USF Division of Patents and Licensing: Your Tech Transfer Office

- Process governing inventorship:
  - Project initiation
  - Invention disclosure
  - Application
  - Grant
  - Outside counsel
Project Initiation

- Communicate, communicate, communicate!
- Publications, grants, patents
Invention disclosure

CONTRIBUTOR(S)

List below all persons who are believed to have contributed to the conception or reduction to practice of this invention.

Please state the number of contributors of the Invention disclosed herein:

Please indicate the name of the contributor completing this form

NOTE: If the invention is described in a publication that identifies authors other than the contributors listed, please describe the contributions made by each author not identified in this disclosure as a contributor to the invention.

If there are more than five contributors, please attach additional sheets for each contributor.

The foregoing list should include names of all persons who may qualify as legal inventors.

Inventorship is a legal question that is generally determined by the attorney of record at the time the patent application is filed.
Please provide information for all persons believed to have contributed to the conception or creative reduction to practice of this disclosure. For each contributor, please provide the following information as to when this research was conducted and where they may be contacted now, if different:

<table>
<thead>
<tr>
<th>Contributor I</th>
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<tbody>
<tr>
<td>First Name</td>
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<td>Work Address</td>
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<td>Work Fax Number</td>
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<tr>
<td>Work E-mail Address</td>
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Department College

Researcher Title

Center or Institute

Please provide details of your contribution to the invention (space is unlimited):

Signature: ___________________________ Date: ___________________________
Patent Application and Issuance

- We will ask you for project updates
- Who contributed to the claims as granted?
What if there is a problem?

- Communicate, communicate, communicate!
- Group discussion
- Outside counsel

Maintain confidentiality at all times
USF's Division of Patents & Licensing Presents:

WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Jeff Lloyd
Glenn P. Ladwig
Saliwanchik, Lloyd & Eisenschenk

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FIRST, WHY DOES IT MATTER?

Inventorship Matters Because:

- Application or Patent must identify true inventors to have enforceable claims
- Affects ownership
FIRST,
WHY DOES IT MATTER?

Application or Patent must identify true inventors to have enforceable claims

- Errors in naming inventors can render a patent unenforceable if done with deceptive intent.
- Exists when the decision to incorrectly include or exclude an inventor was made deliberately, with an ulterior purpose or motive, e.g., to avoid an obligation to assign, to avoid the designation of an inventive entity that may prejudice patentability, to show displeasure with a non-joined inventor, or for financial gain.

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FIRST,
WHY DOES IT MATTER?

Affects ownership...

- According to a regulatory filing May 1, 2012, Pfizer will pay $450 million to settle a six-year lawsuit filed by Brigham Young University (BYU) over the development of the anti-inflammatory drug Celebrex

- BYU claimed its professor should have been included as an inventor on the patents and, pursuant to a joint research agreement, BYU was entitled to at least $9.7 billion in royalties

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Inventorship Determination – Stages of Invention (usually)
1) Conception
2) Interim Activity
3) Reduction to Practice

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Interim Activity and Reduction to Practice

Can be done by ANYONE – they are Construction, not Invention.

The Standard is different from Authorship!
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

- It all starts at Conception: contributors to Conception are the Inventors

- Conception is the Complete (make it) and Operative (use it) idea of the invention, and is often result of 2 steps
  1) Wish for a particular result
  2) Discovery of way to obtain it

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Whoever mutually contributes to the plan and the direction it takes is likely to be an inventor.

Not a contribution to conception:
- Determination of problem, but not solution
- Routine skill ("a skilled pair of hands")
- Explaining/providing the state of the art
- Supplying product or lab space
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

If you think you have a conception and are trying to reduce it to practice, and significant difficulties arise that require deviation from the plan, those responsible for conceiving the deviations are probably inventors.
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Co-inventors:
- need not make equal contributions
- need not be continuous co-workers
- need not make contributions in same time frame
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Anatomy of a Patent/Patent Application:

- Two main components
  - Specification
    - Written description thoroughly describing your invention and what is necessary to implement it
  - Claims (legal language)
    - Define boundaries of the invention
    - Claim 1: A compound having the chemical structure X.
    - Claim 2: A method for treating a movement disorder, comprising administering an effective amount of a compound having the chemical structure X to a subject having the disorder.

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Inventorship is a legal determination based on the claimed invention
- can change during course of an examination
- person that contributes to the conception of at least one claim is an inventor
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Inventorship determinations – what we do:

- Broadly identify anyone that assisted in the invention
- Evaluate contribution of each individual and apply test of conception
- Confirm that each individual contributed to the conception of at least one claim of the current claims
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Example Scenario 1:

- Dr. Ames and Dr. Brown wanted to collaborate and develop a catheter for balloon angioplasty. The novel feature of their design was an improved shaft/lumen configuration.

- In looking for the best material for the balloon, Drs. Ames and Brown consulted Mr. Daniels, an engineer for a company that manufactures heat shrinkable material. Drs. Ames and Brown told Mr. Daniels the properties that the balloon material should have.

- Mr. Daniels suggested incorporation of one of his company’s known heat shrinkable materials as the balloon material to provide an adhesive-free attachment.

→What other information do we need to determine if Mr. Daniels should be a joint inventor?

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Answer: What is CLAIMED!

- A patent issues with Drs. Ames and Brown named as inventors, with the allowed claims directed to a catheter device where the balloon material is capable of attachment to the catheter w/o an adhesive, but w/o reciting the heat shrinkable material suggested by engineer Daniels.

→ Should Mr. Daniels have been a joint inventor?

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Answer: No

- Mr. Daniel’s contributions amounted to nothing more than explaining to the inventors what the state of the art was and supplying the inventors with a product for use.
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Example Scenario 2:

- Dr. Watson discovers a novel compound but has not identified any useful activity associated with the compound. Dr. Watson collaborates with Dr. Crick.

- Through experimentation, Dr. Crick determines a useful activity for the compound.

- Dr. Watson and Dr. Crick are joint inventors on composition claims drawn to the compound and on claims drawn to methods of use.
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Example Scenario 3:

- Dr. Watson discovers a novel compound but has not identified any useful activity for the compound.
- Knowing that Dr. Crick has a proprietary panel of cancer cell lines, Dr. Watson asks Dr. Crick to screen the compound against the panel for activity. Dr. Crick discovers the compound has activity against melanoma.
- Dr. Watson and Dr. Crick are joint inventors on composition claims drawn to the compound and on claims drawn to methods of inhibiting melanoma.
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Example Scenario 4:

- Dr. Watson suspects that a novel compound has anti-viral activity.
- Knowing that Dr. Crick can easily assess anti-viral activity in his lab, Dr. Watson asks Dr. Crick to test the compound. Dr. Crick identifies anti-viral activity against certain viral strains.
- Dr. Watson is the sole inventor on broad composition and method claims. Dr. Watson and Dr. Crick are joint inventors on claims targeting the identified viral strains.

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Example Scenario 5:

■ Dr. Watson suspects that a novel compound has antibacterial activity.

■ Dr. Watson instructs Dr. Crick to test the compound for activity against particular varieties of bacteria specified by Dr. Watson. Dr. Crick verifies activity in the specified bacteria and reports back to Dr. Watson.

■ Dr. Watson is the sole inventor.
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Patent Portfolios

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WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Correcting Inventorship
- Can be corrected if error occurred without deceptive intent

Venue
- Patent Office
  - While application is pending
  - After patent is granted
- Court
WHO IS A CO-INVENTOR, and WHY DOES IT MATTER?

Take-aways:
- Inventorship depends on **conception** of what is **claimed**
- Conception does not require scientific certainty
- Keep proper records of experiments, including "failures" and conflicting data
- Keep records of **thought processes**, hypothesis, etc.
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Questions?