

Even though inventors are central to the creation of an invention, they are often an underutilized resource during the actual patent drafting process. When properly managed, inventor involvement in the patent application drafting process can significantly increase the value of a patent and decrease the costs associated with acquiring the patent. In most cases, this involvement does not need to consume significant amounts of the inventors' valuable time. If inventors are properly educated about the patent process and thoughtful internal procedures are implemented, the patent application preparation process can become more streamlined and less burdensome. A simple way of accomplishing these goals is to educate the inventors about the use of a well-prepared invention disclosure form.

An invention disclosure form is a simple way to maximize patent value and minimize the amount of time inventors spend away from their normal revenue generating work. While many companies already use invention disclosure forms, oftentimes their forms are unduly burdensome and their inventors have not been properly trained on how to fill them out. A well-prepared invention disclosure form should be succinct and inventors should understand what the form is attempting to accomplish.

When preparing an invention disclosure form and training inventors how to use them, special attention should be given to the potential audience of a patent or patent application. Inventors can play a valuable role in the preparation of a patent by ensuring that a patent application is tailored to the unique needs of each audience. Start-ups, for example, often leverage their patent portfolio to generate investor interest and to increase the valuation of their companies. In these cases, the target audience for a patent application is the investors themselves, who often lack a technical background and will likely not be able to fully appreciate the technical details of an invention. To maximize patent value for this audience, it is important that the invention disclosure form asks the inventors to briefly describe to a lay audience what the invention is and why it is better than other options, and what problems may be solved by the invention. While being directed to a lay audience, the inventors should still focus the description on providing a lay description of the technical features of the invention and not digress into discussing the market potential for the invention. This same

layperson description will also become valuable if the patent is ever litigated. Most juries and judges also lack technical backgrounds. The ability to point to an accurate and simple description of the invention within the patent itself can help both the judge and jury appreciate the inventive contribution of the patented invention.

Patents also provide value to companies through their ability to protect their innovation. In order for the company to obtain patent protection, and to later enforce or license its patents, the patent application must describe the invention so that a person having skill in the art could make and use the invention. To meet this requirement, the invention disclosure form should have a section that asks the inventor to describe the invention to a technical audience. This section should be broken up into two different parts. The first part should ask the inventor to describe the current state of the technical field to which the invention pertains, and the second part should ask the inventor to describe the invention itself. The goal of the first part is to explain to the drafting attorney, and a future patent examiner, how things are currently accomplished within the field of the invention. Ideally, after reading this part of the invention disclosure form, the drafting attorney should appreciate how the invention is different from the prior art and how it improves upon earlier approaches. Additionally, this section should also ask the inventor to provide references to any papers, patents, or other documents that the inventor is aware of that describe the prior art. Everyone involved in a patent has a legal obligation to inform the USPTO about known prior art. To fulfill this obligation, the documents referenced by the inventor will need to be cited to the patent office. Importantly, there is no requirement that the inventors proactively search for documents to cite. Instead, the inventors should only cite those materials that they are currently aware of.

Finally, the second part of this section of the invention disclosure form should ask the inventor to describe the invention. Within this section, the inventor describes the technical features of the invention. Inventors can also include tables, charts, and figures. It is not necessary that the inventor describe every possible variation of the invention or to exhaustively provide all of the data that is associated with the invention. The target audience

Preparing Inventors for the Patent Process
by Brad Barger

for this part of the invention disclosure form is the drafting attorney. The drafting attorney will use this portion of the invention disclosure form to prepare for a formal disclosure meeting with the inventor where the rest of the details can be discussed. Ideally, this section of the invention disclosure form will have enough information so that the drafting attorney understands the particular nature of the invention and is prepared to discuss the details of the invention with the inventors at the disclosure meeting.

Invention disclosure forms may ask for additional important information, such as conception date, inventor contact information, information about any disclosures of the technology that may have occurred, and other related data. In any case, however, if inventors are trained to work with simple invention disclosure forms that include the above discussed sections, the drafting process will be streamlined and any resulting patent applications will be better written for the different target audiences. Additionally, as the saying goes “an ounce of prevention is worth a pound of cure.” Investing a little more time during the initial drafting stages of an application can save significant review time for the inventors prior to formally filing the application.