

## US: PATENTS



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## How to avoid errors of inventorship

**Y**our company learns that a competitor has copied the invention in one of your most valuable patents.

Your patent counsel advises there is a strong case of infringement, and your company initiates a suit. During discovery it is revealed that a second person contributed to the invention, but was not identified as an inventor in the patent.

Such errors in naming inventors could invalidate a patent. In most cases, the error can be corrected if done before a court reaches an invalidity holding, but there can be other consequences, such as suits from omitted inventors, and legal fees to correct inventorship. It is thus critical that inventorship be carefully ascertained and documented at the time an application for a patent is filed.

Who invented it? As one court has put it, under US patent law, an invention 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”. The “touchstone of inventorship” is conception. All persons contributing to the invention’s conception must be named as inventors on the patent application. Those who merely assisted the inventor are not inventors.

What can my company do to avoid inventorship errors? Prior to filing a patent application, identify all persons who assisted with the invention. Evaluate the contribution of each individual, keeping the test of conception in mind. Monitor inventorship issues throughout the application process, as inventorship can change with the addition, cancellation or amendment of claims. For instance, if one of the inventors only contributed to one of the claims, inventorship would have to be amended if that claim were cancelled. Retain all corroborating evidence of conception.