Invention Disclosure Form: Why Does It Matter?

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One of the first things patent attorneys will do, when you speak with them about filing a patent application, is send you an invention disclosure form to be filled out. Many companies also complete invention disclosure forms as a step in their internal processes for determining which inventions to try to patent. A good invention disclosure form asks for a lot of information, and sometimes busy inventors skip sections or just do not or practically cannot take enough time to ensure that the information they fill in is complete. Unfortunately, missing or inaccurate information can create problems, ranging from minor items requiring follow-up or correction, to more significant issues that can, in a worst case scenario, potentially put the validity of a resulting patent at risk.

The goal of this article is to review the standard sections of an invention disclosure form and explain why these sections are important.

Description of the Invention

The primary purposes of an invention disclosure form are to provide sufficient information to permit (1) business persons or other decisionmakers to assess whether the invention in question has merit, and (2) patent attorneys to write a solid patent application concerning the invention.

Invention disclosure forms usually have questions about the background state of the art, the problem that prompted the invention, and the solution and benefits provided by the invention. The answers to these types of questions are useful to both business persons and patent attorneys.

Invention disclosure forms usually have questions about the specifics of the invention, such as a basic description, identification of which aspects are necessary and which are optional, whether there are any prototypes, whether any testing has been done, and what variations can be made. These types of questions are aimed at addressing legal requirements and best practices for patent drafting, such as:

- *Enablement* – describing the invention in sufficient detail so that one of ordinary skill in the art can make and use the invention.
    - While actual reduction to practice is not required, being able to describe an existing prototype and data demonstrating that it works is a solid

foundation.

- *Written Description* – every structural element of the invention that is in the claims should be shown in a figure and described in the application with a reference number.
    - The saying that a picture is worth a thousand words is often true with respect to a patent application. It is essential to include drawings of the invention and a part-by-part, step-by-step walk through of the key components and functionality.
- *Distinguishing From Prior Art* – The specification--or descriptive portion of a patent application is essentially written in stone once the application is filed; however, the claims can be amended with any information included in that specification. Therefore it is important to put as much information relevant to the invention as possible into the specification. Evaluation of a patent application by a Patent Examiner includes a search for prior art, including patents and published patent applications. Although a prior art search can be performed before a patent application is filed, a Patent Examiner often will find references that were not identified in such a search. Accordingly, the ability to add information from the specification into the claims is often a key to obtaining allowance of a patent application. While it is a reality that there is often a good deal of information that is included in a patent application that never is claimed (or commercialized), it is typically difficult to determine prior to the filing of a patent application which information may be most helpful for distinguishing the invention from the prior art and achieving allowance, and so generally it is beneficial to include more descriptive information rather than less.
- *Covering Foreseeable Design Arounds* – Many with knowledge on the subject will say that the most commercially valuable patent claims cover at least the patent owner's commercial product, and preferably block competitors from being able to make easy design arounds as well. While competitors may not come up with the invention themselves, they often find ways to make a variation once the invention is commercialized. Envisioning those variations and covering them in the patent application results in a stronger patent.

Inventorship and Ownership

The inventors listed in a patent application are the starting point for determining ownership. Each inventor is an equal owner, with no obligation to the other owners. Given this to be the case, when people or companies collaborate or involve an independent contractor in development, there arises a significant risk of ownership disputes. Early identification of potential issues allows for early resolution. Additionally, getting the inventorship wrong on a patent may result in the patent being unenforceable.

In view of these concerns, invention disclosure forms typically ask that everyone who contributed to the invention--including all individuals involved in discovering, developing, testing, or analyzing any aspect of the invention—be

identified. Preferably, the invention disclosure form also asks whether those individuals are employees or external parties, such as independent contractors, and what roles those individuals played with respect to the invention. Having this information early on in the process identifies the group of potential inventors and any potential ownership issues that need to be resolved. Whether any given individual identified on the invention disclosure form qualifies as an inventor is a legal determination made by the patent attorney, based on who conceived of the subject matter included in the claims of the patent application that is ultimately filed regarding the invention.

Status With Respect To Commercial Development

Invention disclosure forms should have questions asking about the current status of commercial development and any disclosure events that may have occurred regarding the invention--where such disclosure events can include not merely non-confidential or public disclosures but also other types of events such as the publication, sale, or offer for sale of the invention. Different countries have different laws with respect to when one needs to file a patent application relative to the times of any disclosure events concerning an invention, so as to avoid a loss of patent rights. While the United States generally provides a "grace period" or a "window" of time by which a patent application must be filed after a disclosure event occurs, other jurisdictions can be and often are less forgiving, as some offer no grace period at all. Accordingly, the invention disclosure form should be completed to provide all important dates (both past and upcoming) so that any potential deadlines can be identified by the patent attorney.

While the actual filing date of a patent application is a date that governs much of the patentability analysis during examination by the USPTO, an invention disclosure form should also capture information regarding the dates and circumstances relating to conception of the invention, as well as efforts to reduce the invention to practice. It is important to keep in mind that the patent offices of the countries around the world generally do not investigate information surrounding public disclosures, such as those made by inventors, when examining patent applications. Instead, this is an issue that typically arises and is scrutinized as part of a litigation process when, down the road (often many years later), a granted patent is being enforced. Such investigations can be very costly, and it can be especially unsettling to learn that a given patent application was filed in violation of a country's timing requirements, resulting in the likely or actual invalidation of the patent. Thus, identifying the dates associated with any public disclosures or other disclosure events and including that information on an invention disclosure form is essential, as this information allows for a determination to be made as to when a patent application should be filed so as to best preserve and protect patent rights.

Prior Art

Invention disclosure forms should inquire about any known previous work related to the technology of the invention, or other solutions to the same or very similar problems, as well as whether any patentability search has been conducted. Invention disclosure forms may also ask about whether any licensed technology is incorporated into or is otherwise necessary to use the invention. While the answer to such questions may have a bearing on inventorship and ownership issues, it can also reveal relevant prior art.

There is no requirement to conduct a patentability search prior to filing a patent application. However, the United States and some other countries do have a duty of disclosure, in essence requiring submission of art known to the inventors and others involved with the pursuit of patents to the respective patent offices. A failure to disclose known prior art during examination of a patent application can result in the unenforceability of any patent granted based upon that application (e.g., due to inequitable conduct). Patent attorneys will stress the importance of identifying known prior art throughout the process of pursuing a patent, from invention disclosure form submission, through and until a patent is granted.

Conclusion

An invention disclosure form can be an invaluable resource for companies that have inventions they want to protect. The invention disclosure form should be readily available to inventors (e.g., placed on a company intranet) and, when completed, reviewed to ensure that the information provided is thorough and accurate. Armed with this information, a business person or other decisionmaker, guided by a patent attorney, can make informed decisions about whether and, if so, how and when a patent application should be filed to pursue patent protection on an invention. Companies with innovations would be well-served to ask – where is our invention disclosure form and are we using it effectively to capture innovations and maximize our competitive advantage?