

Determining who is an Inventor Under Patent Law

©2009 Don V. Kelly

Determining who contributed to the conception of an invention is important under the patent law. United States patent law requires that all inventors of an invention must be named in a patent application. Under the law, only those persons who contribute to the conception of the invention are considered inventors under the patent law. Courts have defined conception as, "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 invention is complete and operative "if the inventor is able to make a disclosure which would enable a person of ordinary skill in the art to construct or use the invention without extensive research or experimentation."¹

With specific regard to a patent, the determination of inventorship hinges upon the content of the claims. An individual should not be listed as an inventor of a U.S. patent unless that person, individually or jointly, contributed to the conception of at least one claim of the patent. Helping reduce the invention to practice does not qualify an individual as an inventor under the patent law!

There may be more than one inventor for an invention described in a patent or described in a claim. In such case, each inventor is referred to as a "co-inventor" or a "joint inventor."

Inventors may apply for a patent jointly even though:

- (a) They did not physically work together or at the same time,
- (b) Each inventor did not make the same type or amount of contribution, or
- (c) Each inventor did not make a contribution to the subject matter of every claim of the application.

These principles raise important concerns for those interested in the patent process. In many companies that have a patent portfolio there is often pressure to give attribution to a team. Sometime, supervisors opt to reward individuals whose services were valuable in getting an invention to fruition, but who did not technically contribute to the conception of the invention. This is not just bad practice; it is an illegal act that can jeopardize the enforceability or validity of a patent. In the United States, the willful and perhaps, reckless, failure to correctly identify all of the inventors in a patent application is inequitable conduct (i.e., fraud) before the Patent

¹ *Burroughs Welcome Co. v. Bar Lab., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994), cert. denied, 516 U.S. 1070, 116 S. Ct. 771, 133 L.Ed. 2d 724 (1996).

Office. Given this, a company or an individual has no discretion insofar as identifying the proper inventors on a patent.

Don V. Kelly
Evans & Dixon, LLC
Suite 2500
211 North Broadway
St. Louis, Missouri 63102
dkelly@evans-dixon.com