

The Who's Who and What's What of a Patent Application: An Overview
of Inventors, Assignees, and Applicants
by Gerrit Winkel

When filing a patent application, there are three key characters to identify: Who is the inventor? Who is the assignee? Who is the applicant? Each of these determinations is related to a particular submission to the USPTO and has far-reaching effects on the application.

While an exhaustive review of the issues related to the inventor, assignee and applicant in a patent application would be difficult to summarize, the most common issues and best practices can be explained in relatively simple terms.

1) Who is the inventor?

Inventorship has been a pivotal part of US patent practice since the establishment of patent rights. Section 8, Article I of the United States Constitution gives Congress the “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.” As the rights to a discovery are only secured to an inventor, an inventor's oath or declaration is required to identify the true inventor based on the claims of an application.

The inventor's oath or declaration must contain a minimum of:

- A statement that the application was made or authorized to be made by the person executing the declaration.
- A statement that the individual believes himself to be the original inventor or an original joint inventor of a claimed invention in the application.
- Language acknowledging a penalty of “imprisonment of not more than 5 years” for willful false statements.
- The inventor's signature.

A patent that fails to properly identify the true inventors of the claimed subject matter may be invalid, and so it is essential that the true inventors are accurately identified and that only the true inventors execute oaths/declarations.

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"The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor... Insofar as defining an inventor is concerned, reduction to practice, per se, is irrelevant [except for simultaneous conception and reduction to practice]", *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993).

In situations where an inventor is deceased, under a legal incapacity, has refused to execute the oath or declaration, or cannot be found or reached after diligent effort, a substitute statement may be executed by a legal representative of the inventor, a joint inventor, or one with a proprietary interest in the application in lieu of that inventor's declaration (37 CFR 1.64). In these circumstances, the substitute statement alone is sufficient for submission to the USPTO, however proof of a good faith attempt to secure the inventor's signature and the circumstances behind the substitute statement should always be retained in case of future litigation.

Where an application data sheet (ADS) is filed that identifies the entire inventive entity, the filing of the inventor's oath or declaration may be postponed until payment of the issue fee. However, the delay requires the payment of an additional fee and may reduce any patent term adjustment calculated by the USPTO. For these reasons, and due to the fact that an error may affect validity of the patent, **best practice is always to file the declaration as early as possible.**

2) Who is the assignee?

While rights to a discovery are only secured to an inventor, patents have the attributes of personal property and can be transferred, or assigned, to another individual or entity.

An assignment itself is the legal act of transferring to another the ownership of one's property, and as such the assignment must conform to local venue requirements in order to be valid. These requirements generally include that the assignment be made in writing, provide a clear identification of the property transferred, recitation of an exchange of

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consideration, etcetera.

Once completed and signed, an assignment is a valid legal document and the transfer is also valid and legal; no submission to the USPTO is required. Technically, the USPTO is charged with recording assignments and all other documents "affecting title to applications, patents and registrations," for the purpose of providing notice to interested parties. (37 CFR 3.11)

So if the assignment is valid and legal, why take the additional step to record an assignment at the USPTO? According to USC 261, para. 4: "An assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valid consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months of its date or prior to the date of such subsequent purchase or mortgage."

In other words, if an assignment is not recorded within three months after signing, the assignee stands at risk of having its rights subordinated to a subsequent bona fide purchaser or lender acting without notice of the assignment. Further, rights are not enforceable by an assignee without a recorded assignment, and there is no recovery of damages for infringement in the period prior to recordation.

When recording an assignment at the USPTO, it is important to note that the assignment is not reviewed for validity. Under the ministerial recording role, the USPTO requires only (1) The name of the party conveying the interest; (2) The name and address of the party receiving the interest; (3) A description of the interest conveyed or transaction to be recorded; and (4) Identification of the interests involved. Recordation is thus not a guarantee that the assignment meets the local venue requirements, as mentioned previously.

While an error in the assignment or failing to record the assignment does not affect the validity of a patent, it may affect the enforceability. Thus, **it is always best practice to record an assignment with the USPTO as early as possible.**

3) Who is the applicant?

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After determining the identity of the inventor and assignee, the question remains: who is the applicant? It depends.

The applicant is the individual applying for the patent, and is the party responsible for managing the patent application (i.e. filing power of attorney documents).

An applicant may be any person or "juristic entity," e.g., a corporation or other legally created organization, (1) to whom the inventor has assigned, (2) to whom the inventor is under an obligation to assign, or (3) who otherwise shows sufficient proprietary interest in the matter. If there is no assignee or if the assignee has opted not to file the application and not to take over prosecution to the exclusion of the inventor, then the applicant may be a single inventor or joint inventors as co-applicants.

If the application is assigned to an assignee or is under an obligation to assign to an assignee, the assignee should be identified as the applicant. For the inventor to be identified as the applicant because the assignee has opted not to file the application or has opted not to take over prosecution, the USPTO should be notified, as the assignee is the default applicant.

Whether an inventor or an assignee, **it is important for effective prosecution and representation to identify the applicant at the outset of filing a patent application**, as communication with the USPTO must be done by the applicant or on the applicant's behalf.