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Should You Throw Away Your Lab Notebook?

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Legal Update

On March 16, 2013, the U.S. Patent Office will change from a first-to-invent to a first-to-file system. The Board of Patent Appeals and Interferences will be replaced by the Patent Trial and Appeal Board and interference practice will go by the way-side. Newly defined Derivation Proceedings will also begin at this time. The question for many in the scientific world is: does a well-kept laboratory notebook matter in this new race to the Patent Office?

Standard practice has been that each inventor should keep a laboratory notebook that provides a permanent record of every planned and executed experiment. The notebook pages are dated, reviewed, signed, and countersigned. The laboratory notebook has been an essential tool in proving the date of conception and diligence, and thereby determining whether an inventor has rights to an invention.

However, under the new 35 U.S.C. § 102, the date that matters is the effective filing date. The date of invention is no longer relevant to patentability. Section 102(a) states that a person shall be entitled to a patent unless:

1. the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
2. the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

The exceptions of 35 U.S.C. § 102(b)(1) are each related to disclosures of the inventor's work, so a laboratory notebook touting an earlier invention date as compared to some third party will be of no benefit under the new system. Under the new rules, the first one to the patent office wins. Providing evidence of conception and due diligence until the invention is reduced to practice is irrelevant to patentability.

Interesting issues arise when the two inventions are not independently invented. According to new 35 U.S.C. 102(b)(2)(A), novelty (and thus patentability) is not lost where the subject matter disclosed was obtained directly or indirectly from the inventor. For filings after March 16, 2013, where the subject matter is allegedly disclosed to a third party and a separate earlier-filed patent application ensues, the later filing applicant can institute derivation proceedings, as defined in 35 U.S.C. § 135. 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" that the earlier-filed patent or application was derived from the petitioner. Further limitations are that the petition must be filed "within one year from the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the invention" and must be made under oath.

Thus, when the first-to-file system begins, substantial evidence of any derivation must be provided if a derivation proceeding is initiated. While there is no listing of what this evidence will include, it should at a minimum include both evidence that the petitioner actually is the inventor (*i.e.*, conception) and that the invention was communicated by some means to the earlier applicant. Thus, laboratory notebooks are still relevant to patentability because they are often a primary means of proving invention. Thus, the practice of keeping and witnessing a laboratory notebook

remains relevant even as we move to a first-to-file system.

The laboratory notebook could also be useful in derivation proceedings to show the invention was communicated to the earlier applicant. Good laboratory notebooks should record discussions with collaborators and colleagues as well as provide details about the conception and reduction to practice of the invention. One caveat, however, involves the standard that will be applied to show proof of communication. Traditionally, it has been important that a witness to conception be able to understand the invention, but it is unclear if this high standard will remain when showing communication of an invention. In fact, it may be that extrinsic proof, such as an email or phone record verifying that a conversation took place, would carry more weight than the signature of a witness in a laboratory notebook mentioning the conversation. Proposed rule 37 C.F.R. § 42.405(c) requires both "substantial evidence and at least one affidavit addressing communication and lack of authorization."

Outside of proving derivation, the laboratory notebook remains relevant for determining inventorship and correcting errors in inventorship. It also remains relevant during prosecution of the application when it may be necessary to supplement the specification with arguments and/or data from the inventors such as in a declaration under 37 C.F.R. § 1.131.

The evidence required by the derivation proceedings may be significantly more difficult to obtain compared to the evidence needed during interference proceedings. In an interference, 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 notebook and other sources which are nominally in control of the first inventor. In contrast, showing that another derived the invention may be more difficult, particularly where the derivation was indirect.

As a result, laboratory notebooks will remain important, but may carry less weight since communication may be the lynch-pin in proving derivation. It is also likely that there will be significantly fewer derivation proceedings instituted than interferences declared. Over the past three years, there has been an average of 57 interferences declared each year. These interferences include both situations where one applicant derived the invention from another as well as cases where both applicants independently invented the invention. After March 16, 2013, the independent inventor who loses the race to the patent office is simply out of luck.

This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617-439-2000.

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