patent.



Reassess

- **Reassess Freedom to Operate as R & D progresses/changes**
- **Carry out patent watches to watch competitors/potentially problematic patents**





Boult Wade Tennant

European Patent and Trade Mark Attorneys
Chartered Patent Attorneys

Freedom to Operate

by

Dr Michelle Pratt

28 October 2009

© Boult Wade Tennant 2009

