

## To Patent, or to Publish, that is the Question!

By Blair Hesp and Jarrod Ward

Following the introduction of Performance-based Research Funding (PBRF), NZ universities are placing an increasing emphasis on the number and quality of publications produced by both academic and research staff. Consequently, researchers are encouraged to publish their results as often, and as quickly, as possible with the potential intellectual property (IP) contained in their discoveries sometimes being overlooked.

### *The implications of public disclosure of results*

When a discovery is made it is important to understand the implications attached to the public disclosure of results. Premature public disclosure in any form will jeopardize the ability to obtain valid patent protection for an invention. Public disclosure not only includes publication in peer-reviewed journals, but also oral and poster presentations. Indeed, student dissertations and theses are also considered to constitute public disclosure.

Dissertations and theses often contain data that is commonly referred to as *unpublished*. However, any such documents are likely to be considered as available to the general public through the respective university's library. Even a single copy of a document that is available for public inspection will be sufficient to constitute public disclosure.

If you plan to disclose your research at a conference in NZ, it is possible to request that the event is gazetted by the Intellectual Property Office of New Zealand (IPONZ)<sup>1</sup>. If an event is gazetted, a six month grace period will be provided for filing a NZ patent application from the date of the event. However, whilst this grace period is available here, it is not universally recognised overseas.

The US, Canada, China, Russia, Australia and Japan have provisions for period of 6 to 12 months grace under certain circumstances, but other jurisdictions do not. Therefore, even if an event has been gazetted in NZ, inconsistencies across jurisdictions mean we do not recommend relying on these grace periods.

<sup>1</sup> Further information and suitable forms may be obtained from the IPONZ website: [http://www.iponz.govt.nz/iponz-docs/G/Gazetting\\_Info\\_Sheet\\_v2.pdf](http://www.iponz.govt.nz/iponz-docs/G/Gazetting_Info_Sheet_v2.pdf)

Thus arises the real dilemma for the academic researcher: how to balance the desire to patent an invention against the imperative of publishing results.

### *So when can my results be published?*

There is a very simple answer to this question: as soon as you have determined whether or not patent protection for the invention is possible and/or warranted and if necessary, a patent application could be filed. Once a patent application has been filed, the public disclosure of your results will not impact on your ability to obtain patent protection in NZ or overseas.

Patenting and publishing do not have to be mutually exclusive activities. Key things to remember are:

- do not disclose the invention until any potential IP has been identified ;
- if disclosure is unavoidable, ensure it occurs at a gazetted event; and
- there are no restrictions on disclosure once a patent application has been filed.

One final point – lest it seem that even dreaming about an invention could constitute a public disclosure – remember that in order to impact patentability, the disclosure must contain a description of the invention. This must be detailed enough to enable a person skilled in that particular area of technology to understand and practise the invention.

If you are concerned about the effect of publication on your potential IP rights, we suggest consulting an IP specialist.

A reminder: if you have any queries regarding patents, or indeed any form of intellectual property, please direct them to:

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Blair Hesp and Jarrod Ward of Baldwins specialise in chemistry and biotechnology patents. Blair joined Baldwins in 2006, and has a PhD in pharmacology from the University of Otago as well as a NZDipBus with a management focus. Jarrod joined Baldwins in 2007, and has completed the requirements for his PhD in chemistry at the University of Auckland. Blair and Jarrod are currently studying towards law degrees and registration as patent attorneys.

