

## When and How to Publish Technical Disclosures as Prior Art

Should you file a patent application or keep your innovation a trade secret? This question is routinely asked by key decision makers, such as inventors, managers, and legal counsel, when evaluating a new invention. While either choice comes with its own set of advantages and trade-offs, an often ignored third option also exists: publishing a technical disclosure of your innovation on a publicly searchable database. Publishing the disclosure prohibits patent protection or trade secret protection by third parties because the public disclosure serves as prior art to future patent applications. If you decide not to file a patent application, the following considerations can help you decide whether to publish your disclosure: (1) will the innovation be in a product (but not readily understandable), (2) is the innovation a minor change or modest improvement over earlier, patented technology, or (3) is the innovation outside of the company's business? If you answered "yes" (or "most likely yes") to any of these questions, then you should consider publishing your disclosure.

For best results, you must publish the disclosure so that it is easily searchable and accessible by patent examiners. We include here a list of options that will increase the chances that U.S. patent examiners will find your disclosure so that your disclosure can be cited as prior art in the rejections of U.S. patent applications. Any one of these options can accomplish your goal. Some will likely take significant effort, and some can be expensive; thus, the list below is in the order of benefits compared to costs.

### Upload to Prior Art Archive

MIT Media Lab, Cisco, Google, and the USPTO recently launched the [Prior Art Archive](#) for searching and hosting patent prior art. The tool is active, offers a public upload capability, and purportedly utilizes artificial intelligence and machine learning technology to improve searching. According to the website, disclosures may be uploaded for free into the archive, and they will also be available to the broader public through sites such as Google Patents. The Prior Art Archive recommends including the following [metadata elements](#) where possible: title, description, creation date, publication date, modification date, and copyright.

### Ensure Search Engine Indexing

Examiners typically use search engines like Google and Bing to search for prior art. Web pages associated with your innovation and links to disclosure documents must be indexed by search engines in order for search results to include them. You should ensure that the web pages that contain your disclosure comply with, e.g. [Google's requirements](#) so that the content is indexed. Web sites can be optimized for indexing. Your webmaster should be able to assist in ensuring that your web pages comply with [Google's recommendations](#). You can [submit a web address](#) to Google for indexing. If you make changes to your web pages or want to verify that they are being indexed, you can use the [Google Search Console](#) to confirm that Google can access your content.

By ensuring that the web pages associated with your technical disclosure are indexed by search engines, you increase their visibility on the Internet generally and increase the likelihood that a patent examiner will find them and cite them as prior art. Further, if you have copies of your specification on your website in other languages, such as Chinese, Japanese, and Korean (even if they are machine translations), then they are likely to be accessed by patent examiners in China, Japan, and Korea.

While this is a fairly easy option, you need to be aware that search engines may not be able to index your documents because of the following issues:

- Documents are locked behind a membership login: since search engine bots are not a logged-in member, it will not be able to crawl those pages or files.
- Documents contain redirects: an example would be if your document contains a link that redirects to a "Terms of Use" page that a user has to agree to before the browser will give the user access to the document. Once the user agrees, the user does not see this page anymore, but the search engine bot will not get that far because it is not going to click that "Agree" button. Also, Google has a policy against indexing URLs that redirect because redirects are frequently attempted by hackers to hijack a click. As a result, Google will not crawl and index your document.

### Partner With a Commercial Databases

The USPTO uses a wide variety of patent databases and commercial databases to search for prior art. These include U.S. patent publications, U.S. patents, and the publications of numerous foreign countries, including all major industrial countries as well as the World Intellectual Property Organization (WIPO). The USPTO also uses numerous commercial databases, including ProQuest (<https://www.proquest.com/>) and EBSCO (<https://www.ebsco.com/>). For a full list, see <https://www.uspto.gov/learning-and-resources/support-centers/scientific-and-technical-information-center-stic/electronic>. It appears that publishers, which would presumably include a publisher of a technical specification can partner with these companies. By partnering with a database provider whose database is licensed to (and searched by) the USPTO, you would make your disclosures accessible to patent examiners and included in their searches for prior art.

### Author a Review Article

An academic paper, such as a review paper, could be written about your innovation and related technology. The paper could include thorough citations for your innovation and the related technology. If you publish the paper in an academic journal such as an Institute for Electrical and Electronic Engineers (IEEE) journal, the paper would be available to patent examiners when doing prior art searches. You could also publish a scholarly/scientific article using ArXiv.org from Cornell University (<https://arxiv.org/help/submit>).

### Upload to Google Scholar

An academic paper could also be uploaded into Google Scholar, which many patent examiners use when searching for prior art. [Google Scholar](#) appears to be limited to academic-type papers. In addition to a review paper, if your disclosure can be turned into an academic-type paper, it could be uploaded into Google Scholar. You can use the following resources to post papers that can be found in a Google Scholar search: [ResearchGate](#) and [Social Science Research Network \(SSRN\)](#). ResearchGate allows academic, corporate, and government researchers to post their research and communicate with other researchers and is free to join. SSRN is a collection of more than 800,000 research papers, and it too is free.

### Use a Defensive Publishing Services

Commercial defensive publishing services publish patent disclosures to prevent others from patenting subject matter in the disclosures. These companies claim to then distribute the publications to various patent offices throughout the world. Companies include [IP.com](#) and [Research Disclosure](#). The services provided by these companies may be expensive.

### File a U.S. Patent Application

You could file a patent application describing your innovation and simply let the application go abandoned for failure to prosecute it. The application would publish as a patent application, and it would therefore automatically be entered into the primary database that patent examiners search. This is likely the most expensive option (about \$1,500 per application) but may be the most useful at the U.S. Patent Office.

In conclusion, although none of the options above guarantees that patent examiners will cite your disclosure as prior art in rejections, the more exposure you have in the databases used by patent examiners, the better. At a minimum, we recommend uploading your disclosure to the Prior Art Archive as well as ensuring that search engines are indexing your web pages and content. This will ensure some exposure. After that, you may want to investigate the commercial database providers to see whether you can partner with them. If you do want to include your disclosures/specifications in commercial databases, please contact us, because our librarians regularly work with representatives from these companies.

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## Authors



### [Sumedha Ahuja](#)

Partner

[SAhuja@perkinscoie.com](mailto:SAhuja@perkinscoie.com)   [206.359.8081](tel:206.359.8081)



### [Sumedha Ahuja](#)

Partner

[SAhuja@perkinscoie.com](mailto:SAhuja@perkinscoie.com)   [206.359.8081](tel:206.359.8081)

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