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TECHNOLOGY LAW UPDATE

A report of the latest Federal Circuit updates brought to you by Preston Gates.

Caterpillar Inc. v. Sturman Indus., Inc.

Nos. 03-1444, -1490 (Fed. Cir. Oct. 28, 2004)

“[T]o be a joint inventor, an individual must make a contribution to the conception of the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.”

On October 28, 2004, the Federal Circuit, *inter alia*, affirmed the district court’s judgment that Mr. Sturman was the sole inventor of U.S. Patents No. 5,460,329 and No. 5,640,987, but reversed the ruling that he was the sole inventor of U.S. Patent No. 5,479,901. The technology related to fuel injector magnetic latching using residual magnetism. The Federal Circuit stated:

Patent issuance creates a presumption that the named inventors are the true and only inventors. To rebut this presumption, a district court must find clear and convincing evidence that the alleged unnamed inventor was in fact a co-inventor before correcting inventorship under 35 U.S.C. § 256. “[T]o be a joint inventor, an individual must make a contribution to the conception of the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.” This requires more than merely exercising ordinary skill in the art—“a person will not be a co-inventor if he or she does no more than explain to the real inventors concepts that are well. Instead, an alleged co-inventor must supply evidence to corroborate his or her testimony. known [in] the current state of the art.” [A]n alleged co-inventor’s testimony cannot, standing alone, provide clear and convincing evidence.

Caterpillar has not presented clear and convincing evidence to rebut the presumption that Mr. Sturman is the true and only inventor of the ‘329 and ‘987 patents. With respect to the ‘329 patent, we defer to the district court’s findings of fact. [W]e agree with its ultimate legal conclusion that Maley and Tharp should not be named as co-inventors of the ‘329 patent. [T]he facts found by the district court demonstrate that they neither developed nor worked on an integrated spool valve under the JDA, that such a design does not require as much latching force, and, finally, that the teachings of the ‘898 patent together with information in the public domain regarding material properties would have made the choice of materials an exercise of ordinary skill in the art. Thus, the use of 52100 and 4140 steels was an insignificant contribution and does not support their claims of co-inventorship.

[W]e disagree with Caterpillar that Sturman’s amendments to the ‘329 patent claims demonstrate that Maley and Tharp made an inventive contribution. The addition of the “material with enough residual magnetism . . .” limitation is broad; it is not limited to the specific steels identified by Maley and Tharp. Moreover, as the district court found, when used in an integrated spool valve such as claimed in the ‘329 patent, the teachings of Sturman’s ‘898 patent provide all that is necessary for one of skill in the art to identify the appropriate materials. . . .

With respect to Caterpillar’s ‘901 patent, the trial court found in favor of Mr. Sturman as to his claim of sole inventorship. [T]he district court clearly erred in finding that, in addition to conceiving the design for an integrated spool valve, Mr. Sturman presented clear and convincing evidence that he also conceived the idea of a three-way version of the valve applied to a HEUI. [T]he district court clearly erred in finding that Mr. Sturman disclosed the idea as part of a proposal for an integrated product line in his October 14, 1992, presentation. [T]he slides from the presentation [do] not demonstrate that Mr. Sturman conceived of the idea of a three-way integrated spool valve. [T]he presentation as a whole relates to plans to continue with the initial proposal for a traditional solenoid valve (such as the one described above in relation to the ‘898 patent). . . . Mr. Sturman [had not] disclosed the idea for a three-way integrated spool valve in his presentation to Caterpillar. . . . Accordingly, we reverse the district court’s ultimate legal conclusion that Mr. Sturman was the true and sole inventor of the invention claimed in the ‘901 patent.