



PROTECTING YOUR COMPANY’S ASSETS WITH STRONG AND STRATEGIC INVENTION DISCLOSURE SYSTEMS

by

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The value of your intellectual property may have nothing to do with your patent budget, your IP attorney, or your IP portfolio, but may have everything to do with how your employees document their work and inventions.

Smart and strategic documentation of potentially patentable subject matter can mean the difference between a strong patent or patent family, and patent protection riddled with hidden traps for the unsuspecting company.

These three strategic initiatives will maximize a firm’s patent protection: (a) developing a comprehensive invention disclosure form or system; (b) collecting and archiving supporting documents; and (c) ongoing training of employees on invention disclosure standards and practices.

Invention Disclosure Form: How well your invention is documented can “make or break” your patent protection. The first step is capturing specifics related to the invention on a paper or electronic form that includes title, technical team, problem to be solved, description of the invention, related applications, and references/related articles.

Many invention disclosure forms provide spaces for “inventors,” but this designation may prove problematic. Simply put, inventorship is based on who conceived that invention. Reduction to practice, on its own, is irrelevant. Determining inventorship is a complex legal determination, so asking the technical team to list “inventors” during the disclosure stage is putting the cart before the horse.

The “Problem to Be Solved” and “References/Related Articles” sections allow the technical team to document conventional materials or processes that formed the basis or need for the invention. References and related articles provide information that is useful in both the background section of the patent and in drafting a complete set of claims. Full disclosure, coupled with logical, well-reasoned analysis, is significant in crafting a credible case to the US Patent and Trademark Office (USPTO) for allowance of this patent.

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A clear understanding or “map” of related applications is critical for companies that have mid-size to large patent portfolios. Arguments and documents that are submitted in one patent application may have a direct bearing on another patent application. Conflicting arguments during the prosecution of two patent applications may result in one or both sets of claims being narrowed or invalidated. Incomplete disclosure of relevant art in one application may result in it being challenged in court in view of the other, more complete, application. In addition, the proposed USPTO Patent Rules, currently under consideration by the Federal Court, require related applications to be disclosed to the USPTO.

The Description of the Invention section is an opportunity for the technical team to describe the details of the invention, while at the same time provide additional options or embodiments that can broaden the application.

One note of caution: sample claims should never be prepared as part of the invention disclosure process. First, these claims may, at some point during foreign filing or litigation, be considered what the inventors intended as their invention. Second, why spend thousands of dollars paying patent attorneys to craft broad claims, when that work can be easily undermined by another incomplete claim set? Leave the claims-drafting process to a registered patent attorney or agent who knows how to draft claims that are enforceable against infringers, and may be licensed, sold or used to obtain venture capital.

Supporting Documents, such as notes, employee agreements, journal articles, conventional practices, patent references and drawings, should be included with a disclosure form. Substantive information obtained from notes and drawings helps the patent attorney draft a more complete application.

Employee agreements may be critical if an inventor has left the company and refuses to sign documents. An employee agreement stating that an employee (a) has a duty to sign all patent-related documents and (b) has a duty to assign all inventions conceived of while working for the company can be submitted to the USPTO to prove that the company can continue to prosecute the application without the signature of the non-signing inventor. These agreements should be scanned, archived, or otherwise attached to invention disclosure forms in order to make them readily accessible months or years after the invention disclosure form was first prepared.

Journal articles and references should be included with invention disclosure forms, primarily to save costs. The technical team should have these references on hand when they are working with the invention, and, as time passes, these references may find their way into a pile, the bottom of a file cabinet, or the trash. Those references must be submitted to the USPTO in full form.

Training the technical and sales-and-marketing teams on invention disclosures and related issues will result in complete disclosures and fewer costly mistakes. Sales and marketing teams need to know whether products they are presenting to customers are the subject of an invention disclosure form. The technical team needs to understand how complete invention disclosures contribute to making the patent process more efficient and complete.

What can you do to get started? Contact your patent attorney to discuss developing seminars and handbooks for the invention disclosure process. Update materials as the needs of the company and requirements of the USPTO change. Commit to making intellectual property training a part of your employees' training regimen.