



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

What are the objectives of FTO analysis?

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Duncan Clark:

Welcome back to our course, how to do a freedom to operate search. In the second video of this series, we will identify the objectives of a freedom to operate analysis and discuss the different types of search that one might need to accomplish them. So, I'll hand back over now to Juliana to explain more

Juliana Melo:

Now we know what freedom to operate means, so we can carry on with our own search. The first step is to identify objectives of FTO search. So, let's start with three key objectives:

1. Awareness of patent infringement risks
2. Track down where the risks lie
3. Evaluate how to manage risks before proceeding to commercialize

Depending on which objectives you are hoping to achieve, there are several types of FTO search that might help you to get there. Let's look at this now.

One type of search is 'style'. This means that the structure of analysis may change with regard to the company's acceptance for unspecified risk. The next one is 'analysis'. This refers to evaluating patent rights linking to

distinct parts of a product. And finally, there is approach which takes into account each one of the competitor's patents concerning pieces of the item to be commercialized.

What mistakes have you seen companies make with FTO analysis?

This is a really good question because I think that this is quite normal to find these mistakes from organizations, because they haven't run properly a freedom to operate search, or they haven't checked their file wrapper for other applications, or they are not very sure about the jurisdiction where they want to apply for a patent. So, some of the most common mistakes could be because they are trying to achieve some elements, including in the patent application, that are not for consideration of an IP examiner in certain territories. So, for example, the origin of a product could be descriptive in some jurisdictions and also when the patent doesn't fulfil the level of novelty, or the inventive step, could be some kind of mistake in the case of running an FTO search or spotting other competitors in the sector.

Whatever search type is chosen, one aspect must always be considered. Which is: all types of FTO analysis executed may vary depending on the determined characteristics, the most important one is the company's tolerance to unknown risk.

What do we mean by tolerance to unknown risk?

It depends on the type of company you are working on. So, for example, from my experiences, working with startups or large companies, it's not the same because the type of innovation that companies try to protect, they don't really represent the same level of risk. So, basically if you are trying to protect something more on a basic level, then the unspecified risk comes from a meeting with the inventors, with the board team, and all of that, and they are going to agree on the elements they want to include in the claims and abstracts of the invention. So, when you are talking about unknown risk it's because you don't know about the technology, you don't know about companies that are in the sector, and things like that. So, you must be aware about all the elements in order to avoid infringement.

So, in the next video I will be talking about what an analysis encompasses and how we get to the conclusion.

Duncan Clark:

Thanks again to Juliana for that insight. Join us in the third video for that crucial part, namely, how to get to the conclusions. We hope you enjoyed this video, and we look forward to seeing you on video 3.