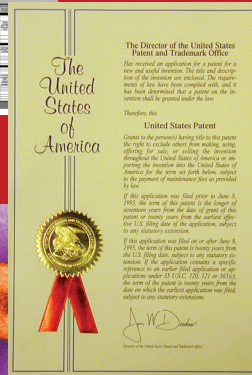
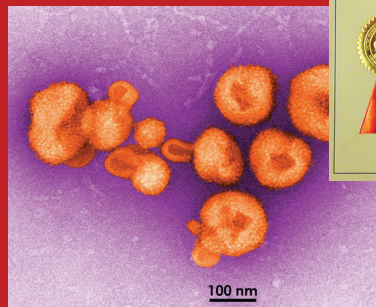


# AVOIDING LOSS OF PATENTABILITY CAUSED BY ORAL AND POSTER PRESENTATIONS



**Criteria for Addition or Removal of a Biological Agent or Toxin from the Select Agent List**  
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| Criteria  | Current Status | Proposed Status |
|---|----------------|-----------------|
| 1. Is the agent or toxin a biological agent or toxin?   | Yes            | Yes             |
| 2. Is the agent or toxin a select agent or toxin?   | Yes            | Yes             |
| 3. Is the agent or toxin a biological agent or toxin that is a select agent or toxin?   | Yes            | Yes             |
| 4. Is the agent or toxin a biological agent or toxin that is a select agent or toxin and is a biological agent or toxin?                                    | Yes            | Yes             |
| 5. Is the agent or toxin a biological agent or toxin that is a select agent or toxin and is a biological agent or toxin and is a biological agent or toxin? | Yes            | Yes             |



Under certain circumstances, a poster presentation or even an oral presentation relating to an invention may prevent an inventor from later being able to patent the invention in the United States (Note: Foreign patents are governed by laws of the relevant countries; consultation with experienced foreign counsel is strongly recommended in these situations.) The most prudent way to avoid the loss of patenting rights is to file a provisional patent application before making any type of disclosure. As a safety precaution, in case of doubt, you should file a patent application no later than one year after making a public oral or poster presentation. However, if you are unable to file a provisional patent application, the information included in this brochure will help you to avoid jeopardizing your patent rights.

## 35 U.S.C. 102(b) CREATES A STATUTORY BAR TO PATENTABILITY

Title 35 U.S.C. Section 102 Conditions for patentability; nov-ely and loss of right to patent.

A person shall be entitled to a patent unless —  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

If a poster or oral presentation meets the requirements of a “printed publication” under the patent statute, the date of the oral presentation starts a one-year clock within which a patent on the invention must be sought. This statutory deadline cannot be extended. Even if a good-faith delay was caused by circumstances outside the control of the researcher, non-compliance with the one-year deadline constitutes an absolute bar to patentability. *In re Foster*, 343 F.2d 980, 984 (CCPA 1965). This is true whether the oral or poster presentation takes place in the United States or in a foreign country. Once an inventor has decided to publicize his or her work, a choice must be made between the protection of a federal patent or the dedication of the invention to the public. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989).

# AVOIDING LOSS OF PATENTABILITY CAUSED BY ORAL AND POSTER PRESENTATIONS

## WHAT IS A “PRINTED PUBLICATION”?

The determination of whether an oral or poster presentation is a “printed publication” is highly factual. Intuitively, we tend to consider that a “printed publication” is something has been published in paper form either as part of a journal, magazine, or book. However, the United States Patent and Trademarks Office uses a much broader definition of the term which—depending on the individual facts of the case—includes temporary printed displays such as posters, handouts, and even oral presentations. There is no bright line. Even though actual “printing” appears to be secondary, case law indicates that public disclosure and public accessibility are the determining criteria.

## A POSTER PRESENTATION CAN BE A “PRINTED PUBLICATION”

A publicly displayed document such a poster, where others can see it and are not pre-cluded from copying, can constitute a “printed publication.” This is true even if the contents of the poster are not disseminated through printed copies. Indexing in the proceedings of a professional meeting, a library, or a database might also be considered publication. Scientists should refrain from making copies of their poster presentations and allowing the public unfettered access to those printed handouts since there is little doubt that those handouts are “printed publications.”

The key element to determine whether information has been “published” is the degree of public accessibility. *In re Klopfenstein*, 380 F.3d 1345, 1352 (Fed. Cir. 2004). Courts have considered the following factors to resolve whether or not a temporarily displayed reference that was neither distributed nor indexed was a “printed publication”:

- “length of time the display was exhibited,”
- “expertise of the target audience,”
- “existence or lack of reasonable expectations that the material displayed would not be copied,” and
- “the simplicity or ease with which the material displayed could have been copied.” 380 F.3d at 1350.

## AN ORALLY PRESENTED PAPER CAN BE A “PRINTED PUBLICATION”

An entirely oral presentation that includes neither slides nor copies of the presentation is without question NOT a “printed publication.” *In re Klopfenstein*, 380 F.3d at 1349 n.4, 72 USPQ2d at 1122 n.4. However, if a paper is orally presented in a forum open to all interested persons, then it constitutes a “printed publication” if written copies are disseminated without restriction. *MIT v. AB Fortia*, 774 F.2d 1104, 1109 (Fed. Cir. 1985). Thus, oral presentations should be structured such that they will not be considered “printed publications” under the patent statute. Inventors who want to preserve the patentability of their inventions should to limit “public accessibility” to the subject matter of the invention.

## PROTECT YOUR RIGHTS, WHEN IN DOUBT, FILE A PROVISIONAL PATENT APPLICATION

### DO NOT

- Hand out copies of a poster or of slides that accompany an oral presentation
- Hand out a written summary of the oral presentation
- Provide access to the poster, slides, or other written material via internet or email
- Allow transcribing or recording of the presentation
- Include enough information such that a colleague would be able to practice the invention
- Allow cataloguing your poster or oral presentations or accompanying printed materials

### DO

- Limit the length of the oral or poster presentation
- Limit the scope of the subject matter presented, avoid disclosing critical details
- Avoid the use of slide shows or show slides only briefly
- If a slideshow is necessary, limit the number of slides and the content of the slides
- Indicate that you intend to keep the subject matter of the presentation confidential, either orally or by providing a handout stating that it is your intent
- Take steps to prevent copying, cataloguing, or indexing of the materials in the presentation

## RESTRICTING “PUBLIC ACCESSIBILITY”

“Public accessibility” is limited when the inventor takes the following precautions:

- The inventor expresses and intends to prevent public distribution of the subject matter of the invention.,
- The disclosure of the invention made by the inventor is limited such that all details of the invention are not revealed,
- The disclosure of the subject matter is made under confidential circumstance (after non-disclosure confidentiality agreement, or express expectation of confidentiality).
- The portion of the public that is exposed to the matter of the invention is limited.

## SCENARIOS AND OUTCOMES

An oral presentation with a 14-slide presentation was delivered to a large audience of scientists. The slides were printed and pasted onto poster boards, which were displayed continuously with no confidentiality restriction or two and a half days at two different events. **Bar. Invention cannot be patented because the information was clearly disseminated without restriction.** *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004).

After delivering his Ph.D. dissertation a graduate student’s thesis is cataloged in the university library. There is no evidence that the anyone accessed the thesis after that. **Bar. Invention cannot be patented because even though nobody accessed the information, the dissertation was “accessible” to the public.** *In re Hall*, 380 F.2d 1345 (Fed. Cir. 1986).

A graduate student delivers an oral presentation describing his invention at a conference. No slides or posters are presented to the audience. **No bar. Invention could be patentable because an entirely oral presentation is “without question” not a “printed publication.”** *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004).

After delivering his Ph.D. dissertation a graduate student deposits his thesis in the university library, but the thesis is not cataloged. **No bar. Invention could be patentable the thesis was not accessible because it had not been cataloged.** *In re Cromyn*, 890 F.2d 1158 (Fed. Cir. 1989).

Paper orally presented to between 50 and 500 persons at a scientific meeting open to all persons interested in the invention. Written copies were distributed without restriction to all who requested. Six persons requested and obtained copies. **Bar. Invention cannot be patented because a paper orally presented in a forum open to all interested persons is a “printed publication” if written copies are disseminated without restriction.** *MIT v. AB Fortia*, 774 F.2d 1104 (Fed. Cir. 1985).

**FUNDING:** The production of this brochure was supported by a grant from ABCD EFGD, Grant No. 12345678-06.