Patent Inventorship: Best Practices for Determination and Correction

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Inventorship and Ownership: Best Practices

Lauren L. Stevens, Ph.D.
March 7, 2013
In the Beginning...

- Inventorship rooted in the concept that a person has a natural, exclusive right to his or her inventive ideas; no one can compel disclosure of those ideas
  - Robinson, *Treatise on the Law of Patents* (1890), vol. 1 at 37-38

- To encourage disclosure of inventions and thus promote human progress, the U.S. Constitution authorizes the U.S. Congress to pass laws that preserve an inventor’s exclusive right to his or her discovery
  - U.S. Const., Art. I, § 8
Supreme Court on Inventorship

- A person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius, and not of another’s.
  - *Pitts v. Hall*, 2 Blatch. 229, 231 (1851)
The conception of the invention consists in the complete performance of the mental part of the inventive act. All that remains to be accomplished in order to perfect the act or instrument belongs to the department of construction, not invention. It is, therefore, 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 that constitutes an available conception within the meaning of the patent law.
Who is an Inventor?

“The threshold question in determining inventorship is who conceived the invention.”


“Formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention.”

What is Conception?

- Conception is the mental part of the inventive activity
- Conception must be complete
  - Recognize the ultimate result desired and develop the means to accomplish it
  - Communicate a sufficiently completed thought that one of skill in the art can make the invention
- Only inventors conceive, others can reduce to practice
“Conception is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.”

– Sewall v. Walters, 21 F.3d 411, 415 (Fed. Cir. 1994)
Requirements Of Conception

- Belief is key—there is no requirement for a “reasonable expectation” that invention will work
  - *Burroughs Welcome Co. v. Barr Labs.*, 40 F.3rd 1223, 32 USPQ2d 1915 (Fed. Cir. 1994)

- Not complete if subsequent experimental failures reveal uncertainty that undermines the “definite and permanent” requirement
  - *Id.*

- But there is “no significance” to the fact that some [compounds] were “inoperative” [in a screen]
Conception Should Be Corroborated

- Evidence showing that the inventor disclosed to others a completed thought is useful for proving inventorship

- Define and document the invention, making sure it is properly recorded, dated, and witnessed by someone (other than a co-inventor) who understands the invention
Sufficient Proof


- Levin asserted that he was an omitted co-inventor
- To show co-inventorship, Levin submitted a declaration stating that he gave one of the named inventors the idea during a telephone call
- As corroboration, Levin submitted named inventor's day planner, which reflected notes confirming that the disputed call took place
- Levin also pointed to lack of evidence showing named inventor's conception as corroboration
Symantec (con’t)

DC: Rejected assertion of co-inventorship
- Day planner entry was insufficient corroborating evidence.
  - “at most shows only that [Levin and Gray] discussed the then-current state of the art”; it “fail[ed] to explicitly identify [Levin’s] contribution”
  - Calling into question named inventor’s contribution irrelevant to whether Levin made contribution
    - Different from facts in Ethicon, where we held that a sole inventor's lack of technical expertise corroborated another’s claim of coinventorship

FC: Affirmed

- Day planner entry only establishes that Gray and Levin spoke about the then-current state of anti-virus programs; it does not establish that Levin contributed to the idea

- Corroboration of conception lower standard than corroboration of reduction to practice
- Unwitnessed notebook page may show conception, even if it does not show that the experiment was actually performed
- FC: District court erred in rejecting corroborative value of 2 pieces of documentary evidence of conception
- Award of priority to Brake vacated
To Determine Inventorship, Focus On *Claims*

- Evaluate inventorship claim-by-claim
- Claims construed first:
  - “... inventorship analysis, like an infringement or invalidity analysis, first requires the construction of each disputed claim to determine the subject matter encompassed thereby. The second step is a comparison of the alleged contributions of each asserted co-inventor with the subject matter of the correctly construed claim to determine whether the correct inventors were named.”
Correct Inventorship Turned On
Claim Construction

- *Univ. of Pittsburgh v. Hedrick, 573 F.3d 1290 (Fed. Cir. 2009)*
  
  - Representative claim 1: An isolated *adipose-derived* stem cell that can differentiate into two or more of the group consisting of a bone cell, a cartilage cell, a nerve cell, or a muscle cell.
  
  - Named inventors on Pittsburgh patent:
    - Katz, Llull, Futrell, Hedrick, Benhaim, Lorenz, and Zhu
  
  - Pittsburgh filed action seeking removal of named “independent researchers” Futrell, Hedrick, Benhaim, Lorenz, and Zhu ("IR’s")
IR’s argued that “adipose-derived” should be limited to a “species of stem cell distinct from the mesenchymal stem cell that is obtainable from bone marrow tissue”
   - This construction would mean that the independent researchers’ work proved that the inventive stem cells were in fact distinct from the prior art mesenchymal stem cells

University researchers Katz and Llull argued for a plain meaning: cells “derived from fat tissue”

DC: Agreed with plain meaning
   - Katz and Llull “conceived the claimed invention as construed prior to Hedrick’s arrival at Pittsburgh,” request for removal granted

FC: Affirmed
§1.45 - If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application

- Look at specification not just claims

Neither the rules nor the MPEP require correction of inventorship of a provisional application unless the correction is needed to establish an overlap of inventorship

What About Joint Inventors?

- Pre-1984
  - Joint inventors had to jointly conceive and contribute to the entire invention
  - Joint inventorship: “one of the muddiest concepts in the muddy metaphysics of patent law”
    - *Mueller Brass* (1972)
What About Joint Inventors?

- 1984 Amendment to 35 USC § 116
  - The 1984 amendment “recognizes the realities of modern team research”
  - Inventors may apply for a patent jointly even though
    - They did not physically work together or at the same time;
    - Each did not make the same type or amount of contribution; or
    - Each did not contribute to the subject matter of every claim.
Pre-AIA: Collaboration Required

- Joint inventorship requires some sort of collaboration, even if the inventors are not working together
  - Working under common direction
  - Building on another’s work
  - Joint inventors must at least be aware of each other
Kimberly-Clark v. P&G (Fed. Cir. 1992)

- K-C inventor conceived of improvement to disposable diaper in 1982; patent issued November 1987
- P&G employee, Lawson, conceived similar invention 1985; patent issued September 1987
- Lawson unaware that other P&G employees made invention as early as 1979
- Other P&G employees unaware of Lawson’s work
- P&G moved to correct Lawson patent to add other P&G employees as inventors and gain earlier date of invention
- FC: for joint inventorship under § 116, there must be some element of joint behavior. Individuals cannot be joint inventors if they are completely ignorant of what each other has done
Pre-AIA: Some Quantum of Collaboration


- Nu-Kote’s argument: "it is absurd to believe that it took sixteen people to invent a simple plastic container of ink."

- “Although the inventors were incapable of recalling each individual's specific contribution, they all generally recalled collaborating together in a series of meetings to produce the patented invention”

- Held: sufficient to satisfy standard for joint inventorship
Pre-AIA: Contribute To At Least One Claim


- Surgical device with electronic sensor
- Doctor named on patent asked for help of electronics technician
- Technician added to patent based on contribution to one limitation of claims 33 and 47
- Accused infringer obtained license to patent from the technician

- **Holding:**
  - Technician was a joint inventor
**Ethicon (cont’d)**

Why did court add inventor?

- Doctor’s lack of expertise in electronics
- Technician was skilled in electronics
- Technician’s sketches of embodiment found in discovery and deemed reliable
- Sketches are similar to figures in the patent
- Sophistication of the sketches
- Named inventor’s documents had altered dates, thus unreliable
- Business relationship between doctor and technician
Pre-AIA: NOT Merely Using the Services of Others


- Drs. Simpson and Robert were working on a balloon angioplasty catheter
- Hess suggested material and seal for balloon
- Doctors used recommended material and filed the patent application
- Holding: Hess’s contribution were insufficient to make him co-inventor

  - “An inventor may use the services, ideas and aid of others in the process of perfecting the invention without losing the right to a patent.”
  - Mr. Hess 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.”
**Standard Reiterated**

- *Nartron Corp. v. Schukra U.S.A. Inc.*, 558 F.3d 1352 (Fed. Cir. 2009)
  - DC: SJ of noninfringement because alleged co-inventor was necessary joint plaintiff.
  - FC: Reversed.

  - Feature asserted as proof of joint inventorship was one part of one claim, but feature was “insignificant” and already in the prior art
  - “a dependent claim adding one claim limitation to a parent claim is still a claim to the invention of the parent claim … not a claim to the added feature alone”
  - Analogous to facts in *Hess v. Advanced Cardiovascular Systems Inc.*, where person who did “nothing more than explain[ ] to the inventors what the then state of the art was and supply[ ] a product to them for use in their invention.”
  - “a person who merely suggests that something be accomplished is not a joint inventor”
Inventorship Under the AIA

- 35 U.S.C. 115(a) was not amended
  - An application for patent that is filed under [35 U.S.C.] 111(a) or commences the national stage under [35 U.S.C.] 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application.
Inventorship Under the AIA

- AIA did not amend 35 USC § 116:
  - 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.
Inventorship Under the AIA

- AIA adds new definitions to 35 USC § 100, which take effect March 16, 2013:
  - (f) The term ‘inventor’ means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.
  - (g) The terms ‘joint inventor’ and ‘coinventor’ mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.
Joint Inventorship Under the AIA

- *Nothing* in the statutory wording that in any way suggests or implies even *some quantum* of collaboration
  - However, 35 USC § 116 was not amended....

- AIA provides certain advantages to joint inventors
AIA: “Joint Inventor” Status to Avoid Prior Art

- The statute permits avoidance of prior art under 35 USC § 102(a)(1) if the inventor of related subject matter is named as a “joint inventor”

- Possible strategy:
  - After initial filing without “joint inventor” continuation-in-part can be filed to combine full disclosures of both applications and claims of both applications and with inventor nomination of both
  - Independent of ownership
AIA: “Common Ownership” Status to Avoid Prior Art

§ 102(b)(2)(C) Exception

- Eliminates patents and applications as prior art, for purposes of novelty and obviousness, where the disclosed subject matter and claimed inventions were commonly owned or subjected to common assignment by the time of the effective filing date.
AIA: “Collaborative” Status to Avoid Prior Art

§ 102(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—

- Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

  1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

  2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

  3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.
Sec. 3(n)(2)

The provisions of sections 102(g), 135, and 291 of title 35, United States Code, as in effect on [March 15, 2013], shall apply to each claim of an application for patent, and any patent issued thereon, for which the amendments made by this section also apply, if such application or patent contains or contained at any time—

(A) a claim to an invention having an effective filing date as defined in section 100(i) of title 35, United States Code, that occurs before [March 16, 2013]; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.
Patent Ownership

35 U.S.C. § 262

- In the absence of any agreement to the contrary, . . . each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, . . . without the consent of and without accounting to the other owners.
Ownership

35 U.S.C. § 261:

- Subject to the provisions of this title, patents shall have the attributes of personal property.
- Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.
What is an Assignment?

- Assignment means a transfer by a party of all of its right, title and interest in a patent, patent application, registered mark or a mark for which an application to register has been filed
  - Most commonly from inventor to employer
    - Inventor presumed to be owner unless assignment.
    - Without assignment employer may not have rights in application, patent, or invention
Preparing Assignments

- Must be in writing
  - Satisfies statute of frauds and 35 U.S.C. § 261
  - Oral assignments are enforceable against the assignor
    - If A orally assigns application to B, B has all the rights of ownership as against A (but no one else) as he would have if the assignment was written
Preparing Assignments

- Identify patent or patent application
- Identify Assignors
- Identify Assignee
- Contain language evidencing an unambiguous intention to transfer all rights in the application or patent
  - Or intention to transfer all rights “to the invention”
    - In case application does not issue, assignee still has rights to the invention
      - Can seek foreign rights, trade secret protection
Preparing Assignments

- Be in the English language
  - The Office will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation.
Implications of Assignments

- Record promptly
  - “An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months of its date or prior to the date of such subsequent purchase or mortgage.”
  - 35 U.S.C. § 261
Agreement to Assign

- Entire right to patent rights may be transferred by means other than written assignment
  - Must have provision presently transferring title and all rights to such future inventions
    - “agrees to and does hereby grant and assign” all rights in future inventions falling within the scope of the employment agreement.
      - What falls within the scope of employment?
      - Depends on state law
“Assignment” by Operation of Law

- Ownership of patent rights may pass by operation of law
  - Does not have to be in writing to effect transfer of rights
  - Probate
    - Will may serve as “writing”
  - Intestate: depends on the jurisdiction
Implied Assignment

- Employee who was “hired to invent”
- Implied assignment - employee occupies special position of trust within company

Factors:
- Inventor assigned previous patents to employer
- Company custom or policy for similarly situated employees to assign patents to company
- Employee policy handbook may refer to ownership of patents
“Shop Right”

- Implied assignment not found and inventor utilized employer’s resources to develop invention
- A non-exclusive, royalty-free right granted in equity to employer to practice invention
- Employer may not sell or transfer its shop right
- Title and all other patent rights remain with inventor even though employer has shop right
Ownership (cont’d)

- If no assignment and no shop right, then inventor(s) own patent outright
Stanford v. Roche

Facts:

- 1988: Dr. Holodniy joins Stanford lab and signs patent agreement in which he “agrees to assign” patent rights
- 1989: Dr. Holodniy signs Cetus Visitor Confidentiality Agreement that “hereby assigns” patents developed as consequence of visit
- 1991: Stanford researchers invent diagnostic use of PCR assay
- 1991: Roche acquires Cetus PCR assets
- 1992: Stanford applies for patent on diagnostic use of PCR assay
- 1995: Dr. Holodniy executes assignment to Stanford
- 2000: Stanford offers Roche exclusive license, but none executed
- 2005: Stanford files claim against Roche for patent infringement

- District Court upholds Stanford’s ownership of patents,
- Federal Circuit reverses
- Supreme Court affirms
Stanford v. Roche (cont’d)

- Dr. Holodniy’s agreements:
    - “agree to assign” rights to future inventions
  - 1989: Visitor Confidentiality Agreement with Cetus
    - “do hereby assign” inventions devised “as a consequence of” work at Cetus
  - 1995: executes assignment to Stanford
“Agree to assign” is not immediate transfer of expectant interests, so Stanford only received equitable rights against Dr. Holodniy

“Do hereby assign” effects a present assignment, so Cetus *immediately* gained equitable title to Dr. Holodniy’s inventions as soon as made

At latest, once patent application filed, legal title vests based on “hereby assigns”

Therefore, Cetus’s equitable title converted to legal title upon 1992 parent application

Dr. Holodniy had nothing to assign in 1995
GOOD LUCK!

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FILING DATE OF APPLICATION

CONTROLS

• AIA changes mean that the filing date of the application will determine which rules apply.

• OLD RULES: Application filing date before September 16, 2012

• NEW RULES: Application filing date on or after September 16, 2012
II. Applicant for Patent, and Information Concerning Real Party In Interest
New Rules Under AIA

• For applications filed on or after September 16, 2012, WHO can be an applicant has changed
OLD

§118. Filing by other than inventor.

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

NEW

§118. Filing by other than inventor.

A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.

Still need to name inventor and provide § 115 inventor documentation (oath & decln).

Non-Inventor Applicants

• AIA allows for three types of non-inventor applicants:
  
  (1) assignee
  
  (2) the party to which the inventor(s) has an obligation to assign
  
  (3) a party that shows a sufficient proprietary interest
Non-Inventor Applicants

• Must be represented by a registered practitioner
• Can only be designated through proper use of an Application Data Sheet (ADS).

• Is the assignee always the applicant? No, the assignee can choose not to be the applicant.
• So for some cases, the applicant will be the inventor or all of the joint inventors. (37 CFR 1.42)
• The applicant can also include, at least in part, a legal representative of the inventor if the inventor is deceased or under legal incapacity. (37 CFR 1.43)
If ADS Names the “Applicant”

• Then Applicant must perfect rights to act before payment of issue fee
  – Assignee must provide “documentary evidence”
  – Record the assignment
The “Applicant” (cont’d)

• If application is being prosecuted by “Applicant,” then Applicant should execute the power of attorney
• No requirement to satisfy § 3.71 or § 3.73 for Applicant who is initially named in ADS
• PTO will accept the signature of a practitioner of record on a §3.73(c) statement on behalf of the assignee without requiring further evidence of the practitioner’s authority to act on behalf of the assignee
Proposed Rules: Disclosure of Ownership and Real Party in Interest
Proposed Rules: Disclosure of Ownership and Real Party in Interest

• The PTO is considering collecting patent ownership information (including the real party in interest (“RPI”)) during patent prosecution and post-issuance and making such information publically available.
Proposed Rules: Disclosure of Ownership and Real Party in Interest

The USPTO is proposing collecting this information:
– upon filing of an application,
– prior to publication,
– prior to issuance, and
– at the time of each maintenance fee payment.

To apply to applications filed on or after March 16, 2013.
Proposed Rules: Disclosure of Ownership and Real Party in Interest

• The PTO is considering promulgating regulations to require **recordation and disclosure of patent ownership information** (including the real party in interest (“RPI”)) during patent prosecution and post-issuance. Fed. Reg. V. 77, No. 227 (11/26/12).

• Roundtable on RPI information held on January 11, 2013.

Proposed Rules: Disclosure of Ownership and Real Party in Interest

– The USPTO is proposing alternative definitions of RPI that would need to be disclosed

→ one “broad” and one “limited” definition

• **Broad**: RPI = entities having the legal right to enforce the patent, *i.e.*, those parties that would be necessary and sufficient to bring a legal infringement action.

• **Limited**: the legal title holder(s) and “ultimate parent entity(ies)” of the patent application or issued patent.

III. Correcting Inventorship
CORRECTING INVENTORSHIP IN AN APPLICATION HAVING A FILING DATE BEFORE SEPTEMBER 16, 2012
Incorrect Inventorship

All persons who conceived of claimed subject matter **must** be named as inventors.

If inventorship incorrect, the patent is **invalid** unless inventorship is remedied.

**Good news:** inventorship can be corrected.

**Bad news:** omitted inventor needed to fulfill duty of disclosure and best mode requirements, opponents might try to prove deceptive intent, and/or opponents might try to find the omitted inventor and obtain a license from her or him.
METHODS OF CORRECTING INVENTORSHIP

- APPLICATIONS -

• **Applications**: 35 U.S.C. § 116/ 37 C.F.R. § 1.48

• Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, 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. **35 U.S.C. § 116**

→ lack of deceptive intent required in both nonjoinder and misjoinder cases
Correcting Pending Application

• Petition and fee under 37 C.F.R. § 1.48
• Statements from each person to be added or deleted:
  – Declaration of no deceptive intent, and
  – Statement of facts explaining the cause of the error
    • must petition or re-file the application if this cannot be obtained
• New Oath or Declaration
• Written consent from assignee
Correcting Pending Nonprovisional Application

1.48(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;
(2) 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;
(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
(4) The processing fee set forth in § 1.17(i); and
(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).
1.48(b) Nonprovisional application—fewer inventors due to amendment or cancellation of claims. If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor’s invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in § 1.17(i).
1.48(c) Nonprovisional application—*inventors added for claims to previously unclaimed subject matter.* If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application.

Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).
Correcting Pending Nonprovisional Application

1.48(f)

(1) Nonprovisional application—filing executed oath/declaration corrects inventorship. If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) and (f) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 naming an inventive entity different from the inventive entity set forth in the international stage.
1.48(d) Provisional application—adding omitted inventors. If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the omitted inventor or inventors, the provisional application may be amended to add the name or names of the omitted inventor or inventors. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and

(2) The processing fee set forth in § 1.17(q).
1.48(e) Provisional application—deleting the name or names of the inventor or inventors. If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;

(3) The processing fee set forth in § 1.17(q); and

(4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).
Correcting Pending Provisional Application

1.48 (f)

(2) Provisional application filing cover sheet corrects inventorship. If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under § 1.51(c)(1), the later submission of a cover sheet under § 1.51(c)(1) during the pendency of the application will act to correct the earlier identification of inventorship.
Minor Inventorship Changes/Corrections in Pending Applications

In applications filed before September 16, 2016, minor inventorship corrections/changes, e.g., a correction in the spelling of an inventor’s name, if made before payment of issue fee, require:

- Submission of a **petition under 37 CFR 1.182**
- a **fee**, and
- a **statement** signed by the inventor setting forth both names **and** the procedure whereby the change of name was effected, or a copy of the court order.

Applicants are also **strongly encouraged to submit an application data sheet (37 CFR 1.76)** showing the new name.
METHODS OF CORRECTING INVENTORSHIP
- PATENTS -


  Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issued a certificate correcting such error. 35 U.S.C. 256

→ Allows correction when inventor is misnamed in error and when an inventor is mistakenly left out if the unnamed inventor is free of deceptive intent

See, e.g., Stark v. Advanced Magnetics, Inc., 199 F.3d 1551 (Fed. Cir. 1997)
Correcting Issued Patent

• May use **Certificate of Correction (COC)** or **Reissue**

• **Use COC if:**
  • **All** involved parties agree to the change,
  • **Only** correcting inventorship, and
  • Can obtain a **declaration** of no deceptive intent from inventor(s) to be added

  – Requires petition, **statements** and **fee** – see **37 C.F.R. 1.324**
    • Written consent from **all parties and assignees** (stricter than correcting applications under 35 USC 116)
Correcting Issued Patent

• Use reissue to correct patent inventorship if:

  – provisions of 35 USC 256 and 37 CFR 1.324 do not apply

⇒ Failure to name correct inventive entity is an error correctable by reissue under 35 USC 251
Correcting Issued Patent


(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is 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 [including inventor(s) to be deleted] named inventors who have not submitted a statement under paragraph (b)(1) of this section 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 paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter;
Potential Effects of Correcting Inventorship
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.

Thus, 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.
**RISK OF NAMING WRONG INVENTORS**

- **Intentional failure** to name collaborating joint inventors may result in a finding of **unenforceability due to inequitable conduct** against the named inventors


Inventorship and Inequitable Conduct

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

- Failure to name individuals from collaborating company
- Failure to name lab technician who participated in experiments

Chromatography beads supplied by company collaborating with named inventors
**PerSeptive** (cont’d)

- **5 Factors listed by the Court:**
  - Statement that named inventors “directed” or “initiated” the work
  - Statement that named inventors “alone” discovered unique properties of materials used in method
  - Collaboration with other company not disclosed to PTO
  - Exchange of data with collaborating company – individuals in collaborating company discussed with named inventors whether they should file patents together
  - Suggestion to PTO that collaborating company was merely a source of raw material
Another Example

  - Relationship between named inventors and un-named collaborator Weiner disintegrates
  - Weiner asks for money and stock owed to him by the company
  - Patent filed without naming Weiner
  - Patent attorneys not told about Weiner
  - Patent also names inventor Shaunfield, but Shaunfield had no knowledge of patent filing and never signed an oath or declaration of inventorship
Frank’s Casing Crew (cont’d)

One bad apple spoils the bunch!

If inequitable conduct renders patent unenforceable, innocent co-inventors also lose rights.
Additional Potential Effects of Correcting Inventorship

Adding an inventor could:

1. Complicate patent ownership
2. Impact the duty of disclosure to the PTO
3. Require adding information to the U.S. application to comply with the best mode requirement of § 112
Patent Ownership

- Inventorship determines ownership
  - Each inventor enjoys presumption of ownership in entire patent.
  - In the absence of an agreement to the contrary, each co-owner of a United States patent is free to make, use, offer to sell, and sell the patented invention without regard to the wishes of any other co-owner. ... Each co-owner's ownership rights carry with them the right to license others, a right that also does not require the consent of any other co-owner 35 U.S.C. §262
Duty of Disclosure

- **37 C.F.R. § 1.56**: Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability.

→ Includes all inventors!!
Duty of Disclosure

- Newly added inventor(s) may have material information regarding:
  - prior art, including the inventor’s own work
  - public disclosures of the invention
  - sales or offers to sell the invention
  - material inconsistent with statements in application
**Best Mode**

- **Each inventor’s** subjective preferred method of practicing the invention must be disclosed in the U.S. application. 35 U.S.C. § 112, ¶ 1; see, e.g., *Bayer AG v. Schein Pharmaceuticals, Inc.*, 301 F.3d 1306 (Fed. Cir. 2002).
  - includes an inventor’s subjective beliefs about which mode is best and any aspect of making or using the invention that materially affects the properties of the claimed invention. *Bayer*, 301 F.3d at 1320.

- Judged as of effective filing date.

- If have to correct inventorship, may have to file new application if added inventor’s best mode different.
Attacking Patents Based on Inventorship
An unnamed inventor has the following choices*

- File a **protest** against other’s application under Rule 291 alleging fraud or incorrect inventorship
- File own **application** (provoke interference)
- File **§ 256 action** in district court to correct inventorship

Patent Litigation - ALLEGATIONS OF MISJOINER OR NONJOINER

• **Standard** - Clear and convincing evidence
  – Evidence must be *corroborated*

• **Stakes are high**: each inventor enjoys a presumption of ownership of entire patent

• If burden of proof is satisfied, patentee should be given opportunity to correct inventorship under § 256

• If relief under § 256 is not sought, patent invalid for failure to comply with § 102(f)
UNNAMED INVENTORS - § 256 Action

  - 35 U.S.C. § 256 to correct inventorship to replace named inventors with 3 scientists from different company
  - Two monoclonal antibodies created by named inventors
  - Subsequently, named inventors discussed and offered samples of antibodies to nonjoined scientists
  - Nonjoined scientists then performed experiments with the antibodies for the next 14 months, and discovered a synergistic effect when mixed with chemotherapy drugs
    - Testified that they ran experiment based on independent judgment
    - Nonjoined scientists merely tested viability of idea wholly conceived of by named inventors
  - DC: motion for SJ to dismiss denied
    - sufficient evidence to create a genuine issue of material fact over the inventorship of the subject matter
    - Ordered PTO to issue Certificate of Correction changing inventors
**LACHES - § 256 Action**

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

- **HELD:** “A § 256 claim for correction of inventorship does not accrue until the patent issues” because "that is what the language of the provision requires."

- An individual who believes himself or herself to be an omitted inventor has **6 years from the date that the patent issues** to attempt to correct the inventorship of that patent, or else the presumption of laches will apply.

  - This is true even if the individual knows of the inventorship problem before the patent issues.

- omitted inventor's failure to seek correction under 35 U.S.C. § 116 or 135 does not prevent the inventor from challenging inventorship under § 256
CORRECTING INVENTORSHIP IN AN APPLICATION HAVING A FILING DATE ON OR AFTER SEPTEMBER 16, 2012
Correction of inventorship or change of inventor information in a nonprovisional application requires:

• An **ADS** listing correct inventors

• A processing **fee** (1.17(i))

• **Oath or declaration** (or substitute statement) for any newly added inventor(s), **IF** any

• An **additional fee** (1.17(d)) **IF** Office Action on merits, **OR** a statement that inventorship change is due solely to cancellation of claims

37 CFR 1.48(a)-(c), (f)
Changing Inventorship Under AIA

Change inventorship of a **provisional** application requires:

- **Request** by party in § 1.33(b) to correct
- A processing **fee** (§ 1.17(q))

37 CFR 1.48(d)
Second and Subsequent ADSs

• An ADS filed after the first ADS should contain:
  – *only* the information that is being changed in the bibliographic data and not the information that is unchanged
    • section headings are no longer required
  – *must* include the application number
  – the changes should be shown with “strikethrough” for deleting information and “underscore” for adding information
Effect of Erroneous Inventorship Under AIA

35 U.S.C.§ 116 (as amended by AIA)

(c) CORRECTION OF ERRORS IN APPLICATION.—Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, 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.

35 U.S.C.§ 256 (as amended by AIA)

(a) CORRECTION.—Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

...
Effect of Erroneous Inventorship Under AIA

- AIA removes “deceptive intent” from 35 U.S.C. 116 and 256 but, if the mis-naming of inventors (including failing to name collaborating joint inventors) is an intentional misrepresentation, it may result in a finding of unenforceability due to inequitable conduct:
  - Inventorship meets the materiality prong of the inequitable conduct analysis, even under the post-Therasense “but for” materiality standard.
Thank You!

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