

What To Do If Fewer Than All Of The Named Inventors Contributed To The
Subject Matter Defined By The Count¹

By Charles L. Gholz²

INTRODUCTION

This article does not deal with the situation wherein, upon digging into the underlying facts, counsel for an interferent discovers to his or her horror that one of the named inventors did not contribute to the conception of the subject matter defined by any of the claims designated as corresponding to the count.³ In that situation there is absolutely no question but that one must move promptly under 35 USC 256 and 37 CFR 1.324 to delete the erroneously named inventor.⁴

No, this article deals with the situation where one or more of the named inventors on the case in interference is there perfectly appropriately because he, she, or they contributed to the conception of at least one claim designated as corresponding to the count,⁵ but he, she, or they did not contribute to the conception of the subject matter defined by the count. At first blush, that would seem to me to be a very common situation. However, I have been able to find only one opinion dealing with that subject.⁶

WHAT THE BOARD SAID IN LARSON V. JOHENNING

Larson v. Johenning, 17 USPQ2d 1610 (PTOBPAI 1990)(opinion by EIC Boler for an expanded panel that also consisted of Vice Chairman Calvert and EICs R. Smith, McCandlish, and Caroff), dealt with precisely this situation—albeit arguably in dicta. The Larson et al application in interference named Lynn D. Larson, Ronald Lee Larson, and Terry L. Stentz as joint inventors. However, their preliminary statement (what is now called a priority statement) named only the Larson brothers as the inventors of the subject matter defined by the count.

The reason that what Larson v. Johenning says with reference to the subject of interest here

is arguably dicta is that the panel held that Mr. Stentz was “a coinventor with the Larsons of the subject matter in the count...”⁷ Moreover, the reason (and the only reason) that the panel even considered whether Mr. Stentz was a coinventor was that “Counsel for Larson et al...[contended] that[,] since Stentz was not named as an inventor of the subject matter of the count in the preliminary statement, he...[was] available as a corroborating witness regardless of whether or not he is a coinventor.”⁸ Since Johenning et al. had not argued that Larson et al.’s claims were unpatentable on the ground that the inventorship named in the Larson et al. application was incorrect, the panel did not give any consideration to whether Larson et al. had any obligation to move to correct the inventorship named in the Larson et al. application.

However, although the panel clearly held that “The testimony of one inventor as to the inventive acts of another joint inventor with respect to conception and/or a reduction to practice cannot...satisfy the requirement for corroborative evidence independent of the inventor(s)...,”⁹ it said that “we have, for the sake of completeness, first considered the evidence as if...[Mr. Stentz] were available as a corroborating witness and then pointed out why we think he is a coinventor and not available as a corroborating witness.”¹⁰ Having done all that, the panel then said what is of interest here:

Prior to the 1984 change in 35 USC 116 permitting joint applications to be filed even though “each [applicant] did not make a contribution to the subject matter of every claim of the patent”, it was well settled that an opposing party could rely on the rule that conception and reduction to practice must be corroborated by evidence other than that that [sic; that is, the opinion uses two that’s in a row] given by joint applicants. *Many v. Garlick*, 135 F.2d 757, 57 USPQ 377, 388 (CCPA 1943). Where it was determined that the invention was made by less than all of the named joint applicants, they were required to diligently reform the interference by deleting the noninventor(s) therefrom. In view of the above noted change in the statute, we foresee some relaxation in the rule prohibiting corroboration of conception and reduction to practice by joint applicants. However, in an interference such as this where all of the claims of Larson et al have been designated as corresponding to the

count, all of the joint applicants must *prima facie* be deemed to be coinventors of the subject matter of the count. In other words, the burden is on the party asserting that the joint applicant relied upon as a corroborating witness is not a joint inventor of the subject matter of the count to establish that fact through convincing evidence in the record. Cf. *Vanderkooi v. Hoeschele*, 7 USPQ2d 1253, 1256 (BPAI 1987).¹¹

COMMENTS

(1) Since the ultimate holding of the case is that Larson et al. had failed to prove that they had conceived the subject matter defined by the count before the date upon which Johenning et al. had actually reduced to practice subject matter within the scope of the count, I think that it can be argued that what the panel said in the set-off quote above is an alternative holding rather than dicta. That is, it can be argued that Larson et al. lost because they failed to carry their burden of “establish[ing]...[the] fact...[that Mr. Stentz was not a joint inventor of the subject matter of the count] through convincing evidence in the record.”¹²

(2) If the quoted statement is an alternative holding, then it is a holding that if Larson et al. had carried that burden, then Larson et al. would have been entitled to rely on Mr. Stentz as a corroborating witness. I think that it follows from that (a) that it is perfectly proper both to name fewer than all of inventors named in one’s case in interference as the inventors of the subject matter defined by the count and (b) that, if one carries the burden of proof set forth in Larson v. Johenning, it is proper to rely on the testimony of the unnamed inventor or inventors to corroborate one’s asserted invention dates.

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² Partner in Oblon , Spivak, McClelland, Maier & Neustadt, LLP. My direct dial telephone

number is 703/412-6485, and my email address is cgholz@oblon.com.

³ My favorite “war story” about such a situation is the time that a named inventor (fortunately, a named inventor on the other side’s case, not a named inventor on my case) proudly testified that he was named on the case in interference because, as a banker, he had approved the loan the proceeds of which were used to prepare the foreign priority application.

⁴ Since 35 USC 256 only permits correction of inventorship where the error “arose without any deceptive intention on...[the] part [of the erroneously named inventor],” that can be difficult. In fact, it was so difficult in the interference referred to in backnote 3 that the named inventor’s testimony (which obviously floored opposing counsel) led to an early and favorable settlement of the interference.

⁵ This article also doesn’t deal with the situation where one or more erroneously named inventors are perfectly appropriately on the case in interference because he, she, or they contributed to the subject matter of at least one claim designated as not corresponding to the count. However, I think that the opinion discussed herein could be easily extended to cover that situation.

⁶ I hereby invite the readers of this article to bring to my attention any other opinion dealing with this subject of which they may be aware.

⁷ 17 USPQ2d at 1611.

⁸ 17 USPQ2d at 1611.

⁹ 17 USPQ2d at 1614.

¹⁰ 17 USPQ2d at 1611-12.

¹¹ 17 USPQ2d at 1614; emphasis supplied.

¹² 17 USPQ2d at 1614.