Report: Discussion round 2
Freedom-to-operate: what does the client expect from the patent searcher?
7 November 2017 / 09.00 - 10.30 hrs

Chair: Bettina de Jong, Source de Durantou
EPO representatives: Christian Soltmann, Jürgen Mühl

The main objective of this session was to share opinions and experiences about freedom-to-operate (FTO) searches with a focus on the communication between client, searcher and other stakeholders involved.

1) Introduction by chairwoman

The chairwoman summarised the most important results of a survey completed by participants before the conference. Based on the participants’ answers to the question "How would you explain to a novice what an FTO search is?", she presented the following definition of the term “freedom-to-operate search”:

The aim of an FTO search is to access the risk of infringing patent/IP rights. This is done by searching for patents that are still in force, pending published patent applications or other IP rights that claim the proposed product or process or features thereof and therefore may block the production/use/sale/commercialisation of the proposed product or process in the countries of interest.

The survey also revealed facts about the participants' experiences with FTO searches: most respondents conduct between four and ten FTO searches per year, with a great variation in the average time spent per search from less than ten to about one hundred hours.

According to the chairwoman, an FTO search can be regarded as the most challenging of all patent searches for several reasons:

- High level of responsibility: a failure could result in serious financial damages due to the infringement of a third party’s IP right and put considerable investments at stake when it turns out at a later stage that there is no freedom to operate on the market.
- High level of skills required: the search requires not only advanced searching skills, but also technical and legal knowledge to understand the claims, a good understanding of patent systems to interpret the legal status of the results and a good overview on all available sources.

In order to do a proper FTO search and deliver what the client needs, it is of key importance to determine up front the scope of the search. Therefore, communication with the customer is even more important and it is mandatory for the searcher to obtain as much and detailed information as possible about the product/process itself, the countries and regions the customer is interested in. On top of that the searcher needs to thoroughly investigate the
client's expectations and the risks they are prepared to take and also to indicate the limitations of the search.

2) Discussion

The above-mentioned aspects also played a major role in the following break-out session. The participants were divided in four groups which debated on the following topics:

Breakout group 1: Communication with the client
Breakout group 2: Geographical challenges
Breakout group 3: Working efficiently
Breakout group 4: When to stop a search?

Breakout group 1: Communication with the client

This group tackled the following key questions in communicating with a client: What does the customer expect? What information does the searcher need from him/her? What if the client's expectations are difficult to meet?

First, the group presented those aspects which have to be addressed before the start of the search. It is absolutely necessary to confirm the time frame and budget with the client and also to inform the client as early as possible about limitations, for example regarding the search tools or the data available. Also, it is important to ask the customer for any background information that could facilitate the search, e.g. a list of known prior art or an overview on the major competitors in the technical field.

Next, the group reported on those features which are particularly important to communicate at the time the search is carried out. It is important to keep a regular exchange with the client also on intermediate results of the search. As FTO searches require a lot of different skills, it is highly advisable to include not only the searcher and client in the communication, but also other stakeholders such as experts from R&D as well as patent attorneys.

Finally, the group also mentioned features which are important after the search is completed. In particular, it is important to agree with the client in advance about the preferred mode of reporting and evaluating the results.

Breakout group 2: Challenges according to the geographical data

This group discussed specific obstacles and challenges regarding the geographical area the client is interested in. Some of the most important challenges are differences in the patent systems and the prosecution, e.g. distinctive regulations in each country for the reinstatement of lapsed rights. A searcher needs to have expertise also in the patent law of many different jurisdictions in order to make a statement whether or not a patent is in force. If the client is interested in developing markets in Latin America, Africa or some regions in Asia, the searcher often has to tackle the problem that insufficient data or tools are available to perform a high quality FTO search.
Language barriers are another major obstacle for FTO searches in different geographical regions. This is particularly true for searches in documents which are written in a non-Latin alphabet. As a solution, the group suggested to collaborate with local contractors who could perform the search in their native language. However, other participants argued that it will be difficult to find a native speaker with technical expertise and sufficient knowledge in the IP law; also the participants expressed some doubts whether or not a client is willing to share confidential information with an "external" person they have no personal contact to.

Breakout group 3: Working efficiently

This group debated on particular challenges and obstacles they find in their daily work to perform FTO searches efficiently. The group agreed that one of the biggest problems in an FTO search is a proper understanding of the technology which makes it difficult to determine the most important keywords, synonyms or translations of these terms.

The group stressed that, once more, communication is extremely important to overcome this obstacle, in particular in-depth discussions with the client. If necessary, it makes sense to get external support in case the subject is too difficult to grasp for the searcher.

Another major challenge of FTO searches are limitations in time and sources. Very often, FTO searches have to be conducted in different languages and also include an analysis of the legal status of the results. The searcher has to rely on many different tools for the different parts of information required. To tackle this challenge, the group suggested to involve different specialists for each specific task (e.g. for searches in Chinese language or for legal status analysis) and expressed the wish to have a single tool that brings all the different parts of information together.

Breakout group 4: When to stop a search

With the dramatic increase in prior art, tools and geographic regions to cover in FTO searches, the risk of missing relevant documents seems to be higher than ever before and the question of when to stop a search has become more and more difficult to answer. The group agreed that a search may be completed simply when it repeatedly yields the same documents again and again, but in many cases, the situation is not that easy. In general, it is important to adapt the search according to the time frame and the budget provided by the client, but if absolutely necessary, the searcher should not hesitate to request additional time from the client.

Very often, the client is not aware of the different framework conditions and particular challenges the searcher has to face. In this context, it is absolutely mandatory to discuss all possible risks with the client before starting the search, in particular the limitations regarding the available tools and the scope of the search. Sometimes, instead of concluding a search, it makes sense to
conducted a further FTO search at a later stage to check for new documents or in the case the specifications of the product/process have changed in the meantime.

3) Summary by chairwoman

As a short summary of the discussions, the chairwoman stressed that communication between searcher and client about framework conditions and limitations with regard to data, search tools, geographical coverage and other aspects was regarded essential in all four breakout groups.

Based on the discussions, she presented a short list of wishes for improvements that would help to enhance prior art searches:

- Communication not only between searcher and attorney, but also including technical experts
- Improvement of the quality and coverage of machine translations, in particular for non-Latin languages
- Expansion of geographical coverage in databases
- Combination of bibliographic data, legal events and other relevant information in a single database.

Bettina de Jong, Chairwoman, Discussion round 2

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