

# ***Hey—You Stole My Invention!***

**Avoiding ethical pitfalls in determining inventorship and authorship and honoring non-disclosure agreement obligations**

**Justin Krieger**

**April 2, 2017**



# Inventorship vs. Authorship

- Inventorship

- The individual(s) who “conceived” of an invention
  - E.g., in a patent
- Patent ownership initially vests in the inventors
- Patent provides right to exclude others from making, using, selling, offering for sale or importing invention
- Focus: patent claims
- Order of names legally irrelevant
- Improper designation can render patent **unenforceable**

- Authorship

- The originator(s) of any written work, e.g., in scholarly article
  - Requires a “significant scientific contribution”
- Copyright ownership initially vests in authors and provides exclusive right to produce or distribute the work
- Reputational benefit
- Focus: entire document
- Order of names can be significant
- Improper designation could lead to serious **reputational damage**

Improper attribution can have severe consequences

# Types of Attribution Abuse

- Coercive authorship/inventorship
  - Improper attribution based on seniority/leadership/reputation
- Honorary/Gift authorship/inventorship
  - Improper attribution based on reputation or friendship
- Ghost authorship/inventorship
  - Failing to name an individual who should properly be named as an author/inventor
- Fraudulent authorship/inventorship
  - Improperly claiming another's work as your own

# Inventorship

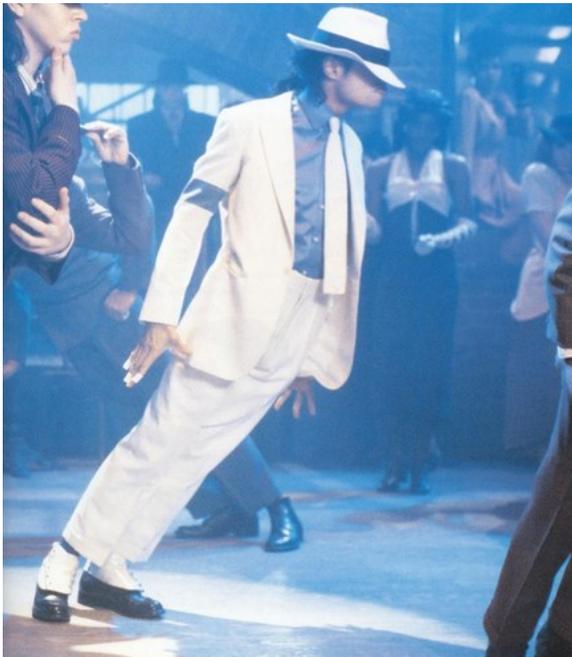
- **Under US Law, Inventorship requires:**
  - Conception
    - when an idea is sufficiently permanent and definite to permit one of ordinary skill in the relevant field to reduce it to practice without undue experimentation
    - Must include every feature claimed in the patent
  - Reduction to Practice
    - Making a working example of the claimed invention
    - Filing of a patent application constitutes “constructive” reduction to practice

Invention typically refers to conception

# Inventorship: Example

Method and Means for  
Creating Anti-Gravity Illusion

US Pat. No. 5,255,452  
to Jackson et al.



US005255452A

**United States Patent** [19] [11] **Patent Number:** 5,255,452

**Jackson et al.** [45] **Date of Patent:** Oct. 26, 1993

[54] **METHOD AND MEANS FOR CREATING ANTI-GRAVITY ILLUSION** 3,889,399 6/1975 Emrich ..... 36/1  
4,445,287 5/1984 Garcia ..... 36/114  
4,538,480 9/1985 Trindle ..... 36/131  
4,645,466 2/1987 Ellis ..... 36/132  
4,762,019 8/1988 Beyl ..... 36/131  
4,882,858 11/1989 Signori ..... 36/131  
5,042,173 8/1991 Blizzard et al. .... 36/113

[75] **Inventors:** Michael J. Jackson, Los Angeles;  
Michael L. Bush; Dennis Tompkins,  
both of Hollywood, Calif.

[73] **Assignee:** Triumph International, Inc., Los  
Angeles, Calif.

[21] **Appl. No.:** 905,479

[22] **Filed:** Jun. 29, 1992

[51] **Int. Cl.<sup>5</sup>** ..... A43B 5/00; A43B 3/00

[52] **U.S. Cl.** ..... 36/113; 36/1;  
36/136; 36/80; 36/132

[58] **Field of Search** ..... 36/1, 80, 103, 113,  
36/114, 131, 132, 136; 482/70, 71, 105

[56] **References Cited**

U.S. PATENT DOCUMENTS

1,059,284 4/1913 Dennis ..... 36/114  
2,114,790 4/1938 Venables ..... 36/132  
2,473,099 6/1949 Hatch ..... 36/1

*Primary Examiner*—Steven N. Meyers  
*Assistant Examiner*—M. Denise Patterson  
*Attorney, Agent, or Firm*—Drucker & Sommers

[57] **ABSTRACT**

A system for allowing a shoe wearer to lean forwardly beyond his center of gravity by virtue of wearing a specially designed pair of shoes which will engage with a hitch member projectable through a stage surface. The shoes have a specially designed heel slot which can be detachably engaged with the hitch member by simply sliding the shoe wearer's foot forward, thereby engaging with the hitch member.

**13 Claims, 4 Drawing Sheets**

# Inventors

Method and Means for Creating Anti-Gravity Illusion  
 US Pat. No. 5,255,452  
 to Jackson et al.



## United States Patent [19]

Jackson et al.



US005255452A

[11] Patent Number: **5,255,452**

[45] Date of Patent: **Oct. 26, 1993**

[54] **METHOD AND MEANS FOR CREATING ANTI-GRAVITY ILLUSION**

[75] Inventors: **Michael J. Jackson, Los Angeles; Michael L. Bush; Dennis Tompkins, both of Hollywood, Calif.**

[73] Assignee: **Triumph International, Inc., Los Angeles, Calif.**

[21] Appl. No.: **905,479**

[22] Filed: **Jun. 29, 1992**

[51] Int. Cl.<sup>5</sup> ..... **A43B 5/00; A43B 3/00**

[52] U.S. Cl. .... **36/113; 36/1; 36/136; 36/80; 36/132**

[58] Field of Search ..... **36/1, 80, 103, 113, 36/114, 131, 132, 136; 482/70, 71, 105**

[56] **References Cited**

**U.S. PATENT DOCUMENTS**

1,059,284	4/1913	Dennis	36/114
2,114,790	4/1938	Venables	36/132
2,473,099	6/1949	Hatch	36/1

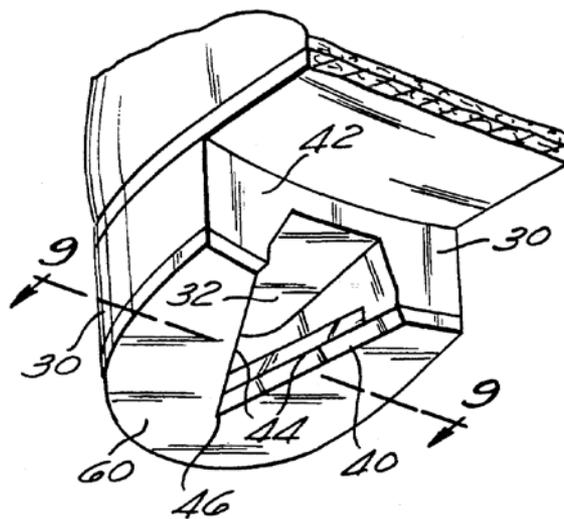
3,889,399	6/1975	Emrich	36/1
4,445,287	5/1984	Garcia	36/114
4,538,480	9/1985	Trindle	36/131
4,645,466	2/1987	Ellis	36/132
4,762,019	8/1988	Beyl	36/131
4,882,858	11/1989	Signori	36/131
5,042,173	8/1991	Blizzard et al.	36/113

*Primary Examiner*—Steven N. Meyers  
*Assistant Examiner*—M. Denise Patterson  
*Attorney, Agent, or Firm*—Drucker & Sommers

[57] **ABSTRACT**

A system for allowing a shoe wearer to lean forwardly beyond his center of gravity by virtue of wearing a specially designed pair of shoes which will engage with a hitch member movably projectable through a stage surface. The shoes have a specially designed heel slot which can be detachably engaged with the hitch member by simply sliding the shoe wearer's foot forward, thereby engaging with the hitch member.

**13 Claims, 4 Drawing Sheets**



US005255452A

[11] Patent Number: **5,255,452**

[45] Date of Patent: **Oct. 26, 1993**

3,889,399	6/1975	Emrich	36/1
4,445,287	5/1984	Garcia	36/114
4,538,480	9/1985	Trindle	36/131
4,645,466	2/1987	Ellis	36/132
4,762,019	8/1988	Beyl	36/131
4,882,858	11/1989	Signori	36/131
5,042,173	8/1991	Blizzard et al.	36/113

*Primary Examiner*—Steven N. Meyers  
*Assistant Examiner*—M. Denise Patterson  
*Attorney, Agent, or Firm*—Drucker & Sommers

**ABSTRACT**

System for allowing a shoe wearer to lean forwardly beyond his center of gravity by virtue of wearing a specially designed pair of shoes which will engage with a hitch member movably projectable through a stage surface. The shoes have a specially designed heel slot which can be detachably engaged with the hitch member by simply sliding the shoe wearer's foot forward, thereby engaging with the hitch member.

**13 Claims, 4 Drawing Sheets**



# It's all about the Claims!

- One or more authors of the patent application may not be inventors
- One or more inventors might not be co-authors

Referring to FIG. 34, the shoulder blades of hitches 34 should be spaced 14-20" apart. Such a distance is desirable during the leaning operation.

The drawings are intended to represent the details of the operation. In fact, it is intended that modifications may be made without departing from the spirit of the invention. Although specific terms are used, they are intended in a generic sense for the purpose of illustrating the invention.

being detracted in

I claim:

1. A system for engaging shoes with a hitch means to permit a person standing on a stage surface to lean forwardly beyond his or her center of gravity, comprising: at least one shoe having a heel with a first engagement means, said first engagement means comprising a recess formed in a heel of said shoe covered with a heel slot plate having a slot formed therein with a relatively wide opening at a leading edge of said heel and a narrower terminal end rearward of said leading edge, said recess being larger in size above said terminal end of said slot than in size below said terminal end of said slot; and a second engagement means, detachably engageable with said first engagement means, comprising a hitch member having an enlarged head portion connected by a narrower shank portion to a means for raising and lowering said head of said hitch member above and substantially level with or below said stage surface, said head portion being larger in size than said terminal end of said slot and said shank portion being narrower than said terminal end of said slot, wherein said hitch member can be moved through apertures in said stage surface between a projecting position raised above said stage surface and a retracted position at or below the stage surface, and when said head portion of said hitch member is raised above said stage surface, said first engagement means can be detachably engaged with said projecting hitch member, thereby allowing a person wearing the shoes to lean forwardly with his or her normal center of gravity beyond a front region of said shoes, and maintain said forward lean.

2. The system of claim 1, wherein said heel slot plate is V-shaped and said leading edge of said

1. A system for engaging shoes with a hitch means to permit a person standing on a stage surface to lean forwardly beyond his or her center of gravity, comprising: at least one shoe having a heel with a first engagement means, said first engagement means comprising a recess formed in a heel of said shoe covered with a heel slot plate having a slot formed therein with a relatively wide opening at a leading edge of said heel and a narrower terminal end rearward of said leading edge, said recess being larger in size above said terminal end of said slot than in size below said terminal end of said slot; and a second engagement means, detachably engageable with said first engagement means, comprising a hitch member having an enlarged head portion connected by a narrower shank portion to a means for raising and lowering said head of said hitch member above and substantially level with or below said stage surface, said head portion being larger in size than said terminal end of said slot and said shank portion being narrower than said terminal end of said slot, wherein said hitch member can be moved through apertures in said stage surface between a projecting position raised above said stage surface and a retracted position at or below the stage surface, and when said head portion of said hitch member is raised above said stage surface, said first engagement means can be detachably engaged with said projecting hitch member, thereby allowing a person wearing the shoes to lean forwardly with his or her normal center of gravity beyond a front region of said shoes, and maintain said forward lean.

# Joint Inventorship

- What does joint inventorship mean?
  - “For persons to be joint inventors..., there must be some element of joint behavior, such as collaboration or working under common direction...”

# What does not constitute invention?

- A technician who merely performs experiments at another's request
- Being a supervisor or manager
- Reducing the invention to practice through known means
- Identifying a problem without coming up with the solution to the problem
- Suggesting an obvious feature—even if it makes its way into a claim!

# Inventorship changes

- **During examination**
  - Claims are frequently added, deleted or amended
  - These changes may necessitate a change of inventorship
  - Inventorship changes are liberally permitted during examination
- **After grant**
  - If an inventorship error is not discovered until after a patent has granted, it can be changed by:
    - Certificate of correction
    - Reopening examination (reissue proceedings)
    - During litigation
  - Correction is unlikely if the original error was intentional (fraudulent).
    - Patent likely unenforceable

# Authorship

- **US Copyright Law**
  - “[T]he author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”
  - Author includes the employer in “Works Made for Hire”
- **This definition is separate from authorship as understood in scholarly articles**

Community for Creative Non-Violence v. Reid,  
490 U.S. 730, 737 (1989)

# ACS Authorship Guidelines

- **Co-Authorship**

- Includes all persons who have:
  - made **significant scientific contributions** to the work reported, and
  - who **share responsibility** and accountability for the results.
- Submitting author accepts the responsibility of having included all appropriate co-authors
- Submitting author should have sent each co-author a draft copy of the manuscript and have obtained the co-author's assent to co-authorship of it.

# Acknowledgement vs. Authorship

- **Contributions that do not qualify for Authorship but that should be Acknowledged**
  - Providing funding, technical advice, reagents, samples or data
  - Providing students or technical personnel who perform studies
  - Routine collection of data/experimentation
  - General supervision of the research group

# Ethical Obligations of Authors

- Provide accurate and complete account of the research performed
- When requested, provide data, methods and samples of unusual materials unavailable elsewhere
- Cite influential publications in determining the nature of the reported work.
  - Guide reader quickly to earlier work essential for understanding the article
  - Perform literature search and cite closely related work
- Duty to inform editor of any related manuscripts by author
- Improper to submit manuscript describing the same research to multiple journals (unless previously rejected/withdrawn)

# Ethical Obligations of Authors

- Identify the source of all quoted or offered information unless “common knowledge”
- Although criticism of another’s work may be appropriate, personal criticism is not.
- Identify any potential and/or relevant competing financial or other interests of all authors
- No plagiarism: “appropriation of another person’s ideas, processes, results, or words without giving appropriate credit” (45 CFR § 689.1)

# Publishing outside of the Scientific Literature

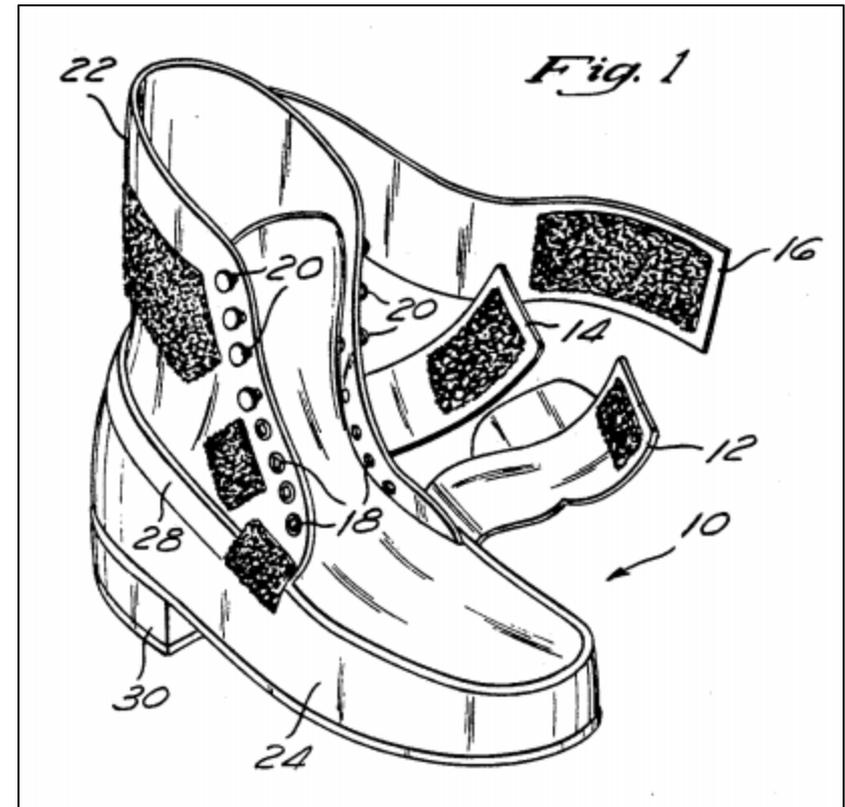
- Same basic guidelines apply
- Common words and less precision may be acceptable
  - Some loss of accuracy can be condoned
- Avoid proclaiming a discovery to the public unless experimental, statistical or theoretical support for it is of strength sufficient to warrant publication in the scientific literature.
  - Account of experimental work should be submitted as quickly as possible in a scientific journal
  - Beware: public disclosure of the research might be considered as equivalent to a preliminary communication in the scientific literature

# Non-Disclosure Agreements

- What is an NDA?
  - An agreement between two parties not to disclose certain confidential information
  - May be used to permit a party to work with another party on a research project
- So what do NDA's have to do with inventorship/authorship?

# Non-Disclosure Agreements

- Michael's Dilemma:
  - Michael invents a method for Creating an Anti-Gravity Illusion
  - Michael enters an NDA with Velcro Co. to develop high strength velcro for his method.
  - Michael discloses his method to Velcro Co. under the NDA.
  - Later, Michael learns that Velcro Co. has prepared and filed a new patent application on its new velcro.
  - Michael asks Attorney K to prepare a patent application for his new method.
  - What are the parties' rights in Michael's invention? In the improved velcro?



# Non-Disclosure Agreements

- Things to watch out for:
  1. Correct type of NDA? One/Two way? Sample exchange?
  2. Carefully define the scope of the confidential information in the agreement, and any restrictions on its use
  3. Keep a Paper Trail: Check the agreement!
    - Ensure all disclosed confidential **documents** are labeled as confidential
    - **Verbal disclosures** often require confirmation of the confidential nature of the disclosed information, in writing, within a certain period of time
      - **Failure to do so may exclude that information from the NDA—possibly resulting in its public disclosure!**
  4. Ensure you are using the information within the scope of the agreement
    - Oftentimes, there are restrictions on the use of the confidential information (e.g., no testing of a provided sample).

*Thank you!*

ATLANTA  
AUGUSTA  
CHARLOTTE  
DALLAS  
DENVER  
LOS ANGELES  
NEW YORK  
RALEIGH  
SAN DIEGO  
SAN FRANCISCO  
SEATTLE  
SHANGHAI  
SILICON VALLEY  
STOCKHOLM  
TOKYO  
WALNUT CREEK  
WASHINGTON D.C.  
WINSTON-SALEM

Justin Krieger

[jkrieger@kilpatricktownsend.com](mailto:jkrieger@kilpatricktownsend.com)  
1.202.481.9922