



Office of the
Vice Provost
for Research
and Advanced
Studies

Office of
Biotechnology

September 2001

The Impact of Public Disclosure on Patentability

Public disclosures of research results take many forms including written, oral and electronic. Disclosures can be published papers, abstracts, posters, seminars, email, and even grant applications. One of the best ways you can avoid the possibility of destroying patentability due to a public disclosure is to plan ahead—either the intellectual property can be protected first, or the disclosure can be made under 'confidentiality'.

United States and Foreign Patent Rights

In the United States, a patent application may be filed up to one year following the first public (non-confidential) disclosure of the invention. In foreign countries, however, the patent *must* be filed prior to any public disclosure. Depending on the industry potentially interested in commercializing the results of the research, the ability to file patents in foreign countries may be important.

Non-confidential Disclosures

Public, or non-confidential disclosures, include journal articles, submitted abstracts submitted, poster presentations, presentations to company representatives, research proposals (see below), seminars, and website postings—essentially all activities that provide persons outside your research group access to the research results. These disclosures are generally not considered confidential and may affect the ability to file a patent application. Personal conversations with colleagues outside your research group may also be public disclosures.

Confidential Disclosures

Confidential disclosures include any discussions concerning research results that take place *after* a confidentiality agreement has been signed and authorized by all parties to the discussion. In some cases, a seminar or poster may be presented to a specific group of people, all of whom have agreed to the terms of the confidentiality agreement. This type of disclosure does *not* impact the ability to file a patent application.

Research Proposals and Agreements

Research proposals and agreements are a form of disclosure that deserve special attention. If the submission is to a company, consortium, or other industry group, it should be done under the terms of a confidentiality agreement and clearly marked "CONFIDENTIAL." If the proposal is to a federal or state funding agency, the guidelines for the specific funding program should be consulted to determine if that agency keeps proposals confidential and at what point the proposal is no longer confidential, e. g., upon award of a grant. If confidentiality is a concern, please check the website for the specific program, or contact Lynne Mumm, ISURF Disclosure Manager, 294-4742, lmumm@iastate.edu.

Invention disclosures, provisional patents and filed patents

For research results that contain potentially patentable information, an invention disclosure should be filed with ISURF prior to any non-confidential disclosure. If there is patentable information in the disclosure, a provisional patent may be filed to protect the intellectual property and preserve the ability to file foreign patent applications, while allowing publication of the research results. The provisional filing provides a one-year period in which the technology can be evaluated and marketed before decisions are made on filing a patent application.

Remember, all confidential documents should be clearly marked "CONFIDENTIAL."

If you have any questions about this tip sheet or working with industry, please contact:

Lisa Lorenzen
Biotechnology Industrial Liaison
1210 Molecular Biology Building

Phone: (515) 294-0926
Email: llorenze@iastate.edu

Acknowledgement: A special thanks to Lynne Mumm for her assistance in preparing this tip sheet.