

Clarifying the Muddy Metaphysics of Joint Inventorship

Nartron Corp. v. Schukra U.S.A. Inc, ___F.3d___, 2009 WL 539912 (Fed. Cir. Mar. 5, 2009)

Joint inventorship has been described as “one of muddiest concepts in the muddy metaphysics of the patent law.” *Mueller Brass Co. v. Reading Industries, Inc.*, 352 F.Supp. 1357, 1372 (E.D. Pa. 1972), *aff’d*, 487 F.2d 1395 (3d Cir. 1973). Recently, in *Nartron Corp. v. Schukra U.S.A. Inc*, ___F.3d___, 2009 WL 539912 (Fed. Cir. Mar. 5, 2009), the Federal Circuit had the chance to clarify the contribution required for a person to be a named a joint or co-inventor.

In 1996, Schukra contracted with Nartron to design a control system for a vehicle seat that provides massage capabilities. By 2000, Nartron patented the control system. In 2006, Nartron sued Borg Indak, a supplier of electronic parts to Schukra, for infringement of Nartron’s control system patent. In its original motion for summary judgment of dismissal, Borg Indak claimed that Benson, a Schukra employee, was a co-inventor of a dependent claim of the control system patent and, therefore, was a necessary plaintiff that must to be joined in the suit. The dependent claim of interest was directed to an extender for the lumbar support adjustor on the control module. The district court determined Benson was a joint inventor by his conception of the dependent claim and granted summary judgment for Schukra and Borg Indak.

On appeal, Nartron argued that Benson’s contribution was insignificant not rising to the level to be a co-inventor. At oral argument the named inventors admitted they did not invent the extender. Benson claimed he gave the idea to Nartron, but acknowledged that the idea for the extender was in the prior art. Borg Indak argued, *inter alia*, that Benson’s contribution could not be insignificant just because it appears in a dependent claim. In ruling for Nartron on this issue, the Federal Circuit relied on the rule in *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir. 1998), which provides that “[o]ne who simply provides the inventor with well-known principles or explains the state of the art without ever having a firm and definite idea of the claimed combination as a whole does not qualify as a joint inventor.” (internal quotations and citations omitted). Further, the court relied on *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998), which states that one must “contribute in some significant manner to the conception or reduction to practice of the invention” and “make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.”

The court found the following facts determinative that Benson’s contribution was insignificant. First, Benson’s idea was in the prior art. Second, his idea was already part of existing automobile seats such that its inclusion in the patent was nothing more than the basic exercise of ordinary skill in the art. Third, the patent specification, which mentioned the extender only one time, focused on the control system and not the structure of a vehicle seat. Based on these facts, the court concluded that Benson’s contribution was insignificant when measured against the full

dimension of the invention, not rising to the level of co-inventorship. The court pointed out that even though Benson alone provided the feature of the dependent claim, the invention of a dependent claim includes all of the features of the parent claims. In this instance, without contribution to the parent claims, Benson could not become a co-inventor by merely providing the sole feature of a dependent claim.

Further on appeal, Borg Indak argued that Benson was a co-inventor of the parent claims since he suggested the utility of a control module with certain specifications and functions. In response to this argument, the Federal Circuit relied on the well-established rule as stated in *Garrett Corp. v. U.S.*, 422 F.2d 874, 881 (Ct. Cl. 1970), that “one who merely suggests an idea of a result to be accomplished, rather than means of accomplishing it, is not a joint inventor.” Accordingly, Benson was not a co-inventor of the parent claims either.

This decision provides some guidance in the murky world of joint inventorship. *Nartron* shows that suggesting a feature that is within the prior art may be deemed an insufficient contribution for inventorship, particularly when the suggestion is the subject matter of a dependent claim and incidental to the invention defined in the parent claims. *Nartron* also emphasizes that the contributions of a putative inventor must be measured against the full dimension of the claimed invention. While the facts of each case will invariably differ, *Nartron* highlights a number of factors useful for determining co-inventorship.