

INVENTORSHIP:

Who Is the Inventor, Why It Matters, and What Happens
When You Don't Get It Right

DBA IP Section

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Who is the inventor?



Who is the inventor cont'd

- Inventorship of a U.S. patent is governed by 35 U.S.C. § 115 & 116

Who is the inventor cont'd

- (a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

Who is the inventor cont'd

- (a) JOINT INVENTIONS.—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.
- (b) OMITTED INVENTOR.—If a joint inventor refused to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Who is the inventor cont'd

- Inventorship basics
 - Conception
 - Conception is the touchstone of inventorship
 - It is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is to be applied in practice
 - An idea is sufficiently definite and permanent when only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation

Who is the inventor cont'd

- One does not qualify as an inventor by merely assisting the actual inventor after conception of the claimed invention
- One who simply provides the inventor with well-known principles or explains the state of the art without ever having a firm and definite idea of the claimed invention as a whole does not qualify as an inventor

Who is the inventor cont'd

- Co-inventorship
 - A patented invention may be the work of two or more inventors
 - Each co-inventor must contribute to the conception of the invention
 - Each co-inventor does not have to make an equal contribution
 - A co-inventor does not have to contribute to every claim of the patent
 - The critical question as to co-inventorship is who conceived the subject matter of the claim(s) at issue

Who is the inventor cont'd

- Collaboration is required for co-inventorship
 - Two inventors cannot be joint inventors if they have had no contact whatsoever and are completely unaware of each other's work
- Some "quantum of collaboration or connection" is required
 - Some element of joint behavior: collaboration; working under common direction; one inventor seeing a relevant report and building upon it; hearing another's suggestion at a meeting
- There is no explicit lower limit on the quantum

Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co., Inc., 973 F.2d 911 (Fed. Cir. 1992)

Who is the inventor cont'd

- Contribution of structure for means-plus-function claim
 - The contributor of any disclosed means of a means-plus-function claim element is a joint inventor as to that claim, unless one asserting sole inventorship can show that the contribution of that means was simply a reduction to practice of the sole inventor's broader concept

Who is the inventor cont'd

- There is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf

In re DeBaun, 687 F.2d 459 (C.C.P.A. 1982)

Who is the inventor cont'd

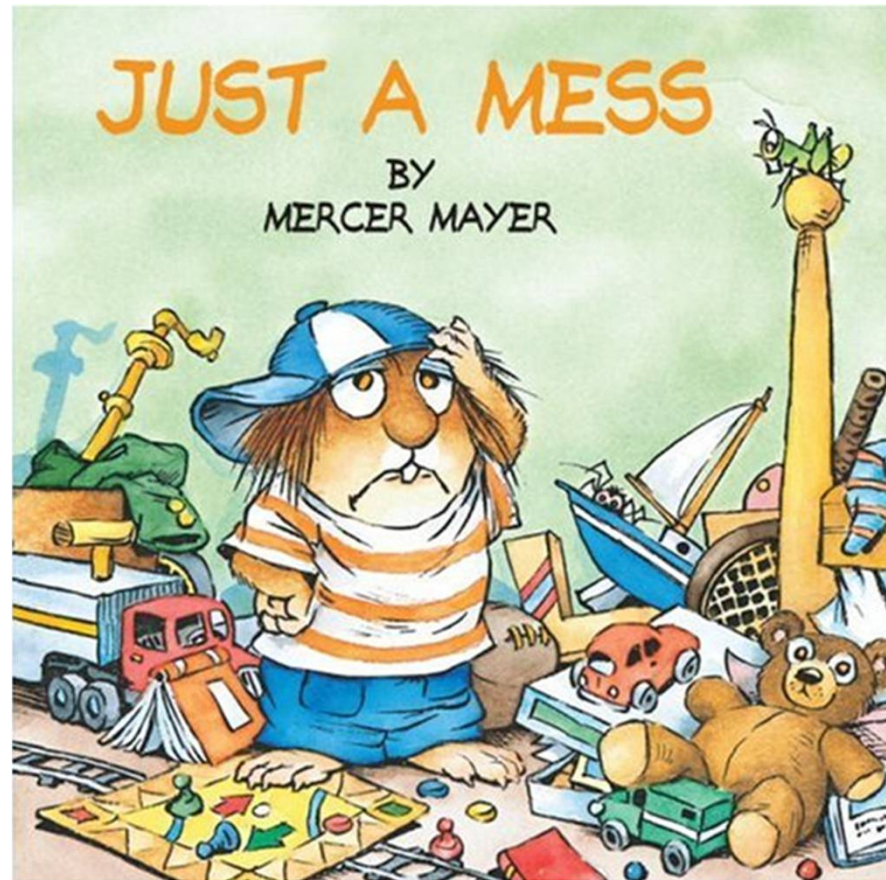
- One who suggests an idea of a result to be accomplished, rather than the means of accomplishing it, is not a coinventor

Ex parte Smernoff, 215 U.S.P.Q. 545 (Bd. App. 1982)

Who is the inventor cont'd

- One following oral instructions is viewed as merely a technician

Why it matters



What happens if you get it wrong?



What happens if you get it wrong cont'd

- Correction in application

(c) CORRECTION OF ERRORS IN APPLICATION.—Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

What happens if you get it wrong cont'd

- Interference Practice
 - Applies to applications filed under the first-to-invent system
 - The purpose of an interference proceeding is to determine whether two parties claim the same patentable invention, and if so, who is entitled to priority
 - An interference-in-fact exists if the subject matter of one claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa
 - Preponderance of the evidence standard applies
 - Issues of patentability *should* be decided

35 U.S.C. § 135[A] (for applications and patents issued thereon that were filed before Mar. 16, 2013)

What happens if you get it wrong cont'd

- Derivation Proceedings
 - Applies to applications filed under the first-to-file system
 - Initiated by a patent applicant upon filing a petition with the PTO
 - Petition must set forth with particularity the basis for finding that an individual named in an earlier application derived the invention from an individual named in petitioner's application
 - Must also explain why and how the earlier application was filed without authorization

35 U.S.C. § 135[B] (for applications and patents issued thereon that have an effective filing date subsequent to Mar. 16, 2013)

What happens if you get it wrong cont'd

- Correction of inventorship of an issued patent:

(a) CORRECTION.—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.

(b) PATENT VALID IF ERROR CORRECTED.—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 into question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

35 U.S.C. § 256 (2011) (effective September 16, 2012)

What happens if you get it wrong cont'd

- The first paragraph of § 256 applies to the administrative process before the PTO
- It provides the standards for judicial correction set out in the second paragraph

Stark v. Advanced Magnetics, Inc., 119 F.3d 1551 (Fed. Cir. 1997)

What happens if you get it wrong cont'd

- When can the inventorship of a patent be corrected?
 - (a) CORRECTION.—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.
 - “Error” is not limited to inadvertence, accident, or mistake, but also includes poor judgment and deliberate acts

What happens if you get it wrong cont'd

- Section 256 is given liberal construction in favor of correction

What happens if you get it wrong cont'd

(a) CORRECTION.—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.

- There has been little commentary on the AIA's quiet removal of all seven occurrences of “without deceptive intention” from the statute
- Most likely done to limit fights over mental state

What happens if you get it wrong cont'd

- What does this mean?
 - Before AIA, it was clear that inventorship error must have been without deceptive intention
 - The statute allowed for complete substitution of inventors—regardless of any mis-joined inventor's intent—as long as the non-joined inventor was without deceptive intent
 - Good faith was presumed absent a persuasive showing of deceptive intent

What happens if you get it wrong cont'd

- One view the statutory change » “no-fault inventorship”
- Inventorship can be corrected irrespective of deceptive intent in the original naming of inventors

What happens if you get it wrong cont'd

Inventor's Oath or Declaration

(h) Supplemental and corrected statements; filing additional statements—

(1) In general.—Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time.

...

(3) Savings clause.—A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

(i) Acknowledgment of penalties.—Any declaration or statement filed pursuant to this section shall contain an acknowledgement that any willful false statement made in such declaration or statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.

What happens if you get it wrong cont'd

(b) PATENT VALID IF ERROR CORRECTED.-- 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 into question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

- Remember:

(a) CORRECTION.-- 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]**

What happens if you get it wrong cont'd

- Also, recall 35 U.S.C. § 102(f):

A person shall be entitled to a patent unless—

...

(f) he did not himself invent the subject matter sought to be patented.

35 U.S.C. § 102(f) (2002)

- Section 102(f) was deleted from the statute by the AIA (effective March 16, 2013)

What happens if you get it wrong cont'd

- The removal of § 102(f) also seems to support the “no-fault” inventorship notion
- But:
 - “A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent.”

What happens if you get it wrong cont'd

- And:
 - As the Federal Circuit has noted, invalidation for improper inventorship predates the creation of § 102(f), and was not altered by the creation of § 102(f)

What happens if you get it wrong cont'd

- Inequitable conduct
 - Lying about inventorship is grounds for inequitable conduct
 - Renders patent unenforceable
 - But, what about 35 U.S.C. § 115(3)?

(3) Savings clause.—A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section **if the failure is remedied** as provided under paragraph (1).

What happens if you get it wrong cont'd

- Do the changes to § 256 affect the law on invalidation and unenforceability for improper inventorship?
- This will most likely come up in the context of patent infringement
 - Defendant raises defense of invalidity/unenforceability for incorrectly naming inventors
 - Plaintiff seeks to correct
 - Defendant says correction not an option due to deceptive intent

What happens if you get it wrong cont'd

- Judicial correction under 35 U.S.C. § 256
 - Defense to allegation of infringement
 - Instances of “you stole my invention”
 - Mis-joinder
 - Naming non-inventors
 - Non-joinder
 - Failing to name inventors

What happens if you get it wrong cont'd

- Inventorship is a question of law based on underlying fact findings
- A patent's designation of inventors is presumed to be correct
- The burden of showing mis-joinder or non-joinder is one of clear and convincing evidence

What happens if you get it wrong cont'd

- “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. One must contribute to the conception to be an inventor.”

What happens if you get it wrong cont'd

- A non-joined inventor's claim to inventorship must be corroborated
- To meet the clear and convincing evidentiary burden, non-joined inventors must prove their contribution to the conception of the invention with more than their own testimony
- Whether testimony is sufficiently corroborated is evaluated under a "rule of reason" analysis which requires an evaluation of all pertinent evidence

What happens if you get it wrong cont'd

- Corroborating evidence may take many forms, including documents and records contemporaneous to the inventive process and testimony from third-parties
- Circumstantial evidence about the inventive process may also corroborate

What happens if you get it wrong cont'd

- The court must consider corroborating evidence in context, make credibility determinations, and assign appropriate weight to determine whether clear and convincing evidence supports the inventorship claim
- There need not be corroboration for every contested factual issue

What happens if you get it wrong cont'd

- Defenses to § 256 correction
 - Laches
 - Equitable estoppel
- Where laches or estoppel bars correction, the court need not address the merits of the inventorship claim

Serdarevic v. Advanced Med. Optics, Inc., 532 F.3d 1352 (Fed. Cir. 2008)

What happens if you get it wrong cont'd

- Laches
 - The patentee asserting a laches defense must show:
 - The inventorship claim was brought after unreasonable and unexcused delay; and
 - The patentee is likely to suffer evidentiary or economic prejudice as a result

Advanced Cardiovascular Sys., Inc. v SciMed Life Sys., Inc., 988 F.2d 1157 (Fed. Cir. 1993)

What happens if you get it wrong cont'd

- Courts may find evidentiary prejudice where the patentee shows the delay affects its ability to adequately defend against the claim
 - Loss of records or death of a witness
 - Loss of monetary investments
 - Patentee may incur damages that would likely have been prevented had the suit been brought earlier

A.C. Aukerman Co. v. R.L. Chaides Const. Co., 960 F.2d 1020 (Fed. Cir. 1992)

What happens if you get it wrong cont'd

- Laches period is measured from the issuance of the patent
- Rebuttable presumption of laches is triggered if the delay is more than six years

Hor v. Chu, 699 F.3d 1331 (Fed. Cir. 2012)

What happens if you get it wrong cont'd

- Excusable delay
 - Poverty
 - Illness
 - Reissue
 - War
 - Other litigation

Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA, 944 F.2d 870 (Fed. Cir. 1991)

What happens if you get it wrong cont'd

- Inexcusable delay
 - Unfamiliarity with the U.S. patent system
 - Inability to find counsel
 - Reexamination
 - Licensing efforts

What happens if you get it wrong cont'd

- Unclean hands
 - Challenger must prove the patentee engaged in egregious conduct:
 - Willfully taking steps to prevent an inventor from learning about a patent application; and
 - The misconduct was responsible for the delay in bringing suit

Yeda Research And Dev. Co. Ltd. v. Imclone Sys. Inc., 443 F. Supp. 2d 570
(S.D.N.Y. 2006)

What happens if you get it wrong cont'd

- Equitable estoppel
 - Requires proof:
 - That the claimant, who had knowledge of the true facts, communicated (through words, conduct, or silence) to the patentee in a misleading manner;
 - The patentee relied on the claimant's action or inaction; and
 - The patentee would be materially harmed if the claimant were allowed to assert a claim inconsistent with earlier conduct

A.C. Aukerman Co. v. R.L. Chaides Const. Co., 960 F.2d 1020 (Fed. Cir. 1992)

What happens if you get it wrong cont'd

- Events occurring prior to patent issuance have resulted in equitable estoppel

What happens if you get it wrong cont'd

- Alternatives to challenging inventorship
 - Equitable transfer of ownership
 - The remedy of assignment is a different question from inventorship
 - Assignment is considered an administrative, as opposed to judicial, action

Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226 (Fed. Cir. 1989)

- May still have a validity issue

Practice pointers

- Get it right the first time
 - Address inventorship at the outset of each new case
 - Assess inventorship again prior to issuance, especially if claims have been amended
 - Consider memo to file listing inventorship claim-by-claim
- Educate inventors and principles
- Ask questions when naming an inventor's boss
- Never name the patent attorney
- Error on the side of inclusion

FOR MORE INFORMATION

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