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CLIENT INFORMATION SHEET

JOINT INVENTORSHIP

For a valid patent to issue, the U.S. Patent Laws require that the patent application be filed in the name of the true inventors. When inventions are developed in an engineering and manufacturing environment where many people are party to given projects, the problem of determining true inventorship can arise.

Therefore, in order that parties can make an initial determination as to whether or not they are joint inventors, the following guidelines have been developed. However, since, as one judge has said, "The exact parameters of what constitutes joint inventorship are sometimes quite difficult to define", final resolution of any questions or disputes concerning inventorship will continue to be made by the cognizant attorney.

Two or more persons jointly working, cooperating or collaborating in devising and putting into practical form the subject matter of an invention are considered joint inventors. The conception may be primarily due to one, but if the other makes suggestions of practical value which assist in working out the main idea (i.e. in making it operative, or contributes an independent part of the entire invention which helps to create the whole) he is a joint inventor even though his contribution be of relatively minor importance or had occurred at a time different from that of the conception. A joint inventor must play some role in the final conception to the extent that he is able to say that without his contribution to the final conception the invention would not accomplish its intended result.

On the other hand, those who act under the instructions of the inventor and are merely acting as mechanics and technicians and who use only their mechanical and technical skills to construct and put the invention into successful operation are not considered joint inventors but are only agents of the inventor.

Therefore, when considering the problem of joint inventorship one must:
a)   determine what the invention consists of, namely the elements or steps that are necessary so that the invention can accomplish its objects, or, in the case of an aesthetic design invention, the elements which create the invention's aesthetic appearance; and

b)   define who has contributed some creative thought, above and beyond the skill of an efficient technician, such thought having contributed to the invention by helping create the final invention.

Joint inventors who are not otherwise under a contractual obligation to the other inventors, or a business entity sponsoring the design effort, should be parties to a joint inventorship agreement, employment agreement of other such agreement that puts them under a duty to assign their rights to their employer, or at least defines their obligations with respect to ownership of the intellectual property.

Paul B. Heynssens is the Managing Member and registered patent attorney with a substantial background in electrical engineering. He counsels clients in a variety of intellectual property and technology matters including patent prosecution and portfolio management, preparation of patent validity and infringement opinions, and preparation of licensing agreements, non-disclosure agreements and other intellectual property agreements. Mr. Heynssens has prepared and prosecuted many patent applications in the area of electronics, software, semiconductors, lasers and computers, among others.

Paul B. Heynssens Attorney at Law, PLC prepares Client Information Sheets to provide information about legal developments that may affect or be of interest to our clients. The information and opinions contained in this Client Information Sheet do not constitute legal advice.