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IP FRONTIERS

Inventorship: A cautionary tale

Orville and Wilbur Wright invented the airplane.

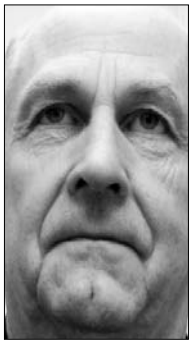
Thomas Edison invented the electric light.

Samuel F. B. Morse invented the first practical telegraph.

All achieved fame and fortune because they were inventors, and they patented their inventions.

What, then, in the eyes of the U.S. patent system, distinguishes someone as an inventor?

U.S. patents are issued to the inventor. When a patent application is filed, a property right is created. Absent any other contractual obligations, the right inures to the inventor. There is a body of patent law that defines what constitutes inventorship, and all those who fall within the definition are inventors; all those who fall outside, no matter how much work they have done, are not.



By PHILIP E. HANSEN
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To begin, inventorship is defined by the claims, not the disclosure. Let us digress for a moment to briefly review a patent.

A patent consists of basically four parts: a cover page setting forth all sorts of useful bibliographic information about the patent grant itself; some drawings of the invention; a written description of the invention and how to carry it out; and, at the very end, a bunch of numbered claims. The claims are the deed to the property and determine what the inventor can keep anyone else from doing for the next 20 years. All of those pages ahead of the claims, which are crucial in describing how to make and use the invention — the specification — are irrelevant to inventorship. Inventorship is determined solely with respect to claims in the patent application.

Each claim has an inventor or inventors. For example, consider a hypothetical patent application that describes and claims an apparatus for spinning straw into gold. The application is drafted with 20 claims. Inventors Lay and Skilling are the proper inventors of all of claims 1 through 19, while inventor Madoff added his contribution only to claim 20. In that case, if the application is filed with 20 claims, the inventorship is Lay, Skilling and Madoff. If the application is filed without claim 20 — albeit with an identical specification — the inventorship of the patent application is Lay and Skilling.

An inventor is any person who makes an intellectual contribution to a claimed invention. The person must have made an intellectual contribution that rises to the level of invention; the carrying out of an experiment designed by another, no matter how difficult and tedious, is not an inventive act. If an inventor conceives of the entire subject matter of a claim but is unable to reduce that subject matter to practice without help, the person or persons who assist the inventor in reducing the invention to practice do not become inventors by so doing, unless their contribution went beyond the skill of the ordinary artisan.

Inventorship is not a function of the size of the contribution; that is, a person may contribute 1 percent or 99 percent of the claimed invention. As long as there was any intellectual contribution, its contributor was an inventor.

Our straw-to-gold machine may provide a helpful example. Suppose inventor Lay conceives of a machine that he believes will spin straw into gold. He goes to his mechanic, Skilling, and describes the machine he wishes to have made and how it will operate. Skilling spends months securing the materials, applying his expertise and building the machine. Having completed the machine, Lay and Skilling go to their mutual friend, Madoff, who is able to provide access to a large quantity of straw that could be spun into gold. Madoff spends months setting up the test, and demonstrates that the machine generates commercially valuable quantities of gold.

Notwithstanding the months and months of effort Skilling and Madoff put into the project, neither is an inventor of a claim encompassing the machine to spin straw into gold conceived by Lay. Inventor Lay had a complete conception of the claimed invention when he approached Skilling and Madoff, each of whom applied the ordinary skill of the artisan to the already complete invention.

Suppose, however, in a slightly different scenario, that inventor Lay approached Skilling with his proposal. Skilling, upon looking at Lay's sketch, believed the machine, as configured, would not generate enough gold to attract interest. Skilling then looked at the question anew and came up with a modification that could produce investor-attracting quantities of gold. In that case, Skilling becomes a co-inventor of the claims to the improved machine because inventor Lay's conception was not complete. Without Skilling's intellectual contribution, which we will assume for the example went beyond the skill of the ordinary artisan, the invention could not have been completed.

Suppose, in a third scenario that Madoff tested the machine and found it did not generate gold at all, but rather iron pyrite. From his observations, Madoff deduced the machine still could be useful, inasmuch as iron pyrite is still a useful substance. He

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tested the machine extensively for its utility in making objects that looked like gold and found it worked for that purpose. As a result, Madoff becomes an inventor, because the Lay and Skilling's original conception was not complete (it lacked utility) without Madoff's contribution.

Finally, one must distinguish between inventorship and ownership. In third example here, we determined that Lay, Skilling and Madoff were the inventors of the successful bauble machine. Will they become rich and famous? Will they at least become rich? Maybe. That depends.

If — like the Wright brothers, Edison and Morse — they own the patent, then the answer is yes. Patents are like the deed to any other property, however: Rights to a patent can be sold at any time, including before the application is filed. Assignment of patent rights often is a condition of employment, in which case the inventors' employer might become rich, but the inventors do not necessarily become rich.

Even if our inventors were not employees, but rather freelance inventors, it may be that they had to sell a portion of their prospective rights in order to obtain funds to reduce the invention to practice or to commercialize the invention. Our inventors will become rich only if they did not assign their application to another party before its true value was known. Otherwise, they will have to settle for fame.

At the risk of gilding the lily, we can take our bauble machine example one step further and illustrate one more principle of patent law as it relates to inventorship. Suppose Madoff's clerk, Ponzi, really was the one who observed the machine's performance and conceived its utility for making baubles, and it was Ponzi who made that suggestion to his boss. Because Madoff was the titular supervisor, he, Lay and Skilling decided to give Madoff credit for the observation and conception of utility. In that case, the patent is fatally defective. A U.S. patent in which the inventorship is incorrect is invalid and, although a mistake in inventorship of a patent or application can be corrected without penalty at any time, the original (incorrect) inventorship must have been determined without deceptive intent. If there was a deliberate attempt to mislead, the error cannot be corrected and the patent remains invalid.

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