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Disclosing Information About a Pending Patent Application

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Once you have filed a patent application for one of your inventions and thereby obtained “patent pending” status, you may feel a sense of relief, and for good reason. Patent pending status provides you with a certain kind and degree of protection against others. Patent pending status does not, however, provide you with the same kind or degree of protection as a granted patent. Therefore, although you may choose to disclose certain information contained in your pending patent application to others, you should understand the nature of the protections afforded to you by patent pending status before disclosing any information from the patent application to others, so that you may make an informed decision about whether and how to make such disclosures.

References hereinto disclosing information to “others” refers to disclosing information to others with whom you do not have a confidential relationship, such as third parties who have not signed any confidentiality (nondisclosure) agreement with you. You may disclose information from your patent application to others who have a legally-binding obligation of confidentiality to you without jeopardizing your rights in the invention disclosed in the patent application. Please note, however, the caveat below relating to the potential ability of third parties to obtain patent protection on improvements to your inventions, even if such parties have signed a confidentiality agreement with you.

Filing a patent application for an invention in the U.S. provides you with some protection against the risk that someone else will obtain a patent on that invention instead of you. In particular, if someone else files a patent application on the same invention as you after you have filed your patent application, then, under the current U.S. “first to invent” system, you are entitled to continue pursuing patent protection unless the other party can prove that they invented the invention before you did. The burden of proof is on the other party. Therefore, although the fact that you filed your patent application first does not provide you with absolute protection against another party filing after you and prevailing over you in a dispute about who invented the invention first, filing first does provide you with a significant procedural advantage in such a dispute. Note that the law in this regard is about to change in 2013, when the U.S. moves to a “first inventor to file” system. Stay tuned to our [web site](#) for updates.

Therefore, once you have filed a patent application in the U.S., if you disclose information from the patent application to someone else and that person then files a U.S. patent application on the same invention and claims to be the first and true inventor, it will be difficult for that person to obtain a patent on the invention instead of you,

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particularly if you have kept good records of your communications with the other party about your invention.

Furthermore, disclosing information about your invention *before* you have filed any patent application on that invention can jeopardize your U.S. and foreign patent rights. In particular, if you publish information about your invention, use the invention in public (such as by providing a demonstration of the invention at a trade show or launching a web site that uses the invention), or sell the invention or offer it for sale, you may immediately forfeit your patent rights outside the U.S., and you may trigger a one-year deadline for filing a patent application in the U.S. In contrast, if you file at least a U.S. patent application before engaging in any of the activities just described, you will preserve your foreign patent rights for up to one year and avoid the need to address (in the Patent Office, in court, or in a due diligence), whether any of your activities occurred more than one year before you filed your U.S. patent application.

In general, therefore, once your patent application has been filed you may disclose information from your patent application to others without jeopardizing your patent rights in the invention disclosed in the patent application. It is important to remember, however, that the patent application only protects the invention as described in the patent application. Therefore, if you make improvements to the invention, and such improvements are not described in the patent application, you should treat such improvements as if they were new inventions for which no patent applications have been filed. You should therefore investigate whether to pursue patent protection for such improvements and then either file patent applications for such improvements or decide not to seek patent protection for such improvements before disclosing information about such improvements to others.

The fact that you *may* disclose information from your patent application to others after your patent application has been filed does not necessarily mean that you *should* do so. You should always exercise due care before disclosing information from your patent application to others, especially during the time when your patent application remains pending but unpublished (normally until 18 months after the patent application was filed). During this period of time the patent applications remains hidden from the public. Therefore, information from the patent application will only become available to the public during this time if you choose to make such information available.

One reason you may not wish to disclose information from your patent application even after it has been filed is that someone who learns of your invention may be inspired by it to invent an improvement to your invention. Such an improvement may not be covered by your patent application. Therefore, it may be possible for the other person to file a patent application and obtain a patent on the improvement, thereby potentially obtaining a patent that can be used against you, even if that person has signed a confidentiality agreement with you (depending on how that agreement is worded). If you want to minimize and/or delay the risk of others obtaining patents on improvements to your invention, you may wish not to reveal information from your patent application until at least the time at which your patent application is published.

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Furthermore, a pending patent application is not a granted patent. You cannot, therefore, sue someone for infringing a pending patent application. Therefore, if you disclose information from your pending patent application to a party who then begins making and selling your invention without your permission, you cannot sue that party for patent infringement unless and until your patent is granted. Although you can cause the Patent Office to examine your patent application more quickly if you can prove that someone else is infringing the claims of the patent application, the burden of proof is high and you will still need to wait some period of time before your patent is granted (assuming that it is granted). Providing information to a third party about your invention while your patent application is pending may, therefore, enable that party to copy your invention during a period when you lack enforceable patent rights against that party.

As the examples above demonstrate, although filing a patent application provides you with some protection against others, there are still reasons to consider disseminating information from your patent application on a “need to know” basis, at least until your patent application is published.

Furthermore, if you wish for others to know that you have applied for a patent on your invention, you can indicate on your product, its packaging, and related documents that your technology is “patent pending” without revealing any information that is contained within the patent application itself. You may therefore obtain the benefit of informing others that you are seeking patent protection for your technology, but without revealing any of the contents of your patent application.

Deciding whether, when, and how to disclose information about your patent-pending invention can be difficult and depend on your particular circumstances. If you have any questions about disclosing information from your pending patent application, please [contact us directly](#).

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