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Whose Invention Is It Anyway? – Some Thoughts on Patent Inventorship and Ownership



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Patents provide a number of commercial benefits to patent owners including exclusivity in the market, bargaining power and the potential for licensing income. Needless to say, ensuring that you are the rightful owner of the patent is essential. And since patent ownership is transferred from the inventors, inventorship is a key and often overlooked aspect of maintaining a valid and enforceable patent.

Getting inventorship correct at the outset of filing is a crucially important step. In many jurisdictions, including the US, the willful naming of an incorrect inventor has been used to invalidate an otherwise valid patent. So while the stakes are high, the risks can be mitigated.

Inventorship is clearly defined by law: it is determined by conducting a review of the claims of the patent application, and attributing one or more inventors to the inventive concepts in each claim. In some cases, there may be joint inventors when there has been some collaboration between inventors even though each did not necessarily make a contribution to the subject matter of every claim of the application. Once this review is complete, the list of names constitutes the list of inventors, no more, no less.

So who is *not* an inventor? Those who apply ordinary skill to assist an inventor, without any extensive research are not inventors. Those who assist an inventor by providing them with known principles or background information on the state of the art are not inventors if they did not contribute to the invention itself. In contrast with academic circles, inventorship is not the same as authorship, where colleagues, supervisors, technicians etc., are often included for the sake of courtesy. The same goes in the commercial sector, where managers and bosses may not be inventors, especially when they had no role in coming up with the inventive concept.

It's key that we get inventorship correct at an early stage. In claiming priority by treaties such as the Paris Convention, an applicant must be able to show at least one common inventor between the priority filing and the corresponding applications. This can be a problem if one such inventor is no longer available, or willing, to assign their rights to the invention to the applicant.

Once correct inventorship is established, the inventors may assign their patent rights to a third party, who becomes the patentee. If the inventors are employees, they may be obligated by their employment agreement to assign any intellectual property (IP) arising from an employee's normal course of work.

In other cases, ownership may be set out in any number of other types of agreements between parties, such as joint development agreements or contractual service agreements. Typically such an agreement will state that one or more parties will be the owner (or co-owner) of any intellectual property relating to technologies, or arising from work identified in the agreement.

In the case of co-ownership between more than one party, it is important to note that co-ownership carries different rights in Canada and the US, generally speaking:

- A co-owner's interest in a co-owned patent can be transferred and used without the consent of the other co-owner in both Canada and the US;
- A co-owner's interest in a co-owned patent can be licensed without the consent of the other owner in the US and there is no need to account to the other owner for licensing revenue; but in Canada the patent cannot be licensed without the consent of the other co-owner;

- A co-owner's interest in a co-owned patent can be enforced in the US but only with the consent of the other co-owners, and in Canada can be enforced without consent, but a co-owner must join with the other co-owners in the enforcement proceedings.

Co-ownership may be a preferred arrangement in some circumstances. It is also possible for the patent owner(s) to license patent rights to one or more licensees, while maintaining full ownership of the patent or patent applications.

Contact [Shohini Bagchee](#) in our [Intellectual Property and Technology Group](#) to review inventorship and patentability issues.

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