

New Year's Resolutions

Ten dos and don'ts for patenting your research in the coming year

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Scientists working toward the development of a product often realize the importance of patents only after multimillion-dollar infringement lawsuits or large patent licensing fees make headlines. "What's this got to do with me?" is the oft-heard refrain from the lab bench. The answer is: Everything. These multimillion-dollar cases are often decided on the basis of how scientists conduct themselves individually and as a team. Quite literally, researchers are mining for intellectual gold each time they conduct an experiment—and protecting that gold begins at the bench.

Patent attorneys see millions of dollars of potential profit lost every day because a few simple dos and don'ts were either ignored or never understood. To be a successful inventor requires a mind set. Every time he or she enters the lab, the inventor's goal must be not only to discover important results, but to run and record experiments in such a way that the results can be patented if they so merit. As a handy guide, I have prepared a short list of laboratory "dos" and "don'ts" that can be used by those who are interested in generating "patentable results."

Keep a proper notebook

The notebook represents the most important record of your work. In a dispute over first inventorship, both sides will argue the case based on a page-by-page analysis of the notebook's contents. Simple errors on your part that make the notebook unclear or incomplete may cause you to forfeit your inventorship. Avoid these common errors:

1. *Sign and date every page of your notebook at the end of every experiment.*
2. *Have your notebook signed by a second person as a witness.* The witness should understand the experiment, but cannot be a coinventor.
3. *Do not keep all your data on a computer.* If you use a computer to store your data, print it out at least once a week, sign and date it, and find a witness to cosign it. Bind this document into a permanent notebook.

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4. *Write down your conclusions at the end of every experiment as well as hypotheses that develop from experiments.* Write these thoughts out in full, understandable sentences without abbreviations or code names that only you would understand. Formulate your thoughts so that a scientist from any discipline could understand what you are trying to convey.

No prior public disclosure

Do not publicly disclose your invention before filing. In many countries, public disclosure of an invention prior to a patent application's effective filing date bars the granting of a patent. Here are some types of public disclosure that you may not have considered:

5. *Be wary of public talks.* "Publish" means to make known to the public. In patent law, giving a 10-minute public talk at a meeting is publishing.

6. *Do not submit manuscripts for publication before filing.* If you plan on applying for a patent, do not submit a manuscript for publication. If the manuscript is accepted for publication before your patent is filed, in your rush to file you may submit an inaccurate or incomplete application.

7. *Do not submit sequences to databases before filing.* If you might be interested in patenting a nucleic-acid or amino-acid sequence, do not submit it to Genbank or other publicly available databases before you file. This too is considered publishing.

8. *Try not to disclose inventions in grant applications.* Obviously, this may be difficult, since justification for further research funding depends on demonstrating innovative results. At the least, be sure you file your application within *one* year of the grant's approval. Better yet, give your patent attorney the grant application's first draft and work on your patent filing simultaneously.

9. *Be the first to file.* Most major countries outside the U.S. award patents to the party who is the first to file. By moving quickly to file your invention worldwide, you not only broaden its potential market, but also are free to publicly disclose your invention after its filing.

10. *Honor thy patent attorney and thy director of technology transfer.* Remember, the patent attorney's job is to get you the best possible patent. Since you know the invention better than anyone, educate your patent attorney so that both of you can develop a strong and enforceable patent. ///

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