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GETTING AND PROTECTING INTELLECTUAL PROPERTY

CHECKLIST: WHY AND HOW YOU SHOULD DOCUMENT YOUR INVENTION

A True Story

Once upon a time a professor at a small college had advanced students of molecular biology help him with a research project. The professor was working with other scientists at other colleges and universities. He and his group developed a gene therapy that was based on a nonobvious use of a bacterium. The formulation had the potential of changing how certain medical conditions, including infertility, were treated. Many other people—not in the professor's research group—were working on the same idea, and when the professor's group applied for a patent, they discovered that a group of researchers from Australia (who he knew were working on the same problem) had filed their own patent application at about the same time.

Everybody hired lawyers and asked an arbitrator to determine who thought of the idea first. They produced their lab books, and it appeared that the Australians may have been first. But then, quietly, the lawyer representing the college and the professor reached into his briefcase and pulled out a notebook. You see, the professor had come up with the idea while he was teaching a class, and had speculated out loud about it. A student had written it down in her class notes, which were very thorough and detailed for the whole semester, and were dated two years before the Australians. The professor and his group got the patent.

This story wonderfully illustrates why keeping good records must be a priority while you work on your invention. If your patent application is challenged or if you discover someone has infringed on it, good documents may well be the key to winning the dispute.

Here are some more reasons why you should keep records of your progress:

- You will need good records to prove that you are the inventor.
- Good records are an indication that you are careful and methodical about your work; they show you are reliable. Think of them as evidence of your character.
- Good records can help you at income-tax time by establishing deductions for expenses relating to your invention, and to stave off the IRS if you're audited.
- Good records may prove that you had the idea first.
- Good records may prove that you were the first to turn the idea into a physical object or specific process. Patent people call this act a "reduction to practice."
- Good records help establish that your idea is new and original.
- Good records can stimulate creativity and help you analyze your work..

This checklist outlines what you should do to ensure that your invention and your rights in it will be protected.

How to Record Data

- Use a bound lab book. If the book is bound, your opponents will have a hard time arguing that you doctored the records, because it will be handwritten and you cannot insert pages later. If you can't find a lab book, use a bound composition book, which should be available at an office-supply store. (Keep the receipt!)
- Write your name and address on the front cover or flyleaf and the date you began to keep the lab book.
- If the book does not have the pages numbered already, do it yourself.
- If you have a book that does not have signature lines at the bottom of the page for your witnesses, add them. Here's an example of what it might look like:

WITNESSED AND UNDERSTOOD:	WITNESSED AND UNDERSTOOD:
_____	_____
Signature	Signature
_____	_____
Date	Date

- Write each entry *by hand* and *with ink*.
- Date every entry.
- A good practice is to start your day by opening your lab book and writing the date right away, before you start working on your invention.
- Have witnesses sign the entry on the same day as it is written, after it is in fact written.
- If you get behind, say so right up front, and state when the work was actually done. Be candid, like, "I forgot." Then write up your entry.
- Write the way you talk. How would you describe your work that day to a friend? What did you learn? Use short sentences.
- Make rough sketches or diagrams if appropriate.
- Don't leave blank gaps on the page.
- If you want a physical separation between two items, draw a diagonal line or cross through the open space.
- If you like to start each day on a new page, draw a diagonal line or cross through any gap on the previous day's page between the end of your entry to the bottom of the page just before your witnesses' signatures.
- Don't use correction fluid to fix mistakes. Don't use an eraser, either.

- Fix a mistake by drawing a straight line through it and writing a brief note about why the item was incorrect, which you can put in the margin nearby.
- Don't scribble things out with a snarly line or a filled-in block of ink. Use a straight line.
- If you have lots of changes to an entry, or want to update it, don't write them in on the earlier entry. Instead, record them and date them as if you were presenting the information for the first time and cross-reference the earlier entry using the date and page numbers where that earlier entry is.
- Try to record your work directly in your lab book as you go. This will save you the task of transferring data from your rough notes.
- Don't use the lab book as a catch-all for your random thoughts or for every calculation you make.
- Err on the side of completeness.

What to Record

- Your record of invention, that is your initial idea. Here's a suggested format:

Name of Invention: _____

Purpose: _____

Description: _____

Working Sketch or Diagram:

Novel Features: _____

Prior Art: _____

Advantages of Your Invention: _____

Disadvantages: _____

Signature: _____

Date: _____

WITNESSED & UNDERSTOOD

WTNESSED & UNDERSTOOD:

Witness

Witness

Date

Date

- As you develop your idea, record how you did so, that is, what exactly did you do that day to make progress.
 - √ Record how you tested your idea.
 - √ Was your test successful?
 - √ What did you learn or figure out from the test?
 - √ Keep your focus on the facts.
 - √ Don't write conclusions except those that are supported by the facts you have recorded.
 - √ Keep your language objective.
 - √ If you generate other documents, such as recorded print-outs from an experiment that cannot be entered by hand, paste or tape them into the lab book in the entry for that day.
 - However you decide to attach the printouts, make sure that the method is permanent. Stapling them on to a page may not be the best way to go.
 - These other documents should be signed and witnessed as well.
 - When you discuss the print-outs in your entry and include a reference to it so that it ties into your record.

Witnesses

- Find impartial witnesses to sign your book. Don't ask your spouse or best friend. Instead ask a business associate, lab mate, or some professional person with an adequate background to be the witness.
- Find a witness who will be available to you at a later date, just in case you should need testimony to support your claims.
- Don't ask your patent lawyer to be a witness, otherwise he or she will not be permitted to represent you before the PTO. (An attorney cannot be a witness in a case in which he or she also represents one of the parties.)
- Make sure your witness can be trusted with knowledge of your work and not blab it to his or her friends.

- If you work in a technical or scientific field, your witness should have sufficient knowledge to read your entry, understand it, and know whether things are correct.
- Don't have a notary witness your work. A notary's testimony will be limited to the fact that he or she saw you sign the document. You will want a witness who can answer specific and substantive questions about it.

Keeping Secrets

- Take steps to ensure that your work and the contents of your lab book are kept secret.
- Consider obtaining confidentiality agreements for your witnesses. A patent lawyer can draft one for you.
- Add the line "The above information is confidential" just above your witness-signature area where it says "WITNESSED AND UNDERSTOOD."
- Consider locking your lab book in your desk at the end of the day.

The Working File

Use a file folder, the kind that is sealed into a pocket is probably best, to keep things like receipts, correspondence, cancelled checks, and other miscellaneous documents relating to your invention. If the item does not have a date on it, note the date you received it, e.g., "Received on [DATE]."