

A scientific presentation can defeat patentability

A fundamental principle of patent law is that, in order for any invention to be patentable, it must be novel. But novelty is not absolute and can be destroyed by an action of the inventor.

In academic research, for example, patentability can be derailed by the kind of disclosure that is a normal part of routine scientific discourse. Published journal articles, doctoral dissertations and even scientific presentations can be novelty-defeating.

Under certain circumstances, an oral scientific presentation can become a "printed publication," which destroys novelty for purposes of foreign filings and starts a one-year clock running for filing a patent application in the United States.

Awareness of the potential for creating prior art by giving a presentation is essential to avoiding problems during patent prosecution and beyond.

The statutory phrase "printed publication" has been interpreted to mean that, before the critical date, the information contained in a reference must have been sufficiently accessible to the interested public. "Public accessibility" is the touchstone in determining whether a reference constitutes a printed publication and therefore, a potential bar to patentability.

The courts have enumerated four factors to be considered when attempting to determine whether a scientific presentation constitutes a novelty-defeating "printed publication."

1. The length of time that the presentation was exhibited—this factor goes to the opportunity the public had to capture, process and retain the information conveyed by the presenter. The more transient the presentation, the less likely it is to rise to the level of a printed publication.

2. The expertise of the target audience—provides evidence in establishing how readily the information is assimilated.

3. The existence (or lack) of reasonable expectations that the material displayed would not be copied—the taking of protective measures are to be considered to the extent they create a reasonable expectation that the information will not be copied and might include a simple disclaimer that the material is not to be copied or used.

4. The ease or simplicity with which a display could be copied—the more highly skilled the audience members, the more likely that the material presented will be easily processed and retained. No single factor is determinative; a case-by-case inquiry of the facts and a balancing of the factors is essential to a determination of whether a presentation amounts to a "printed publication."

So, for example, an entirely oral presentation at a scientific meeting is not a "printed publication."

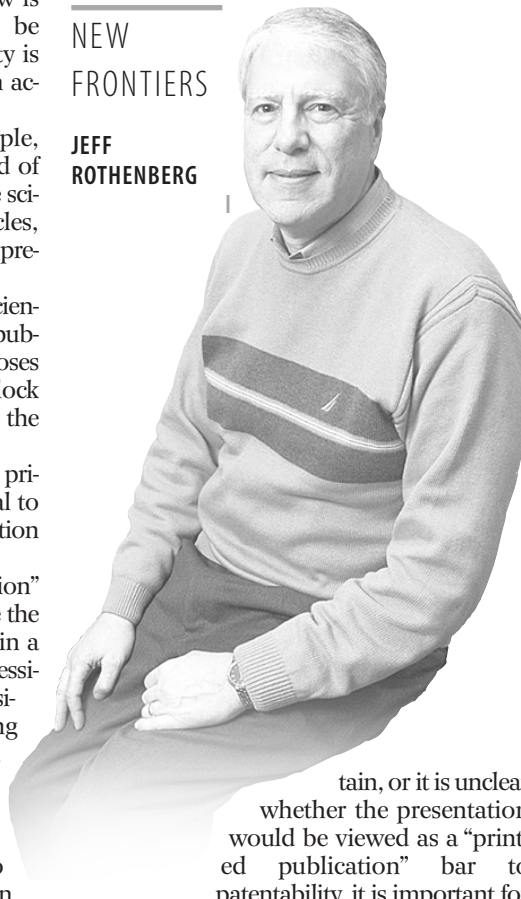
However, a paper delivered orally was determined to be a printed publication where as many as 500 persons having ordinary skill in the art heard the presentation and at least six copies of the paper were distributed to members of the audience.

Likewise, a presentation displayed for three days at a conference of scientists, most likely having ordinary skill in the art, was found to be a printed publication and a patent based on the subject matter was invalidated.

In the event that a patent application on the invention disclosed in the presentation is ultimately filed, but the circumstances surrounding a scientific presentation are not cer-

NEW
FRONTIERS

JEFF
ROTHENBERG



tain, or it is unclear whether the presentation would be viewed as a "printed publication" bar to patentability, it is important for

an applicant to bring the presentation to the attention of the U.S. Patent Office.

Failure to do so may create the appearance of inequitable conduct even if there was no intent to mislead the Patent Office. One case is illustrative of the potential pitfall of not disclosing questionable presentations.

During prosecution of one of their patents, PerSeptive Biosystems of Massachusetts made assurances to the patent examiner that the inventor had not created prior art when he gave a public seminar discussing his invention, because he had not used a poster, abstract, or other writing.

Later, during a patent infringement suit, the opposing party alleged inequitable conduct on PerSeptive's part. The federal district court found that the inventor had used slides in his presentation and had prepared an abstract which was distributed at the conference. This led to a finding of inequitable conduct and the patent was invalidated.

To avoid the creation of a statutory bar to patentability by a scientific presentation, the most desirable course of action is the filing of a patent application, either a provisional or non-provisional application, prior to the presentation.

If, however, the application is not filed prior to the critical date—that is, one year from the date of the presentation—and it is not clear whether the presentation constitutes a "printed publication," the presentation and all circumstances relating to public accessibility should be cited to the U.S. Patent Office as part of the applicant's duty of disclosure of information material to the patentability of the invention. As is often the case, knowledge of this danger is the first step to avoiding unfavorable consequences.

JEFF ROTHENBERG is the managing partner of the intellectual property law firm **Heslin Rothenberg Farley & Mesiti P.C.** He can be reached at jr@hrfmlaw.com. **KATHY SMITH DIAS** of the same firm contributed to this column.

As seen in **THE BUSINESS REVIEW** December 2-8, 2005

© Copyright 2005 by The Business Review, 40 British American Blvd. Latham, NY 12110 • 518-640-6800.