



Topic 4: Receiving all necessary information from the (inhouse) inventor

National Intermediate Patent Drafting Course

Kuala Lumpur, Malaysia

February 26 to March 2, 2018

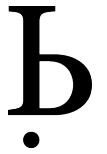
Tobias Kaufmann & Becky White



Step 1:

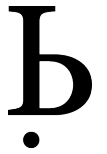
Invention Disclosure Form

Invention Disclosure Forms



INVENTION DISCLOSURE FORM			
1. Title Of Invention			
<hr/>			
2. Inventors			
	Inventor 1	Inventor 2	Inventor 3
Full Name			
Phone			
E-Mail			
Affiliation with the company			
Please use separate sheet for additional inventors.			
3. Description of Invention			

Technical questions



- What was the original problem to be solved by the invention?
- What is the prior art which comes closest to the invention and/or which the invention aims to improve?
- What is the solution to the problem and how was it implemented?
- Attach any drawings, pictures or other material helpful in understanding the solution/ invention
- Describe any variants or different embodiments of the invention.
 - Which is the best version of the invention?

Technical questions



- What are the key and novel features of the invention? How does it differ from other products or methods currently available?
- What are the advantages of the invention over current technologies?
- What are the immediate and/or future applications of the invention?
- Are you working on any developments / improvements?



Other questions – prior disclosure

- Has the invention been publicly disclosed in any publication or been disclosed to any entity outside of your company?
- If yes, provide a list of the type of disclosure, date and to whom the invention was disclosed.
- If yes, was a non-disclosure agreement (NDA) in place with any entity to which you disclosed the invention?
- Are there any upcoming plans to publish / disclose?

Legal questions – if needed



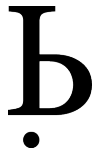
- In most countries, invention owned by employees belong to the employer
- How about inventions coming out of freelance work?
- Explore the transfer of rights, if needed
 - Who is your client?
 - Who is the inventor?
 - Who is the applicant?



Step 2:

The Interview

The inventor interview



The inventor interview



- If you have the chance to personally interview the inventor, you should do so
- In many fields (mechanics, electrical engineering, software), the inventor might also have a prototype to show you
- At the end of the interview, you should have understood all technical issues to the extent that you are able to write these down in your own words



Step 2a:

The Search for Prior Art

The search for prior art



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Step 3:

The First Draft

Elaborating a first draft

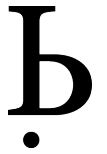
- Similar to drafting a scientific paper
- Typically, draft the claims first
- Then, draft the description and figures
- Where needed, insert questions to the inventor
 - Do not expect the inventor to improve your draft on his own, he might not know what is needed for a patent application
 - Remember: the inventor often does not know the invention (= legal construct), but they do know their technology so ask the right questions
 - If necessary / beneficial then teach the inventor about patentability requirements
- Forward the draft to the inventor for comments



Step 4:

Revised Drafts and Filing

Elaborating a first draft



- The application might be ready for filing after the 1st draft...
- ... but there can also be an extensive back and forth of drafts
 - For example, when several individuals, departments or companies are involved
 - Or the invention has been improved/changed during the drafting



Other considerations



Who is your client?

- Who gives you instructions? Pays the account? Makes the decisions?
- What do they want to achieve?
- Consider:
 - your own employer
 - private inventor
 - small company
 - large company
 - corporate client
 - client via another lawyer / attorney



Thank you very much!