

Determining Inventorship

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Why Worry about Inventorship?

When an invention is made at an institution, chances are the institution doesn't own it.¹ The inventors do. The institution must affirmatively acquire ownership from the inventors. Since the technology transfer manager's business is licensing—a privilege of ownership—identifying the inventors is job one. Some guidance follows.

Inventions, Patentable Inventions, and Inventorship

Governments issue patents on inventions that meet objective standards of novelty and nonobviousness. A patent conveys to the patentee (that is, the inventor) the power to constrain the use of the invention by others. It also discloses the invention, complete with instructions on how to make and use it, to innovative minds everywhere. Both the reward to the inventor and the disclosure of the invention to other innovative minds "...promote the progress of the useful arts..." [Art 1 §8 U.S. Constitution].²

Ownership has its privileges, but duties also attach. In addition to the duty of full disclosure, the inventor(s) must declare (under penalty of perjury for intentional falsification):

I believe the inventor(s) *named below* to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought in the invention ... the specification of which is attached hereto...[and]...have reviewed and understood [its] contents, including the claims. [emphasis added]

All individuals claiming to have contributed to at least one element of one of the claims are to be named below. Everyone named declares that he or she—and each of the others—is an inventor. Given the consequences of declaring falsely and the difficulty of grasping

what is inventive, signing this form ought to evoke apprehension. Unfortunately, especially in academic settings, it usually occasions great misapprehension. Among the misunderstandings are as follows:

- *Inventorship by illusion:* Inventors may be nominated by reason of social status, appealing personality, or intellectual acumen, irrespective of their actual contribution to any claimed invention.
- *Inventorship by dictum:* When a principal investigator (PI) functions as ruler of his or her principality, with a king (department chair) or pontiff (dean) backing him or her up, the PI tends to feel entitled to overrule institutional policies and public laws, especially the patent law. Signatures dutifully affixed to declarations at this PI's dictation are dangerous. Even more dangerous is the signature that does not appear, due to the PI's veto.
- *Inventorship by courtesy:* A group, or a benevolent PI, may wish to include a noninventor as a courtesy or because the noninventor "deserves" royalties. Some institutional policies provide royalties to noninventors, but the patent law does not.
- *Inventorship by authorship:* *Author* describes a person who has written something. Authorship has nothing to do with inventorship. An author, being more than an amanuensis, writes down his or her own thoughts, but their patentability rests solely with the patent laws. In academia, where publications are the coin of the realm, authorship may seem more important than inventorship. It is, therefore, easy to see why academics have such difficulty disentangling the two concepts.
- *Inventorship by effort:* Occasionally, an inventor forms a "definite idea of the complete and operative invention" in a single moment and, when the invention is made and used, it works exactly as expected. More often, the idea doesn't work. If the fault was in the idea itself, the conception was illusory—there was no invention. But if the fault was in the implementation, efforts to get it right may eventually vindicate the original concept. Technicians, students, and others often do the work that proves the principle. But, if the work only validates the concept, none are inventors.
- *Inventorship by enablement:* A patent claim will not issue if the application does not sufficiently describe how to make and use the invention claimed. The claim is not "enabled." Since the patent must describe at least one procedure that would actually

make the claimed concept work, making and using a working prototype might seem to constitute an inventive contribution. But it does not.³ On the other hand, when a worker's effort to enable a concept reveals a fault in the concept and the worker helps formulate a truly valid concept, he or she may be an inventor of the corrected concept, not because of his or her work but because of his or her insight.

- *Inventorship by materials*: If a patent owner wishes, and is not otherwise obligated, he or she can convey rights of *ownership* in the patent to a party who contributed materials in the course of reducing the invention to practice, but a contributor of materials, biological or otherwise, without more, is *not* an inventor. Nor is a contributor of money, equipment, or other facilities.

A Special Note on Reduction to Practice

It is said that “ownership runs to conception.” In fact, ownership runs to *complete* conception. When a “...definite and permanent idea of an operative invention including every feature of the subject matter sought to be patented is known...” [*Coleman v. Dines*, 754 F.2d 353, 359 (Fed Cir. 1985)] so that “...one of ordinary skill in the art could construct the apparatus, perform the process, or make the composition without unduly extensive research or experimentation...” [*Trovan*, 299 F.3d at 1302], conception is complete. Invention is also said to comprise a two-step process of conception and reduction to practice, suggesting that conception is not *complete* until the inventor converts his or her idea into a physical reality. In fact, such proof is not necessary. At the first moment the inventor can describe his or her invention with particularity, including how to make and use it, reduction to practice has occurred. By convention, just as all racehorses are born on January 1, the date the law assigns to that moment is the date a patent application claiming the concept is filed. The statement “filing a patent application is constructive reduction to practice” is a misnomer. Filing a patent application gets you a date to use for legal purposes.

Joint Inventorship

If an individual is, in fact, the sole inventor of a concept, all that remains is to determine the concept's patentability.⁴ But if two or more parties assert a mutual contribution to a concept, the law must determine not only patentability (novelty and nonobviousness) but

also membership in the inventive entity. The relevant law (35 USC §116) seems only to make the inventorship determination more difficult by stating that “Inventors may apply for a patent jointly even though (1) they did not physically work together at the same time,⁵ (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.” Parsing which subject matter is inventive and which is not is exceedingly difficult.

Nevertheless, the law demands accuracy, and violation of the law has consequences, at least when a dispute arises. Any sign that a discloser of an invention harbors any of the foregoing misconceptions about inventorship forewarns of a dispute that may play out badly in the patent office or in litigation. The section “What? When? Where? Who? Why?” outlines an approach to searching for the seeds of dispute in an invention disclosure.

Hazards of Misjoinder, Nonjoinder

Misjoinder, Common Assignee

The law recognizes only actual inventors who are the “first originators of the invention upon which a patent is sought.” When all the prospective inventors have an obligation to assign to one institution, naming too many inventors (misjoinder) is a lesser error than naming too few (nonjoinder). The legal standard for joint inventorship is quite low [*Canon Computer Systems Inc. v. Nu-Kote International Inc.*, 134 F.3d 1085, 1087-88 (Fed. Cir. 1998)], and misjoinder is (usually) easy to correct. It is better to guard against misjoinder by adding claims that recite minor contributions by persons who would otherwise not qualify as inventors. Adding only elements that contribute nothing to the overall invention, however, isn’t inventive and could amount to inequitable conduct.⁶ Should that happen, the aforementioned easy correction mechanism is unavailable [*Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc.*, 45 F.3d 1550, 1556-57, 33 USPQ2d 1496, 1500 (Fed. Cir. 1995)].

Other thorny issues can arise. Suppose three joint inventors agree to split evenly any royalties, but prosecution eliminates an inventor, freeing up one-third of the royalties. If institutional policy doesn’t spell out how to distribute this portion, the inventors’ agreement ought to. Or, suppose several patents with potentially different inventive entities

spring from one invention disclosure, or a series of invention disclosures mature into interrelated patents that must remain bundled for proper licensing. To add even more spice to the hash, the technology manager must bear in mind that a royalty-splitting agreement among inventors, being a private contract, is probably none of the technology manager's business!

The manager can at least keep the inventors apprised of the status of the claims and serve as a sounding board (NB: avoid becoming an arbiter!). The healthiest deliberations on royalty splits include a neutral party who keeps the focus on weighing the scientific contributions to the inventive concept(s). More formulaic approaches, such as splitting royalties in proportion to the number of claims each inventor contributed, tend to be inequitable.

Misjoinder, Different Assignees

As interinstitutional collaborations proliferate, so does uncertainty about inventors and assignees: inventorship determinations necessarily take place across cultural, political, and power gaps that inevitably separate institutions. And, since inventorship affects ownership, everything from a misunderstanding to a cynical plot can undermine the privileges of ownership. For example, in the United States, all joint owners of a patent must voluntarily join any suit for infringement on that patent. If a joint owner refuses to join, the suit fails. On the other hand, any joint owner may unilaterally license or assign the whole patent (albeit nonexclusively) to a third party without accounting to the other owners. Thus does a misjoined "inventor," named perhaps simply to make peace, end up making war.

Nonjoinder

If the technology manager is unaware that an undeclared but bona fide joint inventor exists, a patent may issue and be licensed exclusively to a party who relies on it to make investment decisions. Unfortunately, the patent is susceptible to invalidation unless the inventive entity can be corrected. If the nonjoined party must assign his or her rights to the institution,⁷ correction is usually possible. But a nonjoined true inventor having no such obligation⁸ is a grave danger. He or she can (with clear and convincing evidence)

invalidate the patent. If, to avoid invalidation, he or she is joined, he or she can destroy the exclusivity of a license or prevent your institution or your licensee from bringing suit against an infringer.

Although often overlooked when collaborations begin, a written patent plan is essential. A well-crafted plan that includes a representative from each side, charged with jointly tracking the collaboration's inventions,⁹ can help preserve rights to legitimately co-invented technology. It can prevent noninventors from being named, keep parties from deriving an invention from a joint project and claiming it as an independent invention, and prevent forfeiting benefits of the CREATE (Cooperative Research and Technology Enhancement) Act.¹⁰ A carefully drawn plan will exclude conceptions made before the collaborative effort began and concepts developed during but not under the collaboration. Conversely, the plan can spell out how, and if, an invention conceived prior to or outside the collaboration might be pooled with collaboration inventions.

What? When? Where? Who? Why?

To keep incorrect inventorship from clouding title to a patent, one should¹¹ make a good-faith effort to get inventorship right. Patent attorneys generally regard this as the client's duty. Fortunately, a technology manager who is conversant with the science and follows the prosecution of the claims can usually identify the inventive entity and keep track of changes in it. This may not be enough, however. For example, if the original inventive entity spans two institutions but prosecution eliminates one institution's inventor, what rights and duties do the institutions then have to one another? Should they continue to share attorney-client privileged information? If exchanges of technical information continue, are the exchanges confidential or are they public disclosures having implications for patentability?

What Is the Invention?

Probing inventorship requires, first, knowing what the invention is. An invention, unlike a discovery, is always a solution to a problem. Playing "20 Questions" with witnesses, including but not limited to the inventor,¹² will generally identify the invention (and, usually, the true inventors).

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1. What is the problem with the current state of the art? (Too much heat? Not enough? Too slow, fast, weak, strong, big, small...?)
2. How has everybody managed to get by up to now?
3. Why hasn't the problem already been solved (or solved well enough)?
4. What is the inventor's solution?
5. Has the inventor written that down?
6. Can I see what he or she wrote? (And, if necessary, why not?)
7. What are the individual elements (parts, components, steps) of that solution?
8. In drawings, how would the inventor depict those elements and their interactions?
9. Where can one get the materials needed to make and use what is in the drawings?
10. How should one put the materials together so they'll work?
11. What does the inventor think is the best way of making and using the invention?
12. What's the difference between this and the devices/methods described in the second question?
13. Why didn't anybody who dealt with this problem up to now hit upon the inventor's way of solving the problem?
14. Has the inventor or anyone else tried it?
15. What were the results?
16. Can I see the results? (And, if necessary, why not?)
17. Did the inventor's first ideas have to be modified to get good results?
18. How did the inventor hit upon the modification?
19. Does the inventor have data on the versions that failed?
20. If the inventive solution becomes available, why will the public adopt it?

Who Was Involved?

The inventors, technicians who worked on an underlying discovery or tested prototypes, individuals who witnessed notebook entries or work in progress, or wrote or received reports, or consulted or attended lab meetings are all potential sources of evidence to ascertain who contributed to the complete conception (inventors) and who merely followed directions, suggested a problem in need of a solution, explained how the invention works mechanistically, or provided resources (noninventors).

Where Is Everyone and Everything?

This includes written records, reports, and drawings of the invention, witnesses and inventors, where the invention was made, and where it was first reduced to actual practice.

When Did it Happen?

Both inventorship and ownership can depend upon the developmental history of the invention.

Why Did it Happen the Way it Did?

“Why” questions are aggressive and, therefore, dangerous. On the other hand, they may produce highly revealing answers.

1. Why did/didn't the inventor work with others to develop the invention?
2. Why didn't the inventor keep notebooks or records?
3. Why did the inventor (or another party) tell X he or she should/should not be named as an inventor?
4. Why should/shouldn't X be named as an inventor?

Disputes: Misjoinder or Misunderstanding?

Disputes over who invented first (priority) are different from disputes over who contributed (joinder). When two parties *independently* conceive of a single invention, or so allege, only one of the two can legitimately have a patent on it. In foreign jurisdictions, title goes to the first party to apply for the patent.¹³ In the United States, two applications for the same invention can interfere with one another. To resolve an interference,¹⁴ objective evidence, supported by affidavits or depositions, is essential. A technology manager confronted with such a dispute cannot typically demand evidence from the contending parties and is unlikely to get any information at all from a party at a different institution. The possibility also lurks that instead of two inventors there is one inventor and one thief! Priority disputes cry out for expert legal assistance.

Resolution of joinder disputes depends upon how thoroughly the investigator is able to characterize the contributions made to the conception of the invention. Typically, pieces

of the concept spring independently to several minds. The weight of each piece is irrelevant—only quality counts. Eventually, the pieces are fitted together, perhaps in one brief conversation among less than all of the contributors or perhaps over several years and continents.

Interview the Named Inventors

The investigator must reconstruct the inventive process, annotating each recalled event with hard evidence if possible (notebooks, drawings, manuscripts, abstracts, telephone notes, e-mails, faxes, letters, notes taken at meetings, etc.) by (1) questioning at least the named inventor(s) closest to the development of the invention to understand what they believe the invention is and (2) getting a narrative of the invention's genesis, with an emphasis on who did (said, drew, calculated, looked up, talked with, went to see, tried in the lab) what, when, where, and why.

Interview the Misjoined or Nonjoined Inventors

Remember, this is a dispute. Everyone connected to the situation is potentially an inventor. *Cautionary note:* Investigation of inventorship disputes requires authority. Your knowledge of patent law and the relevant science will help, as will an attitude of objectivity, but if you do not have clear authority to investigate, petition your superiors for the funds to retain a qualified patent attorney for the purpose.

Making Corrections: Who Has to Do What?

Inventorship may change because of

- a canceled claim (loss of inventor),
- a withdrawn claim (e.g., to satisfy restriction requirement),
- an amended claim (loss or gain of inventor),
- an interference (leads to canceled claim),
- new evidence, new view of invention (no change in claims), or
- re-issue.

Under U.S. Patent Law, an attorney, the inventive entity itself, the assignee(s), the U. S. Patent and Trademark Office, or a court, all depending on specific circumstances, can correct inventorship.

When Canceling or Narrowing a Claim by Amendment during Prosecution Cancels an Inventor

Usually, the attorney of record simply files (with a fee) an amendment (by way of a petition) requesting correction because of the cancellation. The assignee is also eligible to do this,¹⁵ and, if the assignee hasn't acted, the inventors (*all* of them) who originally declared themselves inventors—including the canceled inventor—can file the amendment (but any assignee must consent).

When Adding a New Claim during Prosecution Creates an Inventor

A request (with a fee) to correct inventorship must be made, together with a statement from the added inventor(s) that they themselves intended no deception. Since an inventor-come-lately would not have signed the original declaration of inventorship, all members of the new inventive entity must sign a new declaration, and any assignees must consent.

When a Change in the Story, not in the Claims, Changes the Inventors during Prosecution

If an error in naming inventors arises without any deceptive intention during prosecution, the error is easily corrected. The attorney of record files a petition to correct, setting forth the change(s) sought. Also, each person added (or deleted) contributes a statement declaring that he or her himself or herself intended no deception in not joining (or misjoining) the inventive entity.¹⁶ Since correction changes the inventive entity, each member of the new entity must sign a declaration of inventorship. None of this is effective without the written consent of assignees¹⁷ and payment of a fee.

The foregoing steps are formalities if all parties are available to the prosecutor and the proposed change in inventorship doesn't give rise to a dispute or activate a hidden agenda. True inventors who resist an invitation to join the inventive entity, or nonjoined parties who believe they have a right to join, or misjoined parties who resist being removed, cause disputes—and problems.

When a true inventor refuses to join or cannot be reached, a problem of getting a viable declaration of inventorship arises. The other inventor(s) may file a new declaration that names the omitted inventor. According to 35 USC §116, "...the Director, on proof of the pertinent facts and after such notice to the omitted inventor as [the Director] prescribes, may grant a patent to the inventor(s) making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application." If all the inventors refuse to execute the declaration, the institution can step in if at least one has assigned his or her invention to the institution or has agreed in *writing* to do so. The institution, on proof of the pertinent facts, may serve as agent for all. Even without any assignment, a party who shows sufficient proprietary interest can exert the right of agency. The standard for proving sufficient proprietary interest, set out in MPEP 409.03(f), is substantial.¹⁸

During prosecution, a nonjoined party seeking joinder has little recourse via the patent office. As a member of the public, he or she can file a protest against the pending application if he or she can identify the application in question for the patent office.¹⁹ Subject to several rules, the patent office enters the protest into the record, but takes no other action.²⁰ True inventors should not, against their true belief, admit a party to the entity. If they do, the patent can fall because it names an inventor who did not actually invent [35 USC §102(f)] and/or because the entity or some other party in interest deceptively withheld material information from the patent office.

A misjoined party who, in order to remain joined, denies contrary facts is only making a case for deceptive intent. He or she will enjoy, at most, a Pyrrhic victory. His or her continued presence in the inventive entity would render invalid and unenforceable any patent that issues [35 USC §102(f)], thus destroying his or her asset. Fortunately, his or her assignee can remove him or her once the patent has issued (see below).

Interference

A nonjoined party with no obligation of assignment to your institution can provoke an interference in the patent office by filing the patent application (or some of its claims) a second time, this time naming himself or herself and any others he or she believes are

also true contributors. This is one reason to take care about returning rights to a discloser of what a technology manager views as a noninvention. Should the manager later see worthiness in a related invention disclosed to him or her by others, the noninvention, no longer in your institution's control, may rise up in an interference against the case the technology manager thinks is worthy.

Changing the Inventive Entity after Issuance under 35 USC §256

A nonjoined party can make his or her way onto the patent through the patent office or a court. According to the decision in *Stark v. Advanced Magnetics Inc.*, No. 95-1233 (Fed. Cir. 1997), §256 changes the old practice of summarily invalidating a patent that acquires any odor of deception whatsoever. Stark avers that §256 should operate to preserve the patent for all—but only—the true inventors. Although §256 prevents joinder of a true inventor who was deceptive about not joining (probably always a *non sequitur*), it does not invalidate a patent simply because the named inventors weren't honest when they denied entry to the nonjoined inventor. The rule that implements §256 (37 CFR §1.324) does require a statement by all parties to the effect that they agree to the correction. The correction proceeding can also take place under the aegis of a court. The commissioner issues a certificate of correction upon order of the court.

Changing the Inventive Entity by Re-issue

Misjoined noninventors may not wish to remove themselves from the inventive entity. However, according to MPEP 1412.04, if all co-owners of the patent join the proceeding and state that they believe “the original patent to be wholly or partly inoperative or invalid through error of a person being incorrectly named in an issued patent as the inventor, or through error of an inventor incorrectly not named in an issued patent, and that such error arose without any deceptive intention on the part of the applicant.” [Note: *applicant* here refers to the applicant for re-issue, i.e., the assignee(s).] The MPEP continues: “...an assignee of the entire interest can add or delete the name of an inventor by reissue (e.g., correct inventorship from inventor A to inventors A and B) without the original inventor's consent. Thus, the assignee of the entire interest can file a reissue to change the inventorship to one the assignee believes is correct, even though an inventor might disagree.”

Conclusion

The foregoing provides an annotated index of actions that a technology transfer manager can take in managing particular issues surrounding inventorship. Perhaps the most trying job, particular in academic settings, is determining who is *not* an inventor. The most unnerving is finding the hidden or forgotten inventor, i.e., the “destroyer.” The most put-off-until-later job is the most urgent one: get the declarations of inventorship, powers of attorney, and assignment documents executed *now!* And, by all means, complete that interinstitutional agreement. Also, while the inventors are in the mood, get joint inventors to agree, in writing, to their royalty splits. All of these actions reduce the likelihood of a dispute, which nobody wants because it’ll usually require a lawyer to resolve. Know the laws and policies that convey rights to the institution—technology managers typically think they know them, but don’t. Finally, enjoy the inventors. Trying as they may sometimes be, they are the best part of the job.

Notes

1. The intellectual property policy of some public institutions is statutory. If the statute explicitly provides for ownership a priori, an invention may be institutional property at the moment of conception. In general, however, the institution’s interest is secured only by the inventor’s promise to transfer ownership a posteriori.
2. In other jurisdictions, ownership falls to the applicant, who need not be an inventor.
3. The Bayh-Dole Act, and the language of many sponsored research agreements, confound the issue by stating that the sponsor enjoys certain rights to inventions “conceived or first *actually* reduced to practice” [emphasis added] during and under the contract. Individuals who first actually reduce to practice an already “complete” concept (see note 3) may not be inventors. Nevertheless, the institution where those individuals did the (noninventive) actual reduction to practice may have acquired an obligation to grant patent rights to a sponsor of the practical work, which rights it can’t obtain under any policy or law.
4. *Sole* inventor contrasts with *joint* inventor. A sole inventor may not be the *only* inventor. (See note 5.)

5. Joint inventors must communicate. If each made the same invention, unaware of the other's work (even if employed at the same place), the invention is not joint. The second to invent (under U.S. law) will not be granted a patent. Attempts to fix the situation by declaring the invention a joint effort will not be effective.
6. An intentionally concocted claim canceled during prosecution without removing its inventor from the application leaves behind a record of possible deception and a possibly fraudulent inventor declaration. One should always take care, therefore, that any such claim be a dependent claim: the standards of novelty and nonobviousness do not apply to the limitations one finds in the claim itself [*In re McCarn*, 212 F.2d 797, 101 U.S.P.Q. 411, 413 (C.C.P.A. 1954)].
7. *Chou v. University of Chicago* [254 F.3d 1344 (Fed Cir. 2001)] endorsed the view that the mere acceptance of an academic appointment, without any signed agreement at all, subjects the inventor to the administrative policies of the institution, at least under Illinois law. Even so, securing an actual executed assignment and recording it in the patent office as early as possible is preferable. Consider 37 CFR 3.71(a): "One or more assignees as defined in paragraph (b) of this section may, *after becoming of record* pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or reexamination proceeding *to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.*" [emphasis added]
8. Be careful to understand the obligation of assignment (if any) that "lesser parties," particularly students, have at your institution. If a student invents and is not required to assign, persuade the student to execute an assignment as if subject to institutional policy.
9. In complex, large-scale collaborations, a joint steering committee serves this function.
10. The CREATE Act allows information to move among research collaborators at multiple institutions without precipitating a public disclosure and permits collaborating institutions to acquire patent rights that were unavailable to disparate assignees prior to its passage. Much depends, however, upon having a written collaboration agreement in place "on or before the date the claimed invention was made."
11. What the technology manager should do and is actually able to do are two different things. Carefully drawn license agreements, therefore, make no warranties or representations that any licensed patent is or will be held valid.

12. The questions are intended to flesh out the nature of the disclosed invention, not necessarily to probe its legal novelty or nonobviousness. An invention, whether or not it is patentable, is an invention.
13. The first to file must not have *stolen* (derived) the invention.
14. Interference practice is beyond the scope of this article.
15. One of the advantages of securing assignment early is the convenience it brings to prosecution. This benefit of ownership by assignment also extends to certain corrections made without canceling a claim.
16. Since 1997, no showing of facts or of diligent effort to correct is required.
17. Note that changes in inventorship may affect information disclosure statements: bringing a new party into an inventive entity may bring with it “secret prior art” to report [*OddzOn*]. A new party might also bring a new assignee, which could affect the protections of the CREATE Act.
18. A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant.
19. This is one reason to avoid disclosing the serial number and filing date of a patent application.
20. So-called opposition practice, where protesters may take a more active part in patent prosecution, as of this writing, is not practiced in the United States. It is commonplace in other jurisdictions.