The Limited Monopoly

Inventorship: Who Thunk Of It?

The Law

The United States is unique in the industrialized world in that an inventor must be named as the applicant for a patent, rather than his employer. Federal statute 35 USC 111 states that, "An application for patent shall be made, or authorized to be made, by the inventor..."

Additionally, the legal basis for an application by two or more inventors is contained in 35 USC 116, which states, in part, "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."

Someone may thus be named as a joint inventor on a patent even if he only made a contribution to one claim of the patent. But what constitutes an adequate "contribution" to a claim?

Inventorship 101

Details on the subject of inventorship may be found in the Manual of Patent Examining Procedure. In particular, §2137.01 states as follows[1]: "The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor… Insofar as defining an inventor is concerned, reduction to practice, per se, is irrelevant..."

"Conception" seems to be a somewhat nebulous term, but courts have defined it over the years. For example, one court stated[2], "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 hereinafter to be applied in practice."

In order to better understand inventorship, it can be useful to know what is NOT considered inventorship. Suppose you conceive of a new computer mouse. You prepare a detailed written description and hand sketches of it in your notebook, then seek help to get it built:

- A designer studies your detailed sketches and notes and creates a virtual 3D model of the mouse on her PC.
- A technician uploads the 3D model file to an RP machine and builds you a working prototype of it.
- A lab technician runs stress tests on the prototype and gives you "thumbs up," on the data.

Although all of the above participants in the project provide a valuable service, if they do nothing to contribute to the concept defined in at least one claim of the patent, they are not inventors. They have simply assisted in the *reduction to practice* of the invention.

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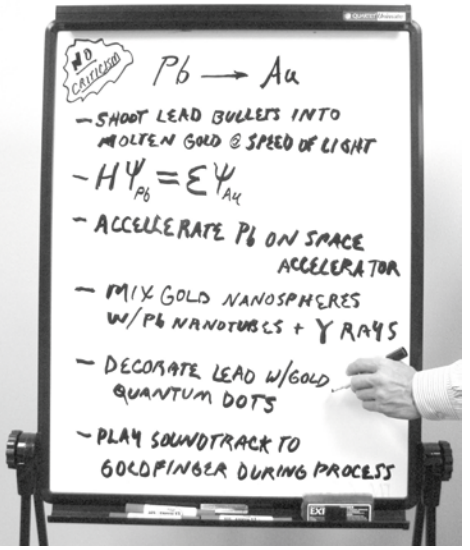
Dilbert As Inventor

As if determining inventorship isn't already complex enough, sometimes workplace politics gets in on the act when employees prepare invention disclosures for consideration for patent applications. There have been cases where subordinates



name bosses as co-inventors. Bosses name subordinates. Friends name friends. And then there's the Dilbertian corporate practice of "brainstorming" to invent.

Here's a scenario: The CEO of Goldbrick Inc. says "We need more IP." So the Goldbrick CTO tells R&D "We want to triple our patent application filings, so we need a 10x increase in invention disclosure submissions." Next, a cross-functional team of a dozen people in R&D convenes for several lunchtime sessions to brainstorm ways to turn lead into gold. Like any cross-functional team, there is a variety of technical expertise... and competence.

A brilliant theoretical chemist comes up with some quantum hypothesis to convert the lead to gold. A lab chemist suggests experiments to test the hypothesis. A couple of engineers propose a way to scale up the lab tests to a pilot process. Six of the other team members propose more ideas… that make no sense at all. Another member, Mary, acts as scribe and writes everything down on flip charts. The last of the twelve, Jon, nods at all of his colleagues' ideas in between bites of his meatball sub.

The chemist and the two engineers, who actually make a living getting things done, go run the experiments and develop the pilot process. Lo and behold! After six months, they have demonstrated their process for conversion of lead into gold. They have learned enough from their work to finish writing an invention disclosure that shows the required "possession of the invention." So they submit their invention disclosure to the legal department… and, being good team players, they name all twelve members as inventors.

So who should be named as an inventor on the patent application, and ultimately any patent issues? Again, it comes down to *who contributed to conception of the invention,* as claimed in the application, and eventually, the issued patent. The patent practitioner, through a review of the written records of the meetings and the experimental work, as well as through interviews with the various team members, is responsible for identifying the inventors to be named. (At this point, it's safe to say that if Mary's and Jon's contributions are limited to the above, they shouldn't be on the list.)

Why it matters.

Under almost all circumstances, there is no examination of the correctness of inventorship in the Patent Office during prosecution of a patent application. Errors (and even fraud) will likely pass through undetected. But litigation is another matter – if inventorship is not properly named in a patent, opposing counsel will surely make a major issue of it. Correct inventorship can also be critical to any financial transactions involving the patent. It's an ethical and legal obligation to get it right at the time of filing – and it's *much* less costly than attempting to fix it later. ❑

1. http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2137_01.htm#sect2137.01
2. *Hybritech v. Monoclonal Antibodies Inc.*, 802 F.2d. 1367 (Fed. Cir.1986).

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Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice.