



Inventorship Considerations in Omnibus Patent Applications

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Last week, Ericsson announced that it had filed a “landmark” patent application that covers a “complete architecture for the 5G network standard.”

Dr. Stefan Parkvall, Principal Researcher at Ericsson, says the patent application contains “everything you need to build a complete 5G network. From devices, the overall network architecture, the nodes in the network, methods and algorithms, but also shows how to connect all this together into one fully functioning network. The inventions in this application will have a huge impact on industry and society: they will provide low latency with high performance and capacity. This will enable new use cases like the Internet of Things, connected factories and self-driving cars.”¹ Dr. Parkvall also brags that it is the “largest application in terms of inventors in the cellular industry ever.” Details of the application are scant at this time, but Ericsson has said that it includes 130 inventors and over 400 pages².

Patent prosecutors across the country likely trembled at the mention of 130 inventors in a single application, and for good reason. An application must include, or be amended to include, the name of the inventor for any invention claimed in the application³. In some cases, errors in inventorship may render a patent unenforceable⁴. With 130 inventors, the chance of error increases dramatically.

Thankfully, the Leahy-Smith America Invents Act (AIA) eases some of the pain of dealing with a large number of inventors. Correcting inventorship under the old law (i.e., for patent applications filed before March 16, 2013) was extremely cumbersome. The AIA streamlines this process and allows addition or removal of inventors from an application without requiring an explanation for the change. This amendment notwithstanding, there are a number of reasons to avoid filing an omnibus patent application with such a large number of inventors.

Claim Analysis

Correcting inventorship in a provisional application is not difficult as inventorship reflects the subject matter of the entire specification. When a non-provisional application is filed, however, the patent practitioner must consider the claims to ascertain the proper inventorship. Thus, for each claim of Ericsson’s application, an analysis must be made to determine who in-fact

¹ <https://www.ericsson.com/en/news/2017/11/ericsson-files-landmark-5g-patent-application>

² *Id.*

³ 37 C.F.R. 1.41(a)

⁴ *PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315 (Fed. Cir. 2000); *Univ. of West Virginia v. Van Voorhies*, 278 F.3d 1288, 1302 (Fed. Cir. 2002) (explaining that an “innocent inventor may not enforce a patent that has been tainted by inequitable conduct.”)

contributed to the subject matter of that claim. This is no simple task, and will require extremely detailed records on the specific contributions of each inventor. Moreover, during prosecution, this analysis will have to be revisited each time a claim is cancelled, added, or amended to ensure that the proper personnel are listed. To complicate the matter, it is almost certain that this application will spawn tens of continuation and divisional applications. The inventorship analysis will have to be conducted in each of those applications as well, upon filing and throughout prosecution. The logistics are not simple, and will only be complicated if the inventors collaborated across subject matters, or if the application is not neatly divided into discrete sections. Device, method and system claims will each present their own unique challenges.

Declarations

The AIA also relaxes some of the rules surrounding declarations. For example, executed declarations may now be submitted at any point prior to allowance. Such a large number of inventors, however, will take a herculean effort by attorneys and staff to collect the signatures of all inventors. Practitioners know that such efforts are hardly painless. Under a first to invent system, collecting signatures before filing would likely delay the filing of the application. However, waiting to collect signatures until after filing and not having a known deadline for filing the declarations will result in stragglers and most likely a mad dash near the end of prosecution. Additionally, issues of deceased, incapacitated, missing or uncooperative inventors will surface. The AIA makes these issues easier to deal with, but not entirely painless.

Assignments

The omnibus application requires extreme diligence and care when handling assignments and reviewing employment agreements. It may also require a great deal of research into foreign and state laws and how these will affect the different employment agreements. For example, some jurisdictions, such as Germany, allow for inventors' rights that are secured at the time of filing in the absence of an express assignment before the filing of an application. Having 130 fully cooperative inventors would be ideal, but unlikely, and even full cooperation by all inventors will require great attention to detail.

These issues are only the tip of the iceberg when considering an application with such a large number of inventors. The attorneys at Ericsson likely recognized these issues and planned for them, painstakingly documenting the details of this application. Practitioners should be extremely careful not to follow suit with this practice without taking the appropriate precautions, and should understand that the circumstances that require such an approach are rare indeed. In most cases, it would be prudent to break the disclosure into different applications and tackle the task piecemeal.

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