

Ready to commercialise your invention? Stop! Do you have Freedom to Operate?

“I have patents on my invention. I don’t need to worry about other people’s patents – do I?” Yes, you do!

Having your own patent does not mean that you can ignore other people’s patents. For example, you might have a patent on a specific compound, but another person might have an earlier patent which covers the whole class of compounds. Or if you have a patent on a certain part of a process, there might be other patents which cover upstream or downstream parts of the process that you are planning to use.

Therefore, before you start commercialising your invention, it is prudent to do a Freedom to Operate (FTO) search to try to find any relevant patents. There are generally three stages to this:

(1) Define the product, process or method that you plan to commercialise in terms of keywords. These keywords will be used to search the patent databases to try to find relevant patents. You will also need to decide on which countries you are likely to make/use/sell your invention because you will need to search the databases of those countries’ patents.

(2) Commission a patent search using the keywords you have selected. The search should cover both patents and patent applications in the countries that you have selected. These searches are usually performed by specialist searching companies.

(3) Analyse the results of the search. The number of “hits” that you get from your search will depend on how broadly your keywords were, on how many different countries’ patent databases you have searched, and on how many relevant patents are in those databases. This analysis is usually done by a patent attorney. All of the claims of all of the patents need to be carefully reviewed. The claims of pending patent applications (which might later mature into patents) also need to be considered, as well as the likelihood of those patent applications actually being granted. Often the patents/applications are sorted by the patent attorney into “relevant”, “possibly relevant” and “not relevant” (or red, amber and green) bundles, indicating the level of risk associated with those patents/applications.

On the “relevant” (red) cases, further investigations might be needed. The options to be explored here could include seeking a license under the patent, challenging the patent’s validity, designing around it or waiting until the patent expires.

An FTO search might cost £500-£2500 (depending on how exhaustive you wish it to be), for a simple product, and the costs for the analysis will depend heavily on the number of patents which are found and their relevance. (The more patents that are found, the more time it will take to analyse them.) Complex products often include multiple separate aspects each requiring separate focus in an FTO search, and the costs can increase accordingly. The analysis costs would vary depending on the number of patent families needing review, and on the number of geographic jurisdictions where FTO clearance was needed. Typical costs for an initial review as outlined above might be perhaps £50-£200 per patent family, depending on relevance and on the number of patent family members. The total cost for analysis might be up to £5,000, or higher, and for complex products the cost can be considerably more since multi-faceted FTO searches can return larger numbers of hits.

Carrying out an FTO search and analysis can be a time-consuming exercise, but it is money well spent. For example, it is much better to find out about relevant patents/applications before you invest \$10 million in a new manufacturing facility. If you don’t, then you risk being sued by a competitor for patent infringement (and possibly being shut down)!

Further advice

If you would like any further advice, please contact us at Dehns using the details below.

**Contact Dehns****T:** +44 (0)20 7632 7200**E:** mail@dehns.com**W:** www.dehns.com