PATTON BOGGS LLP

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Federal Circuit Confirms Time-Bar on Patent Inventorship Suits

Intellectual Property Client Alert

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In a ruling of first impression, the Federal Circuit found that the six-year period plaintiffs have to file a patent inventorship suit does not begin to run until the patent issues. *Hor v. Chu*, No. 2011-1540 (Fed. Cir. Nov. 14, 2012).

Plaintiffs filed a suit under Section 256 of the Patent Act, which creates a cause of action to correct inventorship "whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent." Specifically, plaintiffs filed suit in 2008 and 2010 claiming that two patents on superconductive compounds that were issued in 2006 and 2010 failed to list them as joint inventors of the patents. The District Court dismissed the suit as being time-barred, holding that plaintiffs knew or should have known in the mid-1980s that they were not named as inventors on the patent applications.

The Federal Circuit reversed, finding that the six-year period plaintiffs have to file an inventorship suit that runs from the date the Patent and Trademark Office issues the patent, not from when the omitted inventors knew or should have known prior to issuance that their names were omitted from the application. The Court held that this holding is "what the language of the provision requires," further stating that "[i]n many cases, an omitted inventor may not know whether he or she has a cognizable inventorship claim until the examination concludes and the patent finally issues."

This decision is a win for inventors whose inventorship claims under Section 256 will not be time-barred based on knowledge they had or should have had well before a patent issues.

The *Hor* opinion may be found here.

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