

Background

Determining inventorship can be challenging, especially when the invention emerges from a research group.

Inventorship needs to be evaluated case by case, and one needs a precise definition of a patentable invention in order to perform a sensible inventorship determination.

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 project¹. Inventors listed on a patent are the persons who have conceived the invention as defined by the patent claims.

The following is an attempt to capture the essence of inventorship determination or at least help in the evaluation.

There is not much Norwegian case law concerning this topic, but a decision² from Borgarting Lagmannsrett dated 17. December 2019 gives some guidance reflected below.

Who are inventors?

The patent application shall contain a definition of the invention to be protected by a patent, i.e. the patent claims³. It follows that determining inventorship is answering the question: who invented the subject matter defined by the claims.

Two steps are required to possess a patentable invention:

- 1) **Conception of a technical solution** to a problem, and subsequently or simultaneously
- 2) **Realization of the invention** (also known as “reduction to practice”)

Only persons conceiving the subject matter of at least one claim in the patent/patent application are considered to be inventors, i.e. persons performing step 1). Intellectual contribution involving conception of single patent claim is enough to qualify as inventor.

As phrased by the US Court of Appeals for the Federal Circuit 28. August 2020 ([link here](#)), inventorship is a legal conclusion premised on underlying factual findings, and one that depends on claim interpretation. Like validity of patents, inventorship is determined claim-by-claim. Accordingly, who should be listed on the face of a patent may vary depending on what, exactly, is claimed and what, exactly, a court deciding a legal dispute later may determine the claim scope to be.

Note that two or more persons conceiving an invention together through aggregated intellectual contributions are considered joint inventors. Inventorship is binary in nature (yes/no), thus the listing of inventors on a patent/patent application does not express any qualitative ranking.

The patent claims in a patent application often differ from the claims in a granted patent. Accordingly, the inventorship may also differ between a patent application and the resulting patent.

¹ 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.](#)

² 18-077812ASD-BORG/02

³ see [Patentloven § 8.](#)

Other contributions

In many innovation projects, important contributions may come from other persons than the inventors.

However, persons whose contribution **exclusively** concerns **realization** (i.e. only performing step 2), will not be inventors.

Thus, **exclusively**

- 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 the true inventors have a wish to recognize important and valuable contribution from non-inventor project members, 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. Such persons may of course be listed as authors of a pertaining scientific paper.