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THE IMPACT OF PUBLIC DISCLOSURE ON PATENT PROTECTION

When the issue of patentability arises, one of the first questions that an inventor will be asked is whether there has been a public disclosure of the invention. The timing of public disclosure is often the controlling factor in determining patentability of an invention.

RULE 1: For protection in the U. S., inventors have one year to file a patent application after the first public disclosure. However, to obtain protection in most foreign countries, a patent application must be filed **prior to** any disclosure to the public (in other words, in foreign countries there is generally no one-year grace period as there is in the United States).

To determine the last date for filing a patent application, we must first decide when the first public disclosure of an invention will (or already did) occur.

RULE 2: Under United States law, a public disclosure occurs when an invention is:

A. Described in a printed publication anywhere in the world;

B. Placed in public use in the United States; or

C. Offered for sale in the United States.

This definition (taken from the United States Code) isn't as clear cut as it sounds. Rule 2 will provide guidance only if the *legal* meaning of the individual terms is explained in the context of patent law. The remainder of the rules devised by this author attempt to provide a framework for that analysis.

RULE 3: For U.S. patent purposes, a "printed publication" is any communication that:

A. Appears in a fixed-media form (i.e., not necessarily "printed");

B. Is considered to be available to the public (either because it was intended to be made public, as an article in a scientific journal, or because it was made without an obligation of confidentiality, as a casual letter to a friend); and

C. Describes an invention in such detail that one familiar with the field ("skilled in the art") could duplicate it or put it into use.

Virtually anything is deemed to be a printed publication for patent purposes. The most obvious examples include books and treatises, articles in scientific or trade journals, and articles in newsletters and bulletins. However, printed matter that is less obviously available to the public is generally more likely to cause the inadvertent loss of patent rights.

RULE 4: The fact that a reasonable person wouldn't consider something to be a printed publication doesn't mean that it isn't. (Translation: Under the right circumstances, virtually *anything* can constitute a printed publication for patent purposes.)

For example, a printed publication may occur in each of the following circumstances: • the placing of a thesis or dissertation on the library shelves or on the Internet • the cataloguing of a thesis or dissertation for microfilm distribution • the submission of an abstract as a proposal for a book or journal • the e-mailing of an abstract to prospective attendees of a professional conference • the appearance of a newspaper or web article written by a reporter who attended an oral presentation • a poster presentation • participation in a television or radio interview • the submission of a proposal to a federal agency • making a report to a public or private research sponsor.

To impact patentability, the disclosure must contain a description of the invention that is detailed enough to enable a person skilled in the art to duplicate or use it (see Rule 3.C. above). This requirement is sufficient to exclude some abstracts, articles, etc., from the realm of public disclosure. But as a practical matter, when deciding whether or not to discuss an invention in any way outside of your own research environment, you should assume that it will constitute a public disclosure for patent purposes. Thus arises a real dilemma for the academic researcher: how to reconcile the desire to patent one's inventions with the necessity of publishing the results of one's research.

RULE 5: When faced with the choice between publishing versus patenting, the best solution is to check with UTRF to determine if anything can be done to lessen (or even eliminate) the impact of publication on potential patent rights.

Publication is the most common route for loss of potential patent rights. If at all possible, it is best to inform UTRF about the existence of a new invention *prior* to publishing -- doing so could prevent the unnecessary loss of patent rights. Even after a publication occurs, all is not lost in terms of United States patent rights (remember the one-year grace period), so submitting an invention disclosure form is still worthwhile. It is always better, however, to address the patent issue before a public disclosure rather than after.

RULE 6: Depending on the particular situation, any one of the following alternatives may be an appropriate method of dealing with the "publish vs. patent" dilemma:

A. The most attractive alternative (because it allows the faculty inventor to publish *and* patent) is to file a United States patent application prior to publishing any information concerning the new technology. In that case, there would be a grace period of one year within which to decide whether to pursue patent protection outside the United States. The only drawback to this alternative (albeit a significant one) is the expense of filing a patent application on an invention that is probably at a very early stage in terms of technical development and that may have unknown commercial potential.

B. Also without loss of any potential patent rights, the faculty inventor can publish broad generalities regarding the new technology, carefully avoiding the disclosure of information that might be "enabling." In other words, the publication would not include enough information for a person "skilled in the art" to duplicate the invention. This is probably the most dangerous

alternative due to the possibility that the faculty inventor may unwittingly disclose sufficient information for the publication to qualify as an "enabling" disclosure in the opinion of the Patent Office.

C. Alternatively, the decision can be made to publish the new technology in detail prior to patenting, thereby abandoning (in all probability) any hope of foreign patent protection, but reserving the right to file for a United States patent within one year of the publication date. This is also dangerous for technologies that require worldwide distribution – many companies will not license technologies that cannot give them a competitive advantage in a global economy.

An offer for sale or a public use of the invention will *also* constitute a public disclosure (see Rule 2 above). Again, the types of activities that will constitute an offer for sale or a public disclosure are determined on a case-by-case basis.

RULE 7: For patent purposes, a "public use" may be:

A. Any use of the completed invention by someone who is not under a duty to keep the invention a secret;

B. Any authorized commercial use of the completed invention (even if the invention is kept secret).

It is clear from Rule 7 that a "public" use need not be public at all -- in fact, it may be very private. However, there *are* exceptions and each case will be decided on its own facts. As a result, what may be a public use in one situation in one court may not be a public use in another situation in another court. When attempting to decide whether a proposed use will constitute a "public use" for patent purposes, the safest route is to assume that Rule 7 is to be interpreted broadly. By doing so, patent rights won't be inadvertently lost by engaging in an activity that you think is acceptable but later turns out to be a "public use" of the invention. However, there is one significant caveat to the "public use" rule that is important for academic inventors:

RULE 8: A so-called exception to the "public use" rule as stated above is a *bona fide* experimental use, if its motive is truly the testing and/or perfection of the invention.

In determining whether a use is truly experimental, the courts have developed a laundry list of factors to consider, but the focus of the inquiry is the inventor's *motive*, as evidenced by his or her behavior. If the inventor's motive in allowing the public use was primarily commercial, patentability will be barred unless a U.S. patent application is filed within the one-year grace period.

RULE 9: A single offer to sell an article, device, or composition embodying the invention is enough to bar patentability, even if that offer is not accepted.

Rule 9 applies only to a physical *embodiment* of the invention. Thus:

RULE 10: The licensing or assignment of rights in an invention or a patent does not constitute placing the invention "on sale." Only the sale or offer for sale of a "thing" embodying the invention or capable of performing the invention will result in an "on sale" bar to patentability.

All the foregoing can probably be distilled into one simple rule, which, if followed, will prevent the *inadvertent* loss of patent rights through public disclosure:

RULE 11: Assume that *any* non-secret disclosure or non-experimental use of an invention will impact patentability. Investigate the options available to you prior to taking such action if at all possible, but don't assume that all patent rights are lost simply because a public disclosure has already occurred.

Faculty and staff of The University of Tennessee are encouraged to contact the University of Tennessee Research Foundation with questions concerning the issues raised in this paper.

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