

Intellectual Asset Management

International reports



Early academic disclosure adversely affects patent prosecution

[Formosa Transnational - Taiwan](#)

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Early disclosures of Taiwanese academic work have increasingly been cited as references for rejecting the associated patent applications. Most of these early publications were published in accordance with the regulations of universities or funding councils. Some inventors do not even realise that their inventions were disclosed.

Postgraduate theses are deemed to be the main source of early disclosures of academic work. According to the Degree Conferral Law, postgraduates are asked to hand in at least two copies of their theses to the university library, which submits one copy to the National Central Library. Since government policy encourages researchers to publish their academic work, the libraries put the theses on the shelves and publish them online when they are received. If the theses are involved in patent applications, the postgraduates must request the university library and National Central Library separately not to put their theses on the shelves. In addition, they must specifically request the libraries not to publish the theses online. In several universities abstracts of the theses are published regardless of whether the substantive content of the theses will be published. Hence, postgraduates and their advisers must be careful about the information disclosed in the abstracts. A few years ago the Taiwanese Intellectual Property Office (TIPO) started to pay attention to the abstract issue. After communicating with the Ministry of Education, postgraduates were allowed the right to abstain from publishing the abstracts of their theses online, but they had to go to the libraries personally and specifically request this.

In addition to the publication of theses, the regulations of the National Science Council (NSC), one of the main funding councils of the Taiwanese government for academic research, may force researchers to publish their work prematurely. When a researcher works for a project funded by the NSC, he or she must submit at least one so-called "mid-term report" before the end of the project. The mid-term report records data and other information in order to persuade the NSC examiners to keep funding the project. If the project is involved in a patent application, the researchers can request that the mid-term report not be published until one or two years after it is submitted. Since the mid-term report is submitted in the middle of the project, it is possible that the report may be published before the filing date of the associated patent application. Therefore, the early disclosure of NSC projects also adversely affects the patent prosecution.

What can be done if an invention is premature, but early disclosure is inevitable? When an invention is disclosed early, domestic priority may be helpful in several countries, such as Taiwan and Japan. This will give the applicant one year to complete his or her experiments and prepare the specification and drawings for filing a regular patent application. The US provisional application, which is similar to domestic priority, may also help. However, in China and the European Union, the provisions of the grace period are relatively strict and early disclosure will kill the associated patent applications.

Researchers and corporations which work with researchers should understand the disadvantages caused by the early disclosure of academic research, and consider their patent strategy at an earlier stage. In addition, the TIPO must be aware of the conflict between patents and academic policy, and should help inventors to find a way out of the dilemma.

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