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The Doctrine of Inventorship: Its Ramifications in Patent Law

THE ORIGINAL AUTHORITY for patent law and inventorship in the United States is found in article I of the Constitution which states that: "The Congress shall have Power . . . 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."¹ Under this basic authority, Congress has enacted a number of statutes on patent law, the most recent of which is the Patent Act of 1952.² Like its predecessors,³ this act requires that an application for a patent "shall be made by the inventor."⁴ The doctrine of inventorship has evolved from this and other related provisions of the act.

The traditional inventors were usually individuals like Thomas Edison, who alone had 1039 patents issued to him.⁵ Today, the modern corporation with its vast research facilities has caused substantive changes in inventorship entities. It is estimated that more than half of the living inventors are employed as researchers in the corporation.⁶ Furthermore, because of the "research team" approach employed by corporations, an increasing number of new inventions are developed not through the work of individuals, but rather through team efforts.⁷ A vivid example of this type of joint inventorship is a recent patent on a computer which issued to a research team of twenty-one inventors.⁸

It is not difficult to imagine the present and potential problems with respect to the doctrine of inventorship. The requirement that the true inventor must apply for the patent has at times destroyed an

¹ U. S. CONST. art. I, § 8.

² 35 U.S.C. §§ 1-293 (1964).

³ See, e.g., 38 Stat. 958 (1915); 46 Stat. 376 (1930).

⁴ 35 U.S.C. § 111 (1964). See Patent Office Rules of Practice, 37 C.F.R. § 1.41 (Supp. 1966) [hereinafter cited as Rules].

⁵ Calvert, *Inventors' Psychology*, in THE ENCYCLOPEDIA OF PATENT PRACTICE AND INVENTION MANAGEMENT 492 (Calvert ed. 1964).

⁶ Sanders, *How Many Patentees*, 47 J. PAT. OFF. SOC'Y 501, 504 (1965).

⁷ Siegel, *On Individual and Joint Patent Production*, 6 PATENT, TRADEMARK, & COPYRIGHT J. RESEARCH & EDUCATION 241 (1962) [hereinafter cited by its new name: IDEA].

⁸ See United States Letters Patent 3,112,394 assigned to the National Cash Register Company, Dayton, Ohio.

otherwise valid patent.⁹ The problem is especially acute in the corporate field where the true inventor or inventors are not always easily determined when the invention develops out of a team effort. Difficult questions arise as to whether the inventor is the supervisor, a research member, or the whole research team. Therefore, the purpose of this Note is to examine the scope of the current inventorship laws and to discuss their effect and ramifications on other areas of the law.

I. MEANING OF INVENTORSHIP

In attempting to arrive at an adequate meaning of inventorship, it is first mandatory to define an "invention." Many complete texts, articles, and judicial opinions have struggled with this problem.¹⁰ One of the more recent and more practical articles on this topic was written by Judge Rich of the United States Court of Customs and Patent Appeals,¹¹ who interpreted sections 101 through 103 of the Patent Act,¹² and concluded that an invention must be *new, useful,*

⁹ See text accompanying notes 86-97 *infra*.

¹⁰ See, e.g., TOULMIN, *INVENTION AND THE LAW* (1936); Ballard, *What is Invention*, 39 J. PAT. OFF. SOC'Y 319 (1957); Buckles, *Rules for Determining What Is Invention*, 26 FORDHAM L. REV. 302 (1957). For a comprehensive listing of cases which have dealt with the question of invention see 2 WALKER, *PATENTS* §§ 126-27 (2d ed. Deller 1964).

¹¹ Rich, *The Vague Concept of "Invention" as Replaced by Sec. 103 of the 1952 Patent Act*, 46 J. PAT. OFF. SOC'Y 855 (1964).

¹² 35 U.S.C. § 101 (1964) is entitled "Inventions patentable" and reads: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." 35 U.S.C. § 102 (1964) is entitled "Conditions for patentability; novelty, and loss of right to patent" and reads as follows:

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented,

or

(g) before the applicant's invention thereof the invention was made in

and *unobvious*.¹³ But even if these requirements are met, a patentable invention might not exist because of a statutory bar.¹⁴ Section 102 contains various bars to patentability which, together with section 103, distinguish the patentable from the unpatentable invention. As Judge Rich so aptly stated:

All an invention is, however, is something which has been found out, or devised, or discovered. The question today is not what to call it but whether, under the statute, it is patentable. Hundreds of "real" or "true" inventions, all resulting from "inventive acts" and the exercise of the "inventive faculties" are held unpatentable every day for lack of novelty.¹⁵

The second element of inventorship is the inventor. In order for one to become a statutory inventor, he must be responsible for the development of something which falls within the scope of the statutory definition of an invention.¹⁶ Employing this type of circular reasoning, it seems that the "statutory inventor" must be one who discovers something new, useful, and unobvious. Upon such a discovery, the inventor who wants to become a patentee must first file, in conjunction with his patent application, an oath whereby he swears that he believes himself to be the first and true inventor, and that he knows of no other statutory bar which would affect him.¹⁷ A patent which is not supported by such an oath or is otherwise applied for by one who is not the inventor is void.¹⁸ If it should

this country by another who had not abandoned, suppressed, or concealed it

35 U.S.C. § 103 (1964) is entitled "Conditions for patentability; non-obvious subject matter" and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

¹³ Rich, *supra* note 11, at 874.

¹⁴ *Ibid.* For a recent judicial application of the obviousness doctrine see Application of Hostettler, 356 F.2d 562, 566 (C.C.P.A. 1966).

¹⁵ Rich, *supra* note 11, at 862.

¹⁶ See text accompanying notes 10-15 *supra*.

¹⁷ 35 U.S.C. § 115 (1964); Rules, 37 C.F.R. § 1.65 (Supp. 1966), which reads in part as follows:

Statement of Applicant.

(a) (1) The applicant, if the inventor, must state that he verily believes himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides and whether he is

occur that two inventors file for a patent on the same invention, priority is given to the one who first conceived the invention, provided that he has not abandoned his invention but rather proceeded with diligence to perfect it.¹⁹ Then, if there is no statutory bar, the inventor joins a special class (approximately four out of every 1000 Americans)²⁰ known as patentees.

As was previously indicated,²¹ an invention can be the product of joint inventors.²²

In order to constitute two persons joint inventors, it is not necessary that the inventive concept come to both at the same time. Some of the features may be contributed by one and other features by the other and where, as here, the separate contributions result in a patentable combination the invention is joint.²³

Furthermore, an oath which is executed by joint inventors is prima facie evidence of their joint inventorship.²⁴ Nevertheless, the concept of joint invention, being somewhat nebulous, is the subject of much attack, especially as a defense to infringement actions. The susceptibility of a joint patent to such attacks is seemingly the reason

a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented in any foreign country prior to the date of his application on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. He shall state whether or not any application for patent on the same invention has been filed in any foreign country, either by himself, or by his legal representatives or assigns

¹⁸ Kennedy v. Hazelton, 128 U.S. 667 (1888); City of Milwaukee v. Activated Sludge, Inc., 69 F.2d 577 (7th Cir.), *cert. denied*, 293 U.S. 567 (1934). See also statutory materials cited note 4 *supra*.

¹⁹ Marconi Wireless Tel. Co. of America v. United States, 320 U.S. 1, 35 (1943).

²⁰ Sanders, *supra* note 6, at 506.

²¹ See text accompanying note 8 *supra*.

²² The statutory provision for joint inventorship is found in 35 U.S.C. § 116 (1964), which is entitled "Joint inventors" and states in part as follows: "When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title."

²³ Moler v. Purdy, 131 U.S.P.Q. 276, 279 (Pat. Off. Bd. Int. 1960). For similar language see, *e.g.*, Pointer v. Six Wheel Corp., 177 F.2d 153, 157 (9th Cir. 1949); Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 72 F.2d 53, 56 (3d Cir. 1934), *rev'd on other grounds*, 294 U.S. 477 (1935); 1 ROBINSON, PATENTS § 398 (1890).

²⁴ Moler v. Purdy, *supra* note 23. Many other cases have also recognized this. See, *e.g.*, Carter v. Kellgren, 166 F.2d 592 (C.C.P.A. 1948); Brown v. Edler, 110 F.2d 858 (C.C.P.A. 1940); Beidler v. Caps, 36 F.2d 122 (C.C.P.A. 1929).

that the courts require a high degree of proof to sustain them.²⁵

The statute, however, provides for certain exceptions to the rigid requirement that the true inventor must apply for a patent. If the inventor has died or become mentally incompetent, his legal representative or guardian may apply.²⁶ Also, the statute supplies a remedy if either a joint or sole inventor refuses to apply or is missing and cannot be located after a reasonably diligent search.²⁷ While the utilization of these provisions has not been extensive, it has been urged that great effort should be made to locate missing inventors due to the relative hardship on the Patent Office in verifying applications of this nature.²⁸

II. INVENTORSHIP IN THE CORPORATION

A patent or patent application has the attributes of personal property and is thus freely assignable.²⁹ Furthermore, patents may issue to the assignee of an inventor, as long as the patent is applied for and issued in the name of the inventor.³⁰ Because of this liberal provision, corporations today own, by way of assignment, a majority of the active patents.³¹ Most major corporations and some smaller ones obtain these assignments by requiring each employee involved in research and development to sign an invention assignment contract.³² In such a case, the corporation would be the ultimate owner of the resulting patent; and this would occur regardless of the identity of the true inventor.³³ But it is not the ultimate ownership of the invention which is of primary concern with respect to obtaining a valid patent; rather, it is the identity of the inventor which is of central importance.

²⁵ *E.g.*, *Klein v. American Casting & Mfg. Corp.*, 87 F.2d 291 (2d Cir. 1937); *Holstenson v. Webcor, Inc.*, 150 F. Supp. 441 (N.D. Ill. 1957); *DeLaski & Thropp Circular Woven Tire Co. v. William R. Thropp & Sons Co.*, 218 Fed. 458 (D.N.J. 1914), *aff'd*, 226 Fed. 941 (3d Cir. 1915); *Carter v. Kellgren*, *supra* note 24.

²⁶ 35 U.S.C. § 117 (1964); Rules, 37 C.F.R. §§ 1.42-43 (Supp. 1966).

²⁷ 35 U.S.C. §§ 116, 118 (1964); Rules, 37 C.F.R. § 1.47 (Supp. 1966).

²⁸ Tomkins, *Filing Patent Application by Other Than the Inventor*, 40 J. PAT. OFF. SOC'Y 668 (1958).

²⁹ 35 U.S.C. § 261 (1964); ELLIS, *PATENT ASSIGNMENTS* § 1 (3d ed. 1955).

³⁰ 35 U.S.C. § 152 (1964).

³¹ See Federico, *Distribution of Patents Issued to Corporations (1939-55)*, 39 J. PAT. OFF. SOC'Y 405 (1957).

³² Student Paper, 7 IDEA 380 (1963).

³³ It should be pointed out that the assignor-employee is always entitled to have his name appear on the patent as the inventor. This is all-important to him.

First and foremost, don't ever lose sight of the fact that a United States patent is issued in the inventor's name, and although he assigns the rights to his company, his name will forever be attached to that patent. This is his indis-

The problems which might arise with respect to corporate inventorship can be best demonstrated by first posing a hypothetical fact situation, then looking at the applicable case law, and finally applying that law to the original hypothetical situation.³⁴ In a hypothetical corporation, assume that a chief engineer (*A*) calls into his office a supervisor (*B*) who is the overseer of a team of researchers (*C*, *D*, and *E*). During their conference *A* tells *B* to attempt to develop a certain improvement on a machine and suggests a general method or approach. *B* delegates this duty to his team, relating *A*'s suggestions and adding a few of his own. While *C* does most of the work on this project, he is in constant contact with *B*. *B*, in turn, keeps *A* well informed, and both *A* and *B* offer some other suggestions to the team. During many months of research, *D* and *E* have both aided *C* in small but important aspects of the project. Finally, the research culminates in a patentable invention. The question for

putable claim to being an accomplished inventor, and *no one* — no company — can take this away from him. The more patents that bear his name, regardless of what he did with the rights to them, the greater is his standing in the technological community. Issued patents are tangible evidence of his worth as an inventor, and they are perfectly salable in his quest for a job wherever he goes. They will have an effect on his salary. Barnes, *The Patent System From an Inventor's Point Of View*, 5 IDEA 64, 68 (1961).

In fact, a recent New Jersey case, *Misani v. Ortho Pharmaceutical Corp.*, 83 N.J. Super. 1, 198 A.2d 791 (1964), has held "that a wrongful deprivation of that credit [her name on the patent] by publishing the formula and process in a patent as the invention of another would constitute an *actionable tort*." *Id.* at 14, 198 A.2d at 797. (Emphasis added.) From the result of this decision, it would appear that the employer who does not apply for a patent in the name of the true inventor stands to lose in two respects. First, the patent can be invalidated (See text accompanying notes 86-97 *infra*) and second, damages may be assessed for the denial of intellectual credit to the inventor.

However, in the absence of the typical assignment agreement, it can generally be said that the invention belongs to the inventing employee. The employer is only entitled to a non-transferable "shop right," that is, an irrevocable royalty-free license to use the item. *Marshall v. Colgate-Palmolive-Peet Co.*, 76 F. Supp. 378 (D. Del. 1948), *aff'd*, 175 F.2d 215 (3d Cir. 1949). For a general discussion of the doctrine of shop rights see COSTA, LAW OF INVENTING IN EMPLOYMENT 9-37 (1953); Student Paper, 7 IDEA 380 (1963). This general rule is subject to the exception that if the employee was hired for the specific purpose, *i.e.*, to invent, then there is an implied assignment to the employer. *Solomons v. United States*, 137 U.S. 342 (1890). There the employer was the government. Two other key cases which demonstrate that the government is subject to much the same rules as any other employer are *United States v. Dubilier Condenser Corp.*, 289 U.S. 178 (1933), and *Houghton v. United States*, 23 F.2d 386 (4th Cir.), *cert. denied*, 277 U.S. 592 (1928). For a general discussion of these cases see Finnegan & Pogue, *Federal Employee Invention Rights — Time to Legislate*, 40 J. PAT. OFF. SOC'Y 252 (1958).

³⁴ This problem is not intended to be exclusive of other problems which could arise with respect to inventorship entities within the corporation. Rather, this factual situation is used only as a basis for the substantive material which follows. An example of an ancillary problem is the all too frequent situation where the smaller corporation merely applies for the patent in the name of its president no matter who the inventor. This poor policy is probably due to possible assignment conflicts within the corporation. Nothing but trouble can stem from this corporate practice.

purposes of obtaining a patent is who is the "true inventor"? Is it A; B; B and C; C, D and E; or all five?

Any analysis involving the employer-inventing employee relationship should include the basic case of *Agawam Co. v. Jordan*.³⁵ There, the following principle was set forth:

[W]here a person has discovered an improved principle . . . and employs other persons to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent as a part of his invention. . . . Persons employed, as much as employers, are entitled to their own independent inventions, but where the employer has conceived the plan of an invention and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement which, in itself is a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement.³⁶

The Supreme Court, relying on *Agawam*, may have extended this general rule in the case of *Minerals Separation, Ltd. v. Hyde*.³⁷ There, even though an assisting employee observed a desired result from his experimentation and recognized its inventive advantages, the court held that the resulting invention was the employers'. The employee was nothing more than a mechanical puppet under the direction of the employers who themselves were the stimulus for the invention.³⁸

Seemingly at variance with these cases, however, is a 1959 district court decision,³⁹ where the court implied, under a factual situation which parallels the *Agawam* case, that a joint inventorship entity would have been acceptable.⁴⁰ In this case, the assistant was helping the supervisor in the construction of a certain apparatus. After more than a year's work, the project was completed. Subsequently and without any warning, the assistant procured a patent on the invention. In holding the patent invalid, the court said that at best the patent should have issued to both the supervisor and assist-

³⁵ 74 U.S. (7 Wall.) 583 (1868).

³⁶ *Id.* at 602-03. For a critical discussion of this case see Prager, *Agawam v. Jordan*, *Annotated*, 22 J. PAT. OFF. SOC'Y 737 (1940).

³⁷ 242 U.S. 261 (1916).

³⁸ *Id.* at 270.

³⁹ *Stearns-Roger Mfg. Co. v. Ruth*, 179 F. Supp. 906 (D. Colo. 1959).

⁴⁰ *Id.* at 911.

ant as joint inventors.⁴¹ This statement, if nothing more, is a relaxation of the *Agawam* rule.

If the employer merely suggests a desired result to the employee and the employee's labor culminates in a patentable invention, the Second Circuit Court of Appeals has said that the employee is the inventor.⁴² In that case the employee was instructed to build a certain machine which would perform like a present model, only he was to do it without wires. Holding that this was merely asking for a result, similar to asking the Wright brothers to build something that would fly, the court held that the "employer who seeks to patent the fruits of his employees' labors must go further than merely to express a purpose to be realized."⁴³ The court then attempted to define a point at which the employer would disclose enough of his own ingenuity to claim the invention for himself. It indicated that this point would be reached when a reasonable degree of inventive certitude is disclosed so that one skilled in the art is enabled to practice the invention.⁴⁴ Thus, more than a *purpose, result, or means* is needed.

In the case of *Fersing v. Fast*,⁴⁵ the Court of Customs and Patent Appeals held that unless the employer suggests the *broad idea* that results in the invention, his status as an employer does not entitle him to be considered the inventor. It is hard to determine the legal distinction between the purpose, result, or means criterion used by the Second Circuit, and the broad idea concept of the Court of Customs and Patent Appeals. Surely the broad idea must be more than a mere purpose, result, or means, but where the line is drawn is not clear. Possibly one answer lies in the significance the *Fersing* court placed on the fact that the employee's inventive background demonstrated that he was more likely to be the inventor.⁴⁶ Although other courts have also used this criterion,⁴⁷ it is questionable whether this is consistent with the purpose of the patent statutes.⁴⁸

⁴¹ *Ibid.*

⁴² *International Carrier-Call & Television Corp. v. Radio Corp. of America*, 142 F.2d 493 (2d Cir. 1944).

⁴³ *Id.* at 496.

⁴⁴ *Ibid.*

⁴⁵ 121 F.2d 531 (C.C.P.A. 1941).

⁴⁶ *Id.* at 537.

⁴⁷ See generally *Larson v. Crowther*, 1 F.2d 761 (D.C. Cir. 1924), *cert. denied*, 267 U.S. 593 (1925), where an invention was more logically conceived by a trained bacteriologist than a mechanic.

⁴⁸ 35 U.S.C. § 111 (1964) requires that the patent be applied for by *the inventor*. The obvious purpose is to protect the inventor and to recognize credit due and owing him. Should the courts be allowed to decide cases on such weak points as education or ex-

The one factor upon which the courts will all agree is that the burden of proof of first and sole inventorship will always lie with the employee.⁴⁹ This conclusion is self-evident when one considers the master-servant basis upon which it lies.

The difficulty in applying these cases to the hypothetical factual situation posed above is apparent. Adopting the *Agawam* reasoning,⁵⁰ the inventorship would depend on the scope of *A*'s and *B*'s ideas and suggestions. If the bulk of the inventive work rested with the research team, then *C* would be the inventor, with the possibility of co-inventorship with *D* and *E*. Although the facts in the hypothetical situation are insufficient to make a definite determination, it would appear that *A* merely suggested a purpose or a result to be carried out.⁵¹ Since the purpose or result would probably not fall into the broad idea classification set out by the *Fersing* court,⁵² it seems that *A* could not be considered a co-inventor. In light of the definition of joint inventorship,⁵³ *B* and *C* may well be the true inventors in this case. However, if *D*'s and *E*'s suggestions played a major role in the inventive concept, they too should be included. Also if *B*'s ideas added nothing or if *C* were a mere mechanical puppet, then one or both of these men would be disqualified. Each case must be decided on its own particular facts:

The real question is whether or not the improvements suggested by the workman were of such a serious and important character as to preclude their adoption by the inventor as part of his invention. It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them, and taken out by his employer. *Each case must depend on its own merits.* But, when it is seen that the principal and object of an invention are complete without the suggestion, it is too much that the workman's suggestion should render the whole patent void even though the suggestion was of something calculated more easily to carry into effect the concept of the inventor.⁵⁴

perience in the field? While this is not often the sole basis of the decisions, the fact that it is even considered is not consistent with the absolute manner which § 111 has been interpreted.

⁴⁹ *E.g.*, *Larson v. Crowther*, 1 F.2d 761 (D.C. Cir. 1924), *cert. denied*, 267 U.S. 593 (1925), where the employee had the burden of proof even though he was the senior party in an interference proceeding; *Riehm v. Hambleton*, 53 F. Supp. 328 (D. Mass. 1943).

⁵⁰ *Agawam Co. v. Jordan*, 74 U.S. (7 Wall.) 583 (1868).

⁵¹ See text accompanying note 42 *supra*.

⁵² See notes 45-46 *supra* and accompanying text.

⁵³ See text accompanying note 23 *supra*.

⁵⁴ 1 WALKER, *op. cit. supra* note 10, § 44, at 190-91. (Emphasis added.)

Although statistics show that a majority of the patents are issued to sole inventors,⁵⁵ at least one authority has suggested that corporations ought to employ the joint inventorship doctrine more frequently in cases of doubt.⁵⁶ This would not only protect the employer but would also enhance the position of the employee who was the "doubtful" inventor. The only employee who could possibly be hurt by this method of inventorship selection would be the employee who actually was a sole inventor.⁵⁷ The employer would rarely be hurt because of the liberal rules for correcting erroneous inventorship entities.⁵⁸

It is very possible that this "more-the-safer" attitude toward inventorship is the trend in many corporations today. Whether this is consistent with the statutory requirement that the true inventor must apply has not been decided.⁵⁹ Nevertheless, this trend has and will cause some difficulty where the wrong inventorship entity is placed on an application or patent.

III. CONVERSION OF INVENTORSHIPS AND PRIORITY PROBLEMS

The problem of the identity of the true inventor is often a confusing one. In fact, it is so confusing that many times a true inventor is omitted from the application or a non-inventor is inadvertently added. As was previously mentioned, this could easily arise within the corporation. Prior to the Patent Act of 1952⁶⁰ there was no statutory authority for changing inventorship entities. Now, however, sections 116 and 256 of the act,⁶¹ respectively, allow for the

⁵⁵ See Siegel, *On Individual and Joint Patent Production*, 6 IDEA 241 (1962).

⁵⁶ COSTA, *op. cit. supra* note 33, at 67.

⁵⁷ *Id.* at 68.

⁵⁸ See text accompanying notes 60-85 *infra*.

⁵⁹ It is submitted here, as similarly in note 48 *supra*, that the "more-the-safer" approach is not in keeping with the purpose of § 111. Certainly the drafters of the statute did not expect an application to bear five names simply for the purpose of making sure that *the inventor* was somewhere included, that is, possibly one of the five. The statute would require, however, that all five applicants be joint inventors.

⁶⁰ 35 U.S.C. §§ 1-293 (1964).

⁶¹ 35 U.S.C. § 116 (1964), which states in part as follows:

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

35 U.S.C. § 256 (1964), entitled "Misjoinder of Inventor" reads as follows:

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and

correction of misjoinder or nonjoinder while the application is pending and after it issues. The misjoinder or nonjoinder, however, must have arisen "through error" and "without any deceptive intention." The only real risk in changing inventorship is that of losing the earlier filing date established by the original application. Section 120⁶² stipulates that in order to secure the original filing date, the two applications must be "by the same inventor." Therefore in the typical case, the courts are confronted with the two-fold question of what is "error without any deceptive intention" and who is the "same inventor"?

A. Error Without Any Deceptive Intention

In order to adequately understand the basis of the post-1952 decisions, it is necessary to look at the judicial background of the statute. Prior to the Patent Act, the courts had determined that inventorship corrections could be made by way of amendment or by filing a continuation⁶³ or a continuation-in-part⁶⁴ application. In the case of *In re Roberts*,⁶⁵ the applicants originally applied as joint

assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section.

See also Rules, 37 C.F.R. § 1.45 (Supp. 1966).

⁶² 35 U.S.C. § 120 (1964), entitled "Benefit of earlier filing date in the United States" reads:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

⁶³ *In re Roberts*, 263 Fed. 646 (D.C. Cir. 1920). "A continuation is a second application for the same invention claimed in a proper application and filed before the original becomes abandoned." U.S. MANUAL OF PATENT EXAMINING PROCEDURE § 201.07 (7th rev. 1966).

⁶⁴ Application of Strain, 187 F.2d 737 (C.C.P.A. 1951); *In re Perrin*, 142 F.2d 277 (C.C.P.A. 1944). "A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application and adding matter not disclosed in the said earlier case." U.S. MANUAL OF PATENT EXAMINING PROCEDURE § 201.08 (7th rev. 1966).

⁶⁵ 263 Fed. 646 (D.C. Cir. 1920).

inventors. During the pendency of their application, one of the applicants admitted that he had no part in the invention. With adequate proof that this was mere inadvertence without fraudulent intent, the court allowed the true inventor to file a continuation application in which he received the benefit of the filing date of the previous joint invention.⁶⁶ But in *Ex parte Benes*,⁶⁷ the Commissioner would not allow the reverse to apply. That is, the *Benes* case held that the sole applicant could not amend his application to include another co-inventor.⁶⁸ Sections 116 and 256 of the 1952 act⁶⁹ have in effect codified the *Roberts* decision, but have changed the result of *Benes*. As previously noted, however, the enactment of these sections has caused a semantic problem for the courts.⁷⁰

In *John Blue Co. v. Dempster Mill Mfg. Co.*,⁷¹ a case interpreting the new sections 116 and 256, attorneys for the plaintiff had prepared an application in the names of the two joint inventors. The general manager of the company, however, removed one of the names from the patent application, and filed it as a sole invention. Relying on the interpretation of similar language in another section of the statute,⁷² the court held that "error" and "bona fide mistake" are synonymous. The deliberate act of striking one of the names of an inventorship entity was not "error" in this light.⁷³

The Court of Customs and Patent Appeals was confronted with a similar problem in *Application of Schmidt*.⁷⁴ In that case the inventor first filed a sole application. He later abandoned this application after reapplying for the same subject matter with five co-inventors. Finally he applied a third time, again as a sole inventor,

⁶⁶ *Id.* at 648-49.

⁶⁷ 1925 Dec. Com. Pat. 75.

⁶⁸ *Id.* at 76.

⁶⁹ See statutes quoted note 61 *supra*.

⁷⁰ The courts are now faced with the statutory interpretation of the wording "error without any deceptive intention" and "the same inventor" as found in sections 116, 120, and 256.

⁷¹ 172 F. Supp. 23 (D. Neb. 1958), *aff'd*, 275 F.2d 668 (8th Cir. 1960).

⁷² 35 U.S.C. § 251 (1964) allows for the reissue of a patent using the same wording: "error without any deceptive intention." In *John Blue*, the court could not find any prior interpretations of section 256 so it relied on past interpretations of section 251 which has the above similar language. One case relied on was *Riley v. Broadway-Hale Stores*, 114 F. Supp. 884 (S.D. Cal. 1953), *aff'd*, 217 F.2d 530 (9th Cir. 1954), where a deliberate move on the part of counsel was held not to be error under section 251. A later case, *Ex parte Johnson*, 117 U.S.P.Q. 412 (Pat. Off. Bd. App. 1956), has held that section 251 will not allow a patent to reissue for misjoinder of invention.

⁷³ *John Blue Co. v. Dempster Mill Mfg. Co.*, 172 F. Supp. 23, 30-31 (D. Neb. 1958), *aff'd*, 275 F.2d 668 (8th Cir. 1960).

⁷⁴ 293 F.2d 274 (C.C.P.A. 1961).

the joint application being cancelled. Appellant, the inventor, was seeking to retain the filing date of his first application alleging inadvertence and mistake with respect to the filing of the intermediate joint application. The court held that the "error" which occurred in filing the joint application was of the type for which section 116 had been constructed:

It is, we believe, the correct interpretation of congressional intent that the expression "error . . . without any deceptive intention" in section 116 was intended not only to replace the more cumbersome expression "inadvertence, accident or mistake" previously used [in cases like *In re Roberts*⁷⁵] but was intended to relieve applicants from the narrow application of the old terms as the courts had construed them.⁷⁶

B. *The Same Inventor*

Still another contention of the appellant in the *Schmidt* case was that all three applications were, in effect, filed by the "same inventor." The court thus found it mandatory to interpret that term as used in section 120:⁷⁷

It ["same inventor"] must be construed with all other relevant sections of the statute, including sections 116 and 256 and thus it embraces the possibility permitted by sections 116 and 256 that the earlier application may be corrected thereunder by changes in the name or names of the applicants under the conditions stated in section 116.

We hold therefore that appellant was entitled under section 116 to correct the errors in the intermediate application filed in the names of joint inventors and under section 120 was entitled as "the same inventor" to the benefits of the filing dates of the earlier co-pending applications.⁷⁸

Another case which attempts to interpret the concept of "same inventor" is *Ex parte Kugler*.⁷⁹ There, co-inventors, *A*, *B*, and *C*, had filed a joint application. They decided to divide their application under section 121⁸⁰ into three individual inventions. *A* now wanted to use the filing date of the original joint application, alleg-

⁷⁵ 263 Fed. 646 (D.C. Cir. 1920).

⁷⁶ Application of Schmidt, 293 F.2d 274, 279 (C.C.P.A. 1961). *Schmidt* is cited favorably in *Paterson v. Hauck*, 341 F.2d 131, 138 (C.C.P.A. 1965).

⁷⁷ Application of Schmidt, *supra* note 76. See statute quoted note 62 *supra*.

⁷⁸ Application of Schmidt, 293 F.2d 274, 279 (C.C.P.A. 1961).

⁷⁹ 143 U.S.P.Q. 70 (Pat. Off. Bd. App. 1963).

⁸⁰ 35 U.S.C. § 121 (1964) sets out the procedure to be followed in divisional applications. In the U.S. MANUAL OF PATENT EXAMINING PROCEDURE § 201.06 (7th rev. 1966), a divisional application is defined as "a later application for a distant or independent invention, carved out of a pending application and disclosing and claiming nothing not disclosed in the earlier or parent application"

ing that he was "the same inventor" as *one* of the inventors who filed the original application. The court accepted this argument even though *A* would have been able to employ an alternative procedure for securing the earlier filing date.⁸¹

Despite the logic employed in the *Schmidt* and *Kugler* line of decisions, which holds that *A* is in effect the "same inventor" as *A* and *B* in cases of error, many courts have labeled these inventorships as *different entities*. In *Ex parte Siebring*,⁸² for example, the board of appeals said that sole and joint applicants are separate and distinct entities. In this case *A*, while applying for a patent, was sued by *B* for patent infringement on the same subject matter. *A*'s application had been rejected with *B* as the sole reference. In the process of settling the suit, *A* admitted that *B* was the sole and true inventor. After this admission but prior to the court decree which enjoined *A* from prosecuting his application, *A* changed his inventorship to that of *A* and a third party, *C*. *A* and *C* then were able to swear behind the reference of *B* by way of a Rule 131 affidavit⁸³ and overcome *B*'s priority. The court said that the injunction against *A* did not apply to *A* and *C* because the two entities were not the same.⁸⁴ While this holding would seem at first to be inconsistent with the *Schmidt* case, the two may be reconcilable. *Siebring* can be interpreted as merely upholding the equitable principle of the injunction, because an injunction against *A* alone would never bind *A* and others. The decree in this case was against *A* alone and did not include *C*. Thus *A* and *C*, joined as an entity, were not bound

⁸¹ *Ex parte Kugler*, 143 U.S.P.Q. 70, 71-72 (Pat. Off. Bd. App. 1963). The alternative procedure which could have been followed "would have been to file subsequent to the filing of the original application, and during the pendency thereof, three sole applications, each restricted to the subject matter as in the three applications . . . considered herein." *Id.* at 72. For another case which holds that *A* is entitled to the previous filing date of *A* and *B* see *Johnson & Johnson v. C. B. Stenvall, Inc.*, 193 F. Supp. 128 (S.D.N.Y. 1961). The question arises as to the consistency of this rule with another rule which says that the joint invention of two inventors is a good anticipation to the later invention of either individually. See, *e.g.*, *Dwight & Lloyd Sintering Co. v. Greenwalt*, 27 F.2d 823 (2d Cir. 1928).

The courts have developed still other requirements which must be met if a converted inventorship entity is to receive benefit of a previous filing date. If the entity of *A* and *B* were to be converted to *A* alone, it is mandatory that *B* disclaims his connection with the invention. *Merry Mfg. Co. v. Burns Tool Co.*, 335 F.2d 239 (5th Cir. 1964). Another case, *Van Otteren v. Hafner*, 278 F.2d 738 (C.C.P.A. 1960), has carried over the concept of diligence to the area of conversion of inventorships, holding that correction would be denied to an applicant who did not use diligence in making the correction.

⁸² 138 U.S.P.Q. 82 (Pat. Off. Bd. App. 1961).

⁸³ Rules, 37 C.F.R. § 1.131 (1960). This rule allows an inventor to file an affidavit of prior invention to overcome a cited patent or publication against him.

⁸⁴ *Ex parte Siebring*, 138 U.S.P.Q. 82, 83 (Pat. Off. Bd. App. 1961).

by it. If this case stands for any miscarriage of justice in the area of inventorship law, it would stem from the fact that *A* admitted that *B* was the true inventor and then later swore that he and *C* were the true inventors.

In summation it must be reemphasized that the conversion sections are quite liberal when innocent error is involved and there is no evidence of bad faith. While the judicial decisions in this area may not always be as liberal, it is evident that the courts will readily allow conversions from sole to joint or joint to sole inventorship entities. It should be recognized, however, that the statute is silent as to the possible conversion from sole to sole. If the statute is indeed designed to assure that the true inventor applies, what material justification is there for not permitting the sole to sole conversion in a case of innocent error? One patent authority has suggested that this silence indicates that conversion from sole to sole cannot be accomplished in either one or two steps.⁸⁵ The only logical justification of this interpretation is that the elementary factor — that the true inventor has not signed the application — has not been met. At least if *A* and *B* initially apply as co-inventors and only one is the inventor, the correction can be made without having disturbed the fact that at least a co-inventor originally signed the application. Nevertheless, it seems that only this technicality prevents the conversion of an application of one sole applicant to that of another.

IV. RAMIFICATIONS OF INVENTORSHIP

In view of the liberal conversion statutes, it might appear at first blush that there would be no undesirable ramifications of the doctrine of inventorship. Even since 1952, however, the erroneous and uncorrectable inventorship entity has created problems in the areas of patent invalidity, patent interference practice, double patenting, and antitrust law.

A. Patent Invalidity

As has been pointed out previously, it is of vital importance to the validity of a patent that the true inventorship entity appear on the application. Before the adoption of sections 116 and 256, it was much more difficult, and sometimes impossible, to make any necessary corrections in the inventorship entity in order to save the

⁸⁵ Federico, *Commentary to the New Patent Act*, 35 U.S.C.A. 28 (1954). Mr. Federico is a member of the Board of Appeals of the Patent Office.

patent. Often the issue of invalidity was brought up as a defense to an infringement action or as an argument in an interference proceeding.⁸⁶ While attacks on the patent's validity still arise under the 1952 act, section 256 allows the patentee to make the necessary correction if he can prove error. If error cannot be proven, a subsequent attack on the patent can still invalidate it.

Thus, in a typical pre-1952 infringement action, *De Laval Separator Co. v. Vermont Farm Mach. Co.*,⁸⁷ the lower court's decision holding the patent invalid was affirmed. There, the evidence showed that the work of two inventors had been disclosed in the specifications, but that the claims of the invention covered the work of only one of them.⁸⁸ Thus, the patent which issued to joint inventors was in reality the work of a sole inventor and therefore invalid.⁸⁹ Although the court affirmed the lower court's decision, it displayed some reluctance in doing so because the argument of invalidity based on an erroneous inventorship entity is purely technical and at times can destroy a meritorious patent.⁹⁰ Yet other courts have been quick to invalidate a patent which was secured by an applicant who falsely swore that he was the first and true inventor.⁹¹

Some other pre-1952 cases questioned the validity of a patent, but found that the facts showed that the true inventor had applied.⁹² However, notwithstanding pre-1952 cases which found a valid patent despite the virtual impossibility of correction, it would seem that the only significant change between the pre-1952 inventorship cases and the more recent ones is that now there are fewer patents being invalidated. Today, before a person goes to trial with his patent to sue for infringement, he makes certain that the inventorship entity is correct. If it is not, and he can allege error, he can

⁸⁶ Lackey, *Problems in Joint Ownership of Patents*, 11 VAND. L. REV. 697 (1958).

⁸⁷ 135 Fed. 772 (2d Cir. 1904).

⁸⁸ Every patent application must contain specifications which describe the invention so that one skilled in the art could make or use the apparatus. The specifications must conclude with a claim or claims which define exactly what the applicant believes his invention to be. Rules, 37 C.F.R. §§ 1.71, 1.75 (1960). Thus much matter can be disclosed in the specifications which is not claimed as an invention in the claims.

⁸⁹ *De Laval Separator Co. v. Vermont Farm Mach. Co.*, 135 Fed. 772 (2d Cir. 1904).

⁹⁰ *Ibid.*

⁹¹ *E.g.*, *Gotz v. Universal Prods. Co.*, 107 F.2d 40 (3d Cir. 1939).

⁹² A typical case is *City of Milwaukee v. Activated Sludge, Inc.*, 69 F.2d 577 (7th Cir.), *cert. denied*, 293 U.S. 576 (1934), where the questionable patent issued to a group of scientists. At the outset the court recognized that if the true inventor was not named on the patent that it could not be valid. But after looking at the facts, the court found it unnecessary to declare the patent invalid because it had been granted to the true inventor. *Id.* at 587.

change it. Before 1952, he could not have changed any erroneous inventorships, and the patent would very likely have been declared invalid. Nevertheless, the courts *still* exercise many opportunities to invalidate patents for erroneous inventorships.⁹³

There is one further problem often encountered by the patent application draftsman who handles many joint inventions. Remembering that the claims define the invention,⁹⁴ it should also be remembered that if the inventorship is joint, then each claim must be joint — for a patent which issues to joint inventors with claims to a sole invention is void.⁹⁵ Due to the very technical nature of the proof in this area, the courts are seldom asked to deal with it. But it is inconceivable that every claim of every patent of two, three, or even up to twenty-one inventors⁹⁶ could have been the joint work of all inventors. Technically, this is required. The corporate patent attorney should consider this before he employs the "more-the-safer" doctrine which some authorities seem to sanction.⁹⁷

B. Patent Interference Practice

An interference action is a quasi-judicial proceeding which is instituted by the Patent Office in order to determine inventorship priorities.⁹⁸ In these proceedings, the burden of proof is on the junior party, that is, the party who filed second in time, to prove his alleged priority.⁹⁹ Since the proceeding determines the identity of the true and first inventor as between two applicants, it is mandatory that the applications state the correct inventorship entity. While interference involves less than one per cent of all applications,¹⁰⁰

⁹³ *E.g.*, *Merry Mfg. Co. v. Burns Tool Co.*, 335 F.2d 239 (5th Cir. 1964); *Stearns-Roger Mfg. Co. v. Ruth*, 179 F. Supp. 906 (D. Colo. 1959); 1 WALKER, PATENTS § 42 (2d ed. Deller 1964).

⁹⁴ 35 U.S.C. § 118 (1964). See also note 88 *supra*.

⁹⁵ *E.g.*, *Application of Sarett*, 327 F.2d 1005, 1010 (C.C.P.A. 1964); *Stewart v. Tenk*, 32 Fed. 665 (S.D. Ill. 1887).

⁹⁶ See note 8 *supra* and accompanying text.

⁹⁷ See text accompanying notes 56-59 *supra*.

⁹⁸ 35 U.S.C. § 135(a) (1964). For a general background in interference law see Crews & Crews, *Introduction to Interference Law and Practice*, 46 J. PAT. OFF. SOC'Y 755 (1964).

⁹⁹ *E.g.*, *Mortsell v. Laurila*, 301 F.2d 947 (C.C.P.A. 1962); *Rodin v. Spalding*, 297 F.2d 256 (C.C.P.A. 1962); *Ligh v. Stransky*, 141 U.S.P.Q. 437 (S.D.N.Y. 1964); *Bomart v. Noymer*, 141 U.S.P.Q. 252 (Pat. Off. Bd. Int. 1963); *Lafon v. Zirm*, 141 U.S.P.Q. 442 (Pat. Off. Bd. Int. 1962).

¹⁰⁰ Epperson, *Interferences*, in THE ENCYCLOPEDIA OF PATENT PRACTICE AND INVENTION MANAGEMENT 467, 468 (Calvert ed. 1964).

probably in no other area of patent practice is the inventorship entity put to a more stringent test.¹⁰¹

The recent case of *Ex parte Lyon*¹⁰² is very much on point. There, the interference arose out of the following set of facts: *A* filed for a patent in 1954. In 1957, *A* and *B* filed for improvement on *A*'s invention. *A*'s sole application was issued in July, 1958. After getting fifteen claims allowed on their joint improvement, *A* and *B* cancelled these claims, added nine new claims directed to subject matter not previously claimed, and requested conversion of the application from a joint application in *A* and *B* to a sole application in *A*. On the same day another application was filed by *A* and *B* which claimed the original fifteen allowed claims of their abandoned application. Subsequently the examiner declared the interference with *X* whose patent had issued a year before. In this action *A* wanted to secure the prior date of his first application in order to win the interference against *X*. The sole issue was whether this was a proper conversion, for if it were, *A* could claim the earlier filing date. The applicant asserted that the conversion was proper since the error was the disclosure of some subject matter which had not been invented by the two applicants. The Board held that this was *not* error of joinder of inventors as is necessary for compliance with section 116.¹⁰³ Since the original claims were correctly those of the joint inventors, there was no error at the time of filing, and there could be no error of joinder of parties.¹⁰⁴

One dissenting member of the Board was of the opinion that the statute does not restrict the "application for patent" to the application as originally filed.¹⁰⁵ This view is supported by *Application of Schmidt*¹⁰⁶ where the Court of Customs and Patent Appeals held that the inventorship conversion from sole to joint and back to sole was a proper case for the assertion of the prior filing date. It seems clear in the *Schmidt* case that there also was "no error at the time of filing." The obvious factual distinction between the two cases is that in *Schmidt* the sole inventor's claims were there from the begin-

¹⁰¹ It was decided long ago that a change in inventorship entities could be made during an interference proceeding. *Crane v. Grier*, 71 F.2d 180 (C.C.P.A. 1934). However, the converter must be diligent. *Manny v. Garlick*, 135 F.2d 757 (C.C.P.A. 1943).

¹⁰² 146 U.S.P.Q. 222 (Pat. Off. Bd. App. 1964).

¹⁰³ 35 U.S.C. § 116 (1964), quoted at note 61 *supra*.

¹⁰⁴ *Ex parte Lyon*, 146 U.S.P.Q. 222, 224 (Pat. Off. Bd. App. 1964).

¹⁰⁵ *Id.* at 224-25.

¹⁰⁶ 293 F.2d 274 (C.C.P.A. 1961).

ning while in *Lyon* they were merely added after three years of prosecution. Yet the case of *Teter v. Kearby*¹⁰⁷ indicates that it is immaterial that the subject matter in the continuation is claimed for the first time. The only requirement is that the subject matter must have been previously disclosed.

In the light of the *Lyon* decision, it is difficult to determine the state of inventorship law with respect to interference practice, at least at the Board of Appeals level. It seems quite inequitable that, because a person joins with another to co-invent an improvement in his original sole invention, he should not receive the priority that he would have received had he solely invented the improvement. Does the term "same inventor" have a different meaning for interference purposes than for conversion purposes as defined in *Schmidt*? Is the interpretation of "error" really to mean "error at the time of application"? It would seem that the statute should be as liberally applied in interference practice as it is elsewhere.¹⁰⁸

Other interference cases *have* been more liberal in their interpretation of "error" and "same inventor." In *Johnson & Johnson v. C. B. Stenwall, Inc.*,¹⁰⁹ the district court was quick to hold that a sole inventor who had filed a continuation-in-part of a joint application was entitled to the earlier filing date.¹¹⁰ In another case¹¹¹ the examiner accorded joint applicants, who had converted from a sole application, the status of a division of the sole application.¹¹² Thus, it seems that under certain fact situations the courts are following the liberal trend. This, however, only makes the *Lyon* decision more difficult to reconcile.¹¹³

Notwithstanding their present liberal trend, the courts have required a certain degree of diligence when applying for a conversion. In *Van Ottereren v. Hafner*,¹¹⁴ *A*, *B*, and *C* worked together on a project which culminated in an invention. On the same day, *A* filed a sole application and *B* and *C* filed a joint one. An interference was set up with the burden of proof being equal, no party having a priority date. During the testimony, *A* and *B* decided that together

¹⁰⁷ 169 F.2d 808 (C.C.P.A. 1948).

¹⁰⁸ See text accompanying notes 74-85 *supra*.

¹⁰⁹ 193 F. Supp. 128 (S.D.N.Y. 1961).

¹¹⁰ *Id.* at 131.

¹¹¹ *Moler v. Purdy*, 131 U.S.P.Q. 276 (Pat. Off. Bd. Int. 1960).

¹¹² *Id.* at 281-83.

¹¹³ It is possible that the Board in *Lyon* may have tacitly applied the "late claiming" doctrine discussed in *Gardner, Late Claiming*, 9 IDBA 321 (1965).

¹¹⁴ 278 F.2d 738 (C.C.P.A. 1960).

they were the true joint inventors of the invention. The court said that the liberal rules of conversion would have applied except that *A* and *B* failed to act with due diligence in applying for the conversion. It was argued, but to no avail, that the delay was justified because *A* and *B* were trying to determine whether *C* should have also been joined. But the court found it unusual that there could be joint invention without the parties knowing it.¹¹⁵

Inventorship plays too significant a role in interference proceedings to permit inconsistent or illogical rulings to jeopardize the applicant's patent rights. Unfortunately, well-reasoned cases in this area, like *Van Otteren*, are rare. Logic and the need for consistency dictate that the same inventorship rules should apply to all interference proceedings, whether they involve continuations, continuations-in-part, divisions, or mere conversions.

C. Double Patenting

Double patenting is a judicial doctrine which simply prohibits the same inventor from obtaining two patents on one invention.¹¹⁶ As the Supreme Court ruled, one invention can support only one patent.¹¹⁷ The basic reasons for prohibiting double patenting are two: (1) two patents on one invention could extend the monopoly, and (2) infringers could be exposed to a double harassment.¹¹⁸

The doctrine of inventorship is an important factor in the area of double patenting, for in order to determine if double patenting exists, the Patent Office must first determine if the inventions are by the *same inventor*. If they are not, then the institution of an interference proceeding is proper rather than a rejection for double patenting. If the inventors are the same, or if there is a common assignee of different inventors,¹¹⁹ a rejection for double patenting may be proper.

The Patent Act of 1952 has somewhat lessened the number of rejections due to double patenting. Now the common inventor is

¹¹⁵ *Id.* at 740.

¹¹⁶ See generally Palmer, *Double Patenting and Patent Soliciting*, 41 J. PAT. OFF. SOC'Y 458 (1959); Rosenberg, *Double Patenting: The Remedies of the Patent Act of 1952 and Beyond*, 45 J. PAT. OFF. SOC'Y 34 (1963).

¹¹⁷ See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894).

¹¹⁸ Palmer, *Double Patenting*, in THE ENCYCLOPEDIA OF PATENT PRACTICE AND INVENTION MANAGEMENT 209, 212 (Calvert ed. 1964).

¹¹⁹ See, e.g., *Application of Ward*, 236 F.2d 428 (C.C.P.A. 1956); *Application of Borchardt*, 197 F.2d 550 (C.C.P.A. 1952). *Contra*, *University of Ill. Foundation v. Block Drug Co.*, 133 F. Supp. 580, 588 (E.D. Ill. 1955), *aff'd*, 241 F.2d 6 (7th Cir.), *cert. denied*, 354 U.S. 922 (1957).

allowed to file what is known as a terminal disclaimer¹²⁰ whereby he disclaims any extension of a monopoly over the 17-year period. While at first the courts were hesitant to allow such a disclaimer to overcome a double patenting rejection,¹²¹ the modern trend seems to permit the common inventor to do so where this is the only objection on the record and where there is more than a mere colorable variation in the same idea.¹²²

For the purposes of double patenting, the inventorship entity of *A* is considered different than that of *A* and *B*.¹²³ While this is not totally consistent with the judicial interpretation of the term "same inventor" in the area of conversion of inventorships, it is not at all unjustified, for the doctrine of double patenting stems from the fact that *one* person or entity is trying to get two patents on one invention. Thus, since *A* and *B*, as joint inventors, cannot be the basis of a double patenting rejection against either one individually, it would seem that *A*, being different than *A* and *B*, could be the basis of a novelty reference against *A* and *B* under section 102.¹²⁴ But at least one case¹²⁵ has said that *A* is "not another" to *A* and *B* for section 102 purposes. Again it seems that one goes to court not knowing where he stands.

The confusion which plagues the courts is best demonstrated by the case of *Application of Hession*.¹²⁶ There, two sole applications for the same invention had been submitted to the Patent Office, one by the inventor *A*, and the other by his supervisor *B*. Both applications were assigned to the same corporation. The corporation thus had to decide which application it would honor. Accordingly, it chose *B*'s application upon which a patent was eventually issued. Later it recognized its error and renounced *B*'s invention, giving credit to *A*, the true inventor. In order to avoid double patenting, *A* filed a terminal disclaimer so as not to extend the monopoly beyond the time when the now invalid patent to *B* would have expired. But even though *B* officially admitted that *A* was the true inventor,

¹²⁰ 35 U.S.C. § 253 (1964).

¹²¹ *Application of Siu*, 222 F.2d 267 (C.C.P.A. 1955).

¹²² *Application of Kaye*, 332 F.2d 816 (C.C.P.A. 1964); *Application of Robeson*, 331 F.2d 610 (C.C.P.A. 1964).

¹²³ *E.g.*, *Peelers Co. v. Kaakinen*, 126 U.S.P.Q. 42 (W.D. Wash. 1960), *aff'd*, 301 F.2d 170 (9th Cir.), *cert. denied*, 371 U.S. 823 (1962); *Ex parte Panagrossi*, 126 U.S.P.Q. 287 (Pat. Off. Bd. App. 1960); *Ex parte Lindeman*, 107 U.S.P.Q. 331 (Pat. Off. Bd. App. 1955).

¹²⁴ 35 U.S.C. § 102 (1964), quoted at note 12 *supra*.

¹²⁵ *Application of Blout*, 333 F.2d 928 (C.C.P.A. 1964).

¹²⁶ 296 F.2d 930 (C.C.P.A. 1961).

the court held that the corporation was estopped to change its mind due to its original election.¹²⁷ It thus appears that not only must the common assignee make an election in such situations, but also he must be certain that his election is correct.¹²⁸

Probably the better reasoned opinion in *Hession* is the dissent by Judge Rich¹²⁹ who thought the election was made through innocent error. A hint of sarcasm can be noted by his comments on the majority's logic: "So, the logic is that elections are binding because elections are binding, or, otherwise stated, the fundamental proposition supporting the doctrine of election is the doctrine of election."¹³⁰ While this dissent is not the law today, it is well documented and certainly contains much logical thinking.

Most unpredictability that exists today in the area of double patenting can be attributed to the uncertain concept of inventorship. It is evident that the "research team" approach employed by corporations will continually add to the complexities confronting the courts. Stable inventorship policies would ease these problems and aid the courts in attaining a workable solution.

D. Antitrust Law

(1) *Fraud on the Patent Office*.—Fraud on the Patent Office, like other fraud, consists of (1) misrepresentation of a material fact; (2) knowledge of that fact's falsity; and (3) inducement to act by another party.¹³¹ Thus a person who knowingly and falsely swears that he is the true inventor can be found guilty of such fraud and any patent thus wrongfully issued to him can be invalidated.¹³² While the courts at times have been reluctant to declare a patent invalid on such grounds,¹³³ many patents have been struck down for various fraudulent acts.¹³⁴ Although it has been held that only the

¹²⁷ *Id.* at 934-35.

¹²⁸ At least one authority has suggested that this is a harsh result. See Rosenberg, *supra* note 116, at 60.

¹²⁹ Application of *Hession*, 296 F.2d 930, 939 (C.C.P.A. 1961) (dissenting opinion).

¹³⁰ *Id.* at 951.

¹³¹ Durham, *Fraud in Patent Matters*, in THE ENCYCLOPEDIA OF PATENT PRACTICE AND INVENTION MANAGEMENT 336 (Calvert ed. 1964). See *United States v. Cold Metal Process Co.*, 62 F. Supp. 127, 140 (N.D. Ohio 1945), *aff'd*, 164 F.2d 754 (6th Cir. 1947).

¹³² See, e.g., *United States v. American Bell Tel. Co.*, 128 U.S. 315 (1888).

¹³³ *Edward Valves, Inc. v. Cameron Iron Works, Inc.*, 286 F.2d 933, 947 (5th Cir.), *modified on rehearing*, 289 F.2d 355, *cert. denied*, 368 U.S. 833 (1961).

¹³⁴ E.g., *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238 (1944) (false showing of general industry acceptance); *Mowry v. Whitney*, 81 U.S. 434 (1871)

government can initiate actions to invalidate fraudulently obtained patents,¹³⁵ a party with a real and substantial interest in the controversy can attempt to prove fraud.¹³⁶ However, fraud is most often alleged as a defense to an infringement action.¹³⁷

A defendant, relying on fraud, must show the following factors: (1) intent; (2) knowledge; and (3) materiality.¹³⁸ In order to show fraudulent *intent*, it must be shown that the statement was made in bad faith.¹³⁹ To meet the knowledge test, the applicant must "know that his conduct or statements are false or misleading."¹⁴⁰ There appears to be no real test for materiality since no case has squarely considered the issue. However, it would seem that if one were sued for infringement, and he could prove that the patentee knowingly intended to defraud the Patent Office by swearing he was the true inventor, he could have the patent invalidated, because this would be the misrepresentation of a material fact which goes to the heart of all patent law.

(2) *Antitrust Implications.*—In the recent Supreme Court case of *Walker Process Equip., Inc. v. Food Mach. & Chem. Corp.*,¹⁴¹ it was held that anyone who knowingly enforces a patent which has been obtained by defrauding the Patent Office may be liable for treble damages under antitrust law.¹⁴² While the fraud in *Walker* did not directly involve inventorship problems, there should be no doubt that a similar holding would result no matter what type of fraud was practiced.

(filing of false affidavits); *United States v. Hartford-Empire Co.*, 73 F. Supp. 979 (D. Del. 1947) (false showing of commercial success).

¹³⁵ *United States v. Gunning*, 18 Fed. 511, 512 (S.D. N.Y. 1883).

¹³⁶ *A. B. Dick Co. v. Marr*, 197 F.2d 498 (2d Cir.), *cert. denied*, 344 U.S. 878 (1952). Here, however, the party asserting the fraud could not prove his real and substantial interest, the question being moot. "A party's minor role as protector of the public interest in these cases does not seem to us enough to prevent this case from being moot." *Id.* at 503.

¹³⁷ See, e.g., *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238 (1944).

¹³⁸ *Cullen & Vickers, Fraud in the Procurement of a Patent*, 29 GEO. WASH. L. REV. 110, 126-29 (1960). See particularly cases cited therein: *Floridin Co. v. Atapulugus Clay Co.*, 35 F. Supp. 810 (D. Del. 1940), *aff'd*, 125 F.2d 669 (3d Cir. 1942) (intent); *Armour & Co. v. Wilson & Co.*, 168 F. Supp. 353 (N.D. Ill. 1958), *modified*, 274 F.2d 143 (7th Cir. 1960) (knowledge); *Martin v. Ford Alexander Corp.*, 160 F. Supp. 670 (S.D. Cal. 1958) (materiality).

¹³⁹ *United States v. Cold Metal Process Co.*, 62 F. Supp. 127 (N.D. Ohio 1945), *aff'd*, 164 F.2d 754 (6th Cir. 1947).

¹⁴⁰ *Cullen & Vickers, supra* note 138, at 128.

¹⁴¹ 382 U.S. 172 (1965).

¹⁴² *Id.* at 174. The applicable antitrust laws are Sherman Antitrust Act § 2, 26 Stat. 209 (1890), 15 U.S.C. § 2 (1964); Clayton Act § 4, 38 Stat. 731 (1914), as amended, 15 U.S.C. § 15 (1964).

In *Walker*, the plaintiff filed suit for patent infringement. The defendant denied the infringement and counterclaimed for a declaratory judgment that the patent was invalid. The plaintiff subsequently moved to dismiss with prejudice. Defendant then amended its counterclaim charging that the plaintiff had "illegally monopolized interstate and foreign commerce by fraudulently and in bad faith obtaining and maintaining . . . its patent . . . well knowing that it had no basis for . . . a patent."¹⁴³ By holding for the defendant, the Court laid the framework for similar actions in the future. And it appears very justifiable to hold answerable to the antitrust-monopoly provisions of the law one who secures a patent illegally and enforces it for a number of years.

It remains to be seen whether anyone will ever have to answer to an antitrust counterclaim by reason of maintaining the wrong inventorship entity. But it seems, in view of the increasing number of complications arising in the area, that this will be the next step. It would be a high price to pay for a corporation which knowingly, but for some insignificant reason, did not let the true inventor apply for a patent.

V. CONCLUSION

There can be no doubt that the doctrine of inventorship plays a fundamental role in the prosecution and enforcement of a valid patent. The forces which continually come into conflict are the statutory requirement that the true inventor must apply and the modern trend toward corporate "research-team" inventorship entities. To reconcile the two, a plausible solution would be for the statute to allow the patent to issue to the corporation,¹⁴⁴ that is, if it would have been assigned to it anyway. This system would protect the corporation from the loss of a patent on technical grounds, and would resolve many of the inconsistencies in the interpretation of such phrases as the "same inventor." On the other hand, the inventor who might suffer an intellectual loss (since he would no longer be recognized on the patent) could be compensated by the

¹⁴³ *Walker Process Equip., Inc. v. Food Mach. & Chem. Corp.*, 382 U.S. 172, 174 (1965).

¹⁴⁴ This practice is followed with apparent success in Great Britain and other foreign countries. The Patent Act, 1949, 12, 13 & 14 Geo. 6, c. 87, § 1. For a commentary on the law see VOJACEK, *A SURVEY OF THE PRINCIPAL NATIONAL PATENT SYSTEMS* § 2 (1936). While it could be said that such a system would violate the Constitution, U.S. CONST. art. I, § 8, it is submitted that one could interpret "Inventors" as used in the Constitution to include corporations. Corporations are considered "persons" for many other purposes; is there a justification for not doing so here?

corporation with financial increases and other superficial recognition. For instance, with the proper statutory authority, the Patent Office could require the corporation to issue certificates of inventorship to the deserving employer. This system seems less cumbersome and more logical than the "more-the-safer" practice of the modern corporation. That system of applying in the name of all the researchers or anyone who had a part in the invention is certainly inconsistent with the statutory mandate that only the true inventor can apply. And while this system is dangerous, it is suggested that it is far safer than the practice which some corporations employ, that is, to name the president of the corporation as the inventor.

Finally, it is suggested that due to the recent liberalization of the inventorship conversion statutes, the courts should consider the sole-to-sole inventorship conversion. While there are some valid counter arguments to this suggestion, it seems that if the wrong inventor applies through innocent error the change should be allowed. While the statute is silent now, the statute was also silent in 1920 when *In re Roberts*¹⁴⁵ set out the *judicial* background for present-day statutory conversions.

Many of these questions and more are currently being considered by the President's Commission on the Patent System.¹⁴⁶ It is hoped that some modernization and consistency in the laws which make up the doctrine of inventorship will result from the Commission's endeavors.

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¹⁴⁵ 263 Fed. 646 (D.C. Cir. 1920). See text accompanying notes 63-70 *supra*.

¹⁴⁶ The Commission was formed by Exec. Order No. 11215, 30 Fed. Reg. 4661 (1965). For a report of the initial meeting of the Commission see 1965 AMERICAN PATENT L. A. BULL. 577.