Patent Pending
Inventorship: Getting It Right

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The Society of Vacuum Coaters is pleased to introduce the first in a series of articles dedicated to topics of United States patent law and practice before the United States Patent and Trademark Office.

The United States Patent Act requires that every patent application be filed in the name of the sole inventor or, in the case of a joint invention, the names of the joint inventors. Inventorship is a question of law and the standard for determining the correct inventorship may be unfamiliar to those engineers and scientists engaged in research and development. Failure to list the proposed inventors on the patent application can have dire consequences for the patent owner and can result in compromised ownership and loss of the right to enforce the patent against infringers. While it is possible to correct inventorship during examination of a patent application or following the grant of the patent, it is much more desirable to confirm the proper inventorship before filing the patent application.

The United States Patent Act requires that every new patent application be filed in the name of the sole inventor or the names joint inventors of the invention disclosed in the patent application. The failure to name all of the actual inventors on a patent application is referred to as “non-joinder”, while the inclusion of non-inventors on the patent application is referred to as “misjoinder”. While the Patent Examiners at the United States Patent and Trademark Office generally do not request information from the applicants relating to the determination of inventorship during prosecution of the application, it is the responsibility of the applicants and their patent attorneys to ensure that the inventors named in the patent application are the true inventors of the subject matter disclosed in the patent application. Failure to name only the true inventors on a patent application, whether by misjoinder or non-joinder, coupled with a deceptive intent, may result in subsequent finding by a U.S. court of law that the resulting patent is invalid or unenforceable against third party infringers. Consequently, it is of paramount importance that the patent attorney interviews the proposed inventors at the time of filing the patent application to confirm the correct inventors for each and every application.

35 U.S.C. §101 provides, “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. 116 further provides, “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.”

For each new patent application that a client wishes to file with the United States Patent and Trademark Office, the client’s patent attorney or patent agent will usually require that the client complete an invention disclosure record and return it to the patent attorney. The invention disclosure record will provide the patent attorney with a description of the invention and will include the name(s) of the potential inventors. The invention disclosure record is intended to provide the patent attorney with information about the proposed inventor(s) who contributed to the conception of the invention. This information includes the names of the sole inventor, or in the case of a joint invention, the names of the proposed joint inventors names, the residential postal address of each proposed inventor, and country of citizenship each proposed inventor. However, the invention disclosure record usually does not provide a detailed explanation regarding each of the proposed inventors’ contribution to the conception of the invention.

For a wide variety of reasons, the invention disclosure record submitted to the patent attorney may initially include an incorrect listing of proposed inventors. For example, due to internal business politics, non-inventors may be included on the invention disclosure record. Certain non-inventors may include the vice-president of technology for the client, the manager of research and development of the client, or possibly a product manager that is responsible for the commercialization of the subject matter that constitutes the invention. In the context of a university client, the true inventor(s) may erroneously include the names of their colleagues in other university laboratories that merely provided the state of the art or other non-inventive contribution, doctoral students working the laboratory of the true inventor, or other laboratory personnel, even if such persons contributed nothing to the conception of the invention or merely assisted in the reduction to practice at the direction of the true inventor(s). In the case of the independent inventors, there may be a tendency the true inventor to list family members or friends as proposed inventors on the invention disclosure record. These practices should be avoided at all costs. The recommended practice is that only the actual and true persons that contributed to the conception of the subject matter claimed in the patent application be listed on the invention disclosure record that is submitted to the patent attorney.

The patent attorney will prepare the patent application after receiving and reviewing the invention disclosure record. The patent application will conclude with a set of numbered “claims”, which define the legal scope of protection for the invention. Once the final set of claims has been prepared and are in condition for filing with the United States Patent and Trademark Office, the patent attorney should review the claims with the proposed inventors to confirm that those persons initially listed on the invention disclosure record truly participated in the conception of the subject matter presented in at least one of the claims in the finalized patent application, and/or remove those person(s) that were initially
included who did not participate in conception of the invention, and/or add true inventors that were not initially listed on the invention disclosure record. The patent attorney must determine the true inventorship on a claim-by-claim basis. The determination of the true inventorship for the claimed subject matter is a two-step process. According to the first step of the process, the patent attorney should construe the scope of each claim set forth in the patent application. After the scope of each claim has been determined, the patent attorney compares the purported contribution of each proposed inventor to the conception of the subject matter to determine whether or not the correct inventors were included on the invention disclosure record. Joint inventors included on an invention disclosure record need not have contributed the subject matter of every claim set forth in the patent application. Moreover, the joint inventors are not required to work together and the contribution of each joint inventor need not be of equal importance.

The term conception refers to "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." Cooper v. Goldfarb, 154 F.3d 1321 (Fed. Cir. 1998). It is important to understand that "it is not sufficient that the result to be obtained be conceived, but it is required that there be conceived and disclosed the means provided to accomplish the result..." Field v. Knowles, 183 F.2d 593 (1950). However, a person does not qualify as a joint inventor if that person only assisted the true inventor by reducing the true inventor's ideas to practice or merely provided an explanation of the state of the art for the particular field.

Under the United States patent law, in the absence of a contract to the contrary, the true inventors own the invention, the corresponding patent application for the invention, and any granted patent resulting from the patent application. Most employed engineers and scientists have employment contracts that require them to assign all rights to the invention and related patent applications/patents to their employer. Naming non-inventors on a filed patent application may expose the true owner of the invention to claims of ownership by the non-inventors named on the application. This will cause the true patent owner to dedicate time, effort, and money to correcting the incorrect inventorship at the Patent Office or in a court of law.

In summary, the United States Patent Act requires that the patent application be applied for in the names of the true inventor(s). The inventorship roster on a granted United States patent will most certainly come under attack by alleged infringers during an infringement litigation involving enforcement of the patent in an effort to invalidate the patent. Paying close attention to inventorship issue at the time the invention disclosure form is submitted to the patent attorney, and revisiting the inventorship analysis after the final set of patent claims have been prepared, will go a long way to avoiding the pitfalls related to ownership disputes and patent invalidity.

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