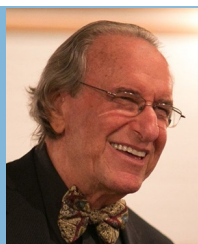


# THE DANGERS OF MISNAMING PATENT INVENTORS



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It is often the case that the question arises of who should be named as an inventor or co-inventor on a US patent. The impact of this query and its effect on individuals can be profound, for many practical as well as psychological reasons. And yet, there is a lack of understanding of how improperly naming inventors on a patent can be deadly to its validity and enforceability. This significant issue cries out for clarification.

Under US patent law, an inventor is the person (or persons) who contributes to the claims of a patentable invention. The claims are those delicately worded numbered paragraphs at the end of every US patent. Not the patent drawings, abstract, or specification, but the claims. The claims operate much like the metes and bounds set forth in one's real estate deed which seeks to distinguish one's own property from that of a neighbour or other. A patent's claim distinguishes one's lawful monopoly rights from those not covered by the patent.

It's just as important to understand from a patent claim what an invention is not, as what it is. Those seeking to lawfully patent their ideas are entitled to see in a patent what they are entitled to do, free from potential allegations of patent infringement. The limitations recited in patent claims, quite apart from the application of the doctrine of equivalents, permit the reader to distinguish between the invention covered by a patent and what it does not embrace.

It is important to realise that under US patent law, an inventor or co-inventor is one who is considered to possess "intellectual domination" over the underlying inventive process, not merely one who assists in its reduction to practice. This sometimes can be difficult to determine, and has given rise to many litigation disputes.

Apart from an unintentional or innocent mistake, under US patent law failure to properly name all inventors in a patent may result in invalidation and unenforceability. Given the foregoing, one seeking to understand the meaning and scope of a patented invention will need to examine the specific language recited in a patent's claims. Similarly, in deciding who should be named as an inventor or co-inventor, one must perform the identical examination of claim language and the recited features. While inventors may be added to or deleted from a patent to correct an innocent mistake, one is not entitled to substitute an inventor for one previously mistakenly named.

In the case of a pending patent application being prosecuted before the US Patent and Trademark Office, since the scope and language of claims may change during this prosecution, inventorship may change. Ongoing consultation with patent counsel is an invaluable tool in making this determination.

## Avoid giving ammunition

Imagine the predicament of a patent owner in litigation who has established wilful infringement of its patent rights, only to have those rights virtually evaporate with a decision that the inventor named in

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the patent is not in fact the true inventor. One must avoid giving such ammunition to any party who may seek to invalidate or weaken their portfolio of patent rights.

Let's not forget that when filing for patent protection, one executes a declaration under oath, attesting to a sincere belief that they are a true inventor or co-inventor. This oath must be treated in much the same way as an oath recited in live testimony or in an affidavit. While perhaps rarely prosecuted, those who deliberately falsely identify themselves as an inventor may be subject to being prosecuted for perjury, with all of the exposures to prison and fine.

In my experience, all too often the naming of an inventor may be treated as a "reward" by the person organising the filing of a patent application. Such a person may be the only one with whom a patent attorney may meet or discuss the invention's fundamentals. In some companies, which may own all patent rights resulting from the efforts of employees, the granting of a patent to the company may be the occasion of a reward for the named person, whose resume is enhanced by being mentioned as a patentee.

There may also be a chance for advancement within the company's ranks if the value of the patented invention is extraordinary. This, of course, will depend on the importance that management places on employees' inventing and innovation. ■

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