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CLIENT ALERT

The Public Disclosure of Ideas That Represent "Less Than the Total Invention" Does Not Negate Joint Inventorship of That Author

AUGUST 13, 2020

Dana-Farber Cancer Institute, Inc. v. Ono Pharmaceutical Co., Ltd., No. 2019-2050 (Fed. Cir. July 14, 2020)

The dispute in this case centered around the inventorship of a discovery in the field of cancer treatment. Listed on the patent at issue was a single individual. The claimant contended that two additional researchers, each of whom had collaborated and contributed to the discovery, should be deemed inventors of the patented subject matter. After reviewing the contributions of the two researchers, and concluding that they were significant to the invention's conception, the district court held that both should be listed on the patent as inventors. The Federal Circuit affirmed.

The standard for joint inventorship is described in 35 U.S.C. § 116(a), which provides that an inventor need not physically work with or at the same time as another inventor, make the same type or amount of contribution, or contribute to the subject matter of every claim of a patent in order to be listed on the patent with the other inventor. In arguing against listing the two researchers as inventors, the patent holder proffered two arguments: first, that the contributions of the two researchers were at most "speculative," as they occurred before *in vivo* experimentation had been conducted; and second, because the researchers' contributions were published prior to conception, they should be deemed "irrelevant" to the question of inventorship. The Federal Circuit disagreed, concluding that by ruling for the patent holder, it would be creating an "unnecessarily heightened inventorship standard." Instead, the court held (i) *in vivo* verification is not a required prerequisite for conception, and (ii) collaborative enterprises are not entirely negated by the public disclosure of ideas that represent "less than the total invention."

View the full opinion here.

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