

Drone Technologies v. Parrot: Inventorship

Today in *Drone Technologies, Inc. v. Parrot S.A.*, ___ F.3d ___ (Fed. Cir. 2016)(Newman, J., concurring), in a case involving a multitude of issues, the senior member of the panel called attention to the issue of inventorship as a substantive requirement of a patent case.

An excerpt from her opinion is attached to the pdf version of this note.

Regards,
Hal

From the Opinion: “[T]he named sole inventor, Ms. Yu-Tuan Lee, testified that, ‘I came up with this idea about having the aircraft move following the motion of the remote controller,’ but when asked whether she knew ‘how to make that idea work,’ Ms. Lee answered, ‘I only came up with the ideas, and subsequently Bruce told me that there was such a chip that could detect movement.’”

“Precedent provides that ‘[o]ne who merely suggests an idea of a result to be accomplished, rather than means of accomplishing it, is not a joint inventor.’ *Nartron Corp. v. Schukra U.S.A. Inc.*, 558 F.3d 1352, 1359 (Fed. Cir. 2009) (alteration in original).

“ * * * Inventorship affects not only the validity of the patent, but also ownership and transfer of ownership. *See Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248 (Fed. Cir. 1993) (‘At the heart of any ownership analysis lies the question of who first invented the subject matter at issue, because the patent right initially vests in the inventor who may then, barring any restrictions to the contrary, transfer that right to another, and so forth.’). There is no right to sue on patents one does not own. *See Bd. of Trs. of Leland Stanford Junior Univ. v. Roche Molecular Sys.*, 583 F.3d 832, 839 (Fed. Cir. 2009), *aff’d*, 563 U.S. 776 (2011) (absence of ownership can be raised ‘as a defense and a challenge to [the plaintiff’s] standing to maintain its action against [the defendant].’). An incorrect inventor or inventive entity cannot pass title by assignment, because that entity has no title to pass.”
[Internal citation omitted; original emphasis]