

How To Document Your Invention

Documenting can be a very important aspect of the inventing process. At some point, you may need to rely on your documents during legal proceedings to establish or maintain rights to your invention. It is critical, therefore, that you document your activities *properly* – i.e., in a way in which the documents will be respected in court for their evidentiary value. This guide has been put together to outline how to achieve this goal. First, let's review various ways that you can benefit from documentation.

Why Documentation is Important

You should consider documenting your invention for the following reasons.

1. Proving your date of conception.

The United States is the only country in the world (besides the Philippines) that uses a first-to-invent system rather than a first-to-file system for determining priority¹ of a given invention. Occasionally, two applications for the same invention will be filed close in time to each other. In that situation, the patent office will declare an interference to determine who has priority. By default, your date of conception is your filing date. You can receive the benefit of an earlier date, however, but only if you are able to *PROVE* it. Otherwise, you may lose your right to acquire a patent for your technology. The technical term for this is: “bad.” Proper documentation will cure this deficiency.

Also, a patent cannot be issued for your invention if it is found to lack novelty or if it is legally obvious *as of the date of conception*. Patent examiners will apply prior art against your application to determine novelty and obviousness. With proper documentation, you can antedate a reference² for up to one year before filing. This can make the difference between acquiring a patent or not.³

2. Proving inventorship.

Every patent must disclose the true inventor(s) of the technology. A valid patent can later be held unenforceable (in other words, *useless*) if it can be shown that this requirement was not met. Your documentation can show not only what was invented, but also who was responsible for the various patentable aspects of the invention. It can therefore be used to show inventorship in case it is ever called into question.

¹ For disputes involving two or more parties, only one party will be granted “priority,” meaning they have the right to pursue patent protection on that technology while the other parties are precluded from doing so.

² Antedating a reference means that you knock it out for consideration. A patent examiner cannot cite it against your application because it is not technically prior art.

³ In addition, this could make the difference between a strong patent and a weak patent. You may have to narrow your claims (i.e., diminish the scope of patent protection) to claim around the prior art.

In addition, many employees are required by contract to assign rights to their employers for inventions that they conceive during the course of employment. If you are inventing in the technical field in which you work, proper documentation may prevent an employer from asserting a claim to your invention. Additionally, documentation can be used to prove that you are the real inventor if someone steals your idea.

3. Assisting with patent preparation.

A well-documented invention will help streamline the process of working with a patent professional by providing (hopefully in a clear manner) much of the information that is needed to put together a patent application. This may save you time and money, and also help to ensure that all important aspects of the invention are accounted for in the patent application.

4. Do it for your own benefit.

It is good practice, in general, to document your invention. Writing forces you to think through your activities and clarify what it is that you have actually invented. It helps to provide direction, and may clear the way for new, possibly better, ideas that you can incorporate into your work. It also helps you remember what you have done in the past, thereby preventing unnecessary rework. Moreover, if your inventing activities are part of a business, you may be able to seek tax deductions for the expenses that you incur.

Methods to Document Your Invention

I think you'll agree by now that documentation can be very important. Not all forms of documentation, however, are created equal. Your documents may need to be presented as evidence in a legal proceeding. Let's review a sliding scale of documentation (or rather, the evidentiary value of various instruments), including the recommended method for inventors to use. Keep in mind that there are no specific legal requirements for documenting your invention. Courts are looking for something that instills a *reasonable amount of confidence* that your documents are authentic and accurate. If you were a judge charged with settling a patent dispute – a dispute that could potentially involve large sums of money – what would satisfy you?

1. Nothing at all. Sometimes in life, you get out of something what you put into it. Obviously, that applies in this case. Perhaps you'll get lucky and inadvertently leave an evidence trail that has some value, but if you leave it to chance, well then, who knows...
2. The dreaded "post-office patent" (i.e., mailing a sealed envelope to yourself to prove inventorship). This is a *very* close second to No. 1. This form of evidence is easily falsified and cannot be supported by independent witness testimony. Courts give it almost no evidentiary value whatsoever.

3. Notarized invention disclosure. This is a step in the right direction; however, for reasons discussed below, it is generally inadequate as a means of proving inventorship.
4. Properly executed inventors notebook signed by the inventor(s) and two witnesses. This is the recommended method of documenting your invention, and will be discussed in more detail below. If you've already completed your invention, an invention disclosure can be used in lieu of the inventors notebook.
5. Filing a patent application (including a provisional application). This provides rock-solid evidence of conception *as of the date of filing*. Of course, filing a patent application and receiving a valuable patent is the ultimate goal. It should not necessarily, however, be the first step. You may benefit from documentation produced at an earlier date for reasons discussed above.

How To Assemble an Inventors Notebook

Again, keep in mind that your goal is to produce a document that will be considered authentic and accurate by the patent office or a court should you ever need to rely on it. Your documentary chain should be something, therefore, that would be difficult to fabricate, and it should be authenticated by independent witnesses.

You should use a lab notebook with permanently bound pages, preferably a notebook with a stiff cover. Print your name, address, and origination date on the front cover. All of the pages will need to be sequentially numbered and all entries signed by the inventor(s) and witnesses. Entries should be made in ink so as not to be erasable. (Sketches made in pencil can be photocopied and attached to the notebook). A large "X" should be drawn over large, open spaces in the notebook to show that you have not added content after it was signed and witnessed. If you make mistakes, do not try to erase them. Rather, cross them out and add a dated explanatory notation. If there is not enough room for your comments, add them to a new page and cross-references each page to the corresponding entry by page number and date.

A sample page of an inventors notebook is presented below for reference. All of the important aspects of your inventing process should be included in the notebook. This doesn't mean every minute detail of the invention, but enough detail so that someone reading your notebook could reasonably understand what you have invented (including various potential embodiments of your invention). You also don't need to use perfect English, but try to disclose your invention as clearly as possible. And avoid "legalese." It's not necessary and it would probably just make your notebook seem unnatural anyway. Remember: you are putting together the notebook to prove conception – not to prove that you are a patent attorney.

Each page must be signed and dated by the inventor(s) and two witnesses. Why two witnesses instead of one? There is value in using only one witness; however, the use of two witnesses has become the standard, accepted convention. It gives you a stronger

case for authentication. (Wouldn't you, as a judge, be inclined to give more weight to the notebook if more witnesses had signed it?) It also increases the likelihood that your witnesses will be available to testify at trial, if necessary. (Hopefully at least one of them can show up!)

It is important to ensure that your witnesses are impartial. Your husband or wife, for instance, would make a poor choice because they would benefit right along with you if your invention is a success. They will not be perceived as impartial. Find friends or acquaintances with no interest in your invention. Also, it is important not only that they witness your notebook, but that they read and understand what you have invented, and have at least a basic grasp of the technology associated with your invention. They may one day be asked to serve on the witness stand to verify their knowledge. It wouldn't look good for your case if they just scratched their "John Hancock" down without knowing what they were signing. This is why an inventor's notebook is better than using a notary. The notary may not have read or understood what you have invented; and it is exceedingly unlikely that they can provide meaningful testimony concerning some document that they notarized on, say, March 23, 2003. As shown in the sample below, the following language is recommended: "THE ABOVE CONFIDENTIAL INFORMATION IS WITNESSED AND UNDERSTOOD." The word "confidential" indicates that you are not publicly disclosing your invention (which could act as a bar to patentability).

Try to sign your notebook pages the same day that you make the entry. If you cannot for some reason, simply comment that you signed it later and explain why. Add comments also for anything that you previously invented and waited to document. Explain, for instance, that you read this guide and understood for the first time how to properly document your invention. Indicate that you conceived of your invention at an earlier date (if applicable) but do not post-date your entries! Always be honest. Attach and reference any relevant documents that you produced prior to assembling your notebook.

Ensure that your disclosure adequately describes your invention as clearly as possible, showing all aspects of novelty and functionality. Don't get too caught up with producing beautiful, flowing prose if that's not your forte. You don't need to be Percy Shelley! You can (and in most cases, should) rely on sketches to detail your invention. Record any building and testing. Describe your activities, results of testing, and any conclusions that you have made. It's also a good idea to record the circumstances of conception – for example, conceiving of adjustable glides after spilling coffee on a book, as in the sample below. This lends credence to the fact that you are the true inventor. Make honest statements regarding the advantages that your invention will have over the prior art to show that it is useful and wonderful, but avoid being too opinionated or boastful. Remember Joe Friday of *Dragnet*: "Just the facts, Ma'am!" If Joe Friday wouldn't approve of your notebook, you've probably gotten a little carried away!

Photos should be permanently attached to the notebook, if possible. Large drawings or printouts should be referenced in the notebook, and attached to the notebook if it is reasonable to do so. These materials should also be dated, signed, and witnessed. Whenever you attach something, make a reference in the notebook describing what you have attached. Save any receipts that are related to your inventing activities. These can make great evidence due to the difficulty of fabrication. And don't forget to keep your notebook in a safe place!

How to draft an invention disclosure

If you've already invented something and you are documenting it now for the first time, you can use an invention disclosure. Essentially it is the same as the inventors notebook, except there is no need for a notebook. The disclosure can be drafted on a sheet of paper, printed out, etc. Use the same documentation procedures described above, making sure that the disclosure is signed, dated, and witnessed.

For your convenience, you can download a detailed inventors disclosure form from the 'downloads' tab at www.madaypatentlaw.com. This form may also be used to describe your invention to us for preparing a patent application.

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Happy Inventing!

Disclaimer

The information provided herein has been produced in a good faith effort to assist inventors with proper documentation. It is believed that use of the techniques outlined will provide valid evidence of inventing activities that may be beneficial to an inventor in a legal proceeding. Each case is unique, however, and the outcome of any legal issue (including admissibility of evidence) cannot be predicted in advance. No guarantee, either express or implied, is given for the use of this material. This should not be construed as legal advice.

Sample page entry:

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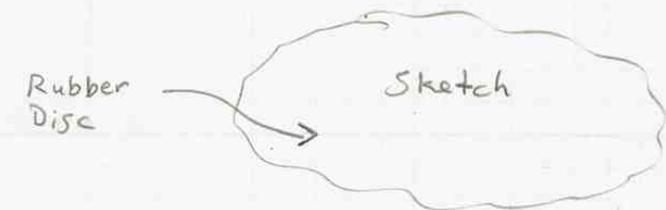
TITLE: Self-leveling glide for table legs

PURPOSE: To provide a glide that automatically adjusts to uneven surfaces.

DESCRIPTION: The glide has a spring mounted inside of a swiveling chamber with a groove of varying height... I conceived of this last month after spilling coffee on a book I was reading due to a wobbly table at a coffee shop...



RAMIFICATIONS: Instead of a spring, a rubber disc could be used as follows.



POSSIBLE NOVEL FEATURES: The swiveling chamber mechanism is believed to be entirely new...

ADVANTAGES: This glide would enhance safety and functionality for various types of tables by eliminating the potential for wobbling, thereby resulting in a stable surface. It would also prevent the need to insert objects, such as napkins, under the table legs...

INVENTOR: Geo Getter

DATED: 01/01/2010

THE ABOVE CONFIDENTIAL INFORMATION IS WITNESSED AND UNDERSTOOD,

Ollie Observer 01/01/2010

Olivia Onlooker 01/01/2010