

## FOCUS ON... → INTELLECTUAL PROPERTY ←

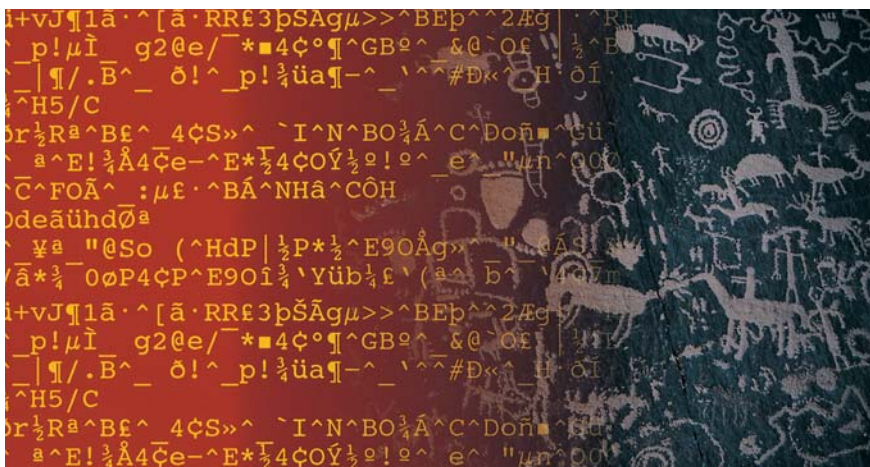
# How To Prove When You Made Your Invention

by Michael B. Harlin

**H**ey, I thought of that first! Lots of people say that when they first hear about a new invention. For the average person, that's probably the end of it. In the business world, however, that may be just the beginning, because the success of many companies depends on their ability to generate inventions, turn them into products, and protect their intellectual property. If you really made the invention first, the consequences for your company may be enormous. For that reason, proving when you made your invention may be a key to your company's competitive edge. Although you might think it is as simple as pulling out an old laboratory notebook, far more may be required.

### WHY ARE INVENTION DATES IMPORTANT?

The stakes can be enormous because invention dates can determine who is (or is not) entitled to a patent. If your competitor gets a patent on an important invention, your company may be at a big disadvantage and could even be prevented from selling its product. Alternatively, if you are an inventor named on a patent, but a competitor proves it made the invention first, then your



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company could lose the patent and the competitor can copy your product.

In the United States, you may need proof of your invention date for proceedings before a federal court or the US Patent and Trademark Office (USPTO). Hopefully, the court or USPTO will decide you made your invention first, and therefore you should get a patent and your competitor should not have one. Proving your invention date sounds simple. Perhaps you have an old laboratory notebook showing when you thought of the invention. But that lab notebook is not enough. You will probably have to tell (and prove) the full story surrounding your invention, using witnesses and documents to prove the relevant facts.

### WHAT DO YOU NEED TO PROVE?

Under US patent law, proving your invention includes proof of several events and activities, including your *conception* and *reduction to practice*. Conception is the mental part of inventing: having the idea. Reduction to practice is the physical part: building the invention. You may also need to prove that you exercised *diligence* between your conception and reduction to practice. Also, you must not have "abandoned, suppressed or concealed" your invention after the reduction to practice. Finally, your testimony and documents regarding your invention must be *corroborated*.

**Conception** is defined as the formation, in the mind of an inventor, of a definite and permanent idea of the complete and operative invention (as defined

by the patent claim). Although conception is a mental act, you cannot prove your conception if you kept the invention locked away in your head. Accordingly, your proof of conception must include proof that you told someone else about your invention.

Conception requires that you know how to make and use your invention. In chemical and biotech cases, those are often crucial issues. For example, you do not have a completed conception if you imagine the structure of a new compound but do not know how to make it. You also do not have a conception if you synthesize a new compound but do not find out what you made. If your invention is a new compound, you must know its structure and how to make it. If your invention is a DNA sequence (such as a gene or restriction fragment), then you must know the sequence itself (as well as how to make it), not just the function or the encoded protein for that sequence.

**Reduction to practice** is defined as constructing an embodiment or performing a process that meets a patent claim. Reduction to practice also requires that you know your invention works for its intended purpose. As a result, reduction to practice may require testing, and the test results must be reported back to you. If you request testing to determine chemical composition or another property but never learn the results, you do not have a reduction to practice. You have only a guess at something that might be useful. Therefore, you may need spectrographic, chromatographic, or other analyses or sequencing results and functional assays to complete your reduction to practice. It is perfectly acceptable (and frequently desirable) for testing, analyses, and/or assays to be done by others on your behalf.

**Diligence** becomes a factor if you were the first to conceive the invention, but your competitor reduced it to practice before you did. Under those circumstances, you must show that you exercised



diligence in making your reduction to practice. If you are able to prove diligence, your conception date (or the date you started acting with diligence) will be your invention date. If you cannot prove diligence, then the date of your reduction to practice will be your invention date.

Diligence means reasonably continuous activity toward making your reduction to practice of the invention. Although courts have said that diligence does not require constant activity on the invention, the acceptable excuses for taking a day off are very limited. Vacations and sick days do not negate diligence, but work on other projects probably does. If you plan to show diligence, you should plan on accounting for your activities day by day.

#### **WHY DO YOU NEED CORROBORATION?**

*Corroboration* is independent evidence that supports your testimony about conception, reduction to practice, and diligence. The corroboration requirement makes it very challenging to prove your invention date. Corroboration must come from witnesses other than the inventor or from documents that were seen or created by persons other than the inventor.

The corroboration requirement is somewhat unusual; in most other cases (criminal and civil), a witness gives his testimony, and the jury or judge decides whether to believe him. In contrast, an inventor's

testimony, by itself, is legally insufficient to prove his case. If an inventor does not have any corroborating witnesses or evidence, he will definitely lose his case.

You may feel insulted when learning of the corroboration requirement. After all, how could it be that an accused murderer or thief does not need corroboration for his testimony, but a Nobel-Prize winning inventor does? Why should your testimony be treated with suspicion?

The answer is that judges recognized long ago that it's too easy to say "I thought of that first" after another person has already gone to the effort of making a product or obtaining a patent. Lots of people say, "Hey, I thought of that first!" But most of them fail to do anything with their ideas. Our patent system seeks to reward inventors not only because they were first, but also because they did something with their ideas.

The corroboration requirement reflects judges' experience and intuition that patents should not be invalidated merely on a competing inventor's oral testimony. Even if the competing inventor-witness is not acting in bad faith, her memory may be blurry from the passage of time and unintentionally skewed in her favor. Moreover, some inventor-witnesses have engaged in fraud to establish an earlier invention date. Finally, there is a general, impersonal suspicion of oral testimony, as reflected in the US Supreme Court decision from 1892 that refused to invalidate a patent on barbed wire, even though 24 witnesses testified that someone else had created barbed wire before the patent's filing date.

#### **WHO CAN HELP PROVE WHEN YOU MADE YOUR INVENTION?**

To overcome this suspicion and satisfy the corroboration requirement, you will need to get other people involved in proving your invention date as corroborating witnesses or sources of documentary evidence. The corroborating witness must have understood the invention



**The corroborating witness must have understood the invention at the time the invention was disclosed to him or her. It is INSUFFICIENT for the witness to have scribbled a signature on a page without taking the time to read and understand the invention or to understand it only in time to testify in court.**

*at the time the invention was disclosed to him or her.* It is insufficient for the witness to have scribbled a signature on a page without taking the time to read and understand the invention. It is also insufficient if the witness only understands the invention in time to testify in court.

The corroborating witness may have actually observed your laboratory work. Ideally, this will be “over the shoulder” observation; for example, if you demonstrated your new process to your colleague, explaining the steps as you went along. Alternatively, the corroborating witness may have carried out a portion of an inventive method or performed testing needed to see if the invention worked. For example, you may have directed your lab technician to perform a reaction to make a new compound. However, “over the shoulder” observation or direct participation is not required; the corroborating witness may have merely reviewed the analytical data or signed your lab notebook. Even that is valuable because corroboration of your documents is also needed.

Diligence may be the most difficult aspect of invention to corroborate. Corroborating witnesses may need to testify about your almost-daily activity on the invention. Corroboration of diligence might come from your supervisor’s testimony about your assignments or your spouse’s testimony about your single-minded devotion to your invention.

#### **WHAT DOCUMENTS ARE USEFUL?**

You should consult other people to find documents that prove when you made your invention. Your supervisors, subordinates, co-workers, and even colleagues outside your company may have documents relevant to your invention. You should think expansively and imaginatively when looking for and asking for documents. Something as small as a sticky note with reaction instructions may be evidence of a reduction to practice. Administrative personnel may keep central files of various reports relating to your invention, and human resources personnel probably have records of your vacation and sick days. On a more informal level, you can turn to known “pack-rats” whose offices are overflowing with paper; they may have saved documents from years earlier regarding your invention. Finally, information technology personnel may be able to resurrect electronic documents that you thought were deleted.

Laboratory notebooks are generally the first place to look when searching for evidence of your invention. They are frequently the best evidence of what an inventor in the chemical or biotech field has done on a particular date. However, the joy of finding your invention described on an old notebook page may turn to disappointment if that laboratory notebook page was not signed by a witness. (Though it’s common for witnesses to sign months of notebook pages in one sitting, a much better practice is for co-workers to make it a habit to

read, discuss, and sign each other’s notebooks every day or so.)

Evidence of conception may come from invention disclosure records, drawings, models, and emails (printed or still on the computer). Perhaps the best documentary evidence for corroborating conception would be replies to an inventor’s emails and reports in which he has described his invention. If a corroborating witness replied and discussed the invention, her reply can show that she understood it.

Evidence of reduction to practice may come in many different forms. Indeed, the reduction to practice may still exist: A sample of a novel chemical compound may still be in your lab. Other evidence may be photographs or videotapes that show the reduction to practice. More commonly, though, evidence of the reduction to practice will be in documentary form. Reports, memoranda, and emails describing the reduction to practice are frequently used as evidence. Analytical results are often necessary to confirm what products were made or that a process was successful.

Evidence of diligence usually comes from your notebooks and those of your assistant or technician. Your daily planner or computer calendar may also be relevant evidence because diligence requires almost-daily effort on the invention or a suitable excuse, such as a sick day or a vacation. You may be able to establish your activities for a given period by collecting the emails you sent and received. General reports may also be relevant to establish diligence. For example, a report may indicate that your primary (or only) assignment or responsibility during the relevant period was working on the invention.

**Circumstantial evidence** may also be useful in proving your invention. For example, if you bought certain starting reagents to make a novel compound, the sales records for those reagents could provide relevant evidence of the conception

and reduction to practice. Even though the sales records do not explicitly show that the compound was made, they provide evidence that you purchased those reagents by a specific date. Circumstantial evidence may be especially important if there is not a perfect witness or document that shows every aspect of the invention. As in a good courtroom drama, evidence that initially seems disconnected can lead the jury to an inescapable conclusion: that you made the invention first.

Other sources of evidence are reports to supervisors or other groups, journal articles or drafts of those articles, patent applications and drafts, plant production records (including pilot plants), and sales records for the commercial product based on your invention. Also, you should make the trek to off-site storage if some of your oldest documents may be there. Emails and voicemails also make useful records.

### **CAN ELECTRONIC RECORDS BE USED?**

Electronic records are more difficult to get admitted into evidence than paper records that are handwritten, dated, and witnessed. Information technology personnel will probably have to testify about these records. With electronic records, the exact dates of creation or alteration must be proven. For example, the “last saved on” date may be established as being accurate and reliable. As a general practice, it is wise to avoid using the auto-date feature; you will be greatly disheartened when an important electronic record from several years ago shows today’s date when it is opened.

Electronic records may be found on floppy disks, hard drives, servers, and backup tapes. Many companies take “snap shots” of their computer systems that show what documents were on the system on that date. Furthermore, documents that were made but deleted might be resurrected from the system.

### **WHAT ELSE CAN YOU DO?**

Finally, a few general steps you can take will increase your chances of successfully proving your invention date. You should find as much evidence as you can, even if it is repetitive, and give all that evidence to your attorney. Do your best to find everything on the first search. If you find documents too late in the proceedings, the court or USPTO may refuse to admit them into evidence.

If your evidence of invention refers to something else, you should get that as well. For example, you may wish to get ASTM standards showing how tests were done or notebooks showing the preparation of your starting materials. Finally, you should find any records that tie your story together, such as your initial research proposal or a memo from your supervisor that assigned your research activities.

### **GATHER THE PROOF**

Proving your invention date in court or to the USPTO takes much more than saying, “I thought of that first,” and it takes more than finding an old lab notebook. You will need corroborating witnesses and documents to establish your conception, reduction to practice, and perhaps diligence. You should think expansively and imaginatively in looking for evidence, talking to lots of witnesses, and finding all the relevant documents. Like the hero of a courtroom drama, you can use all the crucial evidence to prove your story — and prove that you made the invention first. 🌐

*Michael B. Harlin is a partner at McAndrews, Held & Malloy, Ltd., 500 W. Madison Street Suite 3400, Chicago, IL 60661, 1-312-775-8000, fax 1-312-775-8100, mharlin@mhmlaw.com.*