

The Limited Monopoly

The Invention Disclosure - Putting a Stake in the Ground

A Good Habit to Get Into

In the United States, a limited monopoly in the form of a patent may be granted to the first to invent, rather than the first to file a patent application on an invention. So what happens if your competitor beats you to the Patent Office? The answer depends on a number of things, but if you have a properly constructed invention disclosure document and possibly other evidence that pre-dates your competitor's date of invention, you may be able to prove to the Patent Office that your invention was made before your competitor's date of invention. You must also be able to show that your invention was not abandoned, suppressed or concealed. The patent statutes also require that the inventor makes a diligent effort in reducing the invention to practice following conception.¹ A signed, dated and witnessed invention disclosure document, along with ongoing records showing diligence in reduction to practice, may hold the key to proof that you were the first inventor.

Preparing the Invention Disclosure – “Driving the Stake”



Good practices for all engineers, scientists, and others involved with inventions include preparing thorough documentation of the invention. A lab notebook that is routinely inscribed with detailed notes, and

is signed, dated, and witnessed may become very important, should you ever be required to prove that you invented before someone else. In addition, an invention disclosure document that contains a clear and complete explanation of the manner and process of making and

to a patent. Such an invention disclosure provides a “stake in the ground” for not only establishing a date of your invention, but also can provide meaningful information about your invention to a patent practitioner who may use the invention disclosure as the basis for preparing a patent application for you.

So what does an invention disclosure look like? There is no set format, but the document should explain the invention clearly to one who is not familiar with it. The document should contain the name and address of the inventor(s), the name of the invention, and the date on which the inventors conceived of the invention. The document should then lay out a brief description of the invention and the details of the invention. Labeled sketches or drawings that help to describe the invention should be included when possible. If there are alternatives to making and using the invention that differ from what has been described, provide these alternatives. If a description of what already exists helps one to understand why the invention is novel, useful, and not obvious to one skilled in the art, it should also be included.

At the conclusion of the invention disclosure document, the inventor(s) should sign and date the document, and below the inventor(s) signature(s), a witness signature and date should be recorded with the words “Read and Understood” before the witness signature. Yes, that means the witness should read and understand your invention disclosure document. Select a witness carefully – choose someone who can be entrusted to keep the knowledge of your invention confidential. And don't forget to number each page in the style “1 of x, 2 of x, etc.” An even better practice is to keep all records of your invention in a hardcover notebook with sequentially numbered pages. Looseleaf papers, such as handwritten notes, printed pages, and photographs should be securely glued and/or taped in the notebook and signed as well. An ongoing record of your diligent

Uses for the Invention Disclosure Document

An invention disclosure first and foremost provides proof of the date of your invention. The importance of this cannot be overstated. The invention disclosure also has several further uses. Patent practitioners routinely use invention disclosure documents to start the patent application process. The document helps the practitioner to understand your invention. The practitioner should also spend some time conferring with the inventor(s), and studying any prototypes or software models of the invention to attain a thorough understanding of it. Also, an invention disclosure document may help a company or a university sort out and prioritize its inventions to help determine which are worthy of commercialization efforts and the investment in a patent application. Preparing an invention disclosure also may help inventors to organize their thoughts and more effectively plan further development, similar to the way writing a business plan helps entrepreneurs to start companies.

A Note of Caution

An invention disclosure is *not* a substitute for a patent application, nor does it serve to stop any statutory bar dates. Any public use, sale, or offer for sale in the United States, or publication of an invention anywhere in the world more than one year prior to the filing of a patent application on that invention will prohibit the granting of a U.S. patent on it.² Inventors unfamiliar with the requirements of U.S. patent law and procedures should consult a practitioner registered to practice before the USPTO.

1. 35 U.S.C. 102(g).
2. 35 U.S.C. 102(b).

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using your invention in sufficient detail to enable a person having ordinary knowledge in the field of the invention to make and use the invention may be invaluable in proving that you were the first inventor, and are entitled

effort to reduce your invention to practice – i.e. build a working prototype – should also be maintained. (But also keep in mind that a reduction to practice is not necessarily required to file a patent application.)

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