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# Business & Law Newsletter

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## PROTECTING YOUR INVENTION

### Part I. Documenting the invention

The importance of properly documenting the development of an invention cannot be overstated. The patent laws of the United States enable the first inventor who diligently pursues his invention to receive a patent on the invention even if someone else files a patent application first. This policy is in contrast to the patent laws of many European countries in which the patent is awarded to the inventor who files his patent first. Those countries with the "first to file" laws have an advantage of being able to identify easily and with certainty who is the inventor of a new invention by simply determining who filed the application first. However, this "first to file" rule can work an injustice on the true first inventor by awarding the patent to someone who won the race to the Patent Office and filed his application first even though he may have been second in conceiving of and developing the invention. To counter this problem, the patent laws of the United States provide that the patent should go to the inventor who first conceives of the invention and then diligently reduces the idea to practice.

However, when two different parties claim to be the inventor, an expensive and time-consuming problem is created by the policy of awarding the patent to the first inventor rather than the first to file. Namely, the first inventor must prove by a preponderance of the evidence that he was, in fact, the first to invent the new device. This involves litigation. The litigation either occurs at the level of the Board of Patent Appeals and Interferences or in Federal court. In either event, the first inventor must convince a panel of judges or a jury that he was first to invent. For these reasons it is essential to keep good records of the events leading up to the idea for the invention and all of the work that went into developing the invention. Imagine that the first inventor came into court to prove his invention and presented a box to the court containing an unorganized pile of paper towels and other scraps of paper onto which had been scribbled data, conclusions and protocols describing the invention. The second inventor comes to the court with his data and materials neatly contained in a notebook with each entry containing the essential who, what, when and why of the work which went into the invention and

with each entry witnessed by someone other than the inventor. Who is the jury likely to decide was the first inventor and entitled to the patent? Probably, the second inventor will win that decision and get the patent. The best way to protect your invention from this kind of nightmare is to establish a rigorous record-keeping system and follow it diligently. The following are some tips on establishing a record-keeping system for the invention:

1. Use a bound notebook. If a loose-leaf notebook is used, number all pages consecutively and date, sign and have witnessed each experiment or entry.
2. Make all entries in ink. Entries made in ink are less likely to be questioned as forgeries.
3. Permanently affix attachments in the notebook. Machine-generated data, hand-made graphs and tables, drawings, photographs and the like should be permanently attached to a page of the notebook.
4. Don't leave large blank spaces in the notebook. If an entry ends half-way through the page, strike through the remainder of the page.
5. Describe what was done in detail. It is not possible to describe the protocol followed in too much detail. Document all data, observations and results.
6. Identify all who participated in the work. Document each individuals contribution to the work. Those individuals who contributed to the development of the concept should be identified and their contribution noted. Failure to properly identify all of the inventors may lead to the patent being found invalid.
7. Identify and document why the work was done. The information obtained or problem solved which advanced the development of the project should be noted.
8. Document an outline of future work.
9. Remove nothing from the notebook. If a mistake is made, document that a mistake was made. If something was incorrectly recorded, strike through it a single time and make the correct entry.
10. Identify all abbreviations. This notebook may be reviewed by individuals unfamiliar with the abbreviations used.
11. Be factual. State facts, not opinions. Conclusions based on the facts should be recorded.
12. Index the notebook. Identify the first notebook as "No.1" and so forth. Keep the notebook in a safe place. Retain the notebook for the life of the patent plus six years.

The aforementioned suggestions are not as onerous as they sound. Once they become habit, a good notebook will be much easier to maintain. Keeping good records is a lot easier than defending a sloppy notebook during cross examination by your adversaries' lawyer.

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