

# **CLEARING UP THE “MUDDY METAPHYSICS” OF PATENT INVENTORSHIP**

**(OR -- HOW TO CONDUCT AN INVENTORSHIP DETERMINATION)**

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**IT IS ONE OF THE MUDDIEST CONCEPTS IN  
THE MUDDY METAPHYSICS OF THE PATENT LAW<sup>1</sup>**

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<sup>1</sup> *Mueller Brass Co. v. Reading Industries, Inc.*, 352 F. Supp. 1357, 1372 (E.D. Pa. 1972) (describing the concept of joint inventorship).

**THIS PAPER IS INTENDED TO PROVIDE A PATENT PRACTITIONER WITH GUIDELINES FOR CONDUCTING INVENTORSHIP INQUIRIES. THE GUIDELINES ARE APPLICABLE TO DETERMINE INVENTORSHIP AS A PRELIMINARY MATTER, BEFORE A PATENT APPLICATION IS FILED, AS WELL AS TO RESOLVE INVENTORSHIP DISPUTES AFTER A PATENT APPLICATION HAS BEEN FILED OR A PATENT HAS ISSUED. THIS PAPER ALSO EXPLAINS HOW INVENTORSHIP MAY BE CORRECTED IN PATENT APPLICATIONS ISSUED AND IT PROVIDES HELPFUL “PRACTICE TIPS” RELATED TO INVENTORSHIP DETERMINATION AND CORRECTION.**

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## I. INTRODUCTION

Typically, identifying inventorship in a patent application is a routine ministerial task left to one of the “identifiable” inventors or to a patent liaison person. The patent attorney usually accepts the inventorship determination without question or verifies inventor status via a cursory leading-examination of a primary inventor. Inventorship never becomes an issue with the vast majority of patents and patent applications.

Inventorship questions usually involve situations where patent title is disputed. Absent an obligation to assign an invention, title to a patent resides separately with each joint inventor. And the inventorship dispute is a thinly veiled attempt to obtain or void patent title. The stakes can be enormous and the inventorship inquiry must be performed thoroughly and correctly. An attorney involved in an inventorship dispute quickly learns that proper determination of inventorship *before* a patent application is filed will prevent a “muddy” mess later.

This paper is intended to provide the patent practitioner with sufficient information and guidance to conduct a thorough inventorship inquiry, both before a patent application has been filed and once an issue of inventor misjoinder has been raised. This paper describes options for correcting inventorship and it gives instructions on successfully correcting inventor misjoinder or nonjoinder without jeopardizing the validity of the underlying patent or patent application.<sup>4</sup>

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<sup>2</sup> This paper is based, in part, on a paper presented by Edward W. Remus and H. Blair Hughes at the AIPLA Annual Meeting, October 1995.

<sup>3</sup> *Mueller Brass Co. v. Reading Industries, Inc.*, 352 F. Supp. 1357, 1372 (E.D. Pa. 1972) (describing the concept of joint inventorship).

<sup>4</sup> Appendix II of this paper includes a listing and brief summary of all Federal Circuit cases deciding inventorship issues.

## **II. THE INVENTORSHIP INQUIRY**

The patent statute requires that a patent application be filed in the name of the inventor or inventors. An invention can be the result of the efforts of a single individual. But, most often, inventions are the result of a collaboration between individuals with a common obligation to assign the invention to their employer. In such cases, inventorship is frequently not a concern, and the inventors are identified without conducting an in depth investigation of the nature of the contribution of each “inventor” to the claimed invention. Yet patent policy demands that inventorship be correct for all patents irrespective of whether the invention is commonly assigned. Thus, any inquiry into inventorship is important.

### **A. Start With The Statute**

The patent statute requires that a patent application be filed only in the name of the inventor or inventors. 35 U.S.C. §§ 111, 115, and 116.

#### **§ 116 - Inventors**

When an invention is made by two or more persons jointly, they shall apply for a 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.

....

The same statute also established that patent application inventorship can be corrected.

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, 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.

### **B. The Policy Behind The Statute**

The policy underlying inventorship is based on the Constitutional recognition of patents as an intellectual property right. The Constitutional recognition of patents has been limited to allow only the first to invent to receive a patent from the United States. Thus, inventorship entitles the inventor to a patent property right only if:

- (1) the “actual” inventor is seeking the property right: and
- (2) the “actual” inventor is the first originator of the invention upon which a patent is sought.

These two limitations ensure that the inventor is being rewarded with a patent from the public who is benefiting from the inventor's early disclosure of an invention in a patent. The public, however, does not benefit if it awards a patent to a non-inventor or later inventor who copies or misappropriates the invention.

### III. CONCEPTION IS THE TOUCHSTONE OF AN INVENTORSHIP INQUIRY

Conception is the touchstone of inventorship, the completion of the mental part of invention. *Burroughs Wellcome Co. v. Barr Laboratories, Inc.*, 40 F.3d 1223, 1227 (Fed. Cir. 1994); *Trovan, Ltd. v. Sokymat SA*, 299 F.3d 1292, 1302 (Fed. Cir. 2002).

At first glance, determining inventorship appears to be a simple task. It requires determining who conceived of the subject matter of a patent application claim. Those who participated in the conception of a claimed invention are the inventors. Those who were not involved are not inventors. But, in order to know who conceived an invention one must know what invention conception is -- this is where the inventorship inquiry can get muddy.

#### A. Definition of Conception

Conception is a two-step procedure. First, conception must “exist” and then conception must be “complete.” The person or persons involved in both steps are entitled to be called inventors.

##### 1. Existence of Conception

Conception exists when a “definite and permanent idea of an operative invention including every feature of the subject matter sought to be patented is known.” *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985); *Trovan*, 299 F.3d at 1302.

##### 2. Completion of Conception

Conception is complete when one of ordinary skill in the art could construct the apparatus, perform the process, or make the composition without unduly extensive research or experimentation. *Trovan*, 299 F.3d at 1302 (citing *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994)).

- **Conception can be complete though experimentation continues**

Invention conception may be complete even though experimentation continues. This occurs with many inventions where the concept has been proven by the inventors but where the invention must be modified, streamlined, or perfected to make it commercially viable. In order to determine if conception is complete -- even though experimentation continues -- one must examine the nexus between the research and the concept to determine whether or not the research was undertaken to complete conception. *Bac v. Loomis*, 252 F.2d 571, 577 (CCPA 1958).

- **The concept contributed must be patentable**

The conception of an invention -- as a whole -- may consist of the conception of many elements of the overall invention by one or more people. Inventor conception determination, therefore, requires determining what is inventive. The contribution of only obvious elements or improvements to a claimed invention adds nothing to the invention and, one who contributes only obvious elements is not an inventor. *Sewall*, 21 F.3d at 415-16; *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998); *Eli Lilly v. Aradigm Corp.*, 376 F.3d 1352, 1359 (Fed. Cir. 2004).

- **Conception occurs before reduction to practice**

Invention reduction to practice occurs in one of two ways:

- (1) Constructive Reduction To Practice -- filing a patent application describing and claiming the invention sufficiently to teach one of skill in the art how to practice the invention; or
- (2) Actual Reduction To Practice -- Sufficiently developing and testing the invention to show that it will work for its intended purpose.

*Newkirk v. Lulejian*, 825 F.2d 1581, 1582 (Fed. Cir. 1987); *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1332 (Fed. Cir. 2001). One who aids only in reducing a conceived invention to practice can never be an inventor.

### **Practice Tip**

- Identifying the “invention” must precede identifying inventors. Thus, the first task in any inventorship investigation is to identify the “invention.”

### **B. Simultaneous Conception And Reduction To Practice**

Simultaneous conception and reduction to practice of an invention is rare. Simultaneous conception happens when, for example, a shotgun approach is used to solve a problem. If one randomly chooses 1000 compounds and tests them as insecticides against different insects in different amounts and discovers that a specific dose of one compound works against a specific insect, then both conception and reduction to practice occur upon identifying the one compound which worked as an insecticide. *See, e.g., Alpert v. Slatin*, 305 F.2d 891 (CCPA 1962).

If the same 1000 compounds were evaluated by a person who then selected 40 as insecticide candidates against a certain insect for a reason understood by the inventor, and which could be explained to one of skill in the art, then the selection of the 40 promising compounds would be the invention conception. *See, e.g., Burroughs Wellcome*, 40 F.3d at 1228.

- **Conception does not exist where viability of the concept is uncertain**

Conception is not complete if a subsequent course of experimentation, especially experimental failures, reveals uncertainty that so undermines the specificity of the inventor’s idea, that it is not yet a definite and permanent reflection of the complete invention as it will be used in practice. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207 (Fed. Cir, 1991). If the inventor's conception is faulty, there can be no invention because conception cannot be certain.

Lack of problems with (or difficulties with) subsequent research is evidence of conception (or lack thereof). *Burroughs Wellcome*, 40 F.3d at 1229.

## **IV. PERFORMING AN INVENTORSHIP INQUIRY**

The test for inventorship is always the same whether the test is being applied prior to the filing of a patent application or in order to resolve an inventorship dispute. The inventorship test applies equally to sole inventorship and joint inventorship situations. Inventorship cannot be determined, however, without evidence: evidence of conception of the invention, and evidence of the invention.

Issues of joint invention present the most difficult inventorship issues. Solving joint inventorship issues is made easier by looking at evidence of the character of the collaboration as well as evidence of the invention conception.

### A. Conception May Be Joint

Joint invention is the product of a collaboration between two or more persons working together to solve the problem addressed. 35 U.S.C. § 116.

About 80% of all U.S. Utility Patents are issued to joint inventors. It is no surprise, therefore, that most inventorship questions arise in the context of joint inventorship disputes -- where a person has allegedly been nonjoined or misjoined as a patent inventor. Only in rare instances does a person seek to replace the sole inventor named in a patent or patent application, and those rare cases usually involve situations where the named inventor derived the invention from the nonjoined inventor.

In *Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824 (D.D.C. 1967), the District Court for the District of Columbia directly addressed the difficult task of defining joint invention. The court stated that joint inventorship does not necessarily require the same amount or type of contribution of the joint inventors or that they work together. However, the court also stated a general rule that:

“A joint invention is the product of collaboration of the inventive endeavors of two or more persons working towards the same end producing an invention by their aggregate efforts. To constitute a joint invention, it is necessary that each of the inventors work on the same subject matter and make some contribution to the inventive thought and to the final effort ...”

The Federal Circuit has confirmed that *Monsanto* is good law. *Kimberly-Clark Corp. v. The Proctor and Gamble Company*, 973 F.2d 911, 916-17 (Fed. Cir. 1992).

The leading treatises agree. For example, Robinson in his treatise on patents states:

“Only where the same single, unitary idea of means is the product of two or more minds, working pari passu, and in communication with each other, is the conception truly joint and the result a joint invention.”

1 W. Robinson, *The Law of Patents for Useful Inventions* §396 (1890).

Contemporary treatise writers are also in accord:

“[A] joint invention occurs when two or more persons, collaborating together, each contribute to the conception of the solution of a problem which constitutes the invention.”

1 D. Chisum, *Patents* § 2.02[2] (2005) (citing Robinson's treatise) (emphasis added).

“If several persons collaborate to produce a joint invention, the conceptions and inventions of use to them will be assimilated into the joint invention only if those conceptions and inventions were generated by the collaborative effort which produced the invention. Therefore a conception or invention which is developed by a joint inventor before commencement of the collaborative effort never can be treated as the conception of a

joint invention because it is not the result of a collaborative effort to produce a joint invention.”

1 E. Lipscomb, Lipscomb's Walker on Patents § 3.8 (3rd ed. 1984) (citing *General Motors Corp. v. Toyota Motor Co.*, 667 F.2d 504 (6th Cir. 1981).

Joint invention still requires that each inventor individually or together conceive the invention of at least one claim of a patent or patent application. Ultimately, the question of joint inventorship focuses on what invention was conceived by whom and when?

### **B. First -- Evaluate The “Character” Of The Inventors’ Contribution**

Much of the case law involving joint inventorship focuses implicitly on circumstances surrounding the conception of an invention -- the character of the inventors' contribution. Thus, an understanding of circumstances surrounding the invention conception that mitigate for and against joint conception is helpful when determining inventorship.

- **Joint Conception May Exist Where:**

- There were joint labors.

“Each needs to perform but a part of the task if an invention emerges from all of the steps taken together, It is not necessary that the entire inventive concept should occur to each of the joint inventors, or that the two should physically work on a project together.” *Monsanto*, 269 F Supp. at 824; *see also Eli Lilly and Co. v. Aradigm Corp.*, 376 F.3d 1352, 1359 (Fed. Cir. 2004).

- Small contributions are made by one inventor, and large contributions by the other.

*Shields v. Halliburton Co.*, 493 F. Supp. 1376, 1385 (W.D. La. 1980); 35 U.S.C. § 116 (2005).

- The inventors make independent contributions to the conception.
- Individual claims may be invented by different persons.

*Amp, Inc. v. Fujitsu Microelectronics, Inc.*, 853 F. Supp. 808, 819 (M.D. Pa 1994); 35 U.S.C. § 116 (2005)

- Invention conceived in stages via organized R & D efforts.

*General Motors Corp. v. Toyota Motors Co.*, 667 F.2d 504, 506 (5th Cir. 1981).

- **Joint Conception Will Not Exist Where:**

- One contributes an obvious element to the invention.

*Erie Technological Prods, v. Die Craft Metal Prods*, 461 F.2d 5, 6-7 (7th Cir. 1972).

- One merely suggests an idea.

*Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980-81 (Fed. Cir. 1997); *Garrett Corp. v. United States*, 422 F.2d 874, 880-81 (Ct. Cl. 1970), *cert. denied*, 400 U.S. 951 (1970).

- One only follows instructions.

*Mineral Separation, Ltd. v. Hyde*, 242 U.S. 261, 270 (1916); *Engelhardt Minerals and Chemicals Corp. v. Anglo American Claus Corp.*, 586 F.Supp. 435, 445 (M.D. Ga. 1984).

- One explains how or why the invention works.

*GAF Corp. v. AMCHEM Prods.*, 514 F. Supp. 943, 972 (E.D. Pa. 1981).

- One participates in consultations prior to or after conception.

*O'Reilly v. Morse*, 56 U.S. 15(How) 62 (1853); *Ethicon*, 135 F.3d at 1460.

- One adopted derived information.

- One only acts as a salesman, showing an available product and explaining how it could and might be used.

*Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d at 981

- Where conception is nonconjunctive -- where conception occurs before another became involved with the invention.

*Credle v. Bond*, 25 F.3d 1566, 1574 (Fed. Cir. 1994) (there can be no joint invention where dates of conception and reduction to practice of each inventors contribution do not overlap).

## **C. Second - Evaluate Invention Conception**

### **1. Test Of Conception**

The test for conception combines the principles of the existence of and completion of conception. Conception exists if:

the inventor(s) had an idea -- a specific settled idea, a particular solution to the problem at hand and not a general goal or research plan -- that was definite and permanent enough that one skilled in the art could understand the invention.

*Burroughs Wellcome*, 40 F.3d at 1228; *see also The University of Colorado Found., Inc. v. American Cyanamid Co.*, 342 F.3d 1298, 1308 (Fed. Cir. 2003). Conception is a definite solution to a problem that

can be explained to and understood by one skilled in the art and that requires only the assistance of one of ordinary skill in the art to reduce to practice.

## **2. Proof Of Conception**

- **Conception is proven by showing:**

1. An idea that is definite and permanent -- it must involve a specific approach to the problem at hand.
2. The idea must be sufficiently precise so that a skilled artisan can carry out the invention without undue experimentation.

- **Proof of conception does not require:**

knowledge with *any* degree of certainty that the invention will work!  
*Burroughs Wellcome*, 40 F.3d at 1228.

## **D. Corroborating Evidence Of Conception**

Any allegation of conception must be supported by corroborating evidence. Conception occurs “in the mind of the inventor” and not in the mind of another and must be established by some evidence of corroboration independent of the inventor’s testimony. *Mikus v. Wachtel*, 542 F.2d 1157 (CCPA 1976); *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1327 (Fed. Cir. 2004). Proof of conception requires corroborating evidence of and preferably contemporaneous disclosure in writing. Thus, the laboratory notebook, the invention disclosure, articles, publications, and offers for sale are corroborating evidence conception.

## **E. Sources of Corroborating Evidence**

Evidence of invention conception typically does not come on a silver platter. It is found on random pages in hand-written laboratory notebooks, in drawings, in scholarly articles, in notes of telephone conversations between possible joint inventors, in meeting minutes and in many other diverse documents. Probably the most difficult task for the patent practitioner undertaking an inventorship inquiry is to compile all relevant inventorship information into a comprehensive and comprehensible package. Once enough relevant information is collected, the determination of inventorship often becomes quite straightforward.

You have been given the tools to analyze an inventorship dispute, and now we are going to provide you with sources of corroborating evidence.

### **1. The Named Inventors**

At least the named inventor with the most involvement in developing an invention should be questioned in an inventorship investigation. The questions should be in writing and so should the inventor’s answers. Questions that an inventor or potential inventor can be asked regarding invention conception are legion. An example of a line of questioning that might be useful is attached to this paper as Appendix I. Regardless of the line of questioning pursued, any inventorship inquiry should produce answers to these basic questions: (1) What the invention is; (2) What each alleged inventor contributed to the invention; and in the case of a nonjoined inventor (3) Why the nonjoined inventor was not named as an inventor.

Of course, at least the lead inventor should be queried about the type and location of all written documentation supporting conception of the invention including invention disclosures, laboratory notebooks, experimental data, reports, speeches, technical presentations, articles, and any other information that might be relevant to determining invention conception. If more corroborating evidence of conception is needed, then each named inventor should be questioned about documents that corroborate the invention conception.

## **2. The Misjoined Inventor**

The misjoined inventor is a person named an inventor who potentially should not have been, and the person not named an inventor who potentially should have been. The misjoined inventor should be treated as a potential inventor, and the misjoined inventor should always be questioned. The questions in Appendix I may be directed to a misjoined inventor. But in all cases, the misjoined inventor should be asked: (1) what he or she believes the invention is; and (2) what he or she contributed to the conception of the invention. The misjoined inventor should be questioned as well about written documentation supporting the inventorship claim.

## **3. Corroborating Documentation**

The most compelling evidence of inventorship comes from corroborating documentation -- documents describing the invention and the circumstances surrounding the invention conception. *Sandt Tech. Ltd. v. Resco Metal and Plastics, Corp.*, 264 F.3d 1344, 1350-51 (Fed. Cir. 2001). Corroborating documentation will likely show when conception existed, who was working on developing the invention when, and when the invention was conceived to the point that it need only to be reduced to practice.

### **• Practice Tip**

While drafting a patent application, the patent practitioner should investigate claim inventorship. The following questions should provoke answers that will aid the patent practitioner in identifying the application inventors.

1. What problem is solved by the invention?
2. When did you know that you had solved the problem?
3. Who helped solve the problem?
4. How did each person help solve the problem?
5. Did all persons equally help solve the problem?

These questions are simplistic -- an invention may solve a number of problems and an invention may consist of one or more distinctly patentable ideas. But asking these questions will provoke more questions, the answers to which will aid the patent practitioner in ascertaining the true application inventors.

## V. INVENTORSHIP CORRECTION

Non-fraudulent correction of inventorship is allowed during the pendency of a patent application, and after a patent has issued. In the first situation, the patent applicant must prove:

- (1) The omitted person was a true joint inventor;
- (2) the joint inventor was omitted by error; and
- (3) the omission was without deceptive intent on the part of the inventors.

The proof is the same for removing a misjoined inventor from a patent application, in which case, proof that the added person was not a true joint inventor, and that the misnamed inventor was named by error without deceptive intent would be necessary.

In the second situation, where correction is sought after the patent has issued, the patentee must prove:

- (1) The omitted person was a true joint inventor;
- (2) the joint inventor was omitted by error; and
- (3) the omission was without deceptive intent on the part of the omitted inventor.

The proof required for removing a misjoined inventor from a patent is proof that the added person was not a true joint inventor; however there is no additional requirement of proof under 35 U.S.C. § 256 that the error of including that person was without deceptive intent.

### A. Inventorship Correction While Patent Application Is Pending

Correction of inventorship during the pendency of a patent application is controlled by 35 U.S.C. § 116, ¶ 3 which allows inventorship to be corrected where “through error a person is named in an application for a patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive intention on his part . . .”

- **Patent Application Inventorship Correction No Longer Requires Diligence**

Prior to December 1, 1997, correction of nonjoinder or misjoinder of inventors in a patent application required diligence on the part of the patent applicant. As of December 1, 1997, the requirement that an amendment of the inventorship under 37 C.F.R. § 1.48 be made “diligently” has been removed. Section 1.48(a) of 37 C.F.R. now states that “[i]f the inventive entity is set forth in error . . . , and such error arose without any deceptive intention . . . , the inventorship of the nonprovisional applications may be amended to name only the actual inventor or inventors.” *Id.* Therefore, on motions to correct the inventorship of an application filed on or after December 1, 1997, diligence is not a requirement. *Schulze v. Green*, 136 F.3d 786, 789 n.3 (Fed. Cir. 1998).

### B. Inventorship Correction After Patent Issue

37 C.F.R. § 1.324, which regulates the correction of inventorship in issued patents states:

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 Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors.

Under the regulation, any request to correct inventorship must be accompanied by:

- (1) A statement from each person 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 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 (1) and (2) 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).

See 37 C.F.R. § 1.324(b).

The statute does not require an omitted inventor, nor anyone else for that matter, to diligently bring a law suit or action to correct inventorship or be barred from doing so as a matter of law. *Stark v. Advanced Magnetics, Inc.*, 29 F.3d 1570, 1575 (Fed Cir. 1994).

Once a patent issues, the patent inventorship can be corrected by the patentee by petition to the U.S. Patent Office. Alternatively, a Federal District Court can be asked to add a nonjoined inventor to a patent, or to remove a misjoined inventor from a patent.

- **Correction By Patent Office**

Inventorship may be corrected by the Patent Office during the pendency of a patent pursuant to 35 U.S.C. § 256 which provides:

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 requirement as may be imposed, issue a certificate correcting such error.

- **Judicial Correction**

Inventorship of an issued patent may be corrected by a Court upon request pursuant to the second paragraph of 35 U.S.C. § 256 which provides:

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.

### **C. Laches and Estoppel Can Bar Correction**

The equitable principles of laches and estoppel have been applied to bar judicial correction of inventorship. *See, e.g., MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 1571-72 (Fed. Cir. 1989) (concluding that equitable estoppel barred correction of inventorship under Section 256 because the alleged non joined inventor knew of the application and patent, asserted inventorship, acquiesced, and waited four years to have inventorship corrected while named inventors developed a company based on the patented technology).

Cases in which estoppel or laches have been applied to bar correction of inventorship occur in situations where there has been a delay after an assertion of inventorship rights. For example, in *Crainich v. Feinstein*, an omitted inventor communicated with the patentee without making an inventorship claim. Five years later, the omitted inventor sought judicial correction of the issued patent under 35 U.S.C. § 256 and the court concluded the omitted inventor was estopped from asserting an inventorship claim in view of detrimental reliance and prejudice to the original inventorship. *See Stark*, 29 F.3d at 1574 (describing *Crainich v. Feinstein*, No. 91 C 4045 (N.D. Ill. Dec. 3, 1991)).

### **D. Inventorship Correction During an Interference Proceeding**

There is a duty of diligence in correcting inventorship in a patent or patent application involved in an interference proceeding because a change of inventorship can directly affect the outcome of the interference proceeding. The obligation to correct inventorship of patent applications and patents in interference proceedings is found in the ordinary principles governing the duties of the parties to the interference proceeding. *See, e.g., Van Ortern v. Hafner*, 278 F.2d 738 (CCPA 1960) (noting a duty to state whether a party to an interference is a sole or joint inventorship).

- **Practice Tip**

Although diligence is not required for questions of inventorship of patents or patent applications that are not involved in an interference proceeding, to be prudent and avoid the appearance of impropriety, all inventorship claims should be investigated with diligence.

### **E. Procedures For Correcting Inventorship**

Correcting inventorship is liberally allowed where there has been error in naming the inventors. Before inventorship is corrected, however, the board or Court must examine all facts in order to determine whether or not conversion should be allowed. *See Coleman v. Dines*, 754 F.2d 353, 357 (Fed. Cir. 1985).

#### Patent Application

In order to justify correction of inventorship under Section 116, the movant must show:

- (1) the omitted person was a true joint inventor;
- (2) the joint inventor was omitted by error; and

- (3) the omission occurred without deceptive intent on the part of the omitted inventor.

Purging a misjoined inventor from a patent application requires the same three elements of proof except that there must be proof the misnamed inventor was not a true, joint inventor. *Coleman*, 754 F.2d at 357.

#### Issued Patent

In the case of nonjoinder, in order to justify correction of inventorship under Section 256, the movant must show:

- (1) the omitted person was a true joint inventor;
- (2) the joint inventor was omitted by error; and
- (3) the omission occurred without deceptive intent on the part of the omitted inventor.

Purging a misjoined inventor from a patent application requires the same first two elements of proof, plus proof the misnamed inventor was not a true, joint inventor. *Coleman*, 754 F.2d at 357. In correcting inventorship under § 256 in misjoinder cases, there is no requirement that the error must be innocent and free from deceptive intent. *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1555 (Fed. Cir. 1997). However, the implementing rule, 37 C.F.R. § 1.324, considers the deceptive intent of all actual inventors, which the Federal Circuit has noted “exceeds the literal scope of section 256,” but “reaches the result of reading section 256 in conjunction with the inequitable conduct standards.” *Id.* at 1556.

#### **1. Correcting Patent Application Inventorship**

The inventorship of a patent application may be amended to name the correct inventors as long as the error occurred without deceptive intent on the part of any of the actual inventors. The amendment of inventorship is accomplished by:

- filing a request to correct the inventorship that sets forth the desired inventorship change;
- include 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;
- include an new oath or declaration signed be each of the actual inventors;
- pay the fee required by 37 C.F.R §1.17(h); and
- obtain the written consent of any assignee.

37 C.F.R § 1.48(a)

- **Inventorship Correction Precipitated By Claim Amendment**

Inventorship correction can be required in a patent application after canceling or amending patent application claims so that less than all of the originally named inventors are inventors of the claims remaining in the application. When this occurs, inventorship amendment is accomplished the same way as above except that error without deceptive intent does not have to be proven and the consent of the assignee is not required.

## **2. Proof Of Error Without Deceptive Intent**

Where proof of error without deceptive intent is required, such proof must be in the form of “a statement of facts verified by all the original applicants” that “must include at least, a recital of the circumstances [surrounding the error], including the relative dates, of (1) the misjoinder and (2) the discovery of the misjoinder. *Coleman*, 754 F.2d at 358. Conclusory statements that the error occurred and arose without deceptive intent are not factual in nature and are insufficient to support the correction of inventorship in a patent application or patent.

- **Practice Tip**

Proof of error without deceptive intent is accomplished with affidavits and documents establishing as many of the following facts as possible: (1) The circumstances surrounding the initial determination of inventorship, including the date or dates when inventorship was discussed and the factors considered in the original determination of inventorship; (2) establishing how the error in inventorship was discovered including explaining who first discovered the misjoinder or non joinder error, when the error was discovered, and details of any investigations to establish whether an inventorship error had occurred including when the investigation took place and who was consulted; and (3) identifying the proper application inventors including identifying the contribution made by the non joined inventor or misconception about the contribution made by the misjoined inventor and including any laboratory data, drawings, reports, or other information which support the joinder or deletion of inventors from the patent or patent application.

## **F. Non-Meritorious Inventorship Claims**

In some instances, non-meritorious inventorship claims involving patent applications should be reported to the U.S. Patent Office. 37 CFR § 1.56 imposes a duty to report to the Patent Office any information that a Patent Examiner might consider relevant to the patentability of the application claims. Since a patent can only be issued in the name of the true inventors, information about the application inventorship relevant to the patentability of the claimed invention.

An inventorship dispute involving a pending patent application should be reported to the Patent Examiner where patent title is at issue and where the patent practitioner has investigated a patent application inventorship dispute diligently and in good faith concludes it is without merit. The patent practitioner should send a summary of the inventorship dispute to the Examiner along with all the evidence considered by the patent practitioner, as well as a written evaluation stating why the inventorship claims are considered to be without merit.

By providing the Examiner with information about an apparently meritless inventorship dispute, the patent practitioner satisfies his duty of disclosure to the patent office and places the burden on the Patent Examiner to agree or disagree with the inventorship analysis and conclusion.

## **VI. NO PENALTY FOR NAMING INCORRECT INVENTORS - USUALLY!**

Today, a good faith error in inventorship *never* renders a patent invalid. 35 U.S.C. § 256. If the inventorship error occurred without deceptive intent, then the misjoinder of inventors can be corrected before or after issuance of a patent without affecting the enforceability of the patent or the ability to collect damages for past infringement of the patent. *Checkpoint Systems v. U.S. Int'l Trade Comm'n*, 54 F.3d 756, 763 (Fed. Cir. 1995); *Stark II*, 119 F.3d at 1555.

Before Section 256 was enacted, incorrect inventorship of an issued patent invalidated the patent. A purpose of Section 256 was to provide a remedy for a mistake in inventorship. S. Rep. No. 1979, 82d Cong. 2d Sess. 7 (1952) *reprinted in* 1952 U.S.C.C.A.N. 2394, 2401.

Patents are rarely declared invalid for misdesignation of inventors. In fact, we found only a few opinions published since the statute was amended where a patent was declared invalid because a misdesignation of inventors occurred.

If the misdesignation of inventors occurred, then an issued patent with incorrect inventorship can be declared invalid for the following reasons:

- **Under 35 U.S.C. §102(f) - named inventor did not actually invent.**

*New England Braiding Co. v. A.W. Chesterfield Co.*, 970 F.2d 878, 883 (Fed. Cir. 1992) (affirming lower court conclusion that a preliminary injunction was improper and patentee would not prevail at trial because patentee derived the invention from another while an employee of the accused infringer).

- **Under 35 U.S.C. §1.02(g) -- prior invention by another.**

*Sandt*, 264 F.3d at 1350-51 (patent claim invalid where defendant provided corroborating evidence of prior inventorship, and the subject matter invented by the defendant was not abandoned and met all of the claim limitations); *see also Checkpoint Sys.*, 54 F.3d at 763.

- **For inequitable conduct - based on deceptive intent.**

The inequitable conduct route for invalidating a patent for misnaming inventors is not based upon the fact that the inventors were misnamed, but it is based on proof that the patentee withheld a material information from the patent office with an intent to deceive. *E.g.*, *Stark II*, 119 F.3d at 1555-56 (“The standards for inequitable conduct are not likely to permit enforcement of any patent procured by deceiving the [PTO].”); *see also PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315 (Fed. Cir. 2000); *Slade Gordon & Co. v. Mills*, 39 U.S.P.Q.2D (BNA) 1939 (Fed. Cir. Aug. 9, 1995) (unpublished opinion).

The first two bases for claim invalidity -- section 102(f) and 102(g) -- involve patents where failure to correct inventorship exposed the issued patents to the invalidity defenses. The third basis for invalidity -- inequitable conduct -- involves patents where inventorship cannot be corrected because the error in

inventorship was the result of deceptive intent. No case was found where a patent or patent application in which inventorship was properly corrected was subsequently declared invalid for the inventorship misjoinder or nonjoinder.

## **VII. AIDING THE SPURNED INVENTOR**

A person believing that they are rightfully entitled to be named as an inventor on a pending patent application or on an issued patent has a number of options for seeking inventorship correction. As a first step, the nonjoined inventor should always notify the other named inventors and the patent assignee of the inventorship claim and provide as much assistance and information as possible to prove that the inventorship claim is meritorious. If the named inventors and the patent assignee reject the inventorship claim, then an allegedly misnamed inventor still has options. The spurned inventor can: (1) file an identical patent application and claims while a patent application is pending or within one year of the patent issue date in order to provoke an interference; or (2) seek judicial correction of inventorship of an issued patent.

### **A. Correcting Inventorship Via An Interference**

There is no statutory method for correcting inventorship of a pending application where the named inventors and the assignee have rejected the inventorship claim of an omitted inventor. There is, however, at least one non-statutory method for correcting inventorship -- provoking an interference with the patent or patent application at issue.

An omitted inventor who wishes to be added as an inventor to a patent or application can file a patent application identical to a pending or issued patent and provoke an interference. Such an interference is called an “originality case” in contrast to a “priority case” and determines who made the invention instead of who made the invention first. *Sewall*, 21 F.3d at 415.

- **Practice Tip**

Proof of error without deceptive intent on the part of the unnamed inventor is a prerequisite for correcting nonjoinder in both pending patent applications and issued patents. Provoking an interference may be a good strategy to use where the nonjoinder appears to have occurred with deceptive intent. In such a situation there is no good reason for the nonjoined inventor to forgo patent rights because of the inequitable conduct of another inventor and an interference may allow the nonjoined inventor to correct inventorship without losing the right to receive a patent.

An omitted inventor who wishes to replace a sole inventor as the named inventor of a patent or patent application can file a patent or patent application and provoke an interference where the primary issue is priority -- who was the first inventor. This strategy would be used where the later “inventor” derived the invention from the earlier nonjoined inventor.

### **B. Judicial Action To Correct Inventorship**

35 U.S.C. § 256 permits judicial correction of inventorship that was the result of an error, even where the patentee and the assignee refuse to correct patent inventorship. *MCV*, 870 F.2d at 1570.

Federal Courts have federal question jurisdiction over Section 256 actions to correct inventorship because the dispute requires the resolution of a substantial issue of federal patent law. *Banks v. Unisys*

*Corp.*, 228 F.3d 1357, 1359 (Fed. Cir. 2000). According to the Federal Circuit, Section 256 “prescribes only one prerequisite to judicial action: all parties must be given notice and an opportunity to be heard.” *MCV*, 870 F.2d at 1570; *see also Fina Oil & Chemical Co. v. Ewen*, 123 F.3d 1466, 1471 (Fed. Cir. 1997). If that is done, Federal Courts have subject-matter jurisdiction over inventorship disputes arising under the second paragraph of Section 256. *Id.*

A Federal District Court entertaining a request to amend patent inventorship to correct nonjoinder of an inventor, then the Court must determine whether or not an error in inventorship occurred without deceptive intent on the part of the person seeking to be joined. If the Court decides that an error occurred, but that it occurred with deceptive intent, then inventorship cannot be amended and the patent is likely to be invalid for not being issued to the proper inventors.

Before seeking judicial assistance to correct inventorship, the patentee or patent assignee must refuse to correct the patent inventorship. Otherwise, there is no case or controversy for the Court to decide.

## **APPENDIX I INVENTORSHIP QUESTIONS**

- WHO Questions:
  - Who thought of the invention?
  - Who did the work to show the invention was practical?
  - Who witnessed the work?
  - Who directed the work?
  - Who followed directions?
  - Who prepared reports on the invention development?
  - Who received the invention development reports?
  - Who attended meetings where the invention was discussed?
  - Who prepared the invention disclosure?
  - Who first described the idea for the invention?
  - Who was involved in any way in helping develop the invention?
  - Who witnessed the invention development?
  - Who decided that the invention was complete?
  
- WHAT Questions:
  - What problem is solved by the invention?
  - What is the nature of the invention?
  - What is the nature of the prior art?
  - What experiments were conducted to develop the invention?
  - What prototypes were constructed to test the invention?
  - What records were kept of the invention development?
  - What further work is needed to develop the invention?
  - What did each person who helped develop the invention contribute?
  - What portions of the invention development did each witness see?

- WHERE Questions:

- Where was the invention developed?
- Where are written records, reports, articles and drawings of the invention kept?
- Where can the witnesses be reached?
- Where can the inventors be reached?

- WHEN Questions:
  - When did you first think of the invention?
  - When did you begin work on the invention?
  - When did the other inventors become involved?
  - When did the other non-inventors become involved?
  - When did you decide the invention was complete?
  - When did you tell others about your invention?
  - When did you tell others about completing your invention?
  - When did you test the completed invention?
  
- WHY Questions:
  - Why did you work with others to develop the invention?
  - Why didn't you work with others to develop your invention?
  - Why didn't you keep laboratory notebooks, records, etc.?
  - Why didn't you tell anyone you should (should not) be an inventor?
  - Why should (our shouldn't) X be named as an inventor?

## APPENDIX II

### FEDERAL CIRCUIT INVENTORSHIP CASE BRIEFS

1. **Morgan v. Hirsch**, 728 F.2d 1449 (Fed. Cir. 1984).

Party in an interference involving patent applications could not be an inventor of a count where the party merely posed the problem solved by the invention. “By asking someone to produce something without saying just what it is to be or how to do it is not what the patent law recognizes as inventing.”

2. **Dow Corning Corp. v. Danker Labs, Inc.**, 746 F.2d 1490 (Fed. Cir. 1984)(unpublished)

“A mental idea sufficient to enable one of ordinary skill in the art to actually construct the claimed invention without extensive research is sufficient to establish a complete conception.”

3. **Coleman v. Dines**, 754 F.2d 353 (Fed. Cir. 1985).

Procedure: Party to interference allowed to amend inventorship to remove misnamed inventor and thereby claim priority to earlier filed application and win priority contest.

Amendments under 35 USC § 116 should be liberally allowed upon showing error was innocent. Conception must be proved by corroborating evidence that the inventor had conceived the invention.

4. **Shatterproof Glass Corp. v. Libbey-Owens Ford Co.**, 758 F.2d 613 (Fed. Cir. 1985).

Instructions to jury that patent is invalid if it named the incorrect inventors was an oversimplification of the law because the instruction did not recognize the possibility of correcting an error in inventorship.

5. **MCV, Inc. v. King-Seeley Thermos Co.**, 870 F.2d 1568 (Fed. Cir. 1989).

Section 256 request to change inventorship is a substantial question of federal law giving Federal Courts jurisdiction over the issue.

Inventorship correction barred by equitable estoppel where non joined inventor knew of patent application claims, disclaimed any interest in being named an inventor, and then waited four years to seek correction.

6. **Amgen, Inc. v. Chugai Pharmaceutical Co.**, 927 F.2d 1200 (Fed. Cir. 1991).

“Conception does not occur unless one has a mental picture of the structure of the chemical, or is able to define it by its method of preparation, its physical or chemical properties, or whatever characteristics sufficiently distinguish it.”

In this priority contest, the first party to conceive was the first to reduce the invention to practice by isolating the EPO gene sequence.

7. **New England Braiding Co. v. A.W. Chesterton Co.**, 970 F.2d 878 (Fed. Cir. 1992).

Procedure - Preliminary injunction in patent infringement suit denied where patentee was unlikely to prevail in 102(f) challenge to patent validity.

Invalidity challenger likely to prove invention derivation by proof that “the named inventor acquired knowledge of invention from another or at least enough of the invention to make the claimed invention obvious to one of ordinary skill in the art.”

8. **Kimberly-Clark v. Procter & Gamble**, 973 F.2d 911 (Fed. Cir. 1992).

“Joint inventorship” under 35 U.S.C. § 116 requires some quantum of collaboration between the inventors. There can be no “joint inventors” where the inventors are completely unaware of each others work.

9. **Advanced Cardiovascular Systems. v. SciMed Life Systems**, 988 F.2d 1157 (Fed. Cir. 1993).

Laches is a basis for refusing to correct inventorship, but laches period against an unnamed inventor cannot begin while the unnamed inventor remains ignorant of his or her cause of action. The period begins only after the unnamed inventor knows or should have known of the cause of action.

A delay of more than six years after the misjoined inventor knew or should have known of a cause of action to correct inventorship produces a rebuttable presumption of laches,

10. **Beech Aircraft Corp. v. EDO Corp.**, 990 F.2d 1237 (Fed. Cir. 1993).

Patent ownership rights have nothing to do with determining inventorship.

Procedure - non joined sole inventor provoked an interference with patent filed by employee of alleged patent owner.

11. **Sewall v. Walters**, 21 F.3d 411 (Fed. Cir. 1994).

Procedure - Sole inventor filed application and provoked interference against an application naming joint inventors including the sole inventor. The Federal Circuit recognized this type of interference as an “originality” case.

Defines “conception existence” and conception completion.

Co-inventor not inventor where he made obvious contributions to the invention.

12. **Credle v. Bond**, 25 F.3d 1566 (Fed. Cir. 1994).

Joint inventorship cannot occur where the invention was reduced to practice before the misjoined inventor even conceived of the subject matter of the invention.

13. **Stark v. Advanced Magnetics, Inc.**, 29 F.3d 1570 (Fed. Cir. 1994).

A patent application must be filed in the name of the inventors. Diligence is a requirement for correcting inventorship in a pending application, but it is not a requirement for correcting the inventorship of an issued patent.

14. **Burroughs Wellcome Co. v. Barr Laboratories, Inc.**, 40 F.3d 1223 (Fed. Cir. 1994).

The test for conception is whether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention. The conception analysis necessarily turns on the inventor's ability to describe his invention with particularity. Draft patent application is sufficient evidence to corroborate invention conception.
15. **Checkpoint Systems v. U.S. Intl Trade Comm'n**, 54 F3d 756 (Fed. Cir. 1995).

Patent invalid under 35 USC § 102(g) where earlier invention by an employee invalidated a later patent issued to another employee. The Federal Circuit indicated that the patent assignee could have corrected the inventorship of the issued patent if the error arose without deceptive intent. The patent assignee never attempted to correct inventorship in this case.
16. **Slade Gordon & Co. v. Millis**, 92-1497, 39 U.S.P.Q.2D (BNA) 1939 (Fed. Cir. Aug. 9, 1995) (Unpublished).

Patent unenforceable for inequitable conduct where sole inventor misrepresented that he was the sole inventor of the patented invention.
17. **Fina Oil & Chemical Co. v. Ewen**, 123 F.3d 1466 (Fed. Cir. 1997).

“The case law thus indicates that to be a joint inventor, and individual must make a contribution to the conception of the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.”

Procedure – vacated grant of summary judgment where there were genuine disputes about whether the contributions of the claimed inventors were not insignificant in character.
18. **Hess v. Advanced Cardiovascular Sys., Inc.**, 106 F.3d 976 (Fed. Cir. 1997).

The principles the alleged co-inventor explained to the named inventors were well known and found in textbooks. “[He] did no more than a skilled salesman would do in explaining how his employer’s product could be used to meet a customer’s requirements.” The Court affirmed the district court’s finding that whatever contribution the alleged co-inventor made to the named inventors did not constitute conception, and therefore he was not a co-inventor of the patent.
19. **Stark v. Advanced Magnetics, Inc.**, 119 F.3d 1551 (Fed. Cir. 1997).

While a reading of § 256 allows for deletion of misjoined inventors whether the error occurred by deception or innocent mistake, § 256 must be read in conjunction with the rules governing inequitable conduct. The statute allows correction in nonjoinder cases where the unnamed inventor is free of deceptive intent.
20. **Hydril Co. v. Baker Hughes, Inc.**, 1997 U.S. App. LEXIS 21745 (Fed. Cir. Aug. 19, 1997) (unpublished).

The Court found a genuine issue on the questions of inventorship, and in turn ownership. The plaintiff had adequately raised the issue of inventorship where it asserted that a named inventor was not in fact an inventor, where that named inventor testified to that point in state court, and where the plaintiff stated that it sought correction of inventorship from the PTO.

21. **Ethicon, Inc. v. United States Surgical Corp.**, 135 F.3d 1456 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 278 (1998).

The contribution of one of two alternative structures corresponding to the claim's "means" limitation was sufficient to make an electronics technician who assisted the named inventor a joint inventor of that claim.

22. **Schulze v. Green**, 136 F.3d 786 (Fed. Cir. 1998).

In an interference proceeding, a patentability question (e.g. inventorship) fairly raised and capable of being fully presented must be resolved inter partes.

Procedure – Appellants initial motion to correct inventorship was facially deficient, and because Appellants failed to promptly refile their motion during the interference, the Board entered final judgment against Appellants on the ground of unpatentability under 102(f). Because Appellants were entitled to clear notice that they had to make the correction of inventorship in the interference and to a reasonable opportunity to do so before final judgment in the interference could be entered against them, the Court vacated the interference judgment and remanded the case to the Board to set a fixed period of time for Appellants to renew their motion to correct inventorship.

23. **Pannu v. Iolab Corp.**, 155 F.3d 1344 (Fed. Cir. 1998).

The issue of inventorship should go to the jury, and if the jury finds that a co-inventor was not properly named, the patent holder should be given an opportunity to correct inventorship under § 256 before finding the patent invalid under § 102(f).

24. **C.R. Bard, Inc. v. M3 Sys., Inc.**, 157 F.3d 1340 (Fed. Cir. 1998).

"An assertion of incorrect inventorship must be based on facts proved by clear and convincing, corroborated evidence." The Court reversed the jury's finding of invalidity based on incorrect inventorship where there was no clear and convincing evidence establishing the unnamed person was an inventor.

25. **University of Colorado Foundation, Inc. v. American Cyanamid Co.**, 196 F.3d. 1366 (Fed. Cir. 1999).

Actual inventors can be substitute for fraudulently-named inventors without thereby invalidating the patent.

Procedure – The University of Colorado sought to have two people substituted as the named inventors under Section 256. The district court granted summary judgment against the University, concluding that correction under Section 256 is

not applicable when the request for correction is based upon alleged fraud and deception of the named inventors. The Federal Circuit vacated and remanded.

26. **Virginia Electronic & Lighting Corp. v. National Serviced Indus., Inc.**, 2000 U.S. App. LEXIS 131 (Fed. Cir. Jan. 6, 2000).

“Only the inventor's testimony requires corroboration before it can be considered.”

The Court found sufficient independent corroboration of the alleged true inventor’s testimony to survive a motion for summary judgment.

27. **PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.**, 225 F.3d 1315 (Fed. Cir. 2000).

Affirming finding of inequitable conduct based upon intentional falsehoods, misrepresentations, and omissions to the PTO concerning the issue of inventorship.

28. **Banks v. Unisys Corp.**, 228 F.3d 1357 (Fed. Cir. 2000).

“The general rule is that an individual owns the patent rights to the subject matter of which he is an inventor, even though he conceived it or reduced it to practice in the course of his employment. There are two exceptions to this rule: first, an employer owns an employee's invention if the employee is a party to an express contract to that effect; second, where an employee is hired to invent something or solve a particular problem, the property of the invention related to this effort may belong to the employer.”

29. **Mycogen Plant Science, Inc. v. Monsanto Co.**, 243 F.3d 1316 (Fed. Cir. 2001).

“The precise language of the reduction to practice test states ‘it is well-settled that conception and reduction to practice cannot be established nunc pro tunc. There must be contemporaneous recognition and appreciation of the invention represented by the counts.’” Where there was evidence that the Monsanto scientists recognized and appreciated their prior invention, the Court upheld the jury verdict finding the patents in suit invalid under 102(g).

30. **Acromed Corp. v. Sofamor Danek Group, Inc.**, 253 F.3d 1371 (Fed. Cir. 2001).

The Court found there was no corroborating evidence that the alleged true inventor did anything more than follow the instructions of the named inventor and perform work that was nothing more than the “exercise of the normal skill expected of an ordinary machinist.”

31. **Chou v. The University of Chicago**, 254 F.3d 1347 (Fed. Cir. 2001).

“[A]n expectation of ownership of a patent is not a prerequisite for a putative inventor to possess standing to sue to correct inventorship under § 256.”

“[P]arties with an economic stake in a patent's validity may be subject to a § 256 suit.”

32. **Vikase Corp. v. American National Can Co.**, 261 F.3d 1316 (Fed. Cir. 2001).

“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.” The patents in suit were not invalid for the length of time before the PTO corrected inventorship.

33. **Windbond Electronics Corp. v. ITC**, 2001 U.S. App. LEXIS 25113 (Fed. Cir. Aug. 22, 2001).

After the inventorship of the patent at issue was properly corrected under 37 C.F.R. 1.324, challengers to the validity of the patent failed to meet their burden to show that someone other than the named inventors were true co-inventors.

34. **Sandt Tech. Ltd. v. Resco Metal and Plastics, Corp.**, 264 F.3d 1344, 1350-51 (Fed. Cir. 2001).

Documentary evidence and witness statements sufficiently corroborated the inventor’s testimony that he had invented the subject matter prior to the filing of the patent-in-suit. One of the asserted claims was therefore anticipated under § 102(g).

35. **Hoop v. Hoop**, 279 F.3d 1004 (Fed. Cir. 2002).

“One may not qualify as a joint inventor, or as here, a new inventor, by ‘merely assisting the actual inventor after conception of the claimed invention.’” In a dispute over the inventorship of a design patent, the district court made a finding that the persons claiming to be the inventors merely refined and perfected the named inventors’ concept. Therefore the Federal Circuit upheld the finding that it was likely that the named inventors would be found to be the true inventors.

36. **Kowalevich v. Nailite Int’l, Inc.**, 2002 U.S. App. LEXIS 10913 (Fed. Cir. May 21, 2002) (unpublished).

Plaintiff attempted to bring a claim under Section 256; however, he failed to demonstrate that made a significant contribution to the conception of the patented invention.

37. **Frank’s Casing Crew & Rental Tools, Inc. v. PMR Techs. Ltd.**, 292 F.3d 1363 (Fed. Cir. 2002).

Procedure – Declaratory judgment action asserting that the patents at issue are invalid, unenforceable, and not infringed.

Because the method performed by a device conceded to have been invented by the alleged inventor satisfied all the limitations of at least one patent claim, that person was an inventor and should have been named on the patent. The court upheld a finding of unenforceability due to inequitable conduct where two of the named inventors concealed the identity of that co-inventor during prosecution. “[I]f unenforceable due to inequitable conduct, a patent may not be enforced even by ‘innocent’ co-inventors.” Despite the finding of unenforceability, the Court remanded for determination of correct inventorship, should the plaintiff still wish to pursue its claim for correction of inventorship.

38. **Marketel Int’l, Inc. v. Priceline.com, Inc.**, 2002 U.S. App. LEXIS 7843 (Fed. Cir. Apr. 25, 2002) (unpublished).

Summary judgment denying the claim to correct inventorship was properly granted where there was no independent evidence corroborating the allegedly misjoined inventors' testimony.

39. **Trovan, Ltd. v. Sokymat SA**, 299 F.3d 1292, 63 USPQ2d 1865 (Fed. Cir. 2002).

The Court remanded for a determination of co-inventor status based upon corrected claim construction.

40. **Thompson v. Haynes**, 305 F.3d 1369 (Fed. Cir. 2002).

The Court affirmed the district court's finding that "neither party had presented any evidence" supporting the conclusion that the other party should be removed from the patent as a joint inventor. The burden on each party was to show facts supported by clear and convincing evidence that the other listed inventor had not contributed to the conception of the invention.

41. **Riverwood Int'l Corp. v. R.A. Jones & Co.**, 324 F.3d 1346 (Fed. Cir. 2003)

The Court remanded for a determination of whether there was a misjoinder of inventors. If one named inventor was the sole inventor of the portions of the alleged prior art patent relied upon for an obviousness argument, then the patent is not in fact prior art to the patent in suit. If the inventor is the sole inventor, then the district court should order correction under § 256.

42. **BJ Services Co. v. Halliburton Energy Services, Inc.**, 338 F.3d 1368 (Fed. Cir. 2003).

The alleged infringer argued invalidity for failure to name the proper inventor. The patent holder presented evidence that the allegedly unnamed inventor had no knowledge of the claimed subject matter.

43. **Board of Education v. American Bioscience, Inc.**, 333 F.3d 1330 (Fed. Cir. 2003).

"Invention requires conception, and 'conception does not occur unless one has a mental picture of the structure of the chemical . . . or whatever characteristics sufficiently distinguish it. It is not sufficient to define it solely by its principal biological property . . . .' ... [G]eneral knowledge regarding the anticipated biological properties of groups of complex chemical compounds is insufficient to confer inventorship status with respect to specifically claimed compounds." None of the allegedly true inventors conceived the specific compounds being claimed with all of their component substituents. "[T]eaching skills or general methods that somehow facilitate a later invention, without more, does not render one a coinventor."

The patent was not unenforceable due to inequitable conduct because there was no evidence that any material information was withheld from the PTO. Disclosing the identity of the inventors' former employers is not a requirement.

44. **University of Colorado Foundation, Inc. v. American Cyanamid Co.**, 342 F.3d 1298 (Fed. Cir. 2003).

The Court upheld the district court's finding that two unnamed inventors were the true inventors of the patent. The two unnamed inventors were found to have conceived the idea based upon testimony and corroborating documentary evidence.

45. **Eli Lilly v. Aradigm Corp.**, 376 F.3d 1352 (Fed. Cir. 2004).

There was insufficient evidence to support the jury's finding of clear and convincing evidence to demonstrate the alleged non-joined inventor collaborated with the named inventors in a manner that could render him a joint inventor.

"A long line of decisions in this court holds that a person is a joint inventor only if he contributes to the conception of the claimed invention."

46. **Linear Tech. Corp. v. Impala Linear Corp.**, 379 F.3d 1311 (Fed. Cir. 2004).

The claim of joint inventorship was not corroborated under the rule of reason analysis.

47. **Xechem Int'l, Inc. v. University of Texas M.D. Anderson Cancer Center**, 382 F.3d 1324 (Fed. Cir. 2004).

The Court upheld the dismissal based upon Eleventh Amendment grounds of Xechem's claim for correction of inventorship under Section 256.

48. **Gemstar-TV Guide Int'l, Inc. v. Int'l Trade Comm'n**, 383 F.3d 1352 (Fed. Cir. 2004).

A claimed joint inventor failed to present facts supported by clear and convincing evidence of his co-inventorship; therefore the patent at issue was not unenforceable for failure to name a co-inventor. "[M]ore than just the alleged co-inventor's testimony is required to establish co-inventorship," and merely finding the alleged inventor's testimony to be more credible than the named inventor's testimony "does not itself rise to the level of clear and convincing evidence." The technical education and experience of the disputed inventors is only weak circumstantial evidence. Furthermore, corroborating documents should explicitly identify the alleged co-inventor's contributions.

49. **Caterpillar, Inc. v. Sturman Indus.**, 387 F.3d 1358 (Fed. Cir. 2005).

There was no mistake in the inventorship of two patents where the alleged non-joined inventors only made an insignificant contribution to the conception of the invention. There was also no inventorship mistake in the third patent since there was insufficient corroborating evidence to prove that one of the joint inventors was in fact the sole inventor.

50. **Checkpoint Sys., Inc. v. All-Tag Security S.A.**, 412 F.3d 1331 (Fed. Cir. 2005).

The Court reversed a grant of summary judgment of invalidity under 102(f) and remanded for a determination of inventorship where declarations during the prosecution of the patents asserting that the named inventor was in fact the sole inventor created an issue of fact. If the district court finds there is an error in inventorship then the court may allow for correction under Section 256.

51. **Ultra Precision Mfg. Ltd. v. Ford Motor Co.**, 411 F.3d 1369 (Fed. Cir. 2005).

The Court affirmed denial of joint inventorship where there was no evidence that the alleged joint inventors assisted in conception and they in fact admitted that they did not conceive elements of the invention.

52. **Sunbeam Prods., Inc. v. Wing Shing Prods.**, 04-1526, 153 Fed. Appx. 703 (Fed. Cir. Aug. 2005).

The pretrial order constructively amended the complaint to add a claim for joint inventorship. The Court held there was no joint inventorship because the employees' modification did not contain any inventive concept that was absent from the original invention.

53. **Stern v. Trustees of Columbia University**, 05-1291, 2006 U.S. App. LEXIS 1015 (Fed. Cir. Jan. 17, 2006).

The Court affirmed a grant of summary judgment that plaintiff failed to present sufficient evidence to be added as a co-inventor. The alleged co-inventor did not have an understanding of the claimed invention and did not conceive of any part of the invention, but merely carried out an experiment previously performed by the named inventor.