

How to Prevent Grant Proposals from Barring Patent Protection

Grant proposals are the life-blood of the University's research laboratories. However, faculty should be aware that an invention is not patentable in the US if it has been described in a printed publication more than 1 year prior to filing a U.S. patent application and foreign filing rights are lost immediately.

In *DuPont v Cetus*, a federal court held that a NSF grant proposal constituted a publication because it was sufficiently accessible to interested persons. The grant was considered accessible because it had been indexed and could be obtained through a request under the Freedom of Information Act (FOIA). Since it was indexed more than one year prior to filing a patent application, it constituted a patent bar. (One should leave confidential information out of the abstract because I believe they get published as part of the indexing.)

To prevent a bar, and comply with the regulations and exceptions of the FOIA, each individual page should be marked "Confidential" and a legend affixed to the front page that states:

"Confidential. This document, or portions of it, contains confidential information that is, or may become the subject of a United States patent application and is important to future commercial efforts based on such confidential information. Accordingly, this document and confidential information contained herein are exempt from disclosure under the Freedom of Information Act, Sections 552(b)(3) and (b)(4) of Title 5 of the United States Code and corresponding regulations of United States government agencies."

In addition, a cover letter should accompany each grant proposal submitted to an agency of the federal government. The letter should provide a rationale for keeping the proposal confidential and request that the University be notified of all requests the agency receives of the proposal under FOIA. For example, see sample letter below:

Dear _____,

The accompanying grant proposal contains confidential information that is, or may become, the subject of a United States patent application and is important to future commercial efforts based on such confidential information. Disclosure of this document and the information that it contains may cause substantial harm to such commercial efforts. Accordingly, this document and the confidential information contained herein are exempt from disclosure under the Freedom of Information Act, Sections 552(b)(3) and (b)(4) of Title 5 of the United States Code and corresponding regulations of [agency, e.g., NSF, NIH]. If any person or entity should request a copy of this document or any portions of it, Louisiana Tech University and [Applicant, e.g., Michael McShane] ask that such requests be provided to [Applicant] and the Director of Intellectual Property and Commercialization, as provided in Executive Order No. 12600.

Thank you for your consideration.

Sincerely,

Courtney Hilton, Director University Research

The Dept of HHS specifically requires that any requests for grant applications submitted under the Freedom of Information Act be reviewed by the PI before release, affording an opportunity for deletion of confidential information. Including the following disclaimer at the top of the specific aims section of a grant application will help ensure that proprietary rights are maintained:

“The following information is proprietary and confidential and may not be released without the prior written approval of the principal investigator.”