

IP Questions & Expert Answers

Grant applications:

Question: Can we verify which (if not all) federal agencies I can submit grant proposals to without fear of disqualifying a patent application before and after a provisional application is submitted? Are there any confidentiality statements that MUST be included in our grant proposals?

Answer: The general rule is that applications for federal grants are not available to the public. If the application is not funded it remains confidential. If the application is funded the abstract is made available to the public, and the rest of the funded application is available to a member of the public by filing a request under the Freedom of Information Act (FOIA). A grant recipient is informed of a FOIA request by a third party and the recipient is given the opportunity to redact certain parts of the funded application.

Federal agencies may differ in the specifics of how grant applications are available to third parties. The best path is to find the online materials for an agency regarding its policy statement on the availability and confidentiality of grant applications.

Publications:

Question: What information can and cannot be published (peer review journals, conference proceedings) prior to provisional application and after a provisional application is filed?

Answer: The general rule is really simple: do not disclose anything about your invention before you file a patent application (N.B. in this discussion “patent application” includes provisional and non-provisional patent applications).

Of course, there is more to it than that.

The patent laws of most countries have an “absolute novelty” rule. Any disclosure of your invention before filing a patent prevents you from obtaining a patent on the invention. Europe is an example of an absolute novelty system.

Some countries have a grace period, where the inventor is allowed to publicly disclose the invention and then file a patent application later. The US is an example, where the inventor is allowed to file a patent application up to one year after disclosing the invention. Taking advantage of that option in the US prevents an inventor from pursuing the invention in absolute novelty countries. When a disclosure is made before filing a patent application we always need to know the earliest date of the disclosure, as it defines the deadline for filing the patent application. If the patent application is not filed by the one-year anniversary of the disclosure it is all over and there is no way to recover your rights.

After a patent application is filed the inventor is free to publicly disclose the invention without limitation, but it is important for the inventor to limit post-filing disclosures to the information that was

in the patent application. If there's an improvement to the invention that is not in the patent application, that should not be disclosed.

What is a disclosure? Any public dissemination of your invention that is in a written format. That is any format including the usual suspects like peer review journals and conference proceedings (e.g., an abstract of a poster or presentation that will occur at a future conference). It also includes information on the inventor's lab website, a thesis that is available at the institution's library, you name it.

Another aspect to what constitutes a disclosure is that it needs to be enabling, i.e., the disclosure needs to have enough information to allow a "person of ordinary skill in the art" to make and use the invention. If the disclosure is not enabling then the inventor has an argument that the disclosure should not be considered prior art and should not be used against the inventor when trying to get a patent to issue on an application that was filed after the disclosure. It is this aspect of the law that inventors need to keep in mind when they write a grant application. Because the abstract will be publicly available upon funding, it should be drafted in such a way that it is clearly non-enabling.

The safest pathway is to always file the patent application before any disclosure.