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Inventor evolution: is a change in the content from a provisional to a PCT application sufficient to demonstrate co-inventorship?

John Collins, Sumer Dayal (Clayton Utz) · Friday, October 14th, 2016

This question was tackled by the Full Federal Court of Australia in *Kafataris v Davis* [2016] FCAFC 134.

The patent in suit related to an alternative manner of playing card games. The player could play a primary game while at the same time exercising betting options on a secondary or auxiliary game, either separately from the primary game or in cooperation with the primary game.

Mr Kafataris sought to be recognised as a co-inventor as the invention disclosed in the provisional application, prior to his involvement, had been limited to supplementary betting options in the game of baccarat. However, after his involvement, the PCT application included a supplementary betting option for the game of blackjack. Mr Kafataris asserted that the 'invention' indeed went further and applied to all casino table card games, and that the evolution of the invention from the provisional application to the PCT application evidenced his contribution, and he was entitled to co-inventorship.

The primary judge disagreed. The Full Court also dismissed the appeal, making some interesting observations on co-inventorship in the process.

Quality not quantity

At first instance, the primary judge had accepted that:

- the appellant made a material contribution by identifying a supplementary betting option within the game of blackjack; and
- the parties were working together to forge an "ongoing commercial relationship".

However, the primary judge rejected the notion that the appellant's contribution amounted to co-inventorship. The test for the primary judge was not whether there was a quantifiable contribution to the invention, but whether the appellant had made a contribution that was "*material, tangible or qualitative*." In particular, the contribution had to be geared towards the "*concept, design or perhaps method*" and be seen objectively as part of the invention.

The Full Court approved of the primary judge's analysis and further stated that the proper enquiry

for co-inventorship is to the person's "*contribution to the conception of the invention*".

In this case, the Full Court identified the inventive concept as the supplementary betting option. The Full Court found that the appellant had taken the concept, as applied in baccarat, and provided another example of its application in blackjack. This contribution was insufficient to amount to inventorship. Baccarat and blackjack were simply alternative embodiments of the one invention, with the inventive concept "*substantially unchanged*" from the provisional application to the PCT application. As the Full Court succinctly concluded, "*there is nothing novel about the game of blackjack, nor was there anything novel about the secondary bet option for blackjack*".

Keeping contributions black and white

Although the issues in this case were relatively straightforward, *Kafataris* is a strong reminder of the grey area that can exist when a patent application involves multiple contributors. Inventors should therefore ensure that proper contractual arrangements are in place before consulting with other parties. Pre-empting such issues may ensure that, while the inventor's patent application can evolve, the number of claimed inventors does not.

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