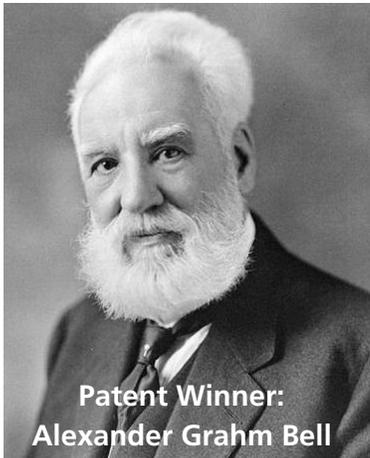




Records Can Win Or Lose Patents

Disputes sometimes arise over who first made an invention. This issue is usually decided on the basis of records kept by the parties to the dispute. But for the lack of witnessed notebooks describing his device, the man known as the inventor of the telephone would have been a talented mechanic named Daniel Drawbaugh. Although Drawbaugh was able to testify that he had talked over a crude telephone long before Alexander Graham Bell filed a patent application in 1875, Drawbaugh had not a scrap of paper dating and describing the invention. The Supreme Court rejected Drawbaugh's claim of prior inventorship in 1888 by a narrow margin of four votes to three. Similar disputes have raged over who invented the automobile, the electric light and the laser and, in all of them, records or the lack thereof played a deciding role.



Patent Winner:
Alexander Graham Bell

As the Drawbaugh case shows, U.S. patent practice places a premium on witnessed records when two or more parties claim the same invention. The date the idea occurred, called conception, and the date it was put into practice form, called reduction to practice, are vital. The U.S. Patent and Trademark Office conducts proceedings, called interference proceedings, to determine who is the first inventor when this is in dispute. Because the first inventor must be able to prove his or her case by means of appropriate evidence, it is important to have good records of conception and reduction to practice, corroborated by witnesses other than inventors.

Equally important to the U.S. Patent Office in such proceedings is the diligence shown by a contending inventor. Diligence refers to work done between the conception and reduction to practice stages of invention. A contending inventor must show work was diligently undertaken on the invention, i.e., the invention was not abandoned. Here too, these efforts should be documented on a day-by-day basis and witnessed by a knowledgeable third party.

The section, "A Fictional Interference Proceeding: The First Inventor May Lose," presents a further example of the importance of recordkeeping

A Fictional Interference Proceeding: The First Inventor May Lose

We describe a fictional interference proceeding to illustrate how important witnessed laboratory records can be.

Inventor "A" ("Andrews") had an excellent idea for an improved building material. After entering the conception in his notebook and having it witnessed, he diligently set about reducing it to practice. After two years of work he made samples of the substance and applied for a U. S. Patent.

Other pressures prevented Andrews from maintaining records on the invention in more than cursory fashion. None of his entries, after the first, was witnessed. This is where Andrews made his big mistake.

Meanwhile, the identical idea had occurred to inventor "B" ("Baker"). She was equally diligent, followed the same trail and created the same material shortly after Andrews. However, Baker filed her U.S. patent application first.



Andrews was placed at a serious disadvantage by this action. To win the patent, he would have to provoke an interference in the Patent Office by copying into his patent application, in exact detail, at least one of Baker's claims for the building materials and then shoulder the entire burden of proving his priority.

Since the materials were the same, there was no trouble in making identical claims. And Andrews did have the idea first: a witness could testify to it and support his statements with the witnessed notebook entry.

"But what proof," the Patent Office asked, "did Andrews have that he had diligently labored to reduce his idea to practice?"

The First Inventor May Lose

Here inventor "A" paid dearly for poor records and lack of witnesses. He could not prove, as the Patent Office demanded, that he had been diligent that he had worked faithfully day in and day out to produce the building material.



Still Andrews had made the new material before Baker, even though his notebook entries weren't witnessed. Could others present in the laboratory on those dates testify in his behalf? Andrews' colleagues, eager to help, did indeed swear they had seen him prepare materials and place them in a molding machine, but they were unable to name the ingredients used or specify what pressures were involved in molding. Andrews had even conducted the strength tests himself, eliminating the possibility of another valuable witness.

Without lifting a finger, Baker won on the basis of her earlier filed patent application. Her earlier filing date was all that was required in the absence of corroborating evidence showing Andrews' diligence and prior reduction to practice.

Had Andrews, our first inventor, maintained adequate, witnessed records to establish his diligence, he would have won the patent, and he might have won even if he had been the last to reduce the invention to practice rather than the first.

The last statement seems paradoxical, but it reflects the intent of U.S. patent laws to recognize the first inventor: the one who originated the idea. Under these laws, the first to conceive and reduce to practice will receive the patent if the records bear out his claims. The first to conceive, even if last to reduce to practice, may win if the records show diligence.

Rules For Recordkeeping

The careful recording of ideas and laboratory activity and data is a matter of routine for industrial researchers. Each entry is often complete and up-to-date, signed and witnessed: a legal record of the day's work. Record keeping is not always so routine for academic investigators, who may work at odd hours or on weekends in a laboratory, an office or at home, often lacking easy accessibility to suitable witnesses. Still, the routine maintenance of a witnessed laboratory notebook is an important task. Additionally such records can serve as valuable repositories of new ideas.

- Ideal practice is to use bound notebooks for records, making entries on a daily basis on consecutively numbered pages. This diary format provides a day-to-day chronology.
- Use the notebook to record a conception (complete description of a means to accomplish a particular purpose or result), laboratory data and drawings. Each entry should be headed with a title and continued on successive pages.
- Make entries in ink and do not erase; draw a line through text or drawings to be deleted and enter the material in corrected form. Draw a line through blank spaces on the page. Do not leave blank pages between entries. You cannot make entries there at a later date.
- Separate sheets and photographs pasted to notebook pages should be referred to in an entry. The pasted items should be initialed in such a way as to connect the pasted material and the notebook page. Material that cannot be incorporated in the notebook should be keyed to an entry.
- Sign and date all entries at the time they are made, and have them signed and dated by a witness. A witness must be someone who has read the material and is capable of understanding it yet had nothing to do with producing it. Secure additional witnesses when something important or highly unusual is discovered.
- Remember that an inventor and co-inventors cannot serve as their own witnesses.
- Set aside a time for making notebook entries and faithfully observe it. Arrange to have two or more colleagues serve as witnesses on a regular basis.



Records, when made routine, take little time and effort, become an invaluable asset to work in progress, and ultimately may protect those rights to which the inventor and the assignee is entitled.