



Mesmer & Deleault, PLLC
41 Brook Street, Manchester, NH 03104



“Tip of the Month”

Determining Patent Inventorship: Who is an Inventor?

By law, the inventors on a patent are the invention’s original owners. Thus, the proper naming of inventors is a very important task. Conversely, the improper omission of an inventor or the addition of a non-inventor to a patent can have significant effects on the patent and may even render it invalid.

Determining inventorship is nothing more than determining who conceived the invention. Conception exists when a definite and permanent idea of an operative invention is known. The test for conception includes the following:

1. Whether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention.
2. The inventor must prove his/her conception by corroborating evidence (preferably by showing a contemporaneous disclosure).

An idea is definite and permanent when an inventor has a specific, settled idea. Particularly, it is a solution to the problem at hand, not just a general goal or research plan s/he hopes to pursue. Conception necessarily turns on the inventor’s ability to describe his/her invention with particularity.

Inventorship also depends on the elements of the patent claims. It is the subject matter of those elements that must have been conceived. Work on unclaimed features, optimization, and commercialization does not constitute contribution to inventorship.

More than one person may contribute to an invention’s conception. They are called joint inventors. Joint inventors must all have contributed to the conception of the claim elements. However, each joint inventor need not have contributed to every claim. Further, joint inventors need not have made equal contributions.

Suggesting an invention in terms of a problem to be solved, a need to be addressed, or a result to be obtained does not make a person a joint inventor. Those who follow the inventor’s lead in carrying out tests and experiments or reducing the invention to practice are not joint inventors. The key is whether the original conceiver truly conceived all of the invention’s elements so that later workers were not required to perform any inventive activity.

If you have any questions about inventorship, please do not hesitate to call us at 603-668-1971 or contact us by e-mail at *Meslaw @ aol.com*.

Frank B. Mesmer, Jr., Esq.
Robert R. Deleault, Esq.

(603) 668-1971

Fax (603) 622-1445

E-mail: Meslaw@aol.com

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