

Who is an Inventor on a Patent Application? Not just any Tom, Dick, or
Harry...
by Peter Malen

From time to time, when exploring the question of inventorship with a client, I've been told things along the lines "I want to list Jane (as an inventor) on the patent application because she helped pay for it," or "I want to list Joe on the patent application because he is a great guy," or "I don't want to be listed on the application because I don't want to have any legal liability," or "Let's add Jack as an inventor because he owns the company," or "Let's remove Jill from the list of inventors because she no longer owns the company."

In fact, however, none of these are adequate reason to add, or remove, an inventor from the list of inventors on a patent application. Instead, inventorship is a legal determination that must be made with reference to the subject matter recited in the claims. As explained in the Manual of Patent Examining Procedure *"The definition for inventorship can be simply stated: 'The threshold question in determining inventorship is who conceived the invention...'"* MPEP 2137.01 (II) (emphasis added) and, more specifically, *"Each joint inventor must generally contribute to the conception of the invention. A coinventor need not make a contribution to every claim of a patent. A contribution to one claim is enough."* MPEP 2137.01 (V) (emphasis added).

As the MPEP makes clear then, the status of "inventor" is not something that can be conferred, or revoked, at whim. Rather, the determination as to who is, and who is not, an inventor on a patent application is a legal determination that must be made with reference to the claimed subject matter.