Inventorship Is an Important Consideration

Who the inventor or inventors of a patent are can be very significant. The law says that a patent application must be filed by an inventor or someone deriving rights from the inventor. Because a corporation is a legal fiction, it has no brain with which to invent. Only people can invent, and when people invent, they are inventors. Although the popular image of an inventor is somebody working alone to come up with a great idea, more commonly, inventions result from a collaborative effort of two or more people working together. When the patent application is filed on that invention, the joint inventors must be identified in the patent application to have a valid patent.

Although ownership of U.S. patents is determined by state laws, in most states, the initial owner of the invention is the inventor unless the inventor has already conveyed away his or her rights to the invention, such as by signing an agreement with his or her employer when he or she goes to work for the employer. If all of the joint inventors have these kinds of agreements and work for the same company, ownership of the resulting invention is easy to determine: it is the employer of the several inventors. However, companies may also work with consultants and suppliers. The resulting inventive team can include employees of the company and non-employees. As we will see, when a company decides to work with an outside company, it is prudent to have an agreement ahead of time allocating ownership of the invention rights, as the parties may negotiate.

A recent case involving a dog, his owner, and a veterinarian illustrates some of the things that can go wrong. The dog had to have surgery and, in recovering from surgery, would drag his hind paw and put weight on his paw’s knuckles. The owner’s patent attorney filed a patent application naming the owner and veterinarian as joint inventors. However, there was a subsequent falling-out between the inventor and the veterinarian, so the dog owner had the attorney withdraw that application and file a separate application naming the dog owner as the sole inventor. That application was rejected by the U.S. Patent and Trademark Office on the ground that the patent applicant, the dog owner, was not the inventor, because he omitted the veterinarian. The dog owner appealed to the U.S. Court of Appeals for the Federal Circuit to rule on whether the veterinarian was required to have been named as a joint inventor.

The court said that the issue depends on what is claimed, and the evidence showed that the claimed invention was, indeed, the product of inventive contributions by both the owner and the veterinarian. The court explained that the pertinent inquiry is as to the conception of the invention as defined in the patent’s claims. Conception requires a definite and permanent idea of an operative invention, including every feature of the claims. An idea is definite and permanent when the inventor has a specific, settled idea: a particular solution to the problem at hand and not just a general goal or research plan.

The court also explained that joint inventors need not contribute equally to the conception. However, a joint inventor must 1) contribute in some significant manner to the conception or reduction to practice of the invention, 2) make a contribution to the claimed invention that is not insignificant in quality when that contribution is measured against the dimension of the full invention, and 3) do more than...
absorbs the variations in input voltage to control the voltage across the noncritical load while the voltage across the critical load is maintained within the required limits. This greatly improves the reliability of the system. The noncritical load together with electrical spring forms a smart load. The talk was followed by an interactive session with the students. Thirty-two IEEE Members attended the program.

On 13 March 2019, Prof. Panda inaugurated the PELS SBC of the College of Engineering, Karunagappally. This program was attended by Prof. Muhammed Kasim S, chair of the joint IAS/IES/PELS Kerala Chapter, and 35 IEEE Members.

**WiE Insight**

As part of International Women’s Day 2019, the IEEE joint IAS/IES/PELS Kerala Chapter also celebrated the spirit of womanhood with WiE Insight. The program, which was conducted from 8 to 16 March 2019, paid tribute to all women who have brought phenomenal change to the Society. WiE Insight attracted attention to the unlimited potential of women in the context of science and technology.

About 25 events were planned in Kerala as part of the program, which mainly focused on the benefits of having female student members in IAS, IES, and PELS. The major activities of WiE Insight were a photography contest and a two-level quiz competition named Quest. The topic of the photography competition was “Women’s Day Celebration and Women Empowerment.” Approximately 15 entries were received for the competition from the SBCs in Kerala.

On 5 March 2019, the IEEE PELS SBC at GEC-Thrissur conducted a workshop to help students obtain a deeper knowledge of circuit simulation using Proteus. Dr. Jason Mathew was the person who helped organize the workshop.

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merely explain to the real inventors well-known concepts or the current state of the art. Because it was clear from the documents in the patent application file that the veterinarian met these criteria, her omission meant that the dog owner’s patent application did not properly identify the inventorship, so the application was properly rejected by the patent office.

Inventorship has commercial significance because of the ownership issues that flow from inventorship. If a company or an individual collaborates with another but wants to be the sole owner of the patent and has not signed contracts for that to be the case ahead of time, it may try to exclude the other inventor from the application, as the dog owner did, putting the validity of the patent in jeopardy as a consequence. Preparing ahead by making sure that agreements of ownership are ironed out in writing helps prevent these kinds of disputes and unfortunate results.

**About the Author**

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