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Fighting the Urge – Balancing Patentability and the Need to Disclose

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All businesses from start-ups to large multinational enterprises can struggle to balance the ongoing business requirements for marketing, publicity, customer engagement etc. and the disclosure these bring with the requirement for novelty in protecting an invention in most countries globally. Each new product and / or technology you engage upon must typically be put into the public arena to gain customer engagement, revenue, publicity etc. Yet against this one of the key requirements for obtaining a valid patent is that your invention to be novel. This means not only technically original and new but also undisclosed and it is easy to forget this aspect.

This undisclosed aspect of the novelty requirement can differ between countries just to make things more complicated for you when considering just patentability. However, other intellectual property aspects such as trademarks, copyright and design patents / registered designs will each generally possess different disclosure issues and timelines even within one country. However, the overriding advice does not change which is the earlier you or your team engage with an intellectual property specialist the better.

Basically, in most countries of interest to you, the public disclosure of the invention by any person, including the inventor, enterprise etc., before filing an initial patent application destroys novelty and with it the ability to obtain a valid enforceable patent to exclude competition. These countries operate quite simply an "absolute novelty" requirement with respect to disclosure. What is public disclosure, well it can include any written or electronic publications, public oral disclosures, public demonstrations, public use, offers for sale, and actual sales. So potentially disclosure can occur from anywhere within your business and can arise from well-planned strategic activities and accidents alike. Knowing when to hold back and shut up can be one of the hardest skills to learn I found when seeking to impress customers, gain traction, engage investors etc.

Some countries operate a "relative novelty" requirement that provides a grace period after a public disclosure within which to file a patent application. This grace period is a define time period after any public disclosure by the inventor, enterprise etc. within which a patent application may be filed and the disclosure is not considered novelty destroying. Within Canada and the United States this grace period is currently 12 months. But the disclosure will still impact you in all those countries that operate under the "absolute novelty" regime.

Hence, the earlier you engage in discussions with an intellectual property specialist then either the earlier initial patent protection can be established to allow disclosure, both accidental and planned, or the earlier adjustments to marketing plans, conferences, etc. can be made to balance the conflicting demands of securing rights and disclosing. Even if disclosure has been made, engage and engage as soon as possible, as options may

exist in “relative novelty” countries that are important to your planned markets and strategy.

However, an accidental disclosure does not mean you can necessarily sit back and wait for the grace period to expire. Every country operates a “first-to-file” policy on patents including the United States since 2013 with the introduction of the America Invents Act. As such the “first-to-invent” is dead and gone. So your disclosure has been made, thereby potentially limiting where you can patent. But if someone else latches onto your disclosure and files a patent they are in the queue ahead of you and may block your immediate product / market or block logical extensions, expansions, and variants either strategically as they are your competition or to gain revenue by licensing / selling you their patent.

Having been in high technology from corporate R&D to start-ups wearing sales / marketing and technology hats I understand how hard this balance is to keep and even remember exists when you cannot see the wood for the trees and the pressure is on. They used to say talk is cheap and loose lips sink ships. Well, today technology has increased the ease and speed with which we can disclose, how widely we can disclose and metaphorically sink our ship. But that initial chat with an intellectual property specialist is still cheap.

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