



**The Journal of Robotics,
Artificial Intelligence & Law**

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Freedom to Operate Analysis: Three Strategies to Efficiently Achieve Robust Results

Kira Gill*

In this article, the author explains that “Freedom to Operate” analyses often are an essential step in commercialization efforts for a new product, process, or service, but that they may become time-consuming and costly if performed without a clear strategy.

Determining whether a new product, process, or service can be launched without infringing existing patents, commonly referred to as “Freedom to Operate” (FTO) analysis, is a critical step in virtually any commercialization effort. In highly competitive fields like today’s high-tech and life science industries, however, robust FTO analysis may not only be a prerequisite for commercial launch, but also may prove beneficial earlier in commercial development, such as during investment and/or partnering negotiations. For example, while the ultimate goal of an FTO analysis may be to minimize the risk of future legal challenges, when performed correctly, FTO analyses can also provide actionable competitive intelligence and inform product development decisions.

Despite the importance of performing robust FTO analyses, it is equally important to ensure the resources devoted to such analyses are used efficiently. Three strategies to efficiently achieve robust FTO analyses are:

1. Developing a clear understanding the product, process, or service at hand;
2. Developing an effective and comprehensive search strategy; and
3. Ensuring that the results of the analysis are clearly articulated and captured for future use.

Strategy 1: Understand Your Product

Every FTO analysis should begin with a deep dive into the product, process, or service at hand, including an identification of its key features. Often companies will find that they may not have completely developed all features of the product prior to initiating an FTO analysis and so an iterative process may be necessary. This process includes having conversations with the company's development team to discuss any current or potential features the product may have.

To the extent additional features are added after the initial search, not only will a new search string have to be developed to account for the additional features, but there will also have to be a second round of analysis, including patents from both the first and subsequent searches.

Therefore, choosing the correct time to conduct an FTO analysis for an emerging product can be crucial to performing an accurate FTO analysis. In such instances, clearly identifying when specific features are "locked" and searched can provide a road map for such iterative processes.

Strategy 2: Carefully Design Your Search

FTO analyses can also be made more efficient by taking time at the outset to refine the search strategy. Developing search strings often requires finding an appropriate balance of creating as inclusive of a search as possible, so as not to miss any relevant art, while simultaneously avoiding irrelevant patents. A string that returns too many hits, particularly irrelevant hits, can be as ineffective as a string that returns too few hits, as substantial time may be spent going through patents that are completely irrelevant to the key features of the product.

On the other hand, if there are not enough hits, then relevant patents may be overlooked that may lead to litigation risk in the future.

Several methods can be implemented at the outset to create effective search strings.

First, it is often possible to limit the scope of the results to specific fields by searching the entire patent for terms that are particular to the field, thus avoiding completely off topic hits. For

example, if the product is related to a chemical process, searching the entire patent for terms such as “chemical” or “chemical compound” may weed out patents directed to mechanical devices that nevertheless share certain terms in their claims.

Second, searching within the claims with specific terms related to the key features is likely to produce the most accurate results with patents with similar features.

Finally, if the number of results remains too large for an efficient review, narrowing the search to a specific subset of assignees can significantly reduce the number of results, while still capturing what may be expected to be the highest risk patents. Typically, the assignees will be competitors identified as particularly problematic due to previous litigation or those that are developing similar products, processes, or services.

Strategy 3: Clearly Articulate and Capture the FTO Results

It is imperative that the FTO results are clearly articulated, and the results are archived. It is particularly helpful to identify at what point in the analysis the patent was cleared, and which features of the patent were distinguishable from the product, process, or service at issue. Maintaining detailed and organized results ensures the materials are available for iterative or future searches. As discussed previously, if new features are added, the previous results can be reviewed to streamline the analysis.

Finally, one last method to ensure maximum efficiency is to cross-check the features of the current product with any patents that were identified in prior searches for similar products. This can eliminate the risk of overlooking relevant patents and is efficient because it requires searching through patents that may already be categorized in an internal database. Additionally, if features are identical between two products, then the reasoning may be the same for clearing a patent.

Conclusion

While FTO analyses are often an essential step in commercialization efforts, they may become time-consuming and costly if

performed without a clear strategy. By beginning an FTO analysis with a clear understanding of the product, process, or service at hand, refining the search strategy to target the highest risk patents, and clearly articulating and capturing the results, costs and time expended on FTO analyses can be significantly reduced, while still providing a quality analysis.

Note

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