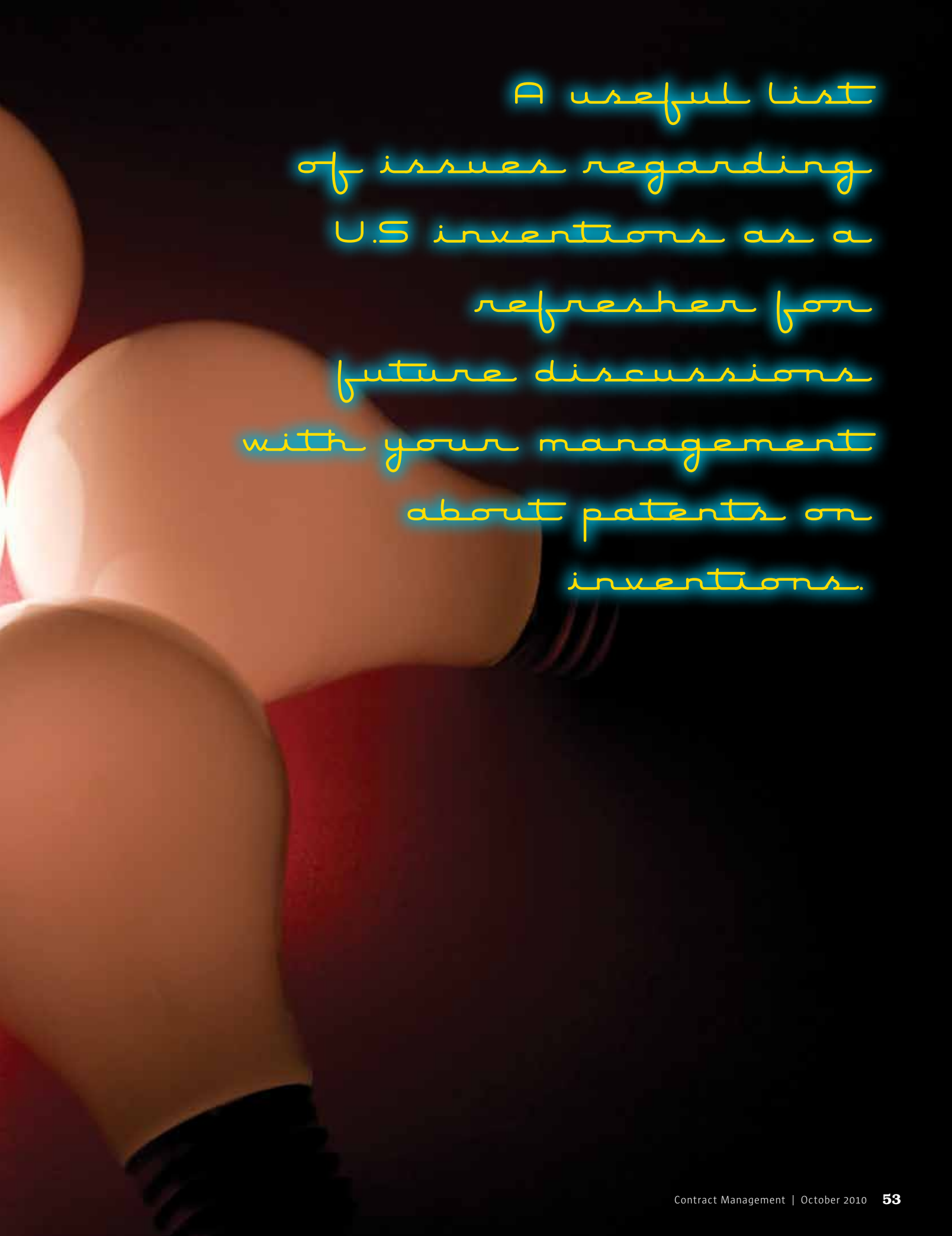




14

Important,  
Practical,  
and Useful  
Inventorship  
Issues

BY JOHN "JOHNNY" E. MILLER

A hand is shown holding a glowing lightbulb, which is the central focus of the image. The background is dark, with several other lightbulbs visible, some of which are also glowing. The overall scene suggests an idea or a point of discussion.

A useful list  
of issues regarding  
U.S. inventions as a  
refresher for  
future discussions  
with your management  
about patents on  
inventions.

*For those involved in contracts management, it is important to understand the implications of inventorship.*



The contracts that we draft, negotiate, and administer cover numerous invention and patent issues, but we tend to skip over the vital topic of determining the correct inventorship.

Inventorship legal disputes are currently driving the rapid growth of intellectual property lawsuits. An entity's risk management program and its best practices procedures should require that inventorship be properly addressed.

A U.S. patent can only be issued in the name of the person who meets or people who meet the applicable inventorship criteria. In-

correctly stating inventorship on the patent application and the resulting patent (if any) can be the basis for invalidating a patent application and the resulting patent (if any). Also, the willful failure to properly identify all the applicable co-inventors in the patent application and resulting patent (if any) could be regarded, in some circumstances, as fraud against the U.S. Patent and Trademark Office (USPTO). It is therefore very important to be correct when determining inventorship and getting inventorship right.

The idea of federally granted patents in the United States is derived from the Constitution. As Article 1, Section 8, Clause 8 states, "The Congress shall have power...to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries...." The U.S. Patent Law (Title 35, Section 101) states, "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of any matter, or any new and useful improvements thereof, may obtain a patent...."

The courts over the years have further interpreted and defined U.S. patent law. Because the government desires to promote progress by disseminating new ideas, patent protection is given only in exchange for a full written disclosure of the invention. A patent is effective only in the territory under the jurisdiction of the country granting it and for the limited term specified by that country's laws.

An inventor is a person who alone, or jointly with other people, first invents a new (novel), non-obvious, and useful process, machine, composition of matter, manufac-

ture, or new use resulting in a utility, non-functional design, or plant patent.

A patent application consists of a specification (a narrative description of the invention including any applicable prior art preceding it) including one or more claims, a drawing, and a statutory legal oath. A "claim" is very important since it states one or more elements making up the invention. Together, the claims define the total scope of the invention and distinguish that invention from the applicable prior art. Any other party practicing one or more claims of a resulting patent without the authorization of the patent owner may be charged by the patent owner with patent infringement.

A patent gives its holder the right to exclude others from making, using, or selling the invention "claimed" in the patent deed for 20 years from the date of filing a successful patent application, provided certain fees are paid. (The term of a patent that is in force on or that results from an application filed before June 8, 1995, shall be the greater of the 20-year term or 17 years from the actual patent grant.)

The patent does not give its owner the right to make the patented item, but only to exclude others from making the patented item. Thus, a patent is a "negative grant" to exclude others from making the patented item.

A patent is in the nature of a contract—one between the government and the inventor or the inventor's assignee. In return for the patent, the inventor discloses the invention, in the patent, in such full and complete detail as to enable others in the field to make

and use the patented item. In return for this full disclosure (or teaching), the government grants the inventor a patent, i.e., the right to prevent others from making, using, and selling the patented invention.

The purpose of this article is to help illuminate the importance of inventorship. Through the course of my contracts career, I have compiled an important, practical, and useful list of 14 inventorship issues regarding U.S. inventions and patents. Before discussing with an entity's management the possibility of potentially obtaining a U.S. patent on an invention by one of the entity's employees, review this list of inventorship issues first as a refresher in preparation for discussions with management.

## 14 INVENTORSHIP ISSUES

1. Unless a person makes an original contribution to the "conception" of the invention, such person is not a legal inventor. *Conception*, the first requirement to invention creation, is the formation

in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it thereafter is to be applied in practice.<sup>1</sup> Conception is complete when the patent application discloses the invention in such a way that it enables a person of ordinary skill in the invention's art to construct or use the invention without extensive research or experimentation.<sup>2</sup>

2. Actual or constructive "reduction to practice," the second requirement to invention creation, is: 1) the physical making of the invention and showing that it works for its intended purpose; or 2) in the absence of actual reduction to practice, constructively reducing the invention to practice, pursuant to statute, when the patent application is filed with the USPTO.<sup>3</sup> Merely reducing an invention to practice (without the conception requirement) is not enough to create an inventor or co-inventor of the invention. For example, the hard work and long hours of an inventor's assistant merely becomes the inventor's "pair of hands" when reducing an invention to prac-

tice and the assistant (who is not involved in conception) does not become a co-inventor. Reduction to practice does not result in inventorship.

3. Inventorship is made specifically in regard to the patent's claims. An inventor and/or co-inventor must make an original conceptual contribution to one or more features of one or more of the invention's claims.<sup>4</sup>

4. For a sole inventor, inventorship is simple. A sole inventor must be responsible for the complete original conception contribution for all the claims of the entire invention.<sup>5</sup>

5. A co-inventor of the invention must be responsible for an original conception contribution of at least one claimed feature of one of the claims.<sup>6</sup> However, if that claimed feature is ever later cancelled from the application's claims, that co-inventor loses inventorship and eventual patent ownership. Joint



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ownership must be proved by clear and convincing evidence.<sup>7</sup>

**6.** Although co-inventors must communicate with each other as a collaboration of inventive endeavors to produce an invention by aggregate efforts, they do not have to physically work together, at the same time, on the same part of the invention, or make the same type of contribution.<sup>8</sup>

**7.** The original conception contribution to a claimed feature of a claim by a co-inventor does not have to be of equivalent importance with other co-inventors.<sup>9</sup>

**8.** Co-inventors (unless altered by a written agreement between the parties) have equal legal ownership rights to the resulting patent. Without the consent of the other co-inventors, any joint owner of a patent may make, use, offer for sale, and sell the invention or grant licenses to the invention without regard to the other co-inventor/co-owners (unless altered by written agreement) and without the sharing

of any resulting income with any of the other co-inventors/co-owners.<sup>10</sup> Anyone who properly and originally contributes (big or small) to any aspect on the conception of the invention may be a joint inventor. Patent owners can change via assignments; however, authentic inventors cannot change.

**9.** In the resulting patent the USPTO does not rank or evaluate the relative original conceptual contributions of co-inventors.

**10.** Inventorship of inventions resulting in patents is determined by original conceptual contribution to one or more features of one or more claims; however, authorship of publications and resulting copyrights may, in some cases, be determined by politics, professional courtesy, hard work, team work, or outstanding science. Incorrectly naming inventors on a patent application can have devastating results.

**11.** Inventors are required to provide correct inventorship information to the USPTO when submitting a

patent application. Failure, either knowingly or unknowingly, to do this is “inequitable conduct.” One type of inequitable conduct is the incorrect listing of inventors in the patent application and issued patent. That incorrect listing can be due to omission of a co-inventor or inclusion of individuals who are not inventors as determined by the USPTO. The issue of inequitable conduct often arises when an entity defends itself against a charge of patent infringement by claiming inequitable conduct on the part of the patent holder. This can result in a court declaring an issued patent unenforceable.<sup>11</sup>

**12.** Due to the numerous complexities involved, inventorship should be determined by a competent patent attorney prior to filing a patent application with the USPTO.

**13.** Keeping a proper lab/engineering notebook and using a proper invention disclosure form documenting, on a real-time basis, the people truly involved in the conception of the invention is highly important.

14. At the time a patent application is filed with the USPTO, the actual inventor or co-inventors may be required by their employer to assign their interests in such inventions to their employer or perhaps to their employer's applicable government or commercial customer, pursuant to any applicable contract.

### THREE EXAMPLES OF INVENTORSHIP PROBLEMS IN CONTRACTS MANAGEMENT SCENARIOS

1. Company A decides to commercialize (by sale or license) one of its U.S. inventions that later became a Company A patent. However, Company A later discovers that it cannot do so because one of its Company B service providers is an inadvertent co-inventor of the invention (related to the work) that resulted from Company A's underlying contract with the service provider. The Company B service provider employee who was a co-inventor

was not stated in the Company A patent application and the patent is not valid due to incomplete inventorship disclosure in the patent application. The underlining contract did not properly allocate to Company A the ownership of patents conceived by Company B while doing the service work for Company A.

2. Entity C, via its contract with its Entity D government or commercial customer, was required to by the contract to notify the Entity D customer in the event Entity C conceived an invention (related to the work) while working on the contract for Entity D. The contract also states that the Entity D customer would own such an invention and its resulting patent. Entity C notified Entity D of the conception of the invention but overlooked the conception inventorship contribution of its subcontractor, Entity E. A patent application was prepared, without including Entity E as a co-inventor. Entity C assigned its ownership rights to the Entity D customer

and a patent was eventually issued to Entity D. The Entity D patent was later invalidated due to the failure to list the Entity E subcontractor as a co-inventor in the patent application.

3. Company F sues Company G for patent infringement. Company G successfully defeats the Company F claim because Company G is able to show that the Company F patent is invalid due to incomplete inventorship disclosure in the underlying patent application. Company G overlooked one of the co-inventors.

The next time you are asked by your entity's management to consider the merits of pursuing a potential U.S. patent on an invention, review this list of 14 issues and 3 examples first to ensure that you have considered all of the key inventorship issues. You will be surprised how many important issues this list will generate for consideration. **CM**

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**ABOUT THE AUTHOR**

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**ENDNOTES**

1. See Research Foundation—K-State Community, "Inventorship Guidelines," *Overview of the Technology Transfer Process* (undated), available at [www.k-state.edu/tech.transfer/inventors/inventor.htm#overview](http://www.k-state.edu/tech.transfer/inventors/inventor.htm#overview).
2. *Ibid.*
3. See Brown University, "Getting Inventorship Right: Why The Big Deal?" *Licensing Your Inventions* (undated), available at <http://research.brown.edu/pdf/Inventorship.pdf>.
4. See Cambia, "I Am An Author On the Paper... Why Am I Not An Inventor?" *Patent Lens* (undated), available at [www.bios.net/daisy/patentlens/g4/tutorials/205.html](http://www.bios.net/daisy/patentlens/g4/tutorials/205.html).
5. *Hybritech Inc. v Monoclonal Antibodies, Inc.*, 802 F.2d 1367 (Fed. Cir. 1986).
6. See "Inventorship Guidelines," at note 1.
7. See Astrid R. Spain, "Proof of Joint Inventorship Must Be Clear and Convincing," *IP Frontline—Intellectual Property Law* (February 14, 2005), available at [www.ipfrontline.com/depts/article.asp?id=2109&deptid=4](http://www.ipfrontline.com/depts/article.asp?id=2109&deptid=4).
8. Pursuant to 35 U.S.C. Section 116.
9. See "Inventorship Guidelines," at note 1.
10. Pursuant to 35 U.S.C. Section 262.
11. See John K. Borchardt, "Navigating the Patent Inventorship Issues," *Lab Manager Magazine* (June 11, 2009), available at [www.labmanager.com/articles.asp?ID=281](http://www.labmanager.com/articles.asp?ID=281).