Proving Dates of Invention for US Patents

Unlike most countries, the United States awards patent rights to the first party to make an invention, rather than to the first party to file an application to patent the invention. This is known as the "first to invent" system.

The date of invention can be used by a patentee to overcome prior art citations or to defeat a competitor in interference proceedings. However, until recently, US law only recognised the right to rely on a date of invention if the work was carried out in the US or, in certain circumstances, if the work was communicated into the US. In the past, this put inventors outside the US at a disadvantage in disputes over patent rights with US inventors because they had no US activities. The former were forced to rely on their patent filing dates or priority dates as their dates of invention.

From I January 1996, inventors in countries belonging to the World Trade Organization can rely on evidence of inventive activities conducted in their own countries when proving dates of invention to the US Patent and Trade Mark Office, or before the US courts.

To be able to prove a date of invention, appropriate records must be kept.

If there are no official guidelines, the following procedures are recommended to maximise the likelihood that your records will provide adequate proof of your inventive activities for US purposes. It is essential that any statement by an inventor can be independently corroborated.

We recognise that these recommendations represent an ideal situation, which may not be appropriate or practicable for every applicant. However, they should be followed as far as possible for crucial experiments. We would be happy to assist you in solving any record-keeping problems that may affect your work.

Record Keeping Checklist

- Records should be kept in a bound notebook with consecutively-numbered pages. Special notebooks are available. Records kept on computer are not currently acceptable as evidence of invention.
- Entries should be made in black pen, not pencil.
- The date should be entered on each page.
- New ideas and plans for experiments should be recorded.
- The purpose of each experiment should be indicated.
- Entries should be made directly in the notebook as the experiment is carried out. Results should be entered immediately they are obtained.
- Each experiment performed should be described in detail in the past tense.
- If some of the experimental work is carried out by another person, the data generated by that person should be entered in the bound notebook as soon as the researcher receives it.
- All non-standard terms and abbreviations should be defined in the notebook.

- Some results may be difficult to enter directly into the notebook. Photographs, graphs etc. should be stuck in, and signed and dated across the border to show that they have not been added later. Bulky results, such as large computer printouts, may need to be kept separately. Some laboratories keep separate catalogues of signed and dated printouts numbered by consecutive catalogue numbers, with a description of the results and a cross-reference to the catalogue number entered in the notebook.

- Incorrect entries should never be erased, but should be struck through with a single line.

- Blank sections of pages should be drawn through with a single diagonal line.

- Each page of the notebook should be signed and dated by the person actually carrying out the experiment as soon as it is completed.

- Each page of the notebook should also be signed and dated by at least one witness who can understand the experiment and, ideally, has observed the experiment.

- The witness should be someone who is not likely to be a co-inventor of any invention embodied in the experiment being witnessed. Where possible, critical experiments should be conducted by someone who is not likely to be a co-inventor. A laboratory technician who is working under the direct instruction of the inventor, using standard manipulations, and who is not required to solve any problems in order to perform the experiment will probably satisfy this requirement.

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