FORTRESS IRON, LP v. DIGGER SPECIALTIES, INC., Appeal No. 2024-2313 (Fed. Cir. Apr. 2, 2026). Before Lourie, Hughes, and Kleeh (by designation). Appealed from N.D. Ind. (Judge Brisco).

Background:

Fortress Iron designed a vertical cable railing panel and filed patents naming two inventors. During subsequent infringement litigation, Fortress acknowledged that two additional individuals, Lin and Huang, were coinventors. Fortress successfully added Lin as a coinventor under 35 U.S.C. § 256(a), but it was unable to locate Huang. Fortress moved to add Huang under § 256(b), while the defendant moved for summary judgment of invalidity due to incorrect inventorship. The district court denied Fortress's motion and granted the defendant's motion. Fortress appealed.

Issues/Holdings:

Was Huang a "party concerned" under § 256(b) entitled to notice and a hearing before correction of inventorship? Yes, affirmed. Was the patent invalid due to the uncorrectable omission of a coinventor? Yes, affirmed.

Discussion:

§ 256(b) provides that the error of omitting an inventor shall not invalidate a patent if it can be corrected but requires that correction occur "on notice and hearing of all parties concerned." The Federal Circuit held that an omitted coinventor is a "party concerned" under § 256(b), relying on case law establishing that a coinventor falls within that category even where the coinventor holds no ownership rights in the patent. In so holding, the Federal Circuit rejected Fortress's argument that "party concerned" should be read narrowly to reach only those with an economic interest that may be adversely affected. The Federal Circuit reasoned that adopting that reading would impermissibly rewrite the statute and conflict with case law.

The Federal Circuit also rejected Fortress's argument that Huang could not be a "party concerned" because he would lack constitutional standing to bring a § 256(b) action himself. Based on case law, the Federal Circuit explained that constitutional standing and "party concerned" status are distinct inquiries with different requirements and declined to conflate them.

The Federal Circuit further affirmed that the patents were invalid as a result of the incorrect inventorship. § 256(b) saves a patent from invalidity for omission of an inventor only "if it can be corrected." The necessary implication is that a patent is invalid when the error cannot be corrected. The Federal Circuit rejected Fortress's argument that naming just one additional inventor is sufficient, finding that position would render the savings provision meaningless. In support, the Federal Circuit pointed to 35 U.S.C. § 100(f), which defines "inventor" as "the individuals collectively who invented." Reading that definition together with 35 U.S.C. § 101's use of the word "whoever," the Federal Circuit concluded that, when an invention has multiple inventors, all of them must be named. The Federal Circuit also disagreed with Fortress's argument that the repeal of former 35 U.S.C. § 102(f) eliminated any invalidity consequence for incorrect inventorship. That provision had simply stated that non-inventors are not entitled to a patent and said nothing about whether all actual inventors must be named. Courts have required joinder of all inventors long before § 102(f) was enacted, and its repeal with the AIA therefore changed nothing in that regard.