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# Workshop:

## Best practices in the preparation and execution of “freedom to operate” reports on patents



# Facilitators for this workshop




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A laptop screen is shown in a dark, dimly lit environment. The screen displays a data dashboard. At the top, there is a line graph with a blue line and a green line. Below the graph, there is a legend with a blue square labeled 'New Visitor' and a green square labeled 'Returning Visitor'. To the right of the legend, there is a pie chart with a blue slice and a green slice. The text '19 av.' is visible below the graph. The overall scene is dark, with the laptop screen being the primary light source.

**What is a freedom-to-operate search?**

# FTO

This type of analysis is generally performed when there is interest to determine whether a product or process infringe pre-existing IP rights from third parties.



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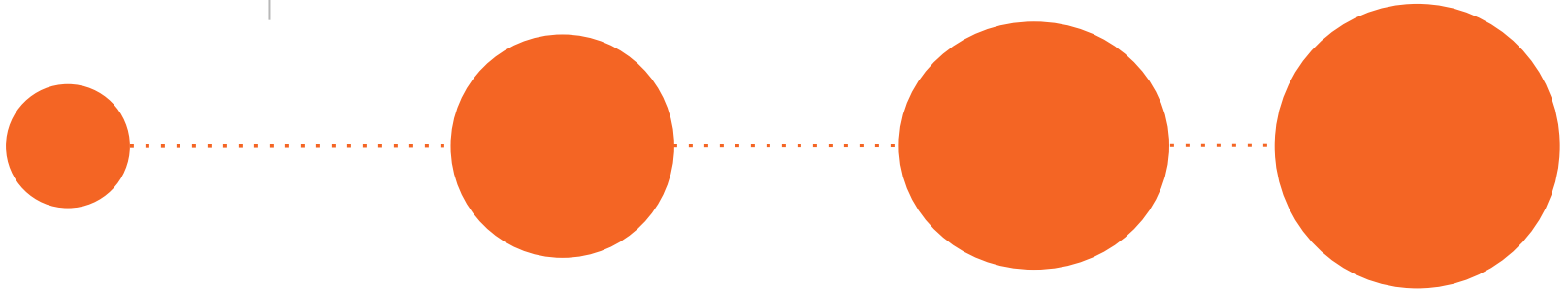
# What will be discussed in this workshop

Different  
FTOs  
scenarios

Best strategies on  
how to conduct  
FTOs

How to  
present  
the FTO  
results to  
clients

Anecdotic  
issues



## Different FTOs scenarios

There is not “one size fits all” type of FTO. FTO can rather mean very different tasks, depending on scenario where “freedom to operate” needs to be checked.



**Product development /  
product clearing**

**M&A, joint ventures, and  
venture-capital  
investments**

**Acquisition of protected  
rights and licenses**

## Different FTOs scenarios

There is not “one size fits all” type of FTO. FTO can rather mean very different tasks, depending on scenario where “freedom to operate” needs to be checked.



**R&D agreements**

**HR (new hires /  
dismissals)**

**Strategic corporate  
development**

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# Best strategies on how to conduct FTOs



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# Workflow of an FTO

- Defining search strategy
  - Commissioning and executing the search
  - Moving from long list to short list of results
  - Substantive evaluation of short list results
  - Preparing presentation of evaluation (next topic)
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# Defining the search strategy

- Database
  - Search terms
  - Operators
  - Restrictions
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## Commissioning and executing the search

- Outsourcing vs Insourcing
  - AI?
  
  - Track record of outside service providers?
    - Services offered by patent offices?
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# Moving from the long list to the short list

- Numerical cut-offs?
  - Re-defining search terms and/or operators?
  - Substantive evaluation (e.g. abstracts)?
  
  - Agreement on reasonable length of the short list:  
25 hits?
  
  - How to ensure constant quality?
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# Substantive evaluation of short list results

- Minimum quality requirements for substantive evaluation of search results?
    - Claim charts? Evaluation of abstracts?
  - Literal infringement only?
    - Equivalent infringement?
    - Indirect/contributory infringement?
  - Consideration of specific defences?
    - Validity check?
    - Exhaustion?
    - Formstein?
    - Skinny labelling?
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# How to present the FTO results to clients



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# What is a “real” FTO report?

- Is it sufficient to present a summary analysis based on abstracts of the patent specifications?
    - Very quick and relatively cost-efficient
  - Or is a “real” FTO analysis always based on an evaluation of the patent claims?
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# The two main categories of FTO reports

- Table format
    - Minimum 2 columns (claim features + infringement analysis)
    - 3 columns (claim features + construction + infringement analysis)
    - 4 columns (claim features + construction + relevant facts + infringement analysis)
  - Legal opinion format
    - Discussion patent by patent, feature by feature
    - Problem solved by the claimed invention + construction of all features + presentation of relevant facts + infringement analysis (literal/equivalent/indirect etc)
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# Must-mention points in the report?

- Definition of the task
    - What is the reason for performing an FTO analysis?
    - What objectives are being pursued by the analysis?
  - Limits of the analysis
    - Search methodology
    - Territorial scope: For how many countries is the research to be done?
    - Research depth: How thoroughly should a given feature be researched?
    - Research breadth: How many features are to be researched?
    - Long list to short list methodology
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# Drafting style?

- Subjectively, from the point of view of the expert (“best professional opinion”) vs. “judgment-style”?
  - Completeness / transparency:
    - Facts, legal arguments
    - Possible alternative assessments?
  - Indicate and evaluate potential courses of action?
    - Validity
    - Defenses
    - Equivalent infringement analysis
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# Risk management

- Explain residual risks?
    - Documents that were not found (Example: patent registration was not published)
    - Not all product features / constructive elements / circuits / designs can be searched for separately (some products involve hundreds or even thousands of intellectual property rights)
    - A patent may not include the keywords or IPC classes used in the search
  - Wording of the disclaimer?
    - “Our assessment represents our best professional opinion; however, we cannot exclude that an infringement court eventually adopts a different position or conclusion”
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# The tricky stuff

- FTO evaluation involves claim construction – no matter what!
  - All applicable rules of claim construction need to be observed!
    - E.g. specific definitions of a claim feature “hidden” somewhere in the specification
  - Claim construction and infringement analysis are separate tasks...
  - How about equivalent infringement etc?
  - This is hardcore legal work, cannot be done by paralegals?
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# TIPS for conducting FTOs



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# Thank you / Gracias

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