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IP: Strategic use of printed publications for intellectual property protection

If used correctly, printed documents can preclude competitors' patent applications

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To develop a comprehensive IP strategy, a company or IP attorney should ask some basic questions about the company's goals.

- Do you want to stop competitors' patents from issuing?
- Do you want to create licensing and sales opportunities?
- Do you want to stop or facilitate litigation?
- Do you want to shore up your patent portfolio without spending your entire patent budget?
- Is it a combination of some or all of the above?

One underused route to any good IP strategy that addresses each of these questions is the strategic use of printed publications.

Patents and patent applications are considered traditional printed publications. An issued patent will protect your invention by giving the inventors the right to exclude others from making, using and selling for 20 years from the filing date of the patent application. Non-patent publications work in conjunction with patents and patent applications. These publications are printed in the forms suggested above and can help make a patent budget more efficient.

A document is proven to be a printed publication "upon such satisfactory showing that the document has been disseminated or otherwise made available to the extent such persons interested and ordinary skilled in the subject matter of the art, exercising reasonable diligence can locate it."

The probability of dissemination of an item really has little to do with whether it's "printed" in the traditional sense of the word anymore. For example, microfilm, magnetic discs or tapes and handwritten items may all be considered printed publications. An electronic publication, including an online database, Internet publication or pages from a website, is a printed publication under 35 USC §§102 (a) and (b) provided the publication was accessible to persons concerned with the field or art to which the document relates. Other, more traditional, printed publications include patents and published patent applications, journal articles, meeting abstracts, company announcements and whitepapers.

One issue is whether the printed publication is a document that would preclude patentability for another company's patent application (prior art) or is just available to show the state of the art in the field of the invention. Most printed publications have a tangible publication date; however, electronic publications are not so obvious. Electronic publications are considered to be publicly available as of the date the item was publicly posted, but it must include a publication date in order for the U.S. Patent and Trademark Office (PTO) or the Federal Circuit to consider it prior art. An electronic publication may be relied on for all that it would have reasonably suggested to one having ordinary skill in the art. If it's printed in abstract form then only the text of the abstract can be relied on to support patentability rejections.

There are limits and special circumstances to the use of printed publications. For example, confidential internal documents are not printed publications for the purposes of this discussion. Oral presentations can be considered printed publications, if written copies are available without restriction. A library document, such as a dissertation or thesis, may also be considered a printed publication if it's sufficiently accessible to the public.

These publications may contain information, such as modifications and improvements to inventions that the PTO has already patented or is currently examining. These publications can also include information that the company does not want to protect with a patent, but instead wants to publish to exclude other companies from securing patent protection on the same or similar subject matter developed on their own or through reverse engineering. In addition, non-patent publications can support a contention of non-infringement, if a competitor obtains a patent on information Company A has already published.

One example of how these publications can be used is that Company A first files a broad patent application in the U.S. or through the Patent Cooperation Treaty (PCT) process. Additional modifications or embodiments are developed later that are related to the broad patent. Company A announces the broad patent and additional embodiments as one or more non-patent publications. If patentable, these publications may be rolled into one continuation-in-part application within a year of the first publication or donated to the public by not filing additional patent applications.

One risk is that non-patent publications can result in the loss of foreign patent rights. Foreign countries will not allow an application to issue if the patentable subject matter of the application was published before the filing date of the application. Therefore, it's crucial that businesses carefully review and consider non-patent publications and use them strategically with respect to the big picture of the patent portfolio for the inventor/company. Companies can facilitate this review by setting up an in-house procedure or Intranet web interface for the submission of all potential printed publications, including invention disclosures, speaking engagement notices, articles, white papers, website updates, etc. Once submitted, these documents and requests are both tracked and channeled to one team leader, in-house counsel or IP committee for review and approval.

The strategic use of printed publications can be a valuable addition to any intellectual property plan. Use of printed publications can maximize a patent budget, keep a litigation budget under control, maximize licensing and assignment opportunities and control loss of trade secrets. Although there are risks associated with printing otherwise patentable information, if handled properly, printed publications can enhance a patent portfolio and help add value to future innovations.

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