

WILL THE REAL INVENTOR PLEASE STAND UP

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The good news: there has been an invention and it looks like it's commercially valuable and is probably going to be patentable. The bad news: it's your job to figure out who should be named as an inventor on the patent application. Test your knowledge - or your instincts - in what has been called "One of the muddiest concepts in the muddy metaphysics of the patent law." Which of the following (if any!) can rightfully claim to be a true inventor of the invention?

1. The person who originally identified the very problem solved by the invention.
2. The project manager who led the research effort and authorized the necessary budget funding.
3. The person who noticed the idea sitting lost and forgotten in an old laboratory notebook.
4. The person who first truly understood how the invention works, and explained it to everyone else.
5. The lab book author who conceived the invention, that is, the one who had formed the idea of the invention as it was eventually to be applied in practice, but merely wrote it down and then, when it was spotted by person No. 3, was pretty testy in giving instructions to a colleague for actually building the device.
6. The colleague who followed No. 5's instructions and built the device.
7. The stick-your-nose-in-where-it-doesn't-belong guy from the next office who suggested an obvious "improvement" to the prototype. ("Hey, when we go to mass production, why not make those tires out of reinforced rubber!")

Thomas Edison is often quoted as having said, "Invention is 10% inspiration and 90% perspiration." But in the eyes of the United States patent laws, only that 10% part of the effort gets your name on a patent. That's right - person No. 6 above, who contributed the all perspiration, gets a bonus at year-end, but is not a named inventor on the patent.

Good news: the stick-your-nose-in-where-it-doesn't-belong guy No. 7 does not get named as an inventor either (most of the time). Person No. 2, the project manager, is out too (although sometimes this needs to be explained diplomatically, and more than once, to the manager).

Take your hat off to the visionary, person No. 1, who originally identified the very problem solved by the invention, but don't name him or her on the patent. And person No. 3 may be a very great benefactor to humanity, having salvaged an idea sitting lost and forgotten in an old laboratory notebook, but he's not an "inventor" down at the US

Patent Office. He merely “derived” the invention from someone else, the author of the lab book.

The bright guy who first truly understood how the invention works, and explained it to everyone else, person No. 4, gets the annual brainiac award, but no patent. Since the lab book author has conceived a workable version or “operative embodiment” of an invention, it was good enough that he or she knew *that* it works; knowing *how* it works in this case is nice but not necessary.

So, that leaves us with the lab book author, person No. 5 – the armchair daydreamer who is long on ideas but never around for the heavy lifting. Good for you if this was your choice for the true inventor.

Joint Inventors

A further word about our stick-your-nose-in-where-it-doesn't-belong guy. If his contribution had not been merely an obvious added feature or variation, he might have qualified as a joint inventor. Certainly, if that new contribution is good enough to call out in one or more of the claims of the patent application, this would likely be the case. Two people can be joint inventors even if they do not physically work together or at the same time. Also, joint inventors don't have to make the same type or amount of contribution. These rules of joint invention recognize the reality of modern organized research efforts, since an invention will often be worked on at different times and by different people in the course of a corporate R & D program.

Remember, however, that “*conception* is the touchstone of inventorship.” Each joint inventor must generally contribute to the conception of the invention. Conception is defined by the courts as “the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice.” An idea is sufficiently “definite and permanent” when “only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.” The conceived invention must include every feature of the subject matter claimed in the patent.

OOPS!!! Inventor Misjoinder

Mistakes happen. Sometimes an inventor is inadvertently omitted from a patent application, or someone is named as an inventor who actually is not one. Generally, this can be fixed. That is, a patent is not invalid when inventor misjoinder occurs, unless the misjoinder occurred with deceptive intent. If there was no deceptive intent in naming a non-inventor as an inventor or in failing to name someone who is an inventor, the mistake can be fixed almost any time. The named inventors can be corrected before the patent issues, that is, while it is still pending as an application in the US Patent Office. It can also be corrected after the patent issues. It can even be corrected during litigation, unless

the patent owner has acted in a way that creates laches or an estoppel. (Laches and estoppel: a whole ‘nuther topic for a different day.)

A word of caution about “deceptive intent.” The standard applied by the courts in determining whether inventor misjoinder occurred without deceptive intent can be strict. Two “joint inventors” recently discovered this, to their great dismay. They had started a business as equal partners. Split everything right down the middle. Shared the hours. Shared the work. Shared the profits. They had a good product idea that they built their business on, and they decided to patent it. Eventually, the time came when they needed to assert the patent to protect their business.

That’s when they discovered that their admirable share-and-share alike philosophy had gotten them into trouble. They were both named as inventors on the patent. They admitted in the litigation, however, that only one of them had come up with the idea. When they filed the patent application, they named themselves both as inventors, since that fit the “share everything” way they ran the business. The court held that the patent was invalid on the ground of inventor misjoinder! They were not allowed to fix the misjoinder, because the court ruled that it had occurred **with deceptive intent**. Even though the two partners had not intended to cheat anyone, they had named themselves both as inventors knowing that only one of them really was a true inventor. (This is an especially sad ending, because there were good ways to accomplish the desired all-for-one result, without jimmying the inventorship!)

Getting back to Thomas Edison, he’s said to be a named inventor on approximately one thousand patents. He ran his own laboratory for years with a number of assistants all busy inventing things. Now that we’ve reviewed “one of the muddiest concepts in the muddy metaphysics of the patent law,” I sometimes wonder if old Tom was always our person No. 5, or maybe was sometimes actually a person No. 1, or a person No. 2, or . . .