

Invention Disclosures – What to Capture from the Spark of Invention

by Robert J. Sayre

Whether an idea illuminates the inventor's mind with a flash or with a gradual dawning, the idea, alone, is impermanent, incommunicable and elusive. Consequently, we must call on the inventor to channel that idea and related information into print in the form of an invention disclosure. The inventor's efficiency in doing so can be the difference between (a) securing the protection and profit to which he/she/the institution is entitled under our patent laws and (b) watching that prospective advantage escape or fade away. Accordingly, preparation of an invention disclosure is the first (and one of the most critical) steps toward preserving the rights afforded under our laws.

An invention disclosure serves several purposes. First, it offers a dated proof of conception of the invention as described in the disclosure; in the United States, the date of invention (at least in so far as you can substantiate it) remains a critical determinate in a number of contexts for evaluating priority and prior-art dates. Second, the invention disclosure can be utilized by an institutional patent review committee to make a fully-informed decision as to whether to proceed with a patent application directed to the invention. Third, the invention disclosure can provide the patent attorney with most of the information that he or she needs to define the invention and draft the patent application.

The invention disclosure can be structured using a standard form, though there is no one "best" form for an invention disclosure. The form must balance the criticality of eliciting information from the inventor (who is nearly always the best source of information about the invention) with the importance of not imposing an undue burden on the inventor. The preferred structure of the invention disclosure in any given context will often be a function of the particular technology involved, the character and the particular needs of the institution, and even the particular thought processes of the attorney. As a starting point, however, a generic sample invention disclosure form is attached. As noted, however, there is nothing "magic" about this particular form or any other form, and you may well find that the "ideal" form for you or your institution is a modification thereof.

Whatever form it takes, the invention disclosure should be a fully integrated component of an institution's research and development program. And employees should be encouraged to complete forms early (before any publication or offers for sale) whenever they have an idea, for often the simplest and seemingly most-mundane ideas offer tremendous potential value.

Finally, what goes into an invention disclosure? Here are a number of important ingredients:

- identification of potential inventors with residential address, citizenship, and work contact information (a final determination of inventorship, from a legal standpoint, should be established in consultation with the attorney);
- a description and drawings of the invention (including what you consider to be the "best mode" of practicing the invention) with sufficient details to enable an outsider to fully understand and practice the invention; the description should also point out the novel

features and the advantages associated therewith in comparison with the existing "state of the art";

- a record of dates of conception and reduction to practice;
- identification of previous or planned public disclosures or commercial activity;
- identification of the closest known art (*e.g.*, patents, articles, *etc.*) and the identification of individuals or institutions that should be targeted in a prior-art search;
- identification of any sources of funding (particularly governmental) for the invention; and
- finally, dated signatures from the inventors and two witnesses; the form may also include a concise assignment clause indicating the inventor's assignment of the invention to the institution; though, a separate assignment will be prepared based on the application, as filed, this initial assignment may prove useful if the inventor leaves the company or, for any reason, becomes uncooperative in the future.

A well-prepared invention disclosure converts the elusive spark of invention into a solid and secure anchor for (a) establishing a documented record of the invention, (b) evaluating the invention, and (c) drafting a patent application. And by generating a record of all of this information up front, each of the latter steps toward ultimately obtaining a patent having the greatest possible scope can be performed with greater expediency and efficiency. Accordingly, incorporating the prompt and frequent preparation of well-crafted invention disclosures into the R&D process enables an institution to protect as many ideas as practicable in today's competitive marketplace by helping to ensure that those sparks of invention do not escape only to catch fire with a competitor.

For a complimentary electronic version of the sample Invention Disclosure Form, which is designed to be completed electronically due to space limitations, please contact:

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