

# ***Patenting Obstacle Prior Public Disclosure***

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Patent law in most countries include rules which **prohibit** you from obtaining a patent **if, before you file your patent application and before your priority date** (if you have a priority date):

- I) **the invention** was in any way disclosed to the public by another person who did not learn of **the invention** directly or indirectly through you; **or**
  - II) **more than one year earlier** your invention was in any way disclosed to the public by you or by someone who did learn of your invention directly or indirectly through you; **or**
  - III) in Canada and some other countries, **the invention** was described in an earlier filed (or deemed filed) patent application of someone else.
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“**your invention**” means specifically what you invented.

“**the invention**” means your invention or someone else’s invention that is the same as your invention in all of its functional aspects. By way of example, if you invented a new screw driver and someone else also invented a new screw driver which did all of the same things as your new screw driver, and did them all in the same ways as your new screw driver did them, and the only differences between your new screw driver and their new screw driver were differences that did not affect what the screw drivers did or how they did them, then your new screw driver and their new screw driver would be considered to be the same invention.

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**You will NOT have a priority date in Country “X” unless:**

- (a) **before you file** your current patent application in Country “X” you previously filed an earlier patent application or something the patent office of Country “X” considers to be an

- equivalent to a patent application for priority date purposes (hereinafter referred to as the “**prior application**”) **and**
- (b) that **prior application** was filed in Country “X” or another country which has a priority date agreement with Country “X” (which is most other countries regardless of which country is Country “X”) **and**
  - (c) the **prior application** disclosed all of the aspects of your invention that you want to patent in your current application **and**
  - (d) usually that **prior application** had to have been filed 12 months or less before your current patent application is filed.

In addition to the above, in some situations there are other conditions that also have to be met, and there are priority date claiming requirements that also have to be met when you file your current patent application or within a specific time period after you file your current application.

The bottom line is that if you are about to file a patent application and you have a previously filed **prior application** and you want to try and make a priority claim based on that other earlier filed **prior application**, look into all of the conditions and requirements that relate to your specific patent application as soon as possible, because even if everything else is in your favour, if you file your current patent application later than 12 months after your earlier filed **prior application**, usually you will be out of time and not get a priority date.

The value of a priority date, if you can get one, is that it effectively gives you an earlier filing date than the date on which you actually filed your current patent application; which, as you can see from statements I), II) and III) of the first paragraph of page 1, might allow you to proceed with a patent application that would have failed without the priority date. A priority date can also allow you to overcome a patent office objection that could not be overcome based on your actual filing date. Patent Office objections are discussed in my paper: “*The Patent Application Process*”.

As a point of interest, most patent applications do not have a priority date. Hence, even though it is good if you do have a priority date, if you do not have a priority date don’t worry about it.

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**Disclosed to the public means that ANYWHERE IN THE WORLD,**

somehow, it doesn't matter how, a least some people who would be considered members of the public, where able to **legally** learn how **the invention** does what it does.

**The usual ways** in which **the invention** could have been disclosed to the public are that **the invention**:

- 1.) was described in someone else's patent or published patent application;
  - 2.) was described in a publication (eg. journal, magazine article, newspaper story, etc.);
  - 3.) was shown or described in such a way as to divulge how it works on any publicly accessible social media or publicly accessible portion of the Internet;
  - 4.) was used in a place where at least some members of the public could see how it works, or how it works was described in a place where at least some members of the public could have learned how it works.
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**For patent law purposes people are considered to be members of the public unless they:**

- (i) are related to you; **OR**
  - (ii) are a friend of yours; **OR**
  - (iii) entered into a non-disclosure (or equivalent) agreement with you, binding them to not disclose how your invention works.
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**How will the Patent Office know if any of 1.), 2.), 3.) or 4.) has happened ?**

For the Patent Office to know if 1.) has happened the Patent Examiner can do a search of the Patent Office's data base and can do searches of the data bases of other country's patent offices. How good a search the Patent Examiner does, and how many different countries' patent office data bases the Examiner searches depends on the ability of the examiner and on how much time she is willing to put into doing the search(es).

For the Patent Office to know if 2.) or 3.) has happened; again, the Patent Examiner would have to look for publications and read through them and check on the Internet and in social media. In my experience some Patent Examiners do very little of checking into whether 2.) or 3.) has happened, other Patent Examiners do some checking into whether 2.) or 3.) has occurred. Before you file your patent application there is no way to know which Patent Examiner will be assigned to your patent application.

For the Patent Office to know if 4.) has happened, it would have had to be done in such a hugely public way that it came to the Patent Examiner's attention, or someone would have had to tell the Patent Examiner that it happened.

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**If you are not sure if I), II) or III) of paragraph 1 of page 1 has happened should you still file a patent application ?**

In all cases that I know of, when I), II) or III) had occurred and a patent application was still filed, the worst that happened was that the person did not get a patent. However, as explained in my paper: "*The Patent Application Process*", there are many other reasons why a person might file a patent application and not get a patent.

However, there are situations in which the person did not know that I), II) or III) had happened, so they filed a patent application; but in fact one of I), II) or III) had happened, however, it did not come to the Patent Examiner's attention that I), II) or III) had happened, and therefore the happening of I), II) or III) did not prevent that person from obtaining a patent. If that happens, and after the person has their patent it is discovered that I), II) or III) had happened, the person does not lose their patent unless someone sues that person to have a court declare their patent to be invalid, which sometimes happens and sometimes does not happen (in which case the person still has a valid patent, even though the patent should never have been granted).

The bottom line is that a patent application is just that, an application, it is not a guarantee that you will get a patent. But, if you have an invention that you feel is valuable, the only way to protect it is with a patent, therefore, if you want to protect your invention, you apply for a patent and take your chances. As explained in my paper: "*The Patent Application Process*", the preliminary patent search, sometimes called a patentability search, will give you a very good idea of the odds of your patent application succeeding and a patent being granted to you.