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Jun 07

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No. 32: Patent Law: It's My Invention; Shouldn't My Name Go on Patent Application?

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PATENT LAW

## It's My Invention; Shouldn't My Name Go on Patent Application?

**Reader Question:** My department chair insisted the patent application be in his name. But I'm the PI who came up with the idea and ran the experiments. How can I get proper recognition?

### Expert Comments:

This is a multi-faceted question and can be answered in a couple of different ways depending on whether you ("who came up with the idea and did the experiments" to reduce the idea to practice), were or were not named as an inventor on the patent application when it was filed with the U.S. Patent & Trademark Office (USPTO).

(1) If the department chair was listed on the non-provisional application as a first-named inventor and you were not listed as an inventor, although you "came up with the idea and did the experiments" to reduce the idea to practice, then if the patent issues with claims to which you contributed, the patent will be invalid and unenforceable in a court of law.

For the sake of argument, I will presume that the patent application is still pending at the USPTO (i.e., has not yet issued into a patent). If this is the case, the inventorship can and should be corrected under 37 CFR section 1.48 to add your name — providing the error was made without deceptive intent.

In the process of determining correct inventorship, if it is determined by the patent agent/attorney that the department chair did not contribute to the subject matter of any of the claims pending in the application, she/he should be removed as an inventor on that application.

I am sure that the intellectual-property (IP) managers and/or patent attorney working for your research institution recognize that inventorship is a legal question based on factual evidence, determined by a patent professional. It should not be influenced by office politics or academic politics (supervisors taking credit for the inventions of subordinates), because this can jeopardize the validity of the patent.

Therefore, if you are concerned that you have not been given proper recognition for your inventive contributions to the claims in the patent application, I suggest that you, at least, confidentially bring this issue to the attention of the IP managers and/or patent attorney working for your research institution.

(2) If the department chair was listed on the application as a first-named inventor, and you were also listed as an inventor (even though not first named), then legally you have the same rights in the invention as the department chair.

The first-named inventor does not have any more rights to the patent than the other inventors. According to law, all inventors have an equal share regardless of how much or how little they contributed.

For example, if an application has 20 claims, and you contributed to 19 claims and the chair contributed to 1 claim, both of you are entitled to be inventors on the application.

If the patent attorney determines that the department chair has not contributed to any of the claims, then inventorship must be corrected, which eventually leaves you as a first-named inventor. Otherwise, the order in which names are listed does not legally matter, because each inventor owns an indivisible interest in the patent — unless all the inventors assign their rights to the research institution for some type of consideration, in which case the assignee owns it.

However, if you really believe for a variety of reasons that you should be listed on the patent as the first inventor, I suggest you discuss this with the IP managers and/or patent attorney working for your research institution. They may be sympathetic to your cause and be willing to pay the costs of re-submitting the formal paper work (such as the Declaration and Application Data Sheet) with the USPTO, listing you as the first inventor.

The declaration is a signed/dated document that identifies each inventor by full name, address and country of citizenship. This may help you get the status and recognition that you seek in a patent that issues.

*Comments by Sara D. Vinarov, PhD, JD, patent attorney with Quarles & Brady LLP, Chicago.*

[\[ Back \]](#)

### Comments (11)

Professor, Dept. Molecular and Cellular Biology, Baylor College of Medicine  
written by David D. Moore, June 02, 2010



It would be a very serious mistake to go forward with this patent application if he did not contribute to the actual invention, since naming an incorrect inventor is clear grounds for invalidating a patent. Patent inventorship is very different from authorship as a consultant, and a clear explanation of the distinction and

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