

IP Expert Advice:

US inventorship and priority disputes over geography

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Unlike most of the rest of the world, the United States employs a "first-to-invent" patent system. If two individuals file separate patent applications

claiming identical inventions, the individual who can prove the earliest date of invention is entitled to a patent.

By proving first invention, this "first to invent" framework allows an applicant who files after another to obtain the patent rights through an "interference" proceeding. This theoretically allows the first inventor, not the first who filed, to benefit from patent rights.

Conversely, most countries use "first to file" patent systems. Conflicting claims by different inventors to the same invention are resolved solely by reference to the filing date. The first person to file an application for a patent prevails, and there are no "interference" proceedings.

A first-to-file system encourages prompt filing of patent applications and prompt disclosure of the invention to the rest of the world.

Conception and reduction to practice in the US

Inventorship involves inquiries with respect to conception and reduction

to practice. Conception of subject matter is the mental formulation and disclosure by the inventor of a complete idea for a product or a process. Invention is above all a mental operation—the perception of a novel means for achieving a particular result.

Merely having a hopeful or desirable result is not considered conception. Additionally, the conception must be complete enough that anyone of ordinary skill in the art can reduce the concept to practice.

Reduction to practice follows from conception. It is generally a matter of mechanics: verifying that the conceived invention actually works. It can be actual, such as by building a prototype, or constructive.

Constructive reduction to practice is the filing of a patent application, disclosing the invention in sufficient detail to enable someone of ordinary skill in the invention's subject matter to practice the invention.

For purposes of determining the invention's priority, the filing date of the patent application may be relied upon as the date of reduction to practice. Actual reduction to practice occurs when an inventor:

- (1) constructs a product or performs a process that is within the scope of the patent claims; and
- (2) demonstrates the capacity of the inventive idea to achieve its intended purpose.

Interference proceedings and 35 U.S.C. §102(g)

An interference proceeding involves determining who invented the claimed invention first. The rule of priority states that the first individual who reduces the subject matter in question to practice—either actually or constructively—is the first inventor. Under 35 U.S.C.



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§102(g) and case law, there are two significant exceptions to the rule:

The inventor who was the first to conceive the invention ("inventor A") but reduced the invention to practice after a second inventor ("inventor B") will prevail over inventor B if inventor A exercised reasonable diligence in reducing the invention to practice from a time before inventor B conceived the subject matter.

Inventor B, on the other hand, will prevail in an interference proceeding if inventor A abandoned, suppressed, or concealed the invention.

The following examples illustrate some of the scenarios that can occur as a result of the U.S. first-to-invent system:

Example	Patent
Inventor AC ----->	RcInventor A
Inventor BC ----->	R
Inventor AC---D----->	RcInventor A
Inventor BC---->	R
Inventor AC----Ra---->	RcInventor A
Inventor BC----->	R
Inventor AC--D--Ra-->	Rc Inventor B
Inventor BC---->	R

In the example timelines (above), C is conception; R is reduction to practice (constructive or actual); Rc is constructive reduction to practice; Ra is actual reduction to practice; and D is commencement of diligence without abandonment, suppression, or concealment.

Diligent individuals are ones who pursue their goal in a reasonable fashion during the period of time in question. There must be reasonable continuous activity in view of all the circumstances. However, inventors are not required to spend all of their time working on the invention. Inventors must show activity aimed

at reducing the invention to practice or legally adequate excuses for inactivity.

Abandonment, suppression, and concealment stem from a unitary concept, focusing on an inventor's actions after conceiving the invention. Courts generally consider the length of delay from reduction to practice to either an application for patent or commercialization, the existence and nature of any activity during the delay period, and the cause of the resumption of activity.

Simply, inventors are stripped of any benefits of a US patent when they conceive an invention, hide it in a drawer for several years, and spring into action only because of a rival inventor. Public policy favors early disclosure, and the US patent laws attempt to achieve that purpose, albeit differently than the laws of most other countries.

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