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## The Publication Bar: How Disclosing an Invention to Others Can Jeopardize Potential Patent Rights

Your client has invented a "new and useful process, machine, manufacture, or composition of matter"<sup>1</sup> and he is anxious to spread the news. This should come as no surprise, for there are many possible reasons to do so, such as making sales, winning an award, or receiving a degree. At the same time, however, your client anticipates subsequently patenting his invention, unaware that his rights to a patent may be jeopardized by such disclosures. This comment examines the "publication" bar to patentability as defined by federal patent laws. Specifically, the comment seeks to provide patent attorneys with a guide for advising their client inventors as to how such disclosures may be made without jeopardizing future patent rights.

To achieve this goal, the comment is divided into three sections. Part I reviews some of the legal principles underlying patents and the publication bar. Part II analyzes the manner in which these principles have been applied in some common factual scenarios. The three common problems that are discussed are deposits in a library, disclosures to foreign patent offices, and specific types of disclosures to industry. Finally, Part III summarizes the publication bar and includes some recommendations for avoiding the loss of patent rights.

### I. THE RATIONALE FOR AND THE LEGAL PRINCIPLES DEFINING THE PUBLICATION BAR

To understand the publication analysis, a review of basic patent principles is necessary. A patent is essentially a contract between the inventor and the public.<sup>2</sup> This contract is supported by mutual consideration, whereby the inventor receives exclusive rights to the invention<sup>3</sup>

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1. 35 U.S.C. § 101 (1994). In the United States, patentable inventions include "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." *Id.*

2. EARNEST BAINBRIDGE LIPSCOMB III, WALKER ON PATENTS § 1.6, at 43 (1984).

3. Specifically, the inventor receives a "right to exclude" others, for a specified time period, from making, using, selling, or offering to sell the invention. 35 U.S.C. § 154(a)(1).

for a specified time period<sup>4</sup> in exchange for disclosure of the invention in full and plain terms so that any person skilled in the "art"<sup>5</sup> might practice the invention.<sup>6</sup> Because a patent is similar to a contract, its validity and enforceability are analyzed according to traditional contract law principles.<sup>7</sup> Therefore, absent mutual consideration, an inventor cannot receive enforceable patent rights. One possible cause of the loss of such consideration is the premature publication of the invention. If premature publication takes place, a subsequently issued patent will be invalid, because the invention has already made its way into the public domain; therefore, the public would receive no benefit from granting the inventor a patent and the rights associated therewith. With these basic patent law principles in mind, an analysis of the publication bar to patentability follows.

The United States patent statute denies patent rights to an inventor whose invention has been described in a printed publication more than one year<sup>8</sup> before the date of invention or the date of application for a patent in the United States.<sup>9</sup> The general rule is that an invention is pub-

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4. The term of a United States patent is now twenty years from the date on which the application for patent was filed. 35 U.S.C. § 154(a)(2) (1994).

5. The word "art" is commonly used in patent law to describe the subject matter with which the patent deals. Specifically, "art" has been termed as "the field of the applicant's endeavor," or "the particular problem with which the inventor was involved." *In re Dillon*, 919 F.2d 688, 694 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991).

6. LIPSCOMB, WALKER ON PATENTS, *supra* note 2, at 43.

7. *Id.*

8. The one-year grace period is unique to the United States. Most countries require "absolute novelty," in other words, if publication occurs at any time prior to the application for patent, then the inventor loses his patent rights. See, e.g., European Patent Convention, Oct. 5, 1973, art. 54 (2) (for purposes of a European patent application, the state of the art includes all that has been made available to the public "by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application") (emphasis added); see also *Id.* at art. 55 (providing some limited exceptions to the general rule set forth in article 54).

9. 35 U.S.C. § 102(a)-(b) (1994). To determine whether an inventor is entitled to a patent requires more than simply a determination of whether there was a publication. To bar a patent, the publication must "describe" the invention and it must also be "printed." Although an examination of these issues is not the purpose of this comment, a brief discussion is useful. A "description" of the invention is sufficient to constitute a bar to patentability if the invention is described in "such full, clear and exact terms as to enable any person skilled in the art to which it relates to practice the invention." LIPSCOMB, WALKER ON PATENTS, *supra* note 2, § 4.24, at 347 (1984). The printed requirement was based on the notion that handwritten documents are less likely to be widely distributed to the public than printed ones. *In re Wyer*, 655 F.2d 221, 225 (C.C.P.A. 1981). It has been held that a publication is printed even if it is not printed in a "traditional" method. *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743 (S.D. N.Y. 1966) (holding that a document reproduced by "modern day methods," in this instance microfilm, could constitute a printed publication). Moreover, considering modern-day computer

lished if the disclosure is made sufficiently accessible to the public interested in the art.<sup>10</sup> Therefore, a smaller circulation will satisfy the publication requirement when the disclosure is made directly to those skilled in the subject matter.<sup>11</sup>

The United States Court of Appeals for the Federal Circuit ("Federal Circuit")<sup>12</sup> has held that a disclosure is sufficiently accessible to those interested in the art to constitute publication if an interested person exercising reasonable diligence could access the disclosure.<sup>13</sup> Courts have also held that there is publication if the class of people interested in the art could have a copy of the disclosure merely "for the asking."<sup>14</sup> Although the publication analysis is "a legal determination based on underlying fact issues,"<sup>15</sup> which "must be approached on a case-by-case basis,"<sup>16</sup> the following facts are generally determinative: (1) the number of copies made; (2) their availability to the public; (3) the extent of dissemination of the document; and (4) the intent behind the distribution.<sup>17</sup>

## II. APPLYING THE LEGAL PRINCIPLES

The rationale for the publication bar and legal principles defining it must be understood in order to apply them in the context of particular fact patterns. This section examines the application of the publication bar in two common situations: (1) disclosures deposited in libraries or other repositories, such as a foreign patent office; and (2) disclosures made to industry colleagues, such as presentations at technical confer-

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technology, the probability of dissemination now bears little relation to whether a document has been printed; therefore, courts now interpret the test to be "probability of dissemination." *In re Wyer*, 655 F.2d at 226.

10. *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989).

11. DONALD S. CHISUM, CHISUM ON PATENTS § 3.04[2], at 3-54 (1998).

12. The Federal Circuit has exclusive appellate jurisdiction in patent cases. *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 1067 (Fed. Cir. 1998).

13. *In re Hall*, 781 F.2d 897, 900 (Fed. Cir. 1986).

14. *Ex parte Kroenert*, 144 U.S.P.Q. 133, 135 (P.O. Bd. App. 1960) (holding that a Military Specification related to a transceiver for underwater communication was not published where it was listed in the Index of Specifications & Standards since the index was merely an alphabetical and numerical list of specifications that could be obtained by contractors from procuring agencies connected to the procurement function).

15. *In re Hall*, 781 F.2d at 899.

16. *Id.*

17. *Canon, Inc. v. Plasser Am. Corp.*, 474 F. Supp. 1010, 1013 (E.D. Va. 1978) (holding that advertisements in periodicals and sales brochures were sufficiently disseminated to a sufficient portion of the public to constitute publication).

ences.

A. *A Disclosure Deposited in a Library or Other Repository Will Be Deemed a Publication if the Disclosure Can Be Located by Using Traditional Search Techniques or if Copies of the Disclosure Are Readily Available*

The publication question often arises in situations in which an inventor had previously disclosed his or her invention to acquire patent rights in a foreign country or to attain an advanced degree at a university. The Federal Circuit has periodically addressed the publication question in these contexts. The results of these cases vary on the basis of the specific factual circumstances surrounding the disclosure at issue; however, a common thread seems to emerge. The Federal Circuit will find a publication when the disclosure can be located by a researcher by using traditional search techniques or when copies of the disclosure are readily available to the researcher.

1. *Disclosure Placed in a University Library*

Modern analysis of the publication bar in this context began with the 1978 case of *In re Bayer*.<sup>18</sup> In *Bayer*, the inventor disclosed his invention in a thesis intended to partially fulfill the academic requirements for his master's degree in chemistry.<sup>19</sup> The inventor then defended the thesis before a graduate committee of three faculty members.<sup>20</sup>

When the inventor subsequently applied for a patent, the patent examiner rejected the application, concluding that the date of publication was the date on which the library received the thesis.<sup>21</sup> The inventor appealed the examiner's rejection to the Patent and Trademark Office

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18. 568 F.2d 1357 (C.C.P.A. 1978). This case was before the United States Court of Customs and Patent Appeals ("CCPA") which was a predecessor court to the Federal Circuit. *In re Cronyn*, 890 F.2d at 1160.

19. *Bayer*, 568 F.2d at 1357. The invention was related to a chemical compound, namely "Naphthyridine Chemical Complexes." *Id.*

20. *Id.* at 1358. Specifically, the committee consisted of the inventor's faculty advisor and two other faculty members. *Id.*

21. *Id.* Using the date of receipt by the library as the publication date would invalidate the patent because the library received the disclosure "sometime in 1966" and the filing date was February 27, 1968. *Id.* Therefore, because the time period between disclosure and filing would have been greater than one year, the publication bar of section 102(b) would prohibit granting a patent. 35 U.S.C. § 102(b) (1994).

Board of Appeals ("Board").<sup>22</sup> The Board rejected the examiner's position that the thesis was a publication as of the date of receipt by the library. Nevertheless, the Board concluded that the inventor's thesis defense to the committee constituted a publication because the "committee could have located [the] thesis in the library where it was available to them on request" and "in the absence of any indication of a continued obligation of confidentiality, the members of the . . . committee could have transmitted the information . . . to any number of other people having an interest in the subject matter."<sup>23</sup> The Court of Customs and Patent Appeals ("CCPA")<sup>24</sup> reversed, concluding that, prior to the library's completion of its cataloguing procedures, the three members of the committee were the only people able to locate the thesis in the library and that the committee's access did not, as a matter of law, constitute sufficient accessibility to the public interested in the art to constitute publication.<sup>25</sup>

Eight years later, the Federal Circuit revisited the publication issue in *In re Hall*,<sup>26</sup> a case dealing with an academic thesis. In *Hall*, the patent examiner rejected the inventor's application, noting that "it is reasonable to assume that the . . . thesis was available (accessible) prior to" one year before the filing date of the patent application.<sup>27</sup> The examiner based his decision on statements made by the manager of the loan department of the university library.<sup>28</sup> The manager indicated that, given the library's standard procedures, the dissertation was available for general use approximately one month after the date of receipt.<sup>29</sup> Because the library received the dissertation almost four months before the "critical date,"<sup>30</sup>

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22. *Bayer*, 568 F.2d at 1358.

23. *Id.* at 1359.

24. *See supra* note 18.

25. *Id.* at 1360. A key factor in the court's decision was the fact that the *only* persons who could readily access the thesis were the members of the committee because the thesis was not accessible through "customary research aids available in the library . . ." *Id.* According to a declaration made by the Chief Catalogue Librarian, the thesis was catalogued sometime between January 1 and March 7, 1967; and post-bindery processing was completed on March 7, 1967. *Id.* Since the filing date was February 27, 1968, the court apparently either: (1) used the post-bindery processing date as the publication date, or (2) assumed that the thesis was catalogued after February 27, 1967.

26. 781 F.2d 897 (Fed. Cir. 1986).

27. *Hall*, 781 F.2d at 898. The invention related to a chemical composition disclosed in a dissertation entitled "1,4-a-Glucanglukohydrolase ein amylyotisches Enzym . . ." *Id.* at 897. The dissertation was submitted in September 1977, and the inventor was awarded a doctorate degree in November 1977. *Id.*

28. *Id.* at 897-98.

29. *Id.* at 898.

30. "Critical date" is a term used to describe the date that is one year before the patent appli-

the examiner rejected the patent application.<sup>31</sup> The inventor appealed the examiner's rejection to the Board, which affirmed the rejection.<sup>32</sup> The Board concluded that the evidence was sufficient to conclude that the dissertation was available to the public before the critical date.<sup>33</sup> On appeal, the Federal Circuit affirmed the Board, concluding that "competent evidence of the general library practice may be relied upon to establish an approximate time when the thesis became accessible."<sup>34</sup> The court also held, for the first time, that a single catalogued thesis in one university library can constitute sufficient accessibility to the public interested in the art.<sup>35</sup>

Most recently, the Federal Circuit construed the publication bar in the context of an academic thesis placed in a library in the 1989 case of *In re Cronyn*.<sup>36</sup> The disclosures in *Cronyn* were three senior theses written by undergraduate students, and the patent applicant was the students' professor.<sup>37</sup> The primary issue in *Cronyn* was whether the method of filing and cataloging theses in the university library was sufficient to make them reasonably accessible to the public. The standard cataloging procedure was to file theses by title and author name on index cards.<sup>38</sup> The titles could be either descriptive of the topic<sup>39</sup> or they could be "fanciful"

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cation date, in other words, it is the date on which the publication bar ends. For example, if an inventor files an application for patent in the United States Patent and Trademark Office on May 1, 1999, the "critical date" for purposes of his or her application will be May 1, 1998. Any publication occurring prior to May 1, 1998 will constitute a bar to patentability; conversely, any publication that took place on May 1, 1998 or later will not affect the inventor's patent rights.

31. *Id.* The important dates were as follows: (1) the dissertation was received by the library on November 4, 1977, (2) according to the library manager's statement, the dissertation would have been available for public use by "the beginning of the month of December, 1977," and (3) the patent application filing date was February 27, 1979. *Id.* Therefore, any publication prior to February 27, 1978 would invoke the publication bar. *Id.*

32. *Id.*

33. *Hall*, 781 F.2d at 898.

34. *Id.* at 899. The court rejected the inventor's assertion that, based on the court's holding in *Bayer*, "accessibility can only be shown by evidence establishing a specific date of cataloguing and shelving before the critical date." *Id.*

35. *Id.* at 900. The court reiterated the fact that public accessibility turns on the specific facts of each case. *Id.* Accordingly, the court rejected the inventor's argument that a single catalogued thesis in one university library cannot, as a matter of law, constitute sufficient public accessibility. *Id.* at 898.

36. 890 F.2d 1158 (Fed. Cir. 1989).

37. *Cronyn*, 890 F.2d at 1159. The subject invention was a chemical compound with potential use as a cancer treatment. *Id.* at 1158. The patent applicant was a chemistry professor at the university. *Id.*

38. *Id.*

39. *Id.* The titles of the three theses at issue were descriptive of the topic, such as "Synthesis of Cyclic Methanedisulfonate Esters by Silver Salt Method." *Id.*

and not at all related to the academic topic.<sup>40</sup> The cards were generally not indexed or catalogued and were not given catalogue numbers.<sup>41</sup> However, both the cards and the theses were available for public examination.<sup>42</sup> The Board affirmed the examiner's rejection of the patent application because of the publication bar, relying on *Hall*.<sup>43</sup> The Board concluded that the facts were indistinguishable from *Hall* and that a researcher exercising "reasonable diligence" would have found the theses.<sup>44</sup> The Federal Circuit reversed, concluding that, because a thesis title might not be related to the topic, "the only research aid was the student's name which, of course, bears no relationship to the subject of the student's thesis."<sup>45</sup>

*Cronyn* exemplifies how unpredictable the results of a publication analysis can be. The Federal Circuit seems to conclude that the existence of a publication turns on whether a thesis is catalogued in the traditional fashion, thus enabling a researcher to locate the work by using traditional search techniques. In *Cronyn*, it would seem, a researcher exercising reasonable diligence could have found the theses if he or she really wanted them, although that researcher may have had to use an unorthodox research technique, such as reviewing each index card individually.

## 2. Disclosure to a Foreign Patent Office

The CCPA faced the publication bar in the context of a disclosure located in a foreign patent office in the 1981 case of *In re Wyer*.<sup>46</sup> In *Wyer*, the alleged publication stemmed from the filing of a patent application in Australia.<sup>47</sup> The Australian Patent Office ("APO") copied the

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40. *Id.* Examples of such titles were "Make My Func. The P-Func," "Close to the Edge," "Evolution and Lucifer," and "Easy Come Easy Go." *Id.*

41. *Id.* The cards at issue in this case could be found in either the main college library or the chemistry department library. *Id.* There were about 6,000 cards in the main library, whereas there were about 450 cards in the chemistry department library. *Id.*

42. *In re Cronyn*, 890 F.2d at 1159.

43. *Id.*

44. *Id.*

45. *Id.* at 1161. Judge Mayer, in dissent, felt that the theses were sufficiently accessible because the cards were maintained alphabetically by the author's name and the theses themselves were kept on shelves in publicly accessible areas of the libraries. *Id.* Judge Mayer argued that this "noncustomary" index satisfied the patent statute's publication definition. *Id.*

46. 655 F.2d 221 (C.C.P.A. 1981).

47. *Wyer*, 655 F.2d at 222. The patent related to a "Cable Junction Box." *Id.* The specification and claims for the Australian patent were filed on February 28, 1973, and the application was laid open for public inspection on August 29, 1974. *Id.* The United States filing date was November 9, 1976, more than two years after both important dates related to the Australian application. *Id.*



application and distributed the copies to five APO sub-offices, as required by customary APO procedures.<sup>48</sup> All APO offices permitted the public to purchase paper copies of applications and enabled the public to view applications in microfilm form on a display screen.<sup>49</sup> After the patent examiner rejected the United States application in light of the Australian application, the inventor appealed to the Board.<sup>50</sup> The Board affirmed the examiner's rejection, holding that "a foreign patent application maintained in the foreign patent office, accessible to the pertinent part of the public and available for duplication is a 'printed publication' as of its date of accessibility."<sup>51</sup> The CCPA affirmed the Board's decision on the basis that the specific facts of the case constituted a disclosure that was sufficiently accessible to the public to trigger the publication bar.<sup>52</sup> The court, however, did not uphold the Board's rather sweeping rejection of the principle that a foreign application laid open for public inspection may not be a printed publication.<sup>53</sup>

The Federal Circuit has consistently stated that the publication analysis is case specific and must take into consideration the specific facts surrounding a given disclosure.<sup>54</sup> It is clear, however, that, if a researcher can locate the disclosure by employing traditional search techniques (especially if he or she has the ability to make copies of the disclosure), then there has been a publication.<sup>55</sup>

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48. *Id.* at 223.

49. *Id.* As of August 29, 1974, an abstract of the invention at issue was published, the application was classified, and the abstract was arranged according to a classification system easily accessible to the public. *Id.*

50. *Id.*

51. *Id.* at 224. The Board reached this conclusion despite acknowledging the existence of a line of cases holding that a patent application open to the public in a patent office is not a printed publication. *Id.* The Board's holding, although seemingly broad, fell back on the specific facts of the case. The Board believed that because the application was printed on microfilm and because equipment was made available for making copies, there was an increased likelihood that the disclosure would be "widely circulated." *Id.*

52. *Wyer*, 655 F.2d at 226.

53. *Id.* The court affirmed the Board despite acknowledging that there was no evidence of "actual viewing or dissemination" of the application. *Id.* The court also cited several cases for the proposition that a foreign application laid open for public inspection is not necessarily a printed publication. *Id.* at 227 n.4.

54. See, e.g., *Hall*, 781 F.2d at 899.

55. Several district courts have addressed similar issues and have maintained this line of reasoning. See, e.g., *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 863 F. Supp. 1165 (C.D. Cal. 1994) (holding that a patent was invalid because an enabling reference could be found before the critical date at a government office where it was catalogued under a descriptive index, and because the reference could also have been found at a university library where it was micro-filmed and catalogued under a descriptive title); *Mobil Oil Corp. v. Amoco Chemicals Corp.*, 779 F. Supp. 1429 (D. Del. 1991) (holding that a patent was not invalid because copies of the

B. *Disclosure Made within a Given Industry and Subject to a Confidentiality Policy, Written or Implied, Coupled with an Absence of Subsequent Dissemination, Is Sufficient to Preclude a Publication Finding*

Another circumstance in which the publication issue often arises is when the inventor discloses his or her invention to colleagues within his or her industry. Such a disclosure is often related to a presentation at a technical conference or is contained in sales or marketing materials. Under these circumstances, a disclosure will probably be deemed a publication if the disclosure is made without any confidentiality restriction and when a sufficient<sup>56</sup> number of copies are made and provided to the public. However, if the disclosure is made subject to a confidentiality policy, regardless of whether such a policy is in writing, then a court is much less likely to conclude that there has been a publication. Moreover, even if the disclosure is made for purposes of dissemination to the public, if the disclosure is not actually disseminated, at least one court has held that the publication bar does not apply.

1. *Disclosure to the Public Interested in the Art, Absent a Confidentiality Policy or Agreement, Constitutes Publication*

The Federal Circuit most recently addressed the publication issue in the context of a disclosure at an industry conference, without a confidentiality policy or agreement, in *Massachusetts Institute of Technology v. AB Fortia* ("MIT").<sup>57</sup> In MIT, the patentee filed suit under section 337 of

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foreign (Venezuelan) patent application could not legally be obtained by members of the public before the critical date, despite the fact that the application was printed in a local newspaper three times before the critical date); *Siemens-Elementa AV v. Puritan-Bennett Corp.*, 13 U.S.P.Q.2d 1804 (S.D. Cal. 1989) (concluding that both a report filed in an engineering library indexed by year and author name, but not subject matter, was a printed publication, and a previous foreign application was a printed publication despite the fact that it was not published in a journal); *Freeman v. Coopervision, Inc.*, 675 F. Supp. 877 (D. Del. 1987) (refusing to grant summary judgment of patent invalidity where there was conflicting testimony as to whether the disclosure was indexed, shelved, and accessible in the library of Moscow Eye Institute); *Phillips Elec. and Pharmaceutical Indus. Corp. v. Thermal and Elect. Indus., Inc.*, 311 F. Supp. 17 (D. N.J. 1970) (concluding that a prior foreign patent application was a publication, because (1) it was microfilmed by the U.S. Government and accessible to the general public before the critical date, and (2) a printed abstract of the application was located in multiple foreign patent offices and available to the public before the critical date).

56. Although no specific minimum number of copies has been established, a review of the cases that follow may clarify the number of copies required, under specific circumstances, to constitute publication.

57. 774 F.2d 1104 (Fed. Cir. 1985).

the 1930 Tariff Act.<sup>58</sup> In accordance with the act, the suit was first brought before the United States International Trade Commission ("ITC").<sup>59</sup> The ITC ruled that the patents at issue were invalid for obviousness<sup>60</sup> in light of an invention disclosure that the patentee presented before an industry conference more than one year before the filing date of the United States patent application.<sup>61</sup> The Federal Circuit agreed, emphasizing that the paper was presented orally to a group of 50 to 500 members of the public interested in the art, a copy of the paper was given to the person heading the conference and, after the conference, copies of the paper were distributed to as many as six individuals, absent any confidentiality restrictions.<sup>62</sup>

Under similar circumstances, the United States Court of Claims invalidated a patent in *Garrett Corp. v. United States*.<sup>63</sup> In *Garrett*, the plaintiff brought suit against the federal government for patent infringement.<sup>64</sup> The court held that the government was not liable, because the patents were invalidated by the publication bar as the result of a document prepared for a British government agency.<sup>65</sup> The court reached this

58. *Massachusetts Inst. of Tech.*, 774 F.2d at 1105. The Tariff Act makes it illegal to engage in unfair methods of competition and importation. 19 U.S.C. § 1337 (1994). Patent infringement and unauthorized importation of a foreign manufactured product that is subject to a valid, unexpired United States patent are acts covered by the Tariff Act. *Massachusetts Inst. of Tech.*, 774 F.2d at 1108.

59. *Id.* at 1105.

60. This was, therefore, not an invalidation of the patent under section 102(b). An obviousness rejection falls under section 103, which incorporates section 102(b) as follows:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103(a) (1994).

61. *Id.* at 1109. The patents related to "limited-charge cell culture microcarriers." *Id.* at 1106. The subject technology concerns developing processes for efficiently and safely growing cells for purposes of producing cell growth by-products. *Id.* at 1105. The defendants were in the business of importing related microcarrier products into the United States. *Id.* at 1107.

62. *Id.* at 1109. Recently, a district court had occasion to distinguish the facts presented in its case from those of MIT. *Compare Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 1998 WL 151411 (D. Del. 1998). In *Ajinomoto* the subject thesis was presented on three different occasions to conferences held in the United States. *Ajinomoto*, 1998 WL 151411 at 10. Moreover, there were two presentations in Australia. *Id.* at 11. The court, however, distinguished MIT on the grounds that there was no indication that copies of the thesis were distributed at the presentations. *Id.* at 38.

63. 422 F.2d 874 (Ct. Cl. 1970). The United States Court of Claims was a predecessor court to the Federal Circuit. *Massachusetts Inst. of Tech.*, 774 F.2d at 1109.

64. *Garrett*, 422 F.2d at 876. The patents in question related to inflatable life rafts. *Id.*

65. *Id.* at 878. The document was entitled "Boarding of Large Inflatable Dinghies from the

conclusion because eighty copies of the report had been distributed to "British Government agencies, American Government personnel in Great Britain, and six commercial companies."<sup>66</sup> In addition, the report was available to government contractors in the United States who had been advised of its availability through the Defense Department and who could obtain copies of the report at no cost.<sup>67</sup>

It is clear that disclosure of an invention to a commercial company or other private entity interested in the art will constitute a publication when copies are made available and there is no confidentiality restriction. This is well-settled law that must be considered prior to presentation of new technologies at technical or sales conferences.<sup>68</sup>

2. *Disclosure to a Limited Number of Persons Interested in the Art, Subject to a Written Restriction on Distribution or a Written Confidentiality Policy, Is not a Publication*

The result is entirely different when a written prohibition against dissemination or a written confidentiality policy exists, as the Federal Circuit held in *Northern Telecom, Inc. v. Datapoint Corp.*<sup>69</sup> In *Northern Telecom*, the Federal Circuit affirmed the district court's holding that documents did not constitute publications when they were labeled "[r]eproduction or further dissemination is not authorized . . . not for

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Water" and was prepared for the British Marine Aircraft Experimental Establishment. *Id.* at 877.

66. *Id.* at 878. The court noted that distribution to government agencies and personnel, standing alone, does not constitute publication. *Id.* (citing *Ex parte Suozzi*, 125 U.S.P.Q. 445 (P.O. Bd. App. 1959)).

67. *Id.* at 878.

68. Several district courts have followed the same reasoning in similar factual circumstances and have reached unsurprising results. See e.g., *Friction Div. Products, Inc. v. E.I. DuPont De Nemours & Co., Inc.*, 658 F. Supp. 998, 1007-08 (D. Del. 1987) (holding that papers presented at a Society of Automotive Engineers conference were publications of the invention because copies of the paper were on display and available for sale); *Canron, Inc. v. Plasser Am. Corp.*, 474 F. Supp. 1010 (E.D. Va. 1978) (holding that sales brochures sent out in a mass mailing to potential customers constituted a publication); *Garbell v. Boeing Co.*, 385 F. Supp. 1 (C.D. Cal. 1973) (concluding that a paper transmitted to the Institute of Aeronautical Sciences Editorial Board was a publication because the Institute informed the inventor that it intended to distribute copies of the paper to company libraries and government departments where the copies would be available as a reference); See also PETER S. ROSENBERG, *PATENT LAW FUNDAMENTALS* § 7.02, at 7-14 (2nd ed. 1994); DONALD S. CHISUM, *CHISUM ON PATENTS* § 3.04[2], at 3-54 n.3 (1993) (citing *Friction Division Products* in addition to other cases finding publication where the disclosure was made, without restriction, to a limited number of persons interested in the art).

69. 908 F.2d 931 (Fed. Cir. 1990).

public release."<sup>70</sup> The court reached this conclusion despite the fact that the documents were not classified and were distributed to approximately fifty government employees and organizations.<sup>71</sup> The Federal Circuit concluded that the "uncertainties of public access" sufficiently precluded a publication finding.<sup>72</sup>

The Federal Circuit also approved a district court holding of no publication in *Hybritech Inc. v. Abbott Laboratories*.<sup>73</sup> In *Hybritech*, the district court viewed the distribution of as many as five copies of the disclosure to a conference committee as insufficient to constitute a publication.<sup>74</sup> The committee received copies to review for scientific merit and for flagrant errors in form.<sup>75</sup> The court concluded that the disclosure of documents "on this restricted basis [did] not amount to a publication."<sup>76</sup>

The United States District Court for the Northern District of Alabama faced the publication issue in the context of a written confidentiality agreement in *Southwest Aerospace Corp. v. Teledyne Industries, Inc.*<sup>77</sup> Teledyne had contracted with Southwest to procure and receive products; Southwest later filed an application for a patent for those same products.<sup>78</sup> Under the contract, Teledyne entered into a "Memorandum

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70. *Northern Telecom, Inc.*, 908 F.2d at 936. The invention related to a method of "batch processing" data with a computer. *Id.* at 933. The invention allowed the entry of data into a form that was displayed on the computer screen thereby aiding the operator in visually inspecting entries before they were transferred to a storage cassette. *Id.* The relevant documents were four reports of a military system for on-line distributed computer processing of logistical data. *Id.* at 936. Only one of the four reports contained the label. *Id.* However, the court found that the unlabeled documents "may have," at one time, had the labels because they "were of the class of documents that would have been distributed with such a notice." *Id.*

71. *Id.* at 936.

72. *Id.* The court also considered it critical that the documents were housed in a library to which public access was restricted. *Id.*

73. 4 U.S.P.Q.2d 1001 (C.D. Cal. 1987), *aff'd*, 849 F.2d 1446 (Fed. Cir. 1988). The district court's publication analysis was, in fact, dicta because the disclosure was made after the critical date. *Hybritech*, 4 U.S.P.Q.2d at 1006. The court, however, decided to address the publication issue in the event that the issue became relevant on appeal. *Id.*

74. *Hybritech*, 4 U.S.P.Q.2d at 1007. There was conflicting evidence as to how many copies of the paper were actually distributed. *Id.* There were between two and five copies, but the court assumed the maximum of five copies for the purposes of conducting its "publication" analysis. *Id.*

75. *Id.*

76. *Id.*

77. 702 F. Supp. 870 (N.D. Ala. 1988).

78. *Southwest Aerospace Corp.*, 702 F. Supp. at 876. The invention at issue related to a turbine vent reeling machine used in deploying and towing aerial gunner targets. *Id.* at 875. Teledyne was engaged in a contract with the United States Air Force wherein it was required to provide the Air Force with such machines. *Id.* at 876. While under contract with Teledyne, Southwest developed an improved turbine vent reeling machine. *Id.* at 879. When Teledyne learned of the imminent issuance of a patent to Southwest for the machine, it filed a protest in

of Agreement" under which all information furnished by Southwest to Teledyne was deemed proprietary.<sup>79</sup> In addition, Teledyne agreed that it would not, without prior written permission from Southwest, "disclose or use any data or information" acquired as part of the contract.<sup>80</sup> Teledyne argued that documents it received from Southwest under the agreement were publications; however, the court disagreed, because "[i]nsofar as the Memorandum of Agreement between Southwest and Teledyne place[d] Teledyne under a confidential obligation with respect to such documents, the communications between Southwest and Teledyne cannot be viewed as a publication under 35 U.S.C. § 102(b)."<sup>81</sup>

Finally, the United States District Court for the Southern District of Ohio addressed a similar issue in *Mead Digital Systems, Inc. v. A.B. Dick Co.*<sup>82</sup> In *Mead*, the inventor received a research contract from the Army Signal Corps to conduct development work on a "drop-charging process."<sup>83</sup> The contract required the inventor to provide "quarterly technical reports" to the Army.<sup>84</sup> The Army consolidated these reports with reports from other projects in a "Consolidated Quarterly Status Report" ("CQSR").<sup>85</sup> CQSRs were distributed to governmental organizations, libraries, universities, and other entities; however, the CQSRs were considered confidential government documents.<sup>86</sup> The inventor's quarterly reports, themselves, were marked "UNCLASSIFIED."<sup>87</sup> The court, with no elaboration, concluded that neither the quarterly reports nor the CQSRs were publications.<sup>88</sup>

It is quite clear that there is no publication when invention disclosures are submitted to a limited number of people or entities interested in the art subject to confidentiality agreements or restrictions on dissemina-

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the United States Patent and Trademark Office under 37 C.F.R. § 1.291. *Id.* Teledyne alleged that the invention was not patentable because, among other things, it was described in a printed publication more than one year prior to the date of the application for patent. *Id.* In support of its protest, Teledyne submitted more than 160 pages of documents illustrating and describing the structure and function of the invention. *Id.* at 880.

79. *Id.* at 877.

80. *Id.*

81. *Id.* at 881.

82. 213 U.S.P.Q. 328 (S.D. Ohio 1981).

83. *Mead Digital Sys., Inc.*, 213 U.S.P.Q. at 331-32. The inventor sought to develop a writing device, such as is used for electrocardiograms, whereby an electrical signal applied a high frequency charge to water droplets, causing the droplets to be deflected so that the desired form was marked on the recording paper. *Id.* at 331.

84. *Id.* at 332.

85. *Id.*

86. *Id.*

87. *Id.*

88. *Mead Digital Sys.*, 213 U.S.P.Q. at 344.

tion.<sup>89</sup> In these cases, the inventor has made a clear effort to keep his invention out of the public domain; therefore, the public is still likely to benefit by granting the inventor a patent. Such cases, accordingly, are relatively straightforward; a more complicated issue is presented in cases in which an alleged confidentiality policy or restriction on dissemination is unwritten.

3. *To Preclude a Publication Finding, a Confidentiality Policy Need not Be in Writing so Long as Those Receiving the Document Are Aware of Such a Policy*

To preclude a publication finding, a confidentiality policy need not be in writing so long as (1) all individuals receiving a copy of the disclosure understand that such a policy exists and (2) there is, in fact, no dissemination of the disclosure to individuals not subject to a confidentiality restriction. *In re George* illustrates this rule.<sup>90</sup> In *George*, the disclosure was a research report submitted to the Gravure Research Institute ("GRI").<sup>91</sup> Despite the fact that the GRI had no written confidentiality policy, the Board concluded that there was no publication.<sup>92</sup> The Board found that, because it was in GRI's best interests, there was an implicit "GRI policy concerning confidentiality and adherence to this policy by GRI members."<sup>93</sup>

Two district court cases are also instructive. In 1989, the United States District Court for the Northern District of Illinois decided *Aluminum Co. of America ("ALCOA") v. Reynolds Metals Co.*<sup>94</sup> In *ALCOA*, the disclosures at issue were a series of "progress letters" through which re-

89. There are additional cases in support of this proposition. See CHISUM, CHISUM ON PATENTS, *supra* note 11, § 3.04[2], at 3-57, 3-58 n.9, 10 (1998).

90. 2 U.S.P.Q.2d 1880 (P.O. Bd. App. 1987).

91. *In re George*, 2 U.S.P.Q.2d at 1881. The patent application related to a "Method and Apparatus for Transferring Ink in Gravure Printing." *Id.* The applicant appealed from the examiner's decision to reject the application on the basis of the disclosure. *Id.*

92. *Id.* at 1882.

93. *Id.* at 1881. The Board was persuaded by the testimony of two long time members of GRI who stated that there was an organizational understanding among GRI members that there was a policy of confidentiality regarding research reports. *Id.* at 1882. The fact that inventors paid a substantial fee to GRI for rights to inventions developed by GRI was also persuasive. *Id.* Therefore, if GRI research results could be disseminated freely, then fees paid to GRI would be for worthless patent rights. *Id.* at 1881. The CCPA followed the same reasoning as that used in *George*. See *In re Kratz*, 592 F.2d 1169 (C.C.P.A. 1979) (finding no publication where the disclosure was an internal research report not subject to a written confidentiality policy, but where the report was treated as confidential by the recipients and was, in fact, not disclosed to others).

94. 14 U.S.P.Q.2d 1170 (N.D. Ill. 1989).

search results were periodically updated.<sup>95</sup> Under a contract between ALCOA and the United States Navy, ALCOA was required to send the progress letters to industry groups, the government, and academicians.<sup>96</sup> The only express requirement was an "export control" notice, which simply required the Navy's approval of any disclosure of the reports to foreign governments or entities.<sup>97</sup> Therefore, the notice simply restricted access to the reports to United States citizens.<sup>98</sup> Nonetheless, the court found that the reports were not publications because it was standard industry practice to treat confidentially those documents stamped with export control notices.<sup>99</sup> The court stated that, in conducting a publication analysis, "the relevant question is not what 'could have' been done but what was actually done."<sup>100</sup>

Furthermore, in *National Semiconductor Corp. v. Linear Technology Corp.*,<sup>101</sup> the United States District Court for the Northern District of California went even further, holding that documents that had been disseminated in contradiction of an implied confidentiality policy did not constitute publications.<sup>102</sup> In *National Semiconductor*, the inventor submitted a paper to a conference program committee to be considered for presentation at the conference.<sup>103</sup> Linear argued that the papers were "up

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95. *Aluminum Co. of Am.*, 14 U.S.P.Q.2d at 1171. The patentee, ALCOA, entered into a contract with the United States Navy to develop a high-strength, stress-corrosion-resistant alloy to solve the Navy's problem of aircraft cracking from "stress corrosion." *Id.* As a term of the contract, the Navy required ALCOA to issue the progress reports. *Id.*

96. *Id.* Specifically, the reports were sent to some thirty designees on a distribution list developed by the Navy. *Id.* The list included some of ALCOA's primary commercial competitors, such as Kaiser and Reynolds. *Id.* at 1172.

97. *Id.*

98. *Id.* at 1171-72. In fact, the Navy originally required ALCOA to stamp their final report "Distribution of This Report is Unlimited." *Id.* at 1171. Also, the record contained no evidence that access to the reports was denied to anyone who sought them. *Id.* at 1172-73.

99. *Id.* at 1172. The court noted that the evidence suggested that, even absent an export control notice, it was industry practice to treat the type of reports at issue in ALCOA as confidential. *Id.* at 1172-73.

100. *Aluminum Co. of Am.*, 14 U.S.P.Q.2d at 1173. Compare with *Crane Co. v. Goodyear Tire & Rubber Co.*, 577 F. Supp. 186, 197 (N.D. Ohio 1983) (holding that documents were publications despite legends on the documents prohibiting dissemination, because the plaintiff intended to and actually did distribute the documents to its customers).

101. 703 F. Supp. 845 (N.D. Cal. 1988).

102. *Nat'l Semiconductor Corp.*, 703 F. Supp. at 848.

103. *Id.* at 847. The inventor sent the paper in response to the committee's "call for papers" that required submission of a 35-page abstract and a 300-page to 500-page summary of the invention. *Id.* Importantly, the "call for papers" stated that the summaries would not be published, and that the committee to which the papers were submitted consisted of nine or ten experts in the field. *Id.*



for grabs"<sup>104</sup> and were submitted without restriction.<sup>105</sup> Moreover, several members of the committee stated that they took the articles back to their respective companies and distributed them to colleagues.<sup>106</sup> The court, however, held that, because "grabbing of papers" and showing them to competing companies was not the practice or intent of the conference, there was no publication.<sup>107</sup> The court relied on the testimony of a committee member who "stated that he knew it was improper to disclose a paper to a company colleague if he worked for a company competing with the one that originated the work."<sup>108</sup> Finally, the court found that a confidentiality policy written after the conference and referring "to a long-standing policy [was] additionally persuasive."<sup>109</sup>

These cases make clear that a written confidentiality policy is not strictly necessary to preclude a finding of publication. To avoid the publication bar when there is no written confidentiality policy, the patentee must present evidence of an implied confidentiality policy paired with the absence of any dissemination of the disclosure. To establish the existence of an unwritten policy, a court may require the testimony of an individual who has received the disclosure. In addition, as *National Semiconductor* illustrates, a policy written after the alleged publication could, in some circumstances, persuasively rebut a publication argument.

#### 4. *The Absence of Distribution Despite an Intent to Publish May Be Sufficient to Preclude a Finding of Publication*

Even when an inventor intends to publish his invention, a court might find that he or she has not done so. One court to so hold was the United States District Court for the District of Minnesota in *Bergstrom v. Sears, Roebuck and Co.*<sup>110</sup> In *Bergstrom*, the inventor wrote a letter disclosing his invention to a *Parade Magazine* writer for publication in an

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104. *Id.* at 848. According to the court, Linear described "a process where the papers would arrive at the meeting, the members would scurry to get a copy, then the members would hurry back to their places of employment to evaluate them and often show them to co-workers. . . ." *Id.*

105. *Id.* at 848.

106. *Id.*

107. *National Semiconductor Corp.*, 703 F. Supp. at 848. The court pointed out that four of the five persons who allegedly distributed the article were employees of the patentee. *Id.* Moreover, the court found that the fifth person, who took the article back to his company to show a co-worker, did not engage in activity that could be considered publication. *Id.*

108. *Id.*

109. *Id.* at 849.

110. 457 F. Supp. 213 (D. Minn. 1978).

article entitled "Parade of Progress."<sup>111</sup> The court found that the letter was an attempt to induce the magazine to include a description of the invention in the article and not an attempt to sell the invention.<sup>112</sup> The inventor received no response from the recipient of the letter, and the recipient had no recollection of receiving the letter.<sup>113</sup> Furthermore, the recipient's standard procedure for rejected disclosures was to discard them.<sup>114</sup> On the basis of this evidence, the court concluded that the letter did not constitute a publication.<sup>115</sup>

### CONCLUSIONS AND RECOMMENDATIONS

To exploit his or her invention, it is common for an inventor to want to make the invention known to the public as soon as possible. Normally, this desire to disclose is related to marketing or sales objectives; for example, when disclosure of the invention at a trade show or conference might be advantageous for garnering publicity and interest in the invention. Also, because of the patent laws in many foreign countries,<sup>116</sup> an inventor may be forced to disclose his or her invention to foreign patent offices before he or she is ready to apply for a patent in the United States. Finally, early disclosure may be required to satisfy academic requirements, such as the receipt of an undergraduate or graduate level degree.

If an invention disclosure is made and one year elapses between the date of the disclosure and the date of the inventor's application for a United States Patent, the inventor may lose his or her patent rights in the United States. In the context of invention disclosures placed in libraries, foreign patent offices, or other repositories, the existence of a publication will turn primarily on (1) whether a diligent member of the public interested in the art could access the disclosure by using traditional search techniques or (2) whether copies of the disclosure are made readily accessible to such a person. If either factor is present, there seems to be little doubt that the disclosure constitutes a publication under section 102(b) of the patent law.

In the context of disclosures made to colleagues within an industry,

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111. *Bergstrom*, 457 F. Supp. at 217. The article was designed to describe new ideas and new consumer product inventions. *Id.* The invention in this case was a tubular fireplace grate. *Id.*

112. *Id.* at 217.

113. *Id.* at 218.

114. *Id.*

115. *Id.* at 223.

116. See *supra* note 8.

several issues must be addressed to determine whether such disclosure(s) will be construed as a publication. First, the attorney should determine whether the recipient of the disclosure has its own written confidentiality policy or whether it entered into any confidentiality agreement with the inventor. If so, the likelihood of a publication drops significantly; however, the patent attorney must still scrutinize the terms of any such policy or agreement carefully. Second, absent any written policy or agreement, the attorney must try to determine whether, at the time of the disclosure, there existed any unwritten confidentiality policy or agreement that was understood by those individuals receiving a copy of the disclosure. Establishing the existence of such an unwritten policy or agreement will likely require the testimony of the recipient(s) or the introduction of circumstantial evidence establishing that the failure of the recipient to keep the disclosure confidential would be detrimental to the interests of the recipient.<sup>117</sup> Third, as a last resort, if there is no confidentiality policy or agreement, written or implied, the attorney should try to establish that there has been, in fact, no further dissemination of the invention to the public interested in the art beyond those who originally received the disclosure.

The publication bar often lurks as an unrecognized obstacle to acquiring a patent. The unsophisticated inventor, in particular, may fall victim to this rule because it runs counter to an inventor's natural desire to show his or her invention to others as soon as possible. Accordingly, it is incumbent on the patent attorney to communicate to his or her client the importance of confidentiality during the period when the patent application is being prepared. If confidentiality has already been lost, the patent attorney must diligently file the United States patent application within one year of the date of any such disclosure. Otherwise, the inventor may lose a once-in-a-lifetime opportunity to enjoy the benefits afforded by receiving a valid and enforceable United States Patent.

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117. In this context, the attorney may, even after the disclosure has taken place, wish to draft a confidentiality policy that refers to a long-standing, unwritten, policy recognized by each individual receiving the disclosure.