

Inventorship Mystery Dinner Theater
Group 2 Presentation, January 23, 2018
FACT SCENARIO

Widget Inc. (“WI”) is suing Gizmo Inc. (“GI”) for infringement of the ‘100 patent. Your client WI asks you to investigate whether WI’s ‘100 patent has an inventorship problem and, if so, whether it can be fixed.

The ‘100 patent has:

- (1) broad claims that cover widgets with caps and mounting brackets,
- (2) narrower claims that cover widgets with *threaded* caps and mounting brackets *with arms*, and
- (3) narrowest claims that cover widgets with *threaded* caps and mounting brackets *with top and bottom arms*.

The patent describes a single embodiment - a widget with a *threaded* cap and mounting bracket *with side, top and bottom arms*. The specification includes test results showing improved performance for the preferred embodiment as compared to conventional widgets that do not have caps and mounting brackets. Your preliminary investigation reveals that the test results reported in the specification are for a prototype with *top and bottom arms*, and do not necessarily reflect results for other arm arrangements.

The prosecution history includes arguments over obviousness rejections based on gizmo prior art. In order to obtain allowance of the patent claims, WI argued that the test results in the specification established that the claimed combinations for widgets resulted in substantially superior performance as compared to caps and mounting brackets used on prior art gizmos. In other words, WI claims to be the first to discover that combining caps and mounting brackets on widgets would produce unexpected improvements.

WI filed a *provisional* patent application that named Col. Markman as a sole inventor. It describes subject matter supporting the broad claims (category 1) above, but not the narrower claim sets (categories 2 and 3). After the provisional patent application was filed, an invention disclosure was prepared and signed by Dr. Daubert, M. Curie and TC Heartland. The ‘100 patent combines the subject matters of both Col. Markman’s provisional patent application and the

Daubert/Curie/Heartland invention disclosure. It claims priority based on the provisional patent application and names Col. Markman and Dr. Daubert as co-inventors, but not M. Currie or TC Heartland. WI has a bonus program in which inventors are paid \$1000 for submitting an invention disclosure and \$5000 for being named a co-inventor on a patent application.

GI is a well-known innovator in the gizmo industry, and holds several patents on variations of gizmos with caps and mounting brackets. GI originally sold only gizmos, but after seeing the success of WI's patented Super Duper Widget (SDW) it decided to enter the widget market. GI's accused product is a widget with *threaded* cap and a mounting bracket *with side arms*. It does not have **top and bottom arms**, and WI does not assert that any of the category 3 claims are infringed.

GI contends that it is a rightful co-owner of the '100 patent because Col. Markman first conceived of the idea when he worked at GI, but later communicated the same idea to WI. GI produced a drawing dated in 2005 that was purportedly created by Col. Markman and, according to GI, shows a widget with cap and mounting bracket. GI also claims that the '100 patent claims are invalid as mere obvious variations of prior art, patented commercial gizmos.

The WI General Counsel asks you to interview the following five witnesses:

(1) **Col. Markman**, a WI senior engineer who previously worked for GI and may have provided a starting point for WI's R&D project. He is a named inventor on GI's patents and co-inventor on the '100 patent.

(2) **Dr. Daubert**, a senior engineer who is named as a co-inventor on the '100 patent.

(3) **M. Curie**, a former WI junior engineer who worked with Dr. Daubert on the project.

(4) **TC Heartland**, a computer simulation engineer who worked with Dr. Daubert and M. Curie to create CAD images and computer simulations of the design.

(5) **J. Lemelson**, WI's patent attorney who wrote, filed and prosecuted the '100 patent.