From Bench to Invention Disclosure

A Practical Primer for Inventors and R&D Managers

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Goals

Identify and Protect Inventions

Reward
Inventors
University
Investors
Community
Identifying the Invention: What is Patentable?

**YES:**
- useful things
- methods of making
- methods of use

**NO:**
- laws of nature
- “abstract ideas”
- mathematical formula

- novel
- non-obvious
- enabled
- “described/possessed”
Identifying Inventions: Economic Drivers

- Faster/better than competition?
- Licensed by a company?
- Build a new business?

**Bottom-line**
Prepare an invention disclosure
Invention Timeline

Conception

Constructive
Reduction to
Practice

Actual
Reduction to
Practice

• A “definite and permanent idea of the complete and operative invention”

• Must enable others to make and use

• Must be recognized and appreciated
Invention Timeline

- Conception
- Constructive Reduction to Practice
  - prophetic example
  - Use future tense
- Actual Reduction to Practice
  - working example
  - Use past tense
Establish the Conception Date

Conception Date Critical

- Keep bound Lab and “Concept” notebooks
- Write up a complete description
- Sign and date your entries
- Have a “witness” read, sign, and date

Also Established by Proper Invention Disclosure
Establish the Conception Date

An ideal notebook witness
- understands the technology
- is under confidentiality
- is not a co-inventor
- available for subsequent testimony

Also Established by Proper Invention Disclosure
Document Path from Conception to Reduction to Practice

- Sign, date, and witness notebooks
- When an experiment fails...
  - DO: Explain
  - why it might have failed
  - what you can do to make it work

DON’T: Over-generalize
  “this idea won’t work”
  “we’re abandoning this”
Using Electronic Records

Be careful!
- Patent related case law scarce

Consider evidentiary requirements
- Use an electronic data custodian
- Use digital signatures (inventor and witness) that:
  - are authentic (identity of signer established)
  - have integrity (no post signing alterations)
  - can’t be repudiated (can’t deny signing)

- www.safe-biopharma.org
Actual Reduction to Practice: It Works!

• Record/sign/date notebooks ASAP
• Witness notebooks ASAP
• Tell technology transfer
• Don’t tell anyone not under confidentiality
Preparing the Invention Disclosure

Conception
Best time to prepare invention disclosure

Constructive Reduction to Practice
Next best time to prepare invention disclosure

Actual Reduction to Practice
Better late than never!
Preparing the Invention Disclosure

Tell All!

• What invention is, how to make it & how to use it
• Variations of the invention
• Publication/ public disclosure plans
• Competing technologies
• Potential licensees or commercial options
Preparing the Invention Disclosure

“Prior Art”

**DO:**
- Provide a list
- Consider patent and non-patent literature

**DO NOT:**
- Characterize your list

“This made it obvious that…”
“Based on this paper, anyone could…”
Summary

• Is it patentable? Is it worth patenting?
  ➢ Ask tech transfer, patent counsel

• Document conception, constructive, and actual reduction to practice

• Complete the Invention Disclosure Form
University of Missouri
Office of Technology Management and Industry Relations