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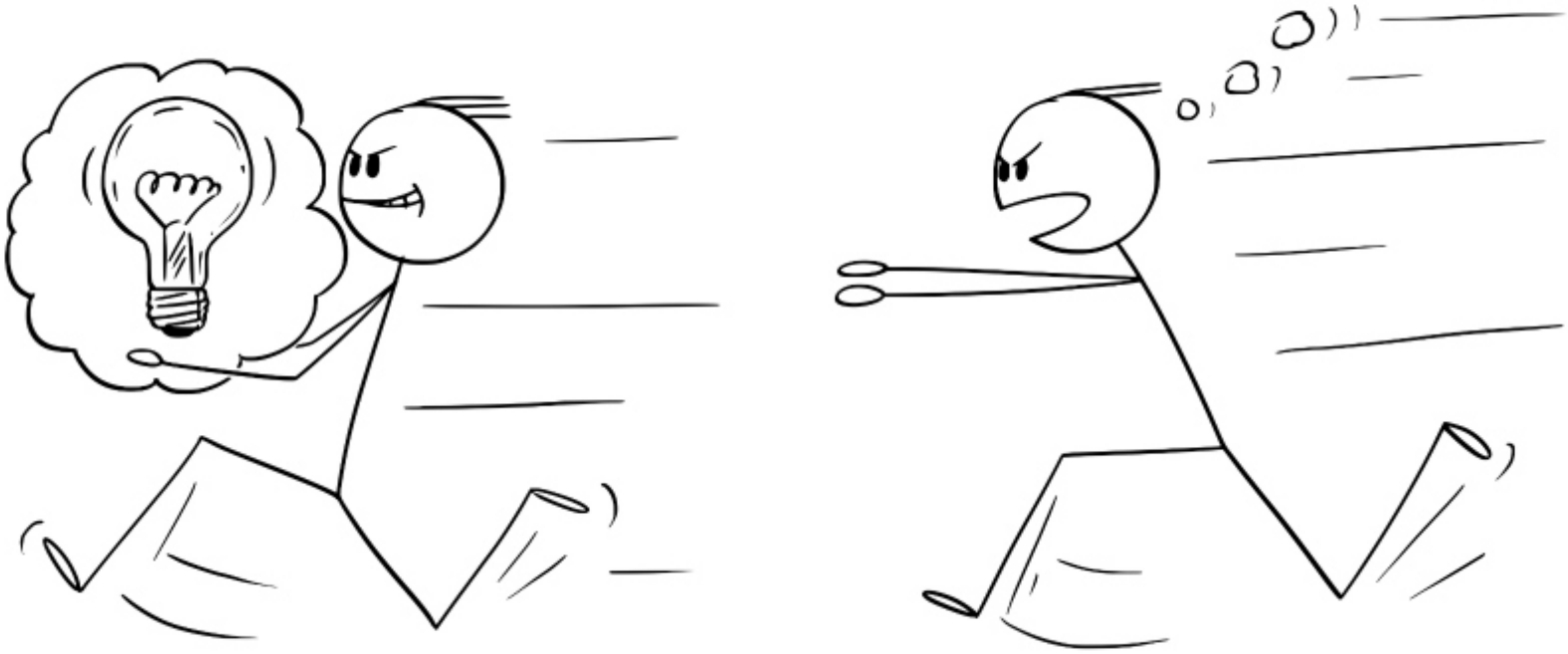

Triage for Inadvertent Invention Disclosure

Ryan Marshall, JD ▪ August 15, 2019

Academic leaders are responsible for obtaining value from innovations developed at a university. Importantly, innovation value can vanish when there is an inadvertent disclosure of an invention. A hallmark requirement for patent protection is an invention's novelty. Many countries have absolute novelty requirements. What happens if a discovery is published or otherwise disclosed before a patent application is filed, and the so-called cat is out of the bag? What value can the university salvage?

Patent offices around the world assess an invention's novelty by reviewing the applicant's claims against the *prior art*: generally, anything that was publicly known prior to a patent application's filing date. Importantly, an invention's public disclosure, even by the inventor or applicant, can jeopardize the invention's protectability. In most countries, therefore, the short answer is that the invention rights are forfeited to the public as the details of that invention were disclosed prior to the filing of a patent application. That can be a very difficult outcome when the invention has promising commercial potential.

Grace periods

Fortunately, some countries have grace periods for applicants who make public disclosures prior to filing a patent application. Patent offices in these countries will not consider as prior art disclosures made by the applicant during the grace period or, in some circumstances, when a person obtained knowledge from the applicant.

Grace periods permit applicants to seek patent protection despite an invention's public disclosure. In some countries, grace periods are limited to specific types of disclosures, such as displays at officially recognized exhibitions, presentations at officially recognized academic or technical meetings, publications by officially recognized journals, and experimental testing. Official exhibitions are international meetings, organized by a country on a government-to-government basis, that exhibit goods from another country.

In addition, grace periods can protect a patent application from indirect public disclosure. That is, public disclosure made by a third party, who improperly or unlawfully derived from the applicant (e.g., through theft), might also be excused as prior art. Unauthorized disclosure, in which public disclosure is made in breach of the applicant's confidence, may also benefit from grace periods.

Grace periods do not apply when an independent third party makes a disclosure. A grace period will not protect an invention if a third party's independent creation and disclosure precede a patent filing. In competitive fields, therefore, it truly is a race to the patent office.

Patent offices also have different requirements for applicants to qualify for a grace period. For example, applicants may be required to inform the patent office about the public disclosure at the time of filing the patent application. Applicants may also need to provide the public disclosure within a prescribed time after filing an application or a legal statement detailing the disclosure.

Grace periods, where available, vary by country and typically last for six or 12 months. There are at least two methods for calculating grace periods.

One measures the grace period according to priority rights. Priority rights allow an applicant to file a subsequent application with a patent office and claim the filing date of a first application (referred to as the priority application) with a foreign patent office as if it had been filed on its priority date. The subsequently filed application is said to claim priority to the first application. This method effectively allows applicants to stack the grace period with the period for claiming priority. That is, the grace period ends on the filing date of the first application in any country from which priority is claimed. This how the grace period is calculated in the United States. Accordingly, a US provisional or non-provisional must be filed within one year of the prior public disclosure to take advantage of the grace period in the US.

Another method measures the grace period from the date a patent application is filed with that national patent office. Canada uses a 12-month grace period for prior art based on the Canadian filing date. The Canadian grace period ends on the date a Canadian patent application is filed with the Canadian Intellectual Property Office. Applicants who use Patent Cooperation Treaty filings, a filing technique commonly used for broadly handling international patent rights, might not get the benefit of a grace period unless they instead directly file in a country that calculates grace periods in this manner.

Where can I file once the cat is out of the bag?

The World Intellectual Property Organization offers a useful summary of grace periods applicable to patent filings. That summary demonstrates that there is no uniform law or rule, particularly in view of the types of disclosure permitted. Thus, you will need to work closely with your patent counsel to assess whether a potential grace period applies to each specific prior disclosure and facts. Your patent counsel may need to work with attorneys in each of the relevant jurisdictions where a grace period might apply.

Is the cat really out of the bag?

It may still be possible to obtain valid patent protection in countries without grace periods or where a grace period has ended. An invention remains novel if the information publicly disclosed does not enable a person of ordinary skill in the relevant art to perform the invention without undue experimentation. Whether disclosure is enabling depends on the facts of each case. If the early disclosure does not provide enough details to make and use an invention, then the earlier disclosure may not be prior art after all.

Also, even when the broad invention is disclosed, significant value may be found in subsequent innovations. Innovation often begets more innovation, and patent protection may be available for subsequent inventions. So, when working with a disappointed inventor who made a public disclosure, encourage them to seek protection for improvements.

Academic leaders should review intellectual property policies, educate institutional employees, and require contractual confidentiality obligations with third parties to ensure that inadvertent disclosures are prevented. Then, when accidental disclosures happen, they can evaluate why and how the institution can better safeguard its procedures for preserving inventive discoveries.

Ryan Marshall, JD, is a seasoned life science patent lawyer located in Salt Lake City at Brinks Gilson & Lione, with experience in the pharmaceutical, biotech, chemical, and medical device industries. He is known for his thoughtful and creative approaches to address complex intellectual property issues, whether in litigation or in procurement.