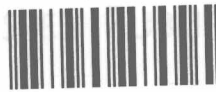


PATENT PRACTICE FORMS

Peter S. Canelias



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PREFACE

This book was compiled as an easy reference for the various basic forms used in patent practice. This book is divided into sections dealing with the various aspects of patent work. The first section generally tracks the progression of a patent from disclosure of the invention to preparation and filing of the application, prosecution, and issuance. Wherever possible, current official USPTO forms are used.

Subsequent sections track the enforcement of a patent in the courts, beginning with pleadings on through discovery and trial. Special attention is given to discovery, including protection of confidential information and form discovery requests from the perspective of both the patentee and the accused infringer. Where appropriate, commonly used objections are also supplied. For trial, included are model jury instructions and some examples of common motions *in limine* filed in advance of trial.

Patent license agreement forms are included, with an emphasis on software-related inventions. The work concludes with sample patent infringement and validity opinions that provide a framework for analysis of the issues to be addressed.

I sincerely hope that this work will prove useful to practitioners (new lawyers, experienced practitioners, and non-specialists alike) as a one-volume collection of basic forms, and that the use of the work will allow for better and faster service for their clients.

New York, New York

PETER S. CANELIAS

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P.S.C.

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CHAPTER 1

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§ 1.01 INVENTION DISCLOSURE

Invention disclosure is the first step in preparing a patent application. The inventor must be able to communicate the invention to the patent attorney or agent in sufficient detail, to allow for a proper preparation of the specification and claim. Another important function of invention disclosure is proof of the dates of conception of the invention and reduction to practice of the invention. Both dates could become important in the event of a priority dispute.

[A] Obtaining an Adequate Invention Disclosure

A written disclosure, dated and witnessed, provides the best corroborative proof of an inventor's conception and reduction to practice. No particular form is required for this disclosure, except that it should be understandable to the witnesses, and in general should be in bound form (i.e., not three-hole punched in a looseleaf notebook).

The considerations for an adequate disclosure are (1) enough information to enable a person of skill in the pertinent art to make and use the invention; (2) a written description of the invention adequate to show that the inventor had possession of the invention; and (3) the best mode known to the inventor of carrying out the invention. The first requirement, an enabling disclosure, must usually contain drawings that are keyed by reference numerals to the detailed description of the preferred embodiment. The second requirement is difficult to quantify; the disclosure must show that the inventor actually has the invention claimed. The third requirement is the subjective preference (if any) pertaining to the claimed invention. Such subjective preferences should be made part of the detailed description.

[1] Invention Disclosure Form with Witnesses

Form follows.

RECORD AND DISCLOSURE OF INVENTION

BE IT KNOWN THAT _____ [name of inventor(s)] had conceived the invention illustrated and described within this Record and Disclosure of Invention document on the date shown below which is called _____ [name of invention].

Name of Inventor(s):

Address:

Telephone:

Fax:

E-mail:

Name of Invention:

Subject of Invention: Describe the general subject of the invention.

Brief Description: Describe the invention in general terms: What does it do? How does it do it? What is it used for?

Sketch of Invention: Provide a sketch of the invention to the best of your ability. If possible, use labeled sketches to detail your invention. Be sure all essential parts are shown on the sketch, and try not to include extraneous details. Measurements are not required, unless they are essential to the operation of the invention (use additional sheets if necessary).

Details of the Invention: What parts (steps, if a method) make up the invention, in its best (preferred) form?

Which parts are new to this invention (in form or usage), which are old?

Indicate the ESSENTIAL parts of the invention — that is, for each part, ask “if this part were left out, or changed, would the remaining device still be my invention?” Or, “if this part were changed or left out, would the invention still work?

What are the advantages of the invention over competitive devices?

Alternatives: You have described the best way to build (perform) your invention. Now consider the alternatives. In what ways could the parts (steps) be changed or equivalent parts substituted without changing the basic invention?

Is there a generic description for any of the parts you listed (i.e. “fastener” instead of “Machine Screw”, or “plastic” instead of “polypropylene”)?

Could the functions of any of the parts be changed, combined, eliminated?

What could be added to make the invention work better?

What could be left out?

Alternate Use: Can your invention be used for anything other than its preferred use?

Limitations: When will the invention not work? Are there any critical ranges of size, weight, pressure, etc. for any of the parts of your invention? (i.e. "the cap must be made of steel with a Rockwell hardness of 32-56")

Must some parts be made of specific substances?

In order to be patentable, an invention must be NOVEL, USEFUL and NOT OBVIOUS to one skilled in the art, based upon everything which was available at the time of the invention.

State of the Art: Consider what was already in existence (whether patented or not) before the invention. How is the function of the invention being done today?

What is the closest device (method) you are aware of to your invention?

Is there something which performs the same function in a different way?

Is there any combination of existing devices (methods) which would be similar to your invention?

How does your invention perform its function different from, or better than, these prior devices (methods)?

How are they similar?

Resources for search: If you hadn't invented the invention, where would you go to find one?

What catalogs, publications, etc. would you look in?

Who would be likely to purchase or use the invention?

Do you know of any publications which might describe the invention or its competitors?

You may not get a patent on an invention which was already patented, or described in a printed publication, or in public use or on sale either: (a) by others, before you invented it, or (b) by anyone, more than one year before you apply for a patent.

Date of Invention: "Invention" means a combination of conception (coming up with the idea of the invention) and reduction to practice (building it, or applying for a patent). When did you first begin to work on the invention?

Has the invention been built or was a final design completed? If so, when?

Publications: Has the invention ever been described in any printed form, by anyone? If so, where and when?

Public Use: Has the invention ever been shown or used in public? If so, where and when?

Sale: Has the invention ever been sold? If so, where and when?

Other Inventors: Is there anyone else who contributed to the conception or reduction to practice of the invention, in more than a purely mechanical way?

Rights in Others: Are you under any obligation to assign any rights in the invention to others? Was the invention developed in the course of your employment, or using any facilities belonging to your employer? If so, the employer may have rights to the invention.

Do you have an agreement with your employer that you will assign any inventions you may make to the employer?

Was the invention developed in the course of a consulting agreement with someone else? If so, did you agree that any inventions belong to them?

Was there any funding of the development of the invention by any party (government agency, school, etc.) who might claim rights in the invention?

Was any equipment or facilities used in the development of the invention which was funded by or belongs to any government agency?

Additional notes and comments.

Be sure to sign and date the form, and have it witnessed by two people who are not the inventors.

Signed: _____

Dated: _____

Read, witnessed and understood:

Signature of Witness #1: _____

Print Name: _____

Date: _____

Signature of Witness #2: _____

Print Name: _____

Date: _____