



Chou V Univ of Chi & Arch Dev Corp.
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Case Facts

Chou appeals from the district's court decision of granting defendant's motion for dismissing her declaratory judgment of inventorship, fraud, breach of fiduciary duty unjust enrichment etc. Dr. Chou is a graduate student for Dr. Roiznan at the Univ of Chicago's department of molecular genetics and cell biology. Dr. Roiznan is named as sole patentee of '688 , '713 and '328 whos ownership is disputed. Chou allegedly told Roizman that her discoveries should be patented and he allegedly disagreed. At that time already Roizman had filed for '688 patent directed to the same disputed invention. Roizman had assigned the '688 patent application to Institut Merieux. Later in 1993, Roizman and Chou signed an agreement to share royalties for the pending patent applications to exploit the properties of herpes simplex virus. At that time the '688 patent application was also pending which was not known to Chou. In 1996, Roizman asked Chou to resign as she would be in a stronger position to contest his inventorship if she stays in the University. In 1999 Chou sued the University, Roizman and others for correction of inventorship. The district court dismissed all her claims and the matter was appealed.

Issue

Whether a putative inventor (Chou) who lacks potential ownership interest in a patent, has standing to sue ? (Question of law: de novo)

Holding

Yes, the appellate court, reversing district court's judgment held that Chou has standing to correct her inventorship.

Rule

35 USC Sec 256 says that the error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected. The court before which such matter is called in question may order correction of the patent on notice and hearing of all the parties.

Analysis

Defendants contended that Chou was obligated to assign her inventions to the Univ by virtue of accepting employment under the Univ's administrative policies and therefore she has no standing to sue for correction of inventorship. The court finds that though Chou did not enter into a separate contract with the Univ for assignment of inventions, she was obligated to do it as Chou's letter of appointment stated that appointment was subject to the administrative policies of the university. Moreover she did not dispute her obligation when she assigned to the univ other inventions in which she was a recognized inventor. This obligation itself does not defeat Chou's standing to sue for corrective inventorship.

The court held that expectation of ownership of a patent is not a prerequisite for a putative inventor to possess standing to sue for corrective inventorship. The statute requires no such condition and Sec 256 should be broadly interpreted. Chou should have right to assert her interest, both for her own benefit and in the public interest of assuring correct inventorship designations on patents. The court further says that Chou both has reputational as well as pecuniary interest in correcting the inventorship.