

Disclosing the Invention

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a. Disclosure in General

In most countries, the unrestricted disclosure of an invention precludes one from receiving a patent on the invention. This is not so in the United States. U.S. patent law allows an inventor one year from the first disclosure of an invention to file an application to patent the invention. This peculiar quirk of U.S. patent law often makes companies complacent about being diligent in seeking patent rights and obtaining appropriate confidentiality protection. Such complacency is not good practice.

As a primary matter, an invention should not be disclosed to a third party before the conception of the idea is properly documented according to the steps above. This practice helps to defend fraudulent claims of inventorship against your company's intellectual property assets.

Secondly, an invention should not be disclosed without an express written confidentiality agreement. Not only does this practice protect against theft of sensitive data, it protects against loss of foreign patent rights.

When dealing with suppliers, it is a good idea to have them sign confidentiality agreements as some resourceful suppliers can piece together from purchase orders much or all of a prospective invention.

b. Patents and Foreign Disclosures

U.S. patent law provides that except when authorized by a license obtained from the Commissioner of Patents, a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent in respect of an invention made in this country.¹ Failure to heed this statute can result in the invalidity of any patent issuing for the invention.² There are also export control laws that prohibit the export of sensitive technology apart from the patent application procedure. Violation of these laws can result in civil and criminal penalties.

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¹ 35 U.S.C. § 184.

² 35 U.S.C. § 185.

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