

## Problems Solved & Avoided

### Identifying the Correct Inventors is Key to a Valid Patent

Under U.S. patent law, whoever “invents” patentable subject matter is entitled to a patent. A patented invention may be the work of one or more inventors. Care must be exercised in identifying joint inventors. Invention disclosure documents often include people who are connected to or involved in some way with the invention but are not really inventors. If more or less than the true inventors are named as inventors, a patent is invalid. However, when the failure to name the correct inventors occurs without deceptive intent, correction of inventorship is generally allowed. When there is deceptive intent in naming inventors, inventorship cannot be corrected and the patent is invalid and unenforceable.

The determination of proper inventorship focuses almost exclusively on conception of the invention. The courts have defined conception to be “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.” Conception is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.

In order to be a joint inventor of a patent, one must generally contribute to the conception of the invention. Inventors may apply for a patent jointly even though: they did not work together or at the same time, each did not make the same type or amount of contribution, or each did not make a contribution to every claim of the patent.

Because co-inventors need not make a contribution to the subject matter of every claim of the patent, inventorship is determined on a claim-by-claim basis. An inventorship analysis begins as a first step with a construction of each asserted claim to determine the subject matter encompassed by the claim. The second step is then to compare the alleged contributions of each asserted co-inventor with the subject matter of the properly construed claim to then determine whether the correct inventors were named.

The courts have held that a number of actions do not support a claim of joint inventorship. One who merely suggests an idea of a result to be accomplished (i.e. recognition of a need), rather than the means for accomplishing it, is not a joint inventor. A joint inventor must do more than simply explain the current state of the art to the true inventor. Similarly, merely pointing to an available product and explaining its properties will not support a claim of joint inventorship. Furthermore, offering suggestions, subsequent to conception, to make an invention safer and more workable is not sufficient to establish joint inventorship.

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