

Intellectual Property Newsletter

Summer 2009

Volume 2, Issue 2

INVENTORSHIP BASICS

The US patent statute, 35 U.S.C. §116 requires that joint inventors must apply for the patent jointly. However, when several people work together to develop a new product, it is often difficult to determine who should be listed as inventors. Yet, the decision may have important consequences.

Inventorship often affects ownership rights if all of the rightful inventors are not obligated to assign invention rights to the same party, such as to a common employer. In other situations, the listed inventorship may affect royalty or compensation issues. Importantly, however, the listed inventorship must be legally accurate. An improper listing of inventors can be corrected under some circumstances if done timely, but renders the patent invalid if not. So, under the law, how does one go about determining who should be listed as an inventor?

The first fundamental concept to understand is that the inventive process generally includes two steps: conception of the invention and its reduction to practice. Conception is the formulation in the mind of the inventor(s) of a definite and permanent idea of a complete and operative invention as it is thereafter applied in practice. An idea is sufficiently definite and permanent when no more than ordinary skill in the art is necessary to reduce the invention to practice without undue research or experimentation. To be an

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Federal Circuit Rules on Joint Inventorship of Dependent Claims

Earlier this year, the Court of Appeals for the Federal Circuit had a chance to clarify the bounds of joint inventorship as it pertains to dependent patent claims. Essentially, the Federal Circuit held that not all dependent claims are created equally.

In Nartron Corp. v. Schukra USA, Inc., 588 F.3rd 1352 (Fed. Cir. 2009), the Court considered the issue of joint inventorship in a situation where an assertion of inventorship is based solely on subject matter defined in a dependent claim. The Court ruled that one is not co-inventor when the contribution is no more than explaining to the real inventors concepts known in the prior art, even though that concept may be the subject of a dependent claim.

The underlying facts in the Nartron case were not all that unusual. Schukra, a supplier of automobile seats with lumbar support systems, had contracted with Nartron to design a control module for the automobile seats. Nartron filed a patent application for the control module, but did not include a Schukra employee (Benson) as a listed inventor. Later, Borg Indak began supplying com-

ponents to Schukra, and Nartron sued Borg Indak for contributory patent infringement. Borg Indak moved to dismiss the suit for failure to join Benson as a co-inventor because he was the purported inventor of the subject matter defined in dependent claim 11, which required "an extender 30" for the lumbar support adjustor. Benson had no part in inventing the control module that was the main focus of the disclosure, and admitted that "the extender 30" was already in the prior art.

The Court of Appeals for the Federal Circuit rejected the notion that Benson was a co-inventor for three main reasons.

Firstly, one who provides inventors with only well known principles in the art is not considered to be an inventor. Benson told the Nartron inventors that including "an extender" for the lumbar support adjustor would enhance the seat's features, but he did not describe how it could be connected to or implemented with the control module that the Nartron inventors were working on. Secondly, when the Court measured

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Nartron—Joint Inventorship

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Benson's contribution to the invention against the dimension of the full invention, namely the control module, Benson's contribution was insignificant in comparison. Nartron's patent as a whole focused on the structure and function of the seat control module and not on the structure of the seat itself. In fact, the entire patent specification mentioned "the extender 30" only once, and referred to the extender only as background technology upon which the control module could work. The Court further explained that this was not a case where Benson had suggested a non-obvious combination of prior art elements to the real inventors.

The Court also noted that a dependent claim adding one claim limitation to a parent claim is still a claim to the invention of the parent claim, albeit with the added feature; and not a claim to the added feature in and of itself. Thus, the addition of "the extender" for the lumbar support adjustor in the dependent claim was looked at in light of the other claims from which it depended. If Benson did not contribute to those inventions, the

Court ruled that he did not attain the status of co-inventor merely by providing the sole feature of a dependent claim.

Finally, the Court emphasized that one is not an inventor when he or she merely suggests an idea for a result to be accomplished or attained rather than means of accomplishing it. For example, an entrepreneur's request to another to create a product that will fulfill a certain function is not conception - even if the entrepreneur supplies continuous input on the acceptability of offered products. That sort of suggestion and feedback is not enough to be included as a co-inventor.

The Nartron case does not provide a bright line test for determining scope of inventorship when addressing dependent claims which may be slightly more "significant" to the main invention than in the Nartron case. However, under Nartron, one should not be listed as a co-inventor if his or her sole contribution is the suggestion of subject matter in a dependent claim that does not significantly add to the main invention and merely describes something in the prior art. In other words, applicants need to take a close look at the contributions of any purported inventor who contributed only to a dependent claim.

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inventor, one must contribute in some significant manner to the conception or reduction to practice of the invention. One's contribution to the claimed invention cannot be insignificant in quality when measured against the full dimension of the invention.

It is not necessary that the entire inventive concept occurs to each of the joint inventors, or that the two inventors physically work together or at the same time on the project. For example, one of the joint inventors might do more hands-on experimental work while the other researches and makes suggestions from

time to time. Joint inventors need not make the same type or amount of contribution. 35 U.S.C. §116.

Inventorship is determined on a claim-by-claim basis. To be an inventor, one must have made a significant contribution in the final conception or reduction to practice of the invention described by the claim. Therefore, the determination of inventorship relies on the scope of the issued patent claims. For this reason, claim amendments made during prosecution, including the addition and cancellation of claims, may require that the listed inventorship be changed before the patent issues.

It is not necessary for each inventor to contribute to the subject matter of every claim in the patent. 35 U.S.C. §116. Therefore, in some circumstances, the

legally proper inventive entity can be adjusted (intentionally or unintentionally) by changing the scope of the patent claims in a pending patent application.

As a side note, the Court of Appeals for the Federal Circuit has held that it is not normally appropriate for an inventor's patent attorney to be listed as an inventor even if the patent attorney was instrumental in helping the inventor(s) articulate, formulate and expand on their inventive concept. "An attorney's professional responsibility is to assist his . . . client in defining her invention to obtain, if possible, a valid patent with maximum coverage. An attorney performing that role should not be a competitor of the client, asserting inventorship as a result of representing his client." Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1382 (Fed. Cir. 2000).