



THE “MUDDY METAPHYSICS” OF INVENTORSHIP: WHAT YOU NEED TO KNOW

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1

Overview

- Statutory Basis
- Court Decisions
- Who is (and is not) an inventor?
- Why do we care?
- How to Determine Inventorship
- Correcting Inventorship
 - USPTO
 - Court
- Why challenge inventorship?

Statutory Basis - Inventorship

The US Constitution and the US patent system are set up to reward and protect the **inventor**

The Congress shall have the power . . .

. . . to promote the progress of science and useful arts, by securing for limited times to authors and **inventors** the exclusive right to their respective writings and discoveries

U.S. Constitution, Article I, § 8

An application for patent that is filed under section [35 USC] 111(a) or commences the national stage under section [35 USC] 371 shall include, or be amended to include, the name of the **inventor** for any invention claimed in the application.

35 USC § 115(a)

Statutory Basis - Joint Inventorship

- 35 USC § 116 (2004)
- When an invention is made by two or more persons jointly, **they shall apply for patent jointly** and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though
 - (1) they did not physically work together or at the same time,
 - (2) each did not make the same type or amount of contribution, or
 - (3) each did not make a contribution to the subject matter of every claim of the patent

Court Decisions - Conception

- “The threshold question in determining inventorship is **who conceived the invention.**” *Mueller Brass Co. v. Reading Industries Inc.*, 176 USPQ 361, 372 (E.D. Pa 1972), *aff’d*, 180 USPQ 547 (3rd Cir. 1973)
- Joint inventorship has been said to be “one of the murkiest concepts in the muddy metaphysics of patent law.” (*id.*)
- “**Conception is the touchstone of inventorship**, the completion of the mental part of invention.” *Sewall v. Walters*, 21 F.3d 411, 415, 30 USPQ2d 1356, 1359 (Fed. Cir. 1994)

Court Decisions – But what is conception?

- Conception is "the formation in the mind of the inventor, of a **definite and permanent idea of the complete and operative invention**, as it is hereafter to be applied in practice." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (citation omitted)
- An idea is definite and permanent when the inventor has "**a specific, settled idea, a particular solution to the problem at hand**, not just a general goal or research plan he hopes to pursue." *Fiers v. Revel*, 984 F.2d 1164, 1169, 25 USPQ2d 1601, 1605 (Fed. Cir. 1993)

Who is (and is not) an inventor?

- **Inventorship is:**

- only by true and original inventors
- determined based on conception
- a legal determination
- based on each claim separately
- supported by corroborating evidence

- **Inventorship is not:**

- the same as authorship
- based on monetary support or supervisory role
- posing a problem to be solved without a solution
- suggesting a desired result without a way to achieve that result
- providing information on prior art or obvious additions
- performing experiment to reduce an invention to practice
- following the instructions of others

Who is (and is not) an inventor?

- Reduction to practice (alone) does **not** determine inventorship
 - a showing of the invention in physical or tangible form
 - can be carried out by the inventors or others under their direction and control
- Actual reduction to practice
 - prototype or working model
 - successful experiments
- Constructive reduction to practice
 - file a patent application that meets the requirements of 35 USC § 112

Why do we care?

- Each inventor of even a single claim is presumed to be an owner of the entire patent
- Without assignment employer may not have rights in application, patent, or invention
- **35 U.S.C. § 262**
 - In the absence of any agreement to the contrary, . . . each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, . . . without the consent of and without accounting to the other owners.
- Employment agreements should require that the employee “hereby assigns” any rights in inventions they make that relate to the employer’s business (not just an obligation to assign)
 - *Stanford University v. Roche Molecular Systems*, 563 U.S. 776 (2011)

Why do we care?

- Inventors typically have an obligation to sign declarations and other documents required for filing patent applications
 - There are exceptions if you have an unwilling or unavailable inventor
- Inventors must comply with an ongoing duty of disclosure
 - Material inconsistent with statements in application
 - Prior art – including inventor's own work
 - Sales or offers to sell the invention
 - Public disclosures of the invention

How to Determine Inventorship

- **Determining sole inventorship** is generally straightforward and can be based on a client's Invention Disclosure Form (IDF)
 - A few questions relating to how and when the inventor named in the IDF came up with the invention usually suffice
 - if there is no dispute by the client, corroboration is generally not required, but is often available in the form of the inventor's notes, emails, lab notebooks, etc.
- **Determining joint inventorship** is typically more complex
 - Collaboration is essential - **each inventor must contribute to the joint arrival at a definite and permanent idea of the invention**
 - Must be **some element of joint behavior**, such as collaboration or working under common direction, one inventor seeing a relevant report and building upon it or hearing another's suggestions at a meeting (but can be minimal and indirect)

How to Determine Inventorship

- Make determination after the entire application and claims have been prepared
- Must analyze each claim
- Determine whether each inventor reasonably believes herself to be the original and first inventor
- Interview possible inventors
 - individually
 - as a group
 - both
 - Look for consistency and credibility in explanations
- Compare contributions of possible inventors to the claims

How to Determine Inventorship

- Review documentary evidence
 - Invention disclosure, notebooks, thesis, inventor publication, invention records, reports, meeting minutes
 - Re-interview inventors if needed
- Look for corroborating evidence
 - Disclosure of completed thought to another may be useful
 - Ideal to record and date the invention witnessed by someone who understands the invention
- Make a final determination of inventorship and record results in a file memo
- Note possible conflicts between potential inventors
- Keep in mind that inventorship can change during prosecution

How to Determine Inventorship - Questions

- Do you believe that you should be named as an inventor?
 - Why or why not?
- Why, when, where, and how did you develop this invention?
- What was the problem you were trying to solve?
- What background information (closest prior art) did you have at the start?
- Did you work with anyone else or receive suggestions, ideas, or recommendations from anyone else not listed on the IDF?
- Do you believe anyone else should be named as an inventor?
 - Why or why not?

How to Determine Inventorship - Questions

- Do you have any records describing the work that was done?
 - If not, why not?
- Have you reduced the invention to practice?
 - Who? When? Where? How?
- Did you encounter any problems while reducing the invention to practice?
 - If so, describe the problems, how they were resolved, and who solved them.
 - Experimental failures may reveal uncertainty that undermines the “definite and permanent” requirement for conception

Correcting Inventorship – at the USPTO

Pre AIA (9/16/2012)

- Must meet “no deceptive intent” requirement
- Pending non-provisional
 - Fee, request to correct error signed by applicant, statement from the inventors that there was no deceptive intent in the error, new declarations from inventors, consent from assignees
- Pending provisional
 - Fee, request to correct error signed by applicant, fee, eventual oath and declaration in non-provisional will determine final inventorship
- Patent
 - Certificate of Correction - Fee, statement from inventors that no deceptive intent, request from application with a description of error, new declarations from inventors, consent from assignees

Correcting Inventorship – at the USPTO

Post AIA (9/16/2012)

- The “no deceptive intent” requirement was removed and the new rules apply to all corrections requested after 9/16/2012
- Pending non-provisional
 - An ADS listing the correct inventors; fee; oath or declaration for newly added inventor(s) (or substitute statement); an additional fee if an Office Action has issued on the merits, or a statement that inventorship change is due solely to cancellation of claims
- Pending provisional
 - Request signed by applicant (or practitioner or assignee), fee, eventual oath and declaration in non-provisional will determine final inventorship
- Patent
 - a petition under [37 CFR § 1.324](#) for a Certificate of Correction - Fee, statement from added inventor and each currently named inventor agreeing to the change or stating no disagreement to the change; new declarations from added inventors; and must have consent from assignees (not need to correct applications)

Correcting Inventorship – in Court

35 USC § 256 (pre-AIA)

- Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent *and such error arose without any deceptive intention on his part*, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.
- **Under AIA**, the “deceptive intent” language italicized above was removed
 - easier for patentee to correct inventorship
 - applies to actions where complaint was mailed on or after September 16, 2012
- Must still show clear and convincing proof of error and corroborating evidence

Correcting Inventorship – in Court

- **35 U.S.C. § 256** has been interpreted by the courts as a “savings provision” to prevent invalidation of patents due to good faith inventorship errors
- However, corrections can be barred in certain circumstances
 - (1) where there is a showing of deceptive intent
 - (2) where the correction is barred due to laches or equitable estoppel
- Deceptive intent on the part of the named inventors can rise to the level of inequitable conduct, but the challenger must prove deceptive intent by clear and convincing evidence
- A patent can be rendered unenforceable, regardless of the good faith of unnamed inventors

Correcting Inventorship – in Court

- Laches or Equitable Estoppel can operate to bar allegedly omitted inventors from seeking to correct inventorship
 - A patentee asserting a laches defense must show that
 - the claim to correct inventorship was brought after unreasonable and unexcused delay, **and**
 - the patentee is likely to suffer evidentiary or economic prejudice as a result
- A rebuttable presumption of laches is triggered if there is a delay of more than six years after a patent issues. *Hor v. Chu*, 699 F.3d 1331 (Fed. Cir. 2012)

Why challenge inventorship?

- Challengers to a patent's validity who assert incorrect inventorship as a defense sometimes persuade the allegedly missing inventor to intervene in the suit
 - the ultimate goal can be either to
 - attempt to invalidate the patent or have it held to be unenforceable, or
 - to license the patent from the allegedly omitted inventor (rights can be licensed even before inventorship is corrected)
- Can use a challenge to inventorship to renegotiate a license agreement
 - Agreements often state that challenging validity results in termination
 - Challenging inventorship may not trigger termination and, with the right facts, can lead to renegotiation of the agreement

Thank you!



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