

Should you elect non-publication?

Short answer: yes, in most cases, assuming no foreign filing.

Longer answer: see below.

Jack S. Emery, JD, PhD
jack@jacksemerypa.com
March, 2013

Under current law in most countries, patent applications are published 18 months after filing. The U.S. adopted this practice in 2000. But in the U.S., it's optional: you can elect not to have the application published (as long as you are not also filing in foreign countries).

Should you?

First, a few of the details about publication:

- **It's the application, not the patent.** We aren't talking about the *patent* being published. If a patent issues, it *will be* published, always (except in rare situations where national security issues are involved). What we're talking about here is the *application* being published, usually long before any patent would issue.
- **18 months from when?** The 18 months is measured from the first application in the priority chain. In the common case where the first filing is a provisional application, followed by a non-provisional application just before the provisional year expires, that means publication is 18 months after the provisional filing date. But what gets published is not the provisional, it's the non-provisional. Also it's usually not 18 months, it usually seems to take up to a few months longer than that. What about divisionals and continuation-in-part applications? If it's already more than 15 months past the filing date of the first application in the priority chain, publication will be scheduled (in theory) about 14 weeks after filing.
- **What is it that gets published, and where, and how?** U.S. applications are published electronically on the USPTO web site. Once published, they are searchable in the USPTO's search database and all of the commercial patent search databases. This includes the written description, drawing figures, initial claims, and abstract. But that isn't all -
- **After publication, the whole file becomes accessible.** The USPTO maintains a web-accessible database, PAIR (for Patent Application Information Retrieval), that includes all the paperwork relating to every patent application. Until an application is published, only the applicant (or applicant's attorney) can access the file on PAIR, but once the application is published (or a patent issues), the entire application file becomes accessible. That

includes all the office actions, the applicant's responses, any amendments – and it also includes the provisional application if there was one.

- **Non-publication requires an election.** In other words, the “default setting” is publication – if you do not file the election, the application will be published. However, filing the election amounts to checking a box on the Application Data Sheet, which should always be filed with a new application anyway, so no extra work or cost is involved.
- **You can also elect early publication.** If you decide that you like the idea of having your application published, you don't have to wait 18 months – you can request early publication.

So what are the pros and cons? First, I'll review some of the claimed advantages and a few of what I see as disadvantages, together with my take on each one (beneath, in italics). Then I'll mention a few other considerations, and close with my own opinion.

Advantages of publishing

- **It acts as a defensive publication.** Once published, a patent application becomes part of the body of prior art against which other applications are judged for novelty and obviousness.

This strikes me as a weak reason. If it is in your interest to make a defensive publication, there is no reason to wait 18 months for the patent office to do it. Better to do it yourself, so you can control what goes into it and get it done immediately. (Note: publications of any kind are potentially hazardous to your patent health. Consult your patent attorney before you do it.)

- **Pre-issuance damages.** Damages for infringement can include royalties for the period after publication but before issuance of a patent, if the application is published. If the application is not published, you cannot collect damages for infringement that occurs before the patent issues.

*This advantage is mostly an illusion in my opinion. You can't sue for patent infringement until you have an issued patent – publication or no publication. Nowadays, it often takes at least two or three years for an application to float to the top of the queue and get examined so that a patent can issue. That gives copyists a multi-year window in which to copy your invention and make as much money as possible before you can do anything about it. In theory, pre-issuance damages give you a (somewhat puny) weapon against that kind of rip-off: after the patent issues, you can sue for a reasonable royalty for infringement that happened before the patent issued but after the application was published. But **only** if the issued claim that you are suing on is "substantially identical" to a claim in the published application, **and** the infringer is given actual notice of the application.*

As a practical matter, claims are nearly always amended during prosecution, so they usually won't be substantially identical. Often, you won't find out about the

infringement until it's already been going on for a while, and you can't give actual notice until you know who to give notice to. Worse, especially for easily copyable products, the infringer may be a shell corporation whose only business is infringing your patent. It won't have any assets for you to collect from, and probably won't even bother to respond to the infringement suit. For all these reasons, pre-issuance damages are a poor solution to the problem of pre-issuance infringement. Better (usually) to apply for accelerated examination and get the patent issued as soon as possible.

Another reason why this "advantage" is illusory is that even after electing non-publication, you can change your mind and get the application published within about four months with a simple request to the PTO. So if an infringer appears, you have only lost a few months of damages, assuming you eventually collect any.

- **Non-publication precludes foreign filing.** When you make the non-publication election, you are required to certify that you have not filed and will not file on the same invention in a foreign country where applications are automatically published (which is essentially all of them). That means if you elect non-publication, you can't file a PCT application or file in a foreign country.

This "advantage" is true, but not really a factor in making a decision whether to elect non-publication. In the most common situation, where the application claims priority from a provisional application filed a year earlier, the "fish or cut bait" decision time on foreign filing is now. Either you are filing a PCT application, or you are not. If you are, you cannot elect non-publication so there is nothing to decide. If you are filing in the US only, you will almost certainly not be filing a foreign application in the future because it will be too late to claim priority from the provisional. And in a very unusual case where a foreign filing might remain an option, you can revoke the non-publication election at any time.

Disadvantages of publishing

- **Loss of trade secrets.** As long as the application remains unpublished, and assuming you haven't disclosed the invention in some other way, one way of protecting against copyists is to keep your invention secret. Obviously that isn't always feasible, but you definitely won't have that option once the application is published.

Whether secrecy is a viable strategy will depend on your business goals. If the important information is already available from a product that you are selling, or from other publications, there may not be much secrecy left to maintain. On the other hand, if your invention does involve some proprietary ideas, trade secret law may give you another weapon that you could use against an infringer during the several years that will likely pass before you have an issued patent and can sue for patent infringement.

- **Competitors can see the details.** Whatever is in the application – or anywhere else in the PTO file – will be out on the web for anyone in the world to access.

Patent applications often disclose considerable detail beyond what a competitor could get from public sources – for example, features that you haven't yet commercialized. If you aren't yet ready to enter the market with a product, a published patent application may simply provide a blueprint for a copyist. Also, most patents are issued with claims that are far narrower than what is disclosed in the application, so by publishing, you're giving everyone with an internet connection an early preview of many details that likely won't even be covered by your patent.

- **Fewer options if no patent issues.** Only about 60% of applications eventually result in issued patents. Those become public once a patent issues. What about the other 40%? If the application was published, it's now publicly available (obviously). But an unpublished application, when abandoned, does not become public (unless you have made its contents public in some other way), so if you kept the contents confidential while the application was pending, you can continue doing so.

Usually, when a patent application is abandoned, it isn't because the invention was worthless – usually, it's because the examiner has rejected the claims that the applicant wants or needs, and the claims that could be gotten, if any, are not worth what it would cost to get them. The applicant may still want to market the invention – or may already be doing so. Or, the applicant may simply prefer to keep his/her failed applications private. If the application was not published, no one ever need know that it was even filed, much less abandoned. But if it was published, now anyone who looks up the applicant's name in a patent search database will see the application, and that it was abandoned.

- **Giving away business intelligence.** An applicant's patent filings can provide considerable insight about what technologies he/she is working on, what his/her IP strategy is, what products are likely to be forthcoming, what future filings are likely, etc. – all valuable information for a competitor.

Allowing applications to be published ensures that this information will be available much earlier than it otherwise would be, and in the case of applications that are eventually abandoned, puts on the record applications that would otherwise never become public at all.

- **May create prior art against your own future filings.** Suppose you later want to file a new application covering similar subject matter – not uncommon for applicants who are developing multiple projects around a core technology. If the old application was published and more than a year has passed, it will be prior art against the new application.

This should be a rare occurrence in practice, because applications on subsequent developments should usually be filed as continuations-in-part claiming priority to a chain of earlier applications for which pendency has been maintained. It can certainly arise as to an earlier application that was published and then abandoned, but I don't recommend letting pendency lapse on an application chain that relates

to subject matter in which the applicant continues to be active. The problem can also arise in situations where it would be desirable to file a new application -- not a continuation-in-part -- so as to restart the patent term clock and get the full 20 years.

- **Publication fee.** At this writing, the PTO charges a \$300 publication fee on applications that are published, payable when and if a patent issues. This fee is currently scheduled to be dropped as of January 1, 2014.

Other considerations

- **Third party prior art submissions.** As of late 2012, anyone can now submit prior art publications for consideration by the examiner in an ongoing application that has been published. The submission can be anonymous.

Depending on your strategy, having some unknown third party point the examiner at problem prior art could be a good thing (if the patent issues anyway) or a bad thing (if it sends the examiner off on some tangent and costs you a lot of time and money to get the application back on track). So far, this is not shaping up as a big deal, and only a few hundred third-party submissions have been made so far. And under current rules, the third party can only submit a copy of the publication - no explanation or argument is allowed. But rules can change, and there is a lot of pressure from some groups to expand the role of third-party opposition, so this may become a much more important consideration in the future.

- **If you elect non-publication, you can change your mind.** A non-publication election can be rescinded at any time by filing a simple form. See 37 CFR 1.213(b).
- **If you do not elect non-publication, you cannot change your mind.** The rules specify that a non-publication request must be submitted with the application upon filing. See 37 CFR 1.213(a).

So, what do I recommend?

It depends on the situation. I'll here insert the usual disclaimers - this isn't legal advice, no one can give you legal advice without taking into account the specifics of your situation, I could be wrong, there are exceptions to everything, etc. With those caveats, I would usually err on the side of electing non-publication.

Naturally, this only applies to US-only applications. If you're filing a PCT application, you won't elect non-publication, because you can't. And if the inventor is an academic who is going to publish everything anyway, the election may not matter much. But the supposed advantages of publication seem to me mostly not to stand up to scrutiny, and it isn't hard to think of scenarios in which an applicant might come to regret being locked in to a decision to publish. Other things being equal, I'd rather make choices that I can change if it turns out I was wrong - if I elect non-

publication I can easily change my mind at any time, but if I file without that election, then I'm stuck with publication.

(Note: This is clearly a minority view, at least as judged by PTO statistics. Only about 6% of applicants currently elect non-publication. But for those who don't, I have a question: if you've decided that publication is such a great idea, why wait 18 months? Why not ask for early publication immediately on filing? Almost no one does - I don't have statistics for the U.S., but in the European Patent Office only about 50 applicants per year ask for early publication. So my hypothesis is that most applicants accept the 18 month publication simply because it's the default.)

For more detail . . .

<http://www.uspto.gov/patents/law/aipa/18month/18monthfaq.jsp>

<http://www.uspto.gov/patents/law/aipa/helpfulhints.jsp>