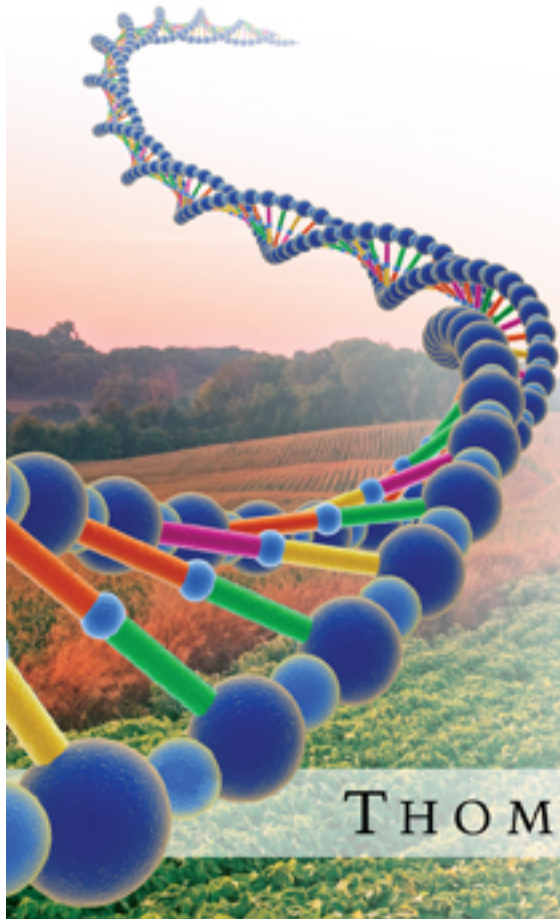


From Bench to Invention Disclosure

A Practical Primer for
Inventors and R&D Managers

Charles Romano, PhD
Senior Patent Agent

THOMPSON COBURN LLP



Goals

Identify and Protect Inventions

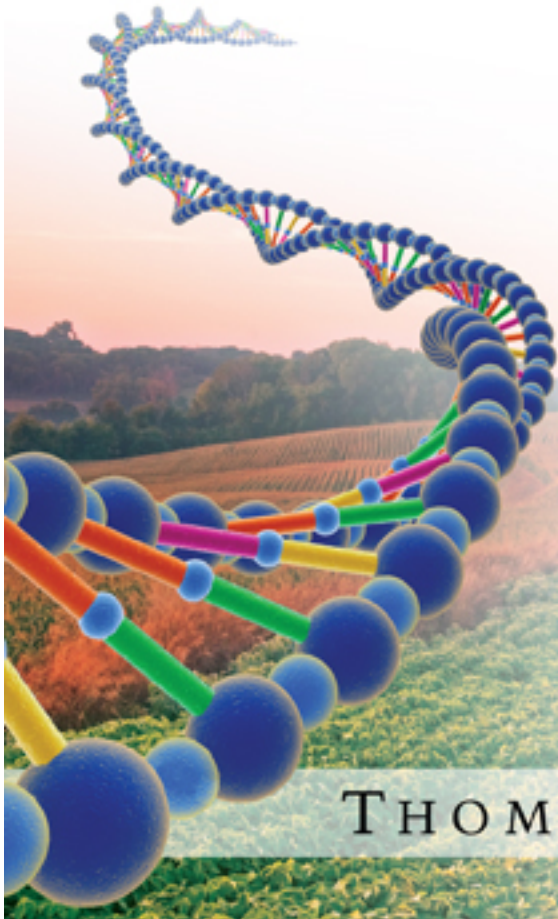
Reward

Inventors

University

Investors

Community



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Identifying the Invention: What is Patentable?

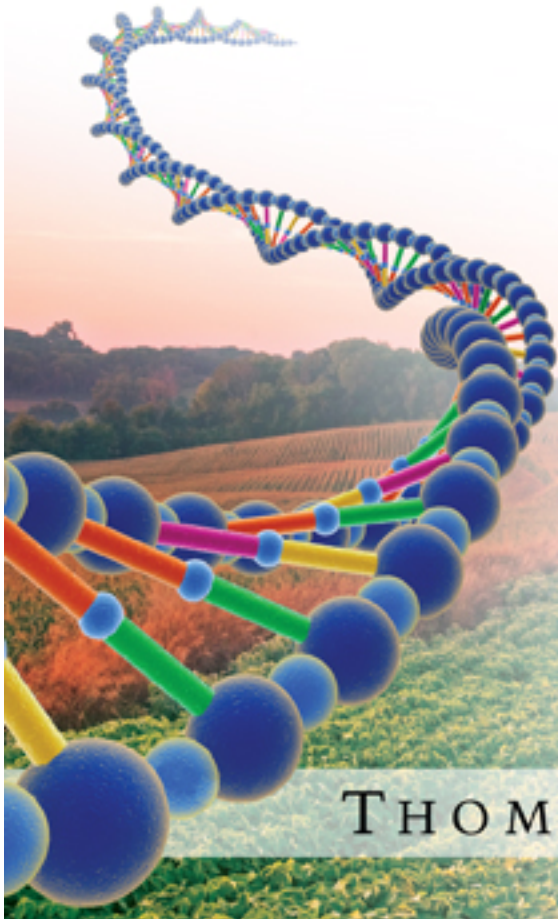
YES:

useful things
methods of making
methods of use

- novel
- non-obvious
- enabled
- “described/
possessed”

NO:

laws of nature
“abstract ideas”
mathematical formula



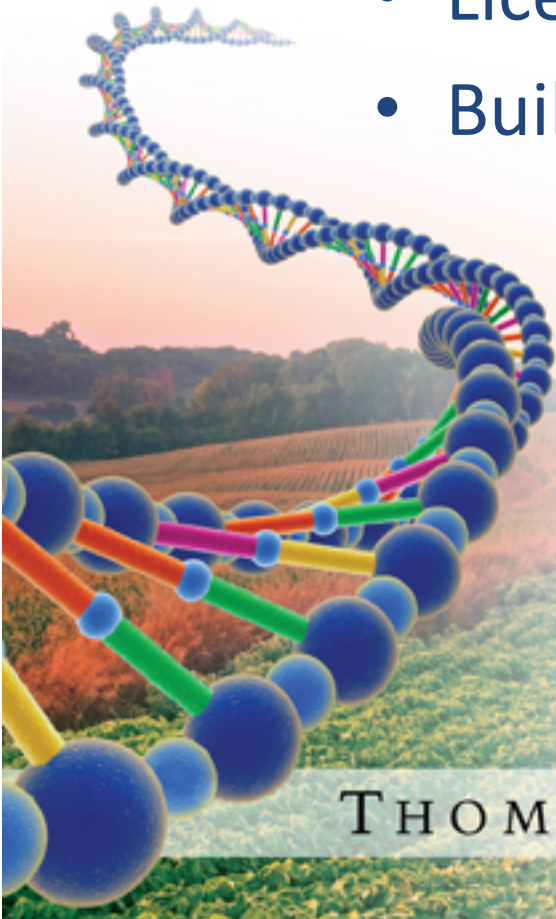
Identifying Inventions: Economic Drivers

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

Bottom-line

Prepare an invention disclosure

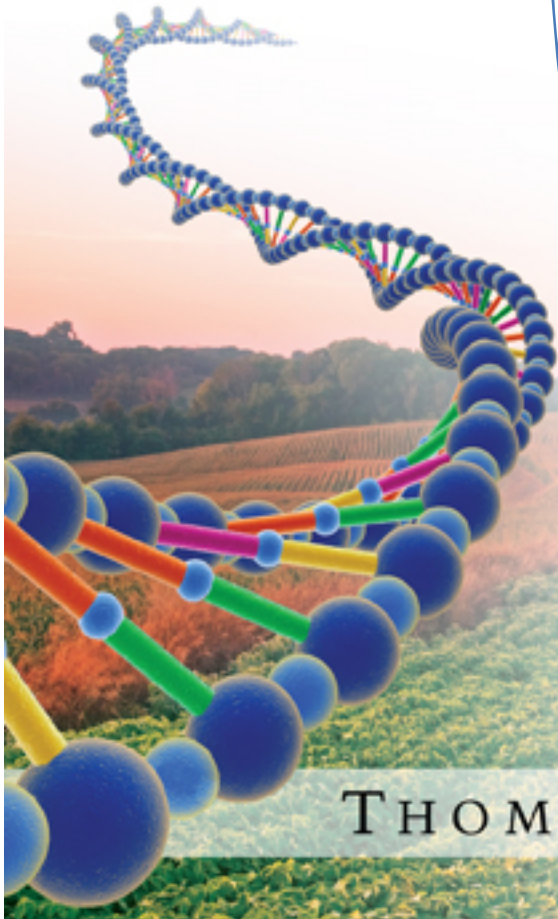
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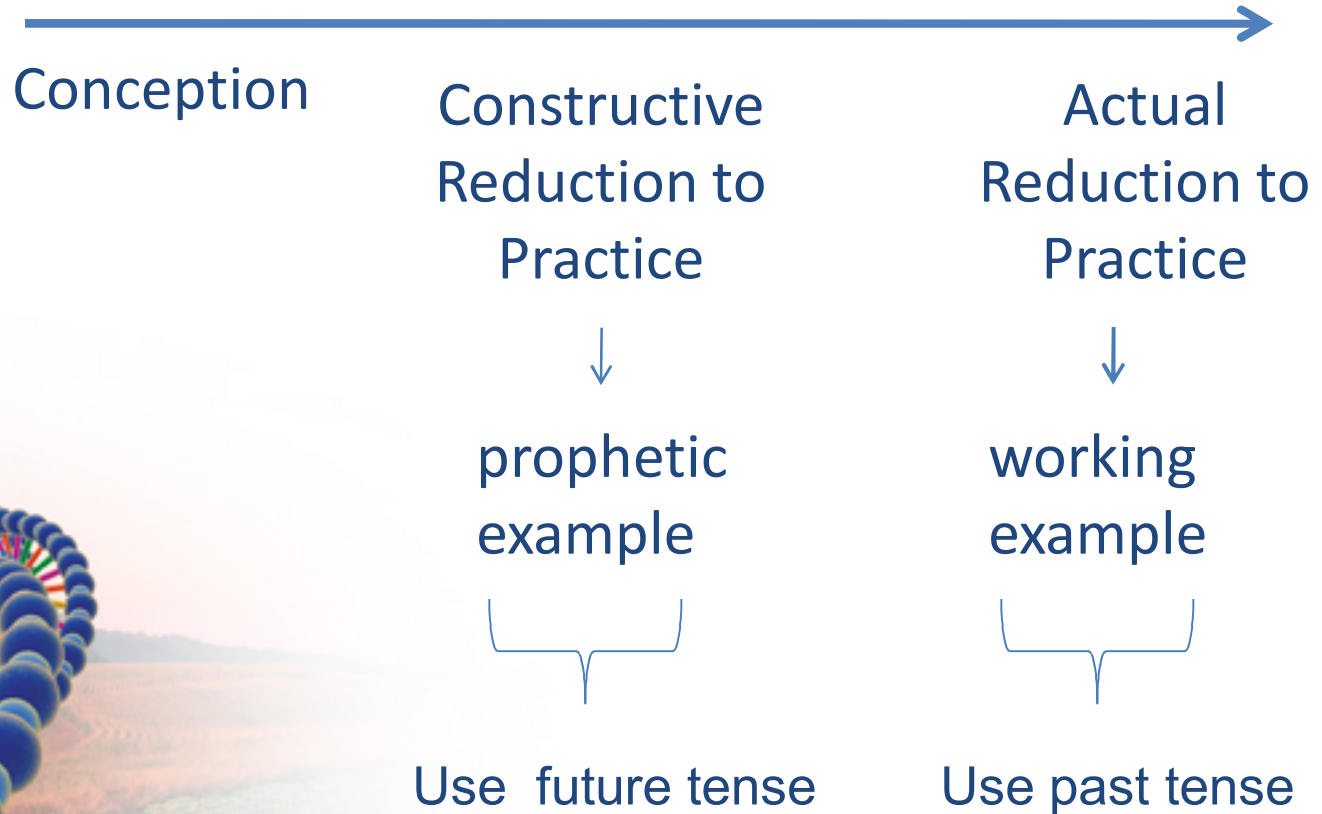
Invention Timeline



- 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

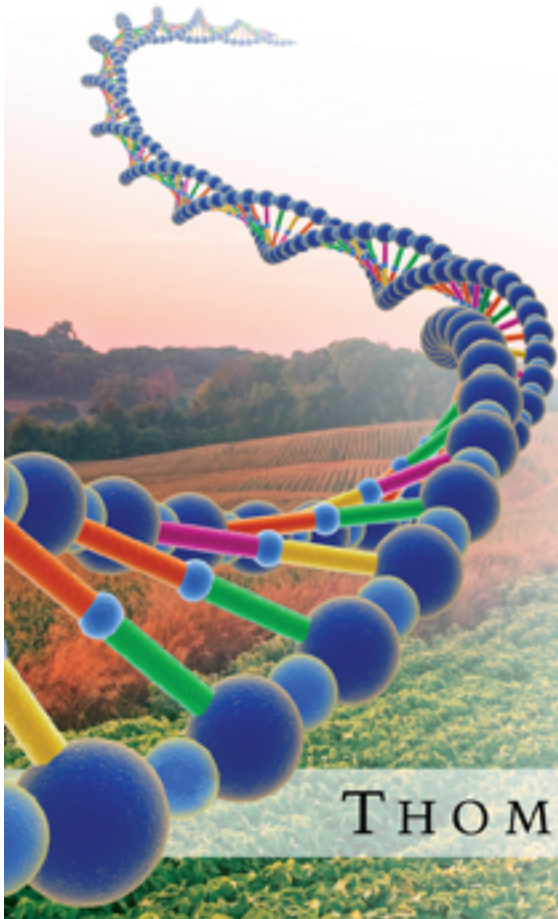


Establish the Conception Date

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



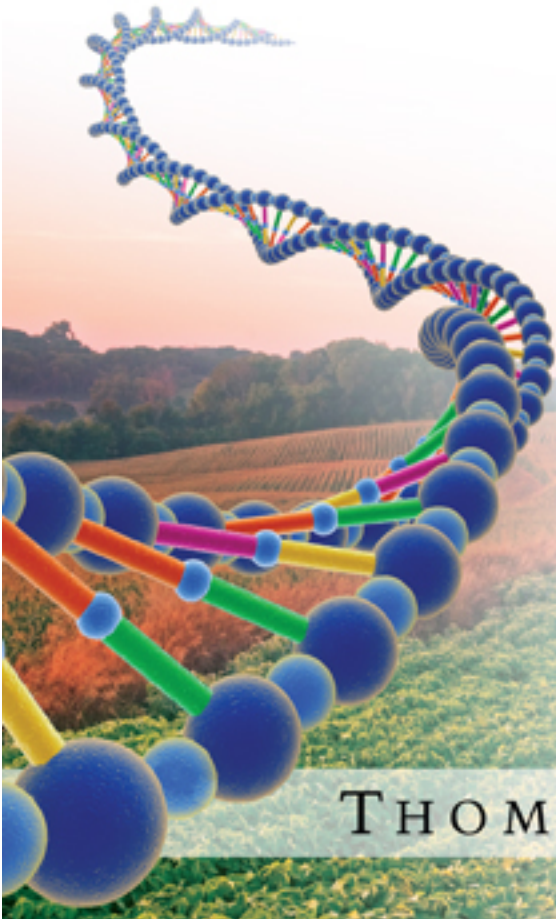
Establish the Conception Date

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

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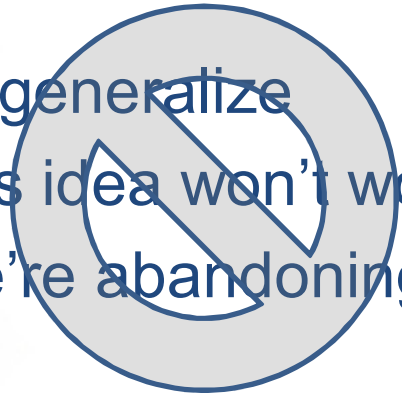
Document Path from Conception to Reduction to Practice

- 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”



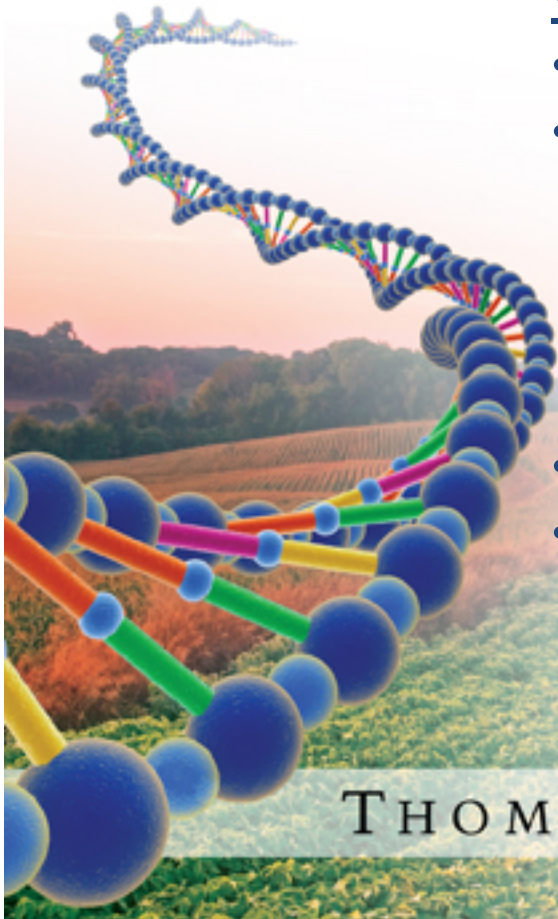
Using Electronic Records

Be careful!

- Patent related case law scarce

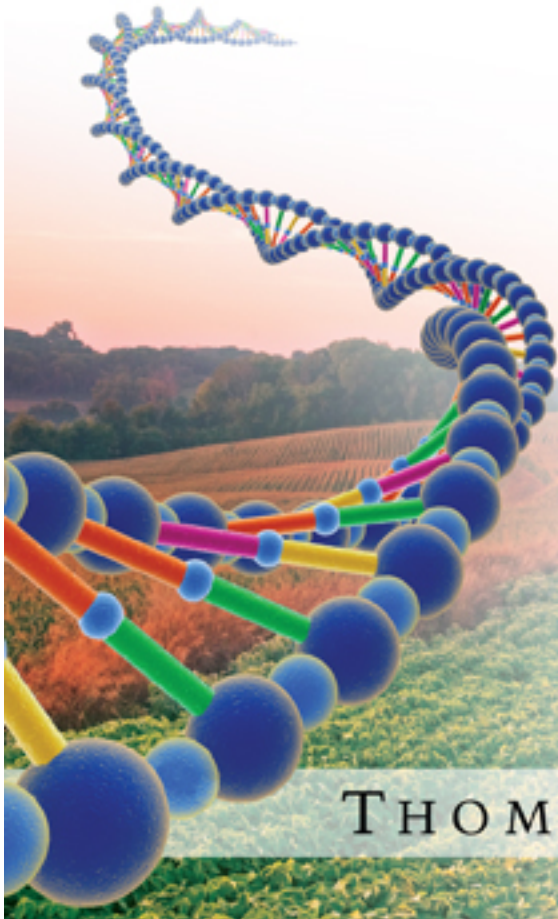
Consider evidentiary requirements

- 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
- [Lisa A. Dolak, *Patents Without Paper: Proving a Date of Invention with Electronic Evidence*, 36 HOUS. L. REV. 471 \(1999\).](#)



Actual Reduction to Practice: It Works!

- Record/sign/date notebooks ASAP
- Witness notebooks ASAP
- Tell technology transfer
- Don't tell anyone not under confidentiality



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Preparing the Invention Disclosure

Conception

Constructive
Reduction to
Practice

Actual
Reduction to
Practice

Conception

Best time to prepare invention disclosure

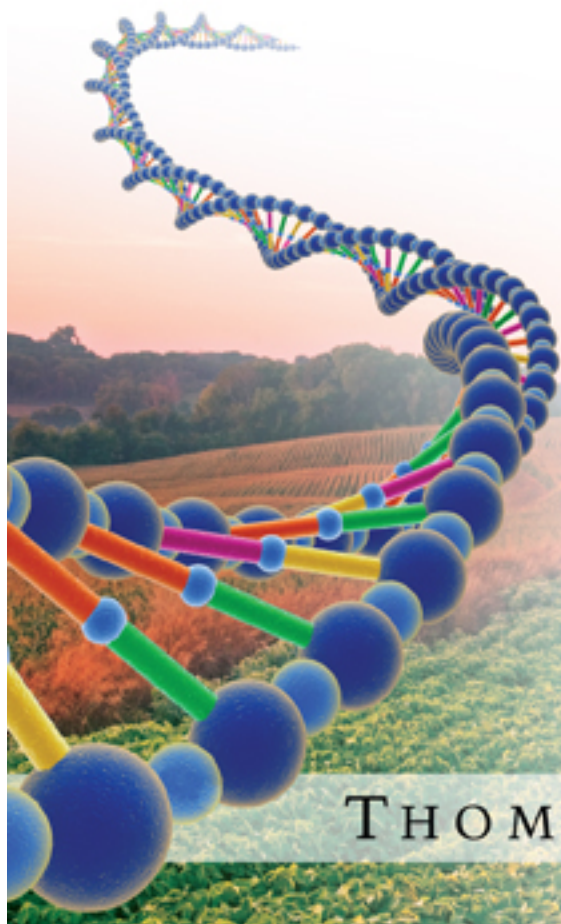
Constructive Reduction to Practice

Next best time to prepare invention disclosure

Actual Reduction to Practice

Better late than never!

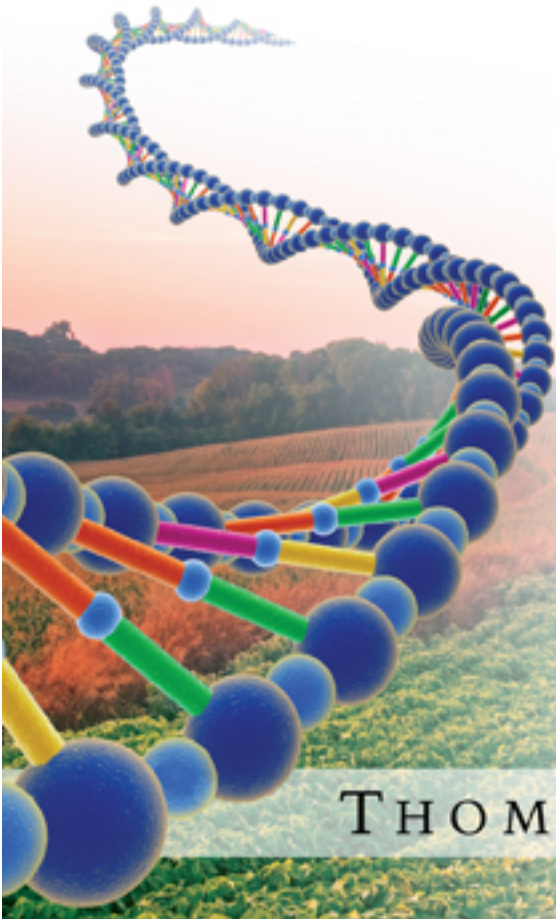
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Preparing the Invention Disclosure

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



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Preparing the Invention Disclosure

“Prior Art”

DO:

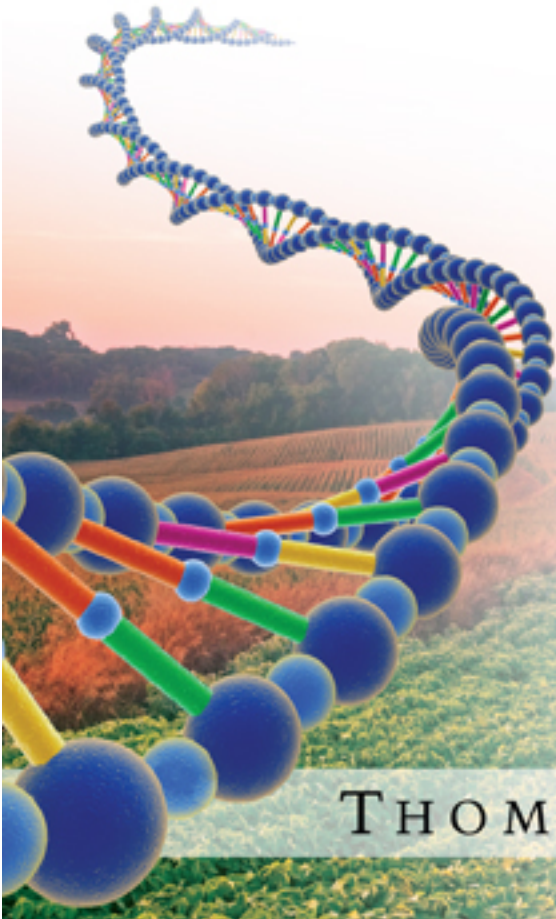
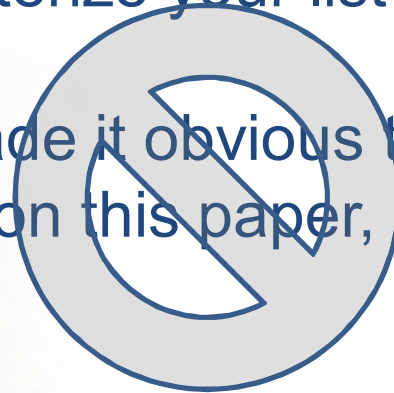
- Provide a list
- Consider patent and non-patent literature

DO NOT:

- characterize your list

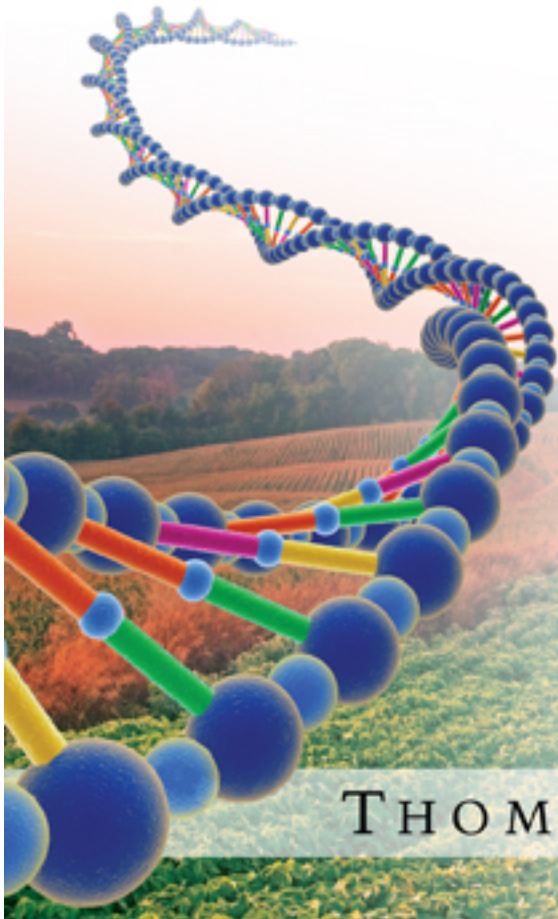
“this made it obvious that...”

“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



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University of Missouri Office of Technology Management and Industry Relations



Chris Fender

Director, OTMIR



Harriet F. Francis

Sr. Licensing Assoc.



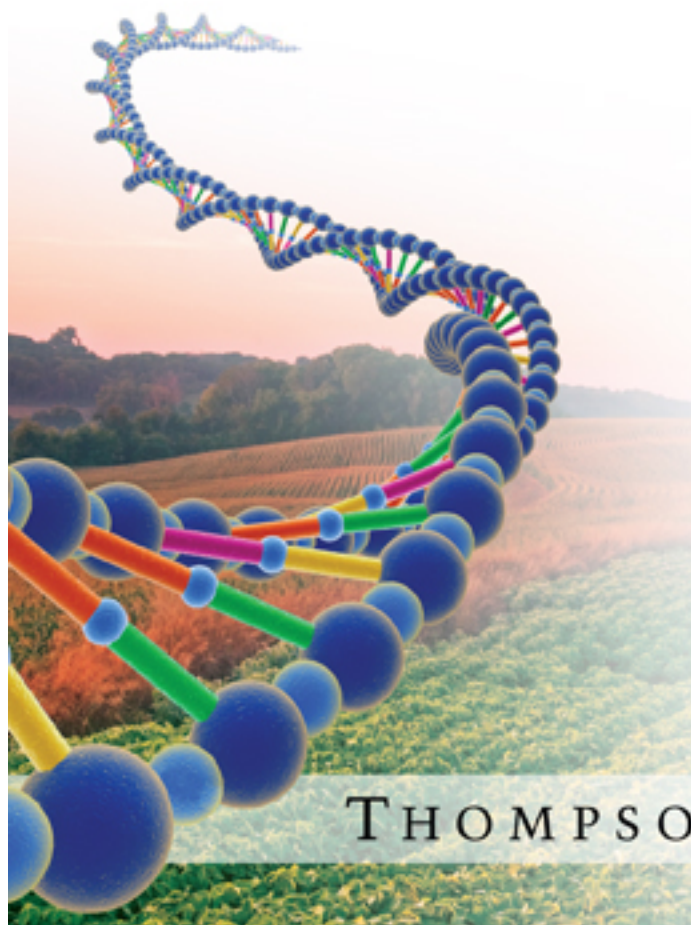
Wayne McDaniel

Sr. Licensing Assoc



Paul Hippenmeyer

Sr. Licensing Assoc.



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