Inventorship
2012 IP Summer Seminar

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July 2012

Agenda
♦ Meaning of Inventorship
♦ Determination of Inventorship
♦ Joint Inventorship
♦ Proof of Inventorship
♦ Correcting Inventorship
♦ Missing and Uncooperative Inventors
♦ Hypothetical Scenarios/Questions
35 USC 101
Inventions Patentable

♦ Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Importance of Inventorship in United States

♦ Only Inventors can be Applicants for a patentable invention
♦ Patent Rights are awarded to those individuals who are first to invent (Interference)
♦ First to invent ⇒ subject to change
The invention is made complete as defined in [*Mergenthaler v. Scudder*, 11 App. D.C. 264, 1897 CD 724 (CADC 1897)].

It is, therefore, this formation in the mind of the Inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice that constitutes an available conception within the meaning of patent law.

[*In re Tansel*, 117 USPO, 188, 189 (CC PA 1958)]

The “complete and operative” invention requirement is met if the inventor is able to make a disclosure which would enable a person of ordinary skill in the art to construct the invention without extensive research or experimentation.

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The making of an Invention involves three stages:

- Conception
- Reduction to Practice; and
- Interim Activity Directed Toward Accomplishing the Reduction to Practice

Stages 2 and 3 may be done by anyone under the Inventor’s direction

Conception (Stage 1) is done solely by the inventor or inventors

Thus, the determination of Inventorship always requires a determination of conception.
Creation/Discovery of an Invention

♦ A Variety of ways
♦ Accident
♦ Sudden Realization (Eureka!!)
♦ Step by Step Experimentation

♦ The manner in which the invention is made is irrelevant
♦ In some cases, conception and reduction to practice can occur simultaneously
♦ Utility is a necessary ingredient of conception

Inventorship

♦ Is not equivalent to academic authorship
♦ Is not a reward for hard work
  ♦ (see Fina Oil and Chemical Co. v. Ewen, 123 F.3d 1446 (Fed. Cir. 1997); Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367 (Fed. Cir. 1986))
♦ Mis-information about Inventorship can lead to inequitable conduct and patent invalidity (see Perspective Biosystems, Inc. v. Pharmacia Biotech Inc., 325 F. 3d 1315 (Fed Cir. 2000))
Determining Inventorship

- Information needed by the Attorney from Inventors:
  - State of the Art (relevant prior art)
  - Improvement by inventions over the art
  - How to make and use the Invention
  - Substitution for inventive element

- Drawings or schematic diagrams
- When earliest work began on Invention
- Where writings about Invention are kept
- Inventor’s published works
- Ultimately, claims are most important!!
Determining Inventorship

- It is a legal determination (by the attorney)
- There is no set procedure for determining inventorship
- Although some degree of diligence is required

**Ideal Procedure**
- Provide each potential inventor with a set of claims as the claims will or have been filed with the USPTO
- Ask the potential inventors to describe, in writing, what was the original conceptual contribution to the subject matter of the claims to which they believe they provided significant contribution

**Practical Procedure**
- Ask each inventor to place their initials beside each claim to which a conceptual contribution was made

Joint Inventorship

- Inventors must make some joint effort
- Cannot join competitors to eliminate inventorship problems
- No need to physically work together (A→B→C)
- No need to work at the same time
- No need to contribute same amount
- **One claim is enough** (See *Kimberly-Clark Corp. v. Procter & Gamble Distributing Co. Inc.* 973 F.2d 911; Fed. Cir. 1992)
Proof of Inventorship

- Courts and USPTO will not accept unsubstantiated testimony from an individual that they thought of the invention; and on a particular date
- There must be corroborating evidence of inventorship
- The best evidence is a well-kept laboratory notebook or other written documentation
- Electronic laboratory notebooks (ELNs)—Maybe

Laboratory Notebooks

- For purposes of providing evidence, laboratory notebooks:
  - Need corroboration by a disinterested witness
  - “Disinterested” means that the witness cannot be an inventor
  - Witness must be of sufficient skill in the art to understand and comprehend the scientific material (i.e., invention)
  - Witness must sign and date the pages of the notebook that are witnessed
  - The face of the notebook page should present no suggestion that the data or information presented has been altered or modified which would cause one to question its truthfulness
**Electronic Notebooks**

- For purposes of providing evidence, electronic notebooks:
  - Standards and guidelines for what is acceptable - a work in progress and not yet firmly established
  - Suggested Requirements/Guidelines
    - Reliable
    - Independent corroboration of ELN entries
    - Limiting ELN access to authorized users
    - Authentication of identity of authorized users (e.g., password + fingerprint)
    - Authentication of ELN records created by each authorized user

**Correction of Inventorship**

**Incorrect Inventorship**

- Any patent identifying as an inventor one who is not an inventor is invalid unless the inventorship can be corrected by adding, removing or substituting the proper inventor or inventors for the erroneously designated inventor or inventors
- Possible Scenarios
  - A is named as the inventor whereas B is the true inventor
  - A is named as the inventor whereas A and B are joint inventors
  - A and B are named as inventors whereas A alone is the true inventor
  - A and B are named inventors whereas A and C are the true inventors
  - C and D are the true inventors
Correlation of Inventorship

- If an individual is erroneously named in a patent application or an issued patent, the error may be corrected; if it was made without deceptive intent, at either of two stages:
  - During Application Stage (amending the application to name the true inventors or filing a continuation application which names the true inventors)
  - After the Patent has issued (corrected thru the USPTO or Court of Law)

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Correlation of Inventorship

- Request Correction during prosecution or post-issuance (see 37 CFR 1.48 and 1.324)
- Different Procedural Requirements for provisional applications, non-provisional applications; issued patents; adding inventor(s), deleting inventors; claim amendments, etc.
- Generally, procedures require a Statement of No Deceptive Intent:
  - From added and deleted persons
  - No other verification required
  - Oath or declaration from each of the actual inventors
  - Consent of Assignee
Missing Or Uncooperative Inventors

- Dead, insane or incapacitated inventor – legal representation can sign instead (37 CFR 1.42)
- If an inventor refuses to sign or is unavailable:
  - Petition PTO to permit other inventors or Assignee to sign
  - Need: Proof of Facts
  - Diligent effort to locate inventor and last known address of missing inventor
  - If assignee must sign – need showing that action needed to preserve rights or prevent irreparable damage

Conclusions

- Conception is key to determining Inventorship
- Inventors conceptual contribution to claims is imperative
- Incorrect Inventorship or Inventorship based on Deceptive Intent \(\Rightarrow\) Invalid Patent
- Correction of Inventorship is available during prosecution or post-issuance
**Question 1**

♦ You are asked to determine inventorship of an improved razor blade wherein the invention resides in a cutting edge having a symmetrical sawtooth configuration

♦ A, technical manager of the razor blade department of X Co. instructed B, his assistant, to develop a razor blade that would provide better shaves than the company's existing silicone-coated blade

♦ B studied various blades including irregularly jagged-edged blades and thought of the idea of a symmetrical saw-tooth edge blade

♦ B instructed C, his assistant, to make such a blade

♦ C made the blade according to B's instructions and ran standard tests that established its improved quality

♦ What is your decision on inventorship?

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**Answer**

♦ B is the sole inventor

♦ A merely described a general result to be achieved

♦ C merely carried out B’s explicit instructions

♦ B’s idea was sufficiently concrete to enable one to make the invention without undue experimentation

♦ Thus, B conceived the invention and is the sole inventor
Question 2

- A conceives of an invention while in France on a business trip
- He writes to B in the United States describing his thoughts
- B reduces the invention to practice at his laboratory in Minneapolis
- Determine inventorship

Answer

- A is the inventor because he conceived the invention
- B cannot be an inventor since he did not contribute to the conception of the invention and thus is not an original inventor
- The fact that conception occurred outside the United States is irrelevant
Question 3

♦ You represent X Co.
  ♦ Employee A conceived an invention on May 1, 2003
  ♦ He wrote a report on his conception that was circulated to other departments of the company
  ♦ He decided to delay work on the invention until June 1, 2003
  ♦ A reduced the invention to practice on August 1, 2003
  ♦ Employee B read A's report on May 15, 2003 and diligently reduced the invention to practice on June 15, 2003
  ♦ Determine inventorship

Answer

♦ A is the inventor
♦ A independently conceived the invention and is the original inventor
♦ B derived the invention from A and therefore is not an original inventor
Question 4

♦ Would the result in question 3 change if B had independently conceived the invention?

Answer

♦ Yes, Both A and B are original inventors, but B was prior to A
Question 5

♦ An application was filed naming A as the sole inventor
♦ The application is placed in an interference and you are retained to handle the interference
♦ In preparing the preliminary statement, you find that B was a joint inventor with A, but because B had a prior obligation to assign the invention to, a former employer, a decision was made not to name B as a joint inventor
♦ Can the application be converted to a joint application?

Answer

♦ No, because the original decision to name A as the sole inventor was done with deceptive intention
Question 6

- A is hired by B to assist in developing a bicycle horn
- A agrees in writing to assign to B all A's rights in any invention conceived by A during his employment by B
- A and B succeed in jointly developing the bicycle horn
- A refuses to assign his right to B
- Can an application be filed naming B as the sole inventor?

Answer
- No. The application must identify the true inventors
- A's agreement to assign his invention to B does not excuse this requirement
Question 7

- A and B work in different divisions of Giant Co
- A develops an insulating surface coating for an electrographic copy paper
- Subsequently, B, who knows of A's special surface layer, develops a metallic layer that will serve as an intermediate layer for this copy paper to be located between a conventional base and the surface coating developed by A
- The claim for the invention reads: An electrographic copy paper comprising a base, a metal layer overlying said base, and an insulating surface coating overlying said metal layer
- Determine inventorship of that claim

Answer

- A and B are joint inventors
- Both contributed significant features to the invention as claimed
- The fact that A and B did not conceive of the invention simultaneously or that B's work occurred after A's was completed is immaterial
Question 8

- A is working on the development of a process for synthesizing chemical X
- In the course of his work he asks B for a compound Y, which B provides
- A uses compound Y to produce compound X
- Determine inventorship of the process

**Answer**

- **A is the sole inventor**
- The mere fact that A obtained a reactant from a co-worker does not make B a co-inventor since by specifying the compound he needed, A clearly had conception of chemical X
Question 9

♦ John Doe, a sole inventor, engages you, a duly registered patent agent, to prepare his patent application
♦ The application must be filed by July 1, 2003 to avoid a statutory bar
♦ Doe realizes he will be on vacation in the Canadian wilderness when the application is completed and will be unavailable to execute the application
♦ He asks you whether he can provide you with written authority to file the application upon his behalf due to his unavailability
♦ Is this proper?

Answer

♦ Yes, under 35 USC 111, an application may be filed by the inventor or one whom the inventor authorizes to file the application
♦ However, an application that is filed without the signature of the inventor must be perfected, by subsequent filing of a properly signed oath and declaration, within time periods set by the Patent Office
Question 10

- If the correct inventor or inventors are not named in a nonprovisional application for patent through error without deceptive intent, the application may be amended to name only the actual inventor or inventors.

- Included, in the types of changes which are permitted when such error arises, is a change from:
  
  (a) Sole inventor to a different sole inventor
  
  (b) Sole inventor Jones to different joint inventors Smith and Ray
  
  (c) Joint inventors Smith and Ray to a different sole inventor Jones
  
  (d) Joint inventors Smith and Ray to different joint inventors Jones and Green
  
  (e) Each of the above

**Answer**

(e) Each of the Above