

### Inventorship & Ownership

Each person who invents, either alone or as part of a group, some patentable technology is, by default, entitled to the rights in any patent granted in respect of that technology. Thus, when filing a patent application, it is important to know which person(s) actually made an inventive contribution to the technology covered by it, in order to know who will own the rights in any resulting patent.

#### WHY IS INVENTORSHIP IMPORTANT?

It is generally easier to sort out the chain of ownership and any possible ownership disputes at an early stage of the patent application procedure rather than leaving things until later when matters may have become much more contentious and relevant evidence may have been lost or forgotten.

For any prudent patent applicant, there should be a careful determination of the identity of the inventor(s) for every patent

application, followed by careful confirmation that the necessary rights have passed from the inventor(s) to the correct patent applicant. This will be discussed in more detail below. Indeed in some countries (e.g. the USA) the inventorship issue is so important that deliberately falsifying it in a patent application can invalidate any patent resulting from the application.

#### How to determine inventorship?

The criteria for deciding who should be considered an inventor are, for example, quite different to those normally applied to determining authorship of a scientific research paper. Although there are no actual rules laid down in law, the following is the approach generally applied in the UK.

Firstly it is necessary to define the invention (or inventions) which form the basis of the patent application. Generally speaking, an invention could be any new material or apparatus, or method or process, which is properly described in the application. This can be assessed by comparing experiments, data or ideas disclosed in the patent application with previously published technology.

If there is any doubt about what the invention(s) may be, the matter should be discussed with the patent agent who is drafting the patent application, particularly with reference to the kind of claims which will be filed as part of the patent application.

Secondly, once each invention is defined, it is necessary to determine who actually devised it. Generally speaking this may include anyone who:

- Conceived the initial ideas which defined the research which leads to the invention;
- Actually devised the experiments or materials which form the basis of the patent application;
- Carried out any experiments or other processes which are described in the patent application and which required that

person to show initiative to complete, for instance because unexpected practical difficulties had to be solved;

- Interpreted the data disclosed in the patent application, particularly if the data was unexpected or its implications were unclear.

Generally speaking this will not include anyone who:

- Simply carried out work under instruction (regardless of how much skill and effort this took) particularly if the work took no initiative and required no modifications to carry out as instructed;
- Had no part in the research, regardless of whether or not they funded it, or were associated with it in other ways, or owned the facilities which were used in the research, or published earlier relevant work, or contributed very general work or assistance;
- Has been a Project Manager or Supervisor but did not contribute technically to the actual invention.

It should be stressed that everybody who is found to have actually devised any invention covered by the patent application should be named as an inventor. There is no significance in the order that the names are published in a patent specification.

#### Telling the Patent Office

Thus in all cases (regardless of who actually is believed to own the rights, or is the named applicant) the name(s) of all the inventors must be furnished to the Patent Office when filing an application (or shortly afterwards). They can then be named as

inventor(s) on the specification when it is published, and each inventor will also be informed that a patent application has been filed (so that they, or others, have a chance to dispute the ownership of the invention). In some countries the signature(s) of the inventor(s) will actually be required in order to process the application.

### Making corrections

It may be necessary to alter the statement of inventorship details which is filed for a patent application. For instance spellings or other details may be corrected, name(s) of inventor(s) who should have been mentioned but were not may be added, and person(s) who were named as inventor(s) but who should not have been may be deleted. Indeed it is possible that the invention may have to be redefined during patent examination and this may lead to a new analysis of who the inventor(s) are.

Various mechanisms exist for making such alterations. These may be mere formalities, or may be contentious proceedings in their own right, particularly where parties are in disagreement and where ownership of the rights in the patent are affected by the outcome.

It should be stressed, however, that the inventorship should always reflect who devised the invention, regardless of whether or not this has implications for ownership.

### What is the normal ownership situation?

Although the inventor is the first owner of an invention, in the vast majority of cases in the UK the ownership of the rights to a patent will pass from the inventor(s) to their respective employer(s) by virtue of their employment.

Thus in such cases it would be their employer (or several employers in the event of a collaboration) who would own the rights.

This is the case as long as: a) the employment is in the UK; and b) the employee is either expected to make inventions or is a very senior employee. If, for example, the employee is a

junior employee not employed to do research, then the rights to the invention will not automatically belong to the employer. In other cases, the contract of employment may help to determine whether or not the rights of the invention are automatically transferred from the employee to the employer. Where there is any doubt as to whether the rights have been transferred it may be agreed that the inventor(s) should sign a formal agreement transferring their rights to the employer(s).

Four common problem situations which are sometimes overlooked are as follows:

1. Where the company whose employee(s) made the invention is part of a group of companies, then it is wise to check that the employee(s) concerned are in fact employees of the company which is to file the patent application and not, for example, of a subsidiary or service company. Again, if there is any doubt, assignment may be required.
2. If some or all of the research work has been done by an academic institution, then it is possible that some of the inventors (e.g. PhD students or visiting scientists) may not in fact be employees as such. It is also possible that more senior academic staff may have complicated employment arrangements with the academic institution or special conditions relating to inventions. Inventions in these cases may not therefore automatically belong to the academic institution or sponsoring company.
3. If any of the inventive research has been done by a sub-contractor or a consultant, then clearly there will be no employment relationship and the particular contracts involved will have to be examined carefully.
4. Where the inventive research results from a collaboration between different companies or institutions, the ownership will be dictated not only by the existence of employment contracts, but also by the contractual relationship between the collaborators.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at [www.mewburn.com](http://www.mewburn.com). Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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