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IP Litigator

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Collaborators, Suppliers, and Coinventors: Key Lessons from Fortress Iron v. Digger Specialties

The Federal Circuit's precedential decision in *Fortress Iron, LP v. Digger Specialties, Inc.*, No. 24-2313 (Fed. Cir. Apr. 2, 2026), reinforces that inventorship errors can still be fatal when they cannot be corrected under [35 U.S.C. § 256](#) — even in the postAIA landscape. The court affirmed the invalidity of two patents after concluding that a missing coinventor could not be added under § 256(b).

Fortress Iron, a designer of railing and fencing products, collaborated with a Chinese supplier whose employees, Lin and Huang, proposed design changes ultimately incorporated into the patented products. Fortress nevertheless listed only its own personnel as inventors. In subsequent litigation, the district court held the patents invalid for failing to name a coinventor and denied Fortress's attempt to correct inventorship under § 256(b). The Federal Circuit affirmed.

As discussed below, this decision offers important guidance for companies that develop products with external partners, including practical steps to avoid inventorship problems that could jeopardize patent rights.

1. A Missing Co-Inventor Can Still Invalidate a Patent PostAIA

In *Fortress Iron*, the Federal Circuit confirmed that omitting a co-inventor can render a patent invalid if the error cannot be corrected under § 256(b).

Section 256(b) is a "savings provision" that permits correction of inventorship errors in certain circumstances; by necessary implication, when its requirements cannot be met, the patent is not saved and remains invalid. [\[1\]](#) The court relied on its earlier decision in *Pannu v. Iolab Corp.*, which treated incorrect inventorship as an invalidity problem, and extended that logic into the postAIA environment, despite the repeal of former § 102(f): [\[2\]](#) [\[3\]](#)

Takeaway: You cannot assume that the repeal of § 102(f) has neutralized inventorship as an invalidity issue. An

uncorrectable inventorship defect can cause a court to find a patent invalid.

2. Inventors Are ‘Parties Concerned’ Under § 256(b)

A central issue of first impression was who qualifies as a “party concerned” for purposes of § 256(b)’s requirement of “notice and hearing of all parties concerned.” Fortress argued that the omitted contributor (Huang) was not a “party concerned” because he allegedly had no economic stake in the patents. The Federal Circuit rejected that position and held that an inventor is a “party concerned” under § 256(b), regardless of whether the inventor has a financial or ownership interest in the outcome. The court emphasized that being named as an inventor carries legal, financial, and ownership consequences, and an inventor has a right to contest being added or omitted.

Takeaway: If you seek to add or remove an inventor under § 256(b), you must treat that individual as a party entitled to notice and an opportunity to be heard, even if they appear indifferent or there is an argument that they have no obvious economic interest.

3. Notice and Hearing Under § 256(b) Is a Prerequisite to Relief

The patents in *Fortress Iron* were not saved by § 256(b) for a basic reason: the omitted co-inventor could not be located and could not be given notice. The Federal Circuit held that failure to satisfy the procedural requirements of § 256(b), particularly notice and an opportunity to be heard, meant that the savings provision could not apply. Without relief under § 256(b), the underlying inventorship defect remained, and the patents were invalid.

Takeaway: Treat § 256(b) proceedings as substantive in nature, not as a one-sided *ex parte* “clean-up” tool. If a true contributor cannot be located or given the required notice, correction may be unavailable, leaving the patents vulnerable to an invalidity challenge based on incorrect inventorship.

4. Collaboration With Overseas Suppliers Raises Elevated Inventorship Risk

The factual backdrop in *Fortress Iron* is a familiar one: a U.S. company works with foreign suppliers whose engineers and designers meaningfully contribute to the product and the idea underlying the product. The case highlights a key risk. If those foreign contributors are true inventors but are not properly identified, contracted, or even reachable, later efforts to correct inventorship under § 256 may fail on procedural grounds.

Companies and in-house counsel should document contributions early, using processes that track who conceived each claimed feature, including personnel at suppliers and contractors. At the start of a project, they should use clear IP and assignment agreements that recognize potential inventors, require cooperation with patent filings and corrections, and keep accurate, current contact information. Inventorship should ideally be audited before filing or shortly thereafter, again before grant, and, where appropriate, once more before asserting a patent, by comparing the pending or issued claims to contribution records, particularly where third parties or overseas partners were involved.

Companies should be cautious about excluding collaborators or suppliers from inventorship if they made a contribution to the conception of the idea. *Fortress Iron* illustrates the risk of allowing business or contractual concerns to dictate who is named as an inventor. Anyone who contributes to the conception of at least one claim limitation that forms part of the inventive concept of the claimed invention must be listed as an inventor, regardless of corporate affiliation or expected ownership. To manage this, include clear IP ownership and assignment provisions in supplier and development agreements (so supplier inventors assign rights to you or a designated entity), and identify and document technical contributions early so you know who must be named and who needs to sign assignments and declarations.

5. Due Diligence and Litigation Strategy Implications

The case has important implications for both transactional and litigation practice. On the transactional side, when evaluating a patent portfolio in an acquisition or financing, inventorship risk, particularly involving foreign collaborators, should be a specific diligence topic. Counsel should assess whether potential coinventors are identifiable, locatable, and subject to cooperation obligations, and whether any prior § 256 corrections have been pursued or may be required.

On the litigation side, plaintiffs should anticipate inventorship challenges where there has been meaningful collaboration with third parties, including suppliers and development partners. Defendants, in turn, should consider whether omitted contributors, especially from those suppliers or partners, provide a basis to argue that not all inventors have been named and § 256 correction is unavailable, such that the asserted patents are invalid.

6. Do Not Too Quickly Concede Coinventorship: Focus on the Claims and on Conception

One notable aspect of *Fortress Iron* is that, as the Federal Circuit observed, “Fortress acknowledged that Lin and Huang were coinventors.” From a litigation and prosecution strategy perspective, that acknowledgment raises a question: was it inevitable, or could Fortress have argued that the supplier’s employees merely assisted in reduction to practice rather than contributing to conception of the claimed invention?

The decision contains relatively little discussion of the actual claim language, and much of the narrative instead centers on the product and the design changes embodied in the commercial prototype. That emphasis on the product rather than the claims is noteworthy. As a practical matter, it underscores the importance of carefully separating what was claimed from what was merely built or tested. A collaborator may contribute substantially to a prototype or to refining a commercial embodiment, without necessarily contributing to the inventive concept as reflected in the claims.

In future cases, parties should consider whether a collaborator’s role truly rises to the level of conception of at least one element of the claimed invention, or whether it is more accurately characterized as implementation, engineering optimization, or assistance in reduction to practice. If the record supports the latter, there may be a viable path to argue that the collaborator is not a co-inventor at all, rather than conceding inventorship and then struggling to satisfy § 256(b)’s procedural requirements for adding a missing inventor who cannot be found or noticed.

Relatedly, this decision highlights the value of thoughtful claim drafting when collaborators are involved. Where possible and consistent with § 112 support and the business objectives, applicants may consider claim strategies that focus on the inventive contribution that clearly resides with the reachable inventors, rather than claiming in a way that necessarily sweeps in features contributed by third parties who may later be difficult or impossible to locate. Even if an early prototype has shortcomings, that does not foreclose broader but well-supported claim language that isolates the core inventive concept and avoids implicating contributors whose role is limited to refinement or implementation.

Another option is to draft claims with varying scopes. Faced with the predicament in *Fortress*, having claims with different scopes, potentially in which the unreachable inventor’s contribution is not reflected, could have led to Fortress having the ability to cancel claims and continue the litigation on claims for the inventors they were able to reach.

The record in *Fortress Iron* is limited, and the opinion does not fully unpack the boundaries between conception and reduction to practice in this specific collaboration. But as a practice pointer, the case suggests that litigants and prosecutors should not reflexively concede co-inventorship in the face of supplier involvement. Instead, they should closely analyze the claims, map each limitation to specific contributions, and, where the facts permit, consider arguing

that a collaborator's role was non-inventive assistance rather than joint conception.

Conclusion

Fortress Iron confirms that inventorship still matters significantly. A missing co-inventor can invalidate a patent if § 256(b) cannot be satisfied, and inventors, whether named or unnamed, are "parties concerned" who are entitled to procedural rights such as notice and an opportunity to be heard. For companies that depend on collaborative or global research and development and supply chains, proactive inventorship management remains critical to preserving patent value and enforceability.

Footnotes

- ¹ Section 256(b) states that "[t]he error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly."
- ² *Pannu v. Iolab Corp.*, [155 F.3d 1344](#) (Fed. Cir. 1998)
- ³ Former Section 102(f) stated that a person was not entitled to a patent if "he did not himself invent the subject matter sought to be patented." Under that provision, a defendant in an infringement suit could readily assert incorrect inventorship as an invalidity defense under § 282(b). Because the AIA repealed § 102(f) and did not enact a direct replacement, some commentators have questioned whether incorrect inventorship remains a viable invalidity defense. In *Fortress Iron*, the Federal Circuit appears to have confirmed that it does.

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