Whose Invention Is It Anyway? Or, “Should I Throw Away My Lab Notebook?”

JUL 7
Posted by **MassBio**

Guest post by Konstantin Linnik, Ph.D., a partner in the Boston office of Nutter McClennen & Fish LLP, and Marc Chateney-LaPointe, Ph.D. a summer associate with the firm.

(http://www.massbio.org/events/calendar/2711-best_practices_in_protecting_and_exploiting/event_detail)On July 17, 2014, MassBio will host an expert panel “Best Practices in Protecting and Exploiting Intellectual Property (http://www.massbio.org/events/calendar/2711-best_practices_in_protecting_and_exploiting/event_detail).” Among other topics, the panel (http://www.massbio.org/events/calendar/2711-best_practices_in_protecting_and_exploiting/event_detail) will discuss the new US patent system, the first inventor to file (“FITF”) regime that took effect a little over a year ago as part of the patent reform law known as American Invents Act (AIA). Under the new law, the first inventor to file at the Patent Office wins.

Before AIA, our patent system operated under “first-to-invent” rules for well over two centuries. Under the old system the initial inventor had rights to the patent regardless of whether he was the person first to file an application with the Patent Office. If a subsequent inventor happened to submit a patent application before the first inventor, the latter could bring an *interference* proceeding at the Patent Office. Here, the first inventor must show that he was the first to conceive of the claimed invention and that he worked diligently to reduce the invention to practice. Both of these facts can be proven by evidence from a laboratory. Therefore, it was standard practice for each inventor to keep a laboratory notebook that provides a permanent record of every planned and executed experiment. Notebooks that were regularly dated, reviewed, signed, and then countersigned by a non-inventor witness, served as evidence of prior conception under the old system.

Many scientists assume that recent changes to our patent system rendered the signing of lab notebooks unnecessary. Not so! Even after the AIA *lab notebooks remain as important as ever*. Here is why.

Where the invention is allegedly disclosed to a third party, for example, in the course of a scientific collaboration, the third party might file a separate patent application on that invention before the original inventor. The inventor may be able to establish that the later filing applicant derived the invention from his disclosure by instituting a so-called *derivation* proceeding at the Patent Office, as defined in 35 U.S.C. § 135 (https://owa.massbio.org/owa/redir.aspx?C=777054d7655b477cb07e0179f5ceb5d9&URL=http%3a%2f%2fwww.bitlaw.com%2fsource%2f35usc-after-america-invents-act%2f135.html). A petition under this section must “set forth with particularity

the basis for finding that an inventor named in an earlier application derived the claimed invention" as well as state that this earlier application was filed without authorization. Additionally, this petition "shall be supported by substantial evidence" showing that the earlier-filed application was derived from the petitioner. (A further limitation is that the derivation petition must be filed within one year from the date of the first publication of a claim to the allegedly derived invention.)

Under the FITF system, "substantial evidence" of any derivation must be provided for the derivation proceeding. This evidence should include at a minimum: 1) evidence that the petitioner actually is the inventor (*i.e.*, conception) and 2) that the invention was communicated by some means to the party who derived the invention. Witnessed laboratory notebooks are still often a primary means of proving invention, as they represent the most direct, timely and corroborated record for most inventions. The new purpose of the notebooks, however, is to prove *conception of the inventionprior to a communication* with a third party that "derives" (or in plain English, "steals") your invention. Good laboratory notebooks should record discussions with collaborators and colleagues and provide details about the conception and reduction to practice of the invention. As a result, the practice of keeping and witnessing a laboratory notebook on a regular basis–but, perhaps, not as frequently as before–still remains important after the AIA.

This and other IP-related topics will be addressed by IP experts at our July 17 event (http://www.massbio.org/events/calendar/2711-best_practices_in_protecting_and_exploiting/event_detail).

This post was written by Konstantin Linnik, Ph.D., a partner in the Boston office of Nutter McClennen & Fish LLP, and Marc Chateney-LaPointe, Ph.D., a summer associate with the firm. This post is for informational purposes only and should not be construed as legal advice on any specific facts or circumstances. Under the rules of the Supreme Judicial Court of Massachusetts, this material may be considered as advertising.

Posted on July 7, 2014, in Guest Bloggers, MassBio and tagged American Invents Act, First Inventor to File, FITF, Intellectual Property, Invention, IP, Konstantin Linnik, Lab Notebook, Marc Chateney-LaPointe, MassBio, MassBio Forum, Patent, Patent Office. Bookmark the permalink. Leave a comment.

Leave a comment

Comments 0