IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Patent Application Document

NAME OF INVENTOR: Inventor X
TITLE OF INVENTION:

FILING DATE: EXAMINER:
SERIAL NO.: CLASS (Preliminary): 364

ATTY DOCKET NO.
****

PETITION TO CORRECT INVENTORSHIP UNDER 37 CFR 1.48

This petition seeks to add Dr. Y as an inventor to application Serial No. _____, filed _____(Date). The application is entitled "_____" and Inventor X is presently the sole named inventor. The following items are included with this petition:

- A declaration by Inventor X, as required by 37 CFR 1.48.
- An oath or declaration by each actual inventor as required by 37 CFR 63.
- Two copies of an authorization for charging Deposit Account _____ for the fee for this petition required under 37 CFR 1.17.
- The written consent of the assignee in this case. A copy of the assignment, from Inventor X to the US Government, is also enclosed. No other assignments presently exist in the case.

DISCUSSION

The invention, as defined by the application's claims 1 and 6, is ...(brief description of invention).

As shown by Inventor X's affidavit, it was Dr. Y's idea both to (include description of Dr. Y's contributions to the claimed

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invention). Hence, Dr. Y should be added as an inventor in the application.

Dr. Y also conceived ... (more description of Dr Y's contributions to the invention as claimed). For this added reason, Dr. Y should be added as an inventor to the application.

It should be noted that Inventor X's ideas and work still contribute to the subject matter of the claims. First, as noted above, ... Inventor X contributed to ... (description of Inventor X's contributions to the invention as claimed).

As shown by Inventor X's declaration, it is customary academic practice for a doctoral student to be considered the primary investigator on his or her doctoral thesis. This led Inventor X to believe he was the inventor of the subject matter of his thesis. Inventor X's declaration also shows that he spent an estimated minimum of 3000 man-hours on his doctoral thesis over a period of two years. His extensive work on his thesis reinforced his belief that he would be considered the inventor of methods developed by the thesis.

As Inventor X's declaration states, the application in this case filed with him as sole inventor through error and without deceptive intent on his part. At the time the application was filed, Inventor X was not aware of the legal significance of Dr. Y's contributions. He learned of this legal significance in

January of 1997. Shortly afterward, preparation of this petition began.

In summary, Dr. Y's contribution to the invention are such that he should be named a co-inventor. Inventor X's being named as sole inventor on the patent application was a result of innocent error. Therefore, the petition to add Dr. Y as an inventor in the application should be granted.

Respectfully submitted,

Peter A. Taucher, Gail S. Soderling, David L. Kuhn
ATTORNEYS OF RECORD
US Army Tank-Automotive Command

AC 313-574-5681
AV 786-5681

By_____
DAVID L. KUHN

CERTIFICATE OF MAILING

Date_____

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231 on or before _____.

_____
DAVID L. KUHN
Reg. No. 30,957

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DECLARATION IN SUPPORT OF PETITION UNDER 37 CFR 1.48

I, Inventor X, declare as follows:

I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both under 18 U.S.C. 1001 and may jeopardize the validity of the application or any patent issuing thereon.

All statements made of my own knowledge are true and all statements based on information and belief are believed to be true.

I am presently employed by the US Army Tank-Automotive and Armaments Command (TACOM) as a scientist at the TACOM Research and Engineering Center (TARDEC). I have been involved with _____ (Description of Inventor X's research duties)

I am now the sole named inventor for the patent application having serial number _____ filed _____ entitled, "_____" I have assigned my rights to the patent application and its underlying invention to the Government of the United States. When the application was filed in the United States Patent and Trademark Office, I believed that I was the sole inventer of the invention.

The invention was conceived in the course of my work on my doctoral thesis, entitled, "----------." It is the

customary academic practice for a doctoral student to be deemed the principle investigator of his or her doctoral thesis. Accordingly, I considered myself to be the principle investigator on my thesis. Since I was the principle investigator, I believed that was the inventor of subject matter in the thesis. Additionally, I estimate that I spent at least 3000 man-hours on my doctoral thesis over a period of two years. My extensive work on the thesis reinforced my belief that I was the inventor of its contents.

An advisor for my doctoral thesis was Dr. Y, a professor at _____ University in _____ (city). Some time after the patent application was filed, I began reconsidering the input Dr. Y gave me in my doctoral thesis; as a result I began to wonder whether Dr. Y should be deemed an inventor on the application. I was not then aware of the legal significance of Dr. Y's contributions noted below. I subsequently received legal advice concerning the significance of Dr. Y's contributions.

[Insert a paragraph discussing of the claims' elements, and what each inventor contributed to each claim element.]

I now know the legal significance of Dr. Y's contributions and believe that Dr. Y is a co-inventor of the invention. The application was filed with me named as sole inventor through error and without deceptive intent on my part. I now desire, and believe it appropriate, to include Dr. Y as an inventor on the application.

_____ _____

Inventor X Date

DEPARTMENT OF THE ARMY
UNITED STATES ARMY TANK-AUTOMOTIVE AND ARMAMENTS COMMAND
WARREN, MICHIGAN 48397-5000

REPLY TO
ATTENTION OF

AMSTA-CS-LP

March 5, 1997

MEMORANDUM THRU DEPARTMENT OF THE ARMY, Office of the Judge Advocate General, Intellectual Property Law Division, ATTN: JALS-IP (Mr. Earl T. Reichart, Acting Chief) 901 North Stuart Street, Suite 700, Arlington, VA 22203-1837

FOR The Assistant Secretary of the Army for Research Development and Acquisition, ATTN: SARDA (The Honorable Gilbert F. Decker) 103 Army Pentagon, Room 2E672, Washington, D.C. 20310-0103

SUBJECT: Request for Consent to Correction of Inventorship on a US Army Patent Application

1. Purpose. This request concerns a patent application filed in the US Patent and Trademark Office (USPTO) by the US Army Tank-Automotive and Armaments Command (TACOM). We seek your written consent to add an inventor to the patent application.

2. Background.

a. Particulars of the application. The application is entitled "----------." Inventor X, a TACOM scientist, signed the application as the sole inventor and assigned his rights thereto to the US Government. The application was filed in the USPTO on (Date), and received Serial No. _____.

b. Description of the invention. The invention is ...(Short description of the invention) Attached is a copy of the patent application, which describes the invention in detail.

3. Reason for Request. After the application was filed, we learned of a second inventor, Dr. Y, a professor at _____ University at (city). This is a problem since US law (35 USC 116) requires that all inventors sign a patent application. A USPTO regulation, 37 CFR 1.48, provides a way to add an inventor to a patent application. 37 CFR 1.48 requires an assignee of the invention to give written consent to corrections of inventorship. Per 1-6(c) of AR 27-60, Intellectual Property, you are the authority to give such consent. 1-6(c) states that the ASA(RD&A) can "Execute, on behalf of the Army, documents relating to change of inventors in an application pending before the USPTO." Hence, we need your written consent to add Dr. Y as an inventor to the application.

4. Key issue. The key issue here is whether both Inventor X and Dr. Y are inventors. Relevant to this issue is 37 CFR 1.45(c), which states "...each named inventor must have made a contribution, individually or jointly to the subject matter of at least one claim of the application..." Based on the facts below, we have concluded that both Inventor X and Dr. Y made contributions to subject matter of claims of the application. Consequently, they both are inventors in the application.

a. Dr. Y. (Here, describe Dr. Y's contibutions to each element in the affected claims of the patent application,)

b. Inventor X. As noted above, Inventor X participated in formulating a new way to determine ... (Here, list Inventor X's contributions to each of the relevant claims of the patent application.)

5. Advisement of issue under 37 CFR 1.48. In order to correct inventorship under 37 CFR 1.48, the failure to name Dr. Y as an inventor must have been the result of "error without deceptive intent." The attached petition to correct inventorship addresses that issue as follows: Inventor X was unaware of the legal ramifications of Dr. Y's contributions. At the time the application was filed, Inventor X believed that his authorship of his doctoral thesis meant that he should be the inventor in a patent application based on the thesis. This was consistent with customary academic practice in which a doctoral student is deemed the principle investigator of his or her doctoral thesis. Hence, Inventor X's signature as sole inventor on the application was an innocent error.

6. Consequences. If the requested consent is obtained, the petition to correct inventorship succeeds and the application is allowed, then TACOM will share ownership of the patent with either Dr. Y or _____ University. However, without the consent, the petition will fail and TACOM will be unable to obtain any patent. The application relates to ....; if no patent is obtained, TACOM's leadership in this technical area will suffer. Also, based on TACOM's expertise in this area, TACOM has a Cooperative Research and Development Agreement (CRDA) with Z Corporation (Z), in which Z is studying... (description of Z's research under the CRDA). Without the requested consent, TACOM's position vis-a-vis Z to negotiate future similar CRDAs may be degraded.

7. Diligence. 37 CFR 1.48 requires diligence in amending applications to correct inventorship. By extension, diligence in obtaining consent from the assignee is required. Therefore we ask that priority be given to this request for consent to correct inventorship.

8. Further information. For your reference, a copy of the petition

to correct inventorship is attached, as is Inventor X's declaration in support of the petition. A copy of the patent application is also enclosed. TACOM's POC is David Kuhn, AMSTA-LP, DSN 786-5681.

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DAVID L. KUHN
Patent Attorney