A Practical Approach to Inventorship

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INTRODUCTION

On April 28, 1783, a committee of the Continental Congress, formed to investigate the need for protecting and encouraging literature and inventive discoveries, provided the following report: “[N]othing is more properly a man’s own, than the fruit of his study. The protection and security of literary property would greatly tend to encourage genius, [and] to promote useful discoveries…”

The founding fathers clearly intended to construct a patent system to justly reward the efforts of individuals, and the U.S. Constitution reads that “inventors,” not investors or employers, are to be rewarded for their discoveries. This focus on the rights of the individual is a unique aspect of U.S. patent law, and has many consequences for the practitioner. For example:

1. The oath or declaration submitted for a United States patent application must ultimately identify the true inventors of the claimed subject matter. This has been a requirement since our first patent statute, the Patent Act of 1790.
2. The application for patent must be made by the inventors, even if the rights to the patent have been assigned (e.g., to an employer). This approach is contrary to most of the world, which emphasizes the applicant (e.g., the assignee) rather than the inventor.
3. Priority among competing inventors turns on who was the “first to invent,” a concept unique to the United States. The rest of the world follows a “first to file” priority rule.
4. A United States patent that fails to properly identify the true inventors is invalid, unless the error can be corrected as provided for under 35 U.S.C. §§116 and 256 and the associated implementing rules.
5. The United States is generally regarded as having the strictest inventorship rules in the world. Determining inventorship according to U.S. rules should lead to a result that is acceptable under the rules of most other countries. In most other countries, the primary focus is on properly identifying the “applicant” (typically a corporate employer or assignee) rather than the “inventors.”
6. Accurate determination of the inventors in a U.S. patent application is also important because it may affect:
   a. The assessment of what constitutes prior art (the earlier work of A may be prior art to the later work of A and B);
   b. The ability to claim priority in a continuation application or to a foreign application;
      i. A United States patent application claiming priority to a foreign patent application must identify the same inventors as shown in the foreign patent application with respect to the claimed subject matter that is common to both applications; and
   c. The ability to use a terminal disclaimer to avoid an obvious-type double patenting rejection.
In the following paper we attempt to provide some useful guidance for the patent prosecutor in (i) determining inventorship for a patent application prior to filing; and (ii) correcting incorrect inventorship in a filed application or an issued patent.

LEGAL REQUIREMENTS

The following outlines the most important legal requirements for determining and/or correcting inventorship in a U.S. patent application or an issued patent. This outline is not intended to provide a legal treatise on the subject, but merely to serve as an instructional guide. The reader should always perform his or her own legal research on the specific factual situation at hand, as statutes and rules may change and/or other legal requirements may apply.

I. Statutes and Rules
   A. Principal Statutes
      1. U.S. Constitution, Article 1, Section 8, Clause 8
      2. 35 U.S.C. §116 Inventors
      3. 35 U.S.C. §256 Correction of Named Inventors
   B. Other Relevant Statutes
      1. 35 U.S.C. §111 Application
      2. 35 U.S.C. §115 Oath of applicant
      3. 35 U.S.C. §120 Benefit of earlier filing date in the United States
   C. Principal Rules
      1. 37 CFR §1.45 Joint inventors
      2. 37 CFR §1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116
      3. 37 CFR §1.324 Correction of inventorship in patent pursuant to 35 U.S.C. 256

II. General Principles of United States Inventorship Law
   1. An inventor is anyone who “invents” a process, machine, manufacture, composition of matter, or a new and useful improvement thereof that is claimed in a patent.
      a. Inventorship is determined on a claim-by-claim basis. The first step is to construe the claims, and the second step is to compare the contributions of asserted inventors with the subject matter of the properly construed claims.
   2. This circular definition begs the question of what it means to invent. It has long been established that there are two principal stages to the making of an invention: conception and reduction to practice.
   3. Patent applications may identify one inventor (sole inventorship) or more than one inventor (joint inventorship).
   4. The patent application must ultimately identify those who are believed to be the true and original inventors, a concept that invokes both originality in work and priority (i.e., first to invent).
5. Mistakes in determining the proper inventors may be corrected if those mistakes occurred without deceptive intent.

ISSUES AND APPROACHES

I. Conception - The threshold question for determining inventorship

Conception is the key to determining inventorship for the invention described and claimed in a patent application - only those individuals who participate in the conception of an invention may be named as true inventors. The inventor must form a definite and permanent idea of the complete and operable invention to establish conception.18

1. “Conception is the touchstone of inventorship, the completion of the mental part of the invention.”19
2. Conception must include every feature or limitation of the claimed invention.20
3. “The conception of the invention consists in the complete performance of the mental part of the inventive act. All that remains to be accomplished in order to perfect the act or instrument belongs to the department of construction, not invention. It is, therefore, the 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 the patent law.”21
4. “Conception is complete only when the idea is so clearly defined in the inventor's mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.”22
5. “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. The conception analysis necessarily turns on the inventor's ability to describe his invention with particularity.”23
   a. Conception may be complete if the inventor can show a reasonable expectation of producing the claimed invention.24
6. “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 apparatus without extensive research or experimentation.”25
7. “Conception of a chemical compound requires both an idea of the compound’s structure and possession of an operative method of making the compound.”26
8. Conceiving an invention may involve one or both of the following steps: identifying the problem that needs to be solved; and determining the solution to that problem.
   a. In many situations the problem that needs to be solved is well-known (e.g., finding a cure for a particular form of cancer), but determining the solution to that problem requires inventive effort.
   b. In other situations, the problem that needs to be solved has not been recognized, but once recognized the solution to that problem is immediately apparent.
   c. In some situations it requires inventive effort to both identify the problem (e.g., the need for a repositionable adhesive such as used in Post-it® brand notes), and
to solve the problem (e.g., incorporate adhesive microspheres into a polymeric matrix).

9. The conception must be contemporaneously recognized and appreciated before there can be an invention. (Nunc pro tunc reductions to practice are not recognized by the courts.)

10. However, conception does not require that an inventor appreciate the patentability of the invention.
   a. There is a split of authority as to whether an undisclosed or unappreciated advantage or utility can be relied upon for evidence of patentability if the individual(s) responsible for this discovery are not named as inventors.

11. The role of utility in assessing inventorship - “Discovery of a practical utility is required for complete conception.”

12. Claims directed to chemical compounds require identifying the name, formula, chemical or physical property, utility, and method of making the compound (unless routine).

13. Claims directed to DNA molecules require identifying the sequence or other structure, utility, and method of obtaining or making the DNA molecule.

14. The doctrine of simultaneous conception and reduction to practice.
   a. Conception and reduction to practice occur simultaneously because the level of unpredictability in the technology is so high that the invention must be reduced to practice in order to demonstrate conception.
   b. Usually applied in biotechnology and chemical cases where there is a high level of unpredictability.
   c. Most uses of this doctrine arise in interferences or litigation where the question of who invented first is at issue.

15. Means plus function claims.
   a. One who contributes to any of the disclosed means for a means plus function claim element is a joint inventor as to that claim unless the contributed means simply reduces to practice the broader concept attributable solely to one of the other inventors.

II. Reduction to Practice

Reduction to practice requires a showing of the invention in a physical or tangible form. Reduction to practice may be an actual reduction to practice or a constructive reduction to practice (which occurs when a patent application on the claimed invention is filed). Reduction to practice does not have to be carried out by the inventor - all that is required for one to be an inventor is to have conceived a definite and permanent idea of the complete and operative invention. However, under certain circumstances, those who offered suggestions and ideas leading to the operative invention may be inventors (alone or jointly with those who first developed the idea) because, in fact, they contributed to the conception.

1. The invention may be reduced to practice by the inventor, or it may be reduced to practice by someone who is operating under the direction and control of the inventor.
2. The reduction to practice may be an actual reduction (e.g., constructing an operative prototype, conducting successful experiments), or a constructive reduction (filing a patent application).
   a. Actual reduction to practice means that the inventor (1) constructed an embodiment or performed a process that met all of the limitations of the claim; and (2) determined that the invention would work for its intended purpose. Depending on the invention, testing may be required to prove that it works for its intended purpose. Some inventions are so simple and their purpose so obvious that testing is unnecessary.33
   i. When testing is required to determine whether the invention will work for its intended purpose, the inventor must appreciate, at that time, that the testing is successful. This can arise in inventions directed to diagnostic and therapeutic methods where testing is required to prove the efficacy of the method.34
   b. An inventor need not know that the invention will work for conception to be complete; discovering that the invention works is part of the reduction to practice.35
3. When do activities related to reduction to practice become important?
   a. Were difficulties encountered during the actual reduction to practice (e.g., prototypes that did not work, significant number of failed experiments, deviations from originally conceived idea)? If so, then those who offered suggestions and ideas leading to the operative invention may be inventors (alone or jointly with those who first developed the idea) because, in fact, they contributed to the conception.

III. Factors Often Leading Away From a Conclusion of Inventorship

In determining inventorship, it is often useful to consider the following general fact situations where the courts have concluded that the investigators were not inventors:

1. Contributing an obvious element or general knowledge;36
2. Merely suggesting a desired result or outcome without providing the means to accomplish the same;37
3. Following the instructions of the conceivers;38
4. Explaining how or why the invention works;39
5. Adopting information derived from another;40
6. Providing additional research or testing that is not related to the claimed invention;
7. Merely supplying a known component or starting material;41
8. Merely refining or perfecting another's design or making only superficial changes;42
9. Providing well-known principles;43 and
10. Explaining the state of the art.44

IV. Sole Inventorship and Joint Inventorship

For a sole invention, only one person is responsible for the conception of that which is covered by the claims of the patent. For a joint invention, two or more people
collaborating together jointly contribute to the conception of that which is covered by the
claims of the patent.

1. Joint inventors are joint owners. Each joint inventor owns an undivided partial
interest in the entire patent. In the U.S., each joint inventor can practice the patent, or
sell or license his share of the patent, without the permission of any other joint
inventor. (This is not true in all countries; e.g., Japan.)
   a. Because of these consequences, it is important to have agreements with
      employees, agents, consultants and others who may make patentable
developments that transfer their rights in these developments to the employer or
principal.

2. There is no clear test for distinguishing between sole inventions and joint inventions.
   a. Determining what constitutes a joint invention has been described as “one of the
      muddiest concepts in the muddy metaphysics of patent law.”

3. Each joint inventor must make some contribution to the conception of the invention.
   Thus, if B merely carries out the instructions of A (who conceived the invention) or
contributes only an obvious element, then B is not a joint inventor.
   a. “The conception of the entire device may be due to one, but if the other makes
      suggestions of practical value, which assisted in working out the main idea and
making it operative, or contributes an independent part of the entire invention,
which is united with the parts produced by the other and creates the whole, he is a
joint inventor, even though his contribution be of comparatively minor
importance and merely the application of an old idea.”
   b. “One need not be able to point to a specific component as one’s sole idea, but one
      must be able to say that without his contribution to the final conception, it would
have been less-less efficient, less simple, less economical, less something of
benefit.”
   c. "All that is required of a joint inventor is that he or she (1) contribute in some
significant manner to the conception or reduction to practice of the invention, (2)
make a contribution to the claimed invention that is not insignificant in quality,
when that contribution is measured against the dimension of the full invention,
and (3) do more than merely explain to the real inventors well-known concepts
and/or the current state of the art."  

4. Statutes and case law provide helpful guidelines for determining whether there is joint
inventorship.
   a. According to 35 U.S.C. §116, inventors may apply for a patent jointly even
though:
      i. They did not physically work together or at the same time;
      ii. Each did not make the same type or amount of contribution; and
      iii. Each did not contribute to the subject matter of every claim.
   b. Collaboration among joint inventors is required. There is no joint invention if two
people are totally independent and completely unaware of each other’s work.
   c. The collaboration may be in the form of direct or indirect communication. As to
A, B and C, the requirement for collaboration can exist if:
      i. A communicates with B, and B communicates with C;
ii. A, B and C are part of the same research or development team;

iii. A, B and C are working under common direction;

iv. A builds upon a research report or invention record of B and C; and

v. A and B learn of a suggestion by C in a meeting.49

d. For a narrow view of joint inventorship, see Levin v. Septodont, Inc.,50 holding that a joint inventor's contribution must help make the invention patentable.

5. Because the inventorship for each claim need not be the same, the proper inventors for subsequently filed divisional, continuation or continuation-in-part patent applications may be different than the inventors named in the originally filed patent application.

V. Originality and Priority

Only true and original inventors are eligible to apply for patents, a requirement that protects both the actual inventors and the public. Only those who actually invest energy in the inventive process should benefit from the advantages bestowed by the patent system.

1. Under 35 U.S.C. §115, each applicant for a patent must submit an oath or declaration stating that “he believes himself to be the original and first inventor of the” claimed subject matter.

a. If the applicant does not believe this to be true, or if his belief is not reasonable, then the threshold for submitting the required oath or declaration has not been met.

b. Primarily, the attorney’s role is to determine whether the applicants possess this belief and whether such belief is reasonable under the circumstances.

c. It is unlikely that the attorney will be aware of someone else who could also claim to be the original and first inventor, except in the context of a common corporate assignee where another employee may claim to be the original and first inventor.

i. Priority disputes are usually resolved through an interference, but 37 CFR 1.602 provides that interferences are generally not declared between two patent applications (or a patent application and an issued patent) owned by the same party.

ii. Under 37 CFR 1.78(c), if the Patent Office identifies two patent applications (or a patent application and an issued patent) containing conflicting claims and different inventors, but owned by the same party, it may request the assignee to confirm that there was common ownership or an obligation of common assignment at the time the later invention was made. Failing this, the assignee may be asked to identify the prior inventor.

2. An original inventor develops the essence or substance of his idea from his own thinking, as opposed to obtaining it from someone else. The latter is called derivation.51

a. An original inventor need not operate in isolation from others, and is free to adopt the ideas and suggestions of others “as long as he maintains intellectual domination of the work of making the invention.”52
3. The “first” inventor concept is related to the “original” inventor concept.
   a. The first inventor is an original inventor who:
      i. First conceived and then reduced the invention to practice; or
      ii. First conceived the invention and was diligent in reducing it to practice from a
time prior to the invention being subsequently conceived by someone else
(i.e., no derivation) who had an earlier reduction to practice. The activity
relied upon for priority can occur in any WTO country.

VI. Evidentiary Standards to be Applied When Determining Inventorship

The presumption of validity under 35 U.S.C. §282 means that the named
inventors on an issued patent are presumed to be the only and true inventors.53

1. A Certificate of Correction extends the presumption to the corrected patent.54
2. If the determination of inventorship is ever challenged in an interference (e.g., to
establish an earlier priority date) or in litigation (e.g., to invalidate the patent), then
the quality of the evidence relied upon in making the initial determination may be
scrutinized.
   a. You should always be able to explain the basis for your conclusion. If two
different inventorship conclusions are possible, then select the one that is most
defensible.
3. Claims of inventorship should be supported by reliable evidence.
   a. Proof of conception needs to be demonstrated by external conduct or statements,
but generally does not require corroboration. A dated but unwitnessed written
record of conception can suffice.
      i. If the only proof of conception is an oral description, then corroboration may
be necessary.
      ii. If there is a dispute over priority (i.e., who conceived the invention first), then
corroboration is necessary.
4. Challenges to validity based on incorrect inventorship have to be proven by clear and
convincing evidence. Alleged inventors must prove their claim with evidence other
than their own testimony, the sufficiency of which is evaluated under a “rule of
reason” analysis. Corroboration is required when inventor testimony is relied on for
conception. If there is physical proof of conception such as a dated drawing, then
“corroboration” is not needed if testimony from the inventor is not being relied on.55
   a. On appeal, the issue of inventorship is reviewed de novo because it is question of
law, although the underlying factual matters are reviewed for clear error.

VII. Correcting Incorrect Inventorship

Despite our best efforts, there are many situations in which our initial
determination of inventorship is incorrect. Under these circumstances, it is necessary to
correct the inventorship record. The following outlines several standard types of
inventorship errors and how to correct them.
1. Types of Incorrect Inventorship
   a. No true inventor is named. (E.g., A is the named inventor, but B is the true inventor; A and B are the named inventors, but C and D are the true inventors.)
   b. Nonjoinder. Some, but not all, of the true inventors are named. (E.g., A is the only named inventor, but A and B are the true inventors.)
   c. Misjoinder. Some of the true inventors are named, but some of the named “inventors” are, in fact, not inventors. (E.g., A and B are the named inventors, but only A is the true inventor.)
   d. Nonjoinder/misjoinder combination. Some, but not all, of the true inventors are named, and some of the named “inventors” are, in fact, not inventors. (E.g., A and B are the named inventors, but A and C are the true inventors.)

2. Each of these types of incorrect inventorship may be corrected under the applicable statutes and rules, if the requirements for correction are met.
   a. Courts have long held that incorrect inventorship issues are technical defects that are easily cured. Objections or defenses based on inventorship arguments are not favored.56
   b. Challenges to validity based on incorrect inventorship must be proven by clear and convincing evidence.57

3. Changes in Inventorship Resulting from Patent Filing and Prosecution Activities
   a. Decisions made during the prosecution of a patent application or in the filing of a subsequent related patent application may require reviewing the inventorship of the claims being pursued at that time. These are not examples of incorrect inventorship because, initially, the proper inventors were named. Such situations arise because the inventorship for each claim need not be the same.
   b. Canceling claims during prosecution may necessitate deleting one or more originally named inventors if their only inventive contribution is reflected in the canceled claims. This can be accomplished by following the provisions of 37 CFR §1.48(b), including the submission of a request to change the inventorship (acknowledge that the deleted inventor(s) invention is no longer being claimed), and the fee required by 37 CFR 1.17(i).
   c. Upon filing a divisional or continuation patent application directed to new or previously canceled claims, it may be necessary to delete one or more originally named inventors if their only inventive contribution is reflected in the claims that are no longer being prosecuted. A statement must accompany the subsequent application requesting deletion of the inventors from the original patent application who will not be named in the subsequent patent application.
   d. A new oath or declaration is not required if the inventors in the subsequent application are the same or less than the inventors named in the original patent application.
   e. A continuation-in-part patent application may name less than or more than all of inventors who were named in the originally filed patent application.
   f. Adding claims during prosecution to previously unclaimed subject matter may require the addition of one or more new inventors whose inventive contribution resides only in the added claims. This can be accomplished by following the provisions of Rule 1.48(c).
g. Practice Tip: At the time the original patent application is filed, prepare a file memo setting forth the inventorship for the different claims as this will simplify later determinations of the correct inventorship for subsequent related patent applications.

4. Requirements for Correcting Incorrect Inventorship

a. Correction of Inventorship in a Pending Patent Application

To be correctable, the incorrect inventorship must occur as the result of an “error [that] arose without any deceptive intention on his part.”58

i. The requirement for an “error” has been liberally construed and includes mistakes of judgment and innocent (even if gross) misunderstandings of the law.59

ii. The error must occur “without any deceptive intention.” Deceptive intention refers to a fraudulent or deliberate inclusion or exclusion of an inventor for reasons unrelated to inventorship considerations such as avoiding an obligation to assign or license, impacting patentability by selecting the inventive entity to permit a claim of priority or to avoid prior art.60

iii. “On his part” under §§116 and 256 refers to the conduct of the erroneously included or excluded inventor.

iv. An expectation of ownership in a patent is not a prerequisite for a putative inventor to possess standing to sue to correct inventorship under §256. A putative inventor has standing to sue for correction of inventorship under §256 even though obligated to assign the patent rights to another party, if the inventor has suffered an injury as a result of incorrect inventorship. Once such a suit has been brought, all parties having a financial stake in the patent's validity are entitled to be heard.61

v. Absent fraud or deceptive intent, the correction of inventorship does not affect the validity or enforceability of the patent for the period before the correction.62

vi. Deceptive conduct could be actionable under 37 CFR §1.56.

- Conduct of some named inventors in excluding another inventor can be inequitable and render the patent unenforceable even as to the innocent, unnamed inventor.63

vii. Although correction of inventorship in provisional applications is not required, provisional applications form the basis for a priority claim, so correction of inventorship is recommended. In the U.S., if there is at least one common inventor between the provisional application and the utility application that claims priority to the provisional, filing an executed oath/declaration in the utility corrects inventorship in the provisional and does not impact the priority claim. However, there may be a different result in other jurisdictions.

viii. Procedural requirements to correct inventorship errors in pending applications, both provisional and non-provisional, are set forth in 37 CFR § 1.48.
Statement that Error Occurred Without Deceptive Intent

ix. In a provisional application:
   - Filing a coversheet corrects inventorship, 37 CFR. § 1.48(f)(2).
   - If the coversheet has been filed:
     1. Add Inventors – 37 C.F.R. § 1.48(d)
        Request to Correct Inventorship
        May be Signed by Attorney/Agent
     2. Delete Inventors – 37 C.F.R. § 1.48(e)
        Request to Correct Inventorship
        Statement - Error in Inventorship Occurred Without Deceptive Intent
        Must be Signed by Each Person Deleted
        If Assignment Executed by Original Inventors, Consent of Assignee Required

x. In a non-provisional application:
   - Filing a signed oath/declaration corrects inventorship, 37 CFR. § 1.48(f)(1).
   - If the oath/declaration has been filed:
     1. Add/Delete Inventors (§ 1.48(a))
        Add Inventors to Claim Previously Unclaimed Subject Matter (§1.48(c))
        Request to correct inventorship
        Statement - Error in Inventorship Occurred Without Deceptive Intent
        Must be Signed by Each Person Added/Deleted
        Oath or declaration
        If no Assignee, Affirmatively State
        If Assignment Executed by Original Inventors, Consent of Assignee
     2. Delete Inventors resulting from Cancellation of Claims, 37 CFR § 1.48(b) (Amendment/Restriction Requirement)
        File Amendment including statement that inventor’s invention is no longer claimed in the application
        May be signed by attorney or agent, no consent of assignee required

b. Correction of Inventorship in an Issued Patent
   i. Inventorship corrections pursuant to 35 U.S.C. §256 and 37 CFR §1.324 (issued patents) may be pursued through the Patent Office upon application of all the parties and the assignees (certificate of correction process), or through the federal courts.
   ii. Procedural requirements for certificate of correction route:
       - Statement from each person being added that the error occurred without deceptive intent on his part;
• Statement from current inventors that they agree to the change or have no disagreement with the change;
• Consent of all assignees; and
• Required fee under 37 CFR §1.20(b)

KEY CONCEPTS AND STRATEGIES

I. Practical Considerations for Determining Inventorship

1. Most inventorship determinations involve individuals having a common obligation of assignment (e.g., employees of the same company). Many potential disputes over inventorship can be avoided or minimized by good record keeping practices, education of the client, awareness of important personnel issues, and encouraging sophisticated IP practices.

2. Make sure you educate your client about good record-keeping practices.
   a. Technical notebooks should be regularly kept up to date (preferably daily). Notebooks should have numbered pages that cannot be removed with each page signed and witnessed.
   b. Records of invention should be promptly prepared, signed, dated and witnessed. Records of invention should refer to “investigators,” not inventors, to avoid a conclusion of premature inventorship determination.
   c. At the time of filing the patent application, a memorandum can be prepared recording the results of the inventorship determination to simplify the inventorship determination in subsequently filed related applications.
   d. At the time of filing the patent application, prepare a memorandum regarding any disclosed but unclaimed subject matter.

3. On-going client education regarding inventorship should emphasize the following concepts.
   a. Inventorship is a legal determination that can only be made by a qualified practitioner.
   b. Inventorship depends on the claims.
   c. Inventorship is not the same as authorship, and does not necessarily reflect the quality, value or quantity of one’s contribution.
   d. There are consequences to incorrect inventorship (i.e., possible invalidity and lack of enforceability).
   e. There are generally standards and guidelines for inventorship, especially those factors that are never appropriate.
   f. A common process should be used to determine inventorship.

4. Be aware of important personnel and personal issues.
   a. The number of filed or issued patents may be a factor in determining eligibility for salary increases or promotions.
   b. Named inventors may be entitled to additional financial compensation.
   c. Peer recognition resulting from issued patents can be important.

5. Adopt sophisticated IP practices.
a. Have agreements with employees, agents, consultants and others who may make patentable developments that transfer rights in these developments to the employer or principal.

b. IP agreements with foreign companies that contemplate the creation of patentable ideas should require that inventorship be determined according to U.S. law (even if the controlling law for the rest of the agreement is that of another country).

c. Despite whatever dispute resolution approach is adopted in a third party IP agreement, inventorship disputes should be resolved by an independent patent attorney so as to not delay application filing.

d. IP agreements should allocate patent ownership to parallel inventorship, with the rights to use and practice the patents allocated by licenses. Avoid allocating ownership of patents or claims based on the type of patent or claim (e.g., Company A owns all patents or claims directed to the manufacture of the product, and Company B owns all patents or claims directed to the use of the product.)

II. Conducting an Inventorship Interview

1. Have all potential inventors at a single meeting.
2. Have the group explain how the invention was made.
3. Review any notebooks and review evidence of collaboration.
4. Explain the following important concepts:
   a. Inventorship is dependent on the claims – must be an inventor of at least one claim, and disclosed, unclaimed subject matter does not count;
   b. Inventorship is determined when the application is complete;
   c. Those involved are not referred to as inventors until inventorship has been determined;
   d. Inventorship is different than authorship;
   e. Inventorship is not necessarily a reflection of the quantity or quality of someone’s work;
   f. The question is: does the work (and its nexus to the claimed subject matter) fit the legal definition of inventorship?;
   g. The key to inventorship is conception – explain conception;
   h. If a person is not part of conception, they cannot be an inventor;
   i. Explain reduction to practice and why it alone does not lead to being named an inventor; and
   j. If a claim is amend, canceled, or added, inventorship may change.
5. After hearing from the group of potential inventors, (briefly) meet individually with each potential inventor (if necessary to resolve issues).
6. Make the decision and explain it to the group.
7. Draft a memo to the file regarding inventorship.
8. It may be helpful to use an Invention Interview Record – an example is attached.
CONCLUSION

As inventors named in a patent receive benefits ranging from financial awards from their employers to recognition from the technical community, disputes over inventorship are not uncommon. Patent attorneys must demonstrate persistence and tact to ensure that the appropriate individuals are named in a given patent.\(^\text{64}\)

Additional resources that can assist you in making a correct determination of inventorship include, for example, treatises on patent prosecution like Donner, *Patent Prosecution, Practice and Procedure before the United States Patent Office; 3\(^{\text{rd}}\) ed.*, (BNA 2003).
(a) IN GENERAL.

(1) WRITTEN APPLICATION. An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS. Such application shall include--

(C) an oath by the applicant as prescribed by section 115 of this title.

(b) PROVISIONAL APPLICATION.

(1) AUTHORIZATION. A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director.

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. … When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. …

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed in the United States, except as otherwise provided in this title, in writing to the Director.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration: neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47. (b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of each claim of the application.

3. 35 U.S.C. §§ 102(a), 102(e).
4. 35 U.S.C. §120.
6. MPEP 201.13.
7. MPEP 804.02.
8. Congress shall have the power “To promote the progress of science and useful arts, by securing for limited times to … inventors the exclusive right to their … discoveries.”
9. 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.
10. 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 permit the application to be amended accordingly, under such terms as he prescribes.
11. 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. The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.
12. The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. … When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. …
13. An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed in the United States, except as otherwise provided in this title, in writing to the Director.
14. (a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration: neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47. (b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of each claim of the application.
the nonprovisional application may be amended to name only the actual inventor or inventors. If the nonprovisional application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

1. A request to correct the inventorship that sets forth the desired inventorship change;
2. A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
3. An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
4. The processing fee set forth in § 1.17(i); and
5. If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

(b) Nonprovisional application—fewer inventors due to amendment or cancellation of claims. If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. If the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

1. A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor’s invention is no longer being claimed in the nonprovisional application; and
2. The processing fee set forth in § 1.17(i).

(c) Nonprovisional application—adding omitted inventors. If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

1. A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and
2. The processing fee set forth in § 1.17(q).

(d) Provisional application—adding omitted inventors. If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the omitted inventor or inventors, the provisional application may be amended to add the name or names of the omitted inventor or inventors. Amendment of the inventorship requires:

1. A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and
2. The processing fee set forth in § 1.17(q).

(e) Provisional application—deleting the name or names of the inventor or inventors. If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

1. A request to correct the inventorship that sets forth the desired inventorship change;
2. A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;
3. The processing fee set forth in § 1.17(q); and
4. If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

(f) Nonprovisional application—filing executed oath/declaration corrects inventorship. If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 naming an inventive entity different from the inventive entity set forth in the international stage.
(2) Provisional application filing cover sheet corrects inventorship. If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under § 1.51(c)(1), the later submission of a cover sheet under § 1.51(c)(1) during the pendency of the application will act to correct the earlier identification of inventorship.

(g) Additional information may be required. The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(h) Reissue applications not covered. The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

(i) Correction of inventorship in patent or interference. See § 1.324 for correction of inventorship in a patent, and § 1.634 for correction of inventorship in an interference.

(a) 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 or her part, the Commissioner may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

(b) Any petition pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

(c) For correction of inventorship in an application see §§ 1.48 and 1.497, and in an interference see § 1.634.

See, e.g., Trovan Ltd. v. Sokymat SA, 63 USPQ2d 1865 (Fed. Cir. 2002).

Bosies v. Benedict, 27 F.3d 539, 543 (Fed. Cir. 1994); See also MPEP 2138.04.


Slip Track Systems Inc. v. Metal-Lite Inc., 64 USPQ2d 1423 (Fed. Cir. 2002).

Slip Track Systems Inc. v. Metal-Lite Inc., supra.


Burroughs Wellcome Co. v. Barr Laboratories, Inc., supra.

Id.

Hitzeman v. Rutter, 58 USPQ2d 1161 (Fed. Cir. 2001).

In re Tansel, 253 F.2d 241, 117 USPQ 188 (CCPA 1958).

Suh v. Hoefle (Bd. Pat. App. and Inter., 1991); See also MPEP 2138.04.

Estate Lauder Inc. v. L’Oreal, 44 USPQ2d 1610 (Fed. Cir. 1997); Rosco Inc. v. Mirror Lite Co., 64 USPQ2d 1676 (Fed. Cir. 2002). See also Heard v. Burton, 333 F.2d 239, 142 USPQ 97 (CCPA 1964), General Tire & Rubber Co. v. Jefferson Chemical Co., 497 F.2d 1283, 182 USPQ 70 (2nd Cir. 1974), and Silvestri v. Grant, 469 F2d 593, 181 USPQ 706 (CCPA 1974).


Ethicon Inc. v. United States Surgical Corp., 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998).

See MPEP 2138.05 for a discussion of reduction to practice.

Cooper v. Goldfarb, 47 USPQ2d 1896 (Fed. Cir. 1998); Mycogen Plant Science Inc. v. Monsanto Co., supra; Slip Track Systems Inc. v. Metal-Lite Inc., supra.

See Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Manning v. Paradis, 63 USPQ2d 1681 (Fed. Cir. 2002).

Burroughs Wellcome Co. v. Barr Laboratories, Inc., supra.


Union Paper Collar Co. v. Van Deusen, 90 U.S. 530 (1875).

Ethicon Inc. v. United States Surgical Corp., supra.


Hoof v. Hoop, 61 USPQ2d 1442 (Fed. Cir. 2002).

Ethicon Inc. v. United States Surgical Corp., supra.

Id.
47 Mueller Brass Co. v. Reading Industries, supra.
50 2002 WL 654098, 63 USPQ2d 1395, unpublished, (2d Cir. 2002).
52 Morse v. Porter, 155 USPQ 280 (POBI 1965).
54 Winbond Electronics Corp. v. ITC, 262 F.3d 1363, 60 USPQ2d 1029 (Fed. Cir. 2001).
57 Ethicon Inc. v. United States Surgical Corp., supra; Hess v. Advanced Cardiovascular Systems Inc., supra.
63 Frank’s Casing Crew & Rental Tools, Inc. et al. v. PMR Technologies Limited and PMR Services, Inc. et al., 292 F.3d 1363, 63 USPQ2d 1065 (Fed. Cir. 2002).
64 Schechter and Thomas, Principles of Patent Law, West 2004, at 238.