

Developing an IP Harvesting Plan

By [Ryann H. Beck](#)

Pursuing a patent starts with an invention. Harvesting the inventions of your employees is an important part of developing a valuable patent portfolio for your company. If an employee (“inventor”) has developed a new product or product improvement, or even a product concept, it is important to track and assess that invention for patentability. One way of identifying and tracking such inventions is through a formal invention disclosure program wherein employees submit invention disclosure forms to management. The invention disclosure forms are assessed by management, perhaps with the assistance of patent counsel, to determine whether pursuing patent protection is appropriate and whether the invention should be maintained in confidence until patent protection is applied for.

Invention Disclosure Forms

An invention disclosure form is a confidential document completed by any employee to identify and document the basic information regarding an invention. The invention disclosure form can be used internally within the company to evaluate whether patent protection should be sought, and will be used by patent counsel at Andrus to gain an initial understanding and assessment of the invention.

An invention disclosure form should ask the inventor to provide one or two paragraphs describing the invention, highlighting the novel feature(s) that differentiate the invention from the prior art, and request inclusion of detailed diagrams or drawings of the invention. Further, an effective invention disclosure form answers the key questions identified in the adjacent diagram.

Key elements to be included on an invention disclosure form.

- Describe the invention.
 - What are the novel features of the invention?
 - How is the invention different from prior art?
 - Provide detailed diagrams or drawings.
- When was the invention conceived?
- Who participated in conceiving of the invention?
- Has the invention been reduced to practice or a working prototype developed?
- What problem prompted the invention or is solved by the invention?
- Has this invention been revealed to persons outside of the company, published, or offered for sale?
- Are there any immediate plans to reveal, publish, or offer the invention for sale?
- What is the closest prior art (device, method, publication, patent, etc.) to the invention that you know of?
- How could one design around this invention (i.e. accomplish the same outcome or solve the same problem without utilizing the invention)?

(Continued on page 2)

(Continued from page 1)

Assessing Inventions for Patent Protection

The invention disclosure form serves two key purposes. First, it allows the company to assess the value of the invention and to determine whether seeking patent protection is appropriate. For example, the company may make decisions regarding whether to pursue a patent for an invention based on factors such as competitive advantage, projected sales, and infringement risks, with a clear focus on maintaining alignment with company's strategic objectives and product development plans. Since the process of obtaining a utility patent involves multiple steps that can be time consuming and expensive, patent protection may not always be the appropriate or most desirable form of IP protection. Second, if the company decides to move forward with applying for a patent, then the invention disclosure form provides an excellent starting point for an Andrus patent attorney to get a preliminary understanding of the invention and to note any impending bar dates or filing deadlines.

Where it is decided that a patent application may be appropriate to pursue, the company should contact its patent attorneys at Andrus to make a final assessment of patentability and a plan for filing the appropriate application. One important factor to consider with your attorney is whether filing for foreign patent protection is valuable for the particular invention. If foreign filing is desired, additional steps for successful patentability must be followed, including preventing any disclosure of the invention to individuals or entities outside of the company prior to filing a patent application.

IP protections and laws are detailed and complex and the information provided herein is not exhaustive. Please consult with your IP Attorney at Andrus with any IP related questions you might have to ensure that your company's IP is harvested and managed properly. We suggest working closely with your IP attorney at Andrus to develop a comprehensive and personalized IP management plan, including written policies and procedures for handling invention collection and confidentiality.

FIRM AND CLIENT NEWS

Joseph Kuborn and George Solveson Named IP Stars by Managing IP - Attorneys Joseph D. Kuborn and George H. Solveson were selected for inclusion in *Managing Intellectual Property's* 2014 edition of *IP Stars* list. *IP Stars* highlights attorneys with a strong understanding of products and industry areas, as well as the requisite legal experience.

Jury Awards \$9.75 Million to Client Douglas Dynamics - In April 2014, a jury awarded \$9.75 million to Andrus' client Douglas Dynamics, LLC ("Douglas") in a patent infringement case in the Western District of Wisconsin.

The original suit involved infringement of three of Douglas' patents related to snowplows. The jury heard the case on patent damages after a 2013 [decision](#) from the U.S. Court of Appeals for the Federal Circuit directed the District Court for the Western District of Wisconsin to "enter summary judgment of infringement in favor of Douglas."

Douglas was represented by Andrus attorneys Aaron Olejniczak, Christopher Liro, Ed Williams and George Solveson.

Douglas Dynamics Tops List of Fastest-Growing Public Companies - Andrus congratulates client Douglas Dynamics for its top ranking in the list of Fastest Growing Public Companies, published in The Business Journal Milwaukee on April 11, 2014.

Client Hydro-Thermal Corporation Named a Top 10 Business of the Year by BizTimes Media and Waukesha County Business Alliance - Congratulations to Andrus' client Hydro-Thermal Corporation, which was named a 2014 Top 10 Business of the Year by BizTimes Media and Waukesha County Business Alliance. The annual awards program recognizes companies headquartered in southeastern Wisconsin that have consistent financial growth and demonstrate a commitment to good business practice through their employee relations, customer-focused commitment and community service involvement.

Andrus Supports UPAF through Workplace Giving Campaign - Andrus employees participated in a Workplace Giving Campaign in support of the United Performing Arts Fund (UPAF) in May. UPAF is a donor-sponsored program that supports the performing arts in Southeastern Wisconsin.