

I. AN INVENTOR MUST CONTRIBUTE TO THE CONCEPTION OF THE CLAIMED INVENTION

The threshold question in determining inventorship is who conceived the claimed invention. Unless a person contributes to the conception of the invention, he is not an inventor. Insofar as defining an inventor is concerned, reduction to practice, *per se*, is irrelevant.

Multiple inventors should be named in a patent application if each contributed to the conception of the invention as set forth in at least one of the claims in the application. Because inventorship is claim-dependent, it can change during prosecution of an application when a claim is amended, added, or cancelled, requiring the list of named inventors to be adjusted.

II. AS LONG AS THE INVENTOR MAINTAINS INTELLECTUAL DOMINATION OVER MAKING THE INVENTION, IDEAS, SUGGESTIONS, AND MATERIALS MAY BE ADOPTED FROM OTHERS

In arriving at conception of the invention, the inventor may consider and adopt ideas and materials derived from many sources [such as] a suggestion from an employee, or hired consultant, so long as he maintains intellectual domination of the work of making the invention down to the successful testing, selecting or rejecting as he goes, even if such suggestion or material proves to be the key that unlocks his problem.

III. THE INVENTOR IS NOT REQUIRED TO REDUCE THE INVENTION TO PRACTICE

Difficulties arise in separating members of a team effort, where each member of the team has contributed something, into those members that actually contributed to the conception of the invention, such as the physical structure or operative steps, from those members that merely acted under the direction and supervision of the conceivers. However, it is not essential for the inventor to be personally involved in carrying out process steps, where implementation of those steps does not require the exercise of inventive skill. In particular, there is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his

IV. REQUIREMENTS FOR JOINT INVENTORSHIP

The inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named inventors. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

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.