



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Thompson
v.
Haynes***

No. 01-1392
Federal Circuit
Sept. 30, 2002

“[T]he burden on each party was to show facts supported by clear and convincing evidence that the other person listed as an inventor had not in fact contributed to the conception of the invention.”

On September 30, 2002, the Federal Circuit, *inter alia*, affirmed the district court’s judgment following a bench trial that no correction of inventorship of U.S. Patent No. 5,284,298 was warranted. The patented technology related to a fluid conducting swivel. The Federal Circuit stated:

As an initial matter, Thompson argues that the issue of inventorship is not properly before us, apparently because there was no mention of inventorship in the Rule 54(b) judgment. Fluid Controls responds that the district court found in that judgment that “[the court’s] ruling in the partial findings and conclusions comprise [sic] a final and separable resolution of all claims addressed therein,” and that among the district court’s conclusions of law in its partial findings and conclusions was that the joint ownership of Thompson and Haynes was “fully supported” and that no correction of inventorship was merited. We agree with Fluid Controls. Because the court’s conclusion on inventorship was addressed in its partial findings of fact and conclusions of law, final judgment was entered on the inventorship claims by the Rule 54(b) judgment. Accordingly, the inventorship issue is properly before us for review.

Whoever invents patentable subject matter is entitled to a patent thereon. “Conception is the touchstone to determining inventorship.” “[Conception] is ‘the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.’” “There is a presumption that the inventors named on an issued patent are correct, so misjoinder of inventors must be proven by clear and convincing evidence.” What is required is “corroborating evidence of a contemporaneous disclosure that would enable one skilled in the art to make the invention.” “The determination of whether a person is a joint inventor is fact specific, and no bright-line standard will suffice in every case.”

In this case, the burden on each party was to show facts supported by clear and convincing evidence that the other person listed as an inventor had not in fact contributed to the conception of the invention. The parties appear to have misapprehended this burden at trial: while the district court found that “[t]he evidence . . . is clear and convincing that both Mr. Thompson and Mr. Haynes contributed in a significant manner to the conception of the ‘298 patent,” it also found that neither party had “presented any evidence that supports the conclusion that [the other] should be removed as a joint inventor of the ‘298 patent.” Without the latter evidence, both claims for correction of inventorship must fail. On appeal, Thompson argues that Haynes’ alleged contributions are not reflected in the claims of the ‘298 patent and suggests that Fluid Controls’ attorney, who prosecuted the ‘298 patent, had a conflict of interest rendering suspect his judgment that Haynes was an inventor. Haynes responds that Thompson’s characterization of Haynes’ contributions is unduly narrow. These arguments are insufficient to establish that the district court erred in refusing to correct the inventorship of the ‘298 patent. Accordingly, we affirm the holding of the district court on this issue.