

What Records Should Inventors Keep?

In 2012, the United States switched from a first-to-invent system to a first-to-file system. Many inventors hoped that this change would eliminate the need to keep detailed invention records, but even in today's first-to-file system, there is still a need to maintain invention records.

An exception to the first-to-file regime occurs when the first filer derives the invention from someone else instead of inventing it him or herself. Keeping invention records that detail the development of the invention and any disclosures to third parties can be helpful in proving that an unrelated first filer is not an inventor, and is not entitled to a patent. Invention records can also help in the converse situation, helping a first filer to prove independent development of the invention, and to defend against a third party's claim of derivation. An inventor should therefore continue to keep invention records, focusing on the conception of the invention and on any pre-filing disclosures of the invention to others.

While invention records have historically been kept in permanently bound notebooks, with entries regularly witnessed and signed by third parties, invention records can now be kept electronically. Key aspects of electronic record keeping include dating the records, keeping the records in a format that cannot be readily altered, and sharing the records so that third parties can corroborate the content and date of the records.

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KEY POINTS FOR MANAGING INVENTION RECORDS INCLUDE:

- 1** An inventor should keep records of the development of the invention from conception to at least the filing of a patent application.
- 2** An inventor should document all pre-filing disclosures to others.
- 3** If paper records are kept, the inventor should sign and date each entry, and have at least one trusted colleague, who is not a co-inventor, contemporaneously read, sign and date the entry as having been “read and understood,” to corroborate the inventor.
- 4** If records are kept electronically, they should be stored in a manner that makes the contents and date of creation difficult to modify, such as a .pdf or image file. They should also be shared with at least one trusted colleague, who is not a co-inventor, to corroborate the inventor.
- 5** If possible, the inventor should submit the invention through his or her company’s invention submission program as soon as possible to provide an independent record of the invention.