Revised Text

SELECTED INVENTORSHIP DESIGNATION AND CORRECTION PROBLEMS

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I. INTRODUCTION

Three years ago at the 7th PIPA Congress in Hakone, I gave a talk on the subject of inventorship discrepancies in which I pointed out that there should be no real objection or obstacle to a practice of discrepant inventorship designation between foreign priority and U.S. counterpart applications.

In articles which will shortly appear in an APLA Journal, Bruce Collins of New York also concludes that the requirement of MPEP 201.15 (that the inventive entity in a U.S. application must coincide with those individuals designated in the priority document) is "without legal or logical basis" and Don Daus of Arlington, Va. speaks of a reluctance on the part of the PTO examiners to accord the benefit of convention priority in cases of discrepancy but adds that "this reluctance is normally overcome by appropiate explanation."

Don Daus also admits that "criteria for actual inventorships may vary from nation to nation." In fact, the Patent Cooperation Treaty recognizes this because its Rule 4.6 provides:

> (c) The request may, for different designated States, indicate different persons as inventors where, in this respect, the requirements of the national laws of the designated States are not the same. In such case, the request shall contain a separate statement for each designated State or group of States in which a particular person, or the same person, is to be considered the inventor, or in which particular persons or the same persons, are to be considered the inventors.

With this brief amplification of the inventorship discrepancy topic, let's focus on other difficult inventorship designation and correction problems - and developments with respect thereto - where resolutions, or at least better understanding, are in sight or at hand. Three complex issues merit attention:

1) Whether all designated joint inventors must be coinventors of all claims;
2) Whether the respective contribution of each coinventor must amount to inventive contribution; and
3) When conversion from sole inventorship to a different sole inventorship can be effected.

II. MUST ALL DESIGNATED JOINT INVENTORS BE COINVENTORS OF ALL CLAIMS

When the question arises as to whether all claims in a patent must have the same inventive entity, that is, whether joint inventors must have contributed to <u>each</u> of the claims in the patent, the affirmative is almost taken for granted. It certainly is the conventional view but

causes many problems in patent practice. In re Sarett (140 USPQ 474, CCPA 1964) is cited generally for this proposition and there is dicta in In re Sarett to the effect that a patent to joint inventors could not legally contain a claim to a sole invention of one inventor because it would not be the invention of the joint patentees.

In the forthcoming APLA Journal issue on inventorship Fred Sherling of the PTO Solicitor's Office also makes the categorial statement that "Claims in the same application or patent of different inventive entities are unpatentable under 35 U.S.C. 102(f)." (APLA Quarterly Journal, No 2, vol 7, 1979, p 129

Patent Law Revision bills have addressed this issue specifically. Following a recommendation by the Presidential Commission, S.1321 (Hart, 93rd Congress, 1st Session) and S.214 (Fong, 94th Congress, 1st Session) provided in Section 116(b) as follows:

> In an application for patent naming two or more inventors, it shall not be necessary for each person named as an inventor to be joint inventor of the subject matter asserted in any claim.

Section 116(a) of S. 2255 (McClellan, 94th Congress, 1st Session, 1976) contained a provision which would have required joint inventors to make inventive contributions to each claim of a patent. This provision was criticized by the late John Clark in a submission to Congress as well as by John Pearne whose analysis was then published in 58 JPOS 205, 1976. After an exhaustive review of decisions on this question, going back as far as Worden v. Fisher, 11 Fed. 505 (E.D. Mich., 1882),

Pearne's conclusion was that

> "joint applicants for a patent need not have made an inventive contribution to each claim of their application or patent, except that 'independent and distinct' inventions must have the same inventorship in order to be validly granted in the same patent (where the Patent Office could have, but failed, to require division, regardless of inventorship.)"

The argument that there must be contributions to each claim was recently urged in SAB Industri AB v. Bendix Corp., 199 USPQ 95 (E.D. Va. Alex. 1978), where the District Court dismissed it as lacking support in any statue or rule and as being "too technical and immaterial" to warrant invalidating a patent. The Court's acceptance of the plaintiff's use of a joint application expressly in order to avoid double patenting provides a sound logic for laying the defense to rest permanently. Thus, if the embodiments of two claims are not patentably distinct (utilizing the criterion of 35 USC Section 103), there is only one inventive concept.

Inventorship should be determined on the basis of contributions to that single concept, not on the basis of contributions to different embodiments thereof set forth in separate claims. On the other hand, an assertion by a defendant that two embodiments are the result of different inventive entities is in fact an assertion that the embodiments are patentably distinct. This is little more than a backdoor effort to avoid the last sentence of 35 USC Section 121 by questioning the patent's validity because restriction was not required in the application.

III. MUST THE RESPECTIVE CONTRIBUTIONS OF EACH COINVENTOR AMOUNT TO INVENTIVE CONTRIBUTIONS

In this connection there is another important but difficult question: whether a contributor's conceptual contribution to an invention must itself constitute the exercise of inventive skill for the contributor to be a joint inventor or whether the exercise of ordinary skill is adequate if the contribution is essential to the completion of the overall concept. There is a great deal of confusion or unclarity on this issue. It has apparently not been treated in the legal literature nor has it been an issue squarely before the court in court decisions. If anything, it is taken for granted that the contributions must be inventive ones.

However, on the one hand, even rudimentary deductive analysis leads clearly and logically to the contrary conclusion, that is, that the contributions of each individual coinventor need not rise to the level of inventive contributions. Only the joint invention as a whole has to satisfy the requirement of unobviousness. If the contribution of each individual coinventor itself has to constitute an inventive or unobvious contribution, the level or requirement of unobviousness would be much higher for a joint invention than for a sole invention. However, there is nothing whatsoever in the Patent Law from which such a discrepancy or such a dichotomy could be derived. Seeger and Wegner argued likewise

in an article entitled "Open Questions of Coinventorship" and published in 'Mitteilungen Der Deutschen Patentanwälte' (Communications of the German Patent Lawyers), 66, 1975, p. 108 but also pointed out that it is the very essense of a coinvention that it cannot be dissected into specific contributions.

But, on the other hand, court decisions can be resorted to to shed some light on this issue. John Tresansky of Kensington, Md., has done some legal research on this topic for the forthcoming APLA Journal issue following up on his 1974 JPOS article entitled "Inventorship Designation" (56 JPOS 551). He refers to two cases, namely, Consolidated Bunging Co. v. Woerle, 29 F. 449 (ND. Ill. 1887) and Delaski & Thropp v. Thropp & Sons, 218 F. 458 (D.N.J. 1914), aff'd 226 F. 941 (3rd cir 1915), as having given this issue more than perfunctory consideration and concludes from these cases that what counts is the essentiality of each of the contributor's contribution to the completion of the conception without concern for the level of skill represented by each of the contributors.

However, it is perhaps not quite as easy to settle this issue. In a talk at the October 1979 APLA Meeting in Washington, Maurice Klitzman drew these distinctions and conclusions:

> "Because of the reluctance to invalidate patents for improper inventorship two standards for determining joint inventorship have resulted.

Where validity of a patent is attacked because of misjoinder, the DeLaski (supra,) Consolidated Bunging (supra) and Vrooman (Vrooman & Penhollow, 179 Fed. 296 6th Cir 1910) reflect a tendency to apply a lower standard for inventorship by finding that if two persons collaborate and a suggestion of practical value in working out the idea is made in making the invention operative, or putting it into practical form, the invention will be considered joint even though the contribution be of only minor importance. . . . . On the other hand, in the Pointer (Pointer v. Six Wheel Corporation, 177 F. 2d 153, 9th Cir. 1949), McKinnon (McKinnon Chain Company v. American Chain, 268 F. 353, 3rd Cir. 1920) and Farber (S.W. Farber, Inc. v. Texas Instruments, 211 F.S. 686, D Del. 1962) cases, where validity was attacked for nonjoinder, these cases reflected a tendency toward a higher standard to become a joint inventor by requiring the contribution to inventive skill.

. . . . . .

Although an easy way out may be to make all contributors joint, bear in mind it may also make it easier for someone to establish a 102(g) defense. Therefore, I offer for your consideration, that until the law becomes more crystalized for 102(g) purposes, the "inventive skill" test be applied for determining joint inventorship."

IV. CONVERSION FROM SOLE INVENTORSHIP TO A DIFFERENT SOLE INVENTORSHIP

Another rule that was clearly well-settled and taken for granted was that conversion from one sole to another sole inventorship was impossible, at least until 1977 when Stoddard v. Dann, 195 USPQ 97, was handed down by the D.C. Court of Appeals. This revolutionary landmark decision has already spawned a great deal of comment, both favorable and unfavorable. P.T. Meikeljohn in an article entitled "Misjoinder, Nonjoinder and Whatever - Stoddard v. Dann" (60 JPOS 487, 1978) and M.H. Sears in an article entitled "The Corporate Patent - Reform or Retrogression" (61 JPOS 380, 1979) criticize Judge Markey's rationale. Conversely, J.L. Welch wrote an article entitled "Stoddard v. Dann - Fundamental Principles from A to C" (61 JPOS 185, 1979) in its defense. Don Daus also takes the defensive in the forthcoming APLA Journal issue with an article entitled "Stoddard v. Dann: A Doctrine of Innocence." Obviously quite a controversial decision! It remains to be seen what kind of a precedent this decision will be.

It was my view that Stoddard v. Dann might be of limited value. I felt that as a practical matter it would probably redound more to the benefit of foreign inventors than U.S. inventors because it was difficult for me to see how U.S. inventors and patent practitioners could rely on ignorance of

the language and the law and get away with it as ingenuously as the foreign party was able to do in the Stoddard case.

In this respect, you may have noticed from a very recent BNA-PTCJ issue (No. 447, A-1, 9-27-79) that the Assistant Commissioner has followed Stoddard v. Dann and ruled that the PTO had authority under certain conditions to permit reissue of a patent to correct an innocent error, i.e., sole-sole conversion. The case is In re Shibata and the party involved is manifestly foreign and in fact relying on ignorance of law and language. How a U.S. party will fare in an attempt at sole-to-sole conversion still remains to be seen, even though the PTO, according to former Commissioner Banner, is working out guidelines or a general announcement permitting sole-to-sole conversion.

Reminiscent of In re Hession, 132 USPQ 40 (CCPA 1961) but strangely without mention whatsoever of Stoddard v. Dann, is the recent decision of the Ninth Circuit, Bemis v. Chevron Research Co., 203 USPQ 123 (1979). In that case Bemis filed suit alleging that the defendants filed an application falsely identifying the inventors, which then matured into a patent. Plaintiff alleged he was the true inventor, and sought a corrected patent to be issued to him under Section 256. The district court dismissed the suit for failure to state a cause of action and the Ninth Circuit affirmed, having considered the Section's legislative history. The court held Section 256, while remedial, cannot be the vehicle for

substituting inventors in a patent in a claim sounding in conspiracy and fraud. Bemis had failed to allege joint inventorship or innocence.

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