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A Typology of Disclosure

Sharon K. Sandeen

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A TYPOLOGY OF DISCLOSURE

*Sharon K. Sandeen**

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ABSTRACT

Information and data have always been valuable to businesses, but in the Information Age, as businesses have figured out more ways to commoditize the information and data they possess, there has been a corresponding increase in expressed concerns about the unauthorized “disclosure” of information. Often, these concerns are expressed in absolute terms, as if any unauthorized disclosure of information

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constitutes an act of unfair competition or theft. The problem is that the common understanding of disclosure, particularly among information owners that seek to restrict access to the information they possess, belies the legal meaning of the term as used in various contexts.

Sometimes, but not as often as information owners/possessors assert, the disclosure of information will result in the loss of associated rights in the information, but other times it will not. This can happen, for instance, when no legal rights attach to a specified body of information, or when any rights that do attach (like copyrights) continue to exist even if there is a disclosure of the information.

Because different areas of information law have developed different meanings of the term disclosure (and related terms, like “publication”), it is important for scholars, courts, and litigants to understand those meanings and use them properly. Otherwise, there is a risk that claims of wrongful disclosure of information will unduly influence policymakers and judges to favor the claims of information owners/possessors over those who are entitled to access and use the subject information. In other words, the limitations that exist on the scope of various information rights should not be overshadowed by the rhetoric of loss and theft when no such loss or theft is possible.

This article begins by first illustrating the different ways that the term “disclosure” is used in law, using trade secret law, patent law, and copyright law as case studies. It concludes by setting forth a typology of disclosure that should be used to explain the legal consequences of acts of disclosure for various types of information. Only Type-L disclosures (those that result in the loss of associated information rights) fit the rhetoric of information owners/possessors.

I. INTRODUCTION

The discourse surrounding information and data,¹ and claimed rights therein, is often expressed as a binary choice between confidentiality or secrecy on one hand and disclosure or publication (and the loss of associated rights) on the other. Typically, the owners/holders of confidential information assert that their rights and interests will be destroyed if “their” information is disclosed and accordingly,² that courts

1. The word “information” is used throughout the remainder of this paper to refer to both information and data, as data is a type of information.

2. Because information is not always considered to be property, and even when it is the person or company that asserts the property rights may not own those rights, it is important not to automatically attribute the status of ownership to information holders. Thus, “owners/holders” is used

should act to protect those rights by preventing any disclosure. In addition, when the information is characterized as property, the actual or threatened act of disclosure is often described as theft or destruction of property. Seen in this light, the word disclosure is a loaded term in information law discourse with rhetorical power that can obscure the real issues in dispute.

The principal reason why the word disclosure is a loaded term is due to its commonly understood meaning, a meaning that is often different from the applicable legal definition. Commonly understood and used, the word disclosure is thought to connote a public revelation of some type or a dedication of the information to the public, but the dictionary and legal definitions of disclosure do not always require such publicness. Indeed, in many situations it is possible for information to be disclosed to another, including government officials, without the information becoming public. Thus, in many areas of information law³ the applicable definitions of disclosure (or publication) are inconsistent with a binary choice between legal protection or loss of rights; rather, there is a middle ground. In fact, the word disclosure is frequently used in different senses within one area of law.

Within different fields of information law, the word disclosure may be a term of art with a meaning that does not comport with any dictionary definitions or the meaning commonly ascribed to it by information owners/holders. Understanding the meaning of disclosure in information law is further complicated by the fact that, although litigants and courts frequently characterize various acts as disclosures, often the subject statutes do not use that word. For instance, in copyright law it is more common to use the word publication.⁴ Similar words might also be used, including “shared,” “sharing,” and “transferred.” Making matters worse, the word disclosure is not always defined by statutes that use it and there are multiple dictionary meanings of the word that are used in different contexts.

Because of the different uses, meanings, and legal effects of both the word disclosure and the effects of an act of disclosure throughout

throughout this article to acknowledge this critical factual issue. In many cases, mere holders of information do not have any standing to complain about the actual or threatened loss of the information.

3. As used herein, “information law” concerns the laws that govern how information (broadly defined) is created, collected, organized, protected, secured, accessed, shared, transmitted used, and discarded by businesses and governments. It also concerns related public policy issues that should inform policymaking, primarily the public interests in information access, diffusion, and transparency and each of our individual interests in information privacy. *See* SHARON K. SANDEEN & DAVID S. LEVINE, *INFO. LAW, GOVERNANCE, AND CYBERSECURITY*, 39 (West Academic 2019).

4. *See infra*, Part III.

information law, it is important for all—but particularly those who own or hold information, their lawyers, and the judges who consider information-related cases—to exercise care when talking about information disclosure. At least five questions should be answered: (1) What is the claimed act of disclosure and does it involve an element of publicness?; (2) What is the information that is (or will be) subject to the act of disclosure?; (3) Is the information factually confidential or secret?; (4) What is the applicable common law or statutory meaning of disclosure, if any?; and (5) If an act of disclosure occurs as defined, what is the legal effect of that act? Importantly, if the information is not confidential or secret then questions (4) and (5) need not be answered because the general rule is that information once revealed to the public is free for anyone to use.⁵ Rather, with respect to such information, the relevant question is whether the publicly disclosed information is protected under law—for instance, patent or copyright law—such that its use is limited.

Given the breadth of information law, it is not possible in this relatively short article to answer each of the questions posed above with respect to all the areas of law where disclosure is discussed. Nor is it possible to engage in an in-depth analysis of the jurisprudence of disclosure in the areas of law that are discussed. Rather, the purpose of this article is to illustrate how concepts of disclosure are used and defined in different information law settings in order to highlight the need for the proposed typology of disclosure. Importantly, it will show that concepts of disclosure in information law are sometimes narrower or broader than the prevalent meaning ascribed to the word by information owners/holders. It also explains why it is important to understand and properly apply the different meanings of disclosure.

Understanding the different meanings of disclosure used in information law is important for the simple reason that not all information is protected by law. Thus, concerns regarding the loss of information rights due to acts of disclosure should never arise with respect to information for which protection is unavailable or nonexistent. For instance, this can occur when an information owner/holder claims rights

5. *Wheaton v. Peters*, 33 U.S. 591, 624 (1834) (“An individual who thus mingles what cannot be exclusively enjoyed, with what can, does, upon familiar principles, rather forfeit the power over his own peculiar work, than throw the chain around that which is of itself as free as air.”); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 149 (1989) (“Once an inventor has decided to lift the veil of secrecy from his work, he must choose the protection of a federal patent or the dedication of his idea to the public at large.”).

in information that is: (1) not factually confidential or secret;⁶ (2) is in the public domain; or (3) constitutes prior art. However, if some information rights attach to a given body of information, there are four principal senses in which the word disclosure is used in information law cases.

First, the word disclosure is often used to describe an action that results in the loss of applicable legal protections in the subject information. This is how plaintiffs in trade secret cases, litigants seeking a protective order, and companies opposing freedom of information requests typically describe the consequences of them sharing information with another. But in some areas of information law, the disclosure of information does not result in the loss of related information rights. For instance, although there are various legal consequences associated with the publication of copyright-protected works,⁷ the copyrights in published works are not destroyed as a result of the disclosure of the work.⁸ There may be other reasons to treat such information as confidential or subject to a protective order, but it wouldn't be because of a loss of rights due to the disclosure of the copyright-protected content. Even under trade secret law, it is possible for information to be shared with another person or wrongfully acquired without a loss of trade secret rights, for instance, when it is shared (some would say “disclosed”) pursuant to a duty of confidentiality.

Second, the word disclosure is often used to describe actions that result in the public dissemination of information. However, as just noted,

6. As explained more fully in Part III, even confidential and secret information may not be protected by law unless it meets the other two requirements of trade secrecy. That is because the Uniform Trade Secrets Act (UTSA), applicable in nearly all U.S. states, precludes any other tort or equitable claims related to confidential or secret information except a trade secret or breach of contract claim. *See* Uniform Trade Secrets Act § 7, 18 U.S.C. § 1838 (2018) [hereinafter the UTSA]. Although primarily used in discussions of copyright law, the classic definition of “the public domain” is information that is unprotected by intellectual property (IP) law. *See, e.g.,* Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 *Law & Contemporary Probs.* 147, 149 (2003) (defining the public domain as “a sphere in which contents are free from intellectual property rights”). This could include information that can never be protected by a form of IP (*see, e.g.,* *Georgia v. Public.Resource.Org, Inc.*, 140 S. Ct. 1498, 1501 (2020) (discussing the government edicts doctrine which holds that certain works are ineligible for copyright protection) or information for which applicable protections have ended (*see, e.g.,* *Kimble v. Marvel Entm't, LLC*, 576 U.S. 446, 446 (2015), referring to a “post-expiration . . . public domain.”). However, as further explained below, just because information enters the public domain doesn't necessarily mean that it has been publicly disclosed. *See infra* note 14.

7. *See* Deborah Gerhardt, *Copyright at the Museum: Using the Publication Doctrine to Free Art and History*, 61 *J. COPYRIGHT SOC'Y OF THE U.S.* 393–451 (2014); Deborah Gerhardt, *Copyright Publication: An Empirical Study*, 87 *Notre Dame L. Rev.* 135 (2011).

8. As explained in Part III, C, before March 1, 1989 in the U.S., publication of a copyright protected work without a proper copyright notice resulted in a loss of copyrights, but the act of publication was typically at the behest of the copyright owner.

whether these actions result in the loss of associated information rights depends upon the type of information rights, if any, that attach to the subject information. The public dissemination of information will destroy trade secret rights, confidentiality, and some privacy interests, but these are not always the types of behaviors that are at issue in information law cases. Some rights in information, principally patent rights and copyrights, continue to exist despite the public dissemination of the information and depending upon the nature and scope of the dissemination. Conversely, some rights in information cease to exist even if the information is not “publicly” disseminated, for instance when inventors commercialize their secret inventions without timely filing for a patent⁹ and when copyrights expire for unpublished works.¹⁰ In these situations, rights in information can be lost even if the information is not publicly disclosed.

Third, the acts of disclosures that are at issue in information law cases often involve the sharing of information between the information owner/holder and another that does not result in the public dissemination of the information or, in trade secret parlance, that does not make the information “generally known” among the public or within an industry. Once again, whether the information that is shared continues to enjoy the legal protections that attach to it, if any, depends upon the type of information involved and whether it was shared in the context of a relationship that gives rise to a duty of confidentiality. If the information was protected by copyright or patent rights, the fact that the information was shared will not adversely affect those rights. The sharing of confidential information without first establishing a duty of confidentiality, however, can undermine trade secret protection, privacy rights, and the ability to claim that the information is confidential. Relatedly, when we say that information “enters the public domain”¹¹ or

9. See the “forfeiture doctrine” of *Metallizing Engineering Co. v. Kenyon Bearing & AP Co.*, 153 F.2d 516 (2d Cir. 1946) and *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S. Ct. 628 (2019).

10. As explained in Part III, C before the effective date of the 1976 Copyright Act on January 1, 1978, copyrights in the U.S. were acquired by either publication or registration of the work, but in both cases, the works were disclosed in the sense that they became available to the public. Since January 1, 1978, unpublished original works of authorship that are fixed in tangible form are automatically protected by U.S. copyright law for the prescribed term. At the end of such term, they technically enter the public domain in the sense that they are no longer protected by copyright law, but there is no requirement that they be publicly disclosed.

11. Like the word “disclosure,” the term “public domain” is often misused to refer to information that is publicly disclosed, but this is not its common technical meaning. Also, although primarily used in copyright law, conceptually it has a broader application. It is frequently referred to as “the body of ideas and works that are not subject to intellectual property protection.” Tyler T.

“becomes prior art,” it does not necessarily mean that the information has been publicly disclosed. Under both patent and copyright law, information may cease being protected even if it is not publicly disclosed.¹²

Fourth, sometimes the word disclosure is used when the more apt word would be “transferred.” In these situations, the word disclosed is used to describe the transfer of information from one location to another, for instance, when it is stored on the computer server of a company that provides cloud storage solutions or in boxes in a climate-controlled warehouse.¹³ In these cases, the information is technically available to be accessed by the storage providers and, in that sense, the information has been shared with them. But, if the storage providers do not access and read the information, the information arguably has not been disclosed in a manner that allows for human (or even machine) cognition. Also, this shared information typically is not disclosed to the public.

There are obvious policy choices involved in whether and how various acts of disclosure waive applicable legal rights in the subject information, with the third-party doctrine of Fourth Amendment jurisprudence under U.S. law being an obvious example.¹⁴ This article does not address those policy choices. Rather, taking the law and policy choices as they currently are, it advocates for greater clarity concerning the types and ranges of disclosures that are at issue in information law cases. Clearly, not all acts of disclosure are treated as a loss of rights. How then should we label these types of disclosure to differentiate them from disclosures that do result in a loss of rights? And what do we call acts that fall somewhere between the two extremes, allowing for the sharing or transfer of information under conditions that do not result in the loss of applicable information rights? Finally, how should we label information that is not protected by law such that no type of disclosure matters from a legal perspective?

To sort out the different meanings, uses, and effects of information disclosing acts, this article proposes a typology of disclosure that will allow litigants, judges, scholars, and policymakers to more easily differentiate between acts that result in disclosures of information that

Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 217 (2002). See also, Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 L. & CONTEMP. PROBS. 147, 149 (2003) (defining the public domain as “a sphere in which contents are free from intellectual property rights”).

12. See *infra*, Part III.

13. Sharon K. Sandeen, *Lost in the Cloud? Information Flows and the Implications of Cloud Computing for Trade Secret Protection*, 19 VA. J. L. & TECH. 1 (2014).

14. See, e.g., Orin S. Kerr, *The Case for the Third-Party Doctrine*, 107 MICH. L. REV. 561 (2009).

result in the loss of associated rights, and those that do not.¹⁵ As further explained in Part IV, it specifies five different types of disclosure, denominated with letters that correspond with the legal protection, if any, that the information possesses following the corresponding act of disclosure. The five types are: (1) Type-L for acts of disclosure that result in the loss (L) of rights in the subject information; (2) Type-P for acts of disclosure that do not result in a loss of rights because the information remains protected (P) notwithstanding being disclosed; (3) Type-C for information disclosures made to a person or entity who is under a duty of confidentiality (C), therefore not resulting in a loss of rights; (4) Type-T for information that is merely transferred (T) from one physical or digital location to another, but in a way that does not involve the exercise of human cognition by the recipient and holder of the information such that they gain any information or knowledge from the disclosure; and (5) Type-X disclosures that concern acts related to information that, due to the various limitations of information law, is not protected by law. An important proviso is that some information, and particularly compilations of information, may involve multiple types of information and disclosures.

The article begins in Part II with a discussion of the meaning of disclosure from various dictionaries, showing how there are different definitions and how those definitions do not always comport with the common assertions of information owners/holders. Part III discusses the various ways that disclosure (or publication) is used in three different fields of information law: trade secret law, patent law, and copyright law. In Part IV, the proposed typology of disclosure is further explained. Part V provides suggestions for how the typology should be used in practice and, in so doing, demonstrates that information owners/holders should not always fear the disclosure of the information they own or hold. The article concludes with Part VI.

II. THE PROBLEM WITH DICTIONARY DEFINITIONS

The U.S. Supreme Court is apt to emphasize, particularly of late, that in the absence of a definition in the statute itself, words in a statute should

15. This article pays homage to two earlier works: Pamela Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 L. & CONTEMP. PROBS. 147 (2003) and Daniel J. Solove, *A Taxonomy of Privacy*, 154 U. PA. L. REV. 477 (2006). Both articles addressed a common problem in legal discourse and information law; namely, the need to understand and define terms and concepts and use them precisely and consistently. It is only then that a discussion of applicable legal consequences and policy choices are possible.

be given their common meanings and that a dictionary from the time when the statute was enacted is a good source for that meaning.¹⁶ A stated reason for this approach is that when a statute does not define a term it should be assumed that the legislators intended the common meaning, and to attribute a different meaning to the term would amount to judicial lawmaking. But there are several problems with this approach, which even the U.S. Supreme Court has acknowledged. First, when you look up a word in the dictionary it often has several meanings and, thus, how does one know which meaning was intended by the legislators?¹⁷ Moreover, which of many possible dictionaries did the legislators have in mind, since there is no official dictionary of the United States?¹⁸ To answer these questions, the Supreme Court often looks for clues elsewhere, for instance, by reading the word in the context of the entire statute,¹⁹ considering the purpose of the statute,²⁰ or looking (often reluctantly) at legislative history.²¹ The Court might also look to industry-specific dictionaries for meaning, like *Black's Law Dictionary*, even if it is not clear that the legislators were familiar with those specialized dictionaries.²²

Looking up the meaning of “disclosure” illustrates the confusion that dictionary definitions can cause when interpreting a statute that uses the term. According to most dictionaries, the word disclosure connotes some form of revelation, but how much and to whom they really do not say. For instance, the Merriam-Webster dictionary defines disclosure as “an act or instance of disclosing; EXPOSURE” or “something disclosed; REVELATION.”²³ Similarly, according to *Black's Law Dictionary*,

16. Crawford v. Metro. Gov't of Nashville & Davidson Cty., 555 U.S. 271, 276 (2009) (“The term [], being left undefined by the statute, carries its ordinary meaning.”); *Perrin v. United States*, 444 U.S. 37, 42 (1979) (“[U]nless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning . . . at the time Congress enacted the statute”). See also, Mark A. Lemley, *Chief Justice Webster*, 106 IOWA L. REV. 299 (2020) (describing the Supreme Court’s recent turn toward dictionaries to determine the “ordinary meaning” of words in statutes).

17. See, e.g., *MCI Telecommunications Corp. v. Am. Tel. & Tel. Co.*, 512 U.S. 218, 241–42 (1994) (Stevens, J., dissenting) (pointing out that a different definition from one of the same dictionaries used by the majority would allow for a different ruling, stating: “The Court seizes upon a particular sense of the word ‘modify’ at the expense of another, long-established meaning that fully supports the Commission’s position.”).

18. *Id.* at 225–28 (debating which dictionary definitions are applicable to the statute).

19. See *United Sav. Ass’n of Texas v. Timbers of Inwood Forest Assocs., Ltd.*, 484 U.S. 365, 371 (1988).

20. *Id.* at 373–74.

21. See, e.g., *Consumer Prod. Safety Comm’n v. GTE Sylvania, Inc.*, 477 U.S. 102, 110–16 (1980) (using legislative history to refute petitioner’s interpretation of a statute).

22. See, e.g., *MCI Telecommunications Corp.*, 512 U.S. at 225 (1994).

23. *Disclosure*, MERRIAM-WEBSTER (10th ed. 1995).

disclosure is defined as “the act or process of making known something that was previously unknown; a revelation of facts.”²⁴ The word exposure is defined by Merriam-Webster to include “the condition of being presented to view or made known.” Similarly, the word revelation is defined, in one sense, as “the act of revealing to view or making known.”²⁵ But none of these definitions say anything about the relative publicness of the disclosed, exposed, or revealed information.

The Oxford English Dictionary (OED) definition, on the other hand, alludes to the disclosure as making information publicly known, defining disclosure as “the action or fact of disclosing or revealing new or secret information; the action of making something openly known.”²⁶ However, even here there is nothing defining how widely known the disclosure has to be to be “openly known.” Importantly, the OED also notes that disclosure is often used attributively as “designating documents in which a formal or legal statement is made disclosing certain information, or legal processes in which such a declaration is required; as disclosure form, disclosure hearing, disclosure statement, etc.”²⁷ Numerous federal and state statutes and regulations require such disclosures to designated persons or entities, but not always including the general public.

Because none of the foregoing definitions identify to whom the information is disclosed or how broadly it must be revealed, the dictionary definitions of disclosure are largely inconsistent with the views of many information owners/holders that disclosure means making information available to the public when, in fact, only the word disclosure preceded by the adjective “publicly” does. Even then, however, what disclosure means in different areas of information law often differs from both the dictionary definitions of disclosure and the common understanding of publicly disclosed. Sometimes, for important public policy reasons, certain information is treated as disclosed or publicly disclosed even though it is only revealed to a select few or is revealed to no one; in effect, being treated as constructively disclosed to the public even if it was never actually disclosed to the public. These specialized meanings as used in certain fields are what are known as “terms of art” and they are prevalent in law.

The fact that certain fields, including law, frequently use terms of art highlights the importance of specialized dictionaries in some instances

24. *Disclosure*, BLACK’S LAW DICTIONARY (9th ed. 2009).

25. *Exposure*, MERRIAM-WEBSTER (10th ed. 1995); *Revelation*, MERRIAM-WEBSTER (10th ed. 1995).

26. *Disclosure*, OXFORD ENGLISH DICTIONARY (Oxford Univ. Press 2000).

27. *Id.*

and explains why they are sometimes consulted to give meaning to statutory words. However, context matters. For instance, under U.S. patent claim construction jurisprudence, the Federal Circuit rejected reliance on dictionary definitions in favor of applicable technical definitions in the patent claims and specifications (intrinsic evidence) or, secondarily, in specialized dictionaries and treatises (extrinsic evidence).²⁸ Similarly, when statutes use terminology that had a common law meaning at the time the statute was enacted, U.S. courts often apply the common law definition of the terms even if they do not comport with applicable dictionary definitions.²⁹ Justice Gorsuch acknowledged as much in the *Argus Leader* decision when he listed “dictionary definitions, early case law, or any other usual source” as possible sources for the meaning of undefined words in a statute.³⁰ Because statutory words often have specialized meanings in a particular field of law, it is important to understand what those meanings are and apply them correctly.

III. THE MANY MEANINGS OF DISCLOSURE IN INFORMATION LAW

There are many areas of law where questions concerning the disclosure of information arise. For instance, every time an individual or business is required to provide information to a governmental entity, information is shared and potentially made available to the public pursuant to freedom of information acts and sunshine laws. When an individual or business initiates a lawsuit, applicable rules of pleading, discovery, and evidence require lots of information to be exchanged between the litigants and filed with the court. The information that businesses require customers and clients to provide raises important concerns about the privacy of the disclosed (or shared) information. While laws and regulations exist that require or enable certain types of information to be kept from public disclosure under specified conditions (for instance, Protective Orders³¹), there are also many laws and legal principles in the U.S. and elsewhere that encourage and facilitate the disclosure of information to the public. U.S. patent law³² and the U.S.

28. 37 C.F.R. § 42.100(b) (2020); *See*, Phillips v. AWH Corp., 415 F.3d 1303, 1322 (Fed. Cir. 2005) (en banc). *See also*, Mark A. Lemley, *Chief Justice Webster*, 106 IOWA L. REV. 299 (2020).

29. United States v. Castleman, 572 U.S. 157, 162 (2014) (“It is a settled principle of interpretation that, absent other indication, ‘Congress intends to incorporate the well-settled meaning of the common-law terms it uses.’”); *See* Community for Creative Non-Violence v. Reid, 490 U.S. 730, 739–740 (1989) (applying the common law definition of “employee”).

30. Food Mktg. Inst. v. Argus Leader Media, 139 S. Ct. 2356, 2363 (2019).

31. *See* FED. R. CIV. P. 26(c).

32. *See infra*, Part III, B.

Freedom of Information Act³³ are two obvious examples. All these laws and regulations constitute what is referred to herein as “information law,” but to illustrate how the word disclosure can be used and defined differently in different legal contexts, this article focuses on the following three areas of information law: trade secret law, patent law, and copyright law.

A. *Trade Secret Law*

Trade secret law in the U.S. was developed at common law but is now largely governed by two statutes which incorporate most of the common law principles: (1) The Uniform Trade Secrets Act (UTSA) which has been adopted by 48 states, and (2) the federal Defend Trade Secrets Act of 2016 (DTSA).³⁴ Both statutes use the word “disclose” in the definition of misappropriation to describe one of three acts that may subject someone to liability for trade secret misappropriation, the other two being “acquisition” and “use.”³⁵ However, nowhere in the UTSA or the DTSA is the word disclose defined. Rather, as the caselaw has developed, disclose for purposes of trade secret misappropriation means an act by the defendant that results in the subject information losing its trade secret protection, and not acts whereby information is shared pursuant to obligations of confidentiality.³⁶ This is because it is the loss of trade secret protection that is one type of harm upon which remedies for trade secret misappropriation can be measured.³⁷

Often in trade secret cases, the meaning of disclose for misappropriation purposes never becomes an issue in the case because the plaintiff cannot prove the existence of a trade secret in the first instance. Unfortunately, this is a situation where the words disclose or disclosure are often used but with varying meanings that do not always comport with dictionary meanings, and where the legal effect of the acts of disclosure vary depending upon the circumstances. Thus, to understand the concept of disclosure in trade secret law, and when it is appropriate to use the word

33. Freedom of Information Act, 5 U.S.C. § 552 (2018).

34. See Sharon K. Sandeen, *The Evolution of Trade Secret Law and Why Courts Commit Error When They Do Not Follow the Uniform Trade Secrets Act*, 33 *HAMLIN L. REV.* 493 (2010); Sharon K. Sandeen & Christopher B. Seaman, *Toward A Federal Jurisprudence of Trade Secret Law*, 32 *BERKELEY TECH. L.J.* 829 (2017).

35. UTSA, *supra* note 6, at § 1(2).

36. UTSA, *supra* note 6, at § 1 cmt. (“Because the trade secret can be destroyed through public knowledge, the unauthorized disclosure of a trade secret is also a misappropriation.”).

37. The other type of potential harm upon which remedies for trade secret misappropriation can be measured relates to the unauthorized use of the trade secrets. UTSA, *supra* note 6, at § 1(2).

disclosure to connote a loss of trade secrecy (a Type-L disclosure), requires an understanding of the definition of a trade secret. Moreover, as will be seen, whether an act is a disclosure that results in a loss of trade secrecy often depends upon who is engaging in those acts: the putative trade secret owner, the misappropriator, or a third party. To differentiate between these circumstances, care must be taken not to use the word disclosure unless a loss of trade secrecy results or to identify and label the type of disclosure that is involved pursuant to the typology that is set forth in this article.

For instance, a plaintiff in a trade secret case, rather than speaking generally about disclosure would say, “I fear a Type-L disclosure that will result in a loss of trade secret rights.” The defendant might respond, “There is no risk of a Type-L disclosure because the subject information is either otherwise protected by law (a Type-P disclosure) or will only be disclosed pursuant to a protective order (a Type-C disclosure).” Or the defendant might challenge the plaintiff’s assertion of trade secrecy and argue that the disclosure of the information would be a Type-X disclosure because the information is not protected by any type of information law.

Under both the UTSA and the DTSA, information is not protected as a trade secret unless it meets three requirements. First, the information cannot be “generally known or readily ascertainable.”³⁸ As is further explained below, this requirement equates most with public perceptions of disclosure, but it alone does not determine trade secrecy. In addition, the subject information must have independent economic value because of its secrecy and be of value to others.³⁹ The information must also be the subject of reasonable efforts to maintain its secrecy.⁴⁰

With regard to the first requirement, trade secret protection is not available for information that has already been made public either by the putative trade secret owner or another (including a misappropriator) such that it becomes “generally known.”⁴¹ Moreover, under longstanding trade secret doctrine, generally known information has a broad definition that includes that which is known to the general public (the common understanding of publicly disclosed), as well as that which is known within discrete industries.⁴² Additionally, while common definitions of

38. UTSA, *supra* note 6, at § 1(4)(i); 18 U.S.C. § 1839(3)(B).

39. *Id.*

40. UTSA, *supra* note 6, at § 1(4)(ii); 18 U.S.C. § 1839(3)(A).

41. *Kewanee Oil. Co. v. Bicron Corp.*, 416 U.S. 470, 479–80 (1974).

42. UTSA, *supra* note 6, at § 1 cmt. (“The language ‘not being generally known to and not being readily ascertainable by proper means by other persons’ does not require that information be generally known to the public for trade secret rights to be lost. If the principal persons who can obtain

disclosure are often equated with public dissemination, the concept that information is not a trade secret if it is “readily ascertainable” does not require broad public dissemination.⁴³ Rather, it recognizes that information may not be generally known by the public or within an industry, but still is effectively disclosed for trade secret purposes if it can be easily found in publicly accessible materials such as scientific journals, books, or on websites. This is true even if no one has actually accessed the information.⁴⁴ Generally, the ease with which information is discoverable (or knowable) is the dividing line between whether information loses its trade secret status immediately upon becoming ascertainable, or whether it only loses its trade secret status when it has actually been found or reversed engineered and thereafter made generally known.⁴⁵

Based on the foregoing, the word disclosure can be used in trade secret litigation in at least four different senses. First, it can determine the consequences of a misappropriator’s actions; namely, whether an act of misappropriation occurred because the defendant disclosed the subject information as prohibited by the UTSA’s and DTSA’s definition of misappropriation. This type of disclosure requires an act that results in the loss of trade secrecy, which means that the information becomes generally known or readily ascertainable because of the misappropriator’s actions.

Second, the word disclosure is often used in trade secret cases to refer to acts that lead to information becoming generally known, which is consistent with the common understanding of disclosure as connoting public dissemination. But as previously noted, disclosure resulting in a loss of trade secrecy can occur even without the widespread dissemination or availability of the alleged trade secrets, so long as the information is generally known within the relevant industry or, if not, is readily ascertainable by the general public or the relevant industry.

economic benefit from information are aware of it, there is no trade secret. A method of casting metal, for example, may be unknown to the general public but readily known within the foundry industry.”).

43. See UTSA, *supra* note 6, at § 1(4)(i), cmt. Some states, most notably California, do not analyze the ascertainability of information as part of plaintiff’s prima facie proof of trade secrecy, but rather, frame the issue as a defense. See CAL. CIV. CODE § 3426.1(d) (Deering 1994). This distinction does not affect the current discussion, however, because it concerns the broader and more abstract issue of what constitutes “disclosed” information under trade secret law.

44. UTSA, *supra* note 6, at § 1 cmt. (“Information is readily ascertainable if it is available in trade journals, reference books, or published materials.”).

45. Weins v. Sporleder, 569 N.W.2d 16, 21 (S.D. 1997) (quoting Computer Care v. Serv. Sys. Enterprises, Inc., 982 F.2d 1063 (7th Cir. 1992)) (“[I]f the information can be readily duplicated without involving considerable time, effort or expense, then it is not secret.”).

Third, disclosure in the trade secret sense can mean that the information has become readily ascertainable, which means something different from generally known but which has the same legal effect as if the information was publicly disclosed. Because this information, by definition, is not generally known, plaintiffs in trade secret cases typically believe it is still a trade secret, not understanding that the information could have been made readily ascertainable by a third party. This might happen, for instance, where the plaintiff keeps information secret, but a third party independently develops the same information and reveals it in their PhD thesis which becomes a part of a library's catalogue of accessible works. Importantly, unlike patent law where the relevant prior art is defined as of a specific date, under trade secret law, the status of information as a trade secret can change at any time as information becomes generally known and readily ascertainable.

Lastly, disclosure in trade secret cases can connote actions by the putative trade secret owner that trigger the requirement to engage in reasonable efforts to keep the information secret, even if the subject information does not become generally known or readily ascertainable. This happens, for instance, when a trade secret owner decides to use its trade secrets in its business or share it with others outside the business. In trying to meet the reasonable efforts requirement, putative trade secret owners will often argue that their information was kept secret and never disclosed. But due to the particularities of the reasonable efforts requirement, how a putative trade secret owner handles its information may result in it not being protected as a trade secret even if the information is never publicly disclosed. That is because secret information is not deemed a trade secret unless reasonable efforts were engaged in to keep it secret. One reason for this rule is the notice function of the reasonable efforts requirement which generally requires efforts that are sufficient to put the recipients and users of trade secret information on notice of applicable confidentiality obligations.

While the acts of a putative trade secret owner often result in disclosure such that the information becomes generally known or readily ascertainable, the public availability of the information is not required when a trade secret owner voluntarily transfers information to a third party without first establishing a duty of confidentiality.⁴⁶ This is due to the

46. *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1002 (1984) (first quoting *Harrington v. Natl. Outdoor Advertising Co.*, 196 S.W.2d 786 (Sup. Ct. Mo. 1946); then quoting *MILGRIM ON TRADE SECRETS* § 1.01[2] (1983)) (“If an individual discloses his trade secret to others who are under no obligation to protect the confidentiality of the information, or otherwise publicly discloses the secret, his property right is extinguished.”).

various functions of the reasonable efforts requirement, including its notice, due process, and legitimacy functions.⁴⁷ A broad definition of disclosure with respect to voluntary, non-accidental owner-initiated acts is also consistent with notions of fairness and judicial efficiency; fairness in giving those who might be found responsible for misappropriating trade secrets advance notice of their obligations and judicial efficiency in not clogging the courts with litigation to protect information that its owner/holder did not take steps to protect. Thus, if such information is misappropriated, there is no trade secret claim even if the information is otherwise secret.

When used in these different senses, the word disclosure can lead to confusion in trade secret cases because the legal meaning of the term is different from the common or dictionary meanings. As noted, a trade secrecy destroying disclosure does not require public disclosure as that term is used in common or dictionary vernacular. Instead, the information will be deemed unprotectable information if: (1) it was generally known, even if only among those in a discrete industry; (2) it is readily ascertainable; (3) it does not have economic value due to its secrecy; or (4) it was not the subject of reasonable efforts to maintain its secrecy. Thus, the information may be confidential in a factual sense, but it is not a qualifying trade secret the disclosure of which we care about in the absence of an enforceable contractual duty of confidence. But then the claim is for breach of contract, not trade secret misappropriation.⁴⁸

Further complicating the meaning of disclosure under trade secret law is the frequent desire of putative trade secret owners not to have acts of misappropriation treated as trade secrecy destroying disclosures. Where trade secrets exist and their wrongful acquisition, disclosure, or use is suspected, trade secret owners should act quickly to prevent any trade secrecy destroying acts of disclosure or use by obtaining appropriate injunctive relief; the goal being to prevent the information from becoming generally known or readily ascertainable. If dissemination of the subject

47. *Rockwell Graphic Sys., Inc. v. DEV Indus.*, 925 F.2d 174, 179 (7th Cir. 1991) (“The remedial significance of such efforts lies in the fact that if the plaintiff has allowed his trade secret to fall into the public domain, he would enjoy a windfall if permitted to recover damages merely because the defendant took the secret from him, rather than from the public domain as it could have done with impunity.” (Internal citations omitted)); *See, e.g., Aries Info. Sys., Inc. v. Pac. Mgmt. Sys. Corp.*, 366 N.W.2d 366, 367 (Minn. Ct. App. 1985) (stating that reasonable efforts of plaintiff technology company including contract terms and proprietary notice clearly establish that defendant employees were aware of trade secret status of contested software development).

48. *UTSA*, *supra* note 6, at § 7 (limiting claims for the misappropriation of competitively significant confidential information to breach of contract and trade secret misappropriation claims).

information by the alleged misappropriator did occur, the question arises whether there was a trade secrecy destroying disclosure.

Many courts have held that the acts of misappropriators do not constitute trade secrecy destroying disclosures unless the trade secrets become generally known or readily ascertainable.⁴⁹ This may be true even if the information was widely shared and used within the misappropriator's company. This approach makes sense from a policy perspective because it provides a window of time in which a trade secret owner can attempt to protect its rights following acts of misappropriation.⁵⁰ Typically, this would include an injunction addressed to all the people known to have possessed or used the trade secret. But it also demonstrates how acts that would be considered trade secrecy destroying disclosures when committed by a putative trade secret owner may not be treated the same way when committed by a misappropriator.

Another form of disclosure which tends not to be treated harshly under trade secret law, but which nonetheless often results in the loss of trade secrecy, concerns accidental disclosures. According to longstanding trade secret doctrine, a trade secret owner who accidentally discloses trade secrets to a third party may be able to avoid the trade secrecy disqualifying effects of their inadvertence if the information did not become generally known or readily ascertainable and they act quickly to prevent further dissemination of the information.⁵¹ Pursuant to the UTSA, the third party possessor of accidentally acquired information may be liable for trade secret misappropriation unless the third party changed its position before receiving notice of the accidental disclosure.⁵² Thus, in situations where notice is timely received by the third party, the accidental disclosure of the information to the third party in a manner that does not make the information generally known or readily ascertainable is not counted as a trade secrecy waiving event.⁵³

Both of the foregoing examples may be labeled Type-C disclosures because although there was an act of disclosure whereby trade secret

49. See, e.g., *Religious Tech. Ctr. v. Netcom On-Line Comm'n Servs., Inc.*, 923 F. Supp. 1231, 1254 (N.D. Cal. 1995).

50. See Elizabeth A. Rowe, *Saving Trade Secret Disclosures on the Internet Through Sequential Preservation*, 42 Wake Forest L. Rev. 1 (2007); 2007 B.C. INTEL. PROP. & TECH F. 091101 (2007) (discussing cases of trade secrets that end up in the hands of third parties who are not the original misappropriators and proposing an analytical framework for preserving such trade secrets in some situations where they have subsequently been disclosed).

51. RESTATEMENT (FIRST) OF TORTS § 758 (1939).

52. UTSA, *supra* note 6, at § 1(2)(ii)(C). See also MILGRIM ON TRADE SECRETS § 7.02[2][b].

53. *Heriot v. Byrne*, 257 F.R.D. 645 (N.D. Ill. 2009) (analyzing effect of inadvertent disclosure made in e-discovery context).

information was disclosed to or shared with someone other than the trade secret owner, the recipients of the information were under a duty not to further disclose that information; in other words, to keep it confidential. In the case of the misappropriation, disclosure is a proscribed wrong under trade secret law. In the case of an accidental disclosure, a duty of confidentiality can be imposed with timely notice.

Sometimes trade secret rights are lost, not due to actions of the putative trade secret owner, but pursuant to the proper actions of others; for instance, if others acquire the trade secrets through reverse engineering or independent development and then disclose them.⁵⁴ This is another situation where trade secret plaintiffs will proclaim that they never disclosed the information, which may be true, but it does not matter. If a third party's acts of reverse engineering and independent development are followed by a disclosure of the resulting information in a manner that makes it generally known or readily ascertainable, then the putative trade secret owner's trade secret rights in the same information cease to exist. A key reason for this rule is that the ability of individuals and companies to engage in reverse engineering and independent development is what differentiates trade secret protection from patent protection, thereby furthering the public disclosure goals of patent law and, in the U.S., preventing trade secret law from being preempted by federal patent law.⁵⁵ It is also consistent with the general goal of promoting the dissemination of information and the flourishing of public knowledge.

B. Patent Law

The U.S. Patent Act uses the word disclosure more than 40 times, but as with the UTSA and the DTSA, it is not defined in the statute.⁵⁶ Also, like trade secret law, U.S. patent law employs different conceptions of disclosure and publicness depending upon the context in which the issue arises and who is doing the disclosing. In nearly all cases where it is used, the word disclosure is used without the adjective "public" and, when read in the context of the statutory provisions where the word appears, its usage is most consistent with a disclosing act that does not necessarily or

54. See MILGRIM, *supra* note 52 (describing the non-liability of the "honest" discoverer).

55. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974).

56. Although there are two versions of the U.S. Patent Act which may apply to issued U.S. patents depending upon whether the corresponding patent applications were filed pre- or post- the effective date of the Leahy-Smith America Invents Act (AIA), this analysis focuses on the AIA version.

immediately make the information public. The provisions of the Patent Act that are known as the Bayh-Dole Act provide one example of this; there, disclosure is used to refer to acts by which a federally-funded inventor discloses (shares) their invention to the federal government, but under circumstances where the information is kept confidential (a Type-C disclosure).⁵⁷ Similarly, under the provisions of the Patent Act dealing with the ability of the federal government to withhold the publication of patents for national security purposes, disclosure is used to refer to the exchange of information between the inventor and the federal government, and not to the dissemination of the information to the public.⁵⁸ Pursuant to 35 U.S.C. § 122, the United States Patent and Trademark Office (USPTO) is required to keep patent applications confidential except as specified, making those that are not published subject to a statutory duty of confidence.

Under the Patent Act, the dissemination of patent information to the public arises in two contexts: (1) the requirements for patentability, particularly 35 U.S.C. § 112, that require patent applicants to disclose specified and detailed information to the USPTO; and (2) the rules governing the publication of issued patents and their related applications.⁵⁹ It is with respect to the publication of issued patents and applications where the information owner's common understanding of the word disclosure as meaning public disclosure applies because once a patent is granted (and in many cases, 18 months after the application is filed), the details of the issued patent (or application) is published in the USPTO's Official Gazette.⁶⁰ Indeed, the grant of a patent requires a *quid pro quo* whereby an inventor must sufficiently disclose the invention before a patent will be granted.⁶¹ This is done in what is known as the specification which "shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same"⁶² According to the USPTO, the written description and

57. See, e.g., 35 U.S.C. § 202 (2012) (using the phrase "disclosure to federal agency").

58. See 35 U.S.C. § 181 (1999).

59. See 35 U.S.C. §§ 102, 112, 122.

60. See 35 U.S.C. § 122 (2012).

61. *Schriber-Schroth Co. v. Cleveland Tr. Co.*, 305 U.S. 47, 57 (1938) (quoting *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 58 (1931)) ("[35 U.S.C. § 112] require[s] the patentee to describe his invention so that others may construct and use it after the expiration of the patent and 'to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.'").

62. See 35 U.S.C. § 112 (2012).

enablement requirements of § 112 are separate and distinct requirements, with the purpose of the enablement requirement being “to ensure that the invention is communicated to the interested public in a meaningful way.”⁶³

When a patent is granted, the publication of the details of the patent is a Type-P disclosure because although the information is publicly disseminated or available, patent protection continues to attach until the patent rights cease or are held invalid. If the patent is not granted, the publication of the patent application is a Type-X disclosure because no patent rights ever attached to the information, unless the information disclosed in the patent application qualifies for trade secret protection.⁶⁴ If trade secrets exist in the patent application, then there are two possible outcomes. First, if the patent is not granted, and provided the patent application is not published, the filing of the patent application is a Type-C disclosure because the application will be kept confidential. Second, if the patent is not granted, but the patent application is published, then it is a Type-L disclosure because the publication destroys the trade secrets.

Another place where the word disclosure is used in the Patent Act is in 35 U.S.C. § 102, the provision which specifies that a patent will not be granted for an invention that already exists and is disclosed in the prior art.⁶⁵ It is here where disclosure has at least two different meanings, and where the applicable concepts of disclosure are sometimes incongruous with an information owner’s common understanding of disclosure as involving publicness. To the contrary, under patent prior art jurisprudence, like trade secret law, it is possible for an act to be treated as prior art even though it does not result in the public dissemination of the patentable invention. Pursuant to the *Metallizing Engineering* doctrine, for instance, a patent owner’s acts of using an invention in private in a manner that does not actually disclose the invention to the public can forfeit patent protection.⁶⁶ As explained in *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*:

[I]t is a condition upon an inventor’s right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly. . . . [I]f he

63. U.S. Patent Office, Manual of Patent Examining Procedure (MPEP) § 2164, The Enablement Requirement.

64. Some might argue that the publication constitutes a Type-L disclosure because the information could have remained as a protected trade secret but for the publication of the application in the Official Gazette. However, I contend that trade secret rights were waived by the patent applicant upon filing the application, so long as no duty to keep the application confidential applies.

65. See 35 U.S.C. § 102 (1990).

66. *Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516 (2d Cir. 1946).

goes beyond the [grace period without filing a patent application], he forfeits his right regardless of how little the public may have learned about the invention.⁶⁷

Similarly, in *Egbert v. Lippman*, the Supreme Court considered whether the use of corset-stays by the inventor's girlfriend for a period over two years constituted a patentability-destroying public use even though the invention was not actually visible to members of the public.⁶⁸ It did. Thus, U.S. patent law's conception of disclosure is like trade secret law's conception;⁶⁹ a patentability-disqualifying disclosure can occur when no information is actually revealed to members of the public.

Inventions are not considered novel under § 102 if, prior to the effective filing date of the subject patent application, they were: patented, described in a printed publication, in public use, on sale, or otherwise available to the public. While the word disclosure is nowhere to be found in § 102(a), all the listed types of prior art require some degree of disclosure. As Robert Merges has detailed, there are several different definitions of (patent-disqualifying) disclosure under patent law that range from "widespread dissemination" on one end of the spectrum of disclosure to merely "a move away from complete secrecy."⁷⁰ Which patent definition of disclosure applies often depends upon who is engaging in the act of disclosure and the form and manner of the disclosure. For important policy reasons, the acts of the inventor (information owner/holder) are more likely to be treated as patent disqualifying disclosures than if those same acts are engaged in by a third party, even if the acts of the inventor do not result in a public disclosure of the subject information.

Although § 102(a) does not contain the word disclosure, subsection (b) uses it multiple times and in different ways, thereby underscoring the need to keep the different concepts of disclosure under information law in mind when determining the legal effect of whichever acts of disclosure occurred. For instance, in the first instance of use of the word disclosure in § 102(b)(1)(A), the word disclosure is used alone to describe acts that, if occurring one year or less before the effective filing date of the subject application, will not be counted as prior art (specifically disclosures made by an inventor or joint inventor). In this context, disclosure is a catch-all

67. *Id.* at 520 (quoting *Pennock v. Dialogue*, 2 Pet. 1, [27 U.S. 1] (1829)).

68. *Id.* at 336.

69. Camilla A. Hrdy & Sharon K. Sandeen, *The Trade Secrecy Standard for Patent Prior Art*, 70 AM. U. L. REV. 1269(2021).

70. Robert P. Merges, *Priority and Novelty Under the AIA*, 27 Berkeley Tech. L.J. 1023 (2012).

phrase for the list of prior art in § 102(a).⁷¹ For purposes of patent law, these can be labeled Type-P disclosures because there is still an ability to protect the disclosed information if a patent application is timely filed, but for purposes of trade secret law they are either Type-C or Type-L disclosures depending upon whether they were made pursuant to a duty of confidence.

The second time the word disclosure is used in § 102(b)(1) is in subsection (B), but there it is used multiple times; three times alone and one time in conjunction with the word publicly. It reads:

A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if— . . .

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

Again, reading the word disclosure in context, when it is used alone it must mean the same thing as it meant in § 102(b)(1)(A), as a reference to all the types of prior art that are set forth in § 102(a). The use of the phrase “publicly disclosed” in § 102(b)(1)(B) then makes sense; it acknowledges longstanding U.S. patent law principles that some patent prior art has not been *publicly* disclosed as that phrase is commonly understood and that the required act of the inventor must result in a truly “public” disclosure. In turn, this reading means the language “otherwise available to the public” in § 102(a) does not mean the same thing as “publicly available,” but encompasses the broader conception of how information is deemed available to the public that is a part of U.S. patent (and, indeed, trade secret) jurisprudence. In short, disclosure in the patent prior art context does not require publicness.

C. Copyright Law

United States copyright law is another area of information law where different conceptions of disclosure exist, but copyright disclosure jurisprudence is obscured by four interrelated facts. First, the U.S. Copyright Act, although lengthy and detailed, does not use the word disclosure much and usually only in the attributive sense. In fact, the

71. US PATENT OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2152.04, “The Meaning of ‘Disclosure.’”

words “disclosure” or “disclose” are used less than ten times throughout the lengthy statute. Instead, the principal terms of art that are used in the Copyright Act which relate to disclosing acts and the public availability of copyright materials are: publication, published, unpublished, and public domain. Second, of the terms just listed, only publication is defined in the statute, although unpublished obviously means that which is not the subject of a publication as defined.⁷² Third, while publication remains an important concept under U.S. copyright law, it was more important before January 1, 1978 when the 1976 Copyright Act became effective and before March 1, 1989 when U.S. copyright law provided that copyrights did not attach to works of authorship that were published (as defined) without the requisite notice of copyright.⁷³ Finally, the deposit requirement of U.S. Copyright Act requires disclosure of copyright protected works, but with applicable regulations that allow for specified works (or portions of work) to be kept secret or confidential.⁷⁴

From the foregoing, it is possible for a single copyright protected work to consist of three types of information: (1) public domain information (unprotected Type-X information); (2) publicly disclosed, but Type-P information (that which is within the scope of copyright protection); and (3) secret information which is not made part of the deposit of the copyright protected work (Type-P or Type-C). Indeed, it is common for computer software to be comprised of all three types of information. However, whether Type-C information exists in a copyright protected work depends, in addition to the deposit rules, on whether the information is published and, if not, whether the information was shared with others pursuant to an obligation of confidentiality. If information in a work is published such that it becomes generally known or readily ascertainable, then the publication is a Type-L disclosure. But in contrast to the broad meanings of disclosure under patent and trade secrets law, the meaning of published under copyright law is narrower than its commonly understood meaning.

Before January 1, 1978, copyrights in the U.S. did not automatically attach to works of authorship fixed in tangible form as they have since,⁷⁵

72. 17 U.S.C. § 101 (2018).

73. Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075, § 9.

74. See 37 C.F.R. §§ 202.19–202.24. See also, Diane L. Zimmerman, *Trade Secrets and the ‘Philosophy’ of Copyright: A Case of Culture Crash*, in *THE LAW AND THEORY OF TRADE SECRECY* 299 (Rochelle C. Dreyfuss & Katherine J. Strandburg, eds., Edward Elgar Publishing 2011) (discussing the traditional disclosure purposes of U.S. copyright law).

75. 17 U.S.C. § 102(a) (1990).

but only attached when a work was published with notice⁷⁶ or registered.⁷⁷ This meant that unpublished and unregistered works were not protected by federal copyright law but may have been protected by common law. Thus, particularly for works that were unregistered, the definition of publication under U.S. copyright law was very important because it determined if copyrights in the work even existed. Publication was also a very important concept for those who may have published their works before March 1, 1989 without the requisite copyright notice because, if the work was deemed to be published without such notice, copyright protection was lost.⁷⁸

Not surprisingly, because the pre-March 1, 1989 copyright notice requirement worked a forfeiture of rights, the jurisprudence surrounding the meaning of publication before March 1, 1989 limited its meaning (and by extension, the meaning of copyright disclosures) by distinguishing between acts of “general publication” and acts of “limited publication.”⁷⁹ Then, in 1976, when a statutory definition of publication was finally added to U.S. copyright law, similar distinctions and limitations were codified.⁸⁰

76. Copyright Act of 1909 § 9.

77. Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075, §§ 10-11.

78. *See, e.g.*, *Holmes v. Hurst*, 174 U.S. 82 (1899) (finding the lack of separate copyright notice on essays in a magazine placed essays in the public domain); *Mifflin v. Dutton*, 190 U.S. 265 (1903) (finding the lack of separate copyright notice on installments of a book published in a magazine placed book in the public domain).

79. *White v. Kimmell*, 193 F.2d 744, 746-47 (9th Cir. 1952) (“[A] limited publication which communicates the contents of a manuscript to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution or sale, is considered a ‘limited publication,’ which does not result in loss of the author’s common-law right to his manuscript; but that the circulation must be restricted both as to persons and purpose, or it cannot be called a private or limited publication.”); *Werckmeister v. American Lithographic Co.*, 134 F. 321, 324 (2d Cir. 1904) (“Publication of a subject of copyright is effected by its communication or dedication to the public. Such a publication is what is known as a ‘general publication.’ There may be also a ‘limited publication.’”).

80. Copyright Act of 1909 § 9. *See also*, H. R. Rep. No. 94-1476, at 3 (1976), https://www.copyright.gov/history/law/clrev_94-1476.pdf [<https://perma.cc/E739-3ZNY>] (Under the definition in § 101, a work is “published” if one or more copies or phonorecords embodying it are distributed to the public—that is, generally to persons under no explicit or implicit restrictions with respect to disclosure of its contents—without regard to the manner in which the copies or phonorecords changed hands. The definition clears up the question of whether the sale of phonorecords constitutes publication, and it also makes plain that any form or dissemination in which a material object does not change hands—performances or displays on television, for example—is not a publication no matter how many people are exposed to the work. On the other hand, the definition also makes clear that, when copies or phonorecords are offered to a group of wholesalers, broadcasters, motion pictures, etc., publication takes place if the purpose is “further distribution, public performance, or public display.”).

The definition of publication (or published) under U.S. copyright law post the 1978 and 1989 changes to the law remain important because the Copyright Act is replete with provisions that treat published and unpublished works differently.⁸¹ But importantly for purposes of this article, publication under current U.S. copyright law does not necessarily mean public disclosure, particularly of the widespread variety. Rather, (and in contrast to the patent law concept of prior art, discussed above), the applicable definition of publication has been interpreted to be narrower than the common understanding of the meaning of disclosure. Section 101 of the U.S. Copyright Act, defines publication as:

[T]he distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.⁸²

On the face of this statutory definition, one can see the requirement of a sale or other transfer of ownership that is not generally required for public disclosures of information. As explained by one copyright law scholar: “[A] *sine qua non* of publication should be the acquisition by members of the public of a possessory interest in tangible copies of the work in question.”⁸³ As a result, U.S. copyright law’s definition of publication does not apply to all works that have been publicly disclosed or disseminated. Indeed, under U.S. copyright law, posting a work of authorship on the Internet does not constitute a publication,⁸⁴ whereas such an act would likely be considered a public disclosure under trade secret law.⁸⁵

Importantly, publication under current U.S. copyright law (or any other type of disclosure of a copyright protected work) does not mean the loss of applicable copyrights, although publication can affect the scope of those rights. Rather, the loss of copyrights under U.S. copyright law is

81. See, e.g., 17 U.S.C. § 408(b) (2005); 17 U.S.C. § 412 (2008).

82. 17 U.S.C. § 101 (2018).

83. 1 MELVILLE B. NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT § 4.07[A] (Matthew Bender, Rev. Ed., 2021).

84. U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 101 (3d ed. 2017) (“As a general rule, the Office does not consider a work to be published if it is merely displayed or performed online, unless the author or copyright owner clearly authorized the reproduction or distribution of that work, or clearly offered to distribute the work to a group of intermediaries for purposes of further distribution, public performance, or public display.”).

85. See Rowe, *supra* note 50.

typically denoted by the phrase “in the public domain” which—making copyright law’s disclosure jurisprudence even more confusing—doesn’t require public dissemination at all but is a term of art that signifies that copyrights in a work never existed or have come to an end.

Usually, copyrights come to an end because the applicable copyright term has ended, but authors of works can also announce that they dedicate their works to the public domain by waiving their copyrights. Additionally, although expressed in an otherwise copyright protected work, copyrights never exist in information, whether published or not, that is not within the scope of copyrighted subject matter. This would include facts and anything else not protected by copyright law as specified in § 102(b) of the Copyright Act. In both cases, the work (or unprotected portions of the work) is in the public domain in the sense that it can be freely copied by the public, not in the sense that it has been publicly disseminated. Thus, it is possible for a U.S. author to write a novel, keep it secret for her life plus seventy years, and it still will enter the public domain without ever being published or publicly disclosed.

Although the public domain is a term of art in intellectual property law that means information is not protected by intellectual property law, often it is used in common (and scholarly) vernacular to refer to information that has been publicly disclosed.⁸⁶ In such cases, care must be undertaken to determine if the term is being used in the intellectual property sense to mean information that is no longer protected by law or, in the more colloquial sense, to mean information that has been publicly disclosed. In the context of U.S. copyright law, the words that should be used to connote public disclosure are either “publication” or “published,” but as noted, copyright law has its own particular meaning of publication that does not comport one-for-one with an information owner/holder’s common understanding of disclosure. This is yet another reason why a typology of disclosure is needed.

IV. A PROPOSED TYPOLOGY OF DISCLOSURE

The foregoing examination of disclosure principles under various areas of information law does not provide an obvious answer to the question of how we should define (or redefine) disclosure. However, it is

86. See, e.g., *Coton v. Televised Visual X-Ography, Inc.*, 740 F. Supp. 2d 1299 (M.D. Fla. 2010). See also Monica Gaudio, *Copyright Infringement and Me*, LIVEJOURNAL.COM (Nov. 3rd, 2010, 11:14 pm), <https://illadore.livejournal.com/30674.html> [<https://perma.cc/34GR-HYNE>] (“Instead, the editor informed [Ms. Gaudio] that ‘the web is considered public domain’, and that [she] should be happy [Cooks Source] didn’t ‘lift’ [her] whole article and put someone else’s name on it!”).

important that we try because there is too much misunderstanding and confusion between an information owner/holder's common understanding of the meaning of disclosure and the legal effect of various disclosing acts. This misunderstanding and confusion often lead to the assertion of actual or threatened harm that is factually inapplicable, often occupying the court's time and attention when it shouldn't.

As has been shown, in certain areas of information law there is a strong public policy that favors the waiver of applicable protections whenever an information owner voluntarily discloses information to a third-party, regardless of whether the information becomes generally known or publicly available; in others, there is agreement that certain types of information are deserving of continued legal protection even if they are disclosed to the public or, at least, readily available to it; and, some information law doctrines recognize that certain types of information are not protected by law even if they are kept secret and confidential. How should we differentiate between these legal effects?

Borrowing from the idea of a "taxonomy of privacy,"⁸⁷ rather than improve or change the existing definitions and usages of the word disclosure under law, this article proposes a typology that distinguishes between acts that result in the loss of applicable rights in information and acts that do not. Specifically, as previewed above, five different types of disclosure with new descriptive labels are proposed that, consistent with the various ways that the word disclosure is used in information law, connote different legal circumstances and effects. They are:

1. Type-L disclosures: Acts that lead to the loss (or waiver) of associated legal rights in the disclosed information.

Type-L disclosures include all the ways that applicable rights in information are lost, including situations where regulated entities and public contractors are required to disclose specified information (including trade secrets and confidential information) to the government as a regulatory condition or a condition of doing business. These are the types of disclosure that worry information owners/holders the most and that are most legitimate to be raised in a court of law but that are often not improper.

87. Solove, *supra* note 15, at 485 ("[T]he goal [of this taxonomy] is simply to define the activities [that affect privacy] and explain why and how they can cause trouble. The question of when and how the law should regulate can only be answered in each specific context in which the question arises.").

2. Type-P disclosures: Acts, often associated with patent and copyright law but that may also apply in other contexts, that result in the public dissemination or availability of information but that do not result in the loss of any associated rights in the subject information.

The letter “P” stands for “protected,” meaning the subject information is protected by a body of information law (to what extent and under which circumstances are different questions) even after the information is disclosed to others or publicly. In addition to patent rights and copyrights, Type-P disclosures would include information that is required to be submitted to government regulators and becomes public but is the subject of applicable data exclusivity rights that restrict certain uses of the information.⁸⁸ It does not include information that is protected by contract, because that information is a Type-C disclosure.

3. Type-C disclosures: Acts that do not lead to the loss of associated legal rights because the sharing of information occurs between persons and entities that owe an obligation of confidentiality imposed by law, court order, or contract.

The sharing of trade secrets and other confidential information would be classified as a Type-C disclosure provided the subject information is confidential or secret and an obligation of confidentiality is established before the sharing occurs. If no such obligation of confidentiality exists before sharing, then the act of sharing is likely to constitute a Type-L disclosure if the information was protected by law before it was shared. This is the category that best describes confidential information that is shared pursuant to a Protective Order or a Non-disclosure Agreement (NDA). Sometimes, however, information that is the subject of a Protective Order or an NDA does not have legal protection beyond factual confidentiality or applicable privilege and should properly be labeled Type-X information (see below).

4. Type-T disclosures: Acts that result in the mere transfer of information, either in analog or digital form, but that do not result in the transferred information being read by the transferee.

This category of disclosure has not yet been explicitly recognized by law but is needed to differentiate between: (a) information which is shared such that knowledge is or could be acquired by another; and (b) the mere transfer (often electronically) of information from one place to another.

88. See, e.g., Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Annex 1C, art. 39.3, Apr. 15, 1994, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).

For this purpose, the word transfer is defined as “to convey or remove from one place or one person to another; to pass or hand over from one to another.”⁸⁹ Thus, this category could cover information that is stored on third-party servers in the Cloud or in old-school banker’s boxes or file cabinets kept at a third-party storage site.⁹⁰ Often these business relationships do not involve express or implied promises of confidentiality that would allow the transfers of information to be described as Type-C disclosures, so a different label is needed. However, if there is a breach of the storage facility, there is a possibility that the information will suffer a Type-L disclosure.

5. Type-X disclosures: This category of disclosures focuses more on the type of information and its legal status, rather than the act of disclosure. It is applicable to acts of disclosure involving information that is not protected by law for one reason or another. This would include, for instance: information that is not within the scope of protected information, information that is in the public domain because applicable protections have expired, information that is generally known or readily ascertainable, and information that constitutes prior art under patent law.

This final type of disclosure is needed to capture the default rule that information is not protected by law unless the law says it is. Unless information is protected by an area of information law (for instance, trade secret, patent, copyright, or privacy law), the law does not provide a remedy for the unwanted disclosure of that information. Indeed, the strong public policy of the U.S. is to facilitate the dissemination and use of information because information is needed to spur creativity and invention. The owners/holders of Type-X information can always engage in self-help to protect it, but if it leaks out they have no standing to complain because, due to the public policy that favors information diffusion and knowledge acquisition, society doesn’t care about the unwanted disclosure of legally unprotected information, even if the information owner/holder subjectively believed that the information was its secret or confidential information.

V. SUGGESTIONS FOR HOW TO USE THE TYPOLOGY

The best way to use the suggested typology is to require information owners/holders to designate the type of information and information

89. *Id.*

90. Sandeen, *supra* note 13.

disclosures that are involved in litigation or other settings where they may be required or compelled to disclose information. The focus of the labels is mostly on the character of the disclosure, not the type of information, except for Type-P and Type-X disclosures which concern the type of legal protection involved; for instance, patent, copyright, trade secret, data exclusivity, or none. Just the effort undertaken to label information should clarify the nature of the designated information, even if more than one designation might plausibly apply to the subject information. If multiple designations apply, litigants and courts will know that they are likely dealing with overlapping rights, which must be sorted through.

From the standpoint of the over-assertion of information rights, and with the rhetorical power of theft in mind, a designation that information as either Type-P or Type-X should quickly dispel any fears of improper disclosure because no rights in the information can be lost. But note that a determination of whether an information owner/holder's or a third party's previous disclosures rendered information Type-X (no protection) will require application of applicable information law and the multiple types of protection destroying acts that may apply to the subject information, including the broad definitions of disclosure under trade secret and patent law. It is unlikely that an information owner/holder will readily admit that its information is Type-X, even if it is, requiring a court to assess that issue.

Type-C disclosures should not be of major concern to courts and litigants because they will be undertaken pursuant to applicable duties of confidentiality, including those imposed by Protective Orders and NDAs. The critical issues will be determining: (1) if a duty of confidentiality exists and is enforceable; and (2) the scope of the duty of confidentiality. This should include a determination of whether the subject information is indeed confidential, but often duties of confidentiality are agreed to, or Protective Orders are issued, without a detailed assessment of this issue. Typically, if an information owner treats information as confidential, it will be treated as such initially, but subject to later factual findings as part of a breach of confidentiality claim.

If a breach of confidentiality is later alleged, the critical questions will be whether the information was and remained confidential. If not, the information would lose its confidential status either because confidentiality did not exist when the Protective Order was issued or the NDA was agreed to (a Type-X disclosure), or confidentiality was subsequently lost (a Type-L disclosure). Information owners, often allege a Type-L disclosure when seeking monetary damages in trade secret and

breach of contract cases, but whether they will prevail on their claims depends upon the confidential and secret status of the subject information.

Under current trade secret principles, Type-T disclosures may result in the loss of information rights if reasonable efforts to protect such information are not undertaken. However, if the law evolves to recognize a distinction between the disclosure or sharing of information and a “mere transfer” of such information, then it might be argued that Type-T disclosures do not result in a loss of any associated information rights. This is because, as noted above, arguably, Type-L disclosures do not involve cognition by the recipient of the information. If more disclosing activities are involved, then a confidentiality obligation should have been established before there was any transfer or sharing of information. Since what might be labeled Type-T disclosures are initiated by the information owner/holder, they should not be heard to complain about the consequences of their own voluntary actions if a court deems their actions to be of the Type-L variety.

It is only Type-L disclosures, or the threat of Type-L disclosures, that legitimately involve the loss of information rights. But because the information involved will often fall into the Type-P or Type X categories, a determination of the protected status of the information should always be made early.

VI. CONCLUSION

This article demonstrates how the word disclosure and disclosing activities vary in different areas of law (focusing on patent, copyright, and trade secret law) and why it is important to understand and correctly apply the different meanings and concepts. The principal concern is that information owners spend a lot of time, energy, and court resources arguing that their rights in information will be lost when in many cases such an assertion is untrue because: (1) the information is not protected by any law; (2) the information will be protected by patent or copyright law even if disclosed; (3) the disclosure is actually a mere transfer of information; or (4) a Protective Order or other confidentiality obligation will suffice to protect the information. To make it easier for litigants and courts to determine when the potential loss of information is truly a concern, this article sets forth a typology of disclosure that differentiates between various disclosing activities. Although presented with respect to the intellectual property laws that are discussed, the typology should be useful in any context where acts of disclosure are discussed.