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SLW Chemistry and Biology Webinar Series

Inventorship & Assignment: Practical Considerations for Your Patents

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Dr. Nicholas P. Lanzatella
Principal and Patent Attorney at SLW



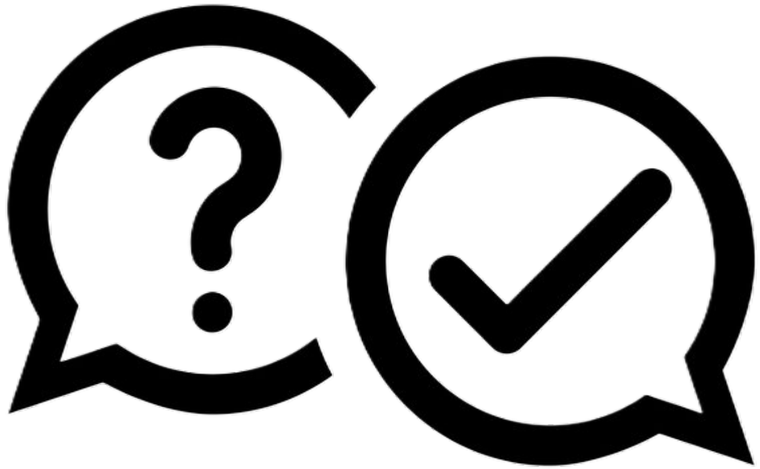
Ryan Connell
Principal and Patent Attorney at SLW

Acknowledgements

Thank you to Douglas Portnow

Overview

- What is inventorship?
- What is assignment?



Why is Inventorship Relevant?



Why is Inventorship Relevant?



- US Constitution gives our federal government the power to grant patents to inventors
  - Article 1, section 8, clause 8 recites:
- "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

Why is Assignment Relevant?

- The government gives patent rights to the inventors
- The inventors can then assign all or some of their patent rights to other parties in exchange for compensation
- Patents are property and can be owned and exploited, sold, or licensed just like any other property

Inventorship vs. Assignment

- Inventorship and ownership (assignment) are two different concepts
- The owner enjoys all the rights and benefits provided by the patent
- The inventor is usually the initial owner of a patent application but is often obligated to assign his/her rights to the employer
- Once the inventor assigns his/her rights to the patent, the inventor no longer enjoys the rights of the patent

Assignor Estoppel

- Prevents an assignor from challenging patent invalidity in litigation

- Minerva Surgical v. Hologic, Inc. (No. 20-440, 2021 WL 2653265 (U.S. June 29, 2021) limited estoppel to any express or implied representations about validity at the time of the assignment.



Licensee Estoppel

- In some jurisdictions, a patent licensee is estopped from challenging validity of a licensed patent

- In the USA, this doctrine was overturned in Lear v. Adkins, (395 U.S. 653, 1969) but only for patents

Inventorship

Who is an Inventor?

- A person listed as an inventor on a patent must meet the legal standard for inventorship
    - In the US, an inventor is a person who contributed to the conception of the claimed invention (MPEP 2137.01)
    - Conception is defined as formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice (MPEP 2137.01)

Who is an Inventor?

- In other words, a person has conceived an invention when their idea is clear enough to enable one skilled in the art to implement the invention in a practical form (reduction to practice)
- The inventor does not need to reduce the invention to practice
    - (MPEP 2137.01)
- In the US inventorship is based only on the claims, not the entire disclosure
    - Some countries, inventorship is based on the teachings of the disclosure

Who is an Inventor?

- A person who implements (builds, codes, or carries out) an invention under the direction of someone else who conceived of the entire idea, is not an inventor unless they make additional inventive contributions
    - Examples
        - You come up with a new molecule and task a lab worker to synthesize it – the lab worker is not an inventor
        - If the lab worker modifies the molecule (e.g., produces a derivative), he/she *may* be an inventor

Who is an Inventor?



- A patent application or patent can have multiple inventors
  - Does not require equal contribution
  - Only needs to be an inventor of 1 claim minimum
- Do not confuse journal article authorship rules/standards with patent inventorship
- A company can never be an inventor
  - Some case law suggests that AI cannot be an inventor
- Inventorship controlled by Federal law
  - Disputes resolved at PTO or in Federal court

Artificial Intelligence (AI) & Inventorship

- Can AI be a named inventor on a patent? Recent case law around the world is not consistent
- In 2021, South African patent office became first country to award a patent to an artificial intelligence (AI named DABUS – device for the autonomous bootstrapping of unified sentience).
  - Patent was directed to a food container design based on fractal geometry
  - No patent examination in ZA. Patent is registered and is valid unless 3rd party challenges validity.
- Australian Federal court also ruled that AI (same DABUS) can be a named inventor for an invention related to a food container and a signal beacon

Artificial Intelligence (AI) & Inventorship

- At EPO, AI cannot be an inventor based on two denials in 2020
- In the USA, inventor must be a human. AI cannot be an inventor. *Thaler v. Hirshfeld*, 20-903, U.S. District Court for the Eastern District of Virginia (Alexandria)
- Issues: How can the same patent in two different jurisdictions have different inventorship? In the US, if AI is an inventor but cannot be listed as an inventor, then is the US patent valid? How are rights to the invention handled?
- Have to look at the law in each jurisdiction. Some refer only to human inventors (e.g. using pronouns like he/her, or require mental conception which can only be performed by a human

Is the Patent Attorney an Inventor?

- As the patent attorney be careful about inserting your own improvements and features into the application so you do not become an inventor
    - You can ask “does your invention do X” or “does your invention include y”
- *Solomon v. Kimberly-Clark Corp* the Fed. Cir. found that patent attorney is not an inventor in a patent application he/she is prosecuting because the patent attorney’s role is to define the invention and that should not force it to compete against the client or assert inventorship

Inventorship Can Change



- Inventorship can change during patent prosecution
- Example
  - You file a patent application with claims 1-20 and inventors A, B, and C
  - During patent prosecution, you amend your claims to overcome prior art rejections or cancel/add claims
  - The amendments may change inventorship
  - If inventorship changes you have to update the patent application inventorship

Order of Inventors – Does it Matter?

- Example
  - Inventorship is listed as Smith, Jones, Doe
  - Inventorship is listed at Jones, Smith, Doe

- No legal significance to order of inventors

- But in reality ego/politics can play a role in determining who the first listed inventor is

- If you want to change the order of inventors you have to file a papers with the PTO and that costs money

Correction of Inventorship

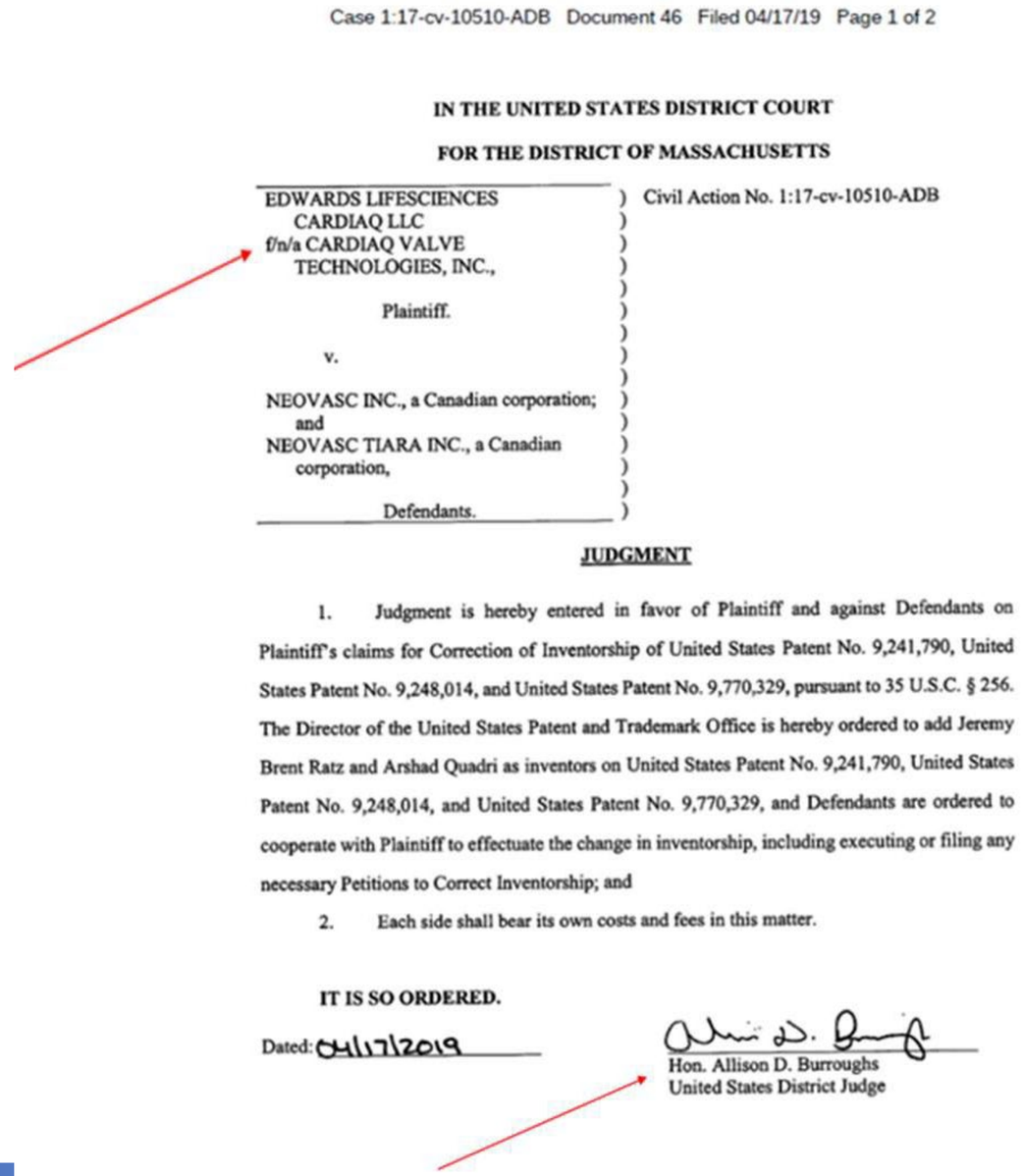
- If there was no deceptive intent then you can correct inventorship using the procedure in 37 CFR 1.48

- You can also file a lawsuit under 35 USC section 256 to correct inventorship in an issued patent



Correction of Inventorship During Prosecution

- Example of inventorship change under 35 USC section 256



Case 1:17-cv-10510-ADB Document 46 Filed 04/17/19 Page 1 of 2

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF MASSACHUSETTS

EDWARDS LIFESCIENCES CARDIAQ LLC f/n/a CARDIAQ VALVE TECHNOLOGIES, INC., Plaintiff. v. NEOVASC INC., a Canadian corporation; and NEOVASC TIARA INC., a Canadian corporation, Defendants.	Civil Action No. 1:17-cv-10510-ADB

JUDGMENT

1. Judgment is hereby entered in favor of Plaintiff and against Defendants on Plaintiff's claims for Correction of Inventorship of United States Patent No. 9,241,790, United States Patent No. 9,248,014, and United States Patent No. 9,770,329, pursuant to 35 U.S.C. § 256. The Director of the United States Patent and Trademark Office is hereby ordered to add Jeremy Brent Ratz and Arshad Quadri as inventors on United States Patent No. 9,241,790, United States Patent No. 9,248,014, and United States Patent No. 9,770,329, and Defendants are ordered to cooperate with Plaintiff to effectuate the change in inventorship, including executing or filing any necessary Petitions to Correct Inventorship; and

2. Each side shall bear its own costs and fees in this matter.

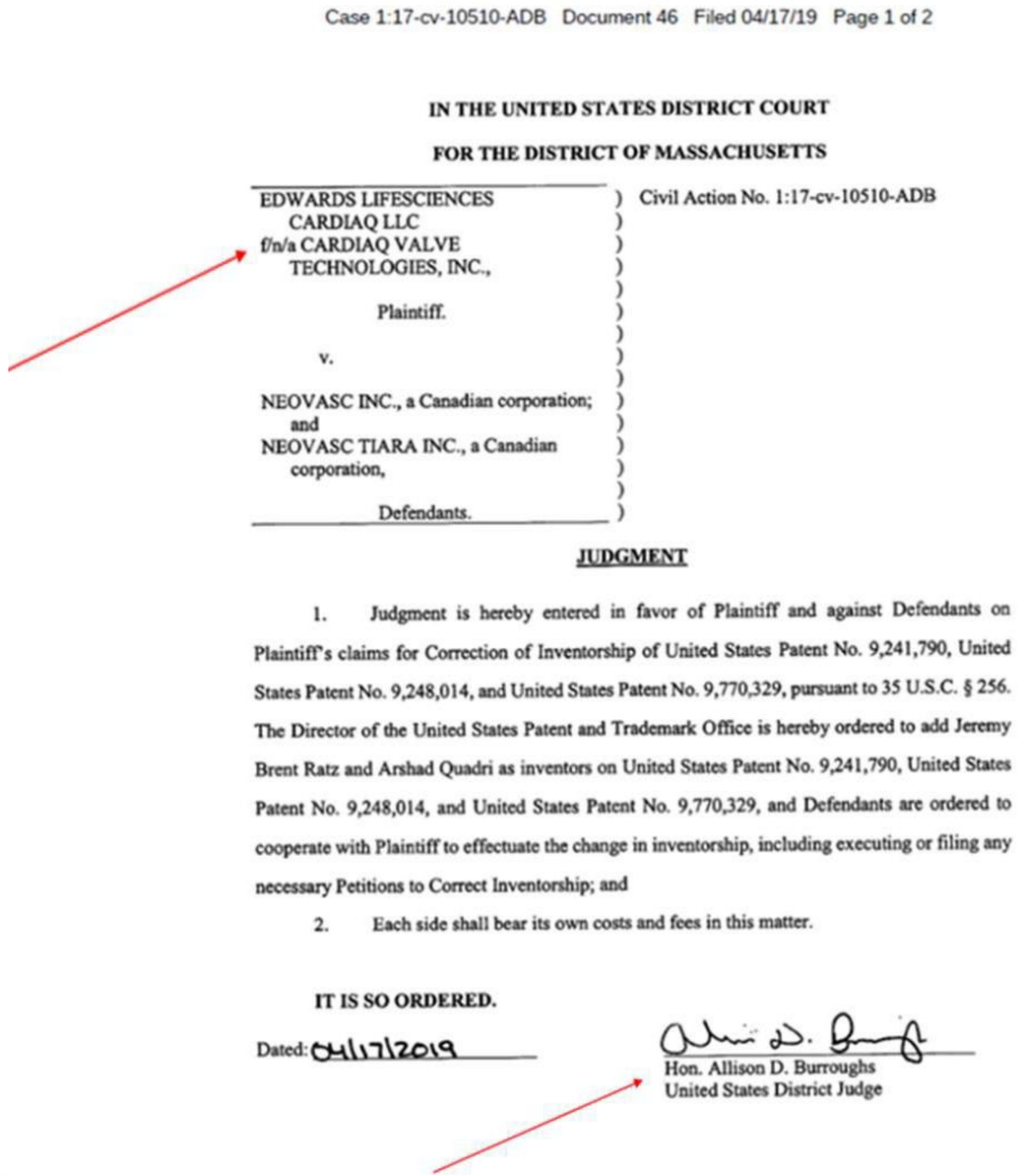
IT IS SO ORDERED.

Dated: 04/17/2019

Hon. Allison D. Burroughs
United States District Judge

Correction of Inventorship Following Issue

- Example of inventorship change under 35 USC section 256



Case 1:17-cv-10510-ADB Document 46 Filed 04/17/19 Page 1 of 2

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2. Each side shall bear its own costs and fees in this matter.

IT IS SO ORDERED.

Dated: 04/17/2019

Hon. Allison D. Burroughs
United States District Judge

Assignment



Ownership



- The inventor(s) is/are the first owner(s) of a patent application
- Typically, the inventors work for a company and are obligated to assign their rights to the company, therefore the company becomes the owner (assignee)

Ownership (cont'd)

- Other legal theories of ownership include:
  - If you were hired to invent, invention likely owned by employer
  - If you used your employer's resources to invent, employer likely to own invention
  - Corporate officers may have a fiduciary duty to assign their inventions to their employers
  - Check employment/consulting agreements

Ownership (cont’d)

- Why do we care about inventors assigning their rights to the employer?
  - Joint owners of a patent have equal undivided rights to make, use, offer to sell, or sell the invention without consent from the other joint owners
  - Without assignment, inventors can license or sell their rights to a competitor, or practice the invention on their own

Ethicon v. United States Surgical Corp.

Ethicon. Inc. v. United States Surgical Corp., 135 F.3d 1456, 1998

- Ethicon sued US Surgical for patent infringement
- An omitted inventor contacted US Surgical and licensed his rights to the patent to US Surgical
- The Court held that the omitted inventor was indeed an inventor
- Because the omitted inventor licensed his patent rights to US Surgical, US Surgical was not infringing the patent
- The case was dismissed

Community Property & IP Ownership

- Certain states (e.g. California and Washington) are community property states
- Certain property acquired during a marriage is community property and therefore equally owned by the married couple
- Does this apply to patents?

Community Property & IP Ownership (cont'd)

- See *Enovys LLC v Nextel* 06-CV-5306, August 3, 2010
  - Plaintiff *Enovyss* sued defendant *Nextel* for patent infringement over GPS location technology
  - Defendant argued that plaintiff did not have standing to bring the patent infringement suit since all patent owners were not joined in the suit
  - Defendant argued that inventor's ex-wife was a co-owner based on community property
  - Court held that the CA state court's divorce decree resolved ownership since both parties agreed there was no community assets therefore no issue with standing
- What if there is no divorce and no state court judgment?

Assignment = Contract Law

- Assignment of the invention follows contract law
  - Offer
  - Acceptance
  - Consideration
  - These components are typically bundled as part of an employment offer so there is not typically separate offer, acceptance, consideration
  - Sometimes employers will give the nominal $1 to an inventor for assignment

Assignment Form

ASSIGNMENT

WHEREAS, Alex Vayser, Sunny Mitchell, Henry Jay Lee and Joseph Guido (hereinafter the "Undersigned") have made one or more inventions and other subject matter (hereinafter collectively referred to as the "Invention"); as described in the provisional patent application filed on February 14, 2019, assigned US application serial number 62/805,595, and titled FIDUCIAL MARKER FOR ONCOLOGICAL AND OTHER PROCEDURES.

FOR GOOD AND VALUABLE CONSIDERATION, the receipt, sufficiency, and adequacy of which are hereby acknowledged by the Undersigned, the Undersigned do hereby irrevocably and unconditionally:

CONVEY, ASSIGN, AND TRANSFER to Videra Surgical Inc. (the "Assignee"), having a place of business at 236 W Portal Ave #561, San Francisco, CA 94127, the Undersigned's entire right, title, and interest for the United States and all foreign countries and jurisdictions in and to:

the Invention which is disclosed in the above-identified application or applications;

such application or applications, and all divisional, continuing (including continuation-in-part), substitute, renewal, reissue, and all other applications for a patent or patents which have been or shall be filed in the United States (including all provisional and non-provisional applications), and in all foreign countries and jurisdictions based in whole or in part on any of such Invention (including any application for a utility model or an innovation patent application);

all original and reissued patents which have been or shall be issued in the United States and all foreign countries and jurisdictions based in whole or in part on any of such Invention;

including the right to claim priority to the above-identified patent application or applications in relation to subject matter based in whole or in part on the above-identified patent application or applications and any of the foregoing including the right to file foreign applications under the provisions of any convention or treaty;

and including the right to all causes of action, remedies, and other enforcement rights related to the above-identified application or applications, including without limitation the right to sue for past, present, or future infringement, misappropriation, or violation of any and all rights related to the above-identified patent application or applications and any of the foregoing, including the right to obtain and collect damages for past, present, or future infringement;

AUTHORIZE AND REQUEST the issuing authority to issue any and all United States and foreign patents granted on such Invention to the Assignee;

AUTHORIZE AND REQUEST that any attorney associated with U.S. Patent and Trademark Office (USPTO) Customer No. 21186 may (directly or through his/her designee) delete, insert, or alter any information related to the above-identified patent application or applications or any of the foregoing, after execution of this Assignment;

WARRANT AND COVENANT that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been or shall be made to others by the Undersigned, and that the full right to convey the same as herein expressed is possessed by the Undersigned;

COVENANT, that when requested and without compensation, but at the expense of the Assignee, in order to carry out in good faith the intent and purpose of this Assignment, the Undersigned shall (1) execute all provisional, non-provisional, divisional, continuing (including continuation-in-part), substitute, renewal, reissue, and all other patent applications for the Invention; (2) execute all rightful oaths, declarations, assignments, powers of attorney and other papers for the Invention; (3) communicate to the Assignee all facts known to the Undersigned relating to the Invention and the history thereof; (4) cooperate with the Assignee in any interference, reexamination, reissue, opposition, dispute, or litigation involving any of the applications or patents for the Invention; and (5) take such further actions as the Assignee shall reasonably consider necessary or desirable for vesting title to such Invention in the Assignee, or for securing, maintaining and enforcing proper patent protection for the Invention;

COVENANT, that should any provision of this agreement be held unenforceable by an authority of competent jurisdiction, such a ruling shall not affect the validity and enforceability of the remaining provisions.

THIS AGREEMENT IS TO BE BINDING on the heirs, assigns, representatives, and successors of the Undersigned, and is to extend to the benefit of the successors, assigns, and nominees of the Assignee.

AGREED as of the date of my signature below:

Assignment Docket No: 5210.002PRV

Assignors: Alex Vayser et al.

Title: FIDUCIAL MARKER FOR ONCOLOGICAL AND OTHER PROCEDURES

Assignor:

(Signature): 

Name: Alex Vayser

City/State: Mission Viejo, CA

Date: 2/25/2019

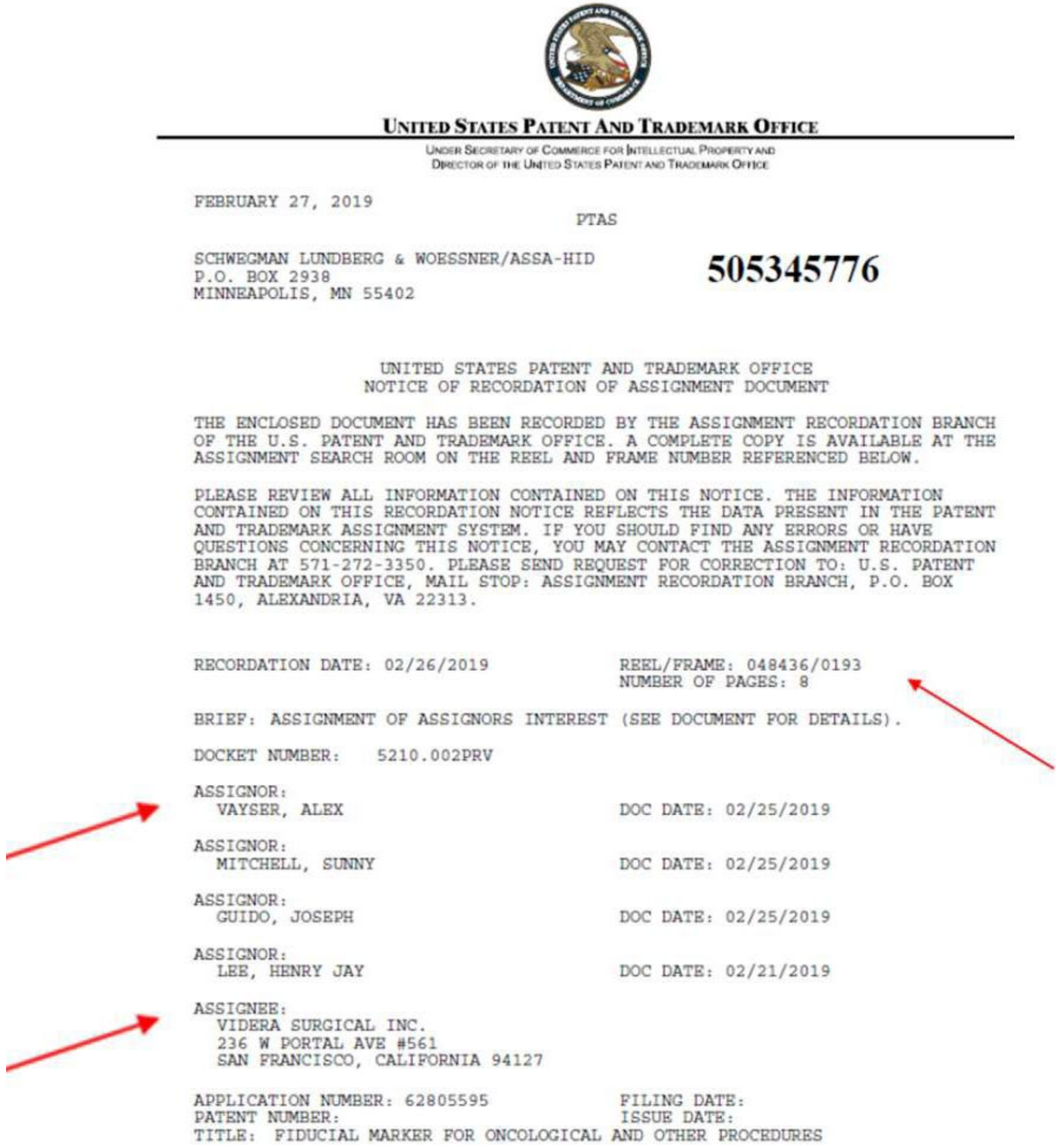
- Notarization
- Witness Signature
- Assignor/Assignee Signatures

How Do You Perfect Assignment?

- After an inventor executes the assignment form and assigns his/her invention to another party (typically a company), what do I do?

- Record the assignment with the USPTO
  - Just like recording the deed to your house with the county registrar
  - Provides public notice as to ownership

Confirmation Documents



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEBRUARY 27, 2019

PTAS

SCHWEGMAN LUNDBERG & WOESSNER/ASSA-HID
P.O. BOX 2938
MINNEAPOLIS, MN 55402

505345776

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT RECORDATION BRANCH OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE ASSIGNMENT RECORDATION BRANCH AT 571-272-3350. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, MAIL STOP: ASSIGNMENT RECORDATION BRANCH, P.O. BOX 1450, ALEXANDRIA, VA 22313.

RECORDATION DATE: 02/26/2019 — REEL/FRAME: 048436/0193
NUMBER OF PAGES: 8

BRIEF: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

DOCKET NUMBER: 5210.002PRV

ASSIGNOR:
VAYSER, ALEX — DOC DATE: 02/25/2019

ASSIGNOR:
MITCHELL, SUNNY — DOC DATE: 02/25/2019

ASSIGNOR:
GUIDO, JOSEPH — DOC DATE: 02/25/2019

ASSIGNOR:
LEE, HENRY JAY — DOC DATE: 02/21/2019

ASSIGNEE:
VIDERA SURGICAL INC.
236 W PORTAL AVE #561
SAN FRANCISCO, CALIFORNIA 94127

APPLICATION NUMBER: 62805595 — FILING DATE:
PATENT NUMBER: — ISSUE DATE:
TITLE: FIDUCIAL MARKER FOR ONCOLOGICAL AND OTHER PROCEDURES

P.O. Box 1450, Alexandria, Virginia 22313-1450 - WWW.USPTO.GOV

How Do You Perfect Assignment (cont'd)?

- Note timeliness of recordation is important
  - Assignment executed but not recorded
    - 35 USC section 261:
      - An interest that constitutes an assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

Other Assignment Issues

- Obtain executed assignments promptly – inventors change jobs and can be difficult to find later or, or may not cooperate

- Assign provisionals before conversion to PCT applications
  - Important for foreign patent applications (e.g. European applications) to benefit from the priority

Correction of Assignments

- Watch out for typos on the assignment
  - Misspelled assignor/assignee
  - Wrong company name
    - ABC, Inc. vs. ABC Inc. vs. ABC LLC
  - Wrong patent number or patent application serial number on assignment form
- If there is a mistake you have to correct it, see MPEP section 323
  - Signatories initial/date the correction and then re-record the assignment as a corrective assignment
- Make sure chain of title is clean

Example of Corrective Assignment

Attorney Docket No.: 46747-704.301

ASSIGNMENT OF PATENT APPLICATION

JOINT

WHEREAS, Luis Fernando Romo, of 79 Madison Avenue, 2nd Floor, New York, NY, 10016; Arto Cinoglu, of 1568 Ocean Avenue, Unit 8, Bohemia, NY, 11716; and David Moses, of 1568 Ocean Avenue, Unit 8, Bohemia, NY, 11716; hereinafter referred to as "Assignors," are the inventors of the invention described and set forth in the below-identified application for United States Letters Patent:

Title of Invention: STERILIZATION UNITS, SYSTEMS, AND METHODS

Date(s) of execution of Declaration:

Filing Date: June 19, 2015

Application No.: 14/744,461; and

AC D.M.

PurpleSun Inc.

WHEREAS, ~~PurpleSun, Inc.~~, whose business address is 79 Madison Avenue, 2nd Floor, New York, NY, 10016, hereinafter referred to as "ASSIGNEE," is desirous of acquiring an interest in the invention and application and in any U.S. Letters Patent and Registrations which may be granted on the same;

For good and valuable consideration, receipt of which is hereby acknowledged by Assignors, Assignors have assigned, and by these presents do assign to Assignee all right, title and interest in and to the invention and application and to all foreign counterparts (including patent, utility model and industrial designs), and in and to any Letters Patent and Registrations which may hereafter be granted on the same in the United States and all countries throughout the world, and to claim the priority from the application as provided by the Paris Convention. The right, title and interest is to be held and enjoyed by Assignee and Assignee's successors and assigns as fully and exclusively as it would have been held and enjoyed by Assignors had this Assignment not been made, for the full term of any Letters Patent and Registrations which may be granted thereon, or of any division, renewal, continuation in whole or in part, substitution, conversion, reissue, prolongation or extension thereof.

Assignors further agree that they will, without charge to Assignor, but at Assignee's expense, (a) cooperate with Assignee in the prosecution of U.S. Patent applications and foreign counterparts on the invention and any improvements, (b) execute, verify, acknowledge and deliver all such further papers, including patent applications and instruments of transfer, and (c) perform such other acts as Assignee lawfully may request to obtain or maintain Letters Patent and Registrations for the invention and improvements in any and all countries, and to vest title thereto in Assignee, or Assignee's successors and assigns.

IN TESTIMONY WHEREOF, Assignors have signed their names on the dates indicated.

Dated: 9/21/15

Luis Fernando Romo

Dated: 9/17/15

Arto Cinoglu

Dated: 9/17/15

David Moses

Assignment – Backup Plan

- Generally a good idea for a company to have employment agreements and consulting agreements with all employees/consultants
  - Include an invention assignment clause

- In case you cannot get the assignment executed you can record the employment/consulting agreement as proof of assignment

Assignment vs. Licensing

- Assignment = ownership
- Licensing = rights to use, no ownership
- Similar to renting/leasing a car vs. buying a car, or renting an apartment/buying a house



Assignment vs. Licensing

- In an assignment you can slice up the invention and assign any or all of the invention in many different ways
- Similarly, in a license you can also limit the license to a field of use, a geographical territory, a time limit, etc.
- Like slicing a pie into big pieces and little pieces



Handy Tools



- Use your internal document/docketing system (e.g. FIP)
- PTO website to check inventorship and assignments

Thank you for your interest.

Questions?



slwip.com

Thank you

These materials are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.