The Muddy Collaboration Element Of Joint Inventorship

Law360, New York (September 20, 2010) -- The Patent Statute provides that two or more people can be joint inventors on a patent covering subject matter they invented jointly even if: (1) they did not physically work together or at the same time; (2) each did not make the same type or amount of contribution; and (3) each did not make a contribution to the subject matter of every claim of the patent.[1] The U.S. Court of Appeals for the Federal Circuit has interpreted this to require that a joint inventor must contribute in some significant manner to the claimed invention[2] and that he must work “jointly” with or collaborate with the other inventor.[3]

Determining what is a significant enough contribution and what constitutes joint behavior is complex and difficult. In fact, one court has gone so far as to call joint inventorship “one of the muddiest concepts in the muddy metaphysics of the patent law.”[4] This is because the statute outlines who should not be excluded from joint inventorship but gives no definitive framework for who should be deemed a joint inventor. Nor does it set forth the minimum threshold required to satisfy the standard. The only thing that is clear is that joint inventorship is a fact-intensive determination,[5] and there are no bright-line rules.[6]

Because the named inventors on a patent are presumed to be the “true and only inventors,”[7] a party asserting that he was an omitted joint inventor carries a heavy burden of proving this by clear and convincing evidence.[8] An alleged joint inventor must present corroborating evidence beyond his own testimony to prove contribution and collaboration.[9]

Most commentators have focused on the first element of the inquiry, providing insights on the quantity and quality of contribution necessary for joint inventorship. This article addresses the second part — collaboration. 

Some Quantum of Collaboration Is Necessary

The Federal Circuit has held that some element of joint behavior, collaboration, connection,[10] concerted effort or conjoined labor[11] is necessary to establish joint inventorship. A joint invention is the product of collaboration of the aggregate inventive efforts of two or more people working toward
the same goals. Examples of joint behavior include: collaboration, working under common direction, one
inventor seeing a relevant report and building upon it or hearing another’s suggestion at a meeting.[12]

While joint inventors need not make an equal contribution or conceive of the entire claimed invention,
they must know of each other’s work at the time of the invention.[13] For example, employees of the
same patent holder could not be joint inventors, where they independently worked on the same
invention at different times and were unaware of what each other had done for several years after their
independent efforts.[14]

There must also be a connection between the alleged inventor’s inventive act and the communication
and/or collaboration with the named inventor(s). There must be collaboration or an “open line of
communication” between the joint inventors “during or in temporal proximity” to inventive work.[15]
As such, contribution and collaboration are interrelated requirements.

What Does a Quantum of Collaboration Look Like?

The courts agree that at least some collaboration is necessary. In Maxwell v. The Stanley Works, the
court dismissed the plaintiff’s co-inventorship claim because he did not allege collaboration.[16] The
plaintiff alleged that he independently developed the claimed wrench invention prior to 1981, began a
patent application for it and offered a license to Stanley. When Stanley said it was not interested, the
plaintiff abandoned his application. In 1991, the disputed patent issued to inventor Wannop and
assignee Midland, which subsequently licensed the patent to Stanley. The plaintiff claimed the patent
covered the same invention he had developed prior to 1981.[17] The court held that plaintiff could not
be a joint inventor because there was no allegation he collaborated with the named inventor at any time
in the development of the invention, and no inferences could be drawn he had ever had any contact
with the named inventor.[18]

In another case, Huang v. California Institute of Technology, the court held that the plaintiff could not
establish collaboration because he never communicated with four of the five named inventors, and
admitted he did not recall discussing the claimed invention with the one inventor he had communicated
with.[19]

Nevertheless, give-and-take interactions between joint inventors are not required. In IP Innovation v.
Red Hat Inc., three inventors working for the same employer were named on a patent, but the evidence
showed that only two had developed the claimed invention. The court denied summary judgment for
invalidity for incorrect inventorship because an article showed that the two later inventors knew of the
earlier inventor’s work at the company and may have built their invention upon the earlier work.[20]

The courts differ, however, on whether an alleged co-inventor must communicate with the named
inventors or if collaboration with someone connected to the named inventors can be sufficient.

In Ultra-Precision Mfg. Ltd. v. Ford Motor Co., the court denied joint inventorship where the evidence
showed that there was no interaction between the plaintiffs and the named inventors during the time of
the invention.[21] There, the plaintiffs alleged they had communicated with another Ford employee, but
not the named inventors. The court held that even if the plaintiffs’ work were considered a prior
conception of the invention, they were not part of the collaborative efforts of the named inventors who
engaged in the subsequent modifications and processes to arrive at the final invention.[22]

Similarly, in Arbitron v. Kiefl, the court dismissed with declaratory judgment the defendant’s claim for
joint inventorship for lack of collaboration, where he did not interact with the named inventor, only
alleged he previously had an open line of communication with the patentee’s counsel, but did not offer factual allegations of a common inventive goal shared with the named inventor.[23]

On the other hand, in Memry Corp. v. Kentucky Oil Technology, the court held that collaboration may be satisfied where evidence showed the alleged inventor had disclosed inventive concepts to a third party, who then communicated and collaborated with the named inventors. The court held that the evidence suggested it was possible that the alleged inventor had collaborated in the inventive contributions provided by the third party, thus precluding summary judgment seeking to dismiss the correction of inventorship claim.[24]

Other Remedies May Be Available

Even if the collaboration required for joint inventorship cannot be shown, other remedies may be available to a plaintiff who can show his invention was misappropriated. In PHG Technologies LLC v. Timemed Labeling Sys. Inc., Riley had had a business relationship with one of the named inventors, Moyer, and had developed a design for a laser-printer generated patient identification label sheet.[25] Later, Moyer teamed up with another inventor, Stewart to develop a patented design which had certain novel inventive features over the older model developed by Riley.[26]

The court found no joint inventorship because at the time when Moyer and Stewart developed their designs, Riley did not “collaborate with them to work toward the same end to produce, by their aggregate efforts” the designs depicted in the patents. The court also found, however, undisputed evidence that Riley had invented certain features of the patented designs and that Moyer had appropriated Riley’s earlier design as the model for the final claimed design. The court hinted that while there was no joint inventorship claim, Riley may have other possible claims.[27]

Conclusion

Proving collaboration by clear and convincing evidence is a high burden. Although far from setting a bright-line test, the cases are helpful in preparing pleadings, conducting pre-filing investigations and planning strategies. Plainly, alleging only that the omitted inventor developed his invention independently is detrimental to a joint inventorship claim. Likewise, alleging only that there was some open line of communication between the alleged inventor and the company where the named inventors worked may not be enough. The connection between the joint inventors cannot be peripheral.

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Inventorship is a mixed question of law and fact. While the overall determination of inventorship is a question of law, the legal issue is based on underlying questions of fact. Eli Lilly v. Aradigm Corp., 376 F. 3d 1352, 1362 (Fed. Cir. 2004).

Fina Oil & Chem. Co. v. Ewen, 123 F. 3d 1466, 1473 (Fed. Cir. 1997)

Ethicon, supra, 135 F. 3d at 1460.

See Eli Lilly & Co., supra, 376 F. 3d at 1358.


Kimberly-Clark, supra, 973 F. 2d at 917.

Eli Lilly & Co., supra, 376 F. 3d at 1357.

See Kimberly-Clark, 973 F. 2d at 917.

Id.

Id.

Eli-Lilly & Co., supra, 376 F. 2d at 1359


Id. at *2.

Id. at *5.


2010 WL 1233365 (E.D. Texas, Mar. 29, 2010)


Id. at *12.


2007 WL 2746737 (N.D.Cal. Sep. 20, 2007)

[26] Id. at *1-5.

[27] Id. at *8.