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ADVOCATI RES MENTIS

Patent Alternative: The Defensive Publication

In general, obtaining and maintaining patents is a form of risk management for a company. For example, a company that has failed to secure any patent protection may lose control over its core technology, and is vulnerable to law suit and oppressive licensing terms. Because obtaining and maintaining patents can represent a substantial portion of a company's intellectual property budget, many companies form an invention review committee that is charged with determining when expenses associated with patent protection are justified. For those inventions where patent protection is pursued, the company risk is effectively managed. However, for those situations where the cost/benefit analysis indicates that the expense of patent protection is not justified, an alternative form of risk management should be sought. A defensive publication is one such alternative, especially when trade secret alternatives are not tenable or otherwise limited.

Under U.S. patent law, a "printed publication" having a publication date that is prior to the effective date of a patent can be used to invalidate that patent. Such a publication can therefore be used defensively, where a company issues a publication (e.g., article in a trade magazine) describing technology that it has developed. By issuing the publication, any subsequent patent filings by other companies or inventors will have to contend with the publication as prior art. In this sense, the company that issues the publication is afforded a degree of protection. For example, if the company is confronted with a competitor's patent that claims the technology described in the publication, the company can wield that publication as a shield to discourage threatened litigation and thwart hostile licensing campaigns. Likewise, the company can wield the publication as a sword to challenge the patent's validity in litigation, or to negotiate favorable licensing terms. Hence, a defensive publication may be used to reduce the company's exposure.

However, to qualify as a "printed publication" under the U.S. patent law, the publication must satisfy certain criteria. In particular, the publication must have been "sufficiently accessible" to the public interested in the described technology prior to the effective date of the target patent.

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In addition, the publication must enable one having ordinary skill in the described technology to practice the invention that is claimed in the patent. The "sufficiently accessible" requirement has two components: accessibility and dissemination.

Accessibility goes to the issue of whether interested members of the relevant public could obtain the publication if they so desired. If accessibility is proven, there is no requirement to show that particular members of the public actually received the publication. In addition, evidence of routine business practices can be used to establish the date on which a publication became accessible to the public. For example, a librarian's affidavit establishing normal time frame and practice for indexing, cataloging, and shelving doctoral theses has been used to establish that a particular thesis in question would have been accessible to the public before the target patent's effective date. Dissemination goes to the issue of whether the accessibility to the public is sufficient, and thus acts as a limitation on the factor of accessibility. The probability of wide circulation of the publication is therefore required. While unrestricted distribution tends to support probability of wide circulation, restrictions such as "reproduction or further dissemination not authorized, and not for public release" tend to go against this probability.

Whether published information qualifies as a "printed publication" under U.S. patent law is a legal determination based on the underlying fact issues. As such, always consult with counsel before launching on a defensive publication strategy.