Before your innovation has patent protection…

Avoiding Public Disclosure

In the publish-or-perish world of academic research, publishing the results of your research and presenting them at conferences might strengthen your case for tenure. But if not managed properly, it also could jeopardize your chances of patenting any innovations that stem from your research.

U.S. Patent law makes this point very clear: “A person shall be entitled to a patent unless:

1. the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent; or

2. the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application of patent in the United States…”

Here’s what you should avoid if you plan to work with the University’s Office of Technology Management (OTM) to seek patent protection and commercial partners for your innovation:

- Publishing anything – abstract or scientific journal article, for instance
- Giving a talk or poster presentation at an “open” meeting outside the University
- Posting messages anywhere online describing the innovation (including Web sites, public news groups or blogs)
- Sharing the content of a patent application or any description of the invention with someone outside of the University without first contacted the OTM
- Talking with external parties about the innovation without having a Confidential Disclosure Agreement in place (which can be crafted with the OTM’s assistance)
- Transferring scientific materials without the use of a Material Transfer Agreement (which can be obtained through the Office of Research)
• Submitting grant progress reports, which are accessible to the public
• Posting or publishing a student thesis (under some circumstances) – even if nobody ever actually reads it.
• Conducting classroom presentations – including distributing handouts
• Presenting at department seminars

Here are things you still can do without jeopardizing patent rights:

• Lab meetings – as long as they are attended by University employees only
• Faculty meetings – Again, with University employees only
• Confidential submissions for publications – Your submissions remain confidential only prior to acceptance by the publications

• Unfunded government grant applications – As long as your proposal has not yet been accepted for funding, your innovation is safe from public disclosure. Once accepted, though, it becomes accessible to the public.

You also should consider the following tools:

✓ Confidential Disclosure Agreement, or CDA – If you're planning to discuss your innovation with an outside party, such as a potential commercial partner or investor, both parties should sign this confidentiality agreement before entering any discussions. The OTM can facilitate the agreement with you.

✓ Material Transfer Agreement, or MTA – This agreement will protect you against the misappropriation, misuse or infringement of any materials that you send to other research organizations outside the University. It simply establishes contractual parameters around the use of your materials. The Office of Research (www.pitt.edu/~offres/) can facilitate this agreement with you.