

The Inventor's Notebook - Disclosing and Protecting Your Invention

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There are several reasons to disclose or document your invention. In the US inventions ordinarily "belong" to the first person to conceive of the invention, and disclosure can establish this date of conception. Disclosure may also help an inventor to clarify ideas about the invention and to focus development efforts. Even if an inventor does not intend to patent an invention, the invention should be disclosed; because disclosure may prevent the inventor from paying damages for infringement in the event someone else later patents the invention.

There are several ways in which an invention may be disclosed. The US Patent and Trademark Office (PTO) has a Disclosure Documents Program in which a simple description of the invention and drawings may be filed with the PTO. The DDP only provides a convenient method by which inventors may prove that they filed the documents by a certain day and does not grant any other rights including patent rights. There is also a useless old myth that the best way to disclose an invention is to mail a description of the invention to yourself and then not open the envelope. Most authorities believe that the Inventor's Notebook is by far the best method of disclosure.

The Inventor's Notebook is simply a written, witnessed description of the invention and the activities surrounding the invention. The best notebook is a hard covered notebook, such as a lab notebook, which has pages which are bound and pre-numbered. The notebook should include the following information:

- Title - A short, descriptive name for the invention.
- Inventors - All persons who made significant contributions to the concept of the invention must be included. Do not include persons such financial backers or technicians who only made models or parts and did not contribute significant inventive ideas.
- Date of Conception - Set out the date on which the complete, basic idea for the invention occurred to you. Include a few details which make the information believable. For example, "I got the idea for the No Slide Turkey Platter on Thanksgiving, November 24, 1997, while eating dinner at Uncle Al's. When he tried to carve the turkey it slipped off the platter onto his lap."
- Description of Invention - Write a description of the invention which includes all significant features, but which is as short as possible.
- Drawing - Make as many sketches as necessary to show the invention. Hand drawn sketches are fine. Consider using 3D views, top view, side view, or sectional views. (A sectional view shows what the invention would look like if it were cut along a line and looked at toward the cut.)
- Purpose of Invention - Describe what the invention does as opposed to what it looks like.
- Prior Art - Prior art is a phrase which means other known inventions which are similar to yours. Include a description of any other inventions which are similar to yours and perform a similar function. Also include where you saw these other inventions. For example, "Turkey platter which is item E on page 345 of Summer 1995 JC Penny catalog." Keep a copy of the catalog etc. in the file where you keep

your other invention related material. If you apply for a patent you must tell the PTO about these other inventions and furnish a copy of the catalog page, article, patent, etc. where these inventions are shown.

- Novel Features of Invention - Describe the novel features of your invention. That is, describe everything about your invention which is new and different from the Prior Art.
- Advantages of Invention - Describe the advantages of your invention over the Prior Art. If there is no Prior Art that you know of, describe the advantageous useful functions of your invention.
- Prototype Construction - Describe how and when you make a prototype (version) of your invention. If you buy materials etc. paste the receipt or a copy of the receipt into your notebook and write a description of what the material was used for.
- Testing - Describe any tests which you performed or had performed using your invention.
- Other - Write a description of any other significant events which occur relating to your invention.

Date and sign or initial every entry. Entries should be made at the time the event occurs when possible, but it is okay to refer to past events as long as entries are dated on the date made. Entries probably won't be in the order shown above. For instance, you may have three or four Prior Art sections scattered through the notebook as you discover other inventions. If you already have drawings or other materials prepared, you may make copies (reduced size if necessary) and paste the copies in the notebook. Be sure to enter a written description in the notebook indicating where, when, and by whom the drawings were made. If some necessary items are just too big or bulky to put in the notebook, label them (Exhibit 1 etc.) and make a reference to them in the notebook. For example, "The turkey platter labeled Exhibit 1 is the first prototype I made of my invention. I made it in my garage during the week of January 15, 1997."

Leave about an inch or inch and a half at the bottom of each page. After you get your notebook up to date and periodically thereafter, show your notebook to two people and explain the entries to them. Then have them sign each page on this empty space in the bottom. This signature area should look like this:

Witnessed and understood by:

John Jones

Date

Mary Roe

Date

You should trust the two witnesses and you should be confident that you will be able to locate them for the next few years. Don't use relatives or people who may have a financial interest in the invention.

A Few Pretty Important Things to Remember About Inventions and Patents

1. Inventor's Notebook

Every inventor should start a notebook and write down about everything that happens relating to the invention. Periodically, it should be shown to a couple disinterested witnesses and each page signed by them.

2. Nondisclosure Agreement

In which a second party promises an inventor not to disclose anything about her invention to any third party except for a lot of exceptions. It's better to keep moving forward with invention development than to get nondisclosures signed, if that's the choice.

3. Consultant's Work Agreement

This is an agreement with a third party consultant to provide technical expertise or, perhaps, prototype building for a fee. Among other things, the agreement provides that if the consultant contributes a patentable idea to the invention, he will be listed as an inventor; but will have no ownership interest in the invention or the patent.

4. Agreement to Work in Concert

This is an agreement among joint inventors to determine ahead of time how decisions relating to the handling of the invention or a patent on the invention will be made.

5. One Year Rule

Generally, you have one year from the time an invention goes "on sale" or becomes known to the public to file a patent application or forever lose your patent rights.

6. Patentability Search

A search and attorney's analysis of the search will give a pretty good idea of whether an invention is patentable and should be done early in the process so that time and money aren't wasted.

7. Provisional Patent Application

A provisional application gives you a year in which you can say your invention is patent pending and gives some protection, but the provisional can never result in a patent and lapses at the end of the year if a "regular" utility patent application is not filed.