Considerations for Joinder or Non-Joinder of Parties in a Patent Application

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I. Introduction

Prior to the enactment of §256 in 1952 to the Patent Act, a patent application which listed inventors who were incorrectly joined or who were mistakenly left out made the patent that issued void.[1] Many of the older cases held that if more or less than the number of true inventors were listed in a patent, that patent was rendered unenforceable.[2] There was also some disagreement among the circuits as to whether a patent with inventors included or excluded mistakenly, rendered the patent void. Even after the enactment of 35 U.S.C. §256, some courts continued to hold that nonjoinder or misjoinder of an inventor invalidated a patent.[3]

Because of the 1952 addition of 35 U.S.C. §256 as finally interpreted by the C.A.F.C. decision in MCV Inc. v. King-Seeley[4], nonjoinder or misjoinder of inventors does not automatically make the patent to which it applies void but the court must determine if that misjoinder or nonjoinder was done with deceptive intent or there was lack of diligence in correcting the inventorship designation before a patent is voided. This makes it much more difficult for a defendant to use misjoinder or nonjoinder as a defense to patent infringement because the defendant must not only prove misjoinder or nonjoinder but must prove deceptive intent to invalidate the patent.

Thus, a claim of incorrect designation of inventorship is less important as a method of attacking an issued patent than it was formerly. Rather, the importance of inventorship designation lies in the rights which vest in the joint inventor. The joint inventor has the right to make, use, and sell the invention without the consent of the other joint inventor.[5] The joint inventor is also a co-tenant in the invention which means that he has the right to an undivided interest in the patent. It is, therefore, important for corporations, patent attorneys, and individual inventors to know when joint co-workers must be included as co-inventors on a patent application. The parties in interest in the patent application must also be concerned with the issue of when persons should be excluded from the patent application and the types of interactions with others that would require including them in the patent application.

II. Primary Authority for the Federal Courts in Deciding Patent Cases

The Court of Appeals for the Federal Circuit in the en banc decision of South Corp. v. United States has held that the foundations of its decisions are the decisions of the United States Supreme Court, the prior holdings of the Court of Customs and Patent Appeals, the Court of Claims, and the prior decisions of the Court of Appeals for the Federal Circuit.[6]. Pursuant to 28 U.S.C. §1295 and §1338, federal district courts are bound by the decisions of the C.A.F.C. in patent cases. Decisions of federal district courts and state courts may be persuasive authority if their reasoning is compelling.

III. Prerequisites for Federal Court Jurisdiction of Joint Inventorship Issues

The C.A.F.C. ruling in the MCV v. King-Seeley case established that federal courts have jurisdiction in joint inventorship cases.[7] The patent in dispute in this case concerned a drainless water cooler with gooseneck faucets mounted on the top- one for hot and the other for cold water. [8] Simon, in his capacity as marketing manager of MCV (which marketed Halsey-Taylor products), recommended to Halsey-Taylor that they manufacture the above drainless water cooler. In 1982, Halsey-Taylor decided to seek a patent on the water cooler and Simon conferred with the patent attorney on the drafting of the claims. Simon also asked to be named a joint inventor on the patent application but Halsey-Taylor refused stating that it was company policy that no non-employee be named on a company owned patent. Halsey-Taylor through King-Seeley filed a U.S. patent on the drainless water cooler which did not name Simon as a joint inventor. In 1984, Halsey-Taylor began marketing the drainless water cooler but relations between Halsey-Taylor and MCV became acrimonious and MCV terminated its marketing contract with Halsey-Taylor. [9] MCV subsequently sued Halsey-Taylor with one of the complaints being that the court should determine co-inventorship of the drainless water cooler pursuant to 35 U.S.C. §256. The District Court dismissed the case and appeal was made to the C.A.F.C.

The CAFC had to decide if a request for a court determination of inventorship and correction of a patent under 35 U.S.C. §256 is an action arising under the patent laws pursuant to 28 U.S.C. §1338(a). The court held that it was an action under the patent laws and therefore the court had jurisdiction.[10] The court explained that MCV's cause of action is created by §256 because that section specifically authorizes judicial resolution of inventorship contests over issued patents. The court further explained that before §256 was enacted:

> [P]atentees and their assignees committed inventorship errors at their peril; misjoinder or nonjoinder of an inventor rendered a patent invalid. Section 256 affords the opportunity to correct the patent...If the patentees and their assignees agree, correction can be had by application to the Commissioner. In the event consensus is not attained, however, the second paragraph of Section 256 permits redress in federal court[11].

The only prerequisite to judicial action, the court held was that all parties must be given notice and an opportunity to be heard and if that is done then the district court has jurisdiction over a matter raising a dispute over a joint inventorship issue[12]. The court then explained in more detail why a determination of joint inventorship is a case arising under federal patent law. To establish a case arising under federal patent law the plaintiff must establish some right, title, or interest under the patent laws, or at least give the appearance that a right, title, or interest will be sustained or defeated according to opposing interpretations of the patent laws.[13]Where co-inventorship is at issue, if co-inventorship were found, then the court would have to address the issue of whether the nonjoinder was "without deceptive intention" pursuant to Section 256[14]. If deceptive intention was not found then the court could permit correction of the patent but if it was found then the patent would be void.[15]. Since this determination affects the right, title, and interest in a patent, the federal courts have jurisdiction.

Where the inventorship issue is the only issue before the court, the case of Dee v. Aukerman established another jurisdictional principle in its consideration of whether the district court has jurisdiction of a case to correct inventorship in a patent application.[16] The court concluded that the intent of Congress in enacting the new versions of §116 and §256 in 1984 was to enlarge the possibilities for corrections of incorrectly named inventors and that correction of innocent errors and omissions was intended by Congress to take place before the Commissioner or in some cases the court.[17] In spite of this the court must order the plaintiff to file a more definite affidavit where she does not state in her complaint whether she was inadvertently omitted from the patent application or whether this omission was done wrongfully.[18] The court held that only if the plaintiff's claim is one of erroneous omission does the court have jurisdiction to order the correction of the patent.[19]

IV. Application of the 1984 Amendments to the Patent Act

The C.A.F.C. decided in a 1988 case, Smithkline v. Helena, that the 1984 Amendments to the Patent Act apply to all U.S. patents granted before, on, or after the date of their enactment.[20] The patent at issue in this case concerned a specimen test slide and a method for detecting hidden or invisible blood in fecal matter, which is an early symptom of a number of diseases including colorectal cancer[21]. This invention was developed by Dr. Paul Lawrence and Charles Townsley and a patent for it was issued to them on December 28, 1982, which they subsequently assigned to their employer, Smithkline Diagnostics. Defendant, Helena Laboratories attacked the validity of the patent on the ground that the true inventor or inventors was not named on the patent application in violation of 35 U.S.C. §101 (only whoever invents or discovers the patentable subject matter may obtain a patent therefor).[22] The basis of this contention was that Lawrence and Townsley's patent incorporated work of their predecessors at Smithkline. The court held that because the Lawrence and Townsley patent was restricted to built in monitors, their claims did not encompass the work of their predecessors and therefore, they are the true inventors.

Helena also attacked the patent on the ground that Lawrence and Townsley did not jointly invent every claim of the patent and they were therefore not joint inventors[23]. The court relied on §116 and §106(a) to refute this contention. §116 states that 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.[24].

Helena asserted that the current patent statute did not apply to this case because this case was pending on the day the 1984 amendments were enacted. [25] The court held, however, that the 1984 amendments did apply because §106(a) provides that with certain exceptions "the amendments made by this Act...shall apply to all United States patents granted before, on, or after the date of enactment [November 8, 1984]."[26]

Helena also asserted that §106(a) did not apply because an exception to §106(a) in 106(e) states "[T]he amendments made by this Act shall not affect the right of any party in any case pending in court on the date of enactment to have their rights determined on the basis of the substantive law in effect prior to the date of enactment." The substantive law in effect on the date of the enactment was that "a patent was invalid if it failed to name proper inventors unless the inventorship entity named was the true origin of every claim in a patent containing more than one claim, i.e. the "all claims" rule.[27] The court held that Helena's argument failed nevertheless because the "all claims" rule was never uniformly accepted by all the circuits. "Congress did not intend by the exception of 106(e) to give a litigant the right to invoke the law of a particular circuit on joint inventorship or to preserve a conflict even for a limited time."[28]

V. Conception of the Invention

To be a co-inventor, the individual must contribute to the final conception of what is covered by the claims of the subject patent.[29] The patent case law defines a conception as the formation within the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is to be applied in practice.[30] As Professor Chisum states in his treatise on patent law, there are three ingredients of conception.[31] First, the inventor must formulate and disclose a complete idea for a product or process. Second, the idea must be of a specific means of enabling the invention and not merely a desirable end result. Third, the invention must be complete to the degree that anyone of ordinary skill in the art to which it pertains could reduce that invention to practice.

The definition from which Prof. Chisum has adopted his criteria and that has been adopted by the federal courts is from the landmark decision of Mergenthaler v. Scudder[32]. In that case the Court of Appeals for the District of Columbia held that:

> The conception of an invention consists in the complete performance of the mental part of the inventive act. All that remains to be accomplished in order to perfect the act of instrument belongs to the department of construction, not invention. It is, therefore, 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 that constitutes an

> available conception with the meaning of the patent law.[33]

It is important to note that for one to be a co-inventor, he must contribute to the conception of the invention and not merely to its reduction to practice. Thus in an issue of joint inventorship, conception must be distinguished from reduction to practice to determine who the co-inventors are. As Lipscomb states in his learned treatise on patent law:

> Every invention contains two elements; a mental element and a physical one. An idea conceived by the inventor is the mental element and the application of that idea to the production of a practical result is the physical element. In order to constitute an "invention" in the sense in which that word is used in the Patent Act, an inventor must have proceeded so far as to have reduced his idea to practice and to have embodied it in some distinct physical form.[34]

Of course reduction to practice is very important since the person who first reduces an invention to practice is prima facie the first inventor. However, the person who had first conception of the invention may date his invention from his conception date provided that he shows diligence in reducing his invention to practice.[35]

Pursuant to the Mergenthaler test, a conception is not complete until it reaches the stage where a worker with ordinary skill in the art to which the invention pertains can create a working invention therefrom. Professor Chisum writes that the requirement of completeness of conception is often treated in the case law as identical to that of enablement for a patent specification.[36] In many cases conception requires experimentation to become complete and in other cases in may be complete without experimentation.[37] It is complete if as In re Tansel holds:

> It is sufficient if the inventor is able to make a disclaimer which would enable a person or ordinary skill in the art to construct the apparatus without extensive research or experimentation.[38]

However, if extensive research and experimentation is required as in the Bac v. Loomis case, then the conception is not complete.[39]

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> It may be that the necessity for a certain amount of selection of sizes of parts, materials, etc., along predetermined lines does not necessarily negative a complete conception of an invention, but where as here, an elaborate program of research, experimentation, and design of parts is necessary before an operative apparatus can be produced, it cannot properly be said that a complete conception of an invention within the meaning of the patent laws has been attained.[40]

The priority of conception can be proven only if the complete conception has been made known or disclosed in some manner.[41] The uncorroborated testimony of the inventor is not alone sufficient to establish the content, origin, or date of the conception even though such testimony is relevant and admissible in court.[42] The ways in which conception can be proven is by written descriptions, drawings, or models and though the court may be skeptical oral testimony by the inventor and corroborating witnesses even without supporting documentation or tangible evidence.[43] Probably the best way to establish corroboration of the inventor's conception is by the inventor's laboratory notebook of unquestioned authenticity as in the Ritter v. Rohm & Haas Co. case.[44]

In certain instances conception and reduction to practice can only take place simultaneously. An example of this is the case of Smith v. Bousquet which involved an interference in which the claims for priority of inventorship were for an insecticide containing two known chemical compounds.[45] The Examiner of Interferences held that neither party was entitled to a date of conception prior to reduction to practice and the court affirmed this decision because:

> [T]here is no known relation between chemical structure and insecticidal action, and therefore it is obviously impossible to predict or determine in advance of actual experiment whether or not any specific compound or group of compounds is a new and useful insecticide. In the experimental sciences of chemistry and biology this element of unpredictability frequently prevents a conception separate from actual experiment and test.[46]

Thus, where it is impossible to predict the outcome of an experiment but only a guess that the experiment will perform as hoped, then conception cannot be separate from reduction to practice.

VI. Effect of the Presumption of the Patent Grant

The court in the Idacon v. Central Forest Products, Inc. case explained that pursuant to 35 U.S.C. §§101, 102(f), and 115 that the granting of a patent raises a presumption that the named person was the inventor of the patented process and a defendant may rebut this evidence only by showing by clear and convincing evidence that there was an improper misjoinder or nonjoinder of inventors.[47] The court in the Amax Fly Ash Corp. v. U.S. case also held that the clear and convincing evidence standard applies when the plaintiff claims to be an unnamed co-inventor.[48] In Amax, the plaintiff claimed he was a co-inventor with others of the invention, but the court held that a claim of co-inventorship challenging those named on an issued patent was looked on with suspicion and could not be sustained without clear and convincing evidence, which was lacking.[49]

The burden of proof to show misjoinder was even greater in the United States Surgical Corp. v. Hospital Products International PTY Ltd. case. Here, the plaintiff, United States Surgical Corp, sued defendant Hospital Products International PTY Ltd. for patent infringement of four patented surgical stapling devices marketed under the name AUTO SUTURE.[50] The plaintiff alleged that defendant Blackman, a former USSC salesman in New York, began marketing and reproducing USSC's patented devices under the defendant's label.[51] The district court held that because of the patent office's expertise in determining whether a device is patentable, one attacking the validity of a patent must prove the invalidity by clear and convincing evidence and this burden remains with the patent challenger throughout the trial. This burden is especially high when the evidence relied on is the same as that relied on by the PTO.[52]

VII. Joint Inventorship Defined

It is unfortunate that the patent act itself does not define joint inventorship but only specifies the types of conduct that do not disprove joint inventorship. Because of this lack of definition as the Rodgard case has stated, "Joint inventorship is a muddled concept and the exact parameters of what constitutes such are difficult to

define."[53] As a result of this, the case law must be resorted to for a definition.

There are varying definitions of joint invention in the case law, which is somewhat problematic. The Monsanto v. Kamp decision holds that a joint invention is the product of the collaboration of the inventive efforts of two or more people working toward the same objective and by their combined efforts producing an invention.[54] Shields v. Halliburton gives a somewhat broader definition of a joint inventor as a person who plays at least some role in final conception of that which is sought to be patented.[55]

In order for there to be a joint invention, the inventors must work on the same subject matter and make some contribution to the inventive conception that is in the final result.[56] Each contributing inventor needs to contribute only a part of the inventive task if all the steps taken together resulted in the production of the invention.[57] To be more specific, for a joint invention[58] what is first needed is two or more inventors. Secondly, there must be a conception that those two or more inventors are working on to derive. Thirdly, it must be shown by clear and convincing evidence that those two or more persons collaborated in developing the patented device or process.[59] Fourthly, the person so claiming must show at least presumptively that the co-worker's contribution beneficially affected the final conception of the claimed invention.[60]

The level of contribution that a co-worker can make to the conception which is embodied in an invention can be considered to be a continuum from the trivial contribution to the non-obvious contribution. The case law in the discussion that follows shows that the contribution must be more than trivial to constitute joint inventorship. This case law also shows that the contribution to the joint invention need not be non-obvious as often thought but rather that the contribution to the conception need only be material.[61]

VIII. The Methods of Collaboration

There are a several variations on the theme of collaboration of inventors in the case law. The older cases such as Altoona Publix Theater v. American Tri-Ergon Corp. represent the classic scenario.[62] This case concerned a patent for recording sound on photographic film for use in talking motion pictures.[63]. The problem which the prior art had been unable to solve was that when attempting to

record sound on prior photographic recording devices there was always a distortion in the sound recorded.[64] What showed joint inventorship in this case is that the patentees had never done any work in sound recording or reproducing prior to their meeting in 1918 after which they agreed to pool their interests to work together. In addition, they agreed that neither would file patent applications in his own name. The patentees then worked together over many years, discussed ideas with one another, used a common notebook, and each of them alternatively made suggestions and performed experiments.[65] The requirement of Altoona that none of the joint inventors have conceived of the invention or worked on it prior to their agreement to work jointly is no longer a requirement for joint inventorship as is shown by many of the following cases.

The case of DeLaski & Thropp Circular Woven Tire Co. v. William R. Thropp & Sons Co. developed a second kind of collaboration that could rise to the level of joint inventorship.[66] The subject of the patent in this case was a machine for wrapping fabric around automobile tires during the course of their manufacture[67]. The court explained that it is not necessary that the same idea have occurred to each co-inventor at the same time and that they then work out its embodiment in a perfected machine.[68] Rather one co-inventor may have conceived of the entire idea of the invention but if the other co-inventor made suggestions of practical value which were of assistance in working out the main idea and making it operational, or had contributed another independent piece of the invention such that it could be combined with the other's piece to create the whole invention, then that person is a joint inventor, even if his contribution were relatively minor.[69] However, if the concept of the other person involved an independent part of the patented invention and does not contribute to the operation of the whole invention, or it is not included in the claims which cover a combination of the elements of the invention, then that person is not a joint inventor.[70]

The General Motors Corp. v. Toyota Motor Co., Ltd. provides a third method of how a prior invention may become part of a later joint invention by the combined efforts of joint inventors.[71] The Southern District of Ohio held that if several persons collaborate to produce a joint invention, the inventions of one of the joint inventors will be assimilated into the joint invention only if those conceptions and inventions were generated by the collaborative effort which produced the joint invention.[72] In addition, if the prior conception of part of an invention or of the entire invention is modified as a result

of collaboration, the modified conception or invention may become incorporated into the final conception or joint invention.[73]

A fourth method of collaborative effort which mandates joint inventorship is when in an issued patent, one joint inventor after issue claims that he is the sole inventor and denies collaboration with anyone. The case of United States Surgical Corp. v. Hospital Products International PTY Ltd. showed that where there is some dispute as to contributions of others, when a patent has issued, the presumption will favor the named joint inventors.[74] The patented device was a surgical stapling device.[75] The defendants challenged the plaintiff's '533 patent on the grounds of misjoinder of inventors.[76] The court stated that a patent for an invention made by more than one inventor must be filed in the names of all its inventors pursuant to 35 U.S.C. §116 and the fact that a patent is filed in the name of an inventor or inventors is prima facie proof of inventorship.[77] Misjoinder is the making of a patent application by one who has not contributed to the invention, which is a technical defense to patent validity that may be sustained by the defendant only by strong, clear, and convincing evidence.[78]

In this case, the defendant alleged misjoinder because inventor Green stated that he had invented by himself the design of the anvil groove in claim 22 of the '533 patent and that therefore this patent is void because of the joinder of Sultanoff and King.[79]At trial, Green testified that he did not remember any input from Soltanoff and King contributing to the invention.[80] The court, however, found contribution by Soltanoff and King because they regularly met as a group, interacted, and exchanged ideas to solve the problems of proper staple firing and formation.[81] Even though Green believed that the idea for the anvil groove was entirely his, it must have been in reality the product of all three inventors.[82]The court stated that the presumption of proper inventorship in such situations is based on the "strong temptation for honest witnesses, who have worked years with a patentee to implement his ideas, to forget whose ideas they were".[83] Joint inventorship is not inappropriate "even though the inventors did not physically work on the patent at the same time, did not make the same type or amount of contribution, or did not make a contribution to the subject of every claim of the patent".[84] For the defendant to succeed in his misjoinder argument he would need to prove that neither King nor Soltanoff made any contribution to the final conception of the anvil groove and that the invention of claim 22 is independent and distinct from the joint invention of the

other claims of the patent.[85]In this case the defendant failed to sustain his burden of proof because he failed to prove his allegations with sufficient certainty.[86]

Discussed in the Clairol case is the fifth type of collaboration, where a prior inventor created a prototype invention later altered by a second person .[87] In Clairol, Sempliner was hired to make a manicuring device and he developed the Sempliner prototype. Later, he sent the device to Clairol but subsequently he had little to do with it. [88] Burian then altered the shape of the prototype to make it more easy to handle, then redesigned the gear train and the scope of the optimal speed and diameter of the abrading disc[89]. The court held that the result of this was a collaborative effort by both inventors and not the result of either alone, so this was joint inventorship.[90] Furthermore, the court held that it was not necessary for two or more inventors to engage in give and take discussions to produce joint inventorship but only that the claims and teachings of their patent be the "synergistic result of the inextricable efforts of the co-inventors." Thus, the court held that Burrian and Sempliner were joint inventors.[91] Given the presumption of validity that attaches to patents by 35 U.S.C. §282, the defendants had the burden of proving by more than a preponderance of the evidence that Sempliner and Burrian were not joint inventors which they failed to do.[92]

IX. Activities that Inventors May Perform Without the Need to Include Others as Co-Inventors

The general rule is that an inventor may use the services, ideas, and aid of others in the process of perfecting his invention without losing the right in the patent to his sole name unless those contributions of others go so far as to be a material part of the complete and perfected invention as claimed. In that case the patent would be invalid because the real invention or discovery would belong to the one making the suggestion.[93]

The inventor need not himself perform every step needed to reduce the invention to practice.[94] The inventor is also free to use information supplied by another as background data or general information without that other person thereby becoming a joint inventor.[95] The court in the Idacon case infra held that since Dr. Santmyer and Dr Hatcher contributed only background and general information and Mr. Hirchner was the first to conceive of the invention and reduce it to practice, Mr. Hirchner was the sole

inventor.[96] In the Monsanto case previously discussed, the fact that Jahn and Kamp visited manufacturers of similar products and derived some ideas from them did not detract from the fact that Jahn and Kamp developed their invention independently and they were entitled to a patent.[97]

The Pointer v. Six Wheel Corp. case considered whether one who has performed experiments at the direction of the inventor, that result in the discovery of an important principle useful in the operation of the invention, is entitled to be named as a co-inventor of the invention[98]. The invention at issue in this case related to a six wheel attachment for motor vehicles, especially for trucks, buses, and the like, which was developed by Knox- a trained mechanical engineer.[99] The purpose of the invention was to distribute the load carried by the motor vehicle to the added wheels by removing from the rear wheels part of the weight which they bore.[100] Knox was the president of the Six Wheel Corp. which initiated an infringement action against defendant Pointer.[101] One of Pointer's affirmative defenses was to attack the validity of the Knox patent because Knox was not the sole inventor as claimed in the patent application.[102] The court stated that where

> a person has discovered an improved principle in a machine, manufacture, or composition of matter, and employs others to assist him in carrying out that principle, and they in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent as part of his invention.[103]

The court does not explain why this is so but it appears to be limited to the context of this case where there is close supervision. In that case, the reason that these suggestions belong to the directing inventor is because he is directing the co-worker in exactly what he should do, i.e. the co-worker functions as his eyes and hands. Had the inventor performed that process himself, he would have made the ancillary discovery, therefore, by right it belongs to him. This is quite clearly the outer limit of what the directing inventor can claim as his own without including the co-worker as joint inventor.

The Pointer court also stated that for a suggestion made to the inventor during the progress of these experiments (to reduce the invention to practice), to defeat the inventor's later patent these suggestions must have encompassed the planned improvement itself and must have furnished sufficient information to the person to whom it was communicated, that it would have enabled an ordinary mechanic skilled in the art to construct the invention and put it into operation, without the exercise of any unusual ingenuity on his part.[104] The court also stated the further requirement for joint invention that by clear and convincing proof the contending joint inventor must show that he and the inventor worked together to achieve a common objective which they achieved by the contribution and united effort of both.[105]

Also in the Pointer case, the defendant claimed that there was joint invention because the named inventor, Knox, had merely improved the prior invention of Stebbins.[106] The court, however, stated that this contention could not be the law because if it were, then all improvement patents would have to include the inventors of the prior patents upon which they were based as co-inventors.[107] If the defendant's theory were true then the fact that improvement patents do not in their patent applications claim the inventors of the prior patents as joint inventors means that all improvement patents are void, which cannot be the case.[108] The court also said that for joint inventorship to exist before the entire conception of the invention by one inventor, that inventor meets with another and they must agree that they will unite in using their inventive skill upon the development and perfecting of the conception.[109] In this case, there could be no joint inventorship because there was no voluntary pooling of ideas.[110] As a matter of fact, one of the individuals (Stebbins) who was working on the improved six wheel attachment after working on it for a while, thought that the idea would never work and asked Knox to take it off his hands.[111] After this occurred, Knox worked on the invention on his own and succeeded where the alleged co-inventor had failed.[112]

The Pointer case seems to conflict with the Clairol case supra in which the inventor of the prototype invention and the final complete invention were declared by the court in that case to be co-inventors. The two cases can, however, be distinguished because in the Pointer case, the prior inventor had abandoned his invention, concluding it would never work, and then turned it over to his successor.[113] In the Clairol case, however, the prototype invention was a complete

working invention in itself and the second inventor improved upon the prototype to develop an improved invention.[114]

The Metal Film Co. v. Metlon case stands for the proposition that where someone makes a specific suggestion that enables the invention to become operable, but that suggestion is one in a category with characteristics which the inventor has requested, the suggesting person does not thereby become a joint inventor.[115] Mr. Scharf of Metal Film (plaintiff) was a man who had gained considerable knowledge of yarn making through 40 years experience in the industry.[116] He thought of an idea of making non-laminated metallized yarn which was soft and strong and could be woven into commercial fabrics.[117] He later desired to develop such a yarn with a plastic coating over the metallic portion of the yarn and sought out a chemist to determine the right plastic with the desired characteristics and upon developing such a material he obtained a patent on it. [118] Defendant (Metlon) attacked plaintiff's patent on the basis that the chemist Crowell developed the chemical formulation of the plastic coating and therefore, the patent is invalid and void for failing to name Crowell as joint inventor.[119].

The court, however, found this claim to be unfounded because Scharf's patent did not claim the Crowell formulation as part of the patent but any formulation that had the same characteristics would do.[120] The court held that using the services of a chemist to help in reducing the invention to practice did not affect the validity of the patent.[121] The court stated that the use of workers to help an inventor in manual work incident to following through with his ideas and conceptions does not elevate those workers to the status of co-inventors and did not alter the status of Scharf as sole inventor.[122] Also where the inventor directs another as to exactly what he is to do to reduce the invention to practice, even if that other worker makes discoveries ancillary to the plan of the inventor, that worker is not a co-inventor.[123]

X. Types of Evidence that Show Lack of Joint Inventorship or Insufficient Evidence of Joint Inventorship

The cases discussed in this section show the difficulty one has when one challenges an issued patent based on misjoinder or nonjoinder of inventors and also illustrates some general principles about when one's activity in working with an inventor does not rise to the level of joint inventorship. The discussion here shows a number of

situations where a connection with the inventor does not establish co-inventorship. Among these are the incorporation of a prior patent in a combination patent, discovery of the principle of operation of a patent that was unknown prior to its reduction to practice, instigation of a suggestion in the mind of the inventor, use of a suggestion as the response to a particular question on the part of the inventor, and refinements which may be done by a person of ordinary skill in the art to which it pertains.

The S.W. Farber, Inc. v. Texas Instruments represents the principle that where an invention incorporates a prior patent, the patentee of the prior invention cannot be a co-inventor.[124]The subject matter of the patent at issue was a combination patent consisting of a detachable temperature regulating connector for an electrically heated device such as a cooking utensil which was issued to Foster. He later assigned it to plaintiff S.W. Farber.[125] Defendant, Texas Instruments, attacked the validity of the patent on the basis that the Foster invention used a thermostat invented by Burch as the most important component of his invention.[126] Foster had even met Burch to discuss the Burch thermostat, but Burch had no idea why Foster was interested in it and Burch suggested no application for the Burch thermostat.[127]

The court emphasized that it was Foster's idea to use the thermostat in connection with an electric frying pan.[128] Burch and Foster had not collaborated in the least on the Foster invention so that they could not have been in any way working toward a common end, which is an essential element of joint inventorship.[129] The court also stated the principle that a patent consisting of a combination of elements which uses one or more elements from a third party's invention, does not make that third party a joint inventor of that combination of elements. It is the person who invented the combination who is entitled to a patent on that combination and he is the sole inventor thereof.[130]

A second doctrine proclaimed by GAF Corp. v. Anchem Products is that one who works with an inventor on an invention, in which the principle of operation is unknown at the time of its reduction to practice but who later discovers this principle, is not entitled on that basis alone to be named a joint inventor.[131]The issue in this case was whether Dr. David Randall, an employee of GAF Corp. was the sole or joint inventor of the chemical 2-chloroethylphosphonic acid as a plant growth regulator.[132] Dr. Randall had assigned any rights to his

inventions to GAF by an employee agreement he signed in 1956.[133] The court stated that to claim inventorship prior to the issuance of a patent, the plaintiff must prove conception of the invention prior to that of the patentees by clear and convincing evidence.[134] The evidence in the case failed to prove Dr. Randall's assertion that he had conceived of the idea of using the patented chemical as a plant growth regulator prior to that of Anchem's patentees.[135] GAF also tried to claim priority for the invention on the basis that Dr. Randall was the first to explain the mechanism of how the chemical worked.[136] The court held, however, that the later explanation of the principle of operation of an invention is not patentable, even though Dr. Randall's explanation led to the discovery of other uses of the chemical.[137] Dr. Randall's explanation of the process did not entitle him to be accorded the status of a joint inventor of the plant growth regulating use of the acid because his explanation came after the invention was made and his work did not contribute to the operativeness of the completed invention.[138]

A further example of a contribution that does not rise to the level of joint inventorship is provided by the Textron case, which holds that one who makes a suggestion that merely instigates the conception of the invention in the mind of the inventor is not entitled to co-inventorship.[139]This case was an infringement action by plaintiff Huck Manufacturing against defendant Textron for manufacturing and selling plaintiff's patented Cherry T-Rivets which are blind side rivets first invented by plaintiff.[140] The defendant attacked the validity of the plaintiff's patent on the ground that Looker named on the patent application as the sole inventor, was either only a co-inventor with Frank Dobbe of the invention or that Dobbe was the sole inventor.[141] This contention was based on a phone call between Dobbe and Looker in which Dobbe suggested a Molly bolt idea as the basis of the blind rivet.[142] Looker, however, rejected this suggestion because he did not know how such a rivet could be made and because Dobbe had proposed this idea earlier and it had been rejected.[143] Dobbe's suggestion had, however, brought to Looker's mind the idea that a he could use a countersunk head lockbolt thorough a blind rivet sleeve and immediately after the phone call went to the engineering laboratory to try it out.[144] He discovered that the rivet sleeve was split in an irregular peeled back fashion which he had never seen before.[145] He then further experimented and found that he could make the peeling back effect more straight, predictable, and regular if he filed notches in the blind rivet sleeve and filed longitudinal grooves in the rivet sleeve from the notches.[146]

This resulted in a reverse curlback petal formation which Looker achieved within a few hours of the Dobbe phone call which achieved his objectives satisfactorily.[147]

The Textron court held that the fact that Dobbe presented suggestions to Looker did not mean he was a co-inventor because he suggested nothing new but only prior art ideas, his suggestion was nothing like the final Looker design, and neither of Dobbe's proposals incorporated the essential feature of forming a continuous curved finger by opposing the spreading force with the hoop strength of an unslotted sleeve.[148] The fact that Dobbe disclaimed suggesting the notched and scored idea to Looker or anyone else and also that he claimed to only have instigated Looker's invention meant that Dobbe was not a co-inventor. This was so notwithstanding Dobbe's contrary diary entries because these entries were merely self-serving.[149] The court further held that the suggestion or conception of an idea or appreciation of a result to be accomplished, rather than the means of accomplishing it, particularly when the means constitute an essential part of the invention, does not constitute joint or sole inventorship.[150] The fact that others made suggestions and possibly gave assistance does not necessarily make them inventors.

Swain and Schuessler v. Mallory established an additional doctrine which is that one who worked with the inventor on the patented invention before the patent issued and who gave a suggestion as the response to a particular question, is not entitled to be named a co-inventor especially when he is skeptical that it will work.[151]This case involved a patent related to a method of drilling oil or gas wells employing an oil-in-water emulsion as a drilling fluid.[152] This was an appeal from an interference to the Court of Appeals and Patent Interferences that awarded priority of invention to Mallory.[153] The defendants Swain and Schuessler moved for the court to strike testimony from Mallory's fellow employee Kern based on their allegation that Kern was a co-inventor of the drilling fluid and his testimony would thus be untrustworthy.[154] The court held that Kern's suggestion to Mallory that he use an emulsifier well known in the agricultural field to be tried as an emulsifier in the invention did not make Kern a co-inventor because Mallory had already conceived using an oil-in-water emulsion with a non-ionic ethylene oxide adduct and containing substantially no solids prior to his first meeting with Kern.[155] In addition, Kern was skeptical of Mallory's contention that such an emulsifier would work because it was contrary to his knowledge of the art.[156] The court further held that

what Kern did was at most to partially aid Mallory. Kern's suggestion of the use of a specific ethylene oxide was not any part of the conception of the entire invention.[157] The court states that an inventor is not precluded from using sources of specialized information in developing his invention.[158] The fact that Kern did not claim to be a co-inventor or inventor of the method patent and that he did not file a patent application is further proof that Kern was not a co-inventor and therefore Kern's testimony was admissible. [159]

In a similar vein, the district court in Alto Co. v. Fish Manufacturing Co. held that one who makes refinements to an invention which do not require any ingenuity and which may be done by a person of ordinary skill in the art, do not permit that person to be named as a joint inventor.[160]This was a patent infringement case based on a patent for a machine employing a horizontal disk knife for slicing several bakery products such as rolls all at one time.[161] The defendant alleged that the patent was invalid because Albert Schmidt, the named inventor in the patent application did not invent its subject matter but that the true inventor was William Harrison or Joseph Hagenberger.[162] The patent had been assigned to Alto Co. by Schmidt and Schaffer.[163] Schmidt was the president of a baking company and became interested in developing a machine that would slice several rolls at one time and package them because of the increased consumer demand for hot dog and hamburger rolls that developed after World War II.[164] Schmidt experimented with a device he had made beginning in 1946 using home made cutting tools and an old conveyor belt but could not arrange the cutting to prevent the rolls from being deformed.[165] He realized that he needed to bring in an experienced engineer to make refinements and adjustments to his machine to make it commercially operable.[166] This he did by contacting engineer William Harrison who made important refinements to the machine that made the machine commercially operable. Harrison later claimed that he was a co-inventor of the machine.[167]

The Alto court held, however, that Harrison was not a co-inventor because the refinements he made were such that any qualified engineer could have made.[168] Just because the engineer's contribution made the machine commercially practicable does not establish him as a joint inventor.[169] Where a person employs someone else to perform experiments to perfect his invention and that other person makes valuable discoveries ancillary to the plan

and preconceived design of the employer, those improvements are generally to be regarded as the property of the employer and the employer may use them as a part of his invention.[170] In addition, Harrison could not be regarded as co-inventor because he was familiar with patent law (having previously obtained a patent on an unrelated article) therefore he must have known of the significance of his affirmation of Schmidt's inventorship. If he were a true inventor, he would be expected to insist that he be named in the patent application which he did not do, therefore he was not a co-inventor.[171]

XI. The Effects of Misjoinder or Nonjoinder of an Inventor

Misjoinder or nonjoinder of inventors does not have the devastating effect of making a patent void which it could have prior to the MCV v. King-Seeley decision of the C.A.F.C.[172] The only time misjoinder or nonjoinder of an inventor will void a patent is if the misjoinder or nonjoinder is a result of a deceptive intent on the part of the patentee or others involved in creating the patent application or if there is lack of diligence in correcting a mistake in designation of inventorship.[173] 35 U.S.C. §116 third paragraph provides that:

> Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

The legislative history of paragraph 3 of §116 states that when a person is joined in a patent application through error, 35 U.S.C. §116 should be liberally construed in favor of applicants so that errors may be readily rectified.[174] The type of error that may be readily rectified is when the actual inventor is not named in a patent application through innocent mistake and diligent action is brought upon discovery of the error.[175]When an inventor failed to join a co-inventor in the patent application because he failed to remember the co-inventor's suggestion which was incorporated into the invention and where the named inventor was solely responsible for the construction details which made the invention complete and operable, then there is no improper misjoinder of the co-inventor.[176]

35 U.S.C. §256 establishes the procedure to be followed if there is a misjoinder or nonjoinder of inventors:

> 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 and such error arose without any deceptive intention on his part, the Commissioner 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.
>
> 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 such correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.[177]

The MCV v. King-Seeley case expands on 35 U.S.C. §256 by providing that if the patentees and their assignees agree the patent application can be corrected by application to the Commissioner of Patents and Trademarks. If the parties in interest disagree, then the district court must decide whether deceptive intent exists and if it is found void the patent. If there was no deceptive intent, the court must then decide who the correct inventors are and order the Commissioner to correct the patent.[178]

Where the action is brought in state court rather than federal court, Universal Sales Corp.,Ltd v. California Press Mfg. Co. holds that where there is misjoinder or nonjoinder of inventors with deceptive intention, the inventor wrongfully not joined has a constructive trust in the proceeds derived from the patent.[179]This case concerned the rights to a patent in a machine for pressing feed for animals into pellets.[180] Defendant and plaintiff signed a contract in which they agreed to jointly work to create an operational pellet making machine but the defendant was to apply for the patent and pay 80 percent of the expenses of its prosecution.[181] Plaintiff continued for a period of years to cooperate and improve the machine they had developed by joint experimentation.[182] After a time the defendant continued to make improvements to the machine but kept them secret from the plaintiff.[183] The court held that the defendant's

conduct in withholding information from the plaintiff as to the fabrication of the roller type press, its sale to the public, and the application for a patent violated the duty of good faith and fair dealing within the contract.[184] Therefore, conduct of the defendant in securing the patent for himself without the plaintiff was unconscionable conduct.[185] The defendant's defense that he attempted to obtain the patent through the corporation but could not because a corporation may not file for a patent in its own name and therefore the defendant filed in his own name only shows that the patent obtained by the defendant was issued to defendant and held in trust by him for the benefit of both parties.[186]

XII. Deceptive Intention

The requirement of §256 that a correctable defect of misjoinder of invention must be the result of error means that defects that are the result of deliberate decisions, intentional courses of misconduct, or gross negligence in avoiding correction by responsible and knowledgeable persons are not correctable errors.[187] Deceptive intention on "his part" in the section refers to inventors, their employees, or their privies in interest, including any attorneys acting on behalf of the applicant for the patent in question.[188] David Carstens's article on joint inventorship provides some examples of deceptive intention.[189] He states that deceptive intention is clearly present when the misjoinder or nonjoinder is done deliberately in such a way as to improve the status of the application. This could be done to eliminate a prior art rejection by joining the prior art inventor in the application. Other examples of deceptive intent occur when the inventor wishes to avoid an obligation to assign or merely to not join a co-inventor because of malice or displeasure with him.

In re Searles holds that disagreements between joint inventors over which joint inventor invented what parts of the invention is not sufficient by itself to cause misjoinder of inventors.[190]The invention in controversy in this case was a method of making cyclic sulfides. Searles had been working with a graduate student, Eugene F. Lutz, on a method of producing cyclic ethers but in the course of their experiments produced a cyclic sulfide instead.[191] After the cyclic sulfide was produced, Searles prepared and submitted a patent application to the Patent Office claiming himself as the sole inventor.[192] The examiner rejected all of his claims because the examiner found an article in the Journal of the American Chemical Society by Searles and Eugene Lutz which disclosed the above

method. [193] Searles then attempted to remove this prior reference by filing an affidavit stating that Lutz was a graduate student who had worked with him on developing the new method under his direction and that therefore, Lutz's name be added to the patent application as a co-inventor.[194]. The examiner refused to accept this affidavit as sufficient proof of joint inventorship and stated that a disclaiming affidavit by Lutz would be necessary to overcome the rejection.[195] One problem that the examiner found was that the oath signed by Searles and Lutz stated that they were the first and sole inventors and not the first and joint inventors.[196] The examiner was also troubled by the fact that in the affidavit, Lutz and Searles stated that they disagreed about who suggested a particular step in the reaction process.[197]

The court held, however, that the mere fact that there was a dispute between the parties as to who discovered, suggested, or performed one detail of the invention would not defeat a claim to joint inventorship.[198] The relationship of the parties to one another as graduate student and professor also had to be taken into account in determining joint inventorship especially because the evidence showed that Searles had suggested the deviation from the original program of experiments that yielded the final results.[199] The court also held that 35 U.S.C. §116 did not require that joint inventorship be conclusively proven before conversion of the application is allowed but the requirements of the statute and Rule 45(c) are satisfied if an allegation of joint inventorship is made together with evidence sufficient to determine the facts in relation to the error in inventorship and the lack of deceptive intent.[200] Joint inventorship need not be specifically alleged but it is sufficient if the evidence submitted shows by a preponderance of the evidence that there is joint inventorship and there was no deceptive intent which was clearly the situation here.[201]

Similarly, the court held in Manildra Mill. Corp. v. Ogolvie Mills, Inc. that when a joint inventor is erroneously omitted from a patent application because of an error in judgment, this is an erroneous omission pursuant to §256 and is correctable.[202] In this case, a group of employees developed a process for producing large wheat granule starch to be used in the manufacture of carbonless carbon paper.[203] Dr. Johnson first came up with the idea of using the large wheat granule starch. Subsequently, Dennis Adkesson, and others began work in the company laboratory to produce the starch.[204] Adkesson later was transferred to the company laboratory at

Columbus, Ohio to continue work on the project and after a short time there, entered the army.[205] Three other employees at Columbus, John Bond, John Salter, and Saul Rogols continued the project at Columbus to a successful conclusion.[206] In 1971 the in-house patent attorney, Howard Barnett, prepared and filed a patent application on this invention in which he listed only Bond, Salter, and Rogols as the inventors.[207] Johnson had not been listed because Barnett had incorrectly believed that the inventor had to be present on the site when reduction to practice took place.[208] Adkesson was not listed because Barnett believed that he was simply a helper to Dr. Johnson.[209] Barnett later added Johnson as inventor after he conducted an investigation.[210]

Subsequently, Ogilvie Mills conducted an investigation in which it determined that Adkesson should have been included on the patent application as a joint inventor and Ogilvie motioned the district court to order the application corrected.[211] The court at that time refused to order the correction because it held that the failure was due to deliberate decision or gross negligence on the part of attorneys Barnett and Collins.[212] After a motion for reconsideration, the court reversed itself because of a misunderstanding of §256, stating that the court may order correction if the movant can show by clear and convincing evidence that: "(1) the omitted person was a true joint inventor; (2) the joint inventor was omitted by error; and (3) the omission was without deceptive intent on his part." The court then held that because of the complex factual issues of factors (1) and (3), the court would defer ruling on these issues until a trial.[213] In evaluating the question of error in factor (2) the court held that error means "only those actions which are taken (or not taken) to avoid correction after the inventors, their employer, and/or their attorneys become aware that the patent or patent application is incorrect."[214] This holding was based on a decision of the C.A.F.C. In re Schmidt, in which the C.A.F.C. held that sections 116 and 256 should be given a liberal construction in favor of applicants. [215]Here there was no evidence that Barnett or Collins engaged in any activity to avoid correction, therefore the patent application was correctable.[216]

In the same way, U.S. v. Telectronics Inc holds that where there was no financial motive or other kind of motive on the part of the incorrectly included inventor,there can be no deceptive intent such as to invalidate the patent.[217] This was an infringement action against Telectronics for infringing a patent assigned to the United States by the inventors Dr. Carl Brighton, Zachary Freidenberg, and

William Redka as co-inventors for a direct current operated bone growth stimulator.[218] The device expedites the growth of bone that has been broken and is particularly useful in cases of non-union, where the bone fracture has not healed naturally within an extended period of time.[219] The defendants claimed that the patent is invalid because it should not have named William Redka as a co-inventor when his circuitry design is not sufficiently related to the patent in its entirety to justify inclusion of his name as an inventor.[220] The court was uncertain whether Redka's contribution was sufficient to justify his inclusion as a joint inventor.[221] The court, however, held that there was no evidence that his inclusion on the application as a co-inventor was with deceptive intent such as to invalidate the patent.[222] This was because defendants could not show there was an financial gain on Redka's part or any motivation by the plaintiffs to mislead the Patent Office.[223] Since there was no deceptive intent, the court ordered that the patent be corrected on notice and hearing pursuant to 35 U.S.C.§256.[224]

Contrariwise, in Eldon Industries, Inc. v. Rubbermaid, Inc., where fraud on the PTO is alleged, 35 U.S.C. §256 does not apply.[225] In Eldon, defendant, Rubbermaid argued that it could not have infringed plaintiff-Eldon's design patents on stackable letter trays and vertical sorters because Eldon committed a fraud on the PTO by failing to name Gordon McKay as a co-inventor and thus the patent was invalid.[226] The district court held that §256 provides that if there is an error in an issued patent as to the named inventors, the error may be corrected where there was no deceptive intent on the part of those named inventors, i.e. where the name of the inventor was inadvertently deleted or joined in the design patent.[227] §256 does not, however, include fraud on the PTO.[228] Where §256 is invoked to correct inventorship errors in an existing patent, the burden is on the named inventor to prove there was no deceptive intent, but when the defendant is claiming fraud on the PTO, the burden is on the defendant of proving fraud by clear and convincing evidence.[229] The elements of fraud on the PTO that the defendant must show are that the "information withheld from the PTO was material, was withheld in bad faith, and that balancing of the materiality and intent factors shows that inequitable conduct has occurred."[230] Since the only evidence that Rubbermaid offered was that the inventor's name had been deleted and Rubbermaid failed to offer any evidence of intent by the other inventors, Rubbermaid failed to prove fraud and thus this challenge to the patent's validity failed.[231]

XIII. Lack of Diligence in Correcting Inventorship Error

Equitable estoppel and laches are two common law doctrines that may cause a joint inventor to lose his right to claim joint inventorship. These doctrines make its essential that the one alleging joint inventorship inform the other joint inventors of the patent in a timely fashion. There is no statutory requirement of diligence in making an inventorship correction but the above common law doctrines have made diligence essential to preserve one's inventorship rights. David W. Carstens in his article on joint inventorship cites the Van Otteren v. Hafner[232] case for the proposition that diligence must be shown from at least the time when any doubts arose as to the identity of the inventorship entities.[233]

Equitable estoppel is one type of lack of diligence that may invalidate a patent. In the MCV v. King-Seeley case discussed earlier, the court found that MCV's claim to joint inventorship was barred by the doctrine of equitable estoppel.[234] Equitable estoppel may apply when there is

> (1)unreasonable and inexcusable delay in filing suit, (2)prejudice to the defendant as a result of the delay, (3) affirmative conduct by the party against whom estoppel is asserted inducing the belief that it had abandoned its claim, and (4) detrimental reliance by the party asserting estoppel.[235]

The court held that equitable estoppel applied in this case because Simon knew Halsey-Taylor was attempting to obtain a patent and knew what was being claimed, and therefore to preserve his rights, Simon must in a timely, explicit, and tenacious way apprise Halsey-Taylor of his claim to co-inventorship so it could be considered.[236] The court further stated;

> 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...MCV's invocation of section 256 at this late date would be to Halsey-Taylor's profound detriment because the result could be to invalidate the patent and jeopardize the business that Halsey Taylor had developed in the treated water, point-of-use, drinking equipment

> market, a market in which Halsey Taylor did not operate prior to its development of the drainless water cooler...And correction of the patent could lead to payment of royalties or perhaps loss of the type of marketing right Halsey Taylor now enjoys.[237]

Laches is a second type of lack of diligence that can result in an invalidated patent. The very recent decision in Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc. shows how a joint inventor sitting on his rights can lose them.[238] In this case, Robert Hess cross-claimed against the plaintiff Advanced Cardiovascular Systems Inc. to be added as a joint inventor in its patent for a balloon dilation catheter used to open coronary arteries, claiming he was co-inventor of the patented device.[239] Hess claimed that the patent should be corrected by the court pursuant to 35 U.S.C. §256 to include him as a co-inventor based on his affidavit listing his contributions to the invention.[240] Advanced Cardiovascular Systems moved that Hess's motion be dismissed pursuant to Rule 12(b)(6), Fed.R.Civ.P.[241] The court stated that a Rule 12(b)(6) motion should only be granted when the claimant's allegation on its face has an insurmountable obstacle to relief and one such obstacle is laches.[242] Laches requires that the moving party prove that there was:

> (1) unreasonable and inexcusable delay in the assertion of a claim and (2) material prejudice to the defendant resulting from this delay.[243]

The facts stated in Hess's brief were accepted as true by the court. Hess stated that he was first contacted by the other named inventors in 1978 as to the patent.[244] Hess then assisted in designing the catheter in a series of meetings and conversations over a three month period and the patent application was filed on April 24, 1978.[245] The patent then issued on April 6, 1982.[246] The court held that it did not matter that Hess had no knowledge that the named inventors planned to patent the invention because the existence of the patent is considered by the law to be notice to the world of its existence.[247] Since Hess did not file his claim until August, 1990, more than eight years after the patent issued in April, 1982; this eight year delay was unreasonable.[248] Because the plaintiff's lawsuit has been in progress since 1987, it had already been heard in the Federal Circuit, and extensive discovery has been completed; this inventorship controversy would delay full trial of the central issues of the case for a still longer period.[249] This is clearly material

prejudice to ACS and because Hess's delay is unexcused, the court found laches and dismissed his motion to intervene pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.[250]

XIV. Correction of Inventorship Designation

When the parties in interest have a dispute over inventorship designation, then the parties must go to federal district court to resolve it. As discussed above in the MCV v. King-Seeley case when joint inventorship is at issue the court must address the issue of whether there was deceptive intention or lack of diligence in correcting the error that caused the misjoinder or nonjoinder pursuant to 35 U.S.C. §256.[251] If the court found no deceptive intention or lack of diligence, then the court could permit correction of the inventorship designation by ordering the Commissioner of Patents and Trademarks to issue a certificate of correction. If deceptive intention or lack of diligence were found then the court would order the patent voided.

The mechanics of correcting an erroneous inventorship designation when the parties in interest agree to correct it, is described in §1.48 of 47 C.F.R. and in §201.03 of the Manual of Patent Examining Procedure. C.F.R. §1.48(a) explains that the application can be changed if the error occurred without deceptive intent on the part of the actual inventor or inventors.[252] The patent application must be amended to name only the true inventors and must be diligently made. As discussed above, diligence means that correction must be made as soon as there are any doubts about the correctness of the inventorship designation. First, the amendment must be accompanied by a petition with a statement of facts which has been verified by the true inventor or inventors which describes how the error without deceptive intention was discovered and how the error occurred.

Second, there must be included an oath or declaration by each inventor or inventors that satisfies the requirements of §1.63.[253] §1.63 requires that the oath be made before a person who is authorized to administer oaths[254] or that a declaration is made which contains a warning that willful false statements are punishable by fine, imprisonment, or both and that such false statements will jeopardize the validity of the patent.[255] The oath must also identify that it is directed to the correction of inventorship amendment; identify the inventor or inventors, their residence, and their respective countries of citizenship; and state whether the inventor is

a joint or sole inventor.[256] Subsection (b) then explains that the oath or declaration must state that the person making it has reviewed the application and understands it including any amendments thereto, that he believes the inventor or inventors named are the true inventors, and that he recognizes the obligation to disclose any material information to the examination of the application.[257] In addition, §1.48(a) requires that the fee set forth in §1.17(h) and the written consent of any assignee be included in the amendment.

§1.48(b) cautions applicants that if the correct inventors were named in the original application when filed but the prosecution of the application results in the amendment or cancelling of some claims so that not all of the originally named inventors are the actual inventors of the claims in the application, then an amendment must be filed which has deleted the names of those who are not the true inventors.[258] This section requires that the amendment be filed diligently and include a petition which identifies all inventors who are deleted from the application and the fee required by §1.17(h).

When there is a misjoinder of invention and 35 U.S.C. §256 is inadequate to allow correction, then 35 U.S.C. §251 permits correction by means of a reissue of the patent.[259] 35 U.S.C. §251 provides that:

> Whenever any patent is through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing...the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent,...for the unexpired part of the term of the original patent.

The holding in Stoddard v. Dann expands upon §251 by providing that even if none of the correct inventors was named in the original patent application, the patent may be corrected through reissue to name the true inventors.[260] It was undisputed in that case that a Belgian, Jean Hospied, was the true inventor of the patented invention.[261] Hospied's patent application was filed in Belgium by Olaf Walser on behalf of the company which owned the Belgian patent. Because Walser's name was on the Belgian patent, when the U.S. patent was filed, the space for the inventor's signature erroneously contained Walser's name without any deceptive intent. Shortly after the patent issued, the patent attorneys for Hospied and

Walser advised them of the error and all parties involved diligently attempted to correct the patent.[262] Stoddard & Co. the owner of the U.S. patent filed a reissue application to correct the error and Hospied the true inventor executed the reissue declaration. The patent examiner rejected the reissue application on the ground that the inventorship corrections could not be made under 35 U.S.C. §116 because it does not authorize the deletion of the name of one sole inventor and the substitution of the name of another sole inventor.[263] Both the Patent Board of Appeals and the district court upheld the examiner's decision.[264]

Chief Judge Markey of the Court of Customs and Patent Appeals stated that the fact that the true inventor was not named in the original U.S. patent does not produce any constitutional bar to the correction of the inventor because the constitutional objective can only be served by the requested correction.[265] The court stated that:

> ...[O]ne of the constitutional objectives is to establish a patent system based on justice, wherein honesty and candor are encouraged, not penalized. Indeed, as with all human systems, the patent system cannot stand if long sullied by dishonesty; it like all of mankind's endeavors, must be constantly nourished and given strength by daily and continuing infusion of candid fairness. ...But justice, if it is to result from honesty and candor, must be a two way street, on which both applicant and government travel...The filing documents show Walser as the inventor. We know now that the inventor was Hospied. To permit the requested substitution of names would on this record harm no one. To deny the requested correction, on the other hand would serve no useful purpose, would frustrate the constitutional objective, would exalt form over substance, and would punish Stoddard's commendable candor, all to the injury of the patent system and to him to whom it must appeal, i. e., the inventor...Congress having provided for the correction of innocent error in stating the inventive entity when the application, whether that entity be singular or plural, we see no rational reason to discriminate against the correction of the same innocent error involving sole inventors and their assignees, or to impute that intent to Congress.[266]

In the practical world of patent practice, a good faith determination of who the true inventors of a patent are must be done using the principles as discussed above. If the determination of whether to include someone as a joint inventor is not clear, it is better to include the potential or putative co-inventors than to exclude someone who might be an actual co-inventor.[267] When an application is challenged by way of interference or litigation after the patent is on file or the patent has issued, the true facts must be adduced objectively from affidavits or testimony to effect correction.

XV. Rights of Joint Inventors as Joint Owners

The ownership rights of joint inventors as joint owners of a patent are provided by 35 U.S.C. §262:

> In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, or sell the patented invention without the consent of and without accounting to the other owners. [268]

The case law expands upon the statute and provides other rights. Drake v. Hall holds that letters patent may be issued to joint inventors as joint patentees and each of the patentees becomes vested with an undivided one-half interest therein, and entitled to the use thereof without accountability to the other cotenant and no relationship of copartnership is involved.[269] In addition, agreements between co-owners of patents are not licensing agreements, in that co-owner may make, use, or sell patented invention without consent and without accounting to other co-owners unless there is agreement to the contrary.[270]

Additionally pursuant to Ex-Cell-O Corp. v. Litton Industrial Products, Inc. a sale of the co-inventors' invention to the other co-inventor is not a sale under the patent statute, which means that the one year statutory bar does not here apply.[271] In this case, plaintiff, Ex-Cell-O, sought a declaratory judgment that the patent of Litton Industries on a automatically controlled boring, drilling, and milling machine with automatic tool changing capability was invalid and unenforceable.[272] One of the plaintiff's claims was that the defendant's invention could not be patented because of the statutory one year bar where an invention is on sale in the U.S. more than one year prior to filing for the patent.[273]. The court found, however, that there was no sale because the parties to the supposed sale Seager of Eimco and Stephan

of Lucas were joint inventors of the machine.[274] Support for this contention came from the fact that Lucas was the primary builder of the machine but Eimco undertook to design the machine and have it built by a subcontractor.[275] Also many of the decisions regarding the machine resulted from discussions between Seager and Stephan.[276] Additionally, the facts surrounding the filing of the patent application and the eventual assignment of the sole ownership of the patent showed joint inventorship rather than sale because Lucas negotiated in obtaining a patent on the machine developed by Seager and Stephan by negotiating with Eimco.[277] The eventual agreement provided that Eimco would not exercise its right to assignment of Seager's patent rights and Seager would assign those rights to New Britain Machine Co. of which Lucas was a division and Seager was to receive in exchange a payment of $500.00. if and when the patent was granted.[278] Thus, as a sale between joint inventors, the statutory one year on sale bar did not apply.[279]

A further right that joint inventors have is that their interests in the patent are indivisible and cannot be split claim by claim which is a holding of the Aetna Standard Engineering Co. v. Rowland case.[280] This case concerned patent rights in an invention designed by defendant Rowland for a plug mill receiving table.[281] After completing the design Rowland signed a disclosure document naming his supervisor Remner as joint inventor and signed a patent application naming himself and Remner as joint inventors.[282] After Rowland was laid off from Aetna Standard, he refused to assign his interest in the patent to Aetna.[283] The court held that since Aetna made no claim to the invention until after it had laid off Rowland and there was no agreement by Rowland to assign any inventions he made to Aetna, Rowland retained his interest in the patent.[284] Because Remner had assigned his interest to Aetna, Aetna now had a one-half interest in the patent because the case law established that joint inventors or co-owners of a patent have indivisible rights to the entire patent which cannot be fragmented into claim by claim interests.[285]

XVI. Conclusion

Because of the rights which accrue to joint inventors and the presumption that the inventors named in an issued patent are the true inventors it is important that inventors in a patent application be correctly named. If there is no disagreement between the interested parties as to the joint inventors and a nondeceptive error

has been made, a petition to the Commissioner will correct the mistake. If there is disagreement among the parties, then there must be a proceeding in the district court to determine whether there was any deceptive intent which may void the patent. If there was no deceptive intent found by the court, the court must determine the identity of the true inventors and order the Commissioner of Patents and Trademarks to issue a corrected patent certificate. If profits from the patent were received by one inventor who with deceptive intent failed to include another, then the fractional share of those profits which are rightfully owed to the excluded inventor must be held in constructive trust for him.

The cases show that one must be included as a joint inventor if one contributes to the final conception of any of the claims of the issued patent, even if that conception is not as great as those of the other inventors. The contribution must not be a mere refinement of an invention to improve its operability because if it is, that person cannot be considered a joint inventor. Because of the complicated nature of inventorship, there are several alternative ways that collaborative effort can rise to the level that mandates inclusion of a co-worker as a joint inventor. The inventor and patent attorney should realize who those persons are that they must include in their patent application so that corrections may be made, if necessary, with due diligence so that inventorship rights are not lost.

Endnotes

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[1] An appendix is attached to the end of this article for the reader's convenience in referring to the applicable sections of the patent statute (35 U.S.C.), the patent rules (37 C.F.R.), and the Manual of Patent Examining Procedure (M.P.E.P.).

[2] Milwaukee v. Activated Sludge, Inc. 69 F.2d 577, 21 U.S.P.Q. 69 (7th Cir 1934).

[3] Jamesbury Corp. v. U.S., 518 F.2d 1384 (Ct.Cl. 1975).

[4] MCV Inc. v. King-Seeley Thermos Co., 870 F.2d 1568,_, 10 U.S.P.Q.2d 1287, 1289 (Fed. Cir. 1987).

[5] 35 U.S.C.A.. §262 (1991).

[6] South Corp. v. United States, 690 F.2d 1368, 215 U.S.P.Q. 657 (Fed. Cir. 1982).

[7] MCV at _, 10 U.S.P.Q.2d at 1287.

[8] Id. at _, 10 U.S.P.Q.2d at 1288.

[9] Id. at _,.10 U.S.P.Q.2d at 1289.

[10] Id.

[11] Id.

[12] Id.

[13] Id. at _, 10 U.S.P.Q.2d at 1290.
[14] Id.
[15] Id.
[16] Dee v. Aukerman, 625 F.Supp. 1427 (S.D.Ohio 1986).
[17] Id. at 1429.
[18] Id. at 1430.
[19] Id.
[20] Smithkline v. Helena, 859 F.2d 878,_, 8 USPQ.2d 1468, 1477 (Fed. Cir. 1988)
[21] Id. at _, 10 U.S.P.Q.2d at 1471.
[22] Id. at _, 10 U.S.P.Q.2d at 1476.
[23] Id.
[24] 35 U.S.C.A.. §116 (1991).
[25] Smithkline at _, 8 U.S.P.Q..2d at 1477
[26] Id.
[27] Id.
[28] Id.
[29] Idacon v. Central Forest Products, Inc., 3 U.S.P.Q.2d 1079, 1088 (E.D.OK 1986).
[30] Id.
[31] D. Chisum, 3 Patents 10-48 (1991).
[32] 1897 C.D. 724, 731 (D.C. Cir. 1897).
[33] Id.
[34] E. B. Lipscomb III, 1 Lipscomb's Walker on Patents 224 (1991).
[35] Id. at 228.
[36] 3 D.Chisum at 10-61.
[37] Id. at 10-62.
[38] 253 F.2d 241, 243, 117 U.S.P.Q. 188, _ (C.C.P.A. 1958).
[39] 252 F.2d 571, 117 U.S.P.Q. 29 (C.C.P.A. 1958)
[40] Id.
[41] 3 D.Chisum at 10-53.
[42] Id. at 10-54.
[43] Id. at 10-56.
[44] 271 F.Supp. 313, 320-321, 154 U.S.P.Q. 518, _ (S.D.N.Y. 1967).
[45] 111 F.2d 157, 45 U.S.P.Q. 347 (C.C.P.A. 1940).
[46] Id. at 159, 45 U.S.P.Q. at _.
[47] Idacon at 1079, 1088.
[48] Amax Fly Ash Corp. v. U.S. 514 F.2d 1041, 1050 (Ct.Cl 1975).
[49] Id.
[50] United States Surgical Corp. v. Hospital Products International PTY Ltd., 9 U.S.P.Q.2d 1241, 1243 (D.Conn. 1988).
[51] Id. at 1244.
[52] Id. at 1253.
[53] Rodgard Corp. v. Miner Enterprises, Inc., 12 U.S.P.Q.2d 1353 (W.D.N.Y. 1989).
[54] Monsanto v. Kamp, 269 F.Supp 818,_, 154 U.S.P.Q. 259, 262 (D.DC 1967).

[55] Shields v. Halliburton, 493 F.Supp. 1376, aff'd 667 F.2d 1232 (W.D.La. 1980).
[56] Monsanto at _, 154 U.S.P.Q. at 262 (D.DC 1967).
[57] Id.
[58] E. B. Lipscomb III, 1 Lipscomb's Walker on Patents 201 (1991).
[59] Pointer v. Six Wheel Corp., 177 F.2d 153, 83 U.S.P.Q. 43 (9th Cir 1949).
[60] Mueller Brass Co. v. Reading Industries, 352 F.Supp. 1357, 176 U.S.P.Q. 361 (E.D.Pa. 1972).
[61] The use of the word "material" to describe the contribution to the conception of the invention required to constitute joint invention was suggested in a personal conversation with Professor Karl Jorda of Franklin Pierce Law Center.
[62] Altoona Publix Theater v. American Tri-Ergon Corp., 72 F.2d 53, 22 U.S.P.Q. 8 (3rd Cir. 1934), rev'd on other grounds, 294 U.S. 477, 24 U.S.P.Q. 308 (1935).
[63] Id. at _, 22 U.S.P.Q. at 9.
[64] Id.
[65] Id. at _, 22 U.S.P.Q. at 12.
[66] DeLaski & Thropp Circular Woven Tire Co. v. William R. Thropp & Sons Co. 218 F. 458, 465 (D.N.J. 1914).
[67] Id.
[68] Id. at 464.
[69] Id.
[70] Id.
[71] General Motors Corp. v. Toyota Motor Co., Ltd., 205 U.S.P.Q. 158 (S.D.Ohio 1979).
[72] Id. at 179.
[73] Id.
[74] United States Surgical Corp. at 1241.
[75] Id.
[76] Id. at 1262.
[77] Id.
[78] Id.
[79] Id.
[80] Id.
[81] Id.
[82] Id. at 1263.
[83] Id.
[84] Id.
[85] Id.
[86] Id.
[87] Clairol v. Save-Way Industries, 210 U.S.P.Q. 459 (S.D.Fl 1980).
[88] Id. at 465.
[89] Id.
[90] Id.
[91] Id.

92 Id., The court also held that prototypes created by a joint inventor are not prior art within §103
93 Rodgard at 1356.
94 Idacon at 1088.
95 Id.
96 Id.
97 Monsanto at _, 154 U.S.P.Q. at 259, 262-263.
98 Pointer at 153, 83 U.S.P.Q. at 43.
99 Id. at _, 83 U.S.P.Q. at 45.
100 Id.
101 Id.
102 Id. at _, 83 U.S.P.Q. at 46.
103 Id.
104 Id. at _, 83 U.S.P.Q. at 47.
105 Id.
106 Id.
107 Id.
108 Id.
109 Id.
110 Id.
111 Id.
112 Id. at _, 83 U.S.P.Q. at 48.
113 Id.
114 Clairol at 459.
115 Metal Film Co. v. Metlon, 316 F.Supp 96, 167 U.S.P.Q. 267 (S.D.N.Y. 1970).
116 Id.
117 Id. at _, 167 U.S.P.Q. at 268.
118 Id. at _, 167 U.S.P.Q. at 275.
119 Id.
120 Id.
121 Id.
122 Id.
123 Id. at _, 167 U.S.P.Q. at 276.
124 S.W. Farber, Inc. v. Texas Instruments, Inc., 211 F.Supp 686, 135 U.S.P.Q. 394 (D.Del 1962).
125 Id. at _, 135 U.S.P.Q. at 395.
126 Id. at _, 135 U.S.P.Q. at 398.
127 Id.
128 Id.
129 Id.
130 Id.
131 GAF Corp. v. Anchem Products, 574 F.Supp 943, 211 U.S.P.Q. 172 (E.D.Pa 1981).

[132] Id. at _, 211 U.S.P.Q. at 191.
[133] Id.
[134] Id.
[135] Id.
[136] Id. at _, 211 U.S.P.Q. at 197.
[137] Id.
[138] Id. at _, 211 U.S.P.Q. at 198.
[139] Huck Manufacturing v. Textron, 187 U.S.P.Q. 388 (E.D.Mich 1975)
[140] Id.
[141] Id.
[142] Id.
[143] Id.
[144] Id.
[145] Id.
[146] Id.
[147] Id.
[148] Id. at 404.
[149] Id.
[150] Id. at 407.
[151] Swain and Schuessler v. Mallory, 329 F.2d 982, 141 U.S.P.Q. 209 (C.C.P.A. 1964).
[152] Id. at _, 141 U.S.P.Q. at 210.
[153] Id.
[154] Id. at _, 141 U.S.P.Q. at 215.
[155] Id. at _, 141 U.S.P.Q. at 217.
[156] Id. at _, 141 U.S.P.Q. at 216.
[157] Id. at _, 141 U.S.P.Q. at 217.
[158] Id.
[159] Id.
[160] Alto Co. v. Fish Manufacturing Co., 158 F. Supp 752, 116 U.S.P.Q. 331 (D.N.J 1957).
[161] Id. at _, 116 U.S.P.Q. at 332.
[162] Id.
[163] Id.
[164] Id. at _, 116 U.S.P.Q. at 333
[165] Id.
[166] Id.
[167] Id. at _, 116 U.S.P.Q. at 334.
[168] Id.
[169] Id.
[170] Id.
[171] Id. at _, 116 U.S.P.Q. at 335.

[172] MCV at 1289.
[173] 35 U.S.C.A.. §116 (1991).
[174] P.L. 98-622, 98 Stat. 5834 (1984).
[175] A.F. Stoddard & Co. v. Dann, 564 F.2d 556 (D.C. Cir. 1977).
[176] Garrett Corp. v. U.S., 422 F.2d 874 (Ct.Cl. 1970).
[177] 35 U.S.C.A.. §256 (1991).
[178] MCV v. King-Seeley at 1289.
[179] Universal Sales Corp.,Ltd v. California Press Mfg. Co., 20 Cal.Rptr.2d 751, 128 P.2d 665, 55 U.S.P.Q. 107 (Cal 1942).
[180] Id. at _, 128 P.2d at _, 55 U.S.P.Q. at 110.
[181] Id.
[182] Id. at _, 128 P.2d at _, 55 U.S.P.Q. at 113.
[183] Id. at _, 128 P.2d at _, 55 U.S.P.Q. at 118.
[184] Id.
[185] Id.
[186] Id.
[187] Rival Mfg. Co. v. Dazey Products Co., 358 F.Supp. 91 (D.C.Mo. 1973).
[188] Id.
[189] Carstens., Joint Inventorship Under 35 U.S.C. §116, 73 J.Pat.Off.Soc'y 617, 637 (August 1991).
[190] In re Searles, 422 F.2d 431, 164 U.S.P.Q. 623 (C.C.P.A. 1970).
[191] Id. at _, 164 U.S.P.Q. at 624.
[192] Id.
[193] Id.
[194] Id.
[195] Id.
[196] Id.
[197] Id. at _, 164 U.S.P.Q. at 627.
[198] Id.
[199] Id.
[200] Id.
[201] Id. at _, 164 U.S.P.Q. at 628.
[202] Manildra Mill. Corp. v. Ogolvie Mills, Inc., 745 F.Supp. 653 (D.Kan. 1990).
[203] Id. at 654.
[204] Id.
[205] Id.
[206] Id.
[207] Id.
[208] Id.
[209] Id.
[210] Id.
[211] Id.

212 Id.
213 Id.
214 Id. at 656.
215 Id.
216 Id.
217 U.S. v. Telectronics Inc., 3 USPQ.2d 1571 (D. Colo. 1987).
218 Id. at 1571.
219 Id. at 1572.
220 Id. at 1580.
221 Id.
222 Id.
223 Id. at 1581.
224 Id.
225 Eldon Industries, Inc. v. Rubbermaid, Inc., 735 F.Supp. 786, 817 (N.D.Ill. 1990).
226 Id.
227 Id.
228 Id.
229 Id.
230 Id.
231 Id.
232 126 U.S.P.Q. 432 (W.D. Mo. 1973).
233 73 J.Pat.Off.Soc'y at 638.
234 MCV at _, 10 USPQ.2d at 1290.
235 Id.
236 Id. at _, 10 USPQ.2d at 1292.
237 Id. at _, 10 USPQ.2d at 1290.
238 Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 20 U.S.P.Q.2d 1870 (D.Minn. 1991).
239 Id. at 1871.
240 Id.
241 Id.
242 Id.
243 Id. at 1872.
244 Id.
245 Id.
246 Id.
247 Id.
248 Id.
249 Id.
250 Id.
251 MCV at _, 10 USPQ.2d at 1289.

252 47 C.F.R. §1.48(a)(1989).
253 Id.
254 47 C.F.R. §1.66(1989).
255 47 C.F.R. §1.68(1989).
256 47 C.F.R. §1.63(a)(1989).
257 47 C.F.R. §1.63(b)(1989).
258 47 C.F.R. §1.48(b)(1989).
259 M.P.E.P. §1402(1989).
260 Stoddard at 556.
261 Id. at 558.
262 Id. at 559.
263 Id. at 560.
264 Id. at 561.
265 Id. at 562.
266 Id. at 562-566.
267 Personal conversation with Professor Karl Jorda of Franklin Pierce Law Center.
268 35 U.S.C.A. §262 (1991).
269 Drake v. Hall, 220 F. 905, 136 C.C.A. 471 (D.Ill. 1914).
270 Lemelson v. Synergistics Research Corp., 669 F.Supp. 642 (S.D.N.Y. 1987).
271 Ex-Cell-O Corp. v. Litton Industrial Products, Inc. 205 U.S.P.Q. 613 (E.D. Mich. 1979).
272 Id. at 616.
273 Id.
274 Id. at 629.
275 Id.
276 Id.
277 Id.
278 Id.
279 Id.
280 Aetna Standard Engineering Co. v. Rowland, 228 U.S.P.Q. 292 (PA 1985).
281 Id. at 296.
282 Id.
283 Id.
284 Id.
285 Id.

Appendix

PATENT LAWS

35 U.S.C. 116 Inventors.

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. 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.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor 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.

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 6(a), 96 Stat. 320; Nov. 8, 1984, Public Law 98-622, sec. 104(a), 98 Stat. 3384.)

35 U.S.C. 251 Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less then he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. 252 Effect of reissue.

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but insofar as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

35 U.S.C. 256 Correction of named inventor.

Whenever through error a person is named in an iss patent as the inventor, or through error an inventor is not nar in an issued patent and such error arose without any decept intention on his part, the Commissioner may, on applicatio all the parties and assignees, with proof of the facts and s other requirements as may be imposed, issue a certific correcting such error.

The error of omitting inventors or naming persons who not inventors shall not invalidate the patent in which such e occurred if it can be corrected as provided in this section. T court before which such matter is called in question may or correction of the patent on notice and hearing of all par concerned and the Commissioner shall issue a certificate cordingly.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 6(b), 96 S 320.)

35 U.S.C. 262 Joint owners.

In the absence of any agreement to the contrary, each of t joint owners of a patent may make, use or sell the patent invention without the consent of and without accounting to t other owners.

§ 1.45 Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in an application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116.

[Paras. (b) & (c), 47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985]

§ 1.46 Assigned inventions and patents.

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 1.334.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the omitted inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and by the required fee (§ 1.17(h)) and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he or she had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and by the required fee (§ 1.17(h)) and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.48 Correction of inventorship.

(a) If the correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by (a) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred; (b) an oath or declaration by each actual inventor or inventors as required by § 1.63; (c) the fee set forth in § 1.17(h); and (d) the written consent of any assignee. When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

(b) If the correct inventors are named in the application when filed and the prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are not inventors of the invention being claimed. The amendment must be diligently made and shall be accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and

(2) The fee set forth in § 1.17(h).

(c) If an application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended pursuant to paragraph (a) of this section to add claims to the subject matter and name the correct inventors for the application.

[OMB Control No. 0651-0018]

[48 FR 270-9, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985]

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(a)(2) as a part of an application must:

(1) Be executed in accordance with either § 1.66 or § 1.68;

(2) Identify the specification to which it is directed;

(3) Identify each inventor and the residence and country of citizenship of each inventor; and

(4) State whether the inventor is a sole or joint inventor of the invention claimed.

(b) In addition to meeting the requirements of paragraph (a), the oath or declaration must state that the person making the oath or declaration:

(1) Has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration;

(2) Believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(3) Acknowledges the duty to disclose information which is material to the examination of the application in accordance with § 1.56(a).

(c) In addition to meeting the requirements of paragraphs (a) and (b) of this section, the oath or declaration in any application in which a claim for foreign priority is made pursuant to § 1.55 must identify the foreign application for patent or inventor's certificate on which priority is claimed, and any foreign application having a filing date before that of the application on *which priority is claimed, by specifying the application number*, country, day, month and year of its filing.

(d) In any continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, the oath or declaration must also state that the person making the oath or declaration acknowledges the duty to disclose material information as defined in § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983]

§ 1.64 Person making oath or declaration.

(a) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, or 1.47.

(b) If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor and, upon information and belief, the facts which the inventor is required to state.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983]

§ 1.45 Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in an application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116.

[Paras. (b) & (c), 47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985]

§ 1.46 Assigned inventions and patents.

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 1.334.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the omitted inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and by the required fee (§ 1.17(h)) and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he or she had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and by the required fee (§ 1.17(h)) and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.48 Correction of inventorship.

(a) If the correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by (a) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred; (b) an oath or declaration by each actual inventor or inventors as required by § 1.63; (c) the fee set forth in § 1.17(h); and (d) the written consent of any assignee. When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

(b) If the correct inventors are named in the application when filed and the prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are not inventors of the invention being claimed. The amendment must be diligently made and shall be accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and

(2) The fee set forth in § 1.17(h).

(c) If an application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended pursuant to paragraph (a) of this section to add claims to the subject matter and name the correct inventors for the application.

[OMB Control No. 0651-0018]

[48 FR 270-9, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985]

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(a)(2) as a p of an application must:

(1) Be executed in accordance with either § 1.66 or § 1.6

(2) Identify the specification to which it is directed;

(3) Identify each inventor and the residence and country citizenship of each inventor; and

(4) State whether the inventor is a sole or joint inventor the invention claimed.

(b) In addition to meeting the requirements of paragraph (the oath or declaration must state that the person making the oa or declaration:

(1) Has reviewed and understands the contents of the spec fication, including the claims, as amended by any amendme specifically referred to in the oath or declaration;

(2) Believes the named inventor or inventors to be t original and first inventor or inventors of the subject matt which is claimed and for which a patent is sought; and

(3) Acknowledges the duty to disclose information whi is material to the examination of the application in accordan with § 1.56(a).

(c) In addition to meeting the requirements of paragraphs (and (b) of this section, the oath or declaration in any applicatio in which a claim for foreign priority is made pursuant to § 1.5 must identify the foreign application for patent or inventor certificate on which priority is claimed, and any foreign appl cation having a filing date before that of the application o which priority is claimed, by specifying the application numbe country, day, month and year of its filing.

(d) In any continuation-in-part application filed under th conditions specified in 35 U.S.C. 120 which discloses an claims subject matter in addition to that disclosed in the prio copending application, the oath or declaration must also stat that the person making the oath or declaration acknowledges th duty to disclose material information as defined in § 1.56(a which occurred between the filing date of the prior applicatio and the national or PCT international filing date of the continu ation-in-part application.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983]

§ 1.64 Person making oath or declaration.

(a) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, or 1.47.

(b) If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor and, upon information and belief, the facts which the inventor is required to state.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983]

§ 1.66 Officers authorized to administer oaths.

(a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

[OMB Control No. 0651-0011]

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982]

§ 1.67 Supplemental oath or declaration.

(a) A supplemental oath or declaration meeting the requirements of § 1.63 may be required to be filed to correct any deficiencies or inaccuracies present in an earlier filed oath or declaration.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed: (1) When a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented; and (2) When an oath or declaration submitted in accordance with § 1.53(d) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into an application after its filing date even if a supplemental oath or declaration is filed (§ 1.53(b); § 1.118). In proper cases the oath or declaration here required may be made on information and belief by an applicant other than inventor.

[OMB Control No. 0651-0011]

[48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.68 Declaration in lieu of oath.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

[OMB Control No. 0651-0011]

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

§ 1.69 Foreign language oaths and declarations.

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by a verified English translation, except that in the case of an oath or declaration filed under § 1.63 the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

[OMB Control No. 0651-0011]

[42 FR 5594, Jan. 28, 1977; para. (b), 48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983]

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201 Types of Applications [R-11]

37 CFR 1.9 Definitions.

(a) A national application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111 or which resulted from an international application after compliance with 35 U.S.C. 371.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

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>*National applications (35 U.S.C. 111) vs. National Stage applications (35 U.S.C. 371)*

Treatment of national applications under 35 U.S.C. 111 and national stage applications under 35 U.S.C. 371 are similar but not identical. Note the following examples:

(1) Restriction practice under MPEP § 806+ is applied to national applications under 35 U.S.C. 111 while unity of invention practice under MPEP § 1898.07(c) is applied to national stage applications under 35 U.S.C. 371.

(2) National applications filed under 35 U.S.C. 111 without an executed oath or declaration or filing fee are governed by the notification practice set forth in 37 CFR 1.53(d) while national stage applications filed under 35 U.S.C. 371 without an oath or declaration or national stage fee must be completed within 22 months from the priority date as set forth in 37 CFR 1.494.

National patent applications fall under three broad types: (1) applications for patent under 35 U.S.C. 101 relating to a "new and useful process, machine, manufacture, or composition of matter, etc."; (2) applications for plant patents under 35 U.S.C. 161; and (3) applications for design patents under 35 U.S.C. 171. The first type of patents are sometimes referred to as "utility" patents or "mechanical" patents when being contrasted with plant or design patents. The specialized procedure which pertains to the examination of applications for design and plant patents are treated in detail in Chapters 1500 and 1600, respectively. National applications include original, plant, design, reissue, divisional, and continuation >applications (which may be filed under >37 CFR 1.53, 37 CFR< 1.60, >37 CFR< 1.62), and continuation-in-part applications >(which may be filed under 37 CFR 1.53 or 37 CFR 1.62)<.

201.01 Sole

An application wherein the invention is presented as that of a single person is termed a sole application.

201.02 Joint

A joint application is one in which the invention is presented as that of two or more persons.

201.03 >Correction of Inventorship in an<** Application [R-11]

Correction of inventorship is permitted by amendment under 35 U.S.C. 116.

As the statute, 35 U.S.C. 116, requires that a showing be made that the inventorship error arose without any deceptive intention, the Office policy as set forth in the notice, *Patent and*

Trademark Office Implementation of 37 CFR 1.56, dated September 8, 1988, published in the *Official Gazette* on October 11, 1988 at 1095 O.G. 16, waiving inquiry in regard to the practice of fraud on the Patent and Trademark Office or the attempt thereof is not intended to waive inquiry as to any deceptive intention on the part of the actual inventor(s) as set forth in 37 CFR 1.48(a).

37 CFR 1.48 Correction of inventorship

>(a)< If the correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by (>a<*) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred; (>b<*) an oath or declaration by each actual inventor or inventors as required by § 1.63; (>c<*) the fee set forth in § 1.17(h); and (>d<*) the written consent of any assignee. >When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

(b) If the correct inventors are named in the application when filed and the prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are not inventors of the invention being claimed. The amendment must be diligently made and shall be accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application, and

(2) The fee set forth in § 1.17(h).

(c) If an application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended pursuant to paragraph (a) of this section to add claims to the subject matter and name the correct inventors for the application.<

>37 CFR 1.48(a)<

Under >37 CFR 1.48(a)<*, if the correct inventor or inventors are not named in an application for patent, the application can be amended to name only the actual inventor or inventors so long as the error in the naming of the inventor or inventors occurred without any deceptive intention on the part of the actual inventor or inventors. >37 CFR 1.48 (a)<*, requires that the amendment be diligently made and be accompanied by (1) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred; (2) an oath or declaration by each actual inventor or inventors as required by >37 CFR< 1.63; (3) the fee set forth in >37 CFR< 1.17(h); and (4) the written consent of any assignee. Correction will be permitted, if diligently requested, in cases where the person originally named as inventor was in fact not the inventor >or the sole inventor< of the subject matter >being claimed<**. If such error occurred without any deceptive intention on the part of the true inventor, the Office has the authority to substitute the true >inventive entity<* for the erroneously named >inventive entity<. ** Instances where corrections can be made include changes from: a mistaken sole inventor to a different but actual sole inventor, ** a mistakenly identified sole inventor to different, but actual, joint inventors; >a sole inventor to joint inventors to include the original sole inventor, erroneously identified joint inventors to different but actual joint inventors;<** erroneously identified joint inventors to a different, but actual, sole inventor **. In each instance, however, the Office must be assured of the presence of innocent error, without deceptive intention on the part of the true inventor or inventors, before permitting amendment.

The required "statement of the facts verified by all of the original applicants" must include at the least, a recital of the circumstances, including the relevant dates, of (1) the error in naming the actual inventor or inventors and (2) the discovery of the error. >For those situations where the error in inventorship included the execution of an oath or declaration under 37 CFR 1.63 naming an improper inventive entity the verified statements by the original named inventors who had so executed the oath or declaration must explain whether they had reviewed and understood the contents of the specification including the claims as amended by any amendment specifically referred to in the oath or declaration (as set forth in 37 CFR 1.63) and whether they had reviewed the oath or declaration prior to its execution and if so how the error had occurred in view of such reviews.< Without such showing of circumstances, no basis exists for a conclusion that the application had been made in the names of the original sole or joint applicant(s) "through error and without any deceptive intention", and no foundation is supplied for a ruling that the amendment to remove the names of those not inventors or include those to be added as inventors was "diligently made."

On the matter of diligence, attention is directed to the decision of the C.C.P.A. in *Van Ottoren v. Hafner*, 757 O.G. 1026, 126 USPQ 151 (CCPA 1960). **

>Petitions under 37 CFR 1.48(a) are generally decided by the primary examiner with the following exceptions:

- In national applications filed under 35 U.S.C. 111, 37 CFR 1.53(d) wherein the petition has been filed prior to issuance of the filing receipt in timely response to a Notice to File Missing Parts of Application from Application Division (decided by Special Program Examiners in the Office of the Assistant Commissioner for Patents)

- When the application is involved in an interference, MPEP § 2334 (decided by the Board of Patent Appeals and Interferences)

- In national stage applications filed under 35 U.S.C. 371 (decided by PCT Legal Examiners in the International Services Division)

- When accompanied by a petition under 37 CFR 1.183 requesting waiver of a requirement under 37 CFR 1.48(a), generally the verified statement of facts by an original named inventor (decided by the Petitions Examiner in the Office of the Deputy Assistant Commissioner for Patents)

- Any attempt to effect a second conversion under 37 CFR 1.48(a) (decided by the group director).

- All petitions under 37 CFR 1.48 where a question of deceptive intent has been raised (e.g., submission of an executed dec-

laration under 37 CFR 1.63 where it is known at the time of its execution and/or submission that the inventive entity set forth therein is improper (decided by Special Program Examiners in the Office of the Assistant Commissioner for Patents).

The provisions of 37 CFR 1.312 apply to petitions for correction of inventorship after allowance and before issue. Where the petition is dismissed or is denied, the examiner must determine whether a rejection under 35 U.S.C. 102(f) or (g) is appropriate. If so, the application must be withdrawn from issue and the rejection made.

When a typographical or transliteration error in the spelling of an inventor's name is discovered, a petition under 37 CFR 1.48(a) is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. The Patent and Trademark Office should simply be notified of the error and reference to the notification paper will be made on the previously filed declaration by the Office.

When any correction or change is effected, the file should be sent to the Application Division for revision of its records and the change should be noted on the original oath or declaration by writing in red ink in the left column "See Paper No. __ for inventorship changes".

Where a person is substituted, added or removed as an inventor during the prosecution of an application before the Patent and Trademark Office, problems may occur upon applicant claiming U.S. priority in a foreign filed case. Therefore, examiners should acknowledge any addition or removal of inventors made in accordance with the practice under 37 CFR 1.48 and include Form Paragraph 2.14 in the next communication to applicant or his attorney. (Copy on page 200-6).

The grant or denial of the petition may result in the loss of inventorship overlap between a parent application and a continuing application and the consequent inability to claim benefit in the continuing application of the parent application's filing date under 35 U.S.C. 120. Intervening references must then be considered.

For correction of inventorship in a patent, see 37 CFR 1.324.

In cases when an inventor's name has been changed after the application has been filed, see MPEP § 605.04(c).

Applications filed under 37 CFR 1.53(b)

Applicants should note that it is Office practice to delay the issuance of the filing receipt (which lists the inventive entity) in applications filed under 37 CFR 1.53(b) when a petition under 37 CFR 1.48(a) has been filed until decision thereof. However, Certification Branch will provide a certified copy of the application as filed with the original named inventive entity prior to the issuance of a decision on the petition by the Special Program Unit, which copy may be sufficient for many foreign filed applications claiming priority of the U.S. application's filing date.

The original named inventors for applications filed under 37 CFR 1.53(b) without an executed oath or declaration are those named when filing the application such as in an accompanying transmittal letter or unexecuted oath or declaration. The application as filed must be executed by the original named inventors submitting a signed oath or declaration under 37 CFR 1.63 or if an error was made in the original naming of the inventors, correction is required by way of petition under 37 CFR 1.48(a). If correction is required, the petition must be filed no later than the maximum period to respond to the "Notice to File Missing Parts of Application, Filing Date Granted" (i.e. two months from the filing date of the application or one month from the mail date of the Notice, both with an additional four months available under 37 CFR 1.136(a) and possibly additional time under 37 CFR 1.136(b). Failure to timely execute the application as originally filed or to timely file the petition will result in abandonment of the application with revival possible only under 37 CFR 1.137(a) upon a showing of unavoidable delay (and not 37 CFR 1.137(b) unintentional abandonment). The petition, although decided by the Special Program Unit, should be mailed to the Special Handling Unit of Application Division to be matched up with the application.

Example

Application filed naming A+B under 37 CFR 1.53(b) without an executed declaration under 37 CFR 1.63. Claims 1 and 2 are present. B has contributed only to claim 2.

B refuses to execute declaration under §1.63.

Cancellation of claim 2 by preliminary amendment, submission of an executed declaration under 37 CFR 1.63 by A only and a petition under 37 CFR 1.48(b) to delete B in response to the "Notice to File Missing Parts of Application" will result in abandonment of the application. The application as filed must be executed. 37 CFR 1.48(b) is only applicable when prosecution (on the merits) results in canceled claims.

A petition under 37 CFR 1.47 on behalf of B or refiling of the application with only claim 1 and naming only A are available remedies.

Declarations under 37 CFR 1.63 by the original named inventors should not be executed or submitted merely to timely complete filing requirements in response to a "Notice to File Missing Parts of Application" where an error in inventorship has been discovered or signed by someone who cannot properly make the averments therein. Additional time to respond to the Notice with an appropriate petition under 37 CFR 1.48(b) to correct inventorship is available under 37 CFR 1.136(a) and possibly under 37 CFR 1.136(b).

Applications that are originally filed under 37 CFR 1.53(b) with "et al" as part of the inventive entity (e.g., Jones et al) have not named all the inventors as is required to obtain a filing date (37 CFR 1.41(a)). A petition under 37 CFR 1.48(a) to change inventorship (e.g., Jones + Smith) is not appropriate. The application as originally filed was incomplete and a notice to that effect will be sent by the Application Division. Applicants may simply respond to that Notice by supplying each inventor's name to obtain a filing date as of the date of receipt by the Patent and Trademark Office of that response or may petition to the Office of the Assistant Commissioner for Patents under 37 CFR 1.183 to waive the requirement of 37 CFR 1.53 and 1.41 that all inventors be named upon filing.

Verified Statement of Facts

37 CFR 1.48(a) requires a verified statement of facts from *each original named inventor. Verification must* be accomplished by an oath (such as by a notary) or a declaration which refers to and incorporates the language of either 37 CFR 1.68 or 28 U.S.C. 1746 (MPEP § 602). *Statements from others including* a registered United States patent attorney or agent need only be over the attorney's or agent's signature. Any statement from a foreign attorney or agent not registered before the U.S. Patent and Trademark Office must be verified.

Where a similar inventorship error has occurred in more than one application for which correction is requested (e.g., parent and continuation thereof) wherein petitioner seeks to rely on *identical verified statements of facts and exhibits, only one* original set need be supplied if copies are submitted in all other applications with a reference to the application containing the originals (original oaths or declarations under 37 CFR 1.63 and written consent of assignees along with separate petition fees must be filed in each application).

On very infrequent occasions the requirements of 37 CFR 1.48(a) have been waived upon the filing of a petition and fee under 37 CFR 1.183 (along with the petition and fee under 37 CFR 1.48(a)) to permit the filing of a verified statement of facts by less than all the original named inventors. *In re Cooper*, 230 USPQ 638, 639 (Deputy. Assist. Comr. Pats. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. *In re Hardee*, 223 USPQ 1122, 1123 (Comr. Pats. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for considerations in determining whether the record unequivocally supports the correction sought.

Where the named inventors would have no knowledge of *how the error occurred and the nature of the error indicates* what the correct inventive entity should have been, such as a clerical error made in the patent attorney's or agent's office in transcribing instructions from a client, waiver under 37 CFR 1.183 would be appropriate if accompanied by a verified statement by the parties with first hand knowledge of how the error occurred and any supporting evidence. A statement from the original named inventors stating that they have no knowledge of how the error occurred and that they agree with the requested correction may also be required.

In those situations where an original named inventor refuses to submit a statement supporting *the addition or deletion of an*other inventor and that original named inventor has assigned his or her entire right or interest to an assignee who has given its consent to the requested correction, waiver would be appropriate upon a showing of such refusal and assignment if the Patent and Trademark Office has issued a filing receipt. Waiver would not be granted if the application had not had a filing receipt issued because all the inventors have not signed an oath or *declaration. Where no assignment has been executed by the* inventors, or if deletion of the refusing inventor is requested waiver will >not< be granted absent unequivocal support for the correction sought.

Absent waiver where an original named inventor refuses to file a statement, an available remedy is to refile the application naming the correct inventive entity. A petition under 37 CFR 1.48(a) would not then be required in the newly filed application *as no correction would be needed. Benefit of the parent* application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole to sole correction would not obtain benefit under 35 U.S.C. 120.) Where the desired correction is deletion of an inventor the application may be refiled under the provisions of 37 CFR 1.60 and 37 CFR 1.62 as an alternative to filing under 37 CFR 1.53 and 35 U.S.C. 111 where the parent application is a complete application under 37 CFR 1.51(a)(2) including the grant of any petition under 37 CFR 1.47 (usually not the case with initial filings under 37 CFR 1.53(b)). For addition of an inventor the application must be filed under 37 CFR 1.53 and 35 U.S.C. 111.

Oath or Declaration

An oath or declaration under 37 CFR 1.63 by each actual *inventor must* be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all *inventors so as to clearly indicate what each inventor believes to* be the appropriate inventive entity.

37 CFR 1.47 is available to meet the above requirement as for example where A, B and C were originally named and D who refuses to cooperate is to be added. The verified statements need be supplied only by A, B and C. In those instances wherein petitions under 37 CFR 1.48(a) and 1.47 have been filed prior to issuance of the filing receipt, the Patent and Trademark Office will first issue a decision on the petition under 37 CFR 1.48(a) so as to determine the appropriate oath or declaration under 37 CFR 1.63 required for the petition under 37 CFR 1.47.

The oath or declaration *submitted subsequent to the filing* date of an application filed under 37 CFR 1.53(b) must clearly identify the previously filed specification it is intended to execute, see MPEP § 601.01. Where a specification is attached to the oath or declaration the oath or declaration must be accompanied by a statement that the attached specification is a copy of the specification and any amendments thereto which were filed in the Office in order to obtain a filing date for the application. *Such statement must be a verified statement if made by a person* not registered to practice before the Office.

Fee

Where waiver under 37 CFR 1.183 is requested in relation to a requirement under 37 CFR 1.48(a) petition fees under both 37 CFR 1.48(a) and 1.183 are required.

Where a similar error has occurred in more than one application *a separate petition fee must be submitted in each applica*tion in which correction is requested.

If the petition fee has not been submitted or authorized the petition will be dismissed and a rejection under 35 U.S.C. 102(f) or (g) considered.

Written Consent of Assignee

The written consent of every existing assignee must be submitted. 37 CFR 1.48(a) does not limit assignees to those who are recorded in the Patent and Trademark Office records. The Office employee deciding the petition should check the file record for any indication of the existence of an assignee (e.g., a small entity statement from an assignee.)

Where no assignee exists petitioner should affirmatively state that fact. If the file record including the petition is silent as to the existence of an assignee it will be presumed that no assignee exists. Such presumption should be set forth in the decision to alert petitioners to the requirement.

The title of the party signing on behalf of a corporate assignee and the authority to do so should be set forth in the written consent.

Continuing Applications

On filing a continuing application under 37 CFR 1.60 or 1.62, it should not be assumed that an error in inventorship made in a parent application was in fact corrected therein in response to a petition under 37 CFR 1.48(a) unless a decision from the Patent and Trademark Office to that effect was received by petitioner. For example, a petition to add an inventor to a parent application that was not acted on (e.g., filed after final rejection) or was denied will cause the filing of a 37 CFR 1.60 or 1.62 application to be improper if an additional inventor is named. A continuing application naming the additional inventor can be filed under 37 CFR 1.53 and 35 U.S.C. 111 with a request for priority under 35 U.S.C. 120 without the need for a decision on the petition.

Should an error in inventorship in a parent application be discovered when preparing to file a continuing application, the continuing application may be filed with the correct inventive entity without the need for a petition under 37 CFR 1.48(a) in the parent or continuing application provided the parent application is to be abandoned on filing the continuing application. The continuing application must be diligently filed either under 35 U.S.C. 111 or under 37 CFR 1.60 or 1.62 where inventors are not to be added and where the parent application is a complete application under 37 CFR 1.51(a) and any petition under 37 CFR 1.47 has been granted. The continuing application may be filed under 37 CFR 1.60 and 1.62 where inventors are to be added provided a petition under 37 CFR 1.48(a) is submitted in the continuing application on the day the application is filed (later submission of the petition will cause an improper filing) and when the parent application is a complete application under 37 CFR 1.51(a).. However, since a new oath or declaration would be required, it is preferred to file a newly executed continuing application under 37 CFR 1.53 with the correct inventors. In such a case, no petition under 37 CFR 1.48 would be required in the continuing application.

An inventorship error discovered while prosecuting a continuing application that occurred in both an abandoned parent application and the continuing application can be corrected in both applications by filing a single petition in the continuing application (e.g., A + B named in parent, B + C named in continuing application, actual inventorship is C +D thereby eliminating inventorship overlap and resulting loss of priority claim under 35 U.S.C. 120 if error is not corrected in abandoned parent application as well as in continuation application).

¶ 2.13 Correction of Inventorship under 37 CFR 1.48(a), Insufficient

The petition to correct the inventorship of this application under 37 CFR 1.48(a) is deficient because [1]

Examiner Note:

1.This paragraph should only be used in response to requests to correct an error in the naming of the proper inventors. If the request is merely to delete an inventor because claims were canceled or amended such that the deleted inventor is no longer an actual inventor of any claim in the application, use paragraph 2.13.1 instead of this paragraph.

2. A primary examiner may not decide the petition if:

(a) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.48(a) (typically a refusal of one of the original named inventors to execute the required statement of facts) - the petition for correction of inventorship and request for waiver of the rules should be forwarded to the Supervisory Petitions Examiner in the Office of the Deputy Assistant Commissioner for Patents; or

(b) it represents an attempt to effect a second conversion under 37 CFR 1.48(a) - the second attempt must be returned to the group director

3. Insert one or more of the following reasons in the bracket:

"the statement of facts by the originally named inventor or inventors is insufficient." (explanation required, e.g., the statement of facts fails to explain how the inventorship error occurred in view of the review of the specification including the claims and understanding thereof by the original named inventors when executing the oath or declaration under 37 CFR 1.63, which is set forth therein);

"an oath or declaration by each actual inventor or inventors has not been submitted";

"it lacks the required fee under 37 CFR 1.17(h)";

"it lacks the written consent of any assignee";

"the amendment has not been diligently filed" (explanation required).

¶ 2.13.1 Correction of Inventorship under 37 CFR 1.48(b), Insufficient

The petition requesting the deletion of an inventor in this application under 37 CFR 1.48(b) is deficient because [1]

Examiner Note:

1.This paragraph should only be used when the inventorship was previously correct but an inventor is being deleted because claims have been amended or canceled such that he or she is no longer an inventor of any remaining claim in the application. If the inventorship is being corrected because of an error in naming the correct inventors, use paragraph 2.13 instead of this paragraph.

Potential rejections

- A rejection under 35 U.S.C. 102(f) or (g) must be considered if the petition is denied.

- The grant or denial of the petition may result in the loss of inventorship overlap between a parent application and a continuing application and an inability to claim benefit in the continuing application of the parent applications filing date under 35 U.S.C. 120. Intervening references must then be considered.

2.Insert one or more of the following reasons in the bracket:

"the petition has not been diligently filed" (explanation required).;

"the petition lacks the statement required under 37 CFR 1.48(b)(1)";

"it lacks the required fee under 37 CFR 1.17(h)".

¶ 2.13.2 Correction of Inventorship under 37 CFR 1.48(c), Insufficient

The petition to correct the inventorship in this application under 37 CFR 1.48(c) requesting addition of an inventor(s) is deficient because [1]

Examiner Note:

See paragraph 2.13

¶ 2.14 Correction of Inventorship Sufficient

In view of the papers filed [1], it has been found that this application, as filed, through error and without any deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48. The inventorship of this application has been changed by [2].

Examiner Note:

In bracket 2, insert explanation of correction made, including addition or deletion of appropriate names.

For correction of inventorship in a patent, see 37 CFR 1.324.

37 CFR 1.48(b)

37 CFR 1.48(b) provides for deleting the names of persons originally properly included as inventors, but whose invention is no longer being claimed in the application. Such a situation would arise where claims have been amended or deleted because they are unpatentable or as a result of a requirement for restriction of the application to one invention, or for other reasons. A petition under 37 CFR 1.48(b) to delete an inventor would be appropriate prior to an action by the examining group where it is decided not to pursue particular aspects of an invention attributable to some of the original named inventors. However, a petition under 37 CFR 1.48(b) is not an available means to avoid execution of the application as originally filed under 37 CFR 1.53(b) situations. Public Law 98-622 and 37 CFR 1.48(b) change the result reached in *Ex parte Lyon*, 146 USPQ 222, 1965 C. D. 362 (Bd. App. 1964). 37 CFR 1.48(b) requires only a petition and fee with the petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application. The amendment would have to be diligently made under 37 CFR 1.48(b). The statement may be signed by applicant's registered attorney or agent who then takes full responsibility for ensuring that the inventor is not being improperly deleted from the application.

37 CFR 1.48(c)

37 CFR 1.48(c) provides for the situation where an application discloses unclaimed subject matter by an inventor or inventors not named in the application as filed. In such a situation, the application may be amended pursuant to 37 CFR 1.48(a) to add claims to the subject matter and also to name the correct inventors for the application. The claims would be added by an amendment and, in addition, an amendment pursuant to 37 CFR 1.48(a) would be required to correct the inventors named in the application. Any claims added to the application must be supported by the disclosure as filed and cannot add new matter.<

201.04 Parent Application

The term "parent" is applied to an earlier application of an inventor disclosing a given invention. Such invention may or may not be claimed in the first application. Benefit of the filing date of copending parent application may be claimed under 35 U.S.C. 120.

201.04(a) Original Application

"Original" is used in the patent statute and rules to refer to an application which is not a reissue application. An original application may be a "first" filing or a continuing application.

201.05 Reissue Application

A reissue application is an application for a patent to take the place of an unexpired patent that is defective in some one or more particulars. A detailed treatment of reissues will be found in chapter 1400.

Chapter 1400 Correction of Patents

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1415 Reissue Filing and Issue Fees
1416 Offer to Surrender and Return Original Patent
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1418 Information Disclosure Statement and Other Information
* * *
1430 Reissue Files Open to the Public ¶and Notice of Filing Reissue Announced in Official Gazette¶
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1480 Certificate of Correction—Office Mistake
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1485 Handling of Request for Certificate of Correction
1490 Disclaimers

Errors in a patent may be corrected in four ways, namely (1) by reissue, (2) by the issuance of a certificate of correction which becomes a part of the patent, (3) by disclaimer, and (4) by reexamination.

1401 Reissue

35 U.S.C. 251. Reissue of defective patents. Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patentee, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

1402 Grounds for Filing [R-3]

The most common bases for filing a reissue application are (1) the claims are too narrow or too broad; (2) the disclosure contains inaccuracies; (3) * * * applicant failed to or incorrectly claimed foreign priority; (¶4¶) applicant failed to make reference to or incorrectly made reference to prior copending applications.

¶An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in In re Wilder, 222 USPQ 369 (Fed. Cir. 1984). The Patent and Trademark Board of Appeals held in Ex parte Scudder, 169 USPQ 814, 815 (1971) that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate. Reissue may no longer be necessary under the facts in Ex parte Scudder in view of 35 U.S.C. 116 as amended effective November 8, 1984 by Public Law 98–622 which provides, inter alia,

"Inventors may apply for a patent jointly even though . . . (3) each did not make a contribution to the subject matter of every claim in the patent."

Note 37 CFR 1.45 as amended effective May 8, 1985 (Federal Register, Vol. 50, No. 45, 9368, 9369, 9379, March 7, 1985).¶

The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue: Ex parte Scudder, 169 USPQ 814. The Filing of a reissue application * * * ¶may not be¶ necessary if the only change is to correct the inventorship since this can be accomplished under the provisions of 35 U.S.C. 256 and 37 CFR 1.324.

A reissue was granted in Brenner v. State of Israel, 862 O.G. 661, 158 USPQ 584, where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119 before the patent was granted.

Correction of failure to adequately claim priority in earlier filed copending U.S. Patent application was

held a proper ground for reissue in Sampson v. Comr. of Pats., 195 USPQ 136, 137 (D.C.D.C. 1976). Reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than they had a right to claim; and thus such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251: In re Orita, Yohagi, and Enomoti, 193 USPQ 145, 148 (CCPA 1977); see also In re Mead, 581 F.2d 257, 198 USPQ 412 (CCPA 1978).

1403 Diligence in Filing [R-3]

When a reissue application is filed within two years from the date of the original patent, a rejection on the grounds of lack of diligence or delay in filing the reissue should not normally be made, in the absence of evidence to the contrary: Ex parte Lafferty, 190 USPQ 202 (Bd. App. 1975); but see Rohm & Haas Co. v. Roberts Chemical Inc., 142 F.Supp. 499, 110 USPQ 93 (S.W. Va. 1956) reversed on other grounds 245 F.2d 693, 113 USPQ 423 (4th Cir. 1957).

However, as stated in the fourth paragraph of 35 U.S.C. 251,

> No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

See § 1412.03 for broadening reissue practice.

◆Note In re Bennett, 226 USPQ 413, 416 (Fed. Cir. 1985); In re Fotland, 128 USPQ 193 (Fed. Cir. 1985).◆

A reissue filed on the two year anniversary date is considered filed within two years: see Switzer & Ward v. Sockman & Brady, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.

1404 Submission of Papers Where Reissue Patent is in Litigation [R-3]

Applicants and protestors (see § 1901.03) submitting papers for entry in reissue applications of patents involved in litigation are requested to mark the outside envelope and the top right hand portion of the papers with the words "REISSUE LITIGATION" and with the Office or group art unit of the Patent and Trademark Office in which the reissue application is located, e.g., Assistant Commissioner for Patents, Board of ◆Patent◆ Appeals ◆and Interferences◆, Examining Group, * * * Office of Publications, etc. Protestor's participation, including the submission of papers, is limited in accordance with 37 CFR 1.291(c). Any "Reissue Litigation" papers mailed to the Office should be so marked and mailed to Box 7, Commissioner of Patents and Trademarks, Washington, D.C. 20231. The markings perferably should be written in a bright color with a felt point marker. Papers marked "REISSUE LITIGATION" will be given special attention and expedited handling. See §§ 1442.01–1442.04 for examination of litigation related applications.

1410 Content of Reissue Application

37 CFR 1.171. Application for reissue. An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications. The application must be accompanied by a certified copy of an abstract of title or an order for a title report accompanied by the fee set forth in § 1.19(b)(2), to be placed in the file, and by an offer to surrender the original patent (§ 1.178).

Applicants for reissue are required to file a reissue oath or declaration which, in addition to complying with § 1.63, must comply with § 1.175. The oath or declaration or filing fee may be submitted after the filing date under 37 CFR 1.53.

◆1410.01 Reissue Applicant, Oath or Declaration, and Assent of All Assignees [R-3]

37 CFR 1.172 Applicants, assignees. (a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see sections 1.42, 1.43, 1.47), and must be accompanied by the written assent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

(b) A Reissue will be granted to the original patentee, his legal representative or assigns as the interest may appear.

The reissue oath must be signed and sworn to or declaration made by all the inventors except as otherwise provided in 37 CFR 1.42, 1.43 and 1.47. Where the reissue application does *not* seek to enlarge the scope of any of the claims of the original patent, the reissue oath may be made and sworn to or declaration made by the assignee of the entire interest.

The reissue oath or declaration must be accompanied by the written assent of all assignees. 35 U.S.C. 111 and 37 CFR 1.53 provide, however, for according an application a filing date if filed with a specification, including claim(s), and any required drawings. Thus, where an application is filed without an oath or declaration, or without the assent of all assignees, if the application otherwise complies with 37 CFR 1.53(b) and the reissue rules, the Application Branch will send out a notice of missing parts setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(d) and 1.16(e). The surcharge is required because, until the assent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication the assignees have assented to the filing.

Where the written assent of all the assignees to the filing of the reissue application cannot be obtained, applicant may under appropriate circumstances petition to the Office of the Deputy Assistant Commissioner for Patents (MPEP section 1002.02(b)) for a waiver under 37 CFR 1.183 with fee (37 CFR 1.17(b)) of the requirement of 37 CFR 1.172, to permit the acceptance of the filing of the reissue application.

The reissue application can then be examined, but will not be allowed or issued without the assent of all the assignees as required by 37 CFR 1.172: N. B. Fassett, 11 O.G. 420, 1877 C.D. 32; James D. Wright, 10 O.G. 587, 1876 C.D. 217, 218.

Form paragraph 14.15 may be used to indicate that the consent of the assignee is lacking.

409.02 Insanity or Other Legal Incapacity [R-11]

37 CFR 1.43. When the inventor is insane or legally incapacitated.

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent.

>Where no legal representative has been appointed, one must be appointed by a court of competent jurisdiction for the purpose of execution of the oath or declaration of the application. MPEP §<* 409.01(b) is also applicable in case of insanity or other legal incapacity of an inventor.

409.03 Unavailability of Inventor [R-11]

37 CFR 1.47. Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the omitted inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and by the required fee (§ 1.17(h)) and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he or she had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and by the required fee (§ 1.17(h)) and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the *Official Gazette*. The inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

35 U.S.C. 116. Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each ** make the required oath, except as otherwise provided in this title. >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.<

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor 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.

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

35 U.S.C. 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

Application papers submitted pursuant to >37 CFR< 1.47 are forwarded by the Application Division to the Office of the *>Assistant Commissioner for Patents< for determination whether the papers are proper, complete, and acceptable under >37 CFR< 1.47.

A *bona fide* attempt must be made to comply with the provisions of >37 CFR< 1.47 at the time application papers are first submitted. If the application papers, and evidence submitted with the application papers, are not found acceptable, the >37 CFR< 1.47 applicant will be notified by the Office of the *>Assistant Commissioner for Patents< of the reasons why the papers are not acceptable. The >37 CFR< 1.47 applicant may request reconsideration and file supplemental evidence in a case where a *Bona fide* attempt was made to comply with >37 CFR< 1.47 from the outset.

409.03(a) At Least One Joint Inventor Available [R-11]

37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, >requires all available joint inventors<** to file an application "on behalf of" >themselves and on behalf of<** a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application". The person making application pursuant to >37 CFR< 1.47(a) is referred to as a "§ 1.47 (a) applicant."

In addition to other requirements of law (35 U.S.C. 111 and 115), an application deposited in the Patent and Trademark Office pursuant to >37 CFR< 1.47(a) must meet the following requirements:

(1) the § 1.47(a) applicant must (i) make oath or declaration on his or her own behalf as required by >37 CFR< § 1.63 or § 1.175 (see >MPEP< §§ 602, 605.01 and 1401.08) and (ii) make oath or declaration on behalf of the >non-signing<* joint inventor as required by >37 CFR< § 1.64.

(2) The application must be accompanied by proof that the >non-signing<* inventor (i) cannot be found or reached after diligent effort or (ii) refuses to execute the application papers. See >MPEP< § 409.03(d).

(3) The last known address of the >non-signing<* joint inventor must be stated. See >MPEP< § 409.03(e).

409.03(b) No Inventor Available [R-11]

>Filing under< 37 CFR 1.47(b) and 35 U.S.C. 118 >is permitted only where no inventor is available to make application and allows<* a "person" with a demonstrated proprietary interest to make application "on behalf of and as agent for" an inventor who "cannot be found or reached after diligent effort" or who refuses to sign the application oath or declaration. The word "person" has been construed by the Patent and Trademark Office to include juristic entities, such as a corporation. The person making application pursuant to >37 CFR< § 1.47(b) is referred to as a "§ 1.47(b) applicant." >Where 37 CFR 1.47(a) is available, application cannot be made under 37 CFR 1.47(b).<

In addition to other requirements of law (35 U.S.C. 111 and 115), an application deposited pursuant to >37 CFR< 1.47(b) must meet the following requirements:

(1) The § 1.47(b) applicant must make the oath required by >37 CFR< 1.63 and 1.64 or 1.175. Where a corporation is the § 1.47(b) applicant, an officer thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976); *In re Striker*, 182 USPQ 507 (Comm'r. Pat. 1973). >Where an application is executed by one other than the inventor, the same information required of the inventor under 37 CFR 1.63 is also required of the 37 CFR 1.47(b) applicant. That is, the citizenship and residence must be stated for the non-signing inventor as well as the 37 CFR 1.47(b) applicant. Additionally, the post office address of the signing and non-signing parties must be stated. Also the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).<

(2) The >37 CFR< 1.47(b) applicant must state his or her relationship to the inventor as required by >37 CFR< 1.64.

(3) The application must be accompanied by proof that the inventor (i) cannot be found or reached after a diligent effort or (ii) refuses to execute the application papers. See >MPEP< § 409.03(d).

(4) The last known address of the inventor must be stated. See >MPEP< § 409.03(e).

(5) The >37 CFR< 1.47(b) applicant must make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the application. See >MPEP< § 409.03(f).

(6) The >37 CFR< 1.47(b) applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See >MPEP< § 409.03(g).

409.03(c) Legal Representatives of Deceased Inventor Not Available [R-11]

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117, since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. *In re Application Papers Filed September 10, 1954*, 108 USPQ 340 (Comm'r. Pat. 1955). See >37 CFR< 1.42 and >MPEP< § 409.01. However, >37 CFR< 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see >MPEP< § 409.03(e)), and proof of the power or authority of the legal representative must be established before the grant of a patent, >37 CFR< 1.44. Also, in hardship situations where time or circumstances do not permit appointment of a legal representative to make application, >37 CFR< 1.47 may apply. *In re Schwarz*, 147 USPQ 394 (Comm'r. Pat. 1960). In such situations, however, subsequent joinder of a properly authorized legal representative will normally be required before the grant of a patent.

409.03(d) Proof of Unavailability or Refusal [R-11]

Where inability to find or reach >a non-signing<* inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration >of facts< should be submitted which fully describes the exact facts which are relied upon to establish that a diligent effort was made. **

The affidavit or declaration >of facts< must be signed, where at all possible, by a person having first hand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as >certified mail return receipt, cover< letter >of instructions<, telegrams, etc., which support a finding that >the non-signing<* inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

In cases where priority under 35 U.S.C. 119 is to be claimed, the >37 CFR< 1.47 applicant should explain what efforts, if any, were made during the Convention year to prepare the applica-