

## Take Note: Protect Your Invention

STEVE A. WITTERS, ESQ., P.E.



Proper management of your technological development activities can lead to strong patents or trade secrets while no management can lead to no patent or trade secret, a worthless patent, or even a patent for someone else.

A 2005 court case shows that improper management of your development activities and technologies can be a costly mistake. In *Yeda Research And Development Co. v. ImClone Systems and Aventis Pharmaceuticals* (S.D.N.Y. Nov. 3, 2005), Yeda sued, ImClone alleging improper inventorship of U.S. Pat. No. 6,217,866. The court,

anything, is better than nothing at all; however, the better and more complete the notebook, the better it may serve you.

Keeping a notebook is a lot of work, but it may become a very important aspect of your developments. Your notebook should be stitch-bound with consecutively number pages, such as the composition notebooks you used in college. Electronic documents may not provide sufficient evidence of invention because they can be easily altered. You should use a different notebook for each invention. If you are a prolific inventor, you may want to keep one notebook for jotting down your ideas and start a separate notebook for each invention that

The record of conception may also provide enough information for drafting a patent application. If you make only one entry in your notebook, this is it. Do not, however, let it languish so as to abandon, suppress, or conceal your invention, unless of course you are keeping it as a trade secret.

When making entries into the notebook, keep in mind that it may be extremely valuable if it can survive the scrutiny of a court. Your entries need to be in ink and clear and concise so that they can be understood by another engineer. Make all entries in a consistent manner, using consistent engineering language, charts, and numbering systems—no legalese or salesmanship. Correct mistakes by striking out, initialing, and dating. Blank spaces and pages should be crossed out.

Having your entries witnessed is critical. Each page should be signed and dated by the inventor(s) and witnessed by an impartial third party who understands your invention. This may be a manager of the engineering department but should not be your brother-in-law or coinventor. If you're an independent inventor, have your notebook notarized. Entries should be consecutively dated and made contemporaneously with the activity—no backdating. If you are entering a prior conception, this should be indicated along with the date of conception. If your witness isn't available each day you make an entry, have each entry witnessed as soon as possible. Securely store your notebook when not in use.

Two court cases show the importance of witnesses. In *Huang v. CIT* (CD Cal. 2004), Huang sued, alleging that he should be a named inventor of CIT's patents. Huang submitted his own testimony and his laboratory notebooks as evidence. The court found that the lab notebooks were insufficient because they were not witnessed or reliably dated. In *ASP v. IQ Hong Kong* (E.D. Wisc. 2007), the inventor submitted a declaration of an earlier date of invention to the U.S. Patent and Trademark Office during reexamination, evidenced by an earlier dated sketch of the invention. The sketch

### Proper management of your technological development activities needs to include procedures for immediately filing for a patent or keeping an engineer's or inventor's notebook.

after finding no "documentary evidence" suggesting that any of the named inventors contemplated the claimed invention, found that the Yeda engineers had proven they were entitled to sole inventorship, hence ownership, of the patent. As of the date of the trial, ImClone had received about \$900 million in revenues under a distribution agreement.

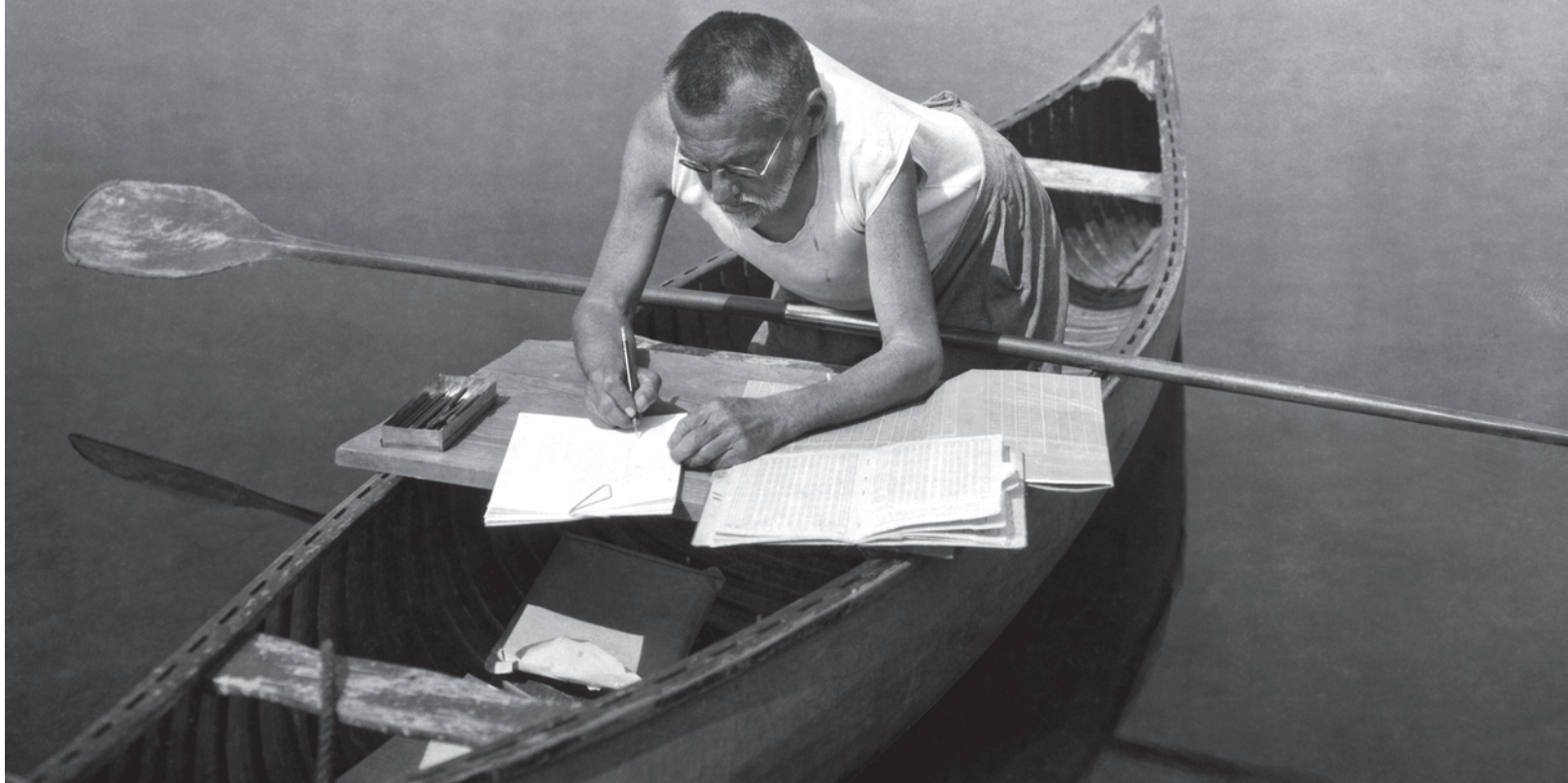
Proper management of your technological development activities needs to include procedures for immediately filing for a patent or keeping an engineer's or inventor's notebook. If an idea isn't yet ready for patenting or you haven't decided to patent the invention, then keeping an inventor's notebook is imperative.

An inventor's notebook is a record of activities related to an invention. The notebook should be treated like a diary and should show a third party what was done and when. All activities related to the invention, from initial conception to filing for a patent, or deciding what to keep as a trade secret, should be recorded in the notebook. An engineer's notebook is not an all-or-nothing proposition. Something,

you move forward. And if you think you might have too many notebooks, remember Thomas Edison: He completed over 2,500 design notebooks in his lifetime.

Your name and phone number should be on the front cover of your notebook. The first entry in the notebook should be a record of conception of your invention. Conception is the formulation of an invention in the mind of an inventor. This will probably be your most important entry and should be done immediately upon conception of the invention, before any building or testing. The record of conception should include the following: 1) title, 2) circumstances of conception, 3) purpose or problems solved, 4) structural description with sketch, 5) possible uses and how it is used, 6) what you think is novel, 7) closest known prior art, 8) advantages, and 9) name of each inventor.

Your record of conception will establish your date of conception and may serve as an invention disclosure. Typically, an invention disclosure is circulated internally within a company when deciding whether to pursue patent or trade secret protection.



WORKING ON YOUR INVENTOR'S NOTEBOOK IN OPEN WATER IS RISKY, BUT THAT DIDN'T DETER ELECTRICAL ENGINEER AND INVENTOR CHARLES STEINMETZ, WHO PATENTED A "SYSTEM OF DISTRIBUTION BY ALTERNATING CURRENT" ON JANUARY 29, 1895.

was not witnessed, and the defendants used an electrostatic test of the sketch to uncover imprints of other sketches made on the same graph pad, but with later signature dates. The court found the patent unenforceable for inequitable conduct.

Following the record of conception, make a record of all activities and communications made while reducing your conceived technology or design to practice. These communications may be conversations or brainstorming sessions with coworkers, subcontractors, vendors, clients, or others. Briefly note with whom you spoke, including contact information and what was discussed. Make detailed notes about anything that may have been contributed to the invention. This information may prove invaluable in determining conception and inventorship. Also, if you must disclose your invention, make sure you have a confidentiality or nondisclosure agreement in place.

Documentation or other items generated while "reducing your invention to practice" need to be entered into your notebook. Such items may include invoices and receipts, photographs, sketches, CAD drawings, e-mail, sticky notes, and other kinds of notes. You may perform lab tests

or experiments during conception of your invention or its reduction to practice. Make sure you record any documentation of testing in your inventor's notebook. State why an experiment was performed, detail the work performed, and include your results or data. Make a brief assessment of what the experiment shows. Make the entry complete so that a third party, skilled in the art, can duplicate the experiment. If a concept or prototype is publically tested, include entries explaining the test, the methods used, results, observations, and your conclusion. Have any participants sign nondisclosure agreements. This entry may serve as a defense to a public disclosure.

If entries can't be made directly in your notebook, attach them to the notebook in some permanent fashion that would likely make it obvious if the document were later removed or replaced. You should also record something about the attached document and draw lines from notes explaining the attached document. Materials too large for the notebook may be entered in an ancillary record with a dated written entry in the notebook describing the material and its location. This may also include software, volumi-

nous data, or other documentation that is impracticable to permanently attach to a page of your notebook.

Managing your design efforts and keeping an inventor's notebook is a lot of work, but proper management of your development activities may serve you well. Currently, the U.S. grants a patent to the first inventors rather than the first to file an application. Therefore, you can use your notebook to "swear behind" references being cited against you during prosecution of your patent, or during an interference proceeding, your notebook can show that you were first to invent. The U.S., however, will likely adopt a first-to-file system in the near future. No, that doesn't mean that your efforts were for naught. Your notebook may still be used to establish inventorship or derivation of your invention by another, provide a basis for the allocation of royalties, provide evidence of a trade secret, or a defend against misappropriation of a trade secret.

*Steve A. Witters, Esq., P.E., is a patent attorney and holds a B.S. in chemical engineering from Ohio State University. He can be reached at [switters@patentlydistinct.com](mailto:switters@patentlydistinct.com).*