

## Background

Determining inventorship can be challenging, especially when the invention emerges from a research group. There is not much Norwegian case law<sup>1</sup> concerning this topic, but it is clear that inventorship needs to be evaluated case by case. However, the following is believed to capture the essence of inventorship determination or at least help in the evaluation.

The criteria for determining inventorship are quite different from the criteria for determining authorship of a scientific publication. Unlike authorship, inventorship is not intended to give credit to everyone contributing in a project<sup>2</sup>, but is intended to identify who has provided actual and qualified intellectual contributions leading to an invention.

## Inventive contribution

The patent application<sup>3</sup> shall contain a definition of the invention to be protected by a patent, i.e. the patent claims. It follows that determining inventorship is answering the question: who invented the subject matter of the claims.

To make a patentable invention, two steps are usually required:

- 1) **Conception of the technical solution** of a problem, and subsequently
- 2) **Reduction of the technical solution to practice**- the physical making of the invention and demonstrating that it works for its purpose

Only persons conceiving the subject matter of at least one claim of the patent/patent application are considered to be inventors, i.e. persons performing step 1). In other words, independent intellectual contribution to the invention is required in order to qualify as inventor<sup>4</sup>. Intellectual contribution involving conception of a single patent claim is enough.

Notably, also two or more persons conceiving the invention through aggregate intellectual efforts can be considered joint inventors. Inventorship is binary in nature (yes/no), thus no ranking is conferred by the listing of inventors on a patent/patent application.

## Other contributions

In many innovation projects, important contributions may come from other persons than the inventors. However, persons whose contribution merely concerns reduction to practice, i.e. persons performing only step 2), will not be considered to be inventors. In addition, merely performing routine experiments according to instructions, being a manager/supervisor, securing funding, discovering a problem i.e. without providing a solution, or defining a desired result without the means for achieving it, will **not** be sufficient for inventorship. If inventors have a wish to recognize important and valuable contribution from non-inventor project members/collaborators, this must be done by other means than listing them erroneously as inventors. For example, a separate agreement can be made between inventors and the other contributors sharing the rewards in case of commercial success, or listing such persons as authors in a later scientific paper.

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<sup>1</sup> A relevant Norwegian case under appeal is scheduled for a trial late 2019.

<sup>2</sup> See for example the difference between inventors on [WO2012168820A1](#) (Pfizer) and the authors of the companion paper [J Med Chem. 2013 Jun 27;56\(12\):5079-93](#).

<sup>3</sup> The inventor shall be identified by name in the patent application (see [Patentloven § 8](#)).

<sup>4</sup> "The threshold question in determining inventorship is who conceived the 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 [except for simultaneous conception and reduction to practice, *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993)].