

## WHO SHOULD YOU LIST AS A CONTRIBUTOR ON THE ONLINE DISCLOSURE FORM?

### INVENTORS vs. NON-INVENTORS

When filling out the University of Oklahoma Office of Technology Commercialization online disclosure form, you are asked to list the researchers who were “contributors” to the invention that you are disclosing. There are two kinds of contributors to an invention: inventor contributors and non-inventor contributors. Patent law specifies that only a person who has made a **conceptual contribution** to an invention can be considered to be an **inventor** of that invention. There can of course be multiple inventors of an invention. In such a case, each inventor is referred to as a “co-inventor” or “joint inventor.” A person who did not make a conceptual contribution to an invention, but did significantly assist in the “reduction of practice” or “making” of the invention, is referred to as a “non-inventor contributor.”

### WHAT CONSTITUTES INVENTORSHIP?

An inventor is a person who first invents a new and useful process, machine, composition of matter, or other patent-eligible subject matter. The most important factor in determining inventorship is who, alone or with others, “**conceived**” of the invention. The courts have ruled that only a person who **contributes to the conception** of an invention is eligible to be called an inventor.

Conception has been defined under patent law as the "formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice." An invention is complete and operative "if the inventor is able to make a disclosure which would enable a person of ‘ordinary skill in the art’ to construct or use the invention without non-routine (extensive) research or experimentation."

Two or more individuals may be co-inventors of an invention even though they did not work together on the invention at the same time or in the same place or make the same type or amount of contribution to the invention. The actual invention is set forth in a patent application as a set of statements called “claims.” A co-inventor is only required to make a conceptual contribution to at least one claim in the patent application. The inventorship of a patent application may change if the claim(s) to which a particular co-inventor contributed are canceled from the application.

Inventorship therefore has a strict legal meaning under the laws and regulations of the U.S. Patent System. Determination of inventorship is not to be taken lightly or haphazardly. In fact, an incorrect listing of inventors on a patent (i.e., leaving out a true inventor, or including a non-inventor as an inventor) can lead to invalidation of a patent. In cases of disputes or murkiness, inventorship may be assessed by a patent professional (a registered patent attorney or patent agent). When the University receives an invention disclosure that lists two or more individuals as contributors, the University may seek more information from the listed inventors for the purpose of confirming inventorship.

#### WHAT CONSTITUTES NON-INVENTOR CONTRIBUTORSHIP?

A non-inventor contributor is someone who has, in one way or another, helped to “reduce to practice” or make the invention conceived of by someone else (the inventor). Often, the non-inventor contributor played a significant role in getting the invention to finality, so the inventor wants to reward this person by recognizing their part in reducing the invention to practice. The inventor designates that the non-inventor contributor will receive a specified portion (X %) of potential future revenues in the event the patent is licensed.

A non-inventor contributor is frequently someone who has worked under the supervision of the inventor and simply followed their directions. Or it may be someone whose prior work or efforts were built upon by the inventor, but who had no direct conceptual input into the invention. An individual who merely suggests an idea without the means of accomplishing the task (“You ought to work on a cure for spinal osteoarthritis.”) is not an inventor. There was no contribution to the conception of an *actual* invention, just a vague suggestion.

The determination of who deserves to be included as a non-inventor contributor (and thus a receiver of royalties) is made solely by the inventor(s).

#### CHANGING OR CORRECTING INVENTORSHIP

Inventorship may need to be reevaluated after the patent application has been filed. For example, the scope of the claims or the nature of the claimed invention may change during the drafting and prosecution of the patent application. As noted above, failure to name an inventor or naming an incorrect inventor can result in the invalidity of the patent. In such a case, the inventorship of the patent application may be amended to add the additional co-inventor or

to remove the incorrect co-inventor provided the error arose without any deceptive intent.

## THE DISTINCTION BETWEEN INVENTORSHIP AND AUTHORSHIP

As is now evident, inventorship is very different from authorship. Papers and journal articles that disclose the results of research conducted at the University frequently list as co-authors everyone who contributed to the project, such as colleagues, students, research assistants, technicians, and those who supervise them. This is different from a patent application, which by law must contain only the names of the actual inventors, i.e., the contributors to the conception of the invention. Thus, for legal reasons, the status of co-inventor may not be conferred merely as a reward for skilled or hard work, friendship, or “politics.” This means that co-authors on a paper who have not made conceptual contributions to the invention cannot be listed as inventors, even though they may have gathered essential data or constructed a practical embodiment of the invention. As noted above, if an issued patent does not correctly list the inventors of the patented invention (whether by improper inclusion or exclusion), the patent may be declared legally invalid and unenforceable, and thus worthless.

## CAN A NON-OU EMPLOYEE BE LISTED AS AN INVENTOR?

Yes, everyone who is an inventor should be listed as a contributor in the OTC online disclosure. Each non-OU inventor should also submit their own invention disclosure to their own institution. The OTC will then separately consult with that institution’s technology transfer office to develop an inter-institutional agreement (IIA) to determine who will take the lead on patenting the invention, and how potential royalties will be divvied up between the institutions. *Non-OU non-inventor contributors* do not need to be listed in the OTC invention disclosure form. That determination is up to the institution of the non-OU inventor.

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Who to list as an INVENTOR/CONTRIBUTOR on a Disclosure?

| <b>OU Inventor/Contributor</b>                                | <b>OU Non-Inventor/Contributor</b>   | <b>Non-OU Inventor/Contributor</b>                           | <b>Non-OU Non-Inventor/Contributor</b>                                    |
|---|--|--|---|
| OU person who made a conceptual contribution to the invention | OU person who assisted in reduction to practice or making of the invention | A person who made a conceptual contribution to the invention | A person who assisted in reduction to practice or making of the invention |
| List in online disclosure as Disclosure Researchers           | List in online disclosure as Disclosure Researchers                        | List in online disclosure as Disclosure Researchers          |   |