Importance of the Inventorship Analysis

The Federal Circuit recently highlighted the importance of making a careful inventorship determination in each patent application by affirming the district court’s order to the United States Patent and Trademark Office (USPTO) to add an inventor to an issued patent. Falana v. Kent State University (Fed. Cir. January 2012).

In Falana, a researcher, Falana, working for KDI Corporation (“KDI”), a spin-off company from Kent State University, developed a synthesis protocol for a novel class of chemical compounds. He also synthesized at least one compound within this class. After Falana left KDI, another researcher, Seed, synthesized a similar compound using the protocol developed by Falana. Soon thereafter, KDI and Kent State filed a patent application that ultimately issued as U.S. Patent No. 6,830,789 (the ‘789 patent). Falana was not named as one of the inventors of the ‘789 patent. While the specification disclosed the synthesis protocol developed by Falana and stated that this protocol was used to synthesize the claimed class of compounds, the claims of the ‘789 patent were only directed to compounds and not methods. In addition, the claims did not encompass the compound that was synthesized by Falana.

The Federal Circuit affirmed the district court’s ruling that Falana is a co-inventor of the ‘789 patent. The fact that claims were directed to chemical compounds and not methods was not critical. Importantly, the Federal Circuit held that if the method of making a compound requires more than the exercise of ordinary skill in the art, the discovery of the method is “as much a contribution to the compound as the discovery of the compound itself.” Further, just because the particular compound synthesized by Falana was not covered by the claims of the ‘789 patent did not negate his contribution of the method used to arrive at the claimed compounds. As the Federal Circuit stated, “a putative inventor who envisioned the structure of a novel genus of chemical compounds and contributes the method of making that genus contributes to the conception of that genus.”

This case underscores the critical importance of conducting a thorough inventorship analysis to ensure that all the appropriate inventors are named in the patent. Even contributing to one claim is sufficient to make someone a co-inventor. Failure to name all inventors may lead to serious problems if a patent is ever asserted in litigation, thus significantly affecting the patent’s enforceability. For example, an alleged infringer could obtain an unnamed co-inventor’s rights, prove in court that this unnamed co-inventor should have been named, and thus derail the infringement lawsuit.
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