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DOCUMENTATION FOR INVENTORS

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Inventors and those engaged in related work -- and their counsel -- have much to lose if their inventive progress or proprietary developments are not properly being documented. Proper documentation of an invention or trade secret requires the careful balancing of seemingly conflicting factors, which if ignored, can have disastrous consequences in the loss of valuable intellectual property rights. One factor, of course, is the need to have proof of the content of an invention or trade secret. Usually, this is in conflict with the need for confidentiality. In the trade secret context, once the information is generally known, it may no longer be protected as a trade secret. Yet in the case of an unauthorized disclosure, the aggrieved party must prove that it was not only maintaining the proprietary information in confidence, but also the extent of the confidential information. Moreover, trade secret protection is usually relied on even when patent protection is sought, at least until the patent issues.

In the patent context, the need for documentation is rooted in the fact that the United States has a "first to invent" patent system. In contrast, all other industrialized countries (except the Philippines) have a "first to file" system which awards the patent to the first party to submit a proper application. (Canada is presently implementing a change to the first to file system.) As set forth in 35 U.S.C. 101, "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, . . ." This provision is subject to 35 U.S.C 102, discussed below, and 35 U.S.C. 103, which renders the invention unpatentable "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art . . ." Section 102 bars the issuance of a patent in case the invention was "anticipated", subsections (a), (b), (d), (e), or (g); "abandoned" subsection (c); or not invented by the applicant, subsection (f). The need for documentation arises in connection with subsections (a), (e), (f) and (g), which state:

A person shall be entitled to a patent unless--

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant . . ., or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was the first to conceive and last to reduce to practice, from a time prior to conception by the other.

The need for confidentiality is critical when foreign patent protection is desired, because in the first to file countries, there is generally some form of an "absolute novelty" requirement that bars the issuance of a patent if the invention was "published" anywhere in the world before the application was filed. This requirement is made less onerous by the Paris Convention, which has been joined by all industrialized countries but Taiwan. The Paris Convention provides a one-year grace period from the first official filing in a signatory country in which to file in any other such countries, the later-filed applications receiving the benefit of the "priority filing date" of the first application. Thus publication of the invention is permitted following the filing of the first application, but only if the other foreign applications are filed within the grace period. When only U.S. patent protection is sought, it is permitted to have the invention in public use, publicly disclosed, or on-sale, but not more than one year prior to the U.S. filing date. 35 U.S.C. 102(b). However, it is usually recommended to maintain trade secret protection at least

until the application is filed, to preserve the possibility of foreign protection, and to lessen the chance that a competitor would copy the invention and flood the market.

In the U.S. application, there must be a "written description of the invention, and of the manner and process of making it and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, . . . to make and use the same . . ." 35 U.S.C. 112 (first paragraph). Accordingly, an invention is presumed to have been completed, or reduced to practice, not later than the filing date of the application. In many cases, this constructive reduction to practice is all that an inventor needs to rely on to obtain his patent. It is only when there are conflicting claims to an invention that the documentation is crucial. When a pending patent application is directed to the same patentable invention as another application, or unexpired patent, an "interference proceeding" is conducted in the Patent Office under 35 U.S.C. 135, for determining which of the applicants is entitled to the patent. Similarly, there can be a civil action by a patentee against another interfering patent, 35 U.S.C. 291. Also, an applicant may find at least some of his claims rejected as being anticipated under 35 U.S.C. 102 or obvious under 35 U.S.C. 103, based on one or more references that predate the filing date of his application, but subsequent to at least some of his activities of invention. It is in these cases that the inventor's documentation is crucial.

Thus the inventor may be required to prove not only that he himself made the invention and when, but each and every element of the invention. The invention is not considered complete until it is reduced to practice, which means that it must be operational, there must be a "demonstration that the embodiment relied upon as evidence of priority actually worked for its intended purpose." *Newkirk v. Lulejian*, 825 F.2d 1581, 1582 (CAFC 1987). However, a complete conception of the invention, coupled with reasonable diligence toward both reduction to practice and the filing of an application, can overcome a reference having an effective date subsequent to both applicant's date of conception and the initiation of applicant's diligent activities. *Paulik v. Rizkalla*, 760 F.2d 1270, 1275. In order to prove conception, the inventor must show that he knew each and every element of the invention as claimed, "by corroborating evidence which shows that the inventor disclosed to others his 'completed thought expressed in such clear terms as to enable those skilled in the art' to make the invention." *Coleman v. Dines*, 754 F.2d 353, 359 (CAFC 1985). In actual practice, however, the inventor seldom knows when his invention is complete. It is only by hindsight that the required elements and the timing needed to win in an interference or to overcome a reference might be known.

Accordingly, the inventor should be able to prove any of the following:

1. each and every feature of whatever project he is working on and how any combination of such features would form an operative invention in practice, and when it was known to him;
2. how to make and use the invention, and in the case of chemical compositions, every contemplated use for the invention;
3. how he disclosed to others his completed thoughts;
4. that each disclosure was made in confidence;
5. as to others that may have contributed to the invention, what each did and when;
6. any activities that he did or supervised for making and testing a working model of the invention, and when they occurred; and
7. any activities that he did or supervised for the filing of a patent application on the invention, and when they occurred.

A most satisfactory record of the above can be kept as a diary in an "engineer's notebook", which is a hard bound volume having prenumbered pages of graph paper, obtainable at better stationery stores. Sketches and drawings, photographs, and written descriptions of the invention, experiments and tests related to the invention are entered in the notebook, with each page signed and dated by the inventor. The work done by the inventor, and that which is done by others, should be clearly indicated. Periodically, such as once per week, the work to that point should be witnessed by another who neither has a financial stake in the work nor is involved in the project, under a legend such as the following:

Read and understood in confidence by (signature), (date). (name)

The Document Disclosure Program of the Patent Office provides another means for documenting an invention by providing an official record of any document submitted by an inventor, together with his signed declaration that he invented whatever it discloses. However the document is retained for only two years unless someone with a pending patent application calls attention to it in the Patent Office, and what

it proves it limited to its contents. The engineer's notebook provides a better record of an invention than the Document Disclosure Program, or the popular practice of having papers mailed to oneself that are unopened, because it is a running, corroborated account of the inventive activities.

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