

Challenging Inventorship in Patent Litigation

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Representative Experience

- *Illinois Tool Works v. Independent Ink*. Authored an amicus curiae brief for a case that involved IP and antitrust law on behalf of the Houston Intellectual Property Law Association in the U.S. Supreme Court.
- *Microsoft Corp v. AT&T Corp*. Co-authored a U.S. Supreme Court amicus brief involving the application of 35 U.S.C. § 271(f) to software components of patented products.
- Represented oilfield services companies in several patent infringement cases involving drilling technology, blowout preventers, and casing exit systems.
- Represented companies in several other industries, such as process control systems, internet telephony services, and gift card processing, in patent infringement cases.
- Argued at two *Markman* hearings.
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I. Scope of Article

Inventorship disputes may arise in several contexts in patent litigation, and the scope of this article is to identify those contexts for the reader, discuss the law applicable to each scenario, and identify strategic options for both plaintiffs and defendants in these cases.

II. Joint Inventorship of a U.S. Patent

A. Joint Inventorship

A patented invention may be the work of two or more joint inventors.¹ As 35 U.S.C. §116 (“Inventors”) states:

(a) Joint inventions.—When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath 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.²

Because “[c]onception is the touchstone of inventorship,” each joint inventor must generally contribute to the conception of the invention.³ But as the statute makes clear, an invention may be jointly conceived even if “each of the joint inventors [does] not ‘make the same type or amount of contribution’ to the invention.⁴ Inventorship is a question of law.⁵

¹ 35 U.S.C. § 116.

² *Id.*

³ *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998) (citation omitted).

⁴ *Id.* (citing 35 U.S.C. § 116).

⁵ *Shum v. Intel Corp.*, 633 F.3d 1067, 1083 (Fed. Cir. 2010), citing *Ethicon*, 135 F.3d at 1460. The Federal Circuit has occasionally noted that underlying fact issues are important to the determination. See *Checkpoint Systems, Inc. v. All-Tag Security S.A.*, 412 F.3d 1331, 1338 (Fed. Cir. 2005) (“Inventorship is a question of law with underlying factual issues.”), citing *Bd. of Educ. v. Am. Bioscience*, 333 F.3d 1330, 1337

The Federal Circuit concisely summarized the requirements for a joint inventor in *Israel Bio-Eng’s Project v. Amgen, Inc.*:

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 and/or the current state of the art.⁶

1. Conception

“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 hereafter to be applied in practice.”⁷ “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.”⁸ The invention that is conceived must include each and every feature of the subject matter claimed in the patent.⁹

2. Significant Contribution

Section 116 “sets no explicit lower limit on the quantum or quality of inventive contribution required for a person to qualify as a joint

(Fed. Cir. 2003); *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1362 (Fed. Cir. 2004) (“Inventorship is a mixed question of law and fact: The overall inventorship is a question of law, but it is premised on underlying questions of fact.”); *Ethicon*, 135 F.3d at 1460 (“Inventorship is a question of law, which this court reviews without deference. However, this court reviews the underlying findings of fact which uphold a district court’s inventorship determination for clear error.”).

⁶ 475 F.3d 1256, 1263-64 (Fed. Cir. 2007), quoting *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998).

⁷ *Ethicon*, 135 F.3d at 1460.

⁸ *Id.*

⁹ *Id.*

inventor.”¹⁰ As a result, as noted previously, one can qualify as a joint inventor by performing only a part of the task that leads to the invention, one does not qualify as an inventor simply by helping the actual inventor after he or she has conceived the claimed invention.¹¹ Nor would one automatically become a joint inventor by merely reducing the original inventor’s idea to practice, even if the specification teaches that the embodiment reduced to practice is the best mode of the invention.¹² Even where one contributes the original idea that led to an invention, such person will not qualify as a joint inventor if the idea is “too far removed from the real-world realization of [the] invention”; it is not enough to suggest an idea or result to be accomplished, without also contributing to the means of accomplishing it.¹³ Thus, for example, “[a]n 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.”¹⁴

A co-inventor need not contribute to every claim of a patent; rather, contributing to even a single claim can be enough to qualify as a joint inventor.¹⁵ And even then, a joint inventor need not contribute to conceiving each and every limitation of a single claim.¹⁶ However, there are limits: where a joint inventor undisputedly was the sole contributor of a dependent claim that consisted of adding to the independent claim a feature that was well known in the prior art, the Federal Circuit held that he did not qualify as a co-inventor.¹⁷

¹⁰ *Eli Lilly*, 376 F.3d at 1358.

¹¹ *Ethicon*, 135 F.3d at 1460.

¹² *Id.*

¹³ *Eli Lilly*, 376 F.3d at 1359, citing *Garrett Corp. v. United States*, 422 F.2d 874, 880 (Ct. Cl. 1970).

¹⁴ *Nartron Corp. v. Schukra U.S.A. Inc.*, 558 F.3d 1352, 1359 (Fed. Cir. 2009), quoting *Ethicon, Inc. v. U.S. Surgical Corp.*, 937 F.Supp. 1015, 1035 (D. Conn. 1996), *aff’d*, 135 F.3d 1456 (Fed. Cir. 1998).

¹⁵ *Ethicon*, 135 F.3d at 1460.

¹⁶ *Eli Lilly*, 376 F.3d at 1361.

¹⁷ *Nartron*, 558 F.3d at 1358-59 (reversing the trial court’s determination at summary judgment that the

3. Contemporaneous

“Joint inventorship under Section 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.”¹⁸ “For persons to be joint inventors under Section 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.”¹⁹

B. The Ownership Implications of Joint Inventorship

Each joint inventor presumptively owns a pro rata undivided interest in the entire patent, no matter what their respective contributions.²⁰ This is important because as a matter of substantive patent law, all co-owners ordinarily must consent to join as plaintiffs in an infringement suit.²¹ Thus, “one co-owner has the right to impede the other co-owner’s ability to sue infringers by refusing to voluntarily join in such a suit.”²²

As a result, where an inventorship challenge results in adding to the patent a previously unnamed inventor, the patent’s ownership could be altered as a result. Where the patent already is enmeshed in litigation, it could set off a race between plaintiff and defendant to secure an assignment of the ownership rights of the newly identified inventor, or a license therefrom.

individual did qualify as a joint inventor). *See also Massachusetts Eye and Ear Infirmary v. Novartis Ophthalmics, Inc.*, 199 Fed. Appx. 960, 2006 WL 2860587, *4-*5 (Fed. Cir. 2006) (reversing summary judgment that an individual was a joint inventor, holding that “[t]he suggestion of an upper limit of a claim limitation does not necessarily constitute an inventive contribution if the upper limit is contained within a previously conceived broader range and is of no demonstrated significance”)

¹⁸ *Eli Lilly*, 376 F.3d at 1359.

¹⁹ *Eli Lilly*, 376 F.3d at 1359 (quote omitted).

²⁰ *Ethicon*, 135 F.3d at 1465.

²¹ *Id.* at 1468.

²² *Id.* (citation omitted); *see also Israel Bio-Eng’s Project*, 475 F.3d at 1264-65 (“Absent the voluntary joinder of all co-owners of a patent, a co-owner acting alone will lack standing.”).

III. Correction of Inventorship of a U.S. Patent

A. 35 U.S.C. § 256

Congress has explicitly provided a procedure for resolution of inventorship disputes surrounding issued patents, through the enactment of 35 U.S.C. § 256 (“Correction of Named Inventor”):

(a) Correction.—Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

(b) Patent valid if error corrected.—The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.²³

Thus, inventorship may be corrected either in a proceeding within the Patent Office, or before a court “before which such matter is called in question.”²⁴

When must such proceeding be brought? The Federal Circuit’s decision in *MCV, Inc. v. King-*

*Seeley Thermos Co.*²⁵ does not explicitly answer the question, but highlights the risk of failing to take prompt action. In *King-Seeley*, a principal (Simon) at a marketing company approached a water cooler manufacturer (Halsey Taylor Co.) suggested the latter begin making a “drainless water cooler,” and even suggested a particular configuration for such cooler.²⁶ The manufacturer then decided to seek a patent on the idea, and conferred with Simon on drafts of the patent’s claims.²⁷ However, when Simon suggested that he be named as a co-inventor, Halsey Taylor declined, citing company policy that purportedly prohibited naming non-employees on patent applications filed by the company.²⁸ However, Simon did not press the issue, but replied instead that he considered it more valuable to have the exclusive right to market the water coolers, and would “help in any way he could to facilitate the submission of the patent.”²⁹ When relations between Simon’s company and Halsey Taylor became fractured, litigation ensued, and eventually, a claim for correction of the patent under 35 U.S.C. § 256 was asserted.³⁰ However, the trial court granted Halsey Taylor’s motion for summary judgment on the claim, holding that Simon was equitably estopped from asserting his alleged status as a co-inventor on the patent “because he knowingly acquiesced in the omission of his name from the application for four years.”³¹ The Federal Circuit affirmed, emphasizing Simon’s knowledge that he had not been named as an inventor, his subsequent acquiescence during the entire pendency of the patent application through the Patent Office, and his affirmative assertion to

²³ 35 U.S.C. § 256. Until the November 2011 enactment of the Leahy-Smith America Invents Act, Subsection (a) of 35 U.S.C. § 256 contained a further requirement that the unnamed inventor show that his or her omission was through error and without deceptive intent on his or her part. *See Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1554 (Fed. Cir. 1997) (holding that section 256 allows correction of inventorship when there is no deceptive intent on the part of the omitted inventor, and that it does not require inquiry into the intent of the originally named inventors). The AIA, however, expressly removed this requirement.

²⁴ 35 U.S.C. § 256.

²⁵ 870 F.2d 1568 (Fed. Cir. 1989).

²⁶ *Id.* at 1569.

²⁷ *Id.*

²⁸ *Id.* The Federal Circuit understandably was less than enthused about the purported company policy. “If this was Halsey Taylor’s policy, we do not endorse it; if, as Halsey Taylor says, it was customary in the industry where marketing and sales representatives often give general advice about products and sales techniques, we are troubled.” *Id.* at 1573.

²⁹ *Id.* at 1569.

³⁰ *Id.*

³¹ *Id.* at 1569-70.

Halsey Taylor that the marketing rights were more valuable to him than patent rights.³² “On the facts of this case, where Simon knew Halsey Taylor was seeking a patent, and knew what was being claimed, it was incumbent upon him timely, explicitly, and tenaciously to apprise Halsey Taylor of his purported inventorship so that it could be maturely considered.”³³ “It is impermissible for him to lie low for four years and then invoke a claim of erroneous inventorship against the patent when the matter could have been resolved from the start.”³⁴

B. The Corroboration Requirement An Unnamed Inventor Must Satisfy

Courts presume that the inventors named on the issued patent are the correct inventors.³⁵ Thus, an alleged (but unnamed) joint inventor must prove his contribution to the conceptions of the claims by clear and convincing evidence.³⁶ This standard cannot be satisfied by the inventor’s testimony alone, but rather requires corroborating evidence.³⁷

Whether the inventor’s testimony has been sufficiently corroborated is evaluated under a “rule of reason” analysis.³⁸ Under this analysis,

an evaluation “of *all* pertinent evidence must be made so that a sound determination of the credibility of the [alleged] inventor’s story may be reached.”³⁹

Corroborating evidence may take many forms. Often contemporaneous documents prepared by a putative inventor serve to corroborate an inventor’s testimony, and circumstantial evidence about the inventive process also may corroborate.⁴⁰ The oral testimony of a person other than the alleged inventor also may corroborate.⁴¹

To determine whether an alleged co-inventor contributed to the conception of the claimed subject matter, the court must determine the alleged joint inventor’s contribution and whether that contribution’s role appears in the claimed invention.⁴² If an alleged joint inventor contributed to the invention defined by the claims, he is a joint inventor of that claim.⁴³

1. Eli Lilly & Co. v. Aradigm

In *Eli Lilly & Co. v. Aradigm*, plaintiff Lilly sued patentee Aradigm, seeking to have two Lilly

³² *Id.* at 1572-73.

³³ *King-Seeley*, 870 F.2d at 1573.

³⁴ *Id.* The possibility that asserting Simon’s inventorship rights earlier “might have jeopardized business dealings with Halsey Taylor” was deemed an “insufficient excuse” by the Federal Circuit. *Id.* at 1572.

³⁵ *Shum v. Intel Corp.*, 633 F.3d 1067, 1083 (Fed. Cir. 2010).

³⁶ *Shum*, 633 F.3d at 1083; *Eli Lilly & Co. v. Aradigm*, 376 F.3d 1352, 1358 (Fed. Cir. 2004); *Ethicon*, 135 F.3d at 1461.

³⁷ *Ethicon*, 135 F.3d at 1461; *see also Marketel Int’l, Inc. v. Priceline.com, Inc.*, 36 Fed. Appx. 423, 2002 WL 732141, *2-*3 (Fed. Cir. 2002) (affirming district court’s award of summary judgment for patentee where plaintiff’s claim for correction of inventorship was based solely on the testimony of the putative co-inventors).

³⁸ *Id.* The Federal Circuit traced this requirement back to the Supreme Court’s decision in *The Barbed-wire Patent*, 143 U.S. 275, 284 (1892):

The law has long looked with disfavor upon invalidating patents on the basis of mere

testimonial evidence absent other evidence that corroborates that testimony. [Thus] the Supreme Court recognized over one hundred years ago that testimony concerning invalidating activities can be “unsatisfactory” due to “the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury.”

See Checkpoint Systems, Inc. v. All-Tag Security S.A., 412 F.3d 1331, 1339 (Fed. Cir. 2005), citing *Finnigan Corp. v. U.S. Int’l Trade Comm’n*, 180 F.3d 1354, 1366 (Fed. Cir. 1999), quoting *The Barbed-wire Patent*, 143 U.S. 275, 284 (1892). “This ‘rule of reason’ standard requiring corroborating evidence extends to claims by individuals purporting to be co-inventors.” *Checkpoint Systems*, 412 F.3d at 1339, citing *Ethicon*, 135 F.3d at 1464.

³⁹ *Ethicon*, 135 F.3d at 1461 (orig. emph., cite omitted).

⁴⁰ *Id.* (“[S]ufficient circumstantial evidence of an independent nature can satisfy the corroboration rule.”).

⁴¹ *Id.*

⁴² *Ethicon*, 135 F.3d at 1461.

⁴³ *Id.*

scientists added as inventors of an Aradigm patent, alleging that Aradigm improperly took information from Lilly about the benefits of pulmonary delivery of an insulin analog (lispro) and claimed it as Aradigm's own invention.⁴⁴ It was undisputed that the companies had held four meetings to discuss a possible collaboration that would combine Lilly's expertise in insulin compounds with Aradigm's expertise in aerosolized drug delivery.⁴⁵ Lilly's evidence as to one scientist's contribution was closely scrutinized.

The patent claim in question required aerosolizing lispro and inhaling the aerosolized compound into the lungs in a manner that caused the lispro to rapidly dissociate, so as to produce "a relative bioavailability greater than twice that seen after the inhalation of a similar amount of [regular] insulin."⁴⁶ The Lilly scientist (Dr. DiMarchi) testified that he remembered discussing insulin at a meeting with Aradigm, a subject he claimed never to discuss without also discussing lispro and its properties.⁴⁷ However, Dr. DiMarchi did not testify that he affirmatively told Aradigm that aerosolized lispro could lead to "a relative bioavailability greater than twice that seen after the inhalation of a similar amount of [regular] insulin."⁴⁸ A colleague also testified that at the same meeting, Aradigm had questioned whether Lilly was pursuing other compounds besides regular insulin, and Dr. DiMarchi had identified lispro as a candidate.⁴⁹ Lilly further argued that Aradigm had produced no evidence to show it had considered using lispro in an aerosol device before meeting with Lilly; that emails and notes showed Aradigm's post-meeting interest, and that Aradigm's patent application filed seven months after the meeting at which Dr. DiMarchi spoke showed Aradigm's "firm grasp of the concept."⁵⁰ At trial, a jury found Dr. DiMarchi

was a co-inventor of the claim in question.⁵¹ However, the Federal Circuit reversed. Emphasizing the absence of any direct evidence that Dr. DiMarchi had told Aradigm that inhaling aerosolized lispro would lead to the improved bioavailability, the court held that the jury's apparent inference that Dr. DiMarchi had communicated the idea was impermissible. "Evidence that Dr. DiMarchi merely suggested that Aradigm try lispro in its aerosol delivery devices" was insufficient to support the jury's verdict in Lilly's favor on the claim in question.⁵²

2. *Ethicon, Inc. v. U.S. Surgical*

The patent in *Ethicon, Inc. v. U.S. Surgical Co.* related to trocars, a tool for endoscopic surgery, which makes small incisions in the wall of, e.g., the abdomen, to permit the introduction of endoscopic instruments therethrough; in particular, the patent related to safety trocars—trocars with safety devices to prevent accidental injury during trocar insertion.⁵³ The named inventor (Dr. Yoon) was a physician who had invented numerous patented devices for endoscopic surgery; the unnamed co-inventor (Choi) was an electronics technician with some college training in physics, chemistry, and electrical engineering, but no college degree.⁵⁴ After Choi and Yoon met, Choi showed Yoon some of the devices he'd developed, and Yoon asked Choi to work with him on several projects, including safety trocars.⁵⁵ They collaborated for eighteen months, until Choi withdrew from the endeavor, concluding that Yoon was dissatisfied with Choi's work and no commercial product ever would result.⁵⁶ The same year, however, Dr. Yoon filed for a patent application on a safety trocar.⁵⁷ Litigation eventually ensued between Dr. Yoon's licensee (Ethicon) and a competitor (U.S. Surgical) who became aware of Choi's

⁴⁴ 376 F.3d 1352, 1357 (Fed. Cir. 2004).

⁴⁵ *Id.* at 1356.

⁴⁶ *Id.* at 1361.

⁴⁷ *Id.* at 1363.

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.* at 1364.

⁵¹ *Id.* at 1357.

⁵² *Id.* at 1363-64.

⁵³ 135 F.3d 1456, 1459 (Fed. Cir. 1998).

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.*

involvement; U.S. Surgical ultimately moved to correct inventorship of the patent by adding Choi (from whom it had obtained a license) as a named inventor.⁵⁸

Before the district court, Choi testified that he had conceived of several dependent claims for specific trocar configurations.⁵⁹ He further produced a series of sketches he had created while working with Dr. Yoon.⁶⁰ Dr. Yoon, for his part, insisted that Choi's drawings merely reflected Yoon's own ideas, which Choi had sketched after Yoon had conveyed them to him.⁶¹

Dr. Yoon's account, however, was not persuasive to the district court, which concluded that Dr. Yoon had "altered and backdated documents to make it appear that he had independently invented trocars, shields, and electronics."⁶²

Moreover, the district court (and the Federal Circuit) were impressed by the circumstantial evidence supporting Choi's claim to conception, namely:

- Yoon had needed a collaborator with expertise in electronics, which Choi possessed;
- Yoon had proposed to Choi that the two collaborate on developing new products, including safety trocars;
- The two subsequently worked together for eighteen months in an informal business relationship;
- Choi was not paid for his work;
- Choi's sketches were very similar to the figures in the patent;
- Choi's letter to Yoon, withdrawing from their collaboration, in which Choi stated he could no longer be a "member" of Yoon's business; and
- U.S. Surgical's expert testimony that some of the sketches dealt with sophisticated concepts that only an

electrical engineer or technician would understand.⁶³

Accordingly, the district court held, and the Federal Circuit affirmed, that Choi had presented Yoon with the sketches, not vice versa.⁶⁴

This is not to say that Choi's account was problem free; in fact, some evidence was introduced that when Choi first saw a copy of Yoon's patent, Choi marked it in a manner that indicated that Choi had invented some claims that he ultimately did not claim to have invented, and also, that Choi failed to mark as his invention some claims that he ultimately did assert were his conception.⁶⁵ However, on balance, the district court and Federal Circuit were satisfied that Choi had sufficiently corroborated his co-inventorship claims.⁶⁶

C. Inventorship Disputes Under 35 U.S.C. §256 Not Involving Patent Infringement Litigation

Though litigation under 35 U.S.C. § 256 often arises in the midst of a patent infringement dispute, that need not always be the case, as *King-Seeley* showed. There, the claim for correction of inventorship arose out of the breakup of the parties' marketing relationship, and was asserted along with a bevy of other claims including breach of contract, antitrust violations, trademark claims and fraud claims.⁶⁷

To give a flavor for other contexts in which the claim has arisen, correction also has been sought in several cases brought by employees or former employees who previously had assigned away their potential ownership in the patented invention.

1. *Chou v. University of Chicago*

In *Chou v. University of Chicago*,⁶⁸ a former graduate student and research assistant sued her professor, the university at which both were

⁵⁸ *Id.*

⁵⁹ *Id.* at 1462.

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.* at 1464.

⁶⁴ *Id.*

⁶⁵ *Id.* at 1464-65.

⁶⁶ *Id.* at 1465.

⁶⁷ *King-Seeley*, 870 F.2d 1568 (Fed. Cir. 1989).

⁶⁸ 254 F.3d 1347 (Fed. Cir. 2001).

employed, and the licensee and assignee of certain patents, seeking correction of inventorship on the patents and asserting other claims. The policy of the defendant university provided that inventors receive 25% of gross royalties and up-front payments from licensing of patents they invented, plus 25% of the stock of new companies based on their inventions.⁶⁹ Plaintiff Chou, a post-doctoral research assistant at the university, also was subject to an employment agreement with the university, pursuant to which she had surrendered her rights to ownership of any patents she invented.⁷⁰ The basis of Chou's suit was that she made certain discoveries relating to the use of herpes simplex virus in vaccines, suggested to the university professor for whom she worked that they be patented, but was rebuffed by the professor, who at the time of her suggestion had pending before the Patent Office his own patent application for the same invention, on which he alone was named as an inventor.⁷¹ (Interestingly, during prosecution of the professor's patent application, the Patent Office cited as prior art two publications the professor had co-authored with Chou; the professor submitted a declaration that those publications did not constitute prior art because he was in fact the sole inventor of the subject matter disclosed therein, and Chou had merely worked under his direction and supervision.)⁷² After suit was filed, Chou's inventorship claim initially was dismissed by the trial court, on the grounds that she lacked standing to correct inventorship under § 256, having surrendered to the university her ownership rights via the employment agreement.⁷³ The Federal Circuit reversed-in-part. Though it agreed with the trial court that Chou had assigned her ownership rights to the university, it disagreed that that foreclosed her from seeking to have her name added to the patent.⁷⁴ "[A]n expectation of ownership of a patent is not a prerequisite for a putative inventor

to possess standing to sue to correct inventorship under § 256."⁷⁵ Chou's allegation of a direct financial interest in the patent—via the university policy that inventors receive 25% of gross royalties and up-front payments from licensing of patents they invented, plus 25% of the stock of new companies based on their inventions—was sufficient confer standing so as to permit her § 256 claim to stand.⁷⁶

In passing, the *Chou* court noted the plaintiff's fallback assertion that a reputational interest alone in being named as an inventor on a patent would itself suffice to confer Article III standing, and deemed it "not implausible."⁷⁷

2. *Larson v. Correct Craft, Inc.*

The issue arose again briefly in *Larson v. Correct Craft, Inc.*,⁷⁸ in which an ex-employee sued his former employer, seeking correction of inventorship of a patent along with several other claims. Larson, like Chou, had affirmatively transferred away to his employer any ownership interest in patents arising from his inventive contributions.⁷⁹ Unlike Chou, however, Larson was not subject to a pre-existing licensing or royalty arrangement; as such, the Federal Circuit held he had no constitutional standing to bring a § 256 claim.⁸⁰ Trying to take another page from Chou's book, Larson argued that even without a direct financial interest in the patent, he still could have standing, based on a reputational interest in being correctly named as the sole inventor of the patented invention.⁸¹ The Federal Circuit noted that it remained an open question whether

⁶⁹ *Id.* at 1353.

⁷⁰ *Id.* at 1354.

⁷¹ *Id.* at 1353.

⁷² *Id.*

⁷³ *Id.* at 1354.

⁷⁴ *Id.* at 1357-59.

⁷⁵ *Id.* at 1358 ("The statute imposes no requirement of potential ownership in the patent on those seeking to invoke it.").

⁷⁶ *Id.* at 1359.

⁷⁷ *Id.*

⁷⁸ 569 F.3d 1319 (Fed. Cir. 2009).

⁷⁹ *Id.* at 1326.

⁸⁰ *Id.* at 1326-27.

⁸¹ *Id.* at 1327 (noting the assertion in Larson's supplemental appellate brief that "Larson is expressly seeking a court determination that only he can hold himself out as the inventor . . . [which] is the reputational aspect of invention possessed by the inventor which this Court discussed in *Chou*.").

reputational interest alone was sufficient to confer standing, and disposed of the argument by pointing out that Larson had failed to raise the reputation interest in the trial court; as such, the issue was not before the court, and Larson’s claim was dismissed.⁸²

3. *Shukh v. Seagate Technology, LLC*

In *Shukh v. Seagate Technology, LLC*, the plaintiff was a former Seagate scientist who had worked for the company for twelve years, and held thirty five U.S. and foreign patents, ten of which he patented while with the company.⁸³ After his employment was terminated, he sued for correction of the inventorship on four issued patents on which he claimed to be an inventor or co-inventor.⁸⁴ Like Chou and Larson, Shukh had previously assigned away to his employer his ownership interest in patents invented by him during his employment.⁸⁵ Following the *Chou* and *Larson* decisions, the trial court concluded that Shukh had no ownership interest that could confer standing, nor (in contrast to Ms. Chou) did he have any financial interest in the patents that could confer standing. However, the trial court took note of Shukh’s argument that reputational interests could give him standing. Shukh had alleged that he was “one of the world’s leading scientists and engineers in the area of computer hard disk drives,” and that during and after his employment with Seagate, the company incorporated Shukh’s inventions “into several hundred million (probably closer to 1.1 billion) of product units sold by Seagate.”⁸⁶ The trial court held it “clear that a failure to be designated as an inventor of a patent that is widely known in an industry” would deny Shukh “an important mark of success,” and that being omitted from such important patents could impact Shukh’s ability to find new employment.⁸⁷ Accordingly, the trial

court held that Shukh had standing to pursue his Section 256 claim.⁸⁸

IV. How inventorship may be challenged by a defendant in a patent infringement suit

A. Procedural Options

A defendant accused of patent infringement may challenge inventorship in a variety of ways. For example, the defendant may raise the defense that the patent is invalid under 35 U.S.C. §102(f) for failing to name the correct inventor.⁸⁹ Typically, the defendant then would seek to gather through discovery evidence that the patent’s inventorship is inaccurate—either that the named inventor did not in fact invent the patented invention, or that another, unnamed inventor, contributed to the conception of at least one claim and thus should be added to the patent as a named inventor. Such evidence may be useful in a motion for summary judgment, either of invalidity under §102(f),⁹⁰ or perhaps that the suit must be dismissed for failure to join the unnamed inventor as a party,⁹¹ or that the failure to properly identify all inventors constitutes inequitable conduct before the Patent Office sufficient to render the patent unenforceable.⁹²

As another option, the defendant may in fact decline to answer the complaint, and instead

⁸² *Id.* at 1327-28 (“Larson claims no reputational injury, and so that cannot be a basis on which to find standing.”).

⁸³ 2011 WL 1258510 (D. Minn. 2011).

⁸⁴ *Id.* at *3.

⁸⁵ *Id.* at *6.

⁸⁶ *Id.* at *7.

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ “A person shall be entitled to a patent unless . . . (f) he did not himself invent the subject matter sought to be patented.” 35 U.S.C. §102(f). As the Federal Circuit has stated, “[i]f nonjoinder of an actual inventor is proved by clear and convincing evidence, a patent is rendered invalid.” *Checkpoint Systems, Inc. v. All-Tag Security S.A.*, 412 F.3d 1331, 1338 (Fed. Cir. 2005).

⁹⁰ See *O.M.S., Inc. v. Dormont Mfg. Co.*, 1996 WL 437475, *4 (W.D. Pa. 1996) (granting defendant’s motion for summary judgment of invalidity for misjoinder of inventors under §102(f) after finding by clear and convincing evidence that two of the three named inventors “did not invent, (or ‘even contribute to the final inventive thought’) of” the patent in suit).

⁹¹ *Ethicon*, 135 F.3d 1456, 1468 (Fed. Cir. 1998) (affirming dismissal of suit where omitted co-inventor declined to consent to suit).

⁹² *Perseptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315, 1320, 1322-23 (Fed. Cir. 2000).

move to dismiss the complaint under FED. R. CIV. P. 12(b)(1), by asserting that it is actually a co-inventor, and thus co-owner, of the patent, and its refusal to join in suit against itself deprives the plaintiff of standing and the Court of subject-matter jurisdiction.⁹³

B. *Ethicon Inc. v. U.S. Surgical Corp.*

In *Ethicon*, discussed previously, defendant U.S. Surgical became aware of the role played in the conception of some of the claims in a 55-claim patent by electronics technician Choi, who was not named as an inventor on the patent.⁹⁴ The defendant contacted Choi, confirmed his involvement, and obtained from him a license to practice the invention.⁹⁵ The defendant then moved to add Choi as an inventor on the patent under 35 U.S.C. 256.⁹⁶ The motion was granted after the trial court determined, following a hearing, that Choi had contributed to the conception of two dependent claims.⁹⁷ The defendant then successfully moved the trial court to dismiss the case in view of the license.⁹⁸ The Federal Circuit affirmed.⁹⁹ “Because Choi did not consent to an infringement suit against U.S. Surgical and indeed can no longer consent due to his grant of an exclusive license with its accompanying ‘right to sue’, Ethicon’s complaint lacks the participation of a co-owner of the patent. Accordingly, this court must order dismissal of this suit.”¹⁰⁰

C. *Bushberger v. Protecto Wrap Co.*

In *Bushberger*,¹⁰¹ the parties previously had

worked together to develop a product (building-foundation materials). One party filed patent applications without naming the other as a co-inventor. The patent holder sought to minimize the inventive contributions of the party claiming co-inventorship. When the relationship broke down, a patent suit broke out.

Todd Bushberger sued defendant PWC for infringement of patents naming only Bushberger as the inventor.¹⁰² PWC did not answer the complaint, but instead, moved to dismiss under 12(b)(1) on the grounds that PWC’s CEO (Hopkins) was a joint inventor, thus joint owner, of the patents-in-suit.¹⁰³ Because Hopkins refused to join in suit, PWC argued that Bushberger’s complaint must be dismissed for lack of standing.¹⁰⁴ Bushberger responded that “Hopkins’ contributions to the patents were merely material selections and obvious embodiments of the inventions conceived solely by Bushberger,” and his contributions already were known in the art.¹⁰⁵

The district court noted that the significant factual disputes typically would require it to make a credibility determination at an evidentiary hearing to resolve the factual issues relating to standing.¹⁰⁶ However, because Bushberger admitted that one dependent claim in one of the patents was invented by Hopkins,¹⁰⁷ and Hopkins refused to join in suit against PWC, Bushberger lacked standing to sue, and the court lacked subject-matter jurisdiction.¹⁰⁸

⁹³ See *Bushberger v. Protecto Wrap Co.*, 2008 WL 725189 (E.D. Wis. 2008) (granting 12(b)(1) motion and dismissing infringement suit, finding defendant’s CEO invented at least one patent claim).

⁹⁴ *Ethicon*, 135 F.3d at 1459.

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ *Id.* at 1459-60.

⁹⁹ *Id.* at 1468.

¹⁰⁰ *Id.*

¹⁰¹ *Bushberger v. Protecto Wrap Co.*, 2008 WL 725189 (E.D. Wis. 2008)

¹⁰² *Id.* at *2.

¹⁰³ *Id.* at *2-3. PWC had a second, alternative ground for its Rule 12(b)(1) motion, which is that Bushberger had assigned a partial interest in the patents-in-suit to Hopkins. *Bushberger*, 2008 WL at *2-3. However, the court granted the 12(b)(1) motion solely on the inventorship ground. *Id.* at *4-5.

¹⁰⁴ *Id.* at *3.

¹⁰⁵ *Id.* at *4.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at *4-5.

¹⁰⁸ *Id.* at *5.

D. Nartron Corp. v. Schukra U.S.A., Inc.

In *Nartron Corp. v. Schukra U.S.A., Inc.*, defendant Schukra, a supplier of back support systems for automobile seats, previously had hired Nartron to develop a control system to provide massage functionality to automobile seats; Nartron filed for and received a patent on the system it developed.¹⁰⁹ Subsequently, Nartron sued a supplier of electrical components to Schukra for contributory infringement of certain of the patent's claims.¹¹⁰ The defendant moved for summary judgment, alleging that a Schukra employee (Benson) was a co-inventor of a single dependent claim of the patent, and neither Benson nor Schukra had consented to the suit.¹¹¹ It was undisputed that Benson was the sole contributor of dependent claim 11, which contained a single limitation—that the back support adjuster in an antecedent claim included an “extender.”¹¹² Benson admitted, however, that the extender component was in the prior art.¹¹³ The district court granted the defendant's motion for summary judgment, holding that Benson was a co-inventor as a result of his conception of the extender element in dependent claim 11, and as a co-inventor, he was required to have been joined as a plaintiff in any infringement suit.¹¹⁴ On appeal, however, the Federal Circuit reversed, holding that as a matter of law, Benson's contribution of the extender element did not confer on him status as a co-inventor of claim 11.¹¹⁵ “Any contribution Benson made to the invention described in claim 11 by contributing an extender was insignificant and therefore prevents Benson from attaining the status of a co-inventor.”¹¹⁶ The court held that “the contribution of the extender is insignificant when measured against the full dimension of the invention of claim 11, not just because it was in

the prior art, but because it was part of existing automobile seats, and therefore including it as part of the claimed invention was merely the basic exercise of ordinary skill in the art.”¹¹⁷

The Federal Circuit's result makes sense—Benson's suggestion that the novel invention developed by Nartron also contain a feature commonly found in the prior art should not confer upon him an ownership right in Nartron's novel invention, or give Benson the power to impact Nartron's assertion of the patented invention in litigation. However, the decision does seem to leave claim 11 without an inventor.

E. Strategic Considerations

Ethicon shows the value of investigating the circumstances under which all claims of the invention were developed, pursuing leads as to possible unnamed co-inventors, and securing a license or assignment from such co-inventors before launching an inventorship challenge. *Bushberger*, a case where the co-inventor was the defendant's CEO, shows that an inventorship challenge may be made even earlier than at summary judgment, and in fact, before the complaint is answered. Critically, in that case, some discovery had taken place (apparently by agreement between the parties) before the answer deadline, and thus the defendant had the necessary evidence to make the inventorship challenge successful. *Nartron* reminds us that even when inventorship seems clear cut—where the unnamed inventor is acknowledged as the sole contributor of the only added limitation of a dependent claim—one still must carefully analyze the unnamed co-inventor's contribution under the framework established by prior Federal Circuit caselaw, namely, the three-prong analysis set forth in *Israel Bio-Eng'g Project v. Amgen*.

V. CONCLUSION

In a sense, this article raised and discussed three questions, which can be informally summarized as (1) who's the inventor, and why is that so important, (2) how can we be sufficiently sure that someone claiming to be an inventor actually is an inventor, and (3) what may occur if a

¹⁰⁹ 558 F.3d 1352, 1353-54 (Fed. Cir. 2009).

¹¹⁰ *Id.* at 1354.

¹¹¹ *Id.*

¹¹² *Id.* at 1354-55.

¹¹³ *Id.* at 1355.

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 1356.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 1357.

patentee proceeds with an infringement suit without confirming the identity of all true inventors, and as importantly, securing the rights that all such inventors may be deemed to possess.

The rules for determining the identity of inventors are set forth by Section 116 of the Patent Act, and subsequent case law. *King-Seeley* and *Perceptive* show the complications that can ensue when a patent issues without naming all the correct inventors; *O.M.S., Inc.*, discussed in a footnote, shows the complications that can ensue when a patent names as inventors persons who in truth were not.

Chou shows that even when an unnamed inventor's most important right—to ownership of the claimed invention—has been signed away, the unnamed inventor still may pursue potentially lucrative claims that will bear fruit only after inventorship of the patent in question is corrected to add the individual as an inventor. *Larson* and *Shukh* show putative unnamed inventors who sought to show that the reputational benefits of being named as a co-inventor could confer sufficient standing to bring in federal court a correction of inventorship claim, and a bevy of other claims against their former employers.

The corroboration requirements for determining that an individual is indeed an unnamed co-inventor were shown by *Eli Lilly* and *Ethicon*.

Ethicon also showed how an infringement suit can be derailed by the appearance of an unnamed co-inventor who licenses to the defendant his rights in the subject patent. *Bushberger* showed how early such a challenge could be brought, and *Nartron* returned us full circle by reminding us of the importance of evaluating inventorship in light of contribution to the invention as a whole.