

INVENTOR GUIDANCE NOTES

(White papers published by the IP Group provide simple and accurate guidelines for inventors/ scientists)



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SCOPE: This Inventor Guidance Notes provides information for scientists regarding inventorship of patents.	DATE: 11 November 2011
TABLE OF CONTENTS: A. Summary B. Relevant legal extracts C. Interpretation of the law and explanations D. Examples and cases E. References	REVIEWER: Nitin S Tewari V. Premnath Srividya Ravi

A. SUMMARY:

[The rules and guidelines for determining inventors are established by laws and judicial decisions and can differ from country to country]

WHO IS AN INVENTOR?

CONCEPTION: An inventor is a person who made an inventive contribution to the invention as defined by the claims of the patent application. One who has made initial conception of the invention, i.e. the formation of a definitive & permanent idea of the complete & operative invention in his mind

REDUCTION TO PRACTICE: Note that the mere reduction of the invention into practice without contributing to the conception of the Idea **doesn't** qualify one to be named as an inventor.

That means: Colleagues, students, research assistants, technicians, mechanists, or their Supervisors [including those who gather essential data or construct a practical embodiment of the invention] aren't inventors unless they have made an inventive contribution.

Thus, someone participating in the reduction to practice AND contributing to the final, complete conception is an inventor, but participation only in the "reduction to practice" does not warrant inventorship.

CO-INVENTORS: In case of joint inventors, each inventor should have made conceptual contribution to at least one claim of the invention.

Inventorship is determined on a claim-by-claim basis. Thus, if a claim is abandoned during examination of the patent, inventorship is re-assessed. If an inventor was named for the purposes of that claim alone, then that inventor is removed by request of the applicant.

All inventors of a patent are awarded equal rights.

WHO IS NOT AN INVENTOR?

An individual is not an inventor if he:

- Merely suggested an idea without a way to implement the idea,
- Contributed an obvious element to the invention,
- Only followed instructions in working on the invention,
- Participated in consultations about the invention before or after
- Is the first importer of an invention into India, or a person to whom an invention is first communicated from outside India
- Is the HOD or head of a Research group, but his inventive contribution was zero.
- Only makes changes to the production method while reducing the invention to practice.

As sometimes occurs, the original conception provides a prototype or basis for the invention but does not represent the final invention which is eventually claimed. An inventor can seek the help of others when perfecting the invention without the helper necessarily becoming an inventor.

B. RELEVANT LEGAL EXTRACTS:

COUNTRY & LAW:	LEGAL EXCERPTS:
<p>1. INDIA: [INDIAN PATENT ACT, 1970]</p>	<p>S 2(y) "true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.</p>
	<p>S 6. Persons entitled to apply for patents (1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,— (a) by any person claiming to be the true and first inventor of the invention; (b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application; (c) By the legal representative of any deceased person who immediately before his death was entitled to make such an application. (2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.</p>
	<p>S 50. Rights of co-owners of patents (1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent. (2) Subject to the provisions contained in this section and in section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to [the rights conferred by section 48] for his own benefit without accounting to the other person or persons. (3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a licence under the patent shall not be granted and a share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.</p>
<p>2. UNITED STATES: [35 U.S.C]</p>	<p>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 Director, 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 Director may permit the application to be</p>

	amended accordingly, under such terms as he prescribes.
	35 U.S.C. 117 Death or incapacity of inventor. Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.
	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 Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.
	35 U.S.C. 262 Joint owners. In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.
3. EUROPE: [EPC]	Article 59 Multiple applicants A European patent application may also be filed either by joint applicants or by two or more applicants designating different Contracting States.
	Article 60 Right to a European patent (1) The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee, the right to a European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has the place of business to which the employee is attached. (2) If two or more persons have made an invention independently of each other, the right to a European patent therefore shall belong to the person whose European patent application has the earliest date of filing, provided that this first application has been published. (3) In proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right to a European patent.

C. INTERPRETATION OF THE LAWS AND EXPLANATION:

	India	United States	Australia	Europe
Inventor	"True and first inventor" does not include – 1.the first importer of an invention into India, or 2. A person to whom an invention is first communicated from outside India. [S2(y)]	Must make an inventive contribution to the invention as defined by the claims	As in United States	Defined by national legislation in Individual EU member countries. It is generally recognized that the actual deviser is the person(s) who contribute(s) to the novelty or inventive step of the invention.
Test to determine inventorship	Not defined under the Indian Patent Act 1970	Contribution to overall conception of invention	'But for' and 'material effect' test. In the 'but for' test: if the invention would not have occurred but for the involvement of a particular person, then that person is an inventor. In the 'material effect' test: a person is defined as an inventor if her contribution had a 'material effect' on the final concept of the invention	Although a patent may issue from the European Patent Office (EPO) and have identical claims in each designated country, the determination of inventorship is made on a country-by-country basis.
Joint inventors	An application may be made by any of the persons referred to therein either alone or jointly with any other person. [S6(2)]	No need for inventors: - to physically work together; -make same amount or type of contributions; -make contribution to	Allowed under s63 Patents Act 1990; If a person solves a problem not recognized by initial inventors; solves a recognized problem that initial inventors had been unable to solve; or produced an	Recognized in Article 59 of the EPC, may also be filed either by joint applicants or by two or more applicants designating different Contracting States.

		every claim (35 U.S.C. 116)	advantage not contemplated by the named inventors they are usually named as joint inventors	
Rights of Co-owners/Joint Inventors	<p>Equal undivided share in the patent.</p> <ul style="list-style-type: none"> - each of those persons shall be entitled to the rights for his own benefit without accounting to the other co-inventors - No licence under the patent can be granted and no share in the patent can be assigned except with the consent of the all inventors. (S 50) 	<p>Equal and undivided rights;</p> <ul style="list-style-type: none"> - can be assigned; - no need to obtain each inventor's consent for licensing agreements or practicing the invention (35 U.S.C. 262). 	<p>As in United States</p> <p>EXCEPT</p> <p>Consent needed from all inventors before any licensing agreement can occur (s16 Patents Act 1990).</p>	<p>Most European countries require permission of other inventors before licensing agreements can be entered into.</p>
Penalty for incorrectly naming inventors	<p>The true inventor can file an opposition and a plea for revocation of the patent on the grounds that the invention has been wrongfully obtained from him. And the patent may stand amended in the name of the opponent alone or added to existing inventors. If some portion of the specification has been contributed by the inventor but not named; the specification may be edited to remove those portions</p>	<p>Possibly patent declared invalid if deception exists. However, most often the court will order a change in inventorship.</p>	<p>Same as United States.</p>	<p>Penalties under national legislation (EPC Article 64(3)). Patent may be declared invalid.</p>

D. EXAMPLES AND CASES:

USA:

Ex 1: Simone, a PhD student, constructs a new plasmid according to the scheme devised by her supervisor. She does not become an inventor because she was merely following the directions of her supervisor. Her supervisor is the true inventor.

Ex 2: Tony is a manufacturer who makes a new product according to the specifications given to him by his boss. Tony is not the inventor because he has merely contributed to the reduction to practice. However, if he contributed to the conception of the new product, both he AND his boss would be inventors.

Ex 3: A post-doctoral physicist adds a feature to a prototype which her laboratory is working on. The additional feature will give the prototype another useful purpose. If the new purpose is claimed in the patent application, the post-doc has contributed to the conception of the invention and, as a result, is an inventor.

Ex 4: Lisa and Margaret are co-inventors and thus, co-owners of the rights to an invention. Bart seeks the permission of Lisa to use it. Lisa does not have to consult Margaret in regards to Bart being able to use the invention. She can allow Bart to use the invention without seeking Margaret's permission. (Note: If Lisa and Margaret have assigned their rights in the invention to their employer, as is often the case in an employment agreement, Bart would have to seek the employer's permission).

Ex 5: Dr Buick is a scientist employed by General M. University. Dr Buick invents a new system of growing hydroponic plants and wishes to patent the invention. Dr Buick is the inventor of the system and is named as such on the patent application. However given that the system was developed at General M. University in the course of Dr Buick's employment, General M. University will be the owner of the system. Therefore General M. University will be designated as the assignee on the patent, and has the right to confer licenses to use the patented technology or not.

Case Study 1: In a real-life example, a university graduate student who contributed to an invention was not named as an inventor on the associated patent application. The patent sought to cover transgenic cotton and methods for transforming it. Monsanto was later assigned the patent by her fellow inventors who were named on the application. Monsanto's competitor, Aventis, discovered the unnamed inventor and sought to have her correct the inventorship on the patent and then transfer her rights to the technology to Aventis. She did so and Aventis received the same ownership rights as Monsanto (see section 3.1 on joint inventorship). If the graduate student had been named initially as an inventor, Aventis would have needed a license from Monsanto to use the technology.

EUROPE:

Ex 1: Pierre is a French national working in Germany, in the German laboratory of a large multinational agricultural biotechnology company, which is incorporated in England. While employed in Germany, Pierre is involved in developing a new method of plant transformation. According to the EPC, whether Pierre is an inventor is determined by the national laws of the country where the employer holds his business. At first glance it would appear that Pierre's status would be governed by German law, but the fact that the employer is a company which is incorporated in England suggests that the laws of England governing inventorship should apply.

E. REFERENCES:

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Note: This IGN was finalized in the current form on 11th Nov 2011. This is intended as a working document. Readers are requested to provide comments/suggestions & point to any errors (if any) so as to help improve this document. Comments may be sent to sv.kanitkar@ncl.res.in