

Patents and Pumpkins: Hidden Soft Spots Can Ruin Them Both

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Imagine: you arrive at the pumpkin patch and see the perfectly shaped, perfectly orange pumpkin for which you've been searching. Envisioning the amazing jack-o-lantern you'll create from this perfection, you snatch it from among the vines – only to find the bottom soft and mushy from mildew!

There may not be many ways in which a patent is like a pumpkin, but the presence of a hidden defect is one. After your patent application finally issues as a patent, surviving rigorous (and expensive) examination, you may unexpectedly discover your patent has a giant soft spot as a result of government funding.

How can the grant of government funding be the mildew on your patent pumpkin?

Grants, particularly government-funded grants, can be heavily relied upon by those at research institutions to support their research. Grant applications typically contain a detailed account of the work to be performed and the corresponding rationale, and if the grant is funded an abstract is generally published contemporaneously. In many instances the grant abstract is publicly available before the filing of a patent application on the resulting work and would be considered prior art. In addition, under government-funded grants, a complete copy of a funded grant application can be requested by anyone who is interested in the project, arguably making the complete grant application publicly accessible. In the US, public disclosures by the inventors trigger a one-year time bar for the inventors to file a patent application; such public disclosures will be a bar to patentability in most foreign jurisdictions for the subject matter disclosed. Moreover, even in the US, public disclosures by third parties (e.g., a competing lab's funded grant publication) can be a prior art bar for inventors pursuing similar subject matter.

There are a number of steps that can be taken to protect patent rights for an invention that has been sponsored by a government grant:

1. The inventors should advise counsel when government funding has been awarded for the research that has led to the filing of the patent application. This is routinely done in view of the obligation to note such funding in the patent application itself and to report corresponding patent applications to the grantor;
2. The grant abstract submitted with the grant application should include only non-confidential, high-level information regarding the proposed research;
3. The inventors/researchers submitting the grant application should reserve all rights to redact or protect confidential information under the particular grant scheme of the funding source if a copy of the grant application is requested. Most granting authorities provide a mechanism by which notification is given to the researcher upon receipt of a

request for the complete grant application, and an opportunity for the researcher to redact confidential information is provided;

4. In the course of preparing the patent application, a determination should be made regarding whether any requests for the complete grant application have been made, and if a copy of the grant application has been provided to a third party, whether confidential information has been redacted; and
5. If the grant abstract was published or a third party request for the complete grant application was made prior to the filing of the patent application, this information should be disclosed to the U.S. Patent & Trademark Office. It may also be helpful to provide for the record a statement that to the inventors' knowledge no request for the grant application has been made (if true).

These steps will help ensure that your granted patent will withstand a challenge based on prior art issues raised by the grant of government funding. In addition, any licensor or acquirer of a patent or patent application that discloses work supported by government funding should make inquiries along this line a part of their due diligence process. Make sure your patent asset has no hidden soft spots to maximize its value. Now, back to planning that perfect jack-o-lantern!

For more information, please contact **Erin Bryan** or **Lisa Warren**.