

THE IMPORTANCE OF RECORD KEEPING

PATENT RIGHTS

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INTELLECTUAL PROPERTY

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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

OWNERSHIP

- 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

OWNERSHIP

- 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