

How to do a freedom to operate search

What is freedom to operate?

Duncan Clark:

Welcome back to Academy. In this series, 'How to do a freedom to operate search', we'll be joining Juliana Melo of Queen Mary University, London, to guide us through the process that you'll be undertaking when bringing an invention or discovery into the commercial world.

In this five-part course we will cover:

- *What freedom to operate means*
- *What are the objectives of FTO analysis?*
- *What conclusions can be drawn?*
- *FTO Strategy*
- *Sources of information*

If during the series you encounter something new and would like more information, feel free to head over to our IP glossary or take part in one of our other courses. So, Juliana, it's over to you.

Juliana Melo:

Thanks, Duncan, for the introduction. So, before we start performing an FTO search, we first need to know what freedom to operate means. So, I'm going to start us with a definition. Firstly, FTO is the capability to use or commercialize an invention or process without interfering with another party's intellectual property rights. This means, it is a way of facing potential liability of competitors. It means that FTO is therefore all about risk analysis, we are trying to assess what potential risks and organization will face if it commercializes a specific product or solution, so it can decide what to do or what the best steps are for mitigating that risk.

So, where do we start? FTO analysis starts by searching patent literature for issued or pending patents and obtaining legal judgment as to whether an item or process may be infringing a patent by another company or person.

Alright then. Let's take a more detailed look at exactly why a business will undertake freedom to operate analysis. There are six major uses which include:

1. To be able to spot patent infringements
2. To know more about art in the industry
3. To design a patent based on what we already know of the patents in the market
4. To provide evidence for state of mind
5. To license essential patents

6. To avoid intentional infringement

When should you carry out FTO searches?

Well, this is an interesting question because you can run an FTO search at all the stages, the whole prosecution of the application. But for me, from my personal experience, I'd consider the FTO search really important before filing the application, because you need to know what is in the sector if you are competing with your invention in other sectors, or if your invention is already patented, or if there is another business developing similar kind of products and things like that. But then after you have filed the application and you're in the process of the publication stage of the application, it is important also to identify key competitors from you. Then, after you carry the application, you also need perform the search in order to identify if there are potential applicants trying to file applications in the same sector or technology.

How much do FTO searches cost?

So, if you involve a group of IP professionals (like attorneys), in this case if you are talking about giving an opinion or doing simple research, like from an attorney's perspective, a simple search will be around £1,000 (\$1,270). Then if you are doing something more complicated it would be around £2,000 (\$2,549) or so. But then, if you go through a process of litigation, oppositions or you have to answer some kind of notification letter to the examiner at the IPO, it might involve a more costly process in the filing of the application. So, for some applications in some jurisdictions it can cost around £800 (\$1,020), and then some applications (like more advanced applications) it can be from £12,000 (\$15,300) to £15,000 (\$19,000). So yeah, it is costly, but it is worth it to do it in a very safe way.

In the next video we will take a closer look at the specific objectives of FTO searching.

Duncan Clark:

So, many thanks there to Juliana. We hope you enjoyed this introduction to FTO, and we look forward to seeing you on the second module. Until next time, goodbye.