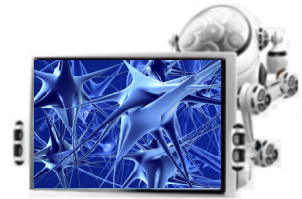


The Villamar Firm PLLC

Attorneys at Law



• 3424 Washington Drive • Falls Church VA 22041 • Phone: 703-623-4122 • Fax: 703-852-3507 •



Don't let your patent sink with the inventorship!

Carlos R. Villamar¹

Determining and claiming proper inventorship in a patent application is an important consideration that must not be overlooked. Oftentimes, persons such as the CEO of a company or a project manager are named as inventors in a patent application, even though they did not actually contribute to the invention. Improperly naming an inventor can lead to problems down the line, including patent invalidity.

“Determining and claiming proper inventorship in a patent application is an important consideration that must not be overlooked”

So, is there a test to determine proper inventorship? A simple example may be helpful here. Assume that an inventor is an avid golfer and invents a golf club with a new and novel golf club head design. The inventor takes the specification for making his golf club to a machinist, who based on the specification makes a prototype golf club for the inventor. The machinist is not a co-inventor. Similarly, a software programmer who merely generates software based on an inventor's specification is not a co-inventor.

“a software programmer who merely generates software based on an inventor's specification is not a co-inventor”

Now, let's assume that the machinist in the first example is also an avid golfer and suggests adding additional new and novel features to the golf club head

that provide for improved ball flight. In such a situation, the machinist's contribution is not insignificant when measured against the invention as a whole. Furthermore, the inventor includes and claims (i.e., defines the scope of protection being sought) the new and novel features in his patent application. Guess what? Now the machinist is a co-inventor. The same applies to the second example provided above: The software programmer becomes a co-inventor, if he suggests new and novel features for the software program which are disclosed and claimed in the resulting patent application.

“The software programmer becomes a co-inventor, if he suggests new and novel features for the software program which are disclosed and claimed in the resulting patent application”

In addition, inventorship is determined based on the claims of a patent application. Accordingly, if claims are cancelled or added, the inventorship may have to be revised to reflect the pending claims. However, patents typically do not get processed until several years after their filing, making inventorship determination difficult after the fact. In this respect, keeping a lab notebook detailing the contributions made by each inventor during the invention development may be helpful for determining proper inventorship down the road.

“keeping a lab notebook detailing the contributions made by each inventor during the invention development may be helpful for determining proper inventorship down the road”

Accordingly, taking steps to ensure proper naming of inventors will help your patent from going down with the inventorship. Finally, it is important to find a patent attorney who takes the time to understand your technology, business model, and work processes to ensure that an IP strategy is executed in a focused and efficient manner.

“it is important to find a patent attorney who takes the time to understand your technology, business model, and work processes to ensure that an IP strategy is executed in a focused and efficient manner”

¹ This article is provided by the author with the understanding that it does not constitute the rendering of legal advice or other professional advice by The Villamar Firm PLLC or its attorneys. © 2010 The Villamar Firm PLLC. All rights reserved.