

## CONFIDENTIAL INVENTION DISCLOSURE QUESTIONNAIRE

If a non-provisional patent application is filed for your invention, you will be required to sign an oath or declaration acknowledging the **duty to disclose information to the Patent Office**. Failure to disclose relevant information could result in the loss of patent rights. The following two paragraphs summarize the duty to disclose:

Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Patent Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability. Information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an argument of unpatentability relied on by the Office, or (ii) Asserting an argument of patentability. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Patent Office or submitted to the Patent Office. The duty to disclose continues while the patent application is pending.

Individuals associated with the filing or prosecution of a patent application, within the meaning of the duty to disclose, are:

- (1) Each inventor named in the application;
- (2) Each agent or attorney who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assigned owner of the application (e.g., employer) or with anyone to whom there is an obligation to assign ownership of the application. Individuals other than the inventor and the agent or attorney may comply with the duty to disclose by disclosing information to the agent or attorney, or to an inventor.

The confidential information that you provide in response to this questionnaire is needed in order to submit a proper patent application and to satisfy the duty to disclose.

**1. GIVE A DESCRIPTIVE TITLE TO YOUR INVENTION** (approx. 2-7 words in length)

**2. DESCRIBE YOUR INVENTION:**

Sketch drawings that show **all** significant features of your invention, numbering each feature in the drawings (as 1, 2, 3...). Then, write a description of what the invention is and how it works, referring to numbered features in the drawings. This will ordinarily take at least several pages. Your description needs to stand alone as a complete blueprint for how to make and use the invention, understandable by a person having ordinary skill in the technology area to which the invention pertains (i.e., someone who would be familiar with technical terms that you use to describe your invention, but who is not necessarily an expert). **Be specific** (if your invention contains, say, a water pump, give a model number). Give alternative features when appropriate (e.g., state that you could use "either copper or aluminum").

### 3. WHAT IS THE BEST MODE OF MAKING AND USING YOUR INVENTION?

Among any alternative ways of making and using your invention (described in response to Question 2), do you have reason to believe that any one of them is better than the others?

Note that a patent application must disclose what is truly the best way to make and use the invention. For example, assume that you have invented a new adhesive, containing a mixture of components A, B, and C. You have also discovered that if you add component D to the mixture, it results in a much stronger adhesive. Your patent application for the new adhesive **must** disclose the mixture A+B+C+D, not just A+B+C, otherwise any resulting patent could be invalidated.

### 4. WRITE A CONCISE SUMMARY OF THE ESSENCE OF YOUR INVENTION:

This can be tricky, so before writing it, consider the following examples, for various types of inventions.

If the "invention" were the process of walking across the street, the essence might be something like: (1) a person ambulates to a distance of less than 25 centimeters to the closest curb of a street; (2) said person looks to the left and to the right; (3) said person waits until the distance to any moving vehicle is perceived to be greater than 50 meters; (4) said person places a foot upon the road; (5) said person ambulates across the road; (6) said person places a foot upon the far curb; and (7) said person continues ambulating away from the road.

If the invention were a doughnut making machine, its essence might comprise: (1) an input conveyor that receives dough to be used in making said doughnuts; (2) means for portioning dough from said input conveyor into a plurality of dough balls, each of said plurality of balls containing dough sufficient to create a single doughnut; (3) means for forming each of said dough balls into a ring of dough; (4) a deep fat fryer which receives rings of dough from said forming means and cooks said rings of dough; (5) means for selectively applying a flavored coating on cooked rings of dough to produce doughnuts; and (6) means for placing a plurality of said doughnuts on a flat sheet.

If the invention were manufactured material for a diver's wet suit, its essence might comprise: (1) an outer layer comprising a structural fabric; (2) a first inner layer of a plush layer of a combination of cotton, silk, wool, and synthetic fabric interwoven together, said first inner layer bonded to said outer layer; and (3) a second inner layer of a plush layer of cotton, silk, wool, or synthetic fabric, bonded to the first inner layer opposite the outer layer; wherein a water-resistant material comprises a bond between said outer layer and said first inner layer.

If the invention were a composition of matter, its essence might be something like "a metal alloy comprising at least 20% by volume of iron, at least 10% by volume of gallium, and at least 10% by volume of copper".

So, write what you think is the entire essence, and nothing but the essence, of your invention. You can use technical and legal-sounding terms like "said widget", "plurality of", etc. if you'd like, but it is more important to be very clear and concise. All inventions have both a structure and a function. Here you are trying to distill its structure (not its function) into a few words. **Give the essence of what the invention is, not what it does** (the latter comes in the next question). State the essence as broadly as possible, but consistent with what you have written in response to Question 2.

## **5. WRITE A SUMMARY OF THE FUNCTION OR PURPOSE OF YOUR INVENTION**

Summarize how and why someone would use your invention. What problem does your invention solve? How does it solve that problem? (i.e., what is the objective or purpose of using your invention?) How would someone go about using your invention, and how would they know whether it works?

## **6. HOW IS YOUR INVENTION NOVEL?**

**A. (Structural Novelty):** Making reference to the numbered items in the drawings from Question 2, what elements (individually or collectively) are new to your invention, and what elements were known to the public before your invention? If you start with the closest already-known product or process, what steps would be involved in converting it into your invention?

**B. (Functional Novelty):** Give general context to your invention as follows. Do there already exist products or methods that solve problems like the ones you identified in connection with Question 5? What functional properties of your invention distinguish it from existing products or methods? What are the advantages and disadvantages of your invention, when compared with existing methods or products?

If you have already done a search of domestic and foreign patents, non-patent literature, sales literature, web sites, trade-show handouts, and the like, make a list of what you have searched and what you have found. Be specific about your search method. If, for example, you used keywords and phrases to search patents at the Patent Office web site [www.uspto.gov](http://www.uspto.gov), what are the keywords and phrases that you used, and what are the identifying numbers of the patents that you found to be relevant to your invention?

## **7. DESCRIBE HOW YOU MADE YOUR INVENTION.**

Give the full name, mailing address, and citizenship of each person who was involved in the conception of the invention, the building of a prototype (if any), and the testing of the prototype (if any). For each such person, indicate whether they made any part of their contribution as an employee or contractor of some organization, whether they made use of resources owned or supervised by some organization, and whether their contribution was in any way made possible by the funding of a third-party (e.g., a government grant). For each of these people, describe what they contributed to the invention and when they did it. Each such person should be given an opportunity to write an independent written account of the conception/building (if any)/testing (if any) of the invention. If there are any uncertainties or disagreements, they should be indicated.

Begin your narrative with something like ... On [give date], [give person's name] was pondering the problem of how to [give problem to be solved]. He/She noticed that [give triggering observation or thought] and realized that [state how the observation illuminated the problem at hand]. He/She thought that instead of [state the usual way of doing things], it would be better to [state the potentially better way of doing things]. He/She described the solution to colleagues [name the individuals] on [give the date]. One of them, [name him or her], indicated that it was a good idea and gave a specific suggestion about how to implement [state the specific suggestion made], etc., etc.

Be sure to include the acquisition of relevant information by the inventors and others at conventions, plant visits, in-house reviews, etc. Also, identify any notebooks or other materials that document the narrative that you provide. Identify any other inventions that you have made that are related this one.

**8. DESCRIBE PUBLIC DISCLOSURE OF THE INVENTION:**

**A.** Describe the date and persons in attendance of any oral presentation in which the invention has been or will be described. Indicate whether there was an explicit understanding as to whether the presentation was confidential.

**B.** Describe the date and recipient of any written presentation in which the invention has been or will be described. Indicate whether there was any explicit understanding as to whether the presentation was confidential.

**C.** Describe and date any circumstance in which the invention was used in public or could be observed by a member of the public, irrespective of whether a member of the public was aware that he/she could be observing a new invention. (For example, you invent a new paint and use it to paint your house. As another example, you invent new laboratory apparatus, and members of the public could see the apparatus while being given a tour of your laboratory).

**D.** Describe and date any circumstance in which a product or method embodying the invention was offered for sale or gift to any member of the public.

**9. IDENTIFY THE INVENTOR WHO WILL COORDINATE THE PATENT APPLICATION:**

If more than one potential inventor was identified in connection with the response to Question 7, who among you coordinated the preparation of answers to this disclosure questionnaire? Unless advised otherwise, it is assumed that you will be the contact-person for the patent application.