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Client Alert: USPTO Rejects Patent Applications with Incorrect Inventorship

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Scott M. Guttman

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The Federal Circuit recently addressed the importance of correctly naming all inventors on a patent application. *In re Verhoef*, No. 2017-1976, 2018 (Fed. Cir. May 3, 2018). The United States Patent and Trademark Office's (USPTO) rejection of the claims of a pending patent application was affirmed by the Federal Circuit because the applicant "did not himself invent the subject matter sought to be patented."

The technology at issue was a dog harness, and the key feature of the dog harness was suggested to the applicant by a veterinarian. A first patent application was filed listing the applicant and the veterinarian as joint inventors. After their relationship soured, that application was abandoned and the applicant subsequently filed a second patent application naming himself as the sole inventor. The USPTO rejected the claims of the second application as unpatentable under pre-AIA 35 U.S.C. § 102(f) because the applicant "did not himself invent the subject matter sought to be patented."

The applicant appealed to the Patent Trial and Appeal Board (the board), which sustained the USPTO's rejection concluding that the veterinarian was a joint inventor. The Federal Circuit affirmed the board's decision, finding that the veterinarian was an inventor as she contributed an essential feature of the invention. The Federal Circuit held that the board properly sustained the USPTO's rejection because the second application did not name the correct inventors and inventorship was never corrected.

"Consistent with statutory command and our precedent, the Manual of Patent Examining Procedure ('MPEP') instructs examiners that '[i]n the rare situation it is clear the application does not name the correct inventorship and the applicant has not filed a request to correct inventorship ..., the examiner should reject the claims under ... pre-AIA 35 U.S.C. [§] 102(f).' This case presents the 'rare situation,' or at least an uncommon one, where the [patent] application and [the applicant's] affidavit make clear that he did not himself solely invent the subject matter sought to be patented...."

PRACTICE NOTES:

It comes as no surprise that full and complete inventorship should be included on any patent application. *In re Verhoef* reminds us that claims of a patent application can be rejected or subject to delay unless the patent application correctly identifies *all* inventors. To help facilitate this process, research and development records should be continuously maintained, including records of the contributions that various employees or non-employees have made to technology for which the company may wish to file a patent application.

Regarding who owns intellectual property that may be subject to a patent application, disputes may often be avoided by obtaining assignments to the technology early on in the process. In addition, companies should ensure that all contributing personnel are working on behalf of the company and obligated to assign their intellectual property rights. To the extent contributions are made by employees, the company should ensure the employees previously executed an employment agreement that contains a present assignment of intellectual property rights to the company (see ***Client Alert: Employment Agreements must 'Presently' Assign IP Rights***). Companies utilizing non-employees for research and development should ensure that such non-employees execute non-disclosure agreements wherein they presently convey all their rights to the developed technology to the company.