

# How to do a freedom to operate search

## What conclusions are drawn from FTO analysis?

### Duncan Clark:

*Welcome to the third video in our series, how to do an FTO search. In this session, we're turning our attention to conclusions that can be drawn from FTO analysis, and we're delighted to welcome Juliana Melo once again, who will be walking us through the steps. Juliana, it's over to you.*

### Juliana Melo:

Thanks, Duncan. Okay, let's start with a key question: what does an analysis encompass? There are two important steps. First, to carry out a search to pinpoint other patents in the same field. The second step is to evaluate such patents and define whether or not the product or service meet the requirements of the patent claims.

So, what we're really talking about here is clearing barriers. In this regard, it is important to remember that. FTO analysis based on the exploration of patent literature is only the first phase. If the patent search shows that a variety of patents restrict a company's freedom to operate, it means that the company can now determine the way to proceed. So, what are the options? Well, it is not all bad news. There are plenty of routes an organization can take, but let's take a look at four of the main options now. Some of the options may involve:

- Cross-licensing
- Buying the patent
- Licensing in
- Inventing around the invention
- Patent pools

### What is a patent pool?

Well, the patent pool is a type of agreement that you can sign with another company in order to share an invention. So, it can be a kind of 'cross-licensing', so you can license an invention from another company to protect two or more patents in the sector or in the industry.

Also, it is worth bearing in mind that there are limitations to patents as well. The limitations include territorial limits. So, patents can be filed internationally or nationally at the regional office. Internationally can be covered by the PCT route. A time limit may involve the duration of the patent, so patents last at least 20 years, some other jurisdictions contemplate other limits of time. Then, after the expiration period, they proceed to the public domain where anyone can use the patent. Then, they also include the limits of scope. The limits of scope involve what key elements are included in the claims of the patent. So, all the elements included in the abstract, in claims of the patent, must be included in the document. So, they would be allowed to check

when you are running your FTO search. So, don't despair if the FTO analysis reveals some obstacles. The key point is that an organization knows the obstacles, can assess the risk and determine the most appropriate action as part of its integrated IP strategy.

### **What is the most common workaround to avoid FTO issues?**

I think all of them are really popular, in the sense that, for example, after your patent has been granted it's very popular to go to patent pools. Then it's also very popular inventing around because you are making amendments to the invention itself. And then also the other options are in the prosecution of the patent application. So, it's quite common to receive a request from other clients outside of the business, or other people that want to contribute to the patent. So, cross-licensing, for example, is a very common way when the patent is already in commercialization (so you want to share part of the rights of the patent).

### **Duncan Clark:**

*Thanks again to Juliana there. So, Juliana ended on an absolutely critical point. Namely, how FTO analysis must be considered within the framework of a larger IP strategy, and that's exactly what we'll explore in the next video. We hope you'll join us for that. Until then, thanks for watching.*