



European IP Helpdesk

Stay ahead of the innovation game.

European IP Helpdesk Webinar:
FTO

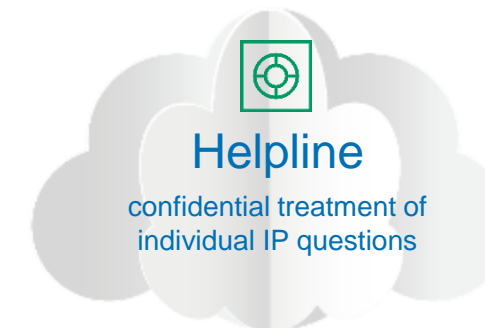
Dr. Christian Hackl
Senior IP Advisor

May 15, 2024



European IP Helpdesk

- Service initiative of the European Commission
- Addressing **current and potential beneficiaries of EU-funded projects, researchers and EU SMEs**
- Free-of-charge first-line support on intellectual property (IP)
- Hands-on IP and innovation management support
- International pool of IP experts from various thematic fields
- Unique cooperation scheme with the Enterprise Europe Network: 43 ambassadors from 26 EU countries



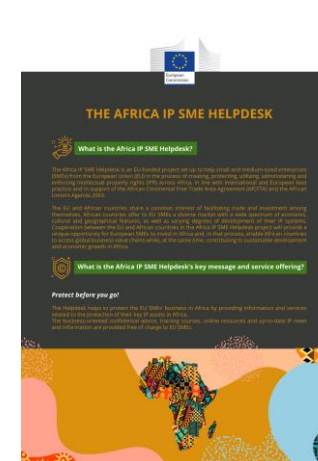
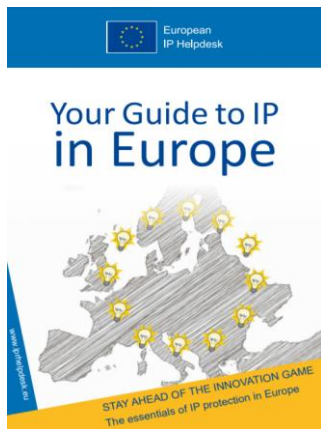


The EC IP Helpdesks





EC IP (SME) Helpdesk Hub – Gateway to Information



- E-learning modules & more
- Guides / Topic, country, sector-specific factsheets / Infographics
- Case studies



European IP Helpdesk Training Calendar

register in time!

Europa - Upcoming events

- | | |
|--|--|
| <p>07-08 MAY 2024</p> <p>Exhibitions European Cluster Conference 2024</p> <p>External event</p> | <p>07 MAY 2024</p> <p>Training and workshops EU - Webinar: Addressing IP impact and innovation in EU projects</p> <p>Live streaming available</p> |
| <p>09 MAY 2024</p> <p>Training and workshops EU - Webinar: IP Management in ICT Projects</p> <p>Live streaming available</p> | <p>14 MAY 2024</p> <p>Training and workshops EU - Webinar: Finding Patents</p> |
| <p>14-23 MAY 2024</p> <p>Training and workshops EPO IP assessment: how to improve informed decision-making</p> | <p>15 MAY 2024</p> <p>Training and workshops EU - Webinar: Freedom to Operate</p> <p>Live streaming available</p> |
| <p>16 MAY 2024</p> <p>Training and workshops EU - Webinar & Horizon Results Platform: IP and Software</p> <p>Live streaming available</p> | <p>21 MAY 2024</p> <p>Training and workshops EU - Webinar: Maximizing the Impact of Horizon project (2020/HEU) results</p> <p>Live streaming available</p> |
| <p>22 MAY 2024</p> <p>Training and workshops EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Digital communication</p> <p>Live streaming available</p> | <p>24 MAY 2024</p> <p>Training and workshops EU - Webinar: Copyright in collaborative projects</p> <p>Live streaming available</p> |



Registration: www.ec.europa.eu/ip-helpdesk



Ambassador Scheme

- **Cooperation scheme** with the Enterprise Europe Network (EEN): 43 ambassadors – 26 countries
- **Building IP capacities** among European SMEs
- **Overcoming language barriers**
- Making the topic **more accessible**
- Exchange and feedback from ambassadors on **needs of SMEs**
- Local **awareness** and **training events**





Thank you!

- www.ec.europa.eu/ip-helpdesk
- helpline@iprhelphdesk.eu
- training@iprhelphdesk.eu
- Twitter [@iprhelphdesk](https://twitter.com/iprhelphdesk)
- LinkedIn [/european-ipr-helpdesk](https://www.linkedin.com/company/european-ipr-helpdesk)





Today's speaker

Dr. Christian Hackl



- Managing Director of TUM-Tech GmbH
- Assistant Professor at the Chair for Technology and Innovation Management (Technical University of Munich: TUM)
- Regular lecturer for the European Patent Office (EPO) / European Patent Academy and the EU-IP Helpdesk
- Author of several publications, e.g. case studies on usage of IPR by companies
- Co-Founder of a start-up (renewable energy)



FTO

Freedom to Operate

“The ability to perform a commercial activity without infringing 3rd party’s IP rights.”



Different Types of IPR?

Registered IP

Patents

Utility models

Registered trade marks

Registered designs

Unregistered IP

Copyright

Database right

Unregistered trade marks

Unregistered designs

Soft IP

Know-how

Trade secrets

Confidential information



What is a patent?

- *A patent is a negative right*
- *A patent is the right to exclude others from*
 - *making*
 - *using*
 - *offering for sale*
 - *selling*
 - *or importing*

*the patented invention for a limited period of time
in a certain geography*

A challenging task – for experts!
This training is to give you some
basic information

FTO-analysis: search for 3rd party IPR which can block your activities



Let's assume:

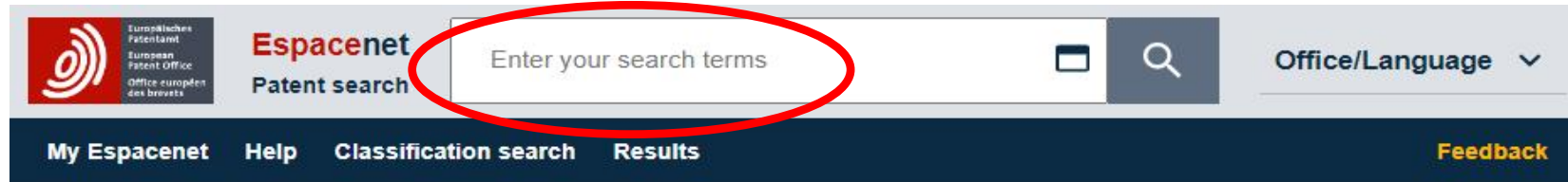
You are in an ongoing R&D-project and would like to do a first FTO-analysis

- What would you do?
- Where would you search for 3rd party patents?



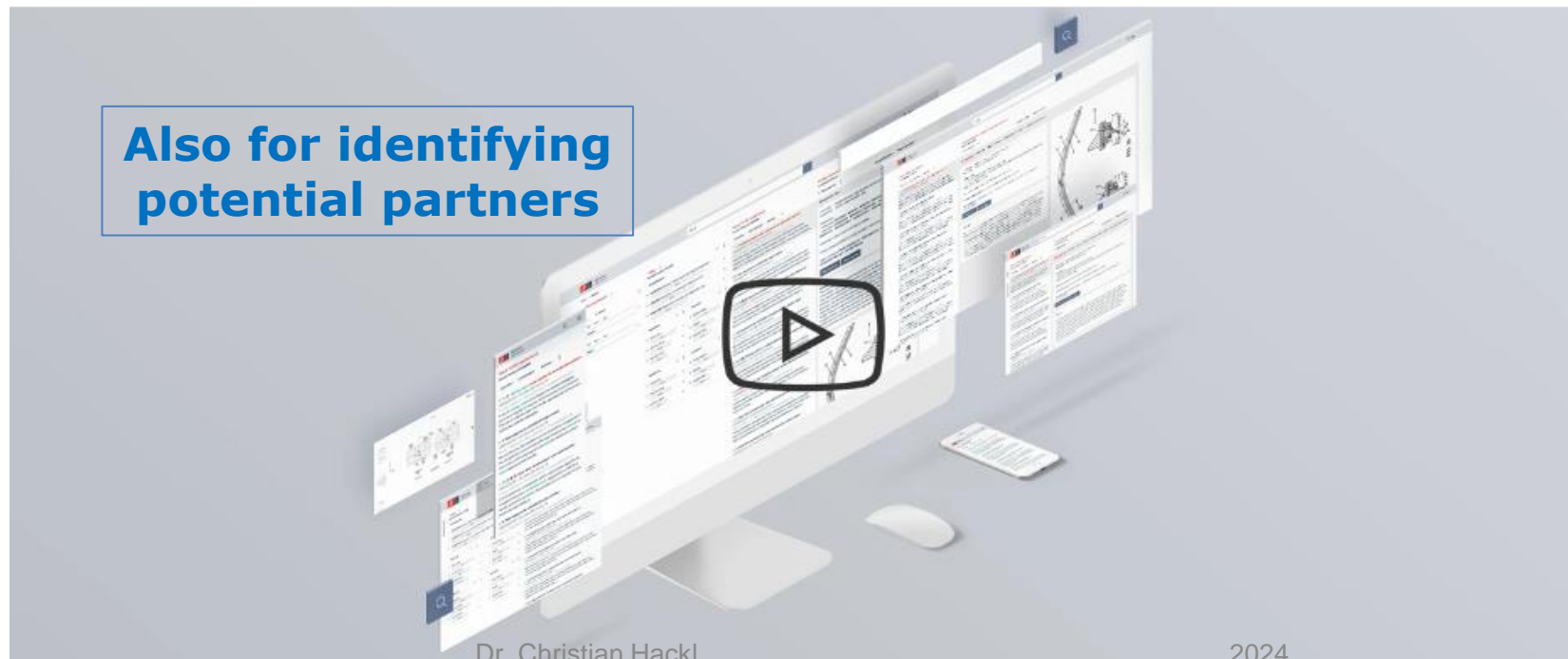
The Espacenet database (over 140 million docs)

<https://worldwide.espacenet.com>



Espacenet: free access to over 140 million patent documents

**Also for identifying
potential partners**





The Espacenet database (over 140 million docs)

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Related links +

Advanced search

Select the collection you want to search in [i](#)

Worldwide - collection of published applications from 90+ countries

Enter your search terms - CTRL-ENTER expands the field you are in

Enter keywords in English

Title: [i](#) plastic and bicycle

Title or abstract: [i](#) hair

Enter numbers with or without country code

Publication number: [i](#) WO2008014520

Application number: [i](#) DE19971031696

Priority number: [i](#) WO1995US15925

Enter one or more dates or date ranges

Publication date: [i](#) yyyymmdd

Enter name of one or more persons/organisations

Applicant(s): [i](#) Institut Pasteur

Inventor(s): [i](#) Smith

Quick access

Discussion forum

Classic Espacenet



The Espacenet (n docs)

The screenshot shows the Espacenet search interface. At the top, there is a search bar with the text "Enter your search" and a red circle highlighting the "Advanced search" button. Below the search bar, there are navigation tabs: "My Espacenet", "Help", "Classification search", "Results", and "Advanced search". The "Results" tab is selected, and the "Advanced search" button is highlighted with a red circle. Below the navigation tabs, there is a breadcrumb trail: "Home > Results". The main content area shows the search results configuration. It starts with "Query language: en de fr" and a dropdown menu. Below that, there is a section for "AND" search with a "+ Field" button. The search criteria are organized into two main groups: "AND" and "OR". The "AND" group contains two criteria: "Title" and "Title or abstract", each with a dropdown menu for "All" and a "Group" button. The "OR" group contains three criteria: "Publication number", "Application number", and "Priority number", each with a dropdown menu for "Any" and a "Group" button. Each criterion has a corresponding input field and a "Group" button. The input fields for "Publication number", "Application number", and "Priority number" are highlighted with red boxes. The input field for "Title" is highlighted with a blue box. The input field for "Title or abstract" is highlighted with a blue box. The input field for "Priority number" is highlighted with a red box. The input field for "Application number" is highlighted with a white box. The input field for "Title" is highlighted with a blue box. The input field for "Title or abstract" is highlighted with a blue box. The input field for "Priority number" is highlighted with a red box. The input field for "Application number" is highlighted with a white box.



The Espacenet

The Espacenet Patent search interface header includes the Espacenet logo, a search input field with the placeholder text "Enter your s...", and a navigation menu with items: "My Espacenet", "Help", "Classification search", "Results", and "Advanced". The "Results" and "Advanced" items are circled in red.

on docs)

Home > Search

Query language: en de fr ▾

OR ▾ + Field

Search criteria panel 1: OR ▾ + Field ×. It contains two identical rows. Each row has a dropdown menu set to "Title or abstract", another dropdown set to "All", and a "→ Group" link. Below each dropdown is an empty search input field with a clear "X" button.

Search criteria panel 2: AND ▾ + Field ×. It contains three rows. The first row has a dropdown set to "Description", another set to "Proximity", and a "→ Group" link. Below these is an empty search input field with a clear "X" button. The second row has a dropdown set to "<", a dropdown set to "3", and a dropdown set to "words away from". The third row has a dropdown set to "Description", another set to "Any", and a "→ Group" link. Below these is an empty search input field with a clear "X" button.

Also for identifying
potential partners



Let's assume:

You are in an ongoing R&D-project and would like to do a first FTO-analysis

- What would you do?
- Where would you search?
- You found a very similar patent (claims!)

In what part of the patent document would you search?

Is this the end?



A patent

- Has to be applied for
- Has to be granted
- Has to be valid (max. lifetime 20 years, renewal fees)
- Has to be valid in a certain territory





Let's assume:

You are during a R&D-project and would like to do a first FTO-analysis

- What would you do?
- Where would you search?
- You found a patent with very similar claims

Is this the end?

Not necessarily!



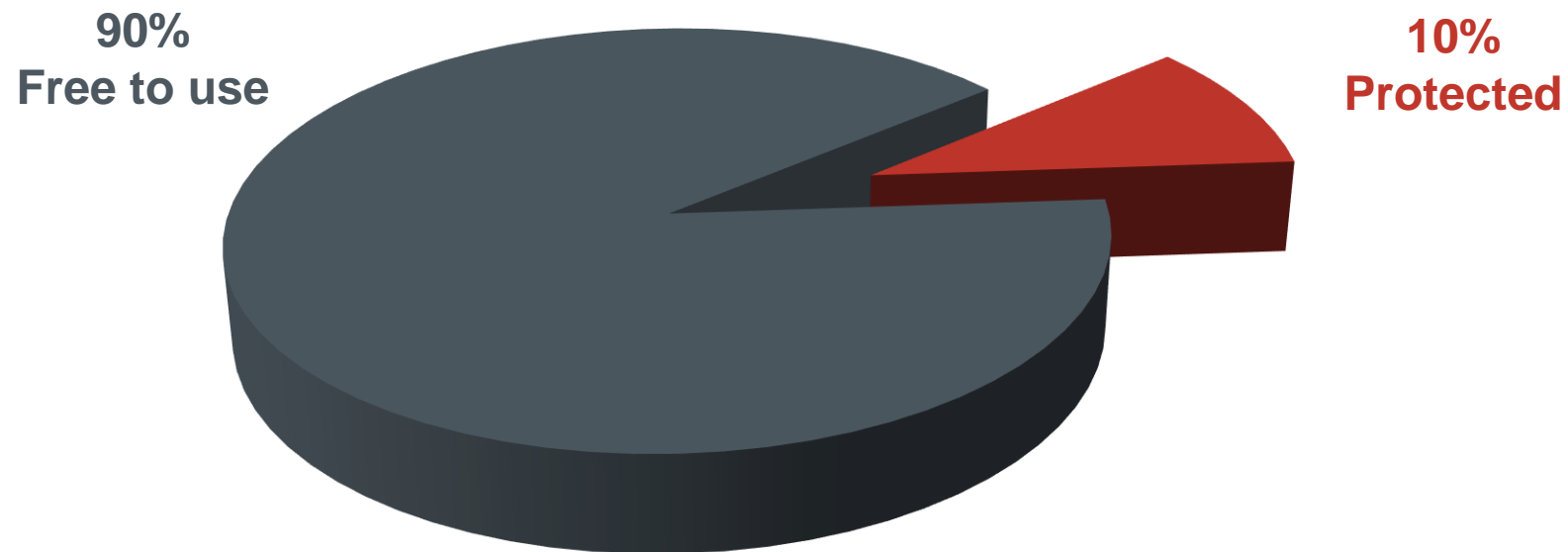
A patent

- Has to be applied for
- Has to be granted
- Has to be valid (max. lifetime 20 years, renewal fees)
- Has to be valid in a certain territory

18 months after filing, a patent (application) will be made public (appear in databases, such as Espacenet) – regardless of the legal status (if not withdrawn before)



Off all solutions found in patent documents



You can find many great solutions for free!



FTO-analysis

Before: search for any 3rd party IP-rights which can block your commercial activities

More precisely: search for any valid 3rd party IP-rights which can block your commercial activities in a certain geography

Business Strategy!



When would you do a FTO-analysis?

- Eg. before the start of a R&D-project (investment)

Remember: Patent protection for a new product



When can a patent be granted?

- **New**
- **Inventive**
- **Commercially applicable**



FTO versus Patentability Ia

Let's assume:

- You conducted a FTO-search before the start of a R&D-project
- You found a patent with very similar claims (not expired, valid in Japan only)
- Your business strategy: doing business in Europe

FTO



Patentability



Strategic question: Would you start the R&D-project, already knowing that you cannot get IP protection?



FTO versus Patentability I_b

Let's assume:

- You conducted a FTO-search before the start of a R&D-project
- You found a patent with very similar claims (expired patent, was valid in Japan only)
- Your business strategy: doing business in Europe

FTO



Patentability



Strategic question: Would you start the R&D-project, already knowing that you cannot get IP protection?



FTO versus Patentability II

Let's assume:

- You have a new idea: computer mouse which needs no cable or battery – it generates its electricity by the movement of the mouse
- Search: let's assume: you found no patent on this specific idea (valid or expired / no application)

Patentability



Check non-patent
literature as well

FTO



Many existing patents on basic
mouse – you build upon



(19)
Bundesrepublik Deutschland
Deutsches Patent- und Markenamt

(10) **DE 10 2008 017 546 A1** 2009.10.15

(12)

Offenlegungsschrift

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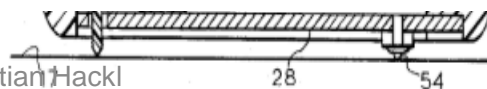
(74) Vertreter:

**Epping Hermann Fischer,
Patentanwalts-gesellschaft mbH, 80339 München**

(56) Für die Beurteilung der Patentfähigkeit in Betracht
gezogene Druckschriften:

DE 10 2005 016293 A1
EP 07 86 849 A1
US 2004/01 96 262 A1

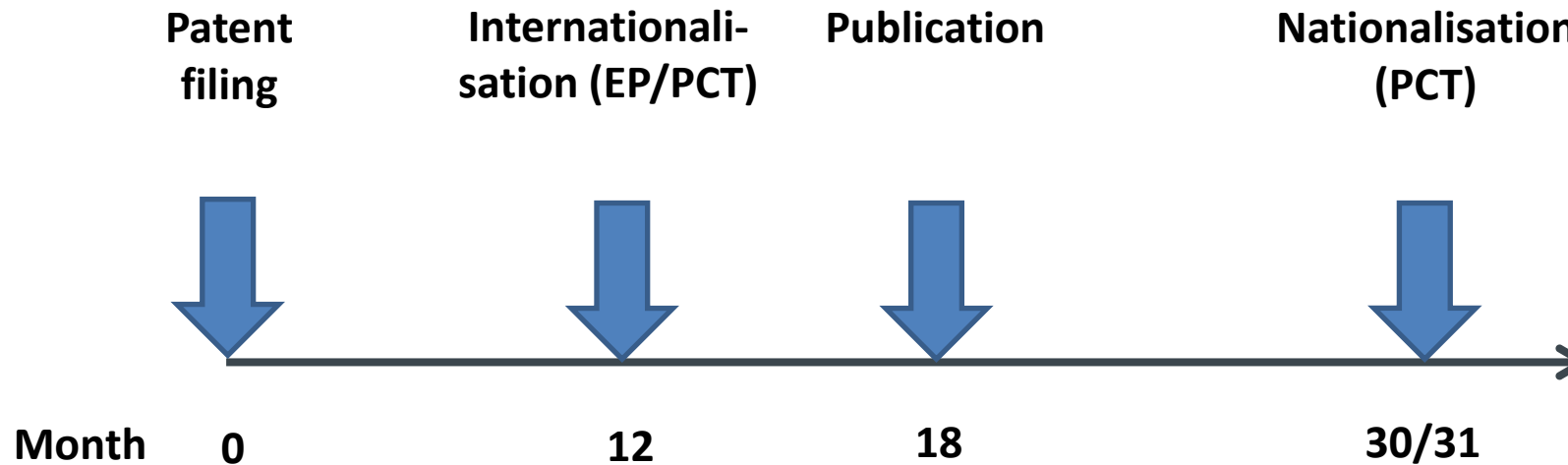
The invention relates to a computer mouse (1) for wireless operation of a computer system. A power supply for the computer mouse (1) is provided without the use of rechargeable batteries or batteries. For this purpose, the computer mouse (1) has a dynamo (2) and an energy storage device (3). By actuating the dynamo (2), energy is generated which is temporarily stored in the energy storage device (3).





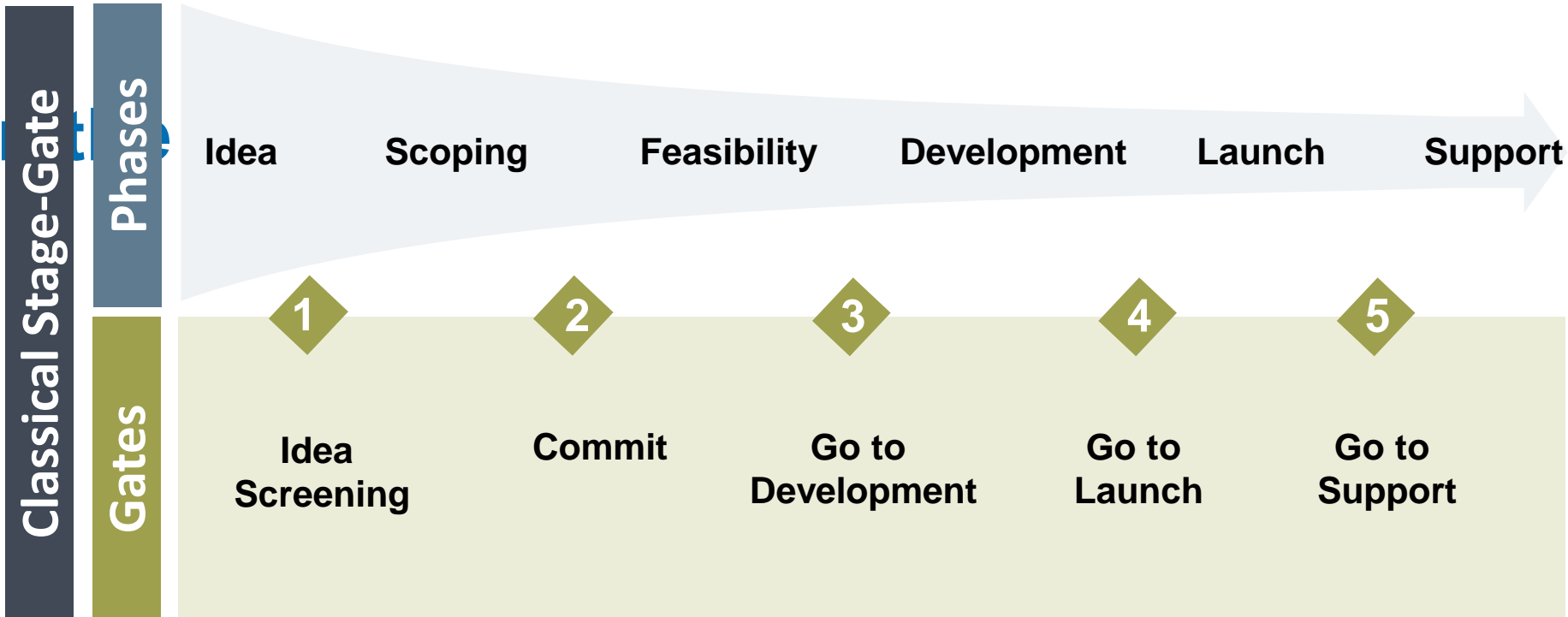
Ongoing Patent Monitoring

- Keep IP monitoring updated (FTO and technology/competitor watch)
- Keep in mind timing of events:





FTO in the





Possible Strategies

Let's assume:

- You did a FTO-search just before the end of the successful R&D-project
- You found a very similar European patent (you want to do business in EU)
- The patent is valid in main EU-member states

Your options:

- Wait for patent to expire
- Modify product / design around
- Move commercial activities (outside validated territories)
- Get a license (cross-licensing), buy patent (M&A)
- Try to invalidate 3rd party's patent
- Abandon R&D-project



Case study: FTO

https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/european-ip-helpdesk/europe-case-studies_en

The image shows the cover of a case study report. At the top left is the European IP Helpdesk logo. At the top right is a green circular badge with the text 'CASE STUDY'. The main image is a photograph of a traffic light with the green light glowing. Below the photograph, the title 'Freedom to Operate.' is followed by a short paragraph: 'How a rather late identified third party patent almost killed an innovation project – but ultimately resulted in a significantly improved product that has innovated the protective clothing industry.' At the bottom right, the website address 'www.iprhelpdesk.eu' is displayed.



Contact:

- Website: ec.europa.eu/ip-helpdesk
- helpline@iprhelpdesk.eu
- Twitter [@iprhelpdesk](https://twitter.com/iprhelpdesk)
- LinkedIn [/european-ipr-helpdesk](https://www.linkedin.com/company/european-ipr-helpdesk)





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