

CLASS 19

**INVENTORSHIP & OWNERSHIP
OF PATENTS**

**PATENT LAW & POLICY
PROFESSOR WAGNER**



Today's Agenda

The Basics of Inventorship

Judicial Correction of Inventorship

Joint Inventorship & Ownership

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Basics of Inventorship

35 USC § 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

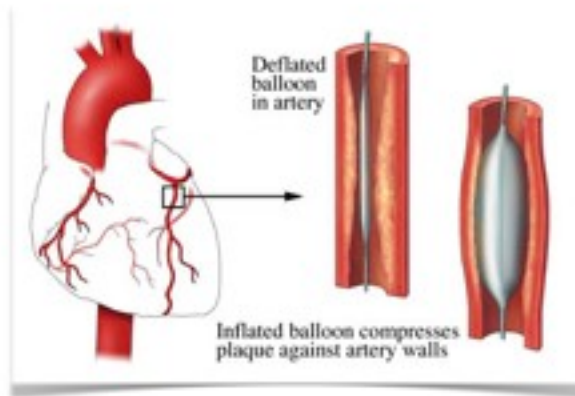
- (1) they did not physically work together or at the same time,
- (2) each did not make the same type or amount of contribution, or
- (3) each did not make a contribution to the subject matter of every claim of the patent.

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Hess v. Advanced Cardio. Systems (Fed. Cir. 1997)



Hess v. Advanced Cardio. Systems (Fed. Cir. 1997)

What is the Inventive Contribution?

Simpson / Robert	Hess
basic design (balloon on shaft)	material selection / choices
experiment with materials	approaches to construction of the catheter

Hess v. Advanced Cardio. Systems (Fed. Cir. 1997)

What is the Inventive Contribution?

Simpson / Robert	Hess
basic design	material selection / choices
experiment with materials	approaches to construction of the catheter

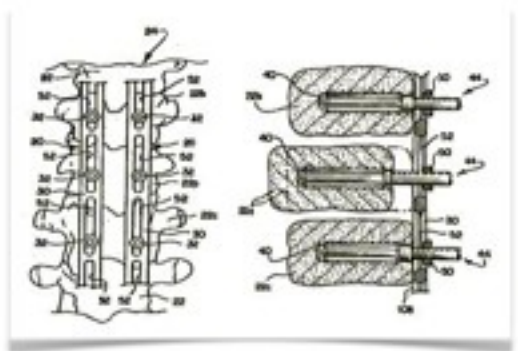
Why is Hess not an inventor?
[What more would be required?]

Hess v. Advanced Cardio. Systems (Fed. Cir. 1997)

What is the Inventive Contribution?

What is the standard?	
What is the evidentiary requirement? [Why?]	
basin	ces
experiment with materials	approaches to construction of the catheter

Acromed v Sofamor Danek (Fed. Cir. 2001)



Acromed v Sofamor Danek (Fed. Cir. 2001)



Steffee	Janson
basic design	machinist claims to have conceived of the 'recesses' in the plate

Acromed v Sofamor Danek (Fed. Cir. 2001)



An apparatus for use with fasteners for maintaining vertebrae in a desired relationship, said apparatus comprising:

an elongated plate for connecting at least two vertebrae . . .

There is no dispute that Janson created the "arcuate recesses" in the plates. Why isn't he an inventor?

recesses in the other of said opposed slot surfaces to define said plurality of locations, said recesses comprising means for blocking sliding movement of (s)aid elongated plate relative to the fastener and of said elongated plate relative to the vertebrae when the fastener is located in a pair of aligned recesses[.]

Acromed v Sofamor Danek (Fed. Cir. 2001)



An apparatus for use with fasteners for maintaining vertebrae in a desired relationship, said apparatus comprising:

an elongated plate for connecting at least two vertebrae . . .

Janson testified that he conceived of the recesses (and conical nut). Why isn't he an inventor?

recesses in the other of said opposed slot surfaces to define said plurality of locations, said recesses comprising means for blocking sliding movement of [s]aid elongated plate relative to the fastener and of said elongated plate relative to the vertebrae when the fastener is located in a pair of aligned recesses[.]

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Judicial Correction of Inventorship

Correction of Inventorship

Stark v. Advanced Magnetics (Fed. Cir. 1997)

**Stark was a non-joined inventor.
(What does this mean?)**

What are the implications for litigation?

Correction of Inventorship

§256. Correction of named inventor

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 Director 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 correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

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Stark claims the listed inventors committed fraud in failing to list him. Can Stark be added to the patent?

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Correction of Inventorship

§256. Correction of named inventor

When
through
with
the
may

Does this mean that you can omit your collaborator, and later add her without implications?

or,
rose
of all
ts as

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**Note Judge Plager's concurrence in Stark:
Correction is an issue of equity.**

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Joint Inventorship & Ownership

Ethicon v. US Surgical (Fed. Cir. 1998)

**Why was Choi determined to be an
inventor on Claim 33?**

{ Choi and Yoon testified in opposition }

Ethicon v. US Surgical (Fed. Cir. 1998)

Why was Choi determined to be an inventor on Claim 47?
{ hint: means-plus-function claim format }

Ethicon v. US Surgical (Fed. Cir. 1998)

Choi contributed to 2 of 55 claims of the patent.
What rights does Choi have in the patent?

Ethicon v. US Surgical (Fed. Cir. 1998)

Choi contributed to 2 of 55 claims of the patent.

Can Choi 'retroactively license' the patent?

[Why did US Surgical sign this agreement?]

Ethicon v. US Surgical (Fed. Cir. 1998)

Choi contributed to 2 of 55 claims of the patent.

Can Choi 'retroactively license' the patent?

**The Court holds that Choi cannot forgive
past damages to Ethicon.**

**Yet, US Surgical is still
not liable for these damages. Why?**

Ethicon v. US Surgical (Fed. Cir. 1998)

Judge Newman argues in dissent that § 116 is not intended to define patent ownership, just invention.

(How does she suggest ownership be resolved?)

Ethicon v. US Surgical (Fed. Cir. 1998)

How should patent-holders resolve the ownership of jointly-invented patents?

NEXT CLASS

ANTITRUST & PATENT MISUSE

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