



Determination of Inventorship

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Significance of Determining Inventorship

Must correctly identify inventor(s) early to avoid negative consequences, since under US law:

- US patent must name correct inventor(s) or it is invalid (though error can be corrected)
- ownership is initially based on inventorship
 - ownership of invention right initially vests in inventor [US Constitution]
- scope of prior art may depend upon who is or is not named an inventor (e.g. non-inventor publication)
- ability to claim priority to a prior filed application ultimately depends on inventorship
 - Inventorship and the right to claim priority are tied together under US laws



Standards for Inventorship

Inventor must participate in “conception” under US law

- conception: “the complete and operative invention as it is thereafter to be applied in practice”¹
- “Conception is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation”²



Standards for Inventorship (con't)

- ¹*Mergenthaler v. Scudder*, 1897 CD 724 (DC Cir. 1897)
- ²*Burroughs Wellcome Co. v. Barr Laboratories, Inc.*, 32 USPQ2d 1915 (Fed. Cir. 1994)



Standards for Inventorship (con't)

- Inventor's participation in conception must result in the inventor ***contributing at least one element to one patent claim*** of the ultimately granted patent
- two people may be co-inventors even if
 - they did not physically work together or at the same time on the invention
 - each did not make the same type or amount of contribution
 - each did not make a contribution to the subject matter of of every patent claim [35 USC 116]
- If originally named inventor's contribution is removed from all patent claims, then he is no longer an inventor for that patent



Standards for Inventorship (con't)

What conception does not require:

- no requirement for reasonable expectation that invention will work for intended purpose
 - need only show that inventor has idea for conception to be complete
- even in unpredictable technologies (e.g. biotechnology) inventor does not need experimental confirmation that invention will work
- inventor need not know *how* invention works
- likely not an inventor if:
 - only following instructions of others (even if highly skilled)
 - adopting information provided by another (this is “derivation”)



Standards for Inventorship (con't)

Conception examples

- mechanical/electrical inventions:
 - devices require knowledge of the structure and a method for making the device
 - methods require knowledge of how to conduct the method and what obtainable resources are needed
- chemical/biotechnological inventions:
 - chemical compounds require knowledge of the structure and a method for making the compound
 - treatment/diagnostic methods require knowledge of how to conduct the method and what obtainable resources are needed



Inventorship Determination Procedures

- Inventorship is a legal qualification that should be made by a qualified practitioner
- Inventorship ultimately depends upon the scope of the patent claims
 - each inventor must have contributed at least one element in one patent claim
- Procedures should be set up to determine inventorship based on objective standards and guidelines
 - use invention disclosure form
 - review notebooks and other evidence
 - meet in person with potential inventors
 - draft inventorship determination memo for the record



A Word on Incentives for Inventors

- Many global companies provide monetary rewards for patenting “milestones”, for example:
 - 0-\$600 for an invention disclosure form
 - \$500-\$1000 for a filed patent application
 - \$1000-\$2500 for a granted patent
- Non-monetary peer recognition rewards are also awarded
- Invention incentive programs can help foster an innovation culture
- Many consultants are available to offer suggestions about incentive programs





**Thank you very
much!**



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Conception Issue Example: Inventor Interview

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Interviews
Dr. Le Forestier
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Inventor Interview

AM:

- The Invention, as described and claimed in U.S. Patent Number '999, is a method for treating AIDS which is caused by the human HIV virus
- Patent claim recites a treatment method of administering to a patient the drug AZT (azidothymidine)
- AZT was one drug among many other drug candidates that proved effective against the human HIV virus
- Dr. Le-F, I understand that you believe you made an inventive contribution and deserve to be named as an inventor on this patent application
- Can you explain?



Inventor Interview (cont'd)

Dr. Le-F:

- I am the founder of the Le Forestier Institute in Paris, France which is devoted to making medical breakthroughs and includes HIV related testing
- I learned of U.S. Patent No. '999 after it granted, noticed that the inventorship did not include me
- Our laboratory, which I manage, is the only one in the world that employs “live” human HIV viruses for use to test candidate drugs for the treatment of AIDS
- Our laboratory skill is far above a “person of ordinary skill in the art” as we are the *only laboratory in the world* that possesses this skill at all



Inventor Interview (cont'd)

Dr. Le-F:

- Our laboratory tests are the only tests that can truly determine whether a drug is effective against the human HIV virus
- I personally designed the tests and together with my colleagues obtained the necessary equipment and biological materials for our laboratory
- Our laboratory was asked by the presently named inventors of Patent '999 to test a number of candidate drugs for effectiveness, as the inventors had no idea which candidate would work or which would be the most effective



Inventor Interview (cont'd)

Dr. Le-F:

- They desperately needed experimental confirmation from our lab, as they simply did not have the means to test AZT on live human HIV virus
- If not for our lab test results which helped them select AZT, they would have not known for years which of their drug candidates to pursue
- Therefore, I firmly believe that I should be a named inventor

AM: Thank you Dr. Le-F for your helpful information. I will get back to you about my inventorship determination.



Inventor Interview (cont'd)

Inventorship analysis:

- Claimed invention: method of treating AIDS by administering the drug AZT to a patient
- Named inventors of Patent '999 knew structure and how to make AZT and other drug candidates
 - but named inventors did not know which, if any, drug candidates, including AZT, would be effective
- Dr. Le-F provided experimental confirmation that AZT was effective, and appeared to help in the selection of AZT as the preferred drug
- **Was Dr. Le-F an inventor?**
 - See *Burroughs Wellcome v. Barr Labs* decision above

