

IP Expert Advice:

How to determine and correct inventorship in U.S. patents

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In an infringement suit, the patent is declared unenforceable because the company is found to have engaged in inequitable conduct by intentionally failing to name one of the true inventors of the machine.

This scenario shows how stringent the U.S. patent laws are and how critical it is to ensure you "cover all your bases" when it comes to inventors being correctly named in patents. If you fail to do so, then you run the risk that your patent will be invalid or unenforceable.

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An invention can be conceived by one or more people. In a

patent, each person contributing to the invention's conception must be named as an inventor. Those who merely assist the inventors without ever forming a "firm and definite idea" of the invention do not qualify as inventors.

The court deciding patent appeal cases has stated that conception is "the touchstone of inventorship." It is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."

Because the invention is defined by the patent "claims" (numbered paragraphs appearing at the end of a patent), patent law only requires that a properly named inventor make a contribution to some aspect of one or more of the claims.

A misnaming of an inventor may render an issued patent invalid. In the majority of cases inventorship errors can be corrected provided the correction is made before the patent is invalidated at trial.

Errors of inventorship arise when:

- An actual inventor is not named among co-inventors ("nonjoinder");
- a listed inventor is incorrectly named among inventors ("misjoinder");
- or an actual inventor is not named and replaces a listed inventor.

Errors of inventorship can be corrected:

- a) while the patent application is pending;
- b) after the patent issues by way of a "certificate of correction;" or
- c) after the patent issues by way of a "reissue" process.

An issued patent carries a presumption that the named inventors are the true and only inventors. Thus, a person challenging the validity of a patent on such grounds has a heavy burden to show misjoinder or nonjoinder of inventors.

If a patent owner can demonstrate that inventorship can be corrected by simply filing a request for a certification of correction with the Patent Office, a court must order correction of the patent, thus saving the patent from being rendered invalid. Absent inequitable conduct, the correction of inventorship does not affect the patent's validity or enforceability for the period before the correction.

While an application is pending, inventorship may be amended by filing a petition to the Assistant Commissioner of Patents. Such an



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amendment of inventorship is proper so long as the error occurred without deceptive intent on the part of the inventor who was mistakenly omitted from, or mistakenly included in, the application. You must provide consent from the newly added inventor and the removed inventor.

After a patent is issued, inventorship can be corrected by filing a request for a certificate of correction or a request for a reissue patent with the Patent Office.

Notably, after a patent issues, a misjoined inventor may be removed from the patent regardless of the reason for the error—deceptive or not—while a nonjoined inventor may be added only if the error arose without any deceptive intention on his part. In practice, it is unlikely that a nonjoined inventor engaged in deception.

For that reason, post-issuance challenges to validity based on incorrect naming of inventors are rarely successful. A certificate of

correction is to be used when all of the parties, i.e. the added inventors, the removed inventors and the remaining inventors, are in agreement and the inventorship is not contested.

Otherwise, the failure to name the correct inventive entity is an error correctable through a reissue application. Notably, an assignee of the entire interest of a patent may add or delete the name of an inventor by reissue without the original inventor's consent.

Thus, in those circumstances where an inventor cannot be found or is uncooperative, the assignee can benefit from the reissue process and correct inventorship.

The following points should help you determine who qualifies as an inventor:

- Broadly identify all individuals who assisted with the invention;
- Evaluate the contribution of each individual and apply the test of conception;

- Confirm that each inventor conceived subject matter of at least one claim in the patent application; if the application is amended to cancel or add a claim, the inventorship may need to be amended; and
- Maintain all relevant corroborating evidence of conception

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