

Chapter 4

Inventorship

In awarding patent rights, the Constitution speaks in terms of promoting “the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” In the US, unlike in Europe and many other parts of the world, patent rights are given to inventors. Inventors may then, in turn, assign their rights to an employer or sell them to another individual or company. This chapter answers the question, who is an inventor?

Standards of Inventorship

The standard for inventorship under US law is to make a contribution to at least one claim in an allowed patent.

As long as the inventor maintains intellectual domination over the invention, others may contribute and not be inventors. To illustrate this point, we turn again to Dr. Evil—this time he has the idea of attaching laser beams to the heads of sharks. Are his minions who perform the day-to-day experimentation in the shark tank co-inventors? Not necessarily. Assume that they have merely acted under the direction and supervision of Dr. Evil. In this case, they would not have had inventive contribution. However, if one of the researchers came up with the idea that a particular type of laser was better for underwater use, and that specific laser was claimed in at least one of

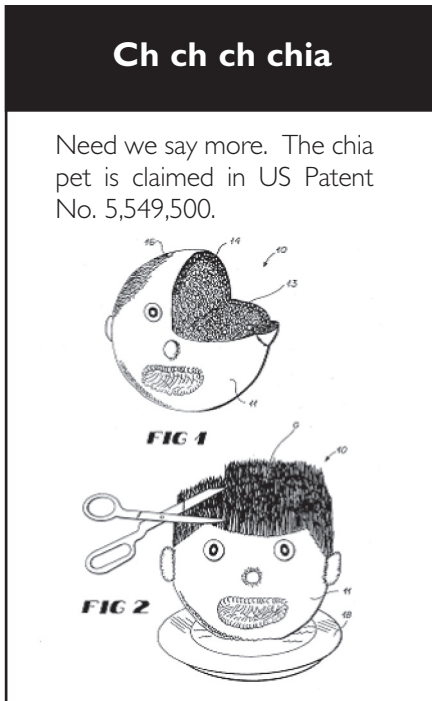
the claims in the granted patent, then that researcher would be listed as a co-inventor.

Joint Inventorship

Today, inventions often take place through the combined efforts of researchers, sometimes at different places and at different times. While the amounts or types of contributions the researchers make may differ, as long as contributions to the subject matter of at least one claim occur, the researchers should be listed as inventors.

First to Invent

US patent law differs from European law and that of many other major industrial countries in another important respect. In Europe, it is a race to the patent office where the first to file is the winner. By contrast, in the US, patents are awarded to the first to invent. This may not be the first to file.



Section 102(g) of the Patent Act has two subsections that provide that a person is entitled to a patent unless there is either: (1) an earlier invention date for the same invention established in an “interference;” or (2) an earlier invention made by another person in the US.

An interference is a formal proceeding conducted by the Board of Patent Appeals and Interferences in the USPTO. Through the submission of evidence, often including laboratory notebooks, the Board reaches a determination of who was the first to invent and, accordingly, the inventor

entitled to patent rights. Section 102(g)(2) disputes are often resolved in court. Interference and other adversarial proceedings are discussed in Chapter 7, “Patent Disputes.”

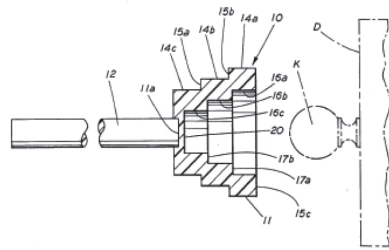
For either of the two subsections of 102(g) to apply, the invention must not have been suppressed, concealed or abandoned. Additionally, for an earlier inventor to prevail in a first-to-invent contest, the inventor must have acted with diligence between conception and when the invention was reduced to practice. Conception is the moment when the inventor has a flash of creative brilliance, the “Eureka!” moment where a new and useful idea formed. Reduction to practice can be the act of filing a patent application; it does not necessarily require actually making and selling a commercial product.

To establish diligence, reasonable delays—for example, time needed to order and receive ingredients or to enter into a confidentiality agreement before retaining an independent testing laboratory—are generally permissible. However, lengthy vacations, prolonged illness or business reasons—reallocating research priorities or budget reallocations, for example—do not excuse failure to act diligently.

The first-to-file rule under Section 102(g) is the easiest to understand with a simple timeline where two inventors, A and B, both file patent applications for the same invention (see **Table 4.1**).

The Littlest Inventor

Perhaps the youngest inventor to be granted a patent was a four-year-old from Houston, Texas. On August 3, 1993, USPN 5,231,733 was issued to Sydney C. Dittman for an implement meant to help physically disabled people grasp round door knobs.



Source: USPN 5,231,733