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The Precedent: Omitted Inventor Renders Patent Invalid when Section 256 Correction Is Not Available in Fortress Iron, LP v. Digger Specialties, Inc.

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In this edition of *The Precedent*, we outline the decision in *Fortress Iron, LP v. Digger Specialties, Inc.*

Overview

In *Fortress Iron, LP v. Digger Specialties, Inc.*, the Federal Circuit affirmed summary judgment that two Fortress patents were invalid because they omitted a coinventor who could not be located and added under the correction-of-inventorship statute. The Federal Circuit held that the omitted inventor was a “party concerned” under Section 256 and, without the notice and hearing that statute requires, the district court could not correct the patents. As a result, the patents remained incorrect on their face and were invalid.

Issues

1. Can a court correct inventorship under 35 U.S.C. § 256(b) when a proven coinventor cannot be located and given notice and a chance to be heard?
2. If a coinventor is omitted and cannot be added under Section 256, does that omission render the patents invalid?

Holdings

1. Section 256(b) requires notice and a hearing for all “parties concerned,” which includes any true inventor. Because the omitted inventor could not be located, the court could not order correction.
2. Once the patents are known to omit a true inventor and cannot be corrected under Section 256, they are invalid due to incorrect inventorship.

Background and Reasoning

Fortress owns two patents directed to vertical cable railing systems for decks and similar structures. The patents originally named two inventors, Sherstad and Burt. Fortress sued Digger Specialties for infringement of the Patents-at-Issue.

During discovery, evidence showed that two engineers at Fortress's Chinese partner company, Lin and Huang, had contributed to the inventive design of the Patents-at-Issue. Fortress eventually agreed that both were coinventors. Fortress was able to locate Lin and worked with the USPTO to add him as a coinventor to the Patents-at-Issue through the administrative correction process in Section 256(a). However, Huang had left his employer years earlier, had not provided updated contact information and could not be found.

Recognizing that Huang was also an inventor, Fortress asked the district court to correct inventorship under Section 256(b), which allows courts to order correction of issued patents. Digger opposed and also moved for summary judgment that the Patents-at-Issue were invalid for incorrect inventorship.

Section 256 and "Parties Concerned"

Section 256 has two parts. Subsection (a) allows the USPTO to issue a certificate correcting inventorship on application of "all the parties and assignees, with proof of the facts." Subsection (b) addresses court-ordered correction. It states that the error "shall not invalidate" the patent "if it can be corrected as provided in this section" and that a court "may order correction of the patent on notice and hearing of all parties concerned."

The key question here was who counts as a "party concerned." Fortress argued that only the current assignee and the named inventors needed notice, and that because adding Huang would benefit him, he was not a "party concerned" in the sense of someone whose interests might be harmed.

The Federal Circuit disagreed. It relied on its earlier decision in *Chou v. University of Chicago*, which held that an omitted coinventor is "clearly within the purview of" Section 256(b). Inventorship carries legal consequences, including presumptive ownership rights and the ability to license or enforce the patent. A court cannot decide to add someone as an inventor without giving that person notice and an opportunity to be heard, even if the change seems favorable.

Huang was therefore a "party concerned." Because he could not be located, the district court could not satisfy Section 256(b)'s "notice and hearing of all parties concerned" requirement. The Federal Circuit emphasized that this language is a prerequisite to court-ordered correction, not a technicality that can be skipped when an inventor is missing. Without satisfying it, the court had no authority to correct the patents.

Invalidity for Correct Inventorship

Fortress then argued that, even if the Patents-at-Issue could not be corrected, the naming of at least one true inventor should be enough to maintain validity. The Federal Circuit rejected that position. It pointed to the text of Section 256(b), which says “[t]he error of omitting inventors ... shall not invalidate the patent ... if it can be corrected as provided in this section.” The flip side is that if the error cannot be corrected, the patent remains vulnerable to invalidity based on incorrect inventorship.

The Federal Circuit also noted that its longstanding case law holds that omitting a true inventor renders a patent invalid, unless corrected. That precedent predates Section 256 and is consistent with the statute’s structure. Section 256 is a “savings provision” that preserves validity despite inventorship mistakes but only when those mistakes can actually be fixed under its procedures.

Because Fortress now agreed that Huang was a coinventor, and because he could not be added via the USPTO or by court order due to the absence of notice and hearing, the error could not be corrected. The Patents-at-Issue, therefore, remained improperly issued and invalid for incorrect inventorship.

Fortress suggested that the repeal of former Section 102(f), which barred patents where the named inventor “did not himself invent the subject matter,” changed the consequences of inventorship errors. The Federal Circuit disagreed. Section 102(f) focused on whether a named inventor actually invented the claimed subject matter. Section 256, by contrast, squarely addresses omissions and misnamings, and continues to govern the validity of patents with inventorship errors.

With no genuine dispute that Huang was a coinventor and no way to correct the patents under Section 256, the Federal Circuit affirmed summary judgment that the patents were invalid.

Takeaway

This case is a cautionary tale about inventorship. If you later discover that an additional person contributed to the claimed invention, you should act promptly while that person can still be contacted. Section 256 can rescue a patent from inventorship errors but only if all inventors (including omitted ones) can receive notice and participate in the correction. Where a true inventor cannot be located and added, the patent may be invalid and unenforceable, even if the error was inadvertent.