



IP: The Notebook, end of a love story?

3 REASONS TO BE DILIGENT WITH WITNESSING NOTEBOOKS POST AIA

It has always been important to keep thorough records of conception and reduction to practice of an invention in case of an interference between two patents or to antedate a prior art reference, usually accomplished by signing and witnessing laboratory notebooks. Despite widespread sentiment, after the new patent rules take effect under the America Invents Act (AIA), the practice will still be relevant in derivation proceedings or antedating certain prior art.

On March 16, patent law in the U.S. undergoes a sea change, from a “first to invent” to a “first inventor to file” system, which also ushers in new rules for resolving a dispute over who is the true inventor of the claimed subject matter. For an application filed prior to March 16, if two applicants claim the same invention, 35 U.S.C. §102(g) of the patent statute requires demonstration of

conception of the invention and diligence toward reduction to practice of one applicant prior to conception/reduction to practice by the other applicant. For claims with priority on or after March 16, the first entity to file a patent application is assumed to be the first to invent, and §102(g) is not available for proving invention prior to the filing date.

Exceptions: As with any rule, there are always exceptions. Consider the following, Inventor A files Application A before Inventor B files Application B. Under the “first inventor to file” system, on or after March 16, Inventor B with later-filed Application B can initiate a derivation proceeding to try to prove that Inventor A, having Application A claiming the same invention as Application B, “derived” the invention from Inventor B. Derivation proceedings were created to ensure that the first

person to file the application is actually a true inventor (Federal Register, Vol. 77, No. 28, 2010). Under amended 35 U.S.C. §135, a petition to initiate a derivation proceeding must be filed within one year of the first publication of a claim to an invention that is the same/substantially the same as the earlier application’s claim, and show that Inventor A derived the invention from Inventor B without authorization.

Consider, Inventor B (petitioner) initiates a derivation proceeding against Inventor A (respondent).

Requirements for the Petition: Without case precedent or specific guidance to on which to rely, the U.S. Patent & Trademark Office has provided rough guidelines as to the content of the petition. Among other things, Inventor B must show that at least one claim in Inventor A’s application is the

same/substantially the same as the invention disclosed to Inventor A and show what was disclosed to Inventor A is what is claimed by Inventor A. The petition must demonstrate that Inventor B, the alleged deriver, did not authorize the filing of the earlier application. A derivation showing is not sufficient unless it is supported by substantial evidence and at least one affidavit addressing communication of the derived invention and lack of authorization. The showing of communication must be corroborated (37 C.F.R. §42.405(a-c)). Other than the affidavit, the “evidence” submitted is up to the parties involved.

Signed, Sealed, Delivered: It has been posed that witnessing lab notebooks (physical or electronic) will become passé under these new rules. Even without §102(g), the benefit of documenting and witnessing data and concepts should not disappear. There are several reasons why the practice should continue.

1. Collaborations: Many ideas and inventions result from collaboration between two entities. Even with an agreement detailing how to handle IP arising from the collaboration, there is the possibility that each party in the collaboration

may independently file an application and omit the other party. Having signed and witnessed lab notebooks that detail the ideas and concepts behind the invention, who carried out the experiments and when they were performed can be important in an affidavit by Inventor B alleging derivation. The communication of the idea to Inventor A must be corroborated, and a signed and witnessed notebook may help satisfy the corroboration requirement. Witnessing documents may also obviate the need to use declarations to authenticate documentary evidence (e.g., similar to the Federal Rules of Evidence) in derivation proceedings, especially if an inventor is unavailable to sign an affidavit.

2. Competitors: While it is possible that two competitors independently invent substantially similar inventions, it is also possible that one competitor derived the invention from the other. In this era of public conference talks, posters, emails and blogs, recording who the inventor talked to, about what and when will be important to establish conception and

communication of the invention. Whether a party is Inventor A or Inventor B in a proceeding, having documented information that was clearly recorded and witnessed by a third party may be an important part of the “substantial evidence” and “corroboration” required by the Board of Patent Appeals in deciding the outcome of a derivation proceeding.

Further, the burden of proof lies with the petitioner for a derivation proceeding and discovery and subpoena power are not available. Presenting witnessed lab notebooks eliminates questions of authenticity and places the evidence in a better light, likely necessitating equally thorough records from the respondent.

3. Pre-filing Disclosures: Under the new rules, an applicant can file a patent application within one year of their own disclosure, e.g., by publication or a public presentation, and the own disclosure is not considered prior art in the U.S. Methodical record keeping may help establish invention prior to disclosure by an unauthorized publication

by a collaborator within the one-year grace period under the AIA. Additionally, recording dates and places of posters and talks by inventors may help pre-date any disclosure of similar information by a competitor such that the competitor's disclosure can be eliminated as prior art in the U.S., and applicant's application filed within one year of the inventor's first disclosure.

In sum, the advent of the new patent rules could require more, not less, meticulous recordkeeping to ensure documentation of the who, what, why and how around an invention.

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