Identifying Inventions in the Public Domain: A Guide for Inventors and Entrepreneurs

Nathalie Montillot
Program Officer, Technology and Innovation Support Division
Presenter

Donna Perdue, Founder, Perdue IP Law, APC, San Diego, USA
Webinar: Asking questions
Webinar: Asking questions
Webinar: Asking questions
IDENTIFYING INVENTIONS IN THE PUBLIC DOMAIN:
A Guide for Inventors and Entrepreneurs

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

Presenter: Donna O. Perdue, Ph.D., J.D. • Perdue IP Law, APC
July 16, 2020
IDENTIFYING INVENTIONS IN THE PUBLIC DOMAIN: A Guide for Inventors and Entrepreneurs

**Purpose:** Help the reader determine whether specific inventions appear to be protected by enforceable patents, or may be in the public domain

**Process:** Teach the tools of freedom to operate (FTO) determination
- Concepts, practical training, checklists, templates, examples
- Risk management

**People:** Anyone involved with or interested in IP related to inventions
- Technology and Innovation Support Center (TISC) staff
- Inventors, entrepreneurs, engineers, managers, IP professionals
Scenario: An invention, a TISC, a question

Inventor/entrepreneur has an idea for addressing a problem
   = a plan for using an invention

Inventor/entrepreneur (“client”) visits a TISC:
   • Describes their plan: technical details and business information
   • Asks: Can they use the invention according to their plan? Any IP issues?
Framing the question

Initial question: Any IP issues related to the client’s plans?

Frame the question to allows search & analysis of patent information:

• Are there any enforceable patents with claims that could cover the client’s planned use of the invention?

Framed like this, the question can be addressed using the process of freedom to operate (FTO) determination taught in the WIPO Guide.
Guide teaches a three-stage process of FTO determination

**DESCRIBE**
- Collect & organize information from client
- Describe client’s invention

**SEARCH**
- Develop search terms for client’s invention
- Search patent databases for potentially relevant patent documents

**ANALYZE**
- Compare claims in search results with client’s invention
- Legal status
- Final determination

Webinar: Overview of the WIPO Guide on Identifying Inventions in the Public Domain • Donna O. Perdue • Perdue IP Law, APC • July 16, 2020 • All rights reserved
Limits, risks, caveats, disclaimers for the guide

The WIPO Guide:

• Teaches concepts and tools of FTO determination
• Teaches ways to use FTO tools in a technical manner
  • Understanding the limitations and risks

The WIPO Guide:

• Does not teach legal analysis or provide guarantees
• Does not consider whether the client’s invention is patentable
• Does not teach patent searching
• Does not teach a “treasure map” to find public domain inventions
## Structure of the guide

<table>
<thead>
<tr>
<th>Basics</th>
<th>How-to</th>
<th>Risks</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Module I. Patents &amp; the public domain</strong>&lt;br&gt;Legal &amp; technical basis for FTO</td>
<td><strong>DESCRIBE</strong>&lt;br&gt;Module II. Information needs&lt;br&gt;Collect &amp; organize information</td>
<td><strong>Module V. Limits &amp; risks</strong>&lt;br&gt;Manage risks at every stage</td>
</tr>
<tr>
<td><strong>Module II. Information needs</strong>&lt;br&gt;Collect &amp; organize information</td>
<td><strong>SEARCH</strong>&lt;br&gt;Module III. FTO Search&lt;br&gt;Develop search terms; search</td>
<td></td>
</tr>
<tr>
<td><strong>Module III. FTO Search</strong>&lt;br&gt;Develop search terms; search</td>
<td><strong>ANALYZE</strong>&lt;br&gt;Module IV. FTO analysis&lt;br&gt;Analyze claims &amp; legal status; compare</td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
Module I. Patents and the public domain

Learn fundamental IP principles and concepts:

• How patent rights are created, interpreted, enforced
• How an invention may be covered by multiple patents
• How to explore patent rights around an invention using FTO tools
• What is a public domain invention
Key concepts for FTO

• Patents have limits
  • Patent rights are defined by the **claims** of a granted patent. Claims control scope of “the patented invention”
  • A patent is enforceable **only** in the granting country & for a limited time

• **Multiple patents can cover an invention**
  • Innovation is incremental: a new invention can use a previously patented invention as a feature
  • An earlier patent can cover a feature of an new invention
Key concepts for FTO: Example

Inventor developed a new water filter system = a new invention

- Start with commercial water filter & add second filter unit
  - Paper pre-filter + chamber with local clay and sawdust.


<table>
<thead>
<tr>
<th>Commercial filter</th>
<th>+</th>
<th>Paper pre-filter</th>
<th>+</th>
<th>Inventor: new chamber with clay &amp; sawdust</th>
<th>→</th>
<th>New filter system</th>
</tr>
</thead>
<tbody>
<tr>
<td>Patent A1 for filter &amp; methods of use</td>
<td>Expires 2022</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Patent A2 for paper pre-filter</td>
<td>Expires 2030</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Webinar: Overview of the WIPO Guide on Identifying Inventions in the Public Domain • Donna O. Perdue • Perdue IP Law, APC • July 16, 2020 • All rights reserved
A public domain invention is:

- a **publicly disclosed** invention
  - that is **not** covered by **any enforceable patents**
  - in a specific country, at a defined time
  - such that anyone may freely use the invention
  - in that country at that time,
  - without liability for patent infringement
# Basics

**Module I. Patents & the public domain**
Legal & technical basis for FTO

# How-to

<table>
<thead>
<tr>
<th>Basics</th>
<th>How-to</th>
<th>Risks</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Module I. Patents &amp; the public domain</strong></td>
<td><strong>Module II. Information needs</strong></td>
<td><strong>Module V. Limits &amp; risks</strong></td>
</tr>
<tr>
<td>Legal &amp; technical basis for FTO</td>
<td>Collect &amp; organize information</td>
<td>Manage risks at every stage</td>
</tr>
</tbody>
</table>

**Module II. Information needs**

**Describe**

- Module II. Information needs
  - Collect & organize information

**Search**

- Module III. FTO Search
  - Develop search terms; search

**Analyze**

- Module IV. FTO analysis
  - Analyze claims & legal status; compare

---

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

- Donna O. Perdue • Perdue IP Law, APC • July 16, 2020 • All rights reserved
Module II. Identifying technology information needs

Learn to gather & organize information to describe the client’s invention in a format that can be used for FTO determination

• Gather information from client about invention and plans for using it
  • Interview questions at Figure 2

• Organize information
  • Describe the invention in technical terms; follow-on analysis
  • Develop a complete description of the invention; identify features
  • Identify possible countries & time frames
• Summary Report  - template at Annex A. 2
Module III. FTO Search: Finding sources of information to identify inventions in the public domain and carrying out an FTO search

Learn to search for patent documents with claims that may be relevant to any feature of the client's invention

- **Prepare** for search
  - Generate inputs
    - Key words
    - Patent classification codes
    - [Non-text inputs]
  - Select database(s) to search; find tools; choose limits

- **Search**
  - Use a hybrid strategy: key words and patent classification codes
  - Review, refine, repeat → stop

- **Collect & organize results** in search report
Key words: Use tools

Generate

Curate

Ex: rebaudioside

Webinar: Overview of the WIPO Guide on Identifying Inventions in the Public Domain  •  Donna O. Perdue  •  Perdue IP Law, APC  •  July 16, 2020  •  All rights reserved
Ex: Invention is a roof tile with photovoltaic cell

WIPO IPCCAT
• Most relevant IPC H02S 20/25
FTO Search & Search Report

Use a hybrid search strategy with different types of inputs

- Key words/phrases find similar language
- Classification codes find similar technology

Organize search results and generate search report
- Sort or rank search results
- Identify potentially relevant patent documents
- **Search report** – Organized search results and optional comments
Why a hybrid strategy? Example using mask invention

Client: face mask with extra layers to stop dust and sand, ear loops

Key words: face mask, protective mask, filtering mask, respiratory mask, anti-dust mask

IPC code: A41D13/11 Protective face masks, e.g. for surgical use, or for use in foul atmospheres. Search A41D13/11 inventive = 535; 298 w/o “mask”

Use hybrid search because key words alone might not find claims that do not use “mask” in the claim language, such as:

- An optically supported polygonal barrier to respiratory pathways . . . OR
- A respiratory protection device comprising a central panel of filter media, and upper & lower panels with engageable extensions to form a chamber over the face.
Module IV. FTO Analysis:  
Reading Claims and Legal Status Information

Learn tools to evaluate whether FTO search found any patent documents that could potentially affect the client's plans to use the invention:

- *Informal* FTO analysis of claim scope and legal status
- Determinations for each patent document you analyzed
- Final Report to communicate your findings to the client
  - *Technical report of FTO search & analysis; no legal conclusions*
FTO analysis: Claim scope & legal status; final determination

Infringement analysis of claims
• Determine potential scope of a claim ("claim construction")
• Compare claim with the client’s invention; classify each claim

Legal status determination
• Determine whether a patent is enforceable in the country of grant, at the time when the client plans to use the invention in that country
• If FTO search included applications, determine legal status of application

Final determination:
• Classify each patent based on infringement analysis and legal status
• Sometimes a final determination cannot be reached
Final Report

Summary of the invention & FTO search

FTO Analysis: Use technical language
- Identify all documents analyzed, e.g., in a table showing final determinations
- Discuss specific documents you want to bring to the client’s attention
- Identify potential coverage, potential clear spaces, and unsettled issues

CONCLUSIONS: This may be the only section the client will read in detail
- No conclusion regarding public domain status is required
- Do not use legal language, or make legal conclusions, or offer legal advice
- Discuss limitations and risks: include disclaimers
Risk management for FTO determination

FTO determination involves making a series of informed guesses based on the best information available at the time

Guide teaches strategies to recognize & manage risk at each stage:
• Risk cannot be eliminated, only managed
• Inform clients of risks and limitations
• No legal advice, no guarantees

Webinar: Overview of the WIPO Guide on Identifying Inventions in the Public Domain  • Donna O. Perdue  • Perdue IP Law, APC  • July 16, 2020  • All rights reserved
Thank you for your attention

Donna O. Perdue  
Perdue IP Law, APC  San Diego, CA  USA  
donnaperdue@perdueiplaw.com  
www.perdueiplaw.com
Question & Answer session

Please wait a moment while we review your questions...

tisc@wipo.int
What’s next?

- Ask the Expert session on eTISC
  - Dates: July 27 to August 7, 2020
  - Link: [https://etisc.wipo.int/ask-the-expert](https://etisc.wipo.int/ask-the-expert)

- Ask the Expert session on the Guide on Using Inventions in the Public Domain until July 23
  - [https://etisc.wipo.int/ask-the-expert](https://etisc.wipo.int/ask-the-expert)

- Guides: [https://www.wipo.int/tisc/en/](https://www.wipo.int/tisc/en/)