

# **Invention Disclosure Records**

*Are they answering the questions you're asking?*

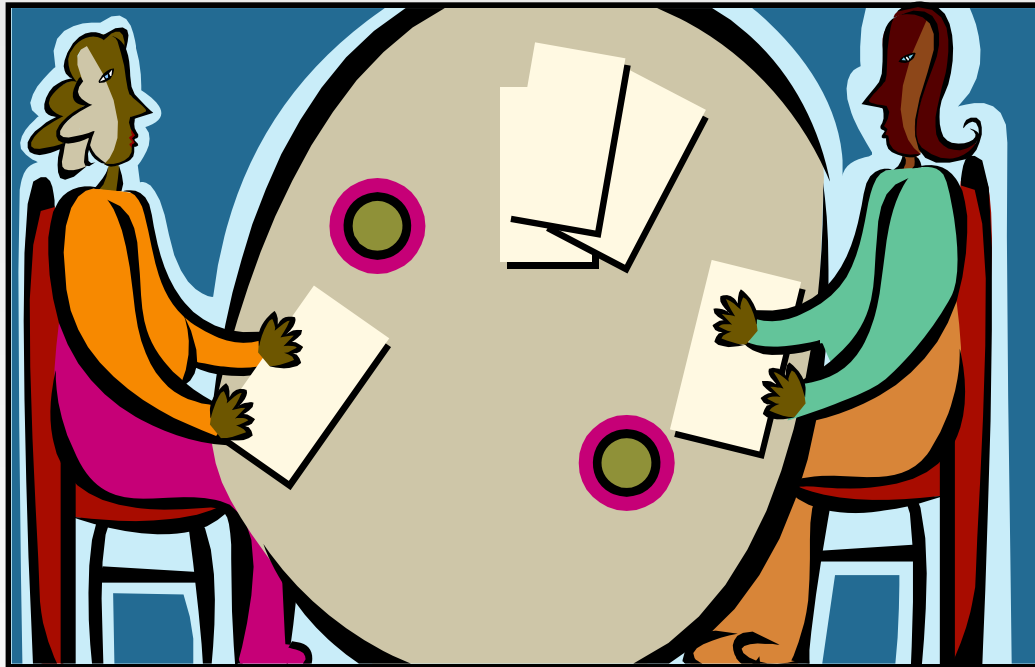
**David G. Burleson**

**November 12, 2010**

**ZOLLINGER & BURLESON** LTD.  
INTELLECTUAL PROPERTY LAW

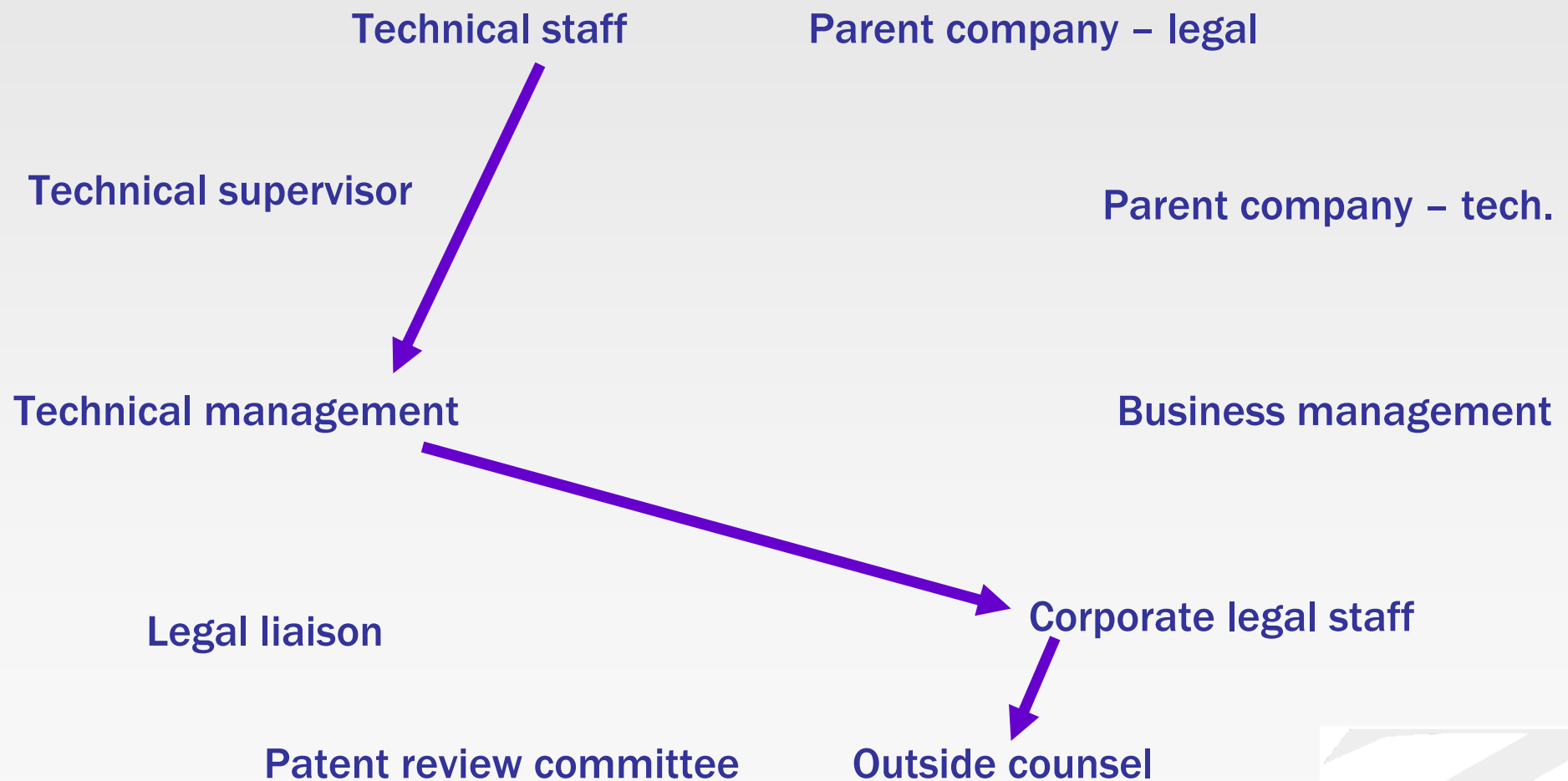
# How information about the invention is communicated to the attorney –

## INDEPENDENT INVENTOR



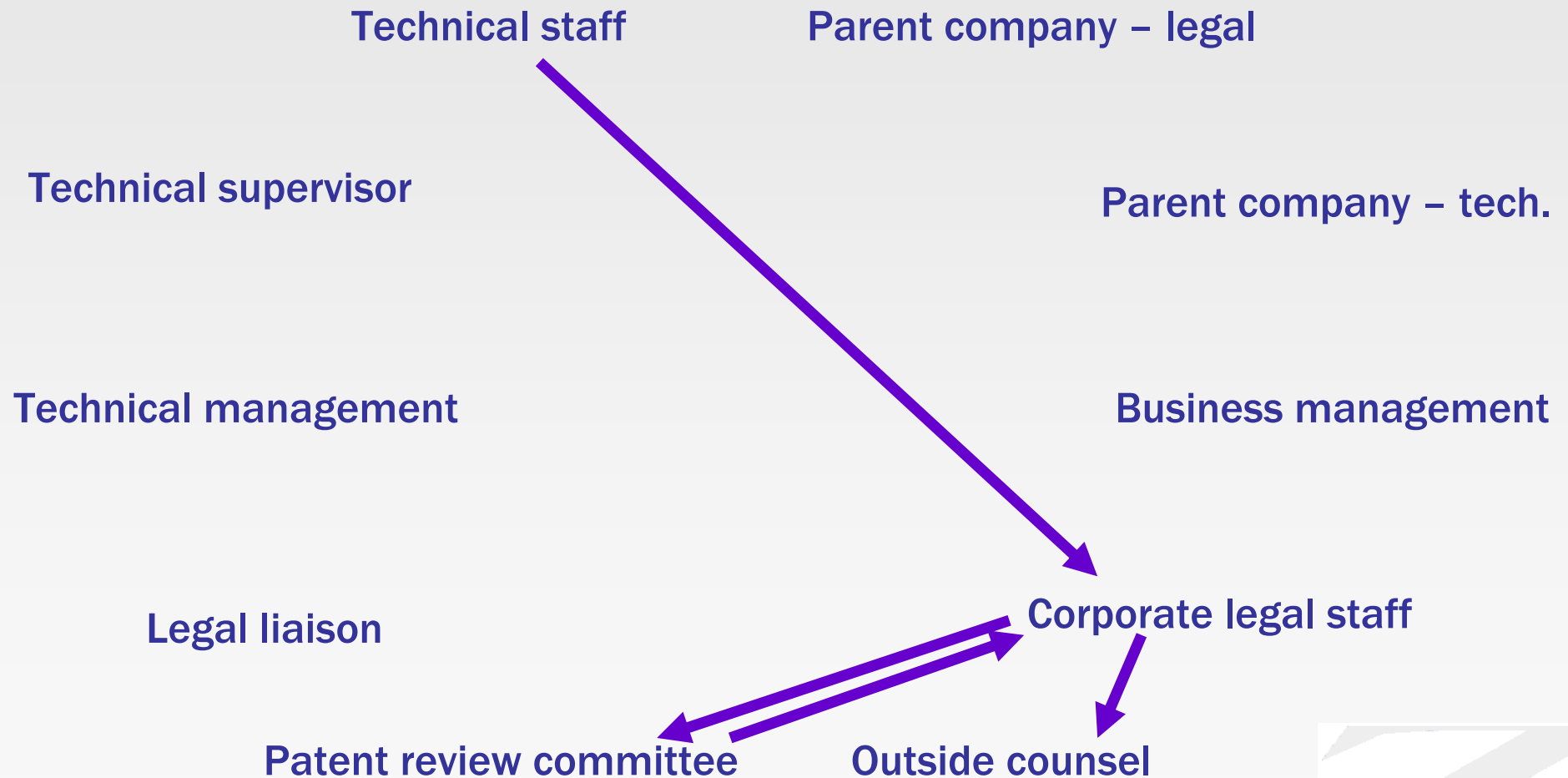
# How information about the invention is communicated to the attorney –

## CORPORATION



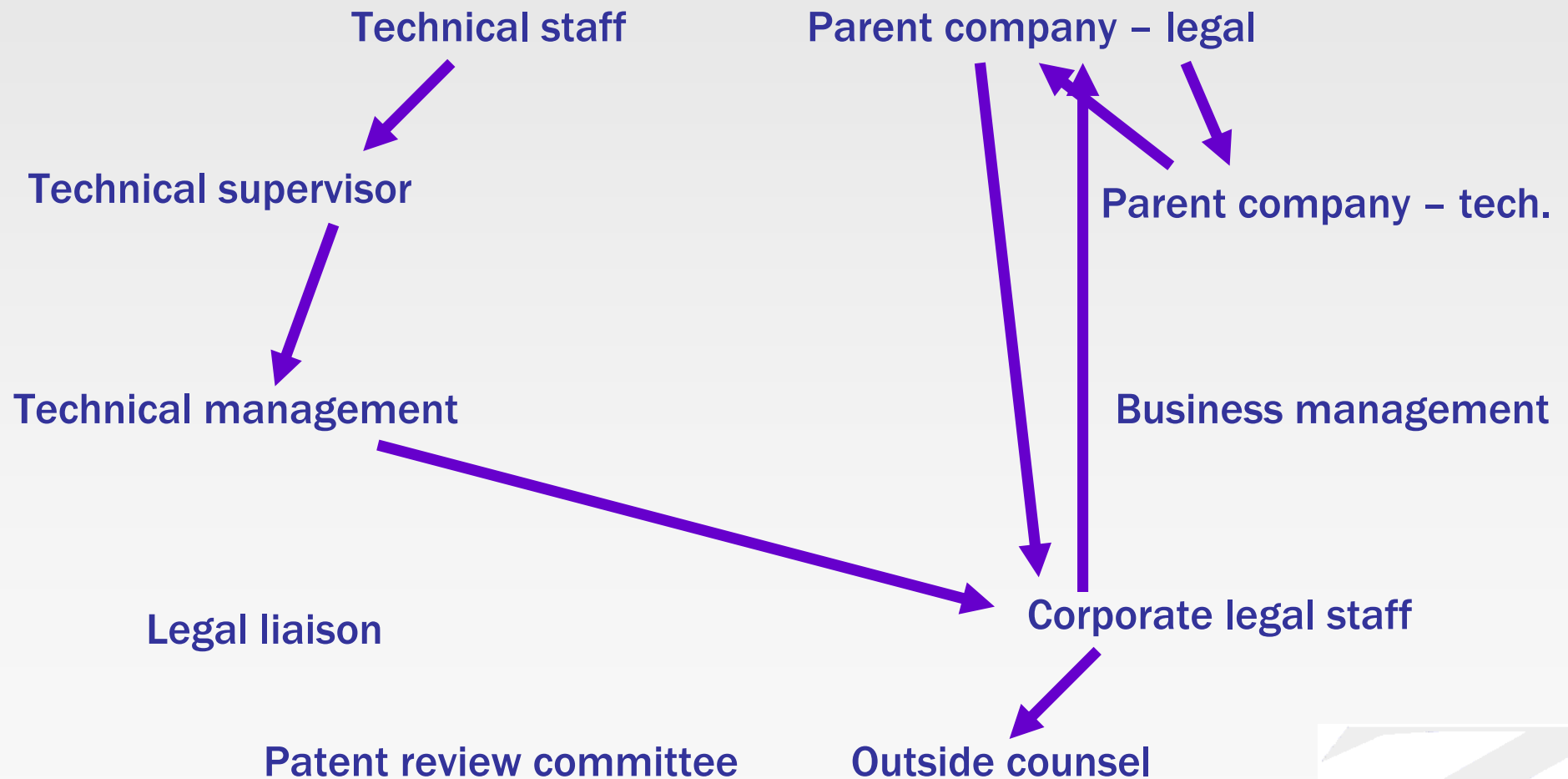
# How information about the invention is communicated to the attorney –

## CORPORATION



# How information about the invention is communicated to the attorney –

## CORPORATION



# Attorney-Client Privilege?

*United States v. United Shoe Machinery Corp.*

---

- **Asserted holder is actual or prospective client of ...**
- **Member of the bar (or a subordinate) acting in capacity as lawyer**
- **Communication made**
  - outside presence of third parties and
  - for primary purpose of securing legal opinion or service



# Attorney-Client Privilege?

*Jack Winter (N. Dist. Cal., 1970)*

---

- Patent attorney as “conduit”
- Most/all Information ultimately disclosed



# United States Patent [19]

Walker et al.

[11] Patent Number: **5,310,178**

[45] Date of Patent: **May 10, 1994**

[54] **BASKETBALL WITH POLYURETHANE COVER**

[75] Inventors: **Alan D. Walker, Somers, Conn.;  
Joseph F. Baltronis, Agawam, Mass.**

[73] Assignee: **Lisco, Inc., Tampa, Fla.**

[21] Appl. No.: **10,956**

[22] Filed: **Jan. 29, 1993**

[51] Int. Cl.<sup>5</sup> ..... **A63B 41/02; A63B 41/08**

[52] U.S. Cl. .... **273/65 B; 273/65 EB;  
273/65 EG; 273/DIG. 8**

[58] Field of Search ..... **273/65 E, 65 EB, 65 EC,  
273/65 ED, 65 EG, 58 BA, DIG. 8, 65 B, 65 R,  
65 C, 65 D**

[56] **References Cited**

## U.S. PATENT DOCUMENTS

2,789,821 4/1957 Crowley ..... 273/65 EB  
3,119,618 1/1964 Molitor et al. .... 273/65 E  
3,219,347 11/1965 Way ..... 273/65 EB  
3,256,019 6/1966 Barton ..... 273/65 EB

4,093,219 6/1978 Piraud ..... 273/65 B  
4,333,648 6/1982 Aoyama ..... 273/65 EB  
4,462,590 7/1984 Mitchell ..... 273/65 E

*Primary Examiner*—George J. Marlo

[57] **ABSTRACT**

An improved basketball comprising an interior spherical bladder formed principally of synthetic butyl rubber with a thickness of about 0.82 millimeters; an intermediate layer of monofilament strands formed of nylon and wound around the bladder to a thickness of between about 0.3 and 0.7 millimeters; an exterior carcass of molded natural rubber formed of two hemispheres with exteriorly projecting ribs or channels; and a plurality of polyurethane inserts formed with matted fibers of nylon or a polyester with a diameter of about 1 micron adhered to the exterior surface of carcass between the channels, the inserts having a thickness of about 1.8 millimeters.

**7 Claims, 5 Drawing Sheets**



# Attorney-Client Privilege?

*In re Spalding Sports Worldwide, Inc. (Fed. Cir. 2000)*

---

- District court ordered production of invention disclosure record
- Appeal → mandamus
- Substantive issue → Fed. Cir. law applies
- Inclusion of technical information irrelevant
- Communication made
  - outside presence of third parties and
  - for primary purpose of securing legal opinion or service



# Attorney-Client Privilege?

*In re Spalding Sports Worldwide, Inc. (Fed. Cir. 2000)*

---

- **Holding:** *“a privileged communication [if] provided to an attorney for the purpose of securing primarily a legal opinion, or legal services, or assistance in a legal proceeding”*
- **Subsequent cases have extended privilege to other prosecution-related documents**
- **High water mark?**



# Invention Disclosure Forms

## Common contents

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
<b>Inventor name(s)</b>	<b>X</b>	<b>X</b>	<b>X</b>



# Invention Disclosure Forms

## Common contents

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
Inventor name(s)	X	X	X
<b>Title</b>	<b>X</b>		<b>X</b>



# Invention Disclosure Forms

## Common contents

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
Inventor name(s)	X	X	X
Title	X		X
<b>Project number/name</b>	<b>X</b>	<b>X</b>	



# **Invention Disclosure Forms**

**Inventors/Contributors**

---

**Who is an inventor?**

**One who contributes to the conception of a claimed invention**

**“Pair of hands” exclusion**

**Who gets named on disclosure forms?**

**Substantial contributors**

**Authorship standard**



# Invention Disclosure Forms

Inventors – useful information

---

- Home address (city/state)
- Citizenship
- Title



# Invention Disclosure Forms

Evaluation aids

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
<b>Keywords</b>	<b>X</b>	<b>X</b>	





# Invention Disclosure Forms

Evaluation aids

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
Keywords	X	X	
<b>Previous submissions</b>	<b>X</b>		<b>X</b>



# Invention Disclosure Forms

Evaluation aids

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
Keywords	X	X	
Previous submissions	X		X
<b>Development status</b>	<b>X</b>	<b>X</b>	<b>X</b>



# Invention Disclosure Forms

Evaluation aids

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
Keywords	X	X	
Previous submissions	X		X
Development status	X		X
<b>Ownership factors</b>	<b>X</b>	<b>X</b>	<b>X</b>



# Invention Disclosure Forms

Evaluation aids

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
<b>Proprietary mat'l used?</b>	<b>X</b>		<b>X</b>



# Invention Disclosure Forms

Evaluation aids

---

	<b>Tech.</b>	<b>Bus.</b>	<b>Law</b>
Proprietary mat'l used?	X		X
<b>Search results / prior art</b>	<b>X</b>		<b>X</b>



# Invention Disclosure Forms

## Description of the invention

---

- **Summary**
- **Distinguishing statement**
- **Detailed description (examples)**
- **Draft claim**

*Try to draft an independent patent claim that contains all of the features of your invention you believe may be necessary to overcome the prior art of which you are aware (this is merely for the purpose of conveying/understanding the scope of what has been invented). Please consider various types of claims (e.g., product, process, apparatus). ...*

*Exemplary format:*

*We claim a (product, process, apparatus) for (an intended purpose), including (elements, steps, components).*



# **Invention Disclosure Forms**

## **Evaluation**

---

- **Position of invention w/in business (core, extension, or tangential business)**
- **Position of invention in product line (basic, strategic, or conceptual)**
- **Patent protection (broad, narrow, or defensive publication)**



# Invention Disclosure Forms

## Memorialization

---

- **Signature & date**
- **Witness(es)**
- **Notarization**

**Memorialization relates to proving date of invention (interference)**

**“We don’t design procedures based on the exception.”**





**A brief word about inequitable conduct ...**



# ***Therasense v. Becton Dickinson***

Amici briefs

---

	<b>PhRMA</b>	<b>BIO</b>	<b>IPO</b>	<b>USPTO</b>
Proper std. for materiality	<b>but for</b>	<b>but for</b>	<b>but for</b>	<b>Rule 56</b>



# ***Therasense v. Becton Dickinson***

Amici briefs

---

	<b>PhRMA</b>	<b>BIO</b>	<b>IPO</b>	<b>USPTO</b>
Proper std. for materiality	but for	but for	but for	Rule 56
Materiality-Intent balance	<b>No</b>	<b>No</b>	<b>Modify</b>	<b>Restate</b>



# ***Therasense v. Becton Dickinson***

Amici briefs

---

	<b>PhRMA</b>	<b>BIO</b>	<b>IPO</b>	<b>USPTO</b>
Proper std. for materiality	but for	but for	but for	Rule 56
Materiality-Intent balance	No	No	Modify	Restate
Infer intent?	<b>No</b>	<b>No</b>	<b>No</b>	<b>No*</b>



# ***Therasense v. Becton Dickinson***

Amici briefs

---

- **Eli Lilly**: Materiality might be able to be inferred from intent, but not the converse
- **J&J + P&G**: Separation of powers, scire facias
- **22 IP firms**: Time-of-action consideration

