

TECHNOLOGY TRANSFER OFFICE

UNIVERSITY OF COLORADO

BULLETIN

> LABORATORY NOTEBOOKS AND PROTECTION OF INTELLECTUAL PROPERTY

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Why are laboratory notebooks important for patenting?

Laboratory notebooks serve an essential purpose beyond just good organization and record keeping. They are also used for proving inventor status on an application and defending an issued patent. Laboratory notebooks provide evidence in defense of challenges infringers make to an issued patent. Though patent infringement litigation rarely occurs, the more valuable an invention, the more likely it will be contested.

To apply for a United States Patent, the applicant must prove two points: initial conception (formation of the idea) coupled with reduction to practice (how the idea would actually work). To be *named as an inventor*, you must have contributed to the *conception* at least one of the claims in the patent application. Direct contribution to reduction to practice is not required. To *determine the date of invention*, an inventor must be able to show a date of conception and a date of reduction to practice.

The first to do *both* has the patent rights. Dated laboratory notebooks are used as proof of the date of invention. Other inventors could be granted the patent if they were first to reduce the invention to practice, even though you conceived of the invention first.

To defend your patent against infringement, the owner of the patent (for CU employees the owner is the University) must inform the infringer of the patent rights violation. If the infringer contests the claim of infringement, the patent owner typically initiates legal proceedings. Laboratory notebooks must be accessible to the University in order to defend the patent during the legal proceedings.

→ U.S. Patent Law — First to Invent

Some patent law background is important to understanding this issue. United States patents are granted on a "first to invent" basis, unlike most other countries where patents are granted on a "first to file" basis. Thus, having adequate laboratory notebook records is essential to identifying the conception and reduction to practice of an invention.

→ What is an Interference?

An interference is a proceeding conducted before the Board of Patent Appeals and Interferences to resolve who, among two or more parties, was the first to invent a claimed invention ("priority of invention"). Interference is an expensive and time-consuming proceeding, but may become necessary when two applicants are claiming the same patentable subject matter and their filing dates are so close together that there is a possibility that the first to file is not the first to invent. An interference may be declared between pending applications or unexpired patents naming different inventors when, in the opinion of an examiner, the applications contain claims for the same patentable invention.

How to Protect Your Invention

Laboratory notebooks are by far the most important source of evidence documenting invention conception and reduction to practice. Laboratory notebooks need not be kept in a particular format. However, the following standards present a reliable format to prevent claims of fraudulent insertion or deletion of entries.

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Standards to Protect your invention:

- Use bound notebooks with pre-numbered pages. Sign your full name and date every page.
- Use ink when recording ideas and experiments. Use a single strike if anything is crossed out and initial these 'strike-outs'.
- Entries should always be made in the notebook without skipping pages or leaving empty spaces. Draw a line through any unused portion and initial and date the marking.
- Initial across the edge of auxiliary material such as figures and computer print outs that are pasted into the notebook.
- Do not place results printed on thermal paper in your notebook as it fades over time. Copy the data and then place it in the notebook.
- Digital records of results can be submitted as evidence of an invention, but it is highly recommended that these records be supported with written documentation -- the courts do not favor digital records.
- Label ideas or proposals to differentiate them from work actually performed.
- Have a witness who understands the content of the recent work sign the notebook pages on a frequent (at least weekly) basis. The witness should not be a direct contributor to the work being reported. At a minimum, have a witness review and document critical experiements.
- Try to preserve the "first samples" of new materials produced by a new method.
- Retain records of purchase orders for components required for testing.
- Students and post-docs: Leave notebooks and other records with your advisor when you leave the University.

Invention Disclosure

Submitting an invention disclosure to the Office for Technology Transfer provides additional support for determining the actual time of an invention. By disclosing the initial conception to our office we will have a signed and dated document that is an official record of the University. It is important to note you can contact our office immediately after the initial conception and before reduction to practice. The sooner we receive news of inventions, even if only a conception, the better we can understand your interests and prepare for the eventual marketing.

Intellectual property developed by faculty, staff or students of CU represents a significant opportunity for academic recognition and financial reward for the institution and for inventors. Properly organized and devised laboratory notebooks and invention disclosures provide a "trail of evidence" to support the invention and contribution claims. For further information, contact your campus Technology Transfer Office.

To learn more about TTO processes: <u>http://www.cu.edu/techtransfer/about/bulletins.html</u>

To download disclosure forms: <u>http://www.cu.edu/techtransfer/disclose/</u>

For more info or to submit a disclosure, email <u>ttocontact@cu.edu</u>

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