Keeping a federal grant application confidential for patent law purposes

There is a procedure by which any federal grant application may be kept confidential for patent law purposes. Unfortunately, it is not straightforward: it requires each page to be stamped "Confidential" and an appropriate warning to be affixed to the front of the proposal. The details are provided here: http://www.siu.edu/worda/tech/patent_resources/prevent.html. This also contains the description of the DuPont v. Cetus case.

The method of labeling the proposal with "This document contains confidential non-patented information" is a good start, but probably not sufficient if tested in court. Instead, the following language should appear on the first page of the proposal:

**CONFIDENTIAL**

This document, or portions of it, contains confidential information that is or may become the subject of a United States patent application and that is important to future commercial efforts based on such confidential information. Accordingly, this document and the confidential information is 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.

Of course, this only becomes an issue if the grant proposal actually contains an "enabling disclosure;" i.e. sufficient information to allow someone to practice your invention. Ordinarily proposals look forward to discoveries, not backwards at inventions already made.

Also note that this safeguard only applies to proposal filed with federal government agencies (which are subject to being required to produce copies of grant applications under the Freedom of Information Act, FOIA).

One does not need to do this if the granting agency were, for instance, a private firm (in which case a confidentiality agreement should be used).

A different, but similar procedure should be followed if the granting agency is the State of Ohio (which has a state equivalent of FOIA, called the "Ohio Open Records Act.")

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