

⁴ 35 U.S.C. § 101.

⁵ *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 26 USPQ2d 1572, 1582 n.2(Fed. Cir. 1993).

⁶ *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998).

⁷ *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998); *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997); *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 32 USPQ2d 1915 (Fed. Cir. 1994). To be a joint inventor, one must contribute to the conception of an invention. *Pro-Mold & Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996). Determining inventorship is nothing more than determining who conceived the subject matter at issue, whether that subject matter is recited in a claim in an application or in a count in an interference. *Sewall v. Walters*, 21 F.3d 411, 30 USPQ2d 1356 (Fed. Cir. 1994). This case came to the court in the context of an originality contest as opposed to a priority context. In an originality case the issue is not who is the first or prior inventor, but who made the invention. The inventorship issue to be decided is merely who conceived the invention for which patent protection is sought, and not who first conceived that invention.

⁸ *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998); *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997); *Sewall v. Walters*, 21 F.3d 411, 30 USPQ2d 1356 (Fed. Cir. 1994).

In practice, patent examiners do not normally engage in determination of the respective contributions of the individual members of an inventive entity as part of making an ex parte examination; rather, it is the responsibility of the applicants and their attorneys to ensure that the inventors named in a patent application are the only true inventors. Inventorship is relevant to patentability under 35 U.S.C. § 102(f), and patents have in the past been held unenforceable for failure to correctly name inventors in cases where the named inventors acted in bad faith or with deceptive intent.⁹

⁹ *Board of Ed. ex rel. Bd. of Trustees of Florida State Univ. v. American Bioscience Inc.*, 333 F.3d 1330, 67 USPQ2d 1252 (Fed. Cir. 2003).

In case of death or incapacity, the inventor's legal representatives may make and prosecute the patent application.¹⁰ And one entitled to the patent by contract or operation of law may, under certain circumstances, apply for and obtain the patent if the inventor cannot or will not.¹¹

¹⁰ 35 U.S.C. § 117.

¹¹ 35 U.S.C. § 118.

§ 9.1(a)(ii) Joint Inventorship

The first paragraph of 35 U.S.C. § 116 provides that:

When an invention is made by two or more persons jointly, they shall apply for patent jointly.... Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

Consequently, a patent is invalid if more or fewer than the true inventors are named. Because a patent is presumed valid under 35 U.S.C. § 282, there follows a presumption that the named inventors on a patent are the true and only inventors. When two or more persons jointly invent, they must jointly apply for a patent even though they did not physically work together or at the same time, each did not make the same type or amount of contribution, or each did not make a contribution to the subject matter of every claim of the patent. Because conception is the touchstone of inventorship, each joint inventor must contribute in some significant manner to the conception of the invention. An inventor may solicit the assistance of others when perfecting the invention without “losing” any patent rights. Because co-inventors need not contribute to the subject matter of every claim of the patent, inventorship is determined on a claim-by-claim basis. Moreover, the inventorship analysis, like an infringement or invalidity analysis,

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first requires the construction of each disputed claim to determine the subject matter encompassed thereby. The second step is a comparison of the alleged contributions of each asserted co-inventor with the subject matter of the correctly construed claim to determine whether the correct inventors were named. Alleged co-inventors must establish their co-inventorship by facts supported by clear and convincing evidence. To meet the burden of clear and convincing evidence, the alleged co-inventors must prove their contribution to the conception of the invention with more than their own testimony concerning the relevant facts. Whether the co-inventor's testimony has been sufficiently corroborated is evaluated under a rule of reason analysis, which requires that an evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached. Corroborating evidence may take many forms. Reliable corroboration preferably comes in the form of records made contemporaneously with the inventive process. Circumstantial evidence of an independent nature may also corroborate. Additionally, oral testimony from someone other than the alleged inventor may corroborate.¹² To the extent that fewer than the true inventors are named on a patent, the patent may be corrected to so reflect as long as the nonjoinder was done without deceptive intent on the part of the person erroneously left off the patent.¹³

¹² *Gemstar-TV Guide Int'l Inc. v. United States ITC*, 383 F.3d 1352, 72 USPQ2d 1609, 1630–31 (Fed. Cir. 2004).

¹³ *Trovan Ltd. v. Sokymat SA*, 299 F.3d 1292, 63 USPQ2d 1865, 1870 (Fed. Cir. 2002).

Section 116 is the statutory locus of joint inventorship doctrine. It provides that a person not listed on a patent need not demonstrate that he or she made a contribution equal in importance to the contribution made by the listed inventors to claim a right to joint inventor status. In fact, § 116 sets no explicit lower limit on the quantum or quality of inventive contribution required for a person to qualify as a joint inventor. However, a long line of decisions holds that a person is a joint inventor only if he or she contributes to the conception of the claimed invention. The line between actual contributions to conception and the remaining, more prosaic contributions to the inventive process that do not render the contributor a co-inventor is sometimes a difficult one to draw. Contributions to realizing an invention may not amount to a contribution to conception if they merely explain what was then state of the art, if they are too far removed from the real-world realization of an invention, or if they are focused solely on such realization. It is, however, uncontroversial that the alleged joint inventor seeking to be listed on a patent must demonstrate that his or her labors were conjoined with the efforts of the named inventors. Joint inventorship under §

116 can only arise when collaboration or concerted effort occurs—that is, when the inventors have some open line of communication during or in temporal proximity to their inventive efforts. What is clear is that the statutory word “jointly” is not

mere surplusage. For persons to be joint inventors under § 116, there must be some element of joint behavior, such as collaboration or working under common direction, one inventor seeing a relevant report and building upon it or hearing another's suggestion at a meeting. Joint inventorship under § 116 requires at least some quantum of collaboration or connection.¹⁴

¹⁴ *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 71 USPQ2d 1787, 1791–92 (Fed. Cir. 2004). The issue of joint inventorship is governed by § 116, which sets no explicit lower limit on the quantum or quality of inventive contribution required for a person to qualify as a joint inventor. Rather, a joint invention is simply the product of a collaboration between two or more persons working together to solve the problem addressed. The determination of whether a person is a joint inventor is fact specific, and no bright-line standard will suffice in every case. *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997). See also *Thompson v. Haynes*, 305 F.3d 1369, 64 USPQ2d 1650 (Fed. Cir. 2002). People may be joint inventors even though they do not physically work on the invention together or at the same time, and even though each does not make the same type or amount of contribution. The statute does not set forth the minimum quality or quantity of contribution required for joint inventorship. *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 32 USPQ2d 1915 (Fed. Cir. 1994).

Because co-inventors need not make a contribution to the subject matter of every claim of the patent, inventorship is determined on a claim-by-claim basis. Moreover, an inventorship analysis, like an infringement or invalidity analysis, begins as a first step with a construction of each asserted claim to determine the subject matter encompassed thereby. The second step is then to compare the alleged contributions of each asserted co-inventor with the subject matter of the properly construed claim to then determine whether the correct inventors were named.¹⁵

¹⁵ *Trovan Ltd. v. Sokymat SA*, 299 F.3d 1292, 63 USPQ2d 1865 (Fed. Cir. 2002). Furthermore, a co-inventor need not make a contribution to every claim of a patent. A contribution to one claim is enough. *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998).

Thus, a patented invention may be the work of two or more joint inventors. Because conception is the touchstone of inventorship, each joint inventor must contribute in some significant manner to the conception of the invention.¹⁶ Conception is 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. Nevertheless, for the conception of a joint invention, each of the joint inventors need not make the same type or amount of contribution to the invention. Rather, each needs to perform only a part of the task that produces the invention. On the other hand, one does not qualify as a joint inventor by merely assisting the actual inventor after conception of the claimed invention. One who simply provides the inventor with well-known principles or explains the state of the art without ever having a firm and definite idea of the claimed combination as

a whole does not qualify as a joint inventor. Moreover, depending on the scope of a patent's claims, a

PHOSITA who simply reduced the inventor's idea to practice is not necessarily a joint inventor, even if the specification discloses that embodiment to satisfy the best mode requirement. Thus, the critical question for joint conception is who conceived, as that term is used in the patent law, the subject matter of the claims at issue.¹⁷ All that is required of a joint inventor is that he or she (1) contribute in some significant manner to the conception or reduction to practice of the invention, (2) make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention, and (3) do more than merely explain to the real inventors well-known concepts or the current state of the art.¹⁸

¹⁶ *BJ Serv. Co. v. Halliburton Energy Serv. Inc.*, 338 F.3d 1368, 67 USPQ2d 1692 (Fed. Cir. 2003). See also *Stern v. Columbia Univ.*, 434 F.3d 1375, 77 USPQ2d 1702 (Fed. Cir. 2006).

¹⁷ *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998). In the case of a design patent, as in the case of utility patents, one may not qualify as a joint inventor, or as a new inventor, by merely assisting the actual inventor after conception of the claimed invention. Minor differences between the prior art and the new claim will not suffice. The differences here must be substantial and not just superficial; the new design must contain an inventive concept. The ultimate test for design-patent inventorship, like the test for anticipation and infringement, is whether the second asserted invention is "substantially similar" to the first. Substantial similarity is a question of fact. *Hoop v. Hoop*, 279 F.3d 1004, 61 USPQ2d 1442 (Fed. Cir. 2002).

¹⁸ *Pannu v. Iolab Corp.*, 155 F.3d 1344, 47 USPQ2d 1657 (Fed. Cir. 1998). See also *Caterpillar Inc. v. Sturman Indus. Inc.*, 387 F.3d 1358, 73 USPQ2d 1609, 1623 (Fed. Cir. 2004).

It is accordingly clear that if a person supplies the required quantum of inventive contribution, that person does not lose his or her status as a joint inventor just because he or she used the services, ideas, and aid of others in the process of perfecting the invention.¹⁹ However, those others may also in appropriate circumstances become joint inventors by their contributions.²⁰ A person is not precluded from being a joint inventor simply because his or her contribution to a collaborative effort is experimental. Instead, the qualitative contribution of each collaborator is the key—each inventor must contribute to the joint arrival at a definite and permanent idea of the invention as it will be used in practice.²¹ On the other hand, requesting someone to

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produce something without saying just what it is to be or how to do it is not what the patent law recognizes as invention.²²

¹⁹ *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997). An inventor may use the services, ideas, and aid of others in the process of perfecting his or her invention without losing his or her right to a patent. *Hess v. Advanced Cardiovascular Sys. Inc.*, 106 F.3d 976, 41 USPQ2d 1782 (Fed. Cir. 1997); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985). Others may provide services in perfecting the invention conceived by another without becoming an "inventor" by operation of law. *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998). The contributor of any disclosed means of a means-plus-function claim element is a joint inventor as to that claim, unless one asserting sole inventorship can show that the contribution of that means was simply a reduction to practice of the sole inventor's broader concept. *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998). In *Sewall v. Walters*, 21 F.3d 411, 30 USPQ2d 1356 (Fed. Cir. 1994), the court refused to recognize one worker as a joint inventor where he only designed circuits to carry out the other worker's idea and where that design effort was simply the exercise of the normal skill expected of an ordinary circuit designer.

²⁰ *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997).

²¹ *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 32 USPQ2d 1915 (Fed. Cir. 1994). The doctrine of simultaneous conception and reduction to practice states that, in some instances, an inventor may only be able to establish a conception by pointing to a reduction to practice through a successful experiment. But it applies to the entire invention and is used to resolve priority disputes. It cannot be used, in a dispute concerning joint inventorship, to show that because the first person did not conceive or reduce to practice the entire claimed invention, that person did not at least contribute in some significant way to the ultimate conception. *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997).

²² *Morgan v. Hirsch*, 728 F.2d 1449, 221 USPQ 193 (Fed. Cir. 1984).

Any joint inventor is free to make, use, or sell the invention in the absence of an agreement to the contrary.²³ A sole inventor (A) and joint inventors (A and B) are separate legal entities, a legal proposition from which certain legal consequences flow, such as who must apply for a patent.²⁴

²³ *Harrington Mfg. Co. v. Powell Mfg. Co.*, 815 F.2d 1478, 2 USPQ2d 1364 (Fed. Cir. 1986). An inventor of one or more claims of a patent is an owner of all claims of the patent. *Lucent Tech. Inc. v. Gateway Inc.*, 543 F.3d 710, 88 USPQ2d 1481, 1489 (Fed. Cir. 2008). A joint inventor as to even one claim enjoys a presumption of ownership in the entire patent. This rule presents the prospect that a co-inventor of only one claim might gain entitlement to ownership of a patent with dozens of claims. Where inventors choose to cooperate in the inventive process, their joint inventions may become joint property without some express agreement to the contrary. *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998).

²⁴ *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). When an invention is the work of several inventors, they must jointly apply for the patent. *Acromed Corp. v. Sofamor Danek Group Inc.*, 253 F.3d 1371, 59 USPQ2d 1130 (Fed. Cir. 2001).

§ 9.1(a)(iii) Correction of Inventorship

The third paragraph of § 116 provides for correction of inventorship error in a pending application, where the error arises without any deceptive intention.²⁵ The 1984 amendments to 35 U.S.C. § 116 made it clear that each joint inventor need not have made a contribution to the subject matter of every claim of a patent.²⁶ But the 1984 amendments to § 116 did not eliminate collaboration as a requirement for joint invention. Thus, a patent issued to a later inventor cannot be corrected to include the name of an earlier inventor (and thereby to obtain the benefit of the earlier invention date), even one within the

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same organization, where the work of the earlier inventor was unknown to the later inventor at the time of the later invention.²⁷

²⁵ *Stark v. Advanced Magnetics Inc.*, 119 F.3d 1551, 43 USPQ2d 1321 (Fed. Cir. 1997). A jury instruction that indicates that the patent must be found invalid if the inventor was not the actual and only inventor is an

oversimplification, in that it does not recognize the possibility of curing improper inventorship. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985). This case also indicated that it was not incumbent upon the patentee to disclaim, during the course of litigation, claims that were subject to a controverted inventorship challenge. See 35 U.S.C. § 253. The interpretation of 35 U.S.C. § 116 is a question of law freely reviewable on appeal. *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 23 USPQ2d 1921, 1925 (Fed. Cir. 1992). A petition to correct inventorship may be filed during reissue proceedings. *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998).

²⁶ *Smithkline Diagnostics Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 8 USPQ2d 1468 (Fed. Cir. 1988). The amendments are not (by the enacting statute) retroactively applicable in litigation pending the date of enactment. Nonetheless, in an interesting bit of jurisprudence, the court effectively applied them retroactively on the following basis: there was a split among the circuits prior to the 1984 amendments—the “All Claims” Rule was not uniformly accepted as the substantive law at that time. Inasmuch as it is doubtful that Congress intended the nonretroactivity provision of the enabling act to give a litigant a right to invoke the law of a particular circuit where there are conflicts on an issue, the nonretroactivity provision of the enacting statute does not negate the applicability of amended § 116 in cases pending on the 1984 enactment date.

²⁷ *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 23 USPQ2d 1921 (Fed. Cir. 1992). See *Checkpoint Sys. Inc. v. United States ITC*, 54 F.3d 756, 35 USPQ2d 1042 (Fed. Cir. 1995), for a situation involving a possible joint invention that became part of the prior art under § 102(g), thus precluding correction of a later-issued patent to one of the inventors.

Closely related to § 116 is 35 U.S.C. § 256. The difficulty of determining legal inventorship has been recognized, and, to avoid inadvertent invalidity, § 256 permits correction of the designated inventorship of a patent.²⁸ Before the enactment of § 256, patentees and their assignees committed inventorship errors at their peril; misjoinder or nonjoinder of an inventor rendered the patent invalid. Section 256 affords the opportunity to correct the patent. If the patentees and their assignees agree, correction can be had on application to the PTO Commissioner. In the event agreement is not attained, however, the second paragraph of § 256 permits redress in federal court.²⁹ A § 256 action is one that is purely equitable and, standing alone, not subject to trial by jury.³⁰

²⁸ *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998). Section 256 creates a cause of action in the district courts only to modify inventorship on issued patents, not on pending patent applications. *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 71 USPQ2d 1787, 1790 n.1 (Fed. Cir. 2004).

²⁹ *MCV Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 10 USPQ2d 1287, 1289 (Fed. Cir. 1989). The standards of the first paragraph of § 256 relating to misjoinder and nonjoinder apply to both the PTO Commissioner and the courts. *Stark v. Advanced Magnetics Inc.*, 119 F.3d 1551, 43 USPQ2d 1321 (Fed. Cir. 1997). The language of § 256 is not broad enough to be read as giving a district court authority to order the Director to change the order of inventors on an issued patent. Nor is § 255, which contemplates correction of other types of mistakes on an issued patent. *Fina Tech. v. Ewen*, 265 F.3d 1325, 60 USPQ2d 1314 (Fed. Cir. 2001).

³⁰ *Shum v. Intel Corp.*, 499 F.3d 1272, 83 USPQ2d 1933 (Fed. Cir. 2007).

In the case of nonjoinder, there is another potential ground for invalidity independent of § 116 and 256. Section 102(f) mandates that a patent accurately list the correct inventors of a claimed invention.

Accordingly, if nonjoinder of an actual inventor is proved by clear and convincing evidence, a patent is rendered invalid. However, in cases of nonjoinder the operation of § 102(f) is ameliorated by § 256. This section is a savings provision. If a patentee demonstrates that inventorship can be corrected as provided for in § 256, a district court must order correction of the patent, thus saving it from being rendered invalid. When a party asserts invalidity under § 102(f) due to nonjoinder, a district court should first determine whether there exists clear and convincing proof that the alleged unnamed inventor was in fact a co-inventor. Upon such a finding of incorrect inventorship, a patentee may invoke § 256 to save the patent from invalidity. Accordingly, the patentee must then be given an opportunity to correct inventorship pursuant to that section. Nonjoinder may be corrected on notice and hearing of all parties concerned and upon a showing that the error occurred without any deceptive intent on the part of the unnamed inventor. But a patent with improper inventorship does not avoid invalidation simply because it might be corrected under § 256. Rather,

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the patentee must claim entitlement to relief under the statute and the court must give the patentee an opportunity to correct the inventorship. If the inventorship is successfully corrected, § 102(f) will not render the patent invalid. On the other hand, if the patentee does not claim relief under the statute and a party asserting invalidity proves incorrect inventorship, the court should hold the patent invalid for failure to comply with § 102(f).³¹

³¹ *Pannu v. Iolab Corp.*, 155 F.3d 1344, 47 USPQ2d 1657 (Fed. Cir. 1998).

It is said that the purpose of § 256 is to provide a remedy for a bona fide mistake in inventorship.³² However, § 256 allows deletion of a misjoined inventor whether the error occurred by deception or by innocent mistake. The statute also allows addition of an unnamed actual inventor, but the error of nonjoinder cannot betray any deceptive intent by that inventor. In other words, correction is available in all misjoinder cases where there is an error and in those nonjoinder cases where the unnamed inventor is free of deceptive intent.³³ In the absence of fraud or deceptive intent, the correction of inventorship does not affect the validity or enforceability of the patent for the period before correction, including the question of ownership and standing to sue.³⁴

³² *Stark v. Advanced Magnetics Inc.*, 29 F.3d 1570, 31 USPQ2d 1290 (Fed. Cir. 1994).

³³ *Stark v. Advanced Magnetics Inc.*, 119 F.3d 1551, 43 USPQ2d 1321 (Fed. Cir. 1997). Here the nonjoined inventor was alleging that his collaborators deliberately and fraudulently omitted him as an inventor. Thus the court rejected the collaborators' argument that their own deceptive intention would prevent correction of inventorship. Only if the nonjoined inventor had deceptive intention would this be so. The majority of this 2–1 panel worried about the consequences of its permitting correction of inventorship where the named inventors may have had fraudulent intention in leaving off the nonjoined inventor. It concluded, as in *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 32 USPQ2d 1915 (Fed. Cir. 1994), that the patent may well be unenforceable for inequitable conduct when any co-inventors are omitted with deceptive intention. It also supposed that the patent would be unenforceable even by the innocent nonjoined inventor, despite the fact that this issue was neither ripe nor presented. As it said, one bad apple spoils the entire barrel. Thus, although the nonjoined inventor might have a state law fraud claim against the listed inventors, the patent would not be enforceable by anybody. See also *Frank's Casing Crew & Rental Tools Inc. v. PMR Tech. Ltd.*, 292 F.3d 1363, 63 USPQ2d 1065 (Fed. Cir. 2002); *University of Colorado Found. v. American Cyanamid Co.*, 196 F.3d 1366, 52 USPQ2d 1801 (Fed. Cir. 1999). In *PerSeptive Biosystems Inc. v. Pharmacia Biotech Inc.*, 225 F.3d 1315, 56 USPQ2d 1001 (Fed. Cir. 2000), the court affirmed a conclusion of inequitable conduct based upon the trial court's finding of a persistent pattern, during prosecution, of intentional falsehoods, misrepresentations, and nondisclosures on the part of the named inventors regarding the matter of inventorship. Compare *Winbond Elec. Corp. v.*

United States ITC, 262 F.3d 1363, 60 USPQ2d 1029 (Fed. Cir. 2001).

³⁴ *Viskase Corp. v. American Nat'l Can Co.*, 261 F.3d 1316, 59 USPQ2d 1823 (Fed. Cir. 2001).

The principles of jurisdiction applicable to declaratory judgment suits are not implicated in inventorship disputes; the cause of action is itself created by 35 U.S.C. § 256, which explicitly authorizes judicial resolution of co-inventorship contests over issued patents. Thus, a suit for determination of co-inventorship and consequent correction of a patent arises under the patent law.³⁵ However, declaratory

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judgment jurisdiction is evaluated by applying the well-pleaded complaint rule, considering the hypothetical complaint that the declaratory defendant would have brought. In the case of an action for a declaration that the inventors on a patent were properly named, this would be a complaint for correction of inventorship under § 256, which provides a cause of action to interested parties to have the inventorship of a patent changed to reflect the true inventors of the subject matter claimed in the patent. A patentee or its assignee may state a claim under this section even where there is not a consensus on the correct inventorship as long as all parties are given notice and an opportunity to be heard. Thus, a declaratory plaintiff may establish an actual controversy in this context by averring that (1) it holds a recognized interest in a patent that could be adversely affected by an action brought under § 256, and (2) another party with a right to bring an action under § 256 has created in the declaratory plaintiff a reasonable apprehension that it will do so.³⁶

³⁵ *MCV Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 10 USPQ2d 1287 (Fed. Cir. 1989). Section 256 creates a cause of action in the district courts for correction of nonjoinder of an inventor on a patent provided the nonjoinder error occurred without deceptive intent. *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 71 USPQ2d 1787, 1791 (Fed. Cir. 2004). The court has said that a federal court has no independent jurisdiction over an action seeking a declaratory judgment of inventorship. Any controversy between the parties, if one exists, can only be contractual, and the fact that a contract action may involve a determination of the true inventor does not convert that action into one arising under the patent laws. *Consolidated World Housewares Inc. v. Finkle*, 829 F.2d 261, 4 USPQ2d 1565 (Fed. Cir. 1987). Though proper inventorship may be the subject of future prosecution, it is not ancillary to priority in an interference. *DeGeorge v. Bernier*, 768 F.2d 1318, 226 USPQ 758 (Fed. Cir. 1985); *Case v. CPC Int'l*, 730 F.2d 745, 221 USPQ 196 (Fed. Cir. 1984).

³⁶ *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997).

The validity of a patent requires that the inventors be correctly named. It follows that parties with an economic stake in a patent's validity are entitled to be heard on inventorship issues once a putative inventor has sued to correct inventorship. It follows that parties with an economic stake in a patent's validity may be subject to a § 256 suit even over their objection.³⁷ An expectation of ownership of a patent is not a prerequisite for a putative inventor to possess standing to sue to correct inventorship under § 256. The statute imposes no requirement of potential ownership in the patent on those seeking to invoke it.³⁸

³⁷ *Chou v. University of Chicago*, 254 F.3d 1347, 59 USPQ2d 1257 (Fed. Cir. 2001).

³⁸ *Chou v. University of Chicago*, 254 F.3d 1347, 59 USPQ2d 1257 (Fed. Cir. 2001). Here the putative

inventor, pursuant to university policy, had a concrete financial interest in the patent, albeit an interest less than ownership. Thus, the fact that she may have been obligated to assign the invention to the university or at its direction did not destroy her standing.

Section 256 does not limit the time during which inventorship can be corrected. It thus serves the public policy of preserving property rights from avoidable forfeiture. On the other hand, equity disfavors undue and prejudicial delay by a person who may have an interest in the property of another. Synthesizing these equitable interests, the defenses of laches and estoppel have been applied in § 256 actions.³⁹ Nonetheless, diligence is not an absolute legal requisite for

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an action to correct inventorship under § 256.⁴⁰ Whether diligent action is required in a particular case must be determined on the facts of that case. Lack of diligence may be an appropriate basis for barring legal action when there is an affirmative obligation on the claimant to act promptly and without significant pause in establishing a legal right. The common law has recognized that varying degrees of diligence may be required, depending on the circumstances. For example, a higher degree of diligence is appropriate when the claimant is chargeable with injury or disadvantage to another due to the claimant's failure to act expeditiously. Thus, there are circumstances where diligence is an appropriate requisite to pursuit of a particular legal right, whether or not the defenses of laches or estoppel may be invoked against the claimant.⁴¹ Where there are several patents at issue in litigation, each is a separate chose in action. It is thus incorrect as a matter of law to hold that correction of several subsequently issued patents would be barred upon a finding of lack of diligence as to the first. This is by analogy to the law of laches, where the general rule is that the laches period does not accrue until each patent issues, even if the patents are interrelated.⁴²

³⁹ *Stark v. Advanced Magnetics Inc.*, 29 F.3d 1570, 31 USPQ2d 1290 (Fed. Cir. 1994). Laches is an equitable defense that may bar an inventorship claim. A delay of more than six years after the omitted inventor knew or should have known of the issuance of the patent will produce a rebuttable presumption of laches. In the context of an inventorship action, a plaintiff relying on the unclean hands doctrine to defeat a defense of laches must show not only that the defendant engaged in misconduct, but moreover that the defendant's misconduct was responsible for the plaintiff's delay in bringing suit. *Serdarevic v. Advanced Med. Optics Inc.*, 532 F.3d 1352, 87 USPQ2d 1481, 1484, 1486 (Fed. Cir. 2008). Equitable estoppel will apply to inventorship contests; the putative co-inventor must be diligent in acting to preserve his or her rights. *MCV Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 10 USPQ2d 1287 (Fed. Cir. 1989). See also *Advanced Cardiovascular Sys. Inc. v. Scimed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993). The fact that one joint inventor allowed his part of the invention to become prior art more than a year before the filing date apparently does not disqualify him as a joint inventor. *Pannu v. Iolab Corp.*, 155 F.3d 1344, 47 USPQ2d 1657 (Fed. Cir. 1998).

⁴⁰ *Stark v. Advanced Magnetics Inc.*, 29 F.3d 1570, 31 USPQ2d 1290 (Fed. Cir. 1994). In so holding, the court pointed out that although 37 C.F.R. § 1.48 requires diligence, that rule relates to correction of inventorship under 35 U.S.C. § 116 while an application is pending. Rule 324 (37 C.F.R. § 1.324), which implements § 256, has no express requirement for diligence.

⁴¹ *Stark v. Advanced Magnetics Inc.*, 29 F.3d 1570, 31 USPQ2d 1290 (Fed. Cir. 1994). The court held that a period from patent issuance to filing suit to correct inventorship, ranging from five months to under four years for six individual patents, did not bar the § 256 action.

⁴² *Stark v. Advanced Magnetics Inc.*, 29 F.3d 1570, 31 USPQ2d 1290 (Fed. Cir. 1994).

Even where correction of inventorship is not properly in issue, the courts have power to decree a remedy of assignment to redress wrongful appropriation of intellectual property by those subject to the court's jurisdiction.⁴³ Also, if a court concludes that a plaintiff is properly an inventor of disputed subject matter under § 256, it can direct the patent owner to take appropriate action to change the inventorship designation on corresponding foreign patent applications.⁴⁴

⁴³ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). This appears to have been a case of derivation under 35 U.S.C. § 102(f), where the defendant had wrongfully obtained a patent on the plaintiff's invention, which had been disclosed to the defendant in confidence.

⁴⁴ *Chou v. University of Chicago*, 254 F.3d 1347, 59 USPQ2d 1257 (Fed. Cir. 2001).

§ 9.1(a)(iv) Presumption of Correct Inventorship; Burden of Proof

The burden of showing misjoinder or nonjoinder of inventors is a heavy one and must be proved by clear and convincing evidence, both as to patent applications under § 116 and issued patents under § 256.

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This rule rests on important policy considerations. The inventors as named in an issued patent are presumed to be correct. The temptation for persons who consulted with the inventor and provided materials and advice, to reconstruct, so as to further their own position, the extent of their contribution to the conception of the invention is simply too great to permit a lower standard than clear and convincing evidence.⁴⁵

⁴⁵ *Hess v. Advanced Cardiovascular Sys. Inc.*, 106 F.3d 976, 41 USPQ2d 1782 (Fed. Cir. 1997). See also *BJ Serv. Co. v. Halliburton Energy Serv. Inc.*, 338 F.3d 1368, 67 USPQ2d 1692 (Fed. Cir. 2003); *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997). Patent issuance creates a presumption that the named inventors are the true and only inventors. *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 45 USPQ2d 1545 (Fed. Cir. 1998). The inventors as named in an issued patent are presumed to be correct, and the simple fact that a large number of individuals are listed does not destroy that presumption. *Canon Computer Sys. Inc v. NuKote Int'l Inc.*, 134 F.3d 1085, 45 USPQ2d 1355 (Fed. Cir. 1998). The presumption of validity embraces the notion that a patent's named inventors are the true and only inventors. A certificate of correction extends that presumption to the corrected document. Incorrect inventorship is a technical defect in a patent that may be easily curable. Rule 324 permits such an easy cure, reasonably carrying out the Director's broad authority to set standards for § 256. The presumption of validity thus extends to corrections in the listing of inventors in accordance with Rule 324. To rebut this presumption, a party challenging patent validity for omission of an inventor must present clear and convincing, corroborated evidence that the correction was improper, and therefore must bear the burden of showing that the patent is invalid under 35 U.S.C. § 102(f). *Winbond Elec. Corp. v. United States ITC*, 262 F.3d 1363, 60 USPQ2d 1029 (Fed. Cir. 2001). In *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 71 USPQ2d 1787 (Fed. Cir. 2004), the court rejected the proposition that the clear and convincing evidence standard for correction of inventorship does not apply when there are two co-pending patent applications claiming the same subject matter in front of the PTO, one of which issues as the patent allegedly omitting the inventor, and the other of which was filed by the allegedly omitted inventor. The court went to some great lengths to distinguish its prior decision in *Environ Prods. Inc. v. Furon Co.*, 215 F.3d 1261, 55 USPQ2d 1038 (Fed. Cir. 2000). Whether these distinctions will stand the test of time remains to be seen.
