

Inventorship

It is important to correctly identify the inventor or inventors of the invention claimed in a patent application. Willfully naming someone as an inventor who is not or failing to name someone who is an inventor can be grounds for invalidating any patent granted on the invention. Ownership of the invention or patent is a separate matter from inventorship and can be handled by an assignment of the patent rights.

In determining the correct inventors, you should first consider who contributed to the conception of the invention. Invention begins with the conception of an idea followed by reducing it to practice. Reduction to practice is the process of making and testing the invention to produce a working concept. However, once a definite and permanent idea of the complete operative invention is fully developed, even if only in the mind(s) of the inventor(s), the invention may be complete at that point without further research and experimentation being required. Filing a patent application can be construed as reducing an invention to practice. The conception of an invention may have occurred in the mind of one person or of more than one person. If the conception of the invention occurred jointly, it is not necessary for the joint inventors to have physically worked together on the invention, or to have worked on the invention at the same time. It is also not necessary that the joint inventors made the same amount or type of contribution to the invention. However, to be a joint inventor, an individual must have made a contribution that is not insignificant in quality when that contribution is measured against the dimension of the full invention. One who merely carried out routine tasks at the direction of the inventor or one who supervised the inventor without contributing to the invention would not be an inventor. The invention may have been conceived by one person, but others may have suggested variations or elaborations on the invention as first conceived. If these suggestions would have been merely the exercise of ordinary skill in the art, then the suggestions would not rise to the level of joint invention. Also, evaluating an invention for performance in an established system, while necessary, is not deemed to be an inventive step.

Errors in determining the inventors may be corrected if the error occurred without deceptive intent. Nevertheless, it is still important to determine the correct inventors. When considering the appropriate persons who should be included as inventors, it is important to focus on the claims presented in the patent application. Carefully examine each of the claims. It is possible for a person to be an inventor as to some of the claims but not others. To be listed as an inventor in a patent application, one must have contributed to the conception of at least one claim in the application. When claims are amended or cancelled, it is important to review and determine whether one who was originally an inventor may no longer be an inventor as to any of the pending claims in the application. If this situation occurs, that person may no longer be shown as an inventor and must be deleted from the application. It is possible to file a provisional patent application without any claims. In that situation, the determination of the correct inventors should be made with respect to the subject matter "disclosed" in the application rather than with respect to the invention "claimed" in the application.

If you have any questions about the meaning of inventorship, please contact us to discuss this further.