If you are an inventor, you probably have a lot of passion for your ideas. It is only natural to want to share your discoveries with others, particularly if you are in an academic field where journal publications are the norm. Publishing your research can garner you esteem among your colleagues, help you to get research grants, and gain you the input of other experts in your field. But, publishing too soon can also jeopardize your patent rights.

If you are a businessman, no doubt you want to commercialize your invention and bring your product to market as fast as possible. You may want to begin marketing and soliciting orders even before you are able to complete production. But again, this strategy can lead to trouble later on if you decide to apply for patent protection.

I always recommend that my clients file something with the patent office before publishing anything about their invention and before taking orders for or selling their invention.

In the United States

In the United States, publication of your invention anywhere in the world acts as an absolute bar to patentability one year from the date of publication. In other words, under United States law there is a one year grace period after publication, during which a patent application can still be filed. After that grace period expires, if no patent application has already been filed, no valid Untied States patent can be obtained.

Public use of your invention or offering your invention for sale in the United States (not anywhere in the world) also acts as an absolute bar to patentability after one year. Therefore, the same one-year grace period applies to all of these activities in the United States.

The Patent Office (PTO) may not necessarily know about public use or sale of your invention, or about an obscure publication of your invention somewhere in the world. Therefore, you might be able to obtain a patent by failing to disclose these matters to the PTO. Nevertheless, the resulting patent would be invalid. Although the USPTO may not discover the publication or sale, it is very likely to be discovered if your patent is ever litigated.

In litigation, your opponent has access to powerful discovery tools, including the right to compel testimony under oath and to compel the production of relevant documents. When the publication or sale is discovered, it is game over. Your patent will be held invalid and you will not be able to stop others from infringing it. Failing to disclose these material events is also unethical conduct.

Foreign Countries

The laws of other countries vary and I am not an expert in international patent laws. However, foreign countries generally do not have any grace period. Rather, most foreign countries have a rule of absolute novelty. Any public disclosure, anywhere in the world, eliminates your right to apply for a patent in those countries.

You can publish your invention, file a United States patent application a year later, and receive a valid United States patent. But you cannot generally receive a valid foreign patent. Even one day after you publish is too late. Your foreign patent rights are gone.

Recommendations

I always recommend that my clients file something with the Patent Office before releasing information to the public or demonstrating or offering their invention for sale. Hold off on publication until after you at least file a provisional application.

Applications can be filed in foreign countries on the basis of a United States provisional application, typically within one year of the filing date of the U.S. application. A foreign application claiming the

priority of a United States application will date back to the original filing date of the U.S. application, which means that the foreign application will still be valid if you have published something in the interim.

Not publishing is the foolproof solution. But, if you must publish or offer for sale before filing an application, there are steps that can be taken that may avoid loss of patent rights. If you give a speech or presentation, do not hand out printed materials such as notes, or if you do, collect them again after the presentation. A private presentation is not considered available to the public and generally will not be considered a publication.

If you publish a paper, limit your description of the actual invention. If the invention is not described in the publication, it will not bar your patent rights to the invention. If there is an offer for sale, your patent rights may be preserved if you are continuing to develop the invention and the offer for sale is of a solution to a problem, and not a particular completed product. If you want to use your product, do it in private. Secrecy alone will not necessarily prevent a public use from acting as a bar to issuance of a patent.

At the very least, your business should be aware of these issues and have policies in place to address them. Inventors should fill out invention disclosures in a timely manner, and these invention disclosure should be reviewed and turned into patent applications relatively quickly, with an eye on potential publication dates and the like.