

# **Public Disclosure and Its Impact on the Ability to Patent**

by Simran Trana

## **What Constitutes Public Disclosure for Patent Purposes?**

Disclosure of inventions to the public is a critical element in determining whether an invention is patentable or not. Under US patent law it is one of the three requirements for an invention to be patentable. The other two requirements are utility and non-obviousness. All countries implement some version of these three elements as a condition of patentability. There is, however, some variation among countries as to what constitutes disclosure and what impact it has on your ability to patent. Following is some guidance regarding publication/academic practice that may constitute disclosure for patent purposes.

### **Written Disclosure**

Manuscripts, book chapters, journal articles, proceedings, thesis, posters, proceeding abstracts, pre-print, and the like are all different forms of publication that may constitute disclosure. Some circumstances and corresponding guidelines in terms of defining when a disclosure is considered to occur are:

#### Grant Proposals

Grant proposals to federal agencies are deemed publications as they are accessible under Freedom of Information Laws, but you can take active steps to ensure that information you provide under grant proposals is maintained in confidence when necessary. The first page of the proposal should carry the following notice:

Confidential Information  
Pages \_\_ to \_\_ of THIS PROPOSAL contain potentially patentable  
information

List the pages containing the confidential information and write “CONFIDENTIAL” on each page that contains the confidential information.

#### Publications

The public disclosure date in most cases is the date, after acceptance of the paper, that it is posted on the web or mailed out for distribution. The submission and review phase is confidential and is not considered publication. It is probably good practice to contact the Office of Technology Commercialization (OTC) when you have a final manuscript ready for submission to explore its potential commercialization.

#### Thesis

The date of disclosure of the thesis is the date when it is actually indexed and made available to the general public on a library shelf. In cases where you wish to preserve the confidentiality of information that is disclosed in a thesis you can request that the thesis be kept in a secure section and not be made available to the public.

### Posters, Abstracts, Proceedings

The date that these are made available for circulation is the date of the disclosure.

### Private Correspondence

Providing information to individuals outside Purdue University by email, letters or other correspondence without indicating that the information being provided is confidential could also constitute disclosure.

## **Oral Disclosures**

Oral presentations are a gray area in terms of whether they constitute disclosure or not. If at a formal talk, you distribute a copy of your presentation in which your invention is disclosed, it is clearly a disclosure. However, even if handouts are not provided but someone in the audience takes detailed notes that describe the invention, it would also constitute disclosure. For these reasons you need to carefully plan your oral presentations so that you do not inadvertently disclose your invention. Following are some examples of oral disclosures that may bar patenting.

### Thesis Defense

At Purdue University all thesis defense presentations are open to the public. Even if you do not distribute a copy of materials you may use during your presentation and defense, the meeting may constitute disclosure under US patent law depending on the level of detail provided regarding the invention.

### Departmental Seminars

Since these events may be widely publicized and attendance is not based on invitation, depending on the level of detail provided regarding the invention, they may constitute disclosure under US patent law.

### Meetings

Discussion with outside parties as small as one person may constitute disclosure if made without any express statement that the information being disclosed is confidential and is followed up within 30 days with a written description of the disclosure.

## **Public Use or Sale**

Distribution of research materials and prototypes, that embody the invention, may constitute disclosure under certain conditions. If the materials are provided without any restriction on use or further distribution it may be considered to be made available to the public. If they are clearly provided only for testing and/or evaluation or for research purposes under written agreements clearly specifying the same, it would not be considered disclosure. A sale or an offer to sell a research material or prototype also constitutes disclosure and could establish a bar date for patent purposes.

## **When Does a Disclosure Not Affect Patentability?**

Not all disclosures result in loss of potential patent rights. In order for a disclosure to bar the patenting of any invention it has to be enabling. This means that the disclosure has to provide enough of a description of the invention for a person skilled in the art to understand and practice it.

Under US patent law, there is also a grace period of one year after the date of an enabling disclosure within which you can still file a patent application to protect your invention. However, there is no such grace period in a majority of countries including Europe, Japan and Australia. An enabling disclosure would thus considerably limit the potential commercial benefit of your invention.

Disclosing inventions to OTC at the time you submit a paper for publication, or earlier, is essential to allow for protection of patent rights while ensuring unrestricted publication. When you believe you have an idea that has commercial potential, please contact OTC prior to disclosure for a consultation. That is the best way to ensure that you will be able to get the broadest possible protection for your invention and thus protect the broadest possible market for its application. Please contact Molly Byers, OTC Receptionist, at 4-2610 or email her at [mjbyers@purdue-research-foundation.org](mailto:mjbyers@purdue-research-foundation.org) to set up a meeting with one of OTC's commercialization associates.

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