

Inventorship: Let's Help Each Other



Why do we care?

- Validity of patent depends on correct inventorship.
- If challenged in a litigation and inventorship is found to be incorrect – either an incorrect inventor is included or a proper inventor is excluded – the patent can be invalidated by the court.
- However, the patent will **not** be invalidated if it can be corrected by the court with notice to all parties concerned.
- Ownership, licensing and revenue consequences flow from omitted inventors.



What's the standard?

- Inventors, i.e., those who “conceived” of the invention recited in the claims.
- To legally conceive of the claimed invention, a person (or group of persons) must envision and be able to communicate the idea in enough detail that a person of ordinary skill in the art can make the invention. As a result, legally conceiving of an invention requires more than coming up with a general idea for something.
- As prosecution proceeds and claims are dropped or narrowed, some originally named inventors may no longer be proper.



How is it different from authorship?

- Author, e.g., a person who designed the research, performed the underlying research, supervised the research, wrote the paper, sponsored the research, etc.
- No legal definition for authorship.
- The challenge is to help researchers understand how the question of who should be a coauthor on a paper is very different from who should be named as a co-inventor.



Joint Inventors

- Joint inventor, i.e., an individual who has not only made a significant contribution to the conception of the invention, but also participated in a "collaboration or concerted effort" towards the invention. *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1359.
- Requires communication between the multiple inventors.



When does this come up?

- Grad student/post doc
- Possible additional inventors outside of your institution
- Sponsored research situations
- Husband and wife teams – intra- and inter-institution
- Unrecognized change in inventorship during prosecution
- Fraud



What is the impact?

- Patent validity
- Financial
 - Disputed inventorship issues can be expensive to resolve.
 - A disputed inventorship/ownership issue can make the technology potentially unlicensable.
- Disputes between researchers over inventorship.



What is the impact?

- Ownership and the right to license
 - Previous employment and related research at a different institution
 - Previous or concurrent employment at a company and related research
 - Unaffiliated inventors and possible ownership issues that can arise.
- Timing of investigation and impact of multiple owners
- A potential inventor from another institution affects the value of the technology for the licensing institution. Better to know early.



What are the best practices?

- What are cost-effective ways to spot potential inventorship issues early?
 - Discuss inventorship vs. ownership with your researchers and ask them to identify inventive contributions.
 - Identify and assess any potential source of inventors outside your institution.
 - Sponsors, previous sponsors of related work, previous inventor employment or collaboration
 - Recheck inventorship during filing of PCTs and continuing applications, and during prosecution
- Are there benefits to being over-inclusive or restrictive in naming inventors?
- How far as an institution do you want to go in an inventorship determination?



What kind of documentation is helpful?

- Invention disclosures
- Lab notebooks, signed and dated
- Emails
- Claim or inventive concept charts approved by the inventors
 - Useful to give precision to inventor interviews about which co-inventors were responsible for which elements.
- Research funding or collaboration agreements



Working with outside counsel

- Times when you may need to call outside counsel:
 - When you genuinely need guidance and independent fact gathering
 - When you know the answer, but the situation is heated and it's helpful to outsource that determination
 - A dispute between your institution and a third party
 - A dispute between researchers over inventorship
- Options for work product
 - High level conversation and verbal guidance
 - Fact gathering by outside counsel and verbal guidance
 - In depth analysis and written memo prepared with determination and support
- Who pays?



Third parties

- When the determination is made that inventorship involves a third party, the language of the agreement is key.
 - Inter-Institutional Agreements (IIAs), Patent Co-ownership Agreements, or collaboration agreements where two or more patent co-owners outline the agreement as to sharing patent costs, rights and revenues
 - Consider pre-negotiating an explicit mechanism regarding inventorship determination and changes based on new facts or patent prosecution.
 - Fixed or variable revenue sharing and/or rights?



Summary

- Inventorship is important to get right
 - To preserve patent rights
 - To fairly allocate ownership rights and revenue
- Important differences exist between authorship and inventorship; this needs to be conveyed to researchers
- Key tools in the TTO toolbox that can be used for inventorship determination:
 - Documentation (research materials and claim charts)
 - Evaluation of potential changes in inventorship during patent prosecution
 - Review of relevant contracts
 - Conversations with patent counsel



Tamsen Barrett
Partner, Norton Rose Fulbright
tamsen.barrett@nortonrosefulbright.com

Thelma Tennant
Oncology Lead, Technology Commercialization at the University of Chicago
trtennan@uchicago.edu

David Palmer
Program Director, Intellectual Property & Technology Transactions at the
University of Texas at Austin, Office of Technology Commercialization
dpalmer@otc.utexas.edu



