

# Encouraging the Exchange and Disclosure of Ideas by Providing Reliable and Easily Accessible Ways of Determining the Actual Inventors and Authors

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The derivation provisions of the America Invents Act underscore the importance of correctly determining the actual inventors of inventions<sup>1,2</sup>. Failure to correctly determine inventorship of a patent can result in costly litigation, change in

the ownership of the patent or the patent becoming invalidated<sup>3</sup>. An applicant for patent may institute derivation proceedings via a petition. The petition could allege that an individual named as the inventor in an earlier application derived the invention from an individual named as inventor on the petitioner's application. Based on this, the applicant may request relief<sup>4</sup>. Derivation proceedings, which challenge the validity and enforceability of patents, and actions to change the inventorship of a patent involve determining whether one or more persons are actual inventors of the claimed subject matter. In addition, it is uncontroverted that the society has an important interest in ensuring that actual inventors and creators receive the credit they deserve for their inventions and creations.

## THE PROBLEM OF DETERMINING INVENTORSHIP IN COLLABORATIVE WORK ENVIRONMENTS.

In the current creative environments, ideas and inventions come to fruition as a result of collaborations between many scientists. The contributors often are affiliated with many different organizations. Scientists work together as part of collaborations, they hold informal discussions with each other in search of solutions to problems, and they present ideas to each other at conferences.

This extensive exchange of ideas and opinions between many people makes it difficult to ascertain the actual inventors<sup>5</sup>. Because of this, disputes arise between various parties regarding the right to be named as an inventor on a patent or the order of the inventors' names appearing on the patent. The lack of proper tools for settling such disputes may lead to naming of individuals on patent applications who are not inventors and omitting individuals who are actual inventors. Besides the above mentioned legal risks, those situations lead to significant resentment and lack of trust among collaborators<sup>6</sup>. This, in turn, leads to significant deterioration of the collaborative work environment. The fear that their

ideas and creations may be misappropriated causes scientists to be wary of sharing their findings and ideas with others (e.g. coworkers, colleagues, collaborators) and to hide or postpone this information.

It is widely accepted that fairness and collaboration are at the core of a productive work environment beneficial to both employers and employees. Further, the society is the ultimate beneficiary of the increased productivity and creativity spawning out of the fair and collaborative work environments associated with the correct inventorship determination at the earliest stages of obtaining a patent.

## THE LACK OF ADEQUATE METHODS FOR SECURING EVIDENCE PROBATIVE OF INVENTORSHIP.

A party alleging that he or she is an omitted inventor of a patent may be added as co-inventor by showing that he or she contributed to the conception of the invention<sup>7</sup>. Such showing must satisfy the clear and convincing evidence standard. While an inventor can testify to the facts surrounding a claim of derivation, the testimony standing alone does not rise to the level of clear and convincing proof. An alleged inventor must supply evidence to corroborate his testimony<sup>8</sup>.

However, inventors often cannot present reliable corroborating evidence because the tools and methods they are using to secure evidence regarding their ideas and findings are inadequate.

Traditionally, such evidence has come in the form of notes in laboratory notebooks, oral testimony of collaborators, and, more recently, communications via electronic means such as emails. However, most of the above ways of securing evidence have significant shortcomings that render them ineffective.

For example, laboratory notebooks are the primary way of keeping records of ideas and solutions that may result in inventions<sup>9</sup>. Besides the fact that maintaining such laboratory notebooks is particularly cumbersome, they also have many inherent shortcomings. For example, laboratory notebooks often belong to the employer; they are not private; they cannot be removed from the laboratory upon termination of employment; and they can be lost, altered, or accidentally destroyed.

With the widespread availability of computers and digital media, new methods of performing discovery and securing

evidence have emerged<sup>10</sup>. In these days, scientists and engineers looking to secure evidence of their discoveries and inventions may keep digital records. Such digital records may be kept on personal storage media, via email attachments and others. The problems with such methods stem from the fact that the value of such evidence may only become apparent many years after recording. Scientists will need to keep track of a large number of disparate digital files for long periods of time. Over the years, people may lose track of the records, storage media may be lost and data may become corrupted. Further, suspicion with respect to the date and time when a specific record has been created will linger because the person keeping the data has control over the record and may employ various means to falsify the time stamp.

Thus, there is a need for better tools and methods for securing evidence indicative of inventorship and for determining the actual inventors of inventions.

## **MODERN METHODS AND SYSTEMS FOR SECURING EVIDENCE AND DETERMINING INVENTORSHIP.**

The following briefly evaluates methods and systems that may be implemented to better determine the actual inventors of inventions.

For instance, with the increasing popularity and sophistication of cloud-based computing, an internet-accessible document and evidence holding docket may be implemented by a government entity or by a private party where prospective inventors record and keep evidence relevant to inventorship. The evidence may be kept in the form of digital files or documents such as text files, image files, movie files, technical drawings, and others. The evidence holding docket is implemented via a website of an on-line service where users create password protected private accounts.

A prospective inventor opens a private account on the evidence holding docket where he uploads and stores digital documents that may be relevant to establishing conception of an invention. The stored digital documents may describe subject matter (e.g. apparatuses, methods, solutions to problems) conceptualized by the prospective inventor. A time-stamp indicating the upload time is associated to each document. Moreover, the content of the uploaded files may itself be associated with timestamps indicative of when the content

was created and/or modified. With passing time, the prospective inventor perfects and finds improvements to the invention. He or she can then record the improvements on the personal account shortly after conception. Further, the prospective inventor may store on the docket documents describing disclosure of the invention to others such as conversations and communications to coworkers and collaborators. This way, prospective inventors create a systematic and centralized trail of time-stamped documents and records corresponding to the evolution of their findings, ideas, inventions and disclosures.

The internet holding docket is administered by an independent party contractually bound to keep documents securely and confidentially in trust for the account holder and to truthfully testify, upon request by the account holder, that the documents have been created on holder's account at the date and time shown on the time-stamp. The administrator of the docket may provide to the account holder copies of the documents stored on the docket and accompanying certification that the documents were uploaded on the docket at the time shown on the time-stamp. Upon request by the account holder, documents on the docket may be published on a website associated with the docket. Thus, the legally bound party provides a confidential and secure internet based evidence holding docket where prospective inventors can store and keep documents that substantiate their inventions within short time after conception.

In the event of an inventorship dispute, such as derivation proceedings or actions under 35 U.S.C. §§ 256 and 116, a prospective inventor using the aforementioned evidence holding docket can bring reliable corroborating evidence in the form of a time-stamped record kept by a neutral disinterested party legally bound to hold and log information accurately. Thus, the prospective inventor has reliable and credible corroborating evidence to support his or her inventorship claims for many years after the time the inventions, ideas and findings were recorded on the evidence holding docket. If the docket is consistently maintained as a standard business record by the administrator, this alleviates much of the authentication and other evidentiary burdens of gaining admissibility of the documents into court, if necessary.

Securing inventorship via an on-line docket system as described above is signifi-

cantly less cumbersome and more secure than using laboratory notebooks. Unlike laboratory notebooks, the accounts on the on-line docket are private. Also, data upload on the docket is significantly less prone to loss or destruction than laboratory notebooks. Securing inventorship via an on-line docket system is significantly more secure and private than securing inventorship via disclosure to coworkers, colleagues or friends. Further, evidence kept via a docket system is less prone to fraud (e.g. document falsification) and more credible than evidence stored on a personal digital storage media or personal email system because the docket is administered by an independent party legally bound to testify as to documents' logging into the docket.

The docket leads to more legal certainty with respect to the date and time when certain evidence (*i.e.* text descriptions, drawings, pictures uploaded on the docket) are created. The docket also provides more verifiable certainty regarding the subject matter docketed. As a result, employers and assignees can better determine the correct inventorship of the inventions at the time an application is filed and avoid costly litigation and derivation proceedings. Further, in the event of litigation or derivation proceedings, the easily ascertainable creation date of the evidence stored on the docket will allow the parties to make more informed decisions and avoid costly litigation and derivation proceedings. The courts and the Patent Office will also benefit from the legal certainty associated with the evidence stored on the docket since the task of determining inventorship is simplified when at least some of the evidence comes as documents stored on the docket. Patent office and judicial resources can be saved due to the reduction in number of derivation proceedings and civil actions associated with using an evidence holding docket.

We anticipate that the major benefits of implementing a docket system come from the fact that prospective inventors can share their ideas and findings with their collaborators, within short time after conception, without fearing that such ideas and findings may be misappropriated. Thus, the docket system may improve collaboration and trust between scientists and engineers and may act as a deterrent to misappropriation of ideas, inventions and innovations. Society is the ultimate beneficiary of the increased productivity and creativity associated with the resulting increased fairness

and collaboration in the collaborative creative environments.

The on-line based evidence holding docket can be used to secure evidence relevant to authorship, priority of ideas, and creations that are not entitled to patent protection. For example, creators of materials that may be entitled to copyright protection can digitally store materials such as literary creations, music, pictures, movies, copies of paintings on a personal account of the evidence holding docket. This way, creators can secure evidence showing the time of creation and the evolution in time of their creations.

Scientific discoveries, abstract ideas, thesis, and theories are not protected as intellectual property. However, in many circumstances (e.g. academia and government research laboratories) it is important to ascertain the actual proponent of an abstract idea, the creator of a scientific theory, or the party who first observed a phenomenon. Scientists can use the docket system to record their ideas, observations, theories, thesis and proposals within short time after conception. This way a scientist can support priority claims such as: he or she is the first person to observe a certain phenomenon, he or she is the first person to propose a certain theory or thesis, he or she is the first to propose a solution to a certain problem etc. Such claims may be used to gain recognition of the scientific community as the original proponent of a thesis, the creator of a theory, the discoverer of a phenomenon etc.

The on-line based evidence holding docket may be implemented either by a Government entity, such as the US Patent and Trademark Office or by a private entity providing such a docket as an on-line service. A docket system implemented by the USPTO has the major advantage of lending government's authority and credibility to such a service. Such an on-line based evidence holding docket is relatively easy and inexpensive to implement. The system may be designed to be user friendly and easily accessible by potential inventors from all over the world. The evidence stored on the docket may be easily preserved for long time via various digital storage means.

## CONCLUSION

Inventors, employers, patent owners, and the society can greatly benefit from the implementation and use of modern methods and systems for securing evidence relevant

to inventorship such as the ones described in this article.

## ENDNOTES

1. See *H.R. REP. NO.* 112-98, at 42 (1st Sess. 2011) (“A new administrative proceeding—called a ‘derivation’ proceeding—is created to ensure that the first person to file the application is actually a true inventor. This new proceeding will ensure that a person will not be able to obtain a patent for the invention that he did not actually invent.”).
2. See also Joshua Sarnoff, *Derivation and Prior Art Problems with the New Patent Act*, 2011 Patently-O Patent Law Review 12.
3. Michael McGurk, Elizabeth Laughton and Flora Amwayi, *Correcting Inventorship During Litigation: When, Why, How*, Law360, (Jan. 31, 2014, 12:36 PM), <http://www.law360.com/articles/361168/correcting-inventorship-during-litigation-when-why-how>.
4. See 35 U.S.C. §§ 291 and 135 (2011).
5. H. Sanders Gwin, *A Practical Approach to Inventorship*, American Intellectual Property Law Association, (Jan. 31, 2014), <http://www.aipla.org/learningcenter/library/papers/bootcamps/07patentbootcamp/Documents/Gwin-ppt.pdf>.
6. The history of science and technology is replete with allegations that inventions have been misappropriated or that credit has not been given to the right person. See e.g. *The Idea Factory: Bell Labs and the Great Age of American Innovation* by Jon Gertner ( ISBN-10: 0143122797, The Penguin Press (2013)) describing the inventorship dispute over the transistor, “the greatest invention of the information age”, between the three Nobel Prize recipients for the invention of transistor. Allegedly, William Shockley secretly planned to upstage his teammates John Bardeen and Walter Brattain, who had already invented a more primitive transistor but had shown it only to a small group of colleagues.
7. *Ethicon Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998).
8. *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993).
9. See, Joshua Matt, *Searching for an Efficacious Joint Inventorship Standard*, B. C. L. Rev. 245 (2002).
10. See e.g. *[Way]Back to the Future: Using the Wayback Machine in Patent Litigation*, by James L. Quarles III, Richard A. Crudo, *Landslide* vol. 6 no. 3 (January/February 2014).