Keeping Good Laboratory Records Is Crucial to Safeguarding Patent Rights

Unknown probably to most research scientists and engineers in the U.S. and abroad, the start of the new year brought a major change in U.S. patent law.

As a result of the General Agreement on Tariffs and Trade (GATT), the new Section 104 of the patent statute removes the geographical discrimination formerly faced by non-U.S. inventors. Now they can prove the all-important "date of invention" with inventive activity occurring in any signatory nation of the World Trade Organization.

On equal ground More important, non-U.S. collaborators and companies now stand on equal ground with their U.S. counterparts when it comes to proving date of invention. They must take steps immediately to make certain that their lab record-keeping systems will satisfy the requirements of U.S. law.

Date of invention is crucial. The U.S. awards patent rights to whoever invents first. (Most other countries award them to whoever files the patent application first.) When the U.S. Patent and Trademark Office must decide which of two or more parties claiming the same invention is entitled to own the patent rights, the party that can establish that it invented first generally wins.

Under prior law, non-U.S. R&D labs were at a distinct disadvantage. U.S. law provided that inventive activity occurring outside the U.S. could not be used to prove the date of invention. The best a non-U.S. inventor could do was rely on a foreign patent-application filing date. Now, however, non-U.S. applicants may rely on inventive activity outside the U.S. to help establish an earlier date of invention.

Keeping faithful records Non-U.S.-based R&D labs should focus on record-keeping systems to make certain they comply with U.S. requirements for proof of invention.

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Apart from an inventor's own testimony, technical lab notebooks and other business records invariably serve a fundamental role in supporting an earlier date of invention. A lab notebook should strive to be self-explanatory—that is, provide evidence to prove conception, reduction to practice, and diligence without any interpretation from its author-inventor, who may have since forgotten the details or even moved, become incapacitated, or died.

Also, certain record-keeping procedures will reduce the risk of legal challenge and increase the evidentiary value of a notebook:

- Establish a central department to issue new notebooks and collect completed ones, and devise a cataloguing system.
- Use permanently bound notebooks to continuously record work progress, plus any ideas that may crop up and be later developed. Blank spaces and skipped pages should be lined out. Identify ongoing experiments by page number so that their progression is clear.
- Enter the project title, notebook number, author, and dates of use on the notebook's cover.
- Write in ink, not pencil.
- Provide a complete account of experiments, including sources of reagents and living organisms, protocols, diagrams, data, and results. Standard methods and recipes of frequently used solutions can be recorded once and cross-referenced.
- Include calculations of data for rechecking.
- Cross out an entry to correct it: *Never* erase, tear out, or cut out.
- Always sign and date any entry. The term encompasses any physical change to the notebook that is written or permanently attached—annotations, raw data, deletions, additions, etc.
- Have a knowledgeable noninventor witness and corroborate the work periodically. The witness should sign and date each entry.

Electronic data Computer-generated notebooks deserve special mention. Currently, the patent office and U.S. courts have no rules for admitting electronic notebooks as evidence. Until that day arrives, it's wise to print out hard copies, sign and date them, have them corroborated, and permanently bind the papers. Any modifications to the original computer records should be handled similarly.

With proper attention to detail, a researcher's technical notebooks will provide solid evidence of complete, consecutive, and contemporaneous inventive activity—whether it occurs inside or outside the U.S.

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