



How to do a freedom to operate search – *Video Transcript*

How to develop an FTO strategy

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Duncan Clark:

In the fourth video in this series, Juliana helps us build a wider picture of FTO by discussing how to create a freedom to operate strategy. Let's join Juliana now, and she starts by explaining those all-important key components of FTO strategy.

Juliana Melo:

Okay, thanks Duncan. Let's start with some components of an FTO strategy. So, there are three key activities.

During our clearance search, we will compare process to claims, evaluate the file wrapper and analyze the legality of patents. Within this scope, you have the attorney's opinion which is indispensable as he needs to be involved with all of the aspects of the development of the invention. It is very important that the attorney has the skills or background to know about the invention. Privilege is when the attorney is involved through the whole process of the application. So, he might need to be involved in all the stages.

The FTO search structure dovetails with the strategy. Therefore, each part of the structure should be documented or reviewed. Let's look at those key elements.

Identifying the elements is very important. You must need to check the legal status of patents, including published applications, pending applications and blocking patents. So, if you are running your FTO strategy you can go and check the status of these applications, so you have a broader picture of what is going on with the patent.

Performing a key word search is an indispensable part of freedom to operate as they link to the type of industry. You might need to search by key words, abbreviations or synonyms. Then, you must need to include the prior art, so search for any prior art or design freeze. So, you will need to identify any similar products existing in the market.

You would also need to include the holders, so look for inventors and assignees determining who are the current holders of the invention. You must need to be aware that sometimes, when you file an application, the application can be transferred para an assignment, so your rights will be transferred to another inventor or assignee. In order to do that, you have to transfer the application.

Classification codes and jurisdiction need to be included, so the inclusions of IPCs codes and CPCs codes will help to determine the type of technology that will be useful. The jurisdiction is also a key element in your structure of the FTO analysis. So, you must need to refine your search by jurisdictions like the USPTO in the US, the EPO in the European Union and all other jurisdictions.

Include the citation and legal information. Search for previous publications, processes or methods relating to similar inventions. It is important also the check the case notes, the litigation process or oppositions.

The link between FTO search structures and strategy demands search management, a process which involves 5 steps. The steps should include:

First step is to perform key words, synonyms or abbreviations. An example of this could including or searching “glasses”, so synonyms could be “goggles”, “sunglasses” or similar.

In step 2, include the inventor’s scientific literature. So, you would need to check the business databases or company names. In the case of the UK, you should go to the company name’s which you’ll find on Companies House.

Step 3 is the timeline of invention. It includes the use of scientific literature, ongoing searches, published applications, pending and issues patents.

Step 4 may involve sequence and targets. So, be careful with the sequence because ‘sequence’ can include medical devices, but also structures like DNA structures, gene structures, biological structures. Then the targets could be focusing the product.

Step 5 talks about the selection of precise queries. So, you need to gather all the information, such as key words, inventors’ scientific literature, timeline of invention, sequence and targets and they will involve a structure.

Who should be responsible for FTO strategy?

Usually the person responsible for FTO strategy is the attorney, or a group of attorneys working on a project. Also, the inventors. So, the inventors have a link with invention and the construction of the patent claims, and the abstract, the title of the invention itself. Then, the pool of attorneys are going to provide a written opinion of what they think about the invention and also they have something called ‘the privilege’. So, this is like an accompaniment to try to provide advice in the technical background of the patent. So, these are very important factors to bear in mind in terms of this.

If you are talking about an organization, you usually have an agent that is attending the application. So, it doesn’t necessarily need to be an expert in the IP sector but needs to be someone that knows exactly what he’s talking about, what is the relation of the patent to the FTO search?

Let's end by taking a look at the limitations in the strategy. So, limitations may include types of claims, methods or uses. So, the type of claims means if this part of the claims doesn't clearly establish what type of technology the invention aims to describe it can be difficult to determine similarities with other patents. The methods talk about the appliance of mistaking words or sequences that are not relevant to the patent claims, they might not match with the creator's explanation or won't help you to identify if the invention infringes any other patent. The users, they are more in relation with the use of wrong CPCs or IPCs and they could lead to different results.

Duncan Clark:

Thank you, Juliana, and thank you Academy users. So now to complete your knowledge on freedom to operate, we'll be looking at some of the places where you can get much more help and information on FTO. We'll look forward to seeing you on the next module. Until then, thanks for watching.