BULLETIN

TIPS FOR PROTECTING PATENT RIGHTS IN PUBLIC FORUMS

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Public Invention Disclosure in the Eyes of the Law

Under U.S. patent law, inventors have a one-year grace period to file for patent protection after the first public disclosure. U.S. patent rights are lost one year after the public disclosure. International patent rights for most countries are lost immediately upon public disclosure. Note: international rights can account for as much as half the value of an invention.

What Makes it an Enabling Disclosure?

In order to impact patent rights, the disclosure must be *enabling* -- that is, it must teach someone "of ordinary skill in the art" how to actually duplicate the invention without undue experimentation. *Helefix Ltd. v. Blok-Lok, Ltd.*, stated “Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.” This case dealt with a marketing brochure boasting the advantages of a process, but not enough information for the process to be duplicated; therefore, it lacked an enabling disclosure.

The University of Colorado Technology Transfer Office strongly supports publication, open collaboration and academic freedom. We do not believe that all potential inventions can or should be kept confidential, and we believe that disclosure of inventions is an important step in furthering knowledge and commercialization.

What Makes it a Disclosure that is Accessible to the Public?

Accessibility means “interested members of the public could obtain the information if they wanted to.” (*Constant v. Advanced Micro Devices, Inc.)* Most books and technical journals are considered publications that are clearly accessible to the public. If an invention is disclosed in a confidential document or distributed as internal use only and marked accordingly, then it is NOT a publication. However, if the invention is distributed via a small number of copies without any restrictions, then it can be considered a publication. If accessibility is proved, there is no requirement to show that particular members of the public actually received the information. The court decision *In re Hall*, 781 F.2d at 899 was concerning a doctoral thesis which was deposited in a university library in Germany where it was, theoretically available for review. The court found that a single cataloged thesis in one university library is publicly accessible, even if it was never accessed by anyone.

The purpose of this document is to describe common scenarios that the courts may consider a “public disclosure” and some steps that you can take to lower the risk that the disclosure would be considered “public.” The definition of public disclosure is a gray area within the law; nothing short of a confidential disclosure agreement (CDA) or similar agreement can guarantee that an information exchange would be considered non-public. However, the following page offers some steps you can take that would allow us to make the argument that your disclosure was not public.

(*Continued on next page)*

TECHNOLOGY TRANSFER OFFICE

What the courts may consider a "public disclosure"	Steps you can take to increase the chances that patent rights will be protected
Presentations at conferences, even without any printed handouts.	• Talk to the TTO about filing a provisional patent prior to the conference.
Presentations at research group meetings, if information on the time and location of the meeting is available to the public.	• Advertise research group meetings through a channel that is only open to CU faculty, staff and students. • Adopt a policy of closing the research group meetings to anyone other than faculty, staff and students who are involved in the research group. Announce the closed meeting policy in conjunction with information about the meeting (place and time). • Make sure participants understand that the ideas discussed in the research group should remain confidential. If confidentiality is not established for the research group in general, ask the group to keep a particular idea confidential if it is something that you would like the TTO to consider patenting.
Research abstracts that are published before meetings either online, in printed materials or in any public forum.	• Make sure that the research abstract is not an enabling description. • Alert the TTO to the date that the abstract will be posted.
Posters shown at public meetings.	• Talk to the TTO about filing a provisional patent prior to the poster session. • It may not be necessary to include an enabling description on your poster depending on the forum and the stage of your research.
Posting of information on websites, including postings on your individual lab web sites.	• Create a password-protected section of your website for collaborators and students. • Make sure that new (unpublished & unpatented) material on the public website is not enabling.
Cataloged thesis or dissertation.	• A student can graduate without having their thesis catalogued and shelved in the library. Request that the library hold a thesis until a patent can be filed.
Thesis defense that is publicly advertised.	• Talk to the TTO about filing a provisional patent prior to the thesis defense, or hold the enabling details for the closed portion of the thesis defense.
Grant applications that are published. (Portions of most federal grant applications are publishable upon acceptance.)	• Find and follow the instructions of the granting organization for keeping certain portions of the grant application confidential.
Submitting an article for publication.	• Most journal reviewers are under a confidentiality obligation. Check the policies of the journal with respect to confidential review.
Articles published online in advance of the printed journal.	• Make sure the TTO is aware of the date that the article will be available online. That is the legally relevant publication date.
Meetings with company representatives or colleagues outside CU where information is disclosed without a confidentiality agreement.	• Ask the recipient to agree that the information is conveyed in confidence. If the patent is ever litigated, your colleagues may be called on to sign an affidavit that they understood the meeting to be confidential.

Keep in mind that these steps cannot guarantee that the disclosure was not "public" and that patent rights will not be lost; some courts may still find that a disclosure is public even if you have followed these suggestions. For example, some courts may believe that a discussion with your colleagues at another research institution would be public because nobody has signed a confidential disclosure agreement. Because such collaboration is critical to a thriving research enterprise, we must continue to be open. We encourage you to take reasonable precautions to preserve patent rights without getting in the way of openness and academic freedom.

References:

Durham, Alan L. Patent Law Essentials – A Concise Guide. Second Edition. Westport, Connecticut: Praeger, 2004.