# THE IMPORTANCE OF RECORD KEEPING

PATENT RIGHTS

#### By Alistair Smith



dcc.com

# INTRODUCTION

- Entitlement
  - Inventorship
  - Ownership
- Commercial Activities
  - Prior Art
  - Evidence of Prior Use



#### ENTITLEMENT

- Inventors are individuals that contributed to development of an invention
- Owners are entities that derive right to file applications from inventors
- Why is entitlement important
- Could lead to claim of ownership
- Patents can only be granted to owners that derive rights from the inventors
- Patents can be revoked if patent not granted to entitled entities
- Entitlement can be difficult to correct post-grant
- Critical to identify inventors and ensure correct chain of entitlement



#### **INVENTORSHIP**

- Assessment of inventorship can be difficult
  - Requires individual to have contributed to putting invention into practice in a manner beyond the normal skill in the art
  - Need to identify contributions made by each individual
  - Need to assess contributions to see if requisite threshold met
- Assessment can be hampered by:
  - Imperfect recollection
- Self interest



#### **INVENTORSHIP**

- Mitigating Issues
- Keep detailed records of research and development (Lab notebooks (or digital equivalent) / meeting notes / emails / draft manuscript papers)
- Perform inventorship determination
  - Identify potential contributors
  - Determine each contributor's input to the project
  - Collect corroborating evidence
  - Prepare fact sheet outlining timeline of development of the invention
  - Have contributors sign off on fact sheet
  - Perform formal assessment



#### <u>OWNERSHIP</u>

- Default position is that inventions are owned by inventors unless overriding transfer of entitlement
  - Assignment
  - Contract
  - Employee / Employer relationship (employed to invent or owe fiduciary duty to the company)
- Some countries require written proof of entitlement
- Advise written documents are prepared



#### <u>OWNERSHIP</u>

- Mitigating Issues
  - Ensure inventors are aware of ownership obligations
  - Ensure contracts have explicit ownership clauses and keep copies of executed employment contracts
  - Obtain confirmatory assignment documents as soon as possible
    - Written form
    - Signed by both parties
    - Sign in wet ink (not electronic)



### COMMERCIAL ACTIVITY RECORDS

- Evidence of activities can be important for invalidating patents or provide a defence to infringement
  - Can include published activities relevant to novelty and inventive step of a patent
  - Can include internal activities relevant as a prior use defence



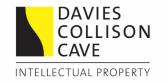
#### PRIOR ART

- Published information predating a patent application
- Can include:
- Published documents
- Websites
- Brochures
- Conference proceedings / papers
- Oral presentation
- Use of the invention (including copies of commercial products)
- Important to keep records of what published and proof of publication



## PRIOR USE

- Use predating a third party patent application
- Can provide a defence to infringement
- Requires:
  - exploitation of invention before patent application priority date
  - exploitation must be continuous (except temporary stoppages)
  - knowledge of the invention must not have come from the patentee (unless the patentee made that information public)
  - jurisdictional evidence



# PRIOR USE

- Important to keep records of what activities performed in preparing for commercialisation
- R&D records
- Contracts with third parties
- Email correspondence
- Grant applications
- Market research
- Prototypes

