

The nanotech researcher's dilemma: publish or patent?

As nanotech researchers develop inventions that are ready for the marketplace, they face a dilemma: how to balance the pressures to publish and promote their findings with the need to keep developments secret in order to preserve patentability. University researchers come from an environment where you publish the results of your work both for the good of your career and in the interests of rigorous academic review. Scientists working in start-ups and other companies inevitably feel the need to tout their new inventions to investors and potential customers.

Many are surprised to learn that such activities can bar their right to seek patents. Yet, researchers can resolve this tension by carefully making early disclosures in a manner that minimizes the risk of creating these bars.

In the U.S., timing is everything

In the United States, so-called "statutory bars" preclude patent protection on inventions when a printed publication, public use or offer for sale occurs more than one year before filing a patent application. A "publication bar" arises when researchers document their findings in written form and make them publicly accessible anywhere in the world, such as in academic journals. The "public use" and "on-sale" bars apply to public demonstrations and offers for sale within the United States.

The easiest way to avoid running afoul of the publication and public use bars is through confidentiality agreements. But researchers want to publish. Other methods may therefore be used.

It's simply a matter of timing. Well ahead of anticipated publication dates in academic journals, researchers should submit drafts of proposed articles to individuals responsible for coordinating patent filings within the university. In this way, patent applications can be filed prior to publication.

Presentations or seminars to discuss new and interesting findings are also common in academic circles and start-ups. When presentations occur without patent applications in place, researchers should discuss their work without leaving behind written documentation and without demonstration. To the extent presentation slides are employed, they should be temporarily displayed, not distributed or posted overnight with free public access.

A group from M.I.T. saw two patents invalidated under the publication bar based on distribution of presentation materials to six seminar attendees. Similarly, public use bars have invalidated patents based on demonstrations to even a single member of the public.

The advice concerning on-sale bars is more basic. Since confidentiality will not negate an on-sale bar, inventors should refrain from offering to sell new inventions until patent applications are in place. When offers for sale are made, patent applications must be filed within one year of making the offer.

Going global

While the rules in most foreign countries are more straightforward than in the U.S., they are also typically more stringent. In many foreign countries, any enabling public disclosure of an

patent rights.

An enabling public disclosure is any disclosure, written or oral, that provides a person familiar with the technology (in legal terms, "one skilled in the art") with sufficient knowledge to adequately make and use the invention. Public disclosures can be made in books, technical journals, poster sessions, presentation slides, lectures, and conversations. Demonstration or sale of a product may also qualify as an enabling disclosure, but only if the product can be reproduced by one skilled in the art.

If early disclosures must be made, here again, the safest course is to employ confidentiality agreements. If such agreements are unavailable, it still may be possible to publicly disclose without a resulting loss in foreign rights. Especially in the world of nanotechnology, where inventions are not easily reverse engineered, inventors may disclose the beneficial results of using their inventions without actually disclosing how to make them. By merely describing an invention's benefits, without offering how to make it, an enabling disclosure is not present.

Practical Guidelines

To summarize, the safest practice is to make no public disclosure, use or sale of an invention prior to filing of a patent application. Because this is not always possible, researchers can help preserve patent rights by considering the strategies outlined here.

This column is not intended to encourage early public disclosures, as pre-filing activity involving third parties can always pose a risk to future patenting. The guidelines are merely a tool to help mitigate this risk.



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