

Keeping Notebooks

This sheet explains one important difference between patent law in the United States and most other countries, and how European-based applicants can use this difference in obtaining patents in the USA. In particular, it can be important to prove the date on which an invention was made, and the keeping of good laboratory notebooks is essential for this purpose. This sheet aims to give guidance on how such notebooks should be kept.

The United States is a first-to-invent country

In most countries, e.g. UK and Europe, if two parties file patent applications for roughly the same or similar inventions, the party whose patent application was filed first will take precedence. In contrast, the USA has a “first-to-invent” system for deciding who is entitled to a patent, i.e. even if one party filed first, they may not take precedence if they were not the first to make their invention.

There can therefore be two situations in which it can be advantageous to you to be able to prove your date of invention for the USA.

- 1 Firstly, if you can prove that you made your invention before someone else, even if you filed your application later than them, then you may be entitled to the patent over them (assuming of course that the invention itself is patentable). The legal procedure to decide who was first to invent in a case of conflict is called an “interference”.
- 2 Secondly, if you can prove that you have a date of invention earlier than the date of someone else’s publication, then you may be able to ignore that publication as “prior art”, provided that publication was not more than a year before your US application filing date. This is called “swearing behind” a prior art document.

In either case, proving a date of invention relies on using the inventor’s records (e.g. laboratory notebooks) describing the work leading up to making the invention. It is therefore important to keep these records in a form that is acceptable to the United States Patent and Trademark Office or courts.

In which countries can the work to prove a date of invention be carried out?

From 1 January 1996, applicants from the UK and all countries which are members of the World Trade Organisation (WTO) can rely on evidence to prove that they made the invention at a date earlier than the date of their US patent application.

Before 1 January 1996, only activities in the USA and ‘NAFTA’ countries (Canada, Mexico) could be used to prove an earlier date of invention.

What constitutes making an invention?

In this discussion, it is important to understand what legally constitutes making an invention. There are two components to making an invention; its “conception” and its “reduction to practice”. Only when both conception and reduction to practice have occurred can a date of invention be recognised.

“Conception” takes place when the inventor has a definite and permanent idea of the complete and operable invention, but has not made a working model or demonstrated that the invention works.

“Reduction to practice” is when the invention is shown to work and may be “actual” or “constructive”. Actual reduction to practice is, for example, when a working model is made and a practical utility demonstrated. Alternatively, an invention is deemed to have been “constructively reduced to practice” when a patent application is filed.

Where two parties make the same invention, it is the timing of their respective dates of conception and reduction to practice which decides who will be granted a US patent.

Why keep notebooks?

The problem then is how to prove when conception and reduction to practice took place. This is where records such as laboratory or workshop notebooks are important as they can provide documentary evidence on when an invention was made. The standard of proof required is that there is more than a “preponderance” of evidence, i.e. “more likely than not”.

What form should the notebook have?

In order to be useful evidence, laboratory notebooks:

- must provide a record of the facts;
- must be legible and comprehensible;
- must be in a form, and the circumstances should be such, that the document will be considered to be authentic and accurate.

Ultimately, the weight which can be given to the notebook as evidence will depend on how likely it seems that the contents are authentic and can be awarded the date alleged to be the date of entry.

Thus, in an ideal world:

- a permanent, bound notebook is best;
- details of the work should be given;
- dates should be given – of ideas, when work was started, when results were achieved;
- the signature of the writer should ideally appear on every page;
- the “corroboration rule” should be followed (see below);
- methodical entry facilitates recollection and allows the writer to be confident of accuracy when giving evidence many years later;
- extrinsic materials (gels, charts, etc.) should be attached permanently and the writer should sign across the join between the material stuck in and the underlying page;
- ink should be used, preferably one colour;
- corrections should be signed;
- a line should be drawn through intentional blank spaces;
- facts should be recorded – impressions are less important and could in fact be damaging; words like “obvious” should be avoided.

This may seem a great deal of effort as compared to your usual practice, but it is important to remember that patent rights are valuable and this is a way to help safeguarding those rights in one of the most important markets in the world.

The importance of independent verification – what does the corroboration rule mean?

One of the most important things that you can do to increase the importance which will be attached to your notebooks is to have someone other than the author periodically read the notebooks and sign them to indicate that they have read and understood the contents. The reason for this is that recorded information only takes the date of its corroboration by someone who is not an inventor but who is able to understand the information. This might be a scientist, technician or supervisor, and should preferably be someone working on another project to avoid the possibility of the corroborating witness turning out to be an inventor.

It is important that pages are counter-signed and dated by the witness to indicate that the information has been read and understood, with as little delay as possible. The longer the delay between recordal and corroboration, the later the date will be which can be awarded to the information. Our suggestion is that this should preferably be done weekly, or at least monthly.

Obviously, what is presented above may be unrealistic to implement in certain laboratories. However, some of the steps should be rather simple to implement and will increase the likelihood of your being able to prove a date of invention which is earlier than your US application filing date, or priority date.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

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LONDON
York House
23 Kingsway
London WC2B 6HP
Tel: 020 7240 4405
Fax: 020 7240 9339

BRISTOL
22-24 Queen Square
Bristol
BS1 4ND
Tel: 0117 945 1234
Fax: 0117 926 5692

MANCHESTER
Bridgewater House
Whitworth Street
Manchester M1 6LT
Tel: 0161 247 7722
Fax: 0161 247 7766

CAMBRIDGE
Newnham House
Cambridge Business Park
Cambridge CB4 0WZ
Tel: 01223 420383
Fax: 01223 423792