

Effective Invention Disclosure Meetings by Shane Jensen

Prior to preparing a patent application for an invention, an invention disclosure meeting should be held between the inventors and the drafting patent attorney. During this meeting, the patent attorney is able to ask questions to the inventors about the invention so that he or she has a good understanding of the invention as the patent drafting process begins. The invention disclosure meeting can be held in-person, either at the inventors' location or at the patent attorney's location, via a web based video application such as Skype, or by a telephone call.

I personally believe that in-person interviews are the most effective for several reasons, even if this requires the patent attorney to travel to the inventors' location. Firstly, during an in-person interview I am able to sit down with the inventors face-to-face and this gives me an opportunity to get to know the inventors and for them to get to know me. This helps to build trust between us, especially as the inventors begin to see that I really care about and understand their invention. In addition, during an in-person invention disclosure meeting I am able to read the body language of the inventors as we have a discussion about the invention. This can be especially helpful as I ask questions as I am able to determine if my questions make sense to the inventors and also if they think that I am properly understanding the invention. In short, in-person interviews provide a superior opportunity for understanding of the invention and are the ideal way to hold the invention disclosure meeting.

However, in-person disclosure meetings are not always possible due to factors such as locations of the inventors and drafting patent attorney preventing an in-person interview, lack of availability of the inventors to hold an in-person interview, or the need for a quick invention disclosure meeting due to an imminent public disclosure of the invention that does not leave time to hold an in-person disclosure meeting. In such cases, a web based video application such as Skype or a telephone call can be used. Although generally less effective than in-person disclosure meetings, both of these can still be effective as the drafting patent attorney is still able to have a discussion about the invention and to ask needed questions. Although the drafting patent attorney may not have the body language insight of the in-

person disclosure meeting, listening for audible clues can help to determine the inventor's demeanor. In addition, taking some time at the beginning of the meeting for a little bit of small talk can help to build trust with the inventors.

Regardless of how the invention disclosure meeting is held, the invention disclosure meeting should be recorded. Recording the meeting allows the drafting patent attorney to go back and listen to the discussion about the invention after the meeting is over. Because these discussions are often complex and fast paced, it is often difficult to take notes about everything that is said. The recording will often pick up an important point about the invention that was missed by the drafting patent attorney during the meeting. The recording also allows the drafting patent attorney to go over important points as many times as needed to ensure proper understanding. I prefer to use a video camera to record the meeting when doing an in-person disclosure meeting as this gives me the opportunity to capture "in real time" the figures and equations the inventors may write on a white board. Other drafting patent attorneys prefer to use a digital recorder and then to take a picture of any figures or equations that are drawn on the white board.

At the start of the invention disclosure meeting, time should be taken to review who the inventors are, whether there has been any type of public disclosure, and similar related legal questions that may need to be resolved before the patent application is drafted. If the inventors are new to the patenting process, this is also a good time to briefly explain the patenting process to them and to let them know what to expect during the process. I have found that this helps to build trust with new inventors and may also answers many of the natural questions they may have. Of course, for experienced inventors this step may not be necessary.

The invention disclosure meeting should focus on the invention disclosure document that should have been prepared by the inventors prior to the meeting and which will typically be used by the drafting attorney to prepare for the invention disclosure meeting. (More detail about the invention disclosure document can be found in a previous blog post from my colleague Brad Barger titled, [Preparing Inventors for the Patent Process](#)). This document will

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generally detail the invention and particularly the inventor's main implementation of the invention. Since the invention disclosure document will not provide details about all possible variations of the invention, the drafting patent attorney should use this document as the beginning point of the discussion. One helpful approach is to have the inventors explain the state of the art in the field of the invention and to explain how the invention overcomes the problems. This will then lead to a discussion of the main implementation of the invention and to possible alternative implementations. As any seasoned drafting patent attorney knows, a patent application that includes more detail about possible alternative implementations will be easier to get allowed in subsequent prosecution and will ultimately provide more protection for the invention when the application is allowed.

The final and perhaps most important step in an effective invention disclosure meeting is to draft a set of claims or at least one or more of the independent claims with the inventors once the invention has been discussed. Drafting the claims during the invention disclosure meeting shows the inventors that the drafting patent attorney understands the invention. In addition, it allows the inventors and the drafting patent attorney to agree on those elements that are believed to be essential to describe the invention in a claim. I have also found that if the inventors agree on the claim set during the invention disclosure meeting, it makes the review of patent application go much more smoothly. An effective way to draft the claim set is to hook up a computer to a projector so that all the inventors can see what is being written by the drafting attorney. Each claim element can then be discussed and those that are deemed not necessary can be removed. If a projector is not available, this can be done using a whiteboard, a notebook, or a computer screen that is able to be viewed by all the inventors.