

The Right to Remain Silent . . .

When Does A Public Disclosure Cost You Your Patent Rights?

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You have the right to remain silent . . . Anyone hearing those words from a police officer will surely get the chills. But when your helpful and friendly patent attorney utters roughly the same words regarding your new development or invention—listen closely—or you might lose your rights and freedom. Fortunately, in this case it's not your personal freedom, but the freedom to obtain US and international patent protection. In my last article I discussed basic considerations in filing for patents abroad. In a nutshell, every country or region has its own patent system and accompanying rules for obtaining a patent. With the big exception of the US, almost all require *absolute novelty*, in which no public disclosure sufficient to allow another to practice the claimed invention has occurred before your earliest patent filing somewhere. That original *somewhere* is the US Patent and Trademark Office for most US-based inventors. However, the US applies a different standard, requiring only that you file US patent application within one year of a public disclosure, public use or offer for sale of the invention being claimed. The dichotomy between the US and the general international standard on what *bars* obtaining a patent is the source of endless confusion, frustration and loss of valuable intellectual property. In this article, I hope to clarify these seemingly conflicting rules and provide guidance for preserving both US and worldwide patent rights.

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The US-only Patent Applicant

If the patent concept is *definitely* to be filed only in the US, then the doctrine of absolute novelty is not a concern to the applicant. Rather, the applicant can file either a provisional or utility patent application within the one year grace period following a barring activity. That barring activity under US patent law is a publication of the claimed concept anywhere in the world, or a public use, public display, oral disclosure to a public group or offer for sale in the US. This means that if the concept is written up in a magazine, journal, internet website, a patent must be filed within one year of the publication date. The publication date is the date the paper or article is first released to readers in the public without restriction. The term "public" means that there is no restriction on the recipient's own ability to disclose the information. For this reason, publications, displays or presentations of the concept within a group in which each recipient is bound to confidentiality are not considered "public" activities, and do not trigger a barring event under US law. Typically, a group in which each recipient has signed a non-disclosure agreement or employee confidentiality agreement will have no public members. One must carefully avoid disclosing to unrestricted visitors, staff or others outside the group. When in doubt get an NDA.

Assuming the activity was indeed public—a published paper, trade show display, presentation to a class—then the applicant must mark the date and file an application within one year.

The very special case in the US is the *offer for sale*. If a concept finds its way into a sales discussion that is sufficient to set terms or a price, then this starts the one year US bar clock—a good reason for engineering to keep the sales department in the dark about the new feature. Aside from publication, all the activities bar filing under US law are only bars if they occur inside the US. That is, a public display or presentation (without publication) only in Germany is not a US bar—though it could well be a bar to international protection, as discussed below. Since many foreign activities require a US component, like phoning a German customer from the US to offer the new product, care must be taken when relying on non-US activities to save the day.

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Sometimes the applicant gets lucky and the disclosure was not sufficient for one of *ordinary skill* to practice the concept. For example, the product is written up in a magazine, but no details on the new technology are given, or they are insufficient to act upon. In such cases the disclosure is not enabling of the invention and not a barring event to filing. However this does not apply in an offer for sale if the offered product was otherwise “ready for patenting.” Likewise, using a product publicly, a trade show for example, is a usually bar, even if the product is used under covers.

The International Patent Applicant

Many of the rules governing what is and isn't a public disclosure in the US also apply to those seeking international rights. However, absolute novelty dictates that a patent be filed at least in the US before there is *any* public disclosure sufficient to enable the ordinarily skilled person the practice concept. Follow-on filings internationally should occur within a year of the US filing. There is no *offer for sale* in most non-US jurisdictions, and a public use or display that doesn't teach how to make the concept is not a bar internationally. When in doubt, file first in the US before making any public disclosure. Until filing, exercise your RIGHT TO REMAIN SILENT.

There is a universe of exceptions and permutations on these general principles. When in doubt consult a patent attorney before disclosing your concept to the wider world. Coming next time, some discussion of the recent *In re Bilski* decision, and the future of business method patents, if any.

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In addition to studying the market, the TUCK team needed to familiarize themselves with the technology. The TellEmotion system works as a software interface between “smart meters” that have a public API and the web-based display. Live, real-time outlet-load and lighting data from two Dartmouth dorms can be seen at www.greenlite.dartmouth.edu.

There are several companies on the market providing real-time energy data. They display energy use through charts and graphs, which provide interesting information but don't create an emotional response and motivate students in schools or children in the home. And while studies have shown that bill-payers respond well to charts showing cost savings, long-term behavioral change has been shown to occur for more altruistic reasons. By creating a meaningful link between an individual's actions and the larger impacts of energy use on the environment and the polar bear in the displays, the TellEmotion/Green Lite system has the potential to motivate long-term changes in habits and social norms around energy conservation.

Consumers interested in putting TellEmotion's “bear-o-meter” in their homes contact TellEmotion regularly. The company is working with off-the-shelf meters to make this possible but the development of a reasonably priced smart meter along with determining how to get meters into the home, creates a bit of a challenge. Good news on this front comes from states like California where plans are in place to put smart meters into every home and business by 2012. President-Elect Obama included smart meters, efficiency and behavioral changes as part of his stimulus plan and environmental initiatives.

The TellEmotion founders—Evan Tice (Lead Software Architect), Tim Tregubov (Content Developer), Gary Loeb (Vice President) and Lorie Loeb (President)—have benefited tremendously from advise and coaching by Dartmouth and Tuck alums such as Jim Lang T'89, Phil Ferneau D'84, T'96, and Wendell Smith D'64.

