

Inventorship is determined according to U.S. Patent Law (35 U.S.C. § 101 et seq.). When a patent application is filed with the U.S. Patent and Trademark Office (USPTO), the individual inventors are listed on the application while it is under review and, ultimately, on the cover page of an issued patent. Inventorship focuses on the specific invention that is being claimed, not on all subject matter described in the patent application. By law, an inventor named on a patent application or issued patent must contribute to the conception of the idea or subject matter of at least one patent claim that is filed with a patent application. If there are several patent claims, an inventor need only contribute to one of those claims to be named.

INVENTORSHIP vs. AUTHORSHIP

Inventorship should not be confused with authorship on a scientific publication. Anyone involved with a project could be identified as an author; however, not everyone involved in a project can or should be named as an inventor. Inventorship is determined by law and focuses on claims filed with the patent.

FACULTY AND STUDENTS

Questions of inventorship can arise when faculty and students work on a research project together. An invention may be co-invented by one or more faculty members and students if they collaborate and “conceive of an invention” together. A faculty member alone or a student alone may also be deemed a sole inventor.

If a faculty member has conceived of general concepts related to an invention before a student becomes involved in working on a project, and that student does not contribute directly to the invention as it is being claimed in a patent application, then the faculty may be a sole inventor. On the other hand, if a student takes a general idea and conceives of the essential elements necessary to make the invention work beyond the general idea of the invention, the student might be considered a sole inventor.

NAMED INVENTORS MAY CHANGE

During prosecution of a patent application, the claims filed in the original patent application may change or some claims may be removed and/or new claims may be added. Since inventors are associated with specific claims, an assessment of inventorship with regard to claims that are part of the application is important, especially once a patent issues.

WHAT IF INVENTORSHIP IS NOT CLEAR?

If inventorship is not clear, INVO, in conjunction with outside patent counsel engaged in prosecuting the application and Northwestern’s Office of General Counsel, can help determine who should be listed on a patent application as an inventor. Outside patent counsel will ask all project contributors to describe their personal contributions to the claimed invention and will ask contributors to provide objective evidence related to their contribution. To gather such evidence, counsel may conduct interviews with contributors, examine notebook pages, or examine other tangible evidence that helps demonstrate an individual’s contribution to the invention.

THE IMPORTANCE OF INVENTORSHIP

There are several reasons why inventorship is important. For example, an outside party can challenge issued patent claims on the basis that inventorship is not correct. If a challenge based on inventorship is successful, the patent may be invalidated by a court. For this reason, including individuals on a patent application who are not inventors or failing to include all contributing inventors must be avoided. In addition, if the correct inventors are not named, they and their respective department and school will not receive distributions if any licensing revenue comes back to the University. If there is an inventorship error, it is possible to make a correction. INVO and outside patent counsel will work with you to help determine if a correction is needed in accordance with U.S. patent law.

PATENT OWNERSHIP

Inventors are not necessarily owners of a patent. Ownership is determined by what rights others may have to the invention. At Northwestern, ownership of inventions and discoveries is determined by the University’s Patent and Invention Policy. See <https://invo.northwestern.edu/policies>.

AT A GLANCE

The legal definition of an **INVENTOR** is an individual who has contributed to the conception of an idea or subject matter of at least one claim in a patent application or issued patent.

You may not necessarily qualify as an inventor under US patent law if you...

- are a technician carrying out experiments according to routine protocols;
- are a department chair or a research supervisor of a named inventor;
- created a physical prototype using ‘ordinary skill’ in the field;
- reduced another person’s invention to practice;
- contributed something that would be considered ‘obvious’ to others in the field; or
- discovered a problem in the field.