

Invention Disclosure Meeting Checklist

Attendees: _____

Draft Due: _____ Date: _____

Overview of Patenting Requirements

- Patentability requirements: New, Useful, Non-obvious, and Patentable subject matter.
- Application requirements: Written description, Enablement, and Best Mode

Background

- What problems existed (or what new problem did you identify)?
- What's the state of the art? (more prior art under AIA – public use/sale/publication worldwide)
- Terminology used in the industry (terms of art)
- Who are the competitors? What have they done to address the problems?

Details of the Invention

- System components of the invention (refer to stock figures)
- Method steps of the invention (develop flowchart diagram)

Patent Claiming Strategies

- Will the invention be embodied in a new commercial product?
- How would you detect copying of the invention by your competitor?
- What components/steps of the invention can be omitted/substituted by an equivalent?
- What are other uses for the invention? Any applicability to other industries?
- User Experience:
 - Does the invention deliver a valuable user experience (UX)?
 - What element(s) of the invention give the user the biggest “wow”?
 - How does the invention deliver the UX?
 - Does the invention address a specific consumer need?
 - How does the invention fit into the greater UX roadmap of the client?
- Is it critical to finish patent examination quickly? (consider Track One under AIA; other pre-AIA)

Timeline/History (AIA “shielding” disclosure, AIA derivation proceedings, other)

- Shielding disclosure? Any prior public disclosure/use/sale anywhere. When? Get a copy.
- *Public* sale/offer for sale?
- Any *secret* commercial use/sale/offer for sale or non-public use? (probably OK under AIA)
- Are 3rd parties/vendors aware of or involved with the invention? Signed NDA? Get good records.
- Actual reduction to practice (i.e., working prototype) date: _____
- Conception date: _____ (Get good records for possible AIA derivation proceeding, etc.)

Duty of Disclosure

- Are inventors/in-house aware of any prior art – AIA expanded definition of prior art
- Order a prior art search?

Foreign Filing Desired (Y/N) – consider absolute novelty countries and subject matter eligibility overseas

Non-Publication Request – not available if foreign filing

Under Contract to Government or Other Entity – (qualify for small or micro-entity status under AIA?)

Inventor(s)/Applicant Information (get full legal name and residential address)

- Indicate file-by-date. Confirm inventor availability to review draft application.
- Applicant information (if desired under AIA)

Presented at Corporate Patent Seminar in Chicago by Banner & Witcoff attorneys Aseet Patel (apatel@bannerwitcoff.com) and Bradley Van Pelt (bvanpelt@bannerwitcoff.com); Peter Nguyen, SC Johnson & Sons.