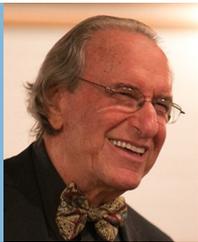


# PROPER PATENT INVENTORSHIP



Paul J. Sutton  
*Sutton Magidoff LLP*

The critical issue of who must be named inventor(s) on US patents is often misunderstood and may affect patent validity. It is not unusual for true inventors to be left off patents and for non-inventors to be named. Sometimes, this error is intentional and may involve personalities and/or politics within organisations. This article seeks to clarify this issue so that the reader is able to properly apply US patent law when dealing with inventorship.

Many years ago, I received a number of invention disclosures from a corporate client's chief engineer. I visited him at his office and he gave detailed drawings of ingenious ideas to me so that they could be patented. When I asked him to identify each and all of the people who contributed to the inventive concepts, he was firm in identifying himself as the sole inventor to be named on related patent applications.

Years later, during a question and answer period following an intellectual property seminar that I presented to the same client's engineers, marketing and sales personnel, an engineer raised his hand and asked: "If I alone create product inventions which I document to my boss, but he adopts the ideas as his own and names himself as the sole inventor on patent applications, what effect might this have? I don't want to alienate my boss or lose my job, but I feel as if I've been robbed and the products are a huge success in the marketplace."

The implications of this type of deliberate ego-driven false designation of inventorship are considerable, and bring possible unenforceability claims of any resulting patents into play, rendering them of no real value to the company. Since all employees of this company had assigned their patent rights to the company under an employer/employee agreement, this misconduct was not necessarily motivated by financial gain. Although being named as an inventor on patents may in some companies result in an increased likelihood of advancement in position and/or salary.

The following samplings of US patent law can be used to develop guidelines to be followed. Also, see Guy F. Birkenmeier's November 2008 Baker Botts LLP *Intellectual Property Report* for an informative discussion of due diligence as it affects inventorship.

- A co-inventor must make a contribution to the invention that is more than merely the exercise of ordinary skill in the art.
- The issue of inventorship necessarily implicates the issue of ownership of patent rights.
- Co-inventors are presumed to own a *pro rata* undivided interest in the underlying invention and resulting patent rights. See *Ethicon v United States Surgical*.

**“SINCE ALL EMPLOYEES OF THIS COMPANY HAD ASSIGNED THEIR PATENT RIGHTS TO THE COMPANY UNDER AN EMPLOYER/EMPLOYEE AGREEMENT, THIS MISCONDUCT WAS NOT NECESSARILY MOTIVATED BY FINANCIAL GAIN.”**

- Each co-inventor is entitled to grant exclusive licences, without the knowledge of or accounting to co-inventors. This often-misunderstood law may provide counterintuitive scenarios where a first co-inventor on a patent may be completely unaware that the second co-inventor has destroyed the first's economic advantage by virtue of granting away exclusive rights, without any knowledge given to the first and without accounting to the first. This is easily avoided by means of a relatively simple agreement between all co-inventors, where there are appropriate and fair restrictions on transfers and assignments put in place.
- Courtesy or politics-driven naming of non-inventor individuals as co-inventors may unintentionally give such people ownership interests in patent rights.
- Individuals named as inventors may owe duties of disclosure and assignment of rights to US-based agencies that fund the work from which an invention is derived.
- There is a duty on the part of each co-inventor to disclose all relevant prior art to the US Patent and Trademark Office, and failure to do so may result in patent unenforceability.
- Where there is deceptive intent in failing to name the correct inventors, this misconduct may, as in the above example, result in a patent being unenforceable. See *Frank's Casing Crew & Tentacle Tools v PMR Techs, Ltd.*
- It is possible to correct inventorship in a patent or patent application under 35 USC 256.
- As observed by Birkenmeier in his named article, a good place to find information regarding inventorship may be laboratory notebooks that are kept by technical personnel in the ordinary course of business. Such notebooks can provide critical evidence of proper naming of inventors in *inter partes* proceedings, such as patent infringement actions. ■

---

*Paul J. Sutton is a founding partner of Sutton Magidoff LLP. He can be contacted at: paul@suttonmagidoff.com*