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

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Overview

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• Why do we care?
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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


- 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)
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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