

Webinar: Overview of the WIPO Guide on Identifying Inventions in the Public Domain

Questions and answers

Why are keywords important when doing a patent search in the context of freedom to operate determination?

It is important to find as many potentially relevant results as possible and limit the degree to which you are missing potentially relevant results. Because the same invention or invention feature can be described in many different ways, you can start with an initial list of keywords and phrases such as the ones that you used for describing the invention that you want to search, then find synonyms and similar words and phrases, and then expand the list to find different keywords and phrases that can be used to describe the same invention or invention feature. This expanded list of keywords and phrases will be used to search for patent documents that recite at least some of these keywords or phrases in the claims, because those patent documents are more likely to be relevant.

How can I generate keywords? Does WIPO have a tool to help retrieve synonyms in different languages?

Keywords should be based on the key concepts or features of the invention on the basis of which you are carrying out a patent search. They may consist of synonyms, variants, and terms related to these key concepts across different languages. Many different resources exist for identifying synonyms, variants, and related terms, starting with technical dictionaries, thesauruses, publications that are relevant to the invention, and any patent documents that you identified early in the process. Because patent documents are an important source of relevant keywords, you could start with broad early searches for patents that use your initial keywords, in a database that provides relevance ranking (such as WIPO PATENTSCOPE) and look at the most relevant patent documents to see what other words are used throughout the document to describe relevant features. Tools that are trained on patent documents are useful for expanding the list of keywords and phrases. The “[Cross-Lingual Information Retrieval \(CLIR\)](#)” tool available in the WIPO PATENTSCOPE free patent database can be used to find terms in different languages. You can also use [WIPO Pearl](#) to identify related terms.

If there is no translation for a patent document you found which you think might be relevant for your invention, what would be your advice?

It is important to get an idea whether a particular patent document might be relevant by trying to translate the patent document. There are a number of tools that are available, in particular machine translation tools trained on patent literature, that can give you an idea whether the document might be relevant. One such tool is the [WIPO Translate](#) instant translation tool that has been designed specifically to translate patent texts, and is available in WIPO’s PATENTSCOPE database.

To carry out an effective analysis of that document however, once you have determined that the patent document may be relevant, you would have to refer to a native speaker or get an official technical translation of the document.

Can you explain the difference between the technical final determination of a freedom to operate (FTO) analysis and a legal FTO opinion?

The technical FTO analysis involves identifying patent documents with claims that may recite some or all aspects of an invention, and providing an explanation of how those patent documents were identified and analyzed. A legal FTO opinion involves determining the scope of claims in the identified patent documents and the degree to which these claims may cover the invention to be cleared, and then assessing the risk that practicing the invention would be found to infringe these claims *if* an accusation of infringement were to be made.

What does it mean when you speak about the “legal status” of a patent?

Patent legal status information is information concerning the administrative status of a patent, according to the applicable laws and regulations that apply to the patent. The process of legal status determination starts with determining whether a patent document – for example, a patent document identified in an FTO search – is a granted patent or a patent application. The purpose for determining the legal status of a granted patent is to determine whether, at a particular point in time, the patent is in force and the patent owner can enforce the IP rights granted in the patent, or the patent is not in force because it has expired or has been abandoned, invalidated, revoked, abandoned, declared unenforceable, disclaimed, or withdrawn.

It can also be useful to determine the legal status of a patent application in order to determine whether the application is still pending and could issue as a patent in the future, or whether the application is expired, abandoned, or withdrawn.

Can you clarify what you mean by “public disclosure” of an invention? Do “dead patents” or withdrawn patents form part of what is considered to be public disclosure? What if a patent application was withdrawn before it was published?

Public disclosure generally includes any non-confidential communication of an invention, which can be made through written publication, demonstration, oral presentation, and many other means. Published patent documents, regardless of their legal status, are generally considered public disclosures. Disclosures in “dead” or withdrawn patents would be public disclosures. However, the disclosures in patent applications that were withdrawn before publication may not be available to the public.

FTO determination is a complex process, in particular in the area of drugs often protected by a bundle of patent rights. What is your opinion on this issue?

During the FTO search process and analysis, it is very important define the invention under consideration, search for patent documents relevant to that invention, and then analyze the claims of each potentially relevant patent document to determine whether these claims could be interpreted to cover (read on) that invention. In some cases, the FTO search may return many results, and it is important to identify the potentially relevant patent documents in the search results and carry out a technical FTO analysis of each potentially relevant patent document with respect to the invention under consideration.

How many times should you make an FTO analysis?

An FTO analysis should be updated regularly, based on your needs. Patent documents are living documents, which means that patents that you have identified previously may expire or go abandoned, the scope of claims may change, previously pending applications may issue as patents, and new patent applications may have been filed and published since the last time you did your FTO search and analysis.

A helpful tip is to store the search strings you used for your FTO search, so you can easily run the same FTO search at a later time and compare the search results. You can use the “saved queries” option in WIPO PATENTSCOPE to store this information. When you run the same FTO search at a later time, the search results should find new patent documents that fulfill the search criteria, such as patent applications that were published after the last FTO search was run, or patents that were granted after the last search was run, where it is important to analyze the claims of the granted patents even if the underlying application was previously analyzed. The updated search may also retrieve older patent documents that were added to the database after the last FTO search was run.

Updating an FTO analysis should include determining the updated legal status of patent documents that were identified as being of interest in the previous analysis, to determine whether any previously enforceable patents are no longer in force because they expired or were abandoned, revoked, etc., to determine whether any previously pending applications issued as patents (and what claims were allowed), and to determine whether any previously unenforceable patents or expired application have been revived or restored.

In the case where you find a blocking patent as a result of your FTO search and final determination, who could raise the question of the validity of the patent and who would be responsible for providing an invalidity opinion?

If the final technical FTO report indicates potential blocking patents in certain markets, the next recommended step would be to consult with a qualified IP professional, which in most countries is an IP attorney or patent attorney. The IP attorney could carry out a more detailed legal analysis of question of whether carrying out the planned use of the invention could be found to infringe the potential blocking patent. The IP attorney can consider whether grounds exist for challenging the patent, for example on the basis of invalidity. The IP attorney can also evaluate the plans for using the invention and consider whether there are exceptions or exemptions, e.g.,

patent exhaustion, first sale doctrine, or research exemptions, that would permit use of the invention under the circumstances described in those plans. These questions involve country-specific legal issues that should be addressed by a qualified legal professional.

What is the difference between an FTO search and analysis and a patent landscape report (or technology scan report)?

The purpose of a patent landscape report (or technology scan report) is typically to gain an overview over an area of technology, e.g. to look at general trends in patenting relevant to this technology, to identify the most active patent applicants in the area, or to focus on patenting activity around specific technical aspects of the technology. The purpose of FTO search and analysis is to determine whether a specific invention might be covered by patent rights, and to evaluate what patent rights may in force in the countries of interest, during the timeframe of interest, for the planned use of that specific invention.

For more information on patent landscape reports, see this [link](#).

Can you provide an example of an FTO final report?

The practical tools in Annexes A, B and C of the Guide are essential for using the guide effectively.

Annex C.3 in the [Guide on Identifying Inventions in the Public Domain](#) (pages 111 to 113) provides a template to demonstrate how the Final Report can be organized and presented. For a more detailed discussion on the Final Report and additional guidance, see Module IV, section 7).

Are there additional resources to help better understand how to deconstruct an invention as explained in the Guide in Module III, section 2?

Annexes A.1, A.2 and B.1 in the [Guide on Identifying Inventions in the Public Domain](#) (pages 100 to 105) contain useful checklists of steps and considerations to help you prepare an FTO search, in particular how to gather information about the invention and deconstruct it in preparation for the FTO search process. You will also find a list of useful additional tools and resources, including other WIPO publications, tools and training materials in Annex D (page 114).

Can you speak about cases in which certain features of a patented invention may be covered by other kinds of intellectual property rights?

When someone makes plans for making, using, selling, *etc.*, an invention, these plans may include aspects that might involve other kinds of IP rights. These rights could include trademark rights in names and logos, copyright for aspects such as marketing material or software (depending on the country), or industrial design rights for ornamental aspects. Some plans may include aspects relevant to some specialized forms of country or industry-specific protections

such as mask work registration, or evolving/*sui generis* IP (or IP-like) rights relating to traditional knowledge/cultural expression. Therefore, someone making plans to use an invention needs to consider any patent rights that may be relevant to the invention, and also needs to consider other types of IP rights that may be involved in carrying out those plans.

The WIPO companion publication to this Guide, *Using Inventions in the Public Domain: A Guide for Inventors and Entrepreneurs*, addresses the use of inventions in the public domain. As explained in that Guide, “Public domain information can only be exploited as you wish where there are no associated IP rights covering the making, use, selling, etc. of the invention disclosed in the patent. [...] Trademarks, trade dress, copyrights and trade secrets are other notable regimes of IP protection that may inhibit unauthorized use, imitation and/or misappropriation/infringement”. For more on this topic, see Module II “Finding opportunities to leverage inventions and public domain knowledge” (pages 17 to 26 of the Guide, which can be downloaded at this [link](#)).

Where can we get a copy of the Guide and of the recording and presentation slides of this webinar?

The Guide can be downloaded free-of-charge at this [link](#).

The presentation slides, questions and answers, and recording of the webinar can be accessed at this [link](#).