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Patents Rights – Avoiding a Collision with the Social Media Iceberg

by Robert Gunderman, PE and John Hammond, PE

Social Media and Intellectual Property - The Iceberg and More

As our world becomes ever more connected, and opinions, ideas, and thoughts are exchanged freely through the rapidly increasing use of social media, websites, forums, and blogs, there are a myriad of legal risks and issues that quickly surface. New social media legal issues are constantly arising with regard to copyrights, trademarks, trade secrets, patents, defamation, privacy, negligence… the list goes on and on.

"If you have an invention that you intend to patent, but have not yet filed a patent application on it, one of the worst things that you can do is to start any online discussion of your invention using social media. "

In this article, we will touch on several issues related to patents and social media. When we talk about "social media", we are including not only the widely used Facebook, Twittter, and LinkedIn media, but also any technical and professional discussion groups, forums, blogs, boards, and similar networking and crowdfunding sites. As this is a large topic that is growing larger by the week, this article is non-comprehensive at best, but should at least create an awareness that there are many issues with using social media that impact your company's patent strategy, future patent plans, and existing patent position.

The Implications of Social Media on Patentability

While there are literally thousands of social media patents and pending applications, we will save that topic for another day. Instead, we will look at how social media can impact the patentability of your inventions. To be patentable, an invention must be patent eligible, useful, novel, non-obvious, and be adequately described in a patent application.

Let's look at how discussing your invention on social media may impact its patentability through the application of the novelty standard. Novelty - is the invention new, or is there prior art? This question has vast implications in the world of social media and the internet, particularly with the change to a "first inventor to file" system in the U.S., and the expanded definition of what is considered to be prior art under the America Invents Act (AIA)[1]. Under this new law, if the "claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention," that is considered prior art and obtaining a patent is not possible.

So with the ease at which communications and disclosure can occur in social, professional and technical networking sites, the probability that someone describes the invention that you consider to be yours can be rather high. Often a discussion among members of an online forum can catalyze the creation and posting of the invention that would otherwise not occur. So if you engage in online discussions that get close to what you consider to be your invention, be careful because someone else may have already been thinking of the idea and may be prompted to write about it, and there is nothing you can do to stop it once it starts.

The deluge of information that rushes in to each of us on a daily basis attests to the fact that most often, quantity prevails over quality. Posts on technical forums, social media sites, professional networking sites, emails, text messages, all point to the quantity of communication that occurs each and every day. With this quantity comes the increased risk that someone, either independently, or by being prompted and encouraged by your own posts, will throw their idea out there that will then be built upon and refined by their subsequent posts or the posts of others. In a matter of a few days or less, the community "brainstorming" that you cause by your posting could result in your invention being made and disclosed online by any number of contributors. If that happens, under the new AIA statute, you now likely have a bar to patentability. At the very least, you would have an obligation to disclose the posted information to the Patent Office, followed by a major challenge to overcome that disclosure in prosecution of your patent application. Then the issue might be raised yet again if your patent were ever litigated.

Another danger occurs when you have an existing product that may already be patented and you engage in market research or product feedback. While these activities may be vital to the growth of your product and your business, inviting feedback on your product or invention in any forum where people can "contribute" has inherent risks. No matter how good your invention is, there is always room for improvement. This can create a bar to patentability of valuable improvements if someone posts those improvements, which are then considered prior art. Again, under the new AIA laws, if you have not filed a patent application on those improvements, you are out of luck if someone else invents and discloses them, even if you made the invention before that online disclosure by those who are providing the feedback that you encouraged.

One Year Grace Periods and Public Disclosure

On the topic of public disclosure through social media, there are also two exceptions to the definition of prior art as it relates to public disclosure under the new law. The first is that if the disclosure is made by the inventor or a third party who obtained the subject matter from the inventor, it is not considered prior art. The second exception is if the disclosure is made by a third party before the filing of a patent application by the inventor, but the third party's disclosure is preceded by a disclosure by the inventor, then it is also not considered prior art. If any of these disclosures, however, are made more than one year before the filing of a patent application, then they are also considered prior art.[2] This provision of the new law is commonly referred to as the "one year personal grace period."

Social Media Collaboration and Inventorship

Obtaining valuable market research information through the use of discussion groups, forums, blogs, and the various other social media tools available comes at a price. It is very difficult if not impossible to control or contain the type of information that is forthcoming from social media posts. If that information relates to ideas for product improvements or new products, not only could that information now be considered prior art, barring you from patenting it as described above (even if you invented it first), but the poster/inventor of that valuable improvement would likely be an individual on a blog that has no connection to your company whatsoever. Now you have a mess.

Of course things can get even worse. Since the United States now operates on a "first inventor to file system," that individual may also file a patent application with no connection to your company whatsoever. By conducting market research and product research online, you may also tip off your competitors to what your plans are, and they may well race you to the Patent Office. If they are even a little faster than you are, they could receive a patent on something important to your business and block you from making, using, or selling that invention. And perhaps they would never have bothered even filing that patent application were it not for your errant posts tipping them off to your plans.

Foreign Patents and Absolute Novelty

In most countries, if you publicly disclose your invention before you file a patent application on that invention, you are not able to obtain a patent on that invention. This is known as the "absolute novelty" standard. In contrast to the U.S., there is no one year personal grace period in most foreign countries. So if you plan to file patent applications in foreign countries, or are not sure, don't rely on the one year personal grace period. Any disclosure, post, tweet, blog entry, email, text message, or shared image could be considered a public disclosure and a bar to patentability in almost all foreign countries.

Enablement - What Determines If Your Posting is a Disclosure

So what determines if your posting is in fact a public disclosure? Like most complex topics, it is not always a simple binary answer. The publication must be sufficiently enabling so that the invention itself can be ascertained (made or used by one skilled in the art). So perhaps the statement "I have an idea for making a better mousetrap" is not a disclosure, but the statement "my better mousetrap uses glue" is in fact a disclosure. This is an overly simple example, and most inventions are not this simple (although they can be). Remember that what is considered a public disclosure may first be determined not by you, the inventor, but by a patent examiner during prosecution of your application. Subsequently, the determination may ultimately be made by a judge, duly persuaded by an attorney who is well versed in the law and skilled in arguing against your position.

The Bottom Line

In summary, if you have an invention that you intend to patent, but have not yet filed a patent application on it, one of the worst things that you can do is to start any online discussion of your invention using social media. Usually there is very little upside to posting, and a great deal of downside. Of course, if you are an anti-patent zealot, you may think that all of this is nonsense anyhow and that ideas are communal property meant to be shared by all. We are not trying to change your thinking and sell you on the virtues of the patent system. Just remember the history of political systems founded on the belief in communal property.

The Future

No one knows for sure where the Internet and social media are heading. Will knowledge become a giant amorphous blob with no boundaries or ownership? Or will knowledge, like any other property right, continue to have boundaries and ownership lines drawn up with the inevitable disputes along the way? We can only hope the latter prevails in the true spirit of independence and self-sufficiency that made this country great. While the risk of public disclosure of your invention on social media represents a risk to obtaining a patent in most foreign countries and starts the one year clock ticking in the U.S., there are other threats to disclosing your invention on social media. Others can beat you to the Patent Office, spurred on by your posts. Or others can post and create prior art that did not exist before, again preventing you from patenting your invention. Further, others can become inventors on valuable improvements to your invention, catalyzed by your original posts related to your invention. While keeping an invention under wraps forever will certainly guarantee lack of commercial success, a careful approach to disclosure and a cautious, well advised, best practices approach to the use of social media is certainly warranted. The perils of disclosure are many, and with most good inventions, they will be copied, modified, improved upon, and fought over. How you use social media now may have profound implications on your intellectual property and the future of your product or company.

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1. See "The Limited Monopoly™" March 2013.
2. See also "The Limited Monopoly™" March 2013.

Authors Robert D. Gunderman P.E. (Patent Technologies, LLC www.patentechnologies.com) and John M. Hammond P.E. (Patent Innovations, LLC www.patent-innovations.com are both registered patent agents and licensed professional engineers. They offer several courses that qualify for PDH credits. More information can be found at www.patenteducation.com.

Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice. No client relationship with the authors is in any way established by this article.

PHOTO CREDIT: Robert Gunderman. Icebergs on Lake Ontario Shoreline. February 2014