

A PUTATIVE INVENTOR'S REMEDIES TO CORRECT INVENTORSHIP ON A PATENT

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Inventorship is a required component of patents issued in the United States, and the penalty for filing a patent with incorrect inventorship is harsh: possible invalidation of the entire patent. This iBrief explores the background on inventorship in the United States patent system, and various remedies such as 35 U.S.C. § 116, 35 U.S.C. § 256, and interference proceedings in correcting errors in inventorship. This iBrief will then discuss the usefulness of these various remedies to a putative inventor who was left off the inventorship of a patent.

I. INTRODUCTION

¶1 The inventorship of a patent is central to the patent system of the United States. Inventorship identifies the true and correct inventor of the claimed invention. The inventor is the individual who first conceived of the invention and also the first owner of a patent on the invention.

¶2 Incorrect inventorship on an issued patent jeopardizes the validity of the patent. When good faith mistakes are made regarding inventorship on a patent application, various means are available to correct the inventorship either before or after the patent issues. Such a correction will preserve the validity of the patent. A putative inventor left unnamed on a patent may elect either administrative or judicial means of correcting inventorship.

II. ISSUES SURROUNDING INVENTORSHIP

A. Definition

¶3 The patent system of the United States is concerned with the inventorship of a patent. This concern stems from the U.S.'s "first-to-invent" rule applied when the United States Patent and Trademark Office ("PTO") considers the award of a patent.² Patents in the United States are awarded to an "inventorship entity" which can be either a sole inventor or multiple co-inventors.³

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² PETER D. ROSENBERG, 1 PATENT LAW FUNDAMENTALS § 10.00 at 10-3 to 10-5 (2d ed. 2000) (United States is a first-to-invent patent system in contrast to the most of the rest of the world which awards patents based on the first-to-file a patent application).

³ Rivka Monheit, *The Importance of Correct Inventorship*, 7 J. INTELL. PROP. L. 191, 191 (1999).

¶4 In general, the inventor is the individual who first conceived of the invention.⁴ The traditional test of conception is “[w]hether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention.”⁵ Courts have interpreted conception to require the inventor “to describe his invention with particularity” in order to demonstrate the proper level of concreteness in his invention.⁶

B. Patent Ownership

¶5 Patents are treated as personal property under United States law.⁷ Like personal property, patent rights can be assigned through the use of written instruments. Such assignments must be recorded in the PTO.⁸ Patent rights may be conveyed by the rightful owner in whole or in part similar to other forms of personal property.⁹

¶6 Inventorship “provides the starting point for determining ownership of patent rights.”¹⁰ The true and original inventor is the owner of the issued patent, “absent some effective transfer or obligation to assign.”¹¹ The inventor may transfer the patent to other entities by written instruments recorded in the PTO.

C. Public Policy

¶7 The Constitution grants Congress the power to “promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries.”¹² Congress has exercised this power by granting patents to “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter.”¹³ Congress also requires “[a]n application for patent shall be made, or authorized to be made, by the inventor . . .”¹⁴ Thus there is a strong historical and statutory justification for the U.S.’s custom of granting of patents to the first to invent.

¶8 There is also a cultural tendency in the United States supporting the “first-to-invent” system. American culture has revered the innovative spirit embodied in inventors such as Benjamin Franklin, Thomas Edison, and the Wright Brothers.¹⁵ The “first-to-invent” system is arguably necessary to protect the small

⁴ Sewall v. Walters, 21 F.3d 411, 415 (Fed. Cir. 1994) (“[d]etermining ‘inventorship’ is nothing more than determining who conceived of the subject matter at issue”).

⁵ Burroughs Wellcome Co. v. Barr Lab., Inc., 40 F.3d 1223, 1228 (Fed. Cir. 1994).

⁶ *Id.*

⁷ 35 U.S.C. § 261 (2002).

⁸ *Id.*

⁹ See 8 DONALD S. CHISUM, CHISUM ON PATENTS: A TREATISE ON THE LAW OF PATENTABILITY, VALIDITY, AND INFRINGEMENT § 22.03 (2002).

¹⁰ University Patents Inc. v. Kligman, 762 F.Supp. 1212, 1218-19 (E.D. Pa. 1991).

¹¹ *Id.*

¹² U.S. CONST. art. I, § 8, cl. 8.

¹³ 35 U.S.C. § 101.

¹⁴ 35 U.S.C. § 111(a)(1).

¹⁵ Coe A. Bloomberg, *In Defense of the First-to-Invent Rule*, 21 AIPLA Q.J. 255, 260 (1993).

inventor who may well be without the resources of a large corporation that would otherwise enable him to fully utilize the patent system.¹⁶ This argument holds sway among the American people because the idea of an independent, struggling inventor succeeding through his own efforts is appealing and embodies the “American dream.”¹⁷

¶9 Morally, it is argued that a “first-to-invent” system is superior because it does not allow “one to harvest what another has sown.”¹⁸ The proponents of this system believe that one has a natural right to his own creative efforts. In addition, a “first-to-invent” system rewards “those who actually expend inventive effort in a successful fashion.”¹⁹ This prevents the unjust enrichment of those who pirate another’s creative efforts.

D. Requirement of Correct Inventorship

¶10 United States patent law requires the true and original inventor or inventors to be named in the application for a patent.²⁰ Failure to list the correct inventor or inventors on a patent application may ultimately jeopardize the validity of a patent.²¹ However, good faith errors in inventorship can be corrected.²² Generally, courts have required a party seeking to invalidate a patent on incorrect inventorship grounds to bear a heavy burden of proof.²³ Courts are hesitant to invalidate a patent for incorrect inventorship because it is a highly technical defense that destroys an otherwise valid patent.²⁴ However, listing the true and correct inventor on the original patent application remains extremely important.

¹⁶ Sean T. Carnathan, *Patent Priority Disputes – A Proposed Re-Definition of “First-to-Invent”*, 49 A.L.L.R. 755, 792 (1998).

¹⁷ *Id.*

¹⁸ CHISUM, *supra* note 9, § 2.01.

¹⁹ *Id.*

²⁰ CHISUM, *supra* note 9, § 22.03.

²¹ *Id.*

²² *Id.*

²³ *See* *Shields v. Halliburton Co.*, 667 F.2d 1232 (5th Cir. 1982); *Jamesbury Corp. v. U.S.*, 518 F.2d 1384 (Ct. Cl. 1975); *Congoleum Industries, Inc. v. Armstrong Cork Co.*, 339 F. Supp. 1036 (E.D. Pa. 1972).

²⁴ *E.g.* *Canon Computer Systems, Inc. v. Nu-Kote Int’l, Inc.*, 134 F.3d 1085, 1089 (Fed. Cir. 1998) (“Incorrect inventorship is a technical defect in a patent that may be easily curable.”); *General Motors Corp. v. Toyota Motor Co.*, 667 F.2d 504 (6th Cir. 1981), *cert. denied*, 456 U.S. 937 (1982), *on remand*, 569 F. Supp. 889 (S.D. Ohio 1983), *aff’d*, 738 F.2d 454 (Fed. Cir. 1984) (unpublished) (“Such defenses are highly technical; courts disfavor these defenses on the strength of the legal presumption that the inventors named in a patent are the true ones. . . . This presumption is only overcome by clear and convincing evidence.”); *Lert v. A.C. Nielsen Co.*, 33 U.S.P.Q.2d 1026, 1029 (N.D. Ill. 1994) (“defendant’s misjoinder of inventors argument is a technical defense which is not favored by the courts.”); *Delaski & Thropp Circular Woven Tire Co. v. William R. Thropp & Sons Co.*, 218 F. 458, 465 (D.N.J. 1914) *aff’d* 226 F. 941 (3d Cir. 1915) (“This defense has . . . always been regarded as technical, and looked upon with disfavor by the courts, and clear and convincing proof has uniformly been required to sustain it.”)

III. CORRECTION OF INVENTORSHIP

¶11 35 U.S.C. § 116 and 35 U.S.C. § 256 describe procedures that allow for the correction of inventorship on patent applications and issued patents. Legislative history indicates Congress' purpose behind these provisions:

Very often two or three people make an invention together. They must apply as joint inventors. If they make a mistake in determining who are the true inventors, they do so at their peril. This provision permits a bona fide mistake in joining a person as inventor or in failing to join a person as an inventor to be corrected."²⁵

A. 35 U.S.C. § 116

¶12 When a patent application contains a good faith inventorship error, the error can be corrected under 35 U.S.C. § 116. The third paragraph of § 116 states:

Whenever through error a person is named in an application for patent as the inventor, or through an 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 pre-scribes.²⁶

¶13 Under the old rules, § 116 required consent from the original named inventor, a declaration from the actual inventor, and consent from any assignees.²⁷ However, the PTO adopted a new set of rules in 1997 that may make § 116 more useful in inventorship disputes.²⁸

¶14 When applying for correction of inventorship on a patent application through § 116, a statement is required "only from the person named in error as an inventor or from the person who through error was not named as an inventor rather than from all the original named inventors so as to comply with 35 U.S.C. 116."²⁹ This requirement is satisfied if "an allegation of joint inventorship is made, coupled with sufficient evidence to enable a determination regarding the facts of error in not including one or more inventors in the application, and the lack of deceptive intent."³⁰ Nor is it necessary to identify the non-joined inventor's exact contribution to the invention.³¹ However, the PTO may "require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship."³² Thus, while the 1997 rules relaxed the standard for correcting a good faith mistake in the declaration of inventorship, the PTO reserves

²⁵ S. REP. NO. 1979, 82d Cong., 2d Sess. 7 (1952).

²⁶ 35 U.S.C. § 116.

²⁷ CHISUM, *supra* note 9, § 2.04(7).

²⁸ Department of Commerce, Patent and Trademark Office, Changes to Patent Practice and Procedure, 62 Fed. Reg. 53132, 53137-38 (Oct. 10, 1997).

²⁹ *Id.* at 53138.

³⁰ Application of Searles, 422 F.2d 431, 437 (C.C.P.A. 1970).

³¹ *In re Russell*, 193 U.S.P.Q. 680 (Comm'r Pat. 1975).

³² 37 C.F.R. § 1.48(g).

the right to require additional verification of correct inventorship due to the importance of this element to a patent.

B. 35 U.S.C. § 256

¶15 After a patent has issued, its inventorship may be corrected under 35 U.S.C. § 256. This section allows the correction of inventorship on an issued patent when the mistake was the result of a good faith error.³³

¶16 35 U.S.C. § 256 states:

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.³⁴

¶17 Where the omission of an inventor is an excusable inadvertence and not attributable to bad faith, § 256 can be used to correct inventorship of an issued patent.³⁵ To demonstrate lack of deceptive intent, an applicant must convince a court weighing all the evidence of his good faith action.³⁶

¶18 The first paragraph of § 256 allows the correction of a patent's inventorship through application to the PTO. After 1997, the application to the PTO no longer required "factual showings to establish a lack of deceptive intent . . . , with a statement to that effect being sufficient"³⁷ However, all concerned parties must apply to the PTO for correction. Therefore, this is not a particularly useful means for a putative inventor disputing the inventorship of a patent. After a PTO decision under § 256, courts retain the right to review the change in inventorship for propriety.³⁸

¶19 The second method to invoke § 256 is by notice, hearing, and order of a court "before which such matter is called in question."³⁹ Courts have split on whether consent of all parties is required before judicial correction under § 256.⁴⁰

¶20 When a putative inventor wishes to correct the inventorship of a patent, he faces a heavy burden. There is a strong presumption of validity that accompanies all issued patents, as well as a simultaneous

³³ *Bemis v. Chevron Research Co.*, 599 F.2d 910 (9th Cir. 1979).

³⁴ 35 U.S.C. § 256.

³⁵ *Norton Co. v. Carborundum Co.*, 397 F. Supp. 639 (D. Mass. 1975).

³⁶ *Ethicon, Inc. v. U.S. Surgical Corp.*, 937 F. Supp. 1015, 1037 (D. Conn. 1996).

³⁷ 62 Fed. Reg. at 53171.

³⁸ *See Consolidated Aluminum Corp. v. Foseco International Ltd.*, 10 U.S.P.Q.2d 1143, 1163 (N.D. Ill. 1988), *aff'd*, 716 F. Supp. 316 (N.D. Ill. 1989), *aff'd*, 910 F.2d 804 (Fed. Cir. 1990).

³⁹ 35 U.S.C. § 256.

⁴⁰ CHISUM, *supra* note 9, § 2.04(2).

presumption that the listed inventorship of a patent is correct.⁴¹ The putative inventor must overcome such a presumption with clear and convincing evidence.⁴²

C. Interference

¶21 Another means for a putative inventor to assert inventorship is to begin an interference proceeding under 35 U.S.C. § 135. To do so, the putative inventor must file a patent application for the disputed invention with the correct inventorship and request an interference proceeding with regard to the original patent.⁴³ This does not require consent from other involved parties and can be initiated by the putative inventor alone.

¶22 An interference proceeding in the PTO occurs when more than one application seeks to cover substantially the same invention.⁴⁴ The proceeding resolves conflicting claims on the same invention. During an interference proceeding, the PTO attempts to “decide who among multiple patent applicants (or an applicant and a patentee) was the first to invent claimed subject matter.”⁴⁵ The PTO will resolve the interference by allowing the patent with the correct inventorship and rejecting the others.⁴⁶

D. Reputational Interests Will Likely Convey Standing

¶23 In *Chou v. University of Chicago*, the Federal Circuit recognized that ownership rights in a patent or a financial interest in the patent create standing for an inventor to sue for correction of inventorship.⁴⁷ The Court also noted that reputational interest may confer sufficient standing to bring suit, as “being considered an inventor of important subject matter is a mark of success in one’s field...”⁴⁸ However, despite its broad reasoning, the Court decided the case solely on Chou’s financial interest in the resulting patent.⁴⁹

¶24 Given the Federal Circuit’s dicta in *Chou*, it is likely that in the future the Court will allow a putative inventor to bring suit to correct inventorship even if only reputational interests are at stake. The putative

⁴¹ *Fritsch v. Lin*, 21 U.S.P.Q.2d 1737, 1739 (Bd. Pat. App. & Int’f 1991) (“Statements in patent applications as to sole or joint invention are prima facie evidence of such fact; and a party, relying upon his application, does not have to prove such facts. Thus, a party who wishes to dispute sole inventorship as stated in an application ... has the burden of overcoming the prima facie effect of the application.”); *Ethicon, Inc. v. United States Surgical Corp.*, 937 F. Supp. 1015, 1304 (D. Conn. 1996), *aff’d*, 135 F.3d 1456, 45 U.S.P.Q.2d 1545 (Fed. Cir. 1998), *cert. denied*, 119 S. Ct. 278 (1998) (“The presumption of validity extends to the patent’s inventorship.”).

⁴² *Hess v. Advanced Cardiovascular Systems, Inc.*, 106 F.3d 976 (Fed. Cir. 1997), *cert. denied*, 520 U.S. 1277 (1997).

⁴³ *Chou v. University of Chicago*, 254 F.3d 1347, 1358 (Fed. Cir. 2001).

⁴⁴ CHISUM, *supra* note 9, 10.09(1)(a).

⁴⁵ *Minnesota Mining & Manufacturing Co. v. Norton Co.*, 929 F.2d 670, 674, 18 U.S.P.Q.2d 1302, 1306 (Fed. Cir. 1991).

⁴⁶ 35 U.S.C. § 135(a).

⁴⁷ *Chou*, 254 F.3d at 1358-59 (recognizing that expectations of ownership or financial interest less than complete ownership are sufficient to grant a supposed inventor standing to bring suit).

⁴⁸ *Id.* at 1359.

⁴⁹ *Id.*

inventor would be able to bring suit to correct inventorship under § 256 on an issued patent or § 116 on a patent application regardless of a lack of ownership or financial interests in the resulting patent.

IV. CONCLUSION

¶25 The “first-to-invent” patent system in the United States places a unique emphasis on identifying the correct and original inventor entity on each patent. The inventorship requirement allows for a simple determination of patent ownership through creation of a chain-of-title beginning with the inventor entity. This requirement also recognizes the contribution of the inventor entity to the progress of science.

¶26 Incorrectly listing the inventors on a patent may invalidate the patent. However, courts have been reluctant to invalidate patents due to such technical violations. When the inventorship of a patent application is incorrect, it can be corrected under 35 U.S.C. § 116. If the inventorship of an issued patent is found to be incorrect, it can be corrected under 35 U.S.C. § 256. Both of these remedies may only be applied where the error was made in good faith.