

HINDLES

Patent & Trade Mark Attorneys

DISCLOSURES OF YOUR INVENTION – FAQs

This information sheet deals with frequently asked questions relating to disclosures regarding your invention, made either by yourself or third parties under an obligation of confidentiality or otherwise.

Can I disclose my invention *before* a patent application has been filed?

It is vital to avoid non-confidential disclosure of a possible invention before an appropriate patent application has been filed. This is because patent law in the UK, Europe and much of the rest of the world requires an invention to be both new and non-obvious over everything known to the public anywhere in the world (the "prior art") at the relevant date. If you make a non-confidential disclosure before filing a patent application, then that disclosure could deprive your invention of novelty and render it impossible to achieve a valid granted patent.

A patent can be invalidated by an act as simple as telling your idea to one person who is not under an obligation to keep the idea confidential. You can talk to professional advisers, such as patent attorneys and solicitors, who are by the nature of their business under an obligation of confidentiality to their clients. Otherwise, you should take professional advice and file any necessary patent applications before you make any non-confidential disclosure. As to the possibility of making a disclosure in confidence, please see below.

Can I disclose my invention *after* an initial patent application has been filed?

This is a thorny issue. Patent applicants are often under pressure to make non-confidential disclosures of their inventions once a first patent application has been filed. This might be in order to publicise or sell their inventions, or because potential licensees and commercialisation partners are not prepared to sign confidentiality agreements, or because there is a desire to publish an academic paper. However, as the example below illustrates, making a non-confidential disclosure of an invention, even after filing an initial patent application, can seriously or fatally compromise the scope of protection that can validly be obtained.

Many high-technology inventions which are the subject of pending patent applications are commercialised using confidentiality agreements, maintaining secrecy for as long as possible. Indeed, confidential information can be protected by the law of confidence as well as by contract law, where there is a contract. Once information is made public, it cannot in principle be protected with a confidentiality agreement and so this commercialisation option is weakened or lost.

Where our clients are under pressure to disclose their inventions, we help them to understand in detail the risks involved in making non-confidential disclosures and discuss what types of disclosure minimise risks. We review whether their patent application(s) already on file are likely to be adequate, or whether they may need to file further patent applications before disclosures are made. We aim to enable our clients to make an informed decision as to what to disclose, to whom, how and when.

The following example serves to illustrate the problem posed by non-confidential disclosures made after the filing of a first patent application.

Example

Imagine that an inventor is the first person to devise the idea of a bicycle which has a bell. He files a patent application for this idea. A week later, the inventor issues a press release describing the bicycle with a bell and demonstrates it in public, putting the idea firmly into the public domain. The patent application already on file is not in itself affected by these disclosures.

A week later, the inventor realises that the idea could have broader application and that a bell could usefully be fitted to a train, a car, a truck or any other type of vehicle. The inventor wishes to obtain patent protection for this broader idea and files a revised patent application including the broader concept of a vehicle with a bell.

If he had not disclosed his invention, the revised patent application might have led to grant of a valid patent for the broader idea of a vehicle with a bell. Unfortunately, as a result of the disclosures, the idea of a vehicle with a bell is not now new. This is because one example of a vehicle with a bell (namely the bicycle with a bell) is already known to the public due to the press release and demonstration. Thus, a broad claim to a vehicle with a bell is now invalid due to a lack of novelty, at least in Europe. (Claiming priority from the first application does not help as the earlier application only disclosed a bicycle with a bell and so this priority claim would not be valid under current European practice).

Specific claims to, for example, a train with a bell, or a car with a bell, may be new but it would be very difficult to argue that any of these concepts are inventive over public disclosure of a bicycle with a bell.

In this example, disclosure has prevented the inventor from broadening the scope of his protection, at least by way of a UK or European Patent. Disclosures after the filing of a first patent application can also cause serious or fatal problems in other circumstances, for example, where:

- (1) the patent applicant subsequently wants to narrow the scope of protection sought to include specific features which were not fully disclosed in the initial patent application;

- (2) the patent applicant subsequently wants to otherwise amend the scope of protection sought in a way which was not disclosed in the initial patent application, perhaps as a result of becoming aware of previously unknown prior art;
- (3) it is discovered that the initial patent application is invalid or cannot be used as the basis for a valid priority claim, perhaps because the example given in the initial patent application turns out not to enable the skilled reader to carry out the invention.

Conclusion

In order to avoid compromising the scope of patent protection that can be obtained, the best legal advice is to not make non-confidential disclosures of an invention even once an initial patent application has been filed. If commercial realities mean that it is desirable to make non-confidential disclosures, then it is important to take legal advice beforehand in order to understand and, if possible, minimise the risks involved.

How can I use confidential disclosures?

In principle, disclosures made in confidence do not become part of the prior art that is taken into account when deciding whether a subsequent UK or European patent application is new and non-obvious.

For example, discussions with your patent attorney or solicitor do not become part of the prior art because of the obligation which they have to keep information concerning your invention confidential. However, you should only disclose information about your invention to anyone other than your patent attorney or solicitor after they have signed a suitable written confidentiality/non-disclosure agreement.

Even making a disclosure under a confidentiality/non-disclosure agreement can entail risks. The risks include, but are not limited to, the risk that if someone breaches the confidentiality agreement it could prejudice your patent rights. It may be hard to know, let alone prove, who has broken confidentiality and it may be harder still to obtain suitable redress from them.

The careful use of confidentiality/non-disclosure agreements can enable you to work on the commercialisation of your invention whilst minimising the risks to the scope of your patent protection. However, you should proceed with care and take professional advice first.

What can I do if a potentially patentable invention has already been disclosed?

If a non-confidential disclosure of a potentially patentable invention has already been made by the inventor or another person, then the disclosure may well make it impossible to obtain valid patent protection, at least in the UK and Europe. Nevertheless, you should always seek professional advice before concluding that a valid patent cannot be obtained since, in some circumstances, it may still be possible to secure patent protection.

If a potential disclosure has occurred, we would investigate whether there were grounds to argue that the disclosure was actually in confidence, or was not sufficient to put the idea into the public domain. There may also be patentable aspects of the invention which were not disclosed.

Some countries, notably the United States, will in some circumstances discount disclosures made by the inventor within a certain period of time, called a grace period, before the application was filed. Other countries have patent or utility model rights which discount disclosures made by the inventor outside that country. Yet further, many patent granting authorities, including the UK Intellectual Property Office and the European Patent Office, may discount disclosures made in the six months prior to the filing date of the invention if they were made in breach of a confidence owed to the inventor.

For more information:

- ❖ Visit our website
- ❖ Contact one of our attorneys directly
- ❖ Call 0131 243 0660

Disclaimer

This document is provided as a source of general information only and should not be considered legal advice. No guarantee is provided that the information provided herein is complete or current. Readers should not act or rely on any information provided herein without first obtaining specialist professional advice.



Hindles, European Patent & Trade Mark Attorneys, 131 – 135 George Street, Edinburgh EH2 4JS. UK

T: +44 (0)131 2430660 F: +44 (0)131 2430661 mail@hindles.co.uk www.hindles.co.uk