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888-53-PATENT * www.frompatenttoprofit.com

Getting Started

If you're just getting started or somewhat new to the world of invention, we'll show you how you can start protecting your rights to file a patent application immediately.

Before you start, please allow us to make a few recommendations that will improve your chances of success dramatically. First, beware of invention promotion companies and patent mills...they are riddled with fraud. We don't know a single inventor who has profited from their services, yet we know hundreds of inventors who have been successful without them. Second, don't rush to file a patent application. This may be a waste of time and money if you don't qualify your invention first. We will show you how to do this in our *Quick Start Guide*.

If you're serious about developing your invention, our *Quick Start Guide* and our proprietary system will get you started building a powerful portfolio in all phases of intellectual property, not just patents. And best of all, you don't have to be experienced or be a legal expert in order to follow the instructions. The *Quick Start Guide* is available online with membership and our start-up kits. Check out our online store to learn more.

If you are on a limited budget, or want to get your feet wet before you jump in, then keep reading, and we'll at least help you get your potential patent rights protected right away. This is done with a form called an *Invention Disclosure*.

After you're printed out the *Invention Disclosure*, read the attached instructions and you're on your way to legal protection:

Best wishes and let us know how we can help.

Sincerely,

Dave Lampson
CEO

Invention Disclosure Instructions

This document establishes the **date of original conception** of your invention. Disclosures are brief summaries, which you'll elaborate on in greater detail later on in a legal journal, such as our *Scientific Journal*. All you need to complete this disclosure a reasonably good idea of how your invention will work.

It's best to fill out an invention disclosure as soon as possible after the date your discovery was made. Include the following:

Title of the invention. Write a descriptive title. For example, "Pot Scrubbing Device" is descriptive, but a nickname, or trademark, like "Potzella" is not.

Background of the invention. Describe what is being used today and problems associated with their use. For example, with our pot scrubber you may say that sponges, Brillo[®] soap pads, and assorted scrub brushes are commonly used as cleaning devices, but all of them harbor bacteria when left wet.

Brief description of the invention. Next, briefly describe your invention and how it fixes the problems you've just described. For example, the pot scrubber may be described as a "nylon mesh pad" made from a continuous length of nylon webbing that is accordion-folded upon itself into the shape of a ball. You can further explain that the open mesh nylon allows air to freely circulate and therefore does not harbor bacteria because it dries quickly.

Detailed description of the invention. In this section show how it looks and how it works with drawings and a written description. You will also tell what it is made of. If your invention is a machine explain how it is used. If it's a computer game, tell how it's played. For an example, with our invention, we might have 3 drawings. They would be:

1. A first drawing shows a length of plastic webbed material being bunched up to form the ball.
2. A second sketch could show how it is bunched up and sewn in the center thereby forming a ball.
3. A third drawing shows the scrubber being used.

It does not matter how well you draw as long as your drawings can be understood and clearly illustrate your invention. Have someone help if necessary.

List the unique attributes. Make a list of the unique aspects of your invention as described in the detailed description. Try to use words such as "unique", "more sanitary", "faster", "easier to use", "convenient", etc.

Other possible uses and variations. List as many as you can imagine. You may find alternate uses later on that have more potential. Also, include all materials and various ways to use and manufacture your invention.

Name, address, date and signature. After completing your disclosure, print

MAINTAIN EXCELLENT
RECORDS

The United States is the only country that determines priority among competing inventors by reference to who was the *first to invent*. The inventor who can prove that he/she: 1) is the *first to invent*, and; 2) exercised *diligence* in reducing the invention to practice is entitled to the patent rights. It is therefore extremely important to establish convincing evidence of your earliest possible *invention date*—
Michael S. Neustel, U.S.
Patent Attorney

your name, address and those of any co-inventors. Sign it in front of a witness.

Validation. This means that someone else must witness your signature, which verifies the disclosure as your invention. Use one of the following:

1. **Reliable witness.** This is someone who understands your invention, but not a business partner or relative. It may be someone such as a neighbor or friend you trust. If you don't know the person well, you should ask have him/her sign a confidentiality agreement like the ones we have online.
2. **Notarize the disclosure.** Most states have notary publics who can place a notary seal on your invention disclosure. It may cost \$10 or more.

Do not mail it to yourself. This is not an acceptable way to validate it.

Reduction to practice

After you have documented your date of original conception, you must thereafter be **diligent** in reducing the invention to practice. **Reduction to practice** means that you either illustrate or show that an invention works the way you say it works. This may be accomplished by either: 1) filing a patent application,¹ 2) constructing a prototype,² or; 3) sufficiently illustrating how the invention works. The latter may be the logical choice in the development of a complex concept such as large machinery. You wouldn't spend millions of dollars solely to prove something when it can be clearly illustrated by a series of engineering drawings. It may be several months later when the actual machine is built.

Due diligence

The date of original conception may only be relied on as the date that determines patentability and priority if the inventor exercised *due diligence* in reducing the invention to practice. Due diligence is accomplished by exercising *continuous activity* from before the conception date of a second inventor to the date of reduction to practice of the second inventor.³ "Continuous activity" does not mean the inventor worked on the invention every day.

To establish due diligence, the inventor must account for the entire *critical period*, which is defined as being from the time just prior to a second inventor's conception date to the second inventor's reduction to practice date. In determining priority, there is no race of diligence. In a priority contest, the party first to conceive and first to reduce to practice prevails.⁴ Where an inventor is the first to conceive but the last to reduce to practice, he must show the exercise

PATENT LAWS YOU SHOULD KNOW

Under current United States patent law, the person who can prove he/she is the "*first to invent*" gets the patent. However, there is proposed legislation that would change this to a "*first to file*" system where the person who is the first to file a patent application gets the patent. If this proposed legislation is enacted it will be in your best interests to apply for patent protection at the earliest feasible date. Also, keep in mind that if this legislation is adopted journal records and the use of confidentiality agreements will become more important than before. An individual cannot file a patent application on an invention revealed to him by another person, confidential or otherwise.—Bob DeMatteis and Michael S. Neustel, U.S. Patent Attorney

¹ Also known as "*Constructive Reduction To Practice*."

² Also known as "*Actual Reduction To Practice*."

³ 35 U.S.C. § 102(g); See *Marconi Wireless Tel. Co. v. United States*, 320 U.S. 1, 34-35 (1943) ("It is well established that as between two inventors priority of invention will be awarded to the one who by satisfying proof can show that he first conceived the invention").

⁴ *New Idea Farm Equipment Corp. v. Sperry Corp.*, 916 F.2d 1561, 1567, 16 USPQ2d 1424, 1429 (Fed. Cir. 1990).

of diligence at the time the subsequent inventor entered the field to the time of his reduction to practice.⁵

Once an inventor has completely reduced his invention to practice he is not required to show subsequent diligence in applying to the Patent Office for patent protection.⁶ However, it is also well established that when there is doubt as to whether there has been an actual reduction to practice, the inventor's subsequent conduct may disclose that, instead of a reduction to practice, the acts relied on showing what the inventor did amounted only to an abandoned experiment.

The most important activity during this initial stage of disclosure is to maintain good records and drawings in your journal. Also, maintain any signed confidentiality agreements, prototypes and material lists in a secure place.

Writing a disclosure and subsequently following through with the invention's development in your journal's pages will help you understand the inventive matter. Knowing the various types of patent coverage you can achieve will guide you in your developmental process. It'll give you a clearer picture of your objectives as you strive to invent the most highly desirable product imaginable. As you write your disclosure, consider all the ways you can turn it into a dazzling, high impact product.

Last, don't forget to visit us online at www.frompatenttoprofit.com.

⁵ Grabowsky v. Gallaher, 39 App. D.C. 548, 1913 C.D. 415, 417 (1913).

⁶ Conner v. Joris, 241 F.2d 944, 951, 113 USPQ 56, 62 (CCPA 1957).

Detailed description continued.

List the unique attributes: *What gives your invention a **unique, marketing advantage** over prior art?*

Potential uses and fields: *What are the various uses and fields in which your invention may be used?*

Ways it can be made: *List the ways it can be **made cost-effectively**?*

Additional Information:

When did you conceive of this invention?..... Date:_____

Have you tested the concept?.....Yes No Date:_____

Have you publicly disclosed it to anyone?.....Yes No Date:_____

Has there been any publication of your invention?.....Yes No Date:_____

Have you offered it for sale?.....Yes No Date:_____

If you have offered your invention for sale, or publicly disclosed it, you may still file a patent application up to one year after the disclosure. If you are unsure whether or not you've made a public disclosure, consult a patent attorney.

Declaration of Inventorship

I (we) believe the described invention to be my (our) own original concept.

Signature _____ Date _____

Full name _____

Street Address _____

City _____ State _____ Zip code _____

Area code _____ Phone number _____ Email address _____

Signature _____ Date _____

Full name _____

Street Address _____

City _____ State _____ Zip code _____

Area code _____ Phone number _____ Email address _____

Witnesses:

If notarizing your disclosure, you may place a notary seal here



Signature _____ Date _____

Full name _____

Street Address _____

City _____ State _____ Zip code _____

Area code _____ Phone number _____ Email address _____

Signature _____ Date _____

Full name _____

Street Address _____

City _____ State _____ Zip code _____

Area code _____ Phone number _____ Email address _____

After completing the disclosure and validating the signatures, maintain the information confidential. You may use it later for a patent search, or as may be required to prove your first to invent position.

