



PUBLIC DISCLOSURE BEFORE PATENT FILING

Patent laws can be full of pitfalls for the unsuspecting inventor. Public disclosures of inventions can result in the complete loss of patent rights. An inventor who does not take immediate action to protect these rights may indeed lose the ability to obtain a patent. All inventors should seek the advice of a patent attorney or patent agent once it is determined that an invention exists. **At NMSU, the Arrowhead Center, Office of Intellectual Property will work with you and the NMSU patent attorney.**

What Constitutes a Public Disclosure?

Under patent law, a public disclosure is any non-confidential communication of an idea or invention. But not all disclosures result in the loss of potential patent rights. For a disclosure to bar the patenting of any invention, it must be “enabling”, meaning that it has to provide enough of a description of the invention for a person “of ordinary skill in the art” to practice it. Determining what is and what is not a public disclosure of an invention should be left to a patent attorney, but the following general rules apply.

Activities That Do Not Typically Constitute Public Disclosure include:

- Lab Meetings attended by NMSU employees only
- Faculty Meetings –attended *only* by NMSU employees
- Confidential submissions for publications –if the journal has confidentiality agreements with reviewers prior to acceptance and publication

- Unfunded government grant applications unless the funding agency has specified otherwise.

Public Disclosures May Include:

- Public presentation
- Poster session
- Department or campus seminar
- Online information posting
- Publicly available funded grant proposal abstract
- Filing of a provisional patent application without filing a corresponding utility patent within one year after the provisional filing.
- Public release of an academic publication (printed or digital online)
- Public release of an abstract, master's thesis, Ph.D. dissertation, or open thesis defense.
- Posters, Abstracts, and Proceedings

Oral Disclosures:

Any conference presentation, departmental seminar, or thesis defense presents an opportunity for public disclosure that defeats patentability. Plan one’s oral presentation in a manner that avoids any inadvertent disclosure of one’s invention.

- A public disclosure can occur at a formal talk, in which one distributes a handout copy of a presentation in which an invention is disclosed.
- If handouts are not provided, a public disclosure can occur if a listener takes notes that describe the invention.

Public Use or Sale:

Distribution of research materials and prototypes, that embody the invention, may constitute disclosure under certain conditions.

- A sale or an offer to sell a research material or prototype or providing material without any restriction on use or distribution may be an act of making that material available to the public.
- Providing material only for testing and/or evaluation or for research purposes under written agreements

specifying test and evaluation only may not be a public disclosure.

Preventing Public Disclosure

Inventions are not considered to be publicly disclosed if discussed under an appropriately worded confidentiality agreement approved by an attorney.

- **Correspondence:** Providing information to individuals outside of NMSU, by mail or email, without indicating that the information being provided is confidential could also constitute a public disclosure.
- **Grant proposals** to federal agencies are deemed publications as they are accessible under Freedom of Information Laws, but, when necessary, one can take active steps to ensure that a recipient federal agency maintains confidential any information provided under a grant proposal. 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 conspicuously write "CONFIDENTIAL" on each page that contains the confidential information.
- **Grant proposals abstracts** should be high-level and not describe the invention. Grant applications typically are not made public, although grant abstracts and final reports can be available to the public and would be considered a public disclosure.

FAQ'S

What if an inventor wishes to discuss his or her invention with a third party before a patent application is filed?

If an inventor believes the time is right to propose a business relationship concerning the invention to a third party even though it

has not reduced the invention to practice or filed a patent, a non-disclosure or confidentiality agreement with the third party will usually prevent the disclosure from being considered a "public disclosure" and preserve the novelty of the invention. However, it is recommended that the non-disclosure/confidentiality agreement be reviewed by a patent attorney along with any conditions related to the disclosure to ensure that the absolute novelty of the invention is preserved.

How does public disclosure impact prior art?

In the U.S., an inventor's public disclosure of their own work made less than one year prior to their patent filing date will not count as prior art. This is referred to as a grace period for the inventor's own disclosure. If an inventor's public disclosure was made more than one year before the inventor's patent filing date, that disclosure is considered prior art and may prevent the inventor from obtaining a patent. **Note, however,** that any publication by a third party that builds off the inventor's work and occurs during the time window between an invention's public disclosure and its patent application filing date may prevent or hinder patentability of that invention.

What are the inventor's obligations after Provisional Patent is Filed?

The duty of disclosure continues throughout the pendency of an application. Any additional information that the inventors may discover, such as brochures, articles, etc., relevant to the subject invention, should be brought to the attention of NMSU/Arrowhead IP Office, who will work with patent attorneys for possible disclosure to the US Patent & Trademark Office (USPTO).

**Arrowhead Center, NMSU
Office of Intellectual Property
IP@nmsu.edu**