

## When is Your Patent Yours, and When is It Yours to Lose?

MARCH 31, 2025

In a recent March 17, 2025 summary judgment order, federal district court Judge Georgette Castner in the District of New Jersey invalidated a patent that had been filed before the 2011 America Invents Act (AIA) upon finding that a key feature of the invention, a pressure-activated cooling composition, had been created in a foreign factory rather than by the sole inventor named in the patent. Under pre-AIA 35 U.S.C. § 102(f), “[a] person shall be entitled to a patent unless . . . he did not himself invent the subject matter sought to be patented.”

The patent-at-issue relates to a cooling platform designed to cool other objects, including pets. The claimed cooling platform must comprise a composition that cools down upon the application of pressure. The plaintiff’s expert described this as a “key” feature of the claimed invention. Upon review of the evidence, however, the court found the sole named inventor had enlisted a mainland Chinese factory to provide a formula for the composition, merely requesting that they provide a cooling composition that did not require freezing and without specifically requesting a pressure-activated composition.

Judge Castner explained that the key inquiry for ascertaining inventorship is determining who “conceived of” the subject matter of the claims-at-issue. And that conception, she clarified, must include every feature or limitation of the claimed invention. Here, however, the named inventor was not involved in the conception of the purportedly “key” pressure-activation aspect of the claimed composition; nor did his subsequent “discovery” of this previously unknown feature—after the Chinese factory had already provided the composition—retroactively confer upon him the conception of this feature for purposes of inventorship under pre-AIA § 102(f). On these grounds, Judge Caster granted summary judgment in the defendant’s favor and declared the patent to be invalid.

Judge Castner’s ruling comes on the heels of last year’s *Digger Specialties* ruling in the Northern District of Indiana that dealt with post-AIA patents relating to vertical cable railing systems. The passage of the America Invents Act had both eliminated § 102(f) and removed a prior restriction on the USPTO Director to correct only errors in inventorship that “arose without any deceptive intention.” (See pre-AIA 35 U.S.C. § 256(a)). Under this patent savings provision, the Director under sub-para. (a) may issue a certificate of correction; and a court under sub-para. (b) may order such a certificate, but only upon notice to, and opportunity for, all concerned parties—including any omitted inventor(s)—to be heard. Because the patentee was unable to locate and contact one of the two omitted inventors in mainland China in time for the U.S. legal proceedings, however, District Court Judge Brisco was unable to exercise the

statutory power per 35 U.S.C. § 256(b) to uphold their validity. This, despite both omitted inventors having long since assigned their rights in the inventions to plaintiff's successor-in-interest already.

## TAKEAWAY

Incorrect inventorship can lead to invalidation of pre-AIA patents. Under U.S. patent law, the focus of the inventorship inquiry is on the conception of the claimed invention as issued. Applicants should double-check the allowed claims on a per-claim basis and identify each inventor who made a significant contribution to any claim, even a dependent claim limitation.

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