Discussion round 2
Freedom-to-operate: what does the client expect from the patent searcher?

Chair: Bettina de Jong, Source de Durantou
EPO representatives: Christian Soltmann, Jürgen Mühl
Discussion round 2: Agenda

- General overview by the chairwoman:
  - Introduction to the general concept of a FTO search
  - Results of the survey

- Discussion of 4 important topics in breakout groups

- Summary and short wish list
Breakout group 1: Communication with the client

- A priori agreement with the client on time frame and budget
- Expectation management: Inform client on limitations (e.g. regarding tools, data etc.)
- Background information to be provided by client:
  - List of known prior art
  - Overview of major competitors
- Close interaction between R&D, attorney and patent information specialist required
- Regular exchange with client also on intermediate results of the search
- Agreement with client on preferred mode of result reporting
Breakout group 2: Challenges according to geographical area

- Differences in the patent systems and the prosecution, e.g. different regulations for grace periods or the reinstatement of rights

- Language barriers, documents written in a non-Latin alphabet
  - Solution: hiring of local contractor to perform search, but difficult to find native speaker with technical expertise and knowledge in IP law for reasonable price, confidentiality dilemma

- Availability of data/search tools for “exotic” jurisdictions

- Different concepts of FTO searches in different regions
Breakout group 3: Working efficiently

- Proper understanding of the technology, incl. finding specific terms, synonyms, translations
  - Solution: Discuss with client (attorneys/scientists) about request. If necessary: external support if subject is difficult to grasp

- Time consuming search (Different tools necessary for different parts of information)
  - Solutions:
    - Have a specialist for each specific task (e.g. for legal status or for searching in Chinese language)
    - Have one tool that brings all the parts of information together
Breakout group 4: When to stop a search?

- Particular challenge: Steep growing of prior art, tools and geographic coverage of searches: impossible to “cover everything”

- In general: adapt your search according to given timeframe and budget
  - But do not stop because your client says so; don’t be shy to ask for more time

- Risk assessment:
  - Client must be made aware of scope of search, tools used and their limitations
  - Risk correlated to the stage of the product’s development
  - Sometimes second FTO update necessary to reassess the information

- Good indication to stop a search: When your searches repeatedly yield the same documents
A short wish list

β In communications ideally have technical person next to attorney

β Improvement of quality and coverage of machine translation (in particular for non-Latin languages)

β Expansion of geographical coverage in databases

β Combining bibliographic, legal event and other relevant data into one single database
Thank you for your attention