

# Determining Inventors and Owners and Working with a Patent Attorney

23 June 2015

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# Inventors and Owners

- **Patents are property under the control of the owners**
  - The ability to exercise patent rights and obtain remedies rest with the owner
- **However owners must first be able to establish they are the true owners**
  - This requires them to demonstrate entitlement from the original inventors

# Who is an Inventor?

- **“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor”**
  - US Patents Act 35 USC 101
- **The concept of who is an inventor is difficult to define under patent law but essentially it is a person who, when faced with a problem, *materially contributed* to its solution**
  - Amount of contribution is irrelevant
  - the question is whether there was a contribution or not

# Joint Inventorship

- **“the exact parameters of what constitutes joint inventorship are quite difficult to define. It is one of the muddiest concepts in the muddy metaphysics of the patent law”**

# What constitutes invention

- **‘conception’ of the invention as the complete performance of the mental part of the inventive act; the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice. The mental part of the inventive act is then complete. What remains belongs to the department of construction, not invention**

# Joint Inventorship

- **For joint inventorship, each inventor must generally contribute to the conception of the invention. This conception is the ‘formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice’**
- **[T]o be a joint inventor, an individual must make a contribution to the conception of the claimed invention that is not insignificant in quality’ and the inventors must ‘have some open line of communication during or in temporal proximity to their inventive efforts’**

# Who is an inventor

- **The question is what did a person who claims to be an inventor contribute to the claimed invention?**
- **One question to ask is “but for the involvement of person X, would we have arrived at the invention”?**
- **There must be some suggestion from the person as to what the structure of the solution to the problem is to take, or they must be involved in collaborative discussions in which the final form is defined**
  - They must contribute to the structural solution to the problem

# The role of contractors and technical staff

- **A person working under instructions is typically not an inventor**
  - A contractor or technical staff member who is given a set of design criteria or constraints, and then implements a solution that fits within those bounds is not typically an inventor
- **However it is not enough to suggest a problem without any information as what or how the solution is to be formed or made**
  - In this case the contractor/technical staff will be forced to discover the solution, and will typically be considered an inventor

# Inventorship is not the same as authorship

- **The criteria for inventorship is different to adding an author to a scientific paper**
- **Generally list of inventors will be smaller than the list of authors on a paper**
  - Must be able to justify inventorship on contribution
- **Main issues arise around technical staff, lab heads, and people who provided materials**
  - Often these will not be inventors

# Who owns the invention

- **The general principle of intellectual property law is that an invention is owned by the inventor unless there is some reason to the contrary**
- **However most inventions by employees will automatically be owned by their employers.**  
**This will occur if:**
  - the person is employed to invent or design things
    - ie most engineering, and R&D jobs
  - There is a specific contract clause which states this
    - Most contracts will specify that employee inventions are owned by their employers

# When does an employer own your invention

- **When the invention arose as part of what the employee was employed to do**
  - What was their duty to the employer
- **If the employee's invention is the product of what they were employed to do, and did do, it will belong to the employer unless otherwise agreed**
- **When there is a contractual clause in place**
  - Many employment contracts will specify that the employer owns inventions arising from the employee's work

# University researchers and students

- **University lecturers employed primarily to teach and perform/organise/stimulate research *may, in certain specific cases, own their inventions***
  - In a university the duty to research is not necessarily a duty to invent (this will depend on the specific facts)
  - Most employment contracts will have a contractual clause to overrule this situation
- **University staff specifically employed to do research do not typically own the inventions**
- **Students are not employees and thus own their inventions**
- **These default conditions are typically overridden by specific agreements**

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# Assignment of rights

- **Patent rights may be explicitly assigned to another party**
- **An assignment will typically overrule existing agreements or contracts**
- **Typically an assignment must be in writing, and be signed by the assignor and assignee**
  - Generally there will be some consideration (eg monetary amount) from the assignee to the assignor

# Joint Owners

- **A patent may be co-owned by multiple owners**
- **Each owner receives an undivided share in the invention**
  - This allows each owner to exploit the invention *independently* of the other owners
    - They could offer the product cheaper or offer an inferior version that still falls within the scope of the claims
- **We generally recommend that a patent has a single owner**
  - Eg a holding company that licenses the patent back to the original parties

# Amendments

- **Inventorship is determined on a claim by claim basis**
- **During prosecution of a patent it is not uncommon for some claims to be deleted**
- **If this occurs then the list of inventors may need to be updated and ownership reassessed**
  - In extreme circumstances this may mean a joint owner loses entitlement

# Who are patent attorney's

- **We are technical people who have studied IP law**
  - A patent attorney *must* have a science or engineering qualification
  - To become registered we must pass an approved set of IP subjects relating to patents, designs and trademarks
- **We have an in-depth understanding of the various validity requirements under patent law**
  - novelty, inventiveness, descriptive support
  - We also understand how these vary from country to country

# What is our role in the patent process

- **We are there to guide you and represent you through the patenting process**
- **This has two main phases**
  - identifying what you have invented, drafting and filing the patent application
  - Prosecuting the patent application through the various national patent offices
- **This means we need to work closely with you from time to time, over several years**
  - The initial period of contact is most important

# Preparing a patent specification

- **Our first job is to draft the claims that define the legal boundary for protection**
- **We then oversee the drafting of the description**
- **The description has two roles**
  - First role is provide support for the claims
  - Second role is a teaching document to inform skilled workers of how to implement the invention
  - Broken into sections - Background, Summary, Detailed Description, & Figures

# We want to understand your invention

- **In order to protect your invention, we first need to get an in-depth understanding from you of how your invention works**
- **Whilst we do have a technical background we do rely on your specialist knowledge**
  - We will try and generalise and abstract what you have done
  - We also want to understand the variations and limitations
  - We need your feedback when we do this
- **We also rely on technical information you can provide (flow diagrams, experimental results, etc)**

# Understanding Patent Claims

- **A patent claim is infringed if someone copies each and every feature of a claim**
- **Our job is to understand your preferred invention and then strip it back to the determine the minimum number of essential features and capture this in a patent claim**
- **The aim is to make it as hard as possible for others to copy**
  - a less efficient system can still be a commercially viable competitor

# Design Objectives

- We are drafting the application based on incomplete information
  - We don't know all the prior art
  - We don't know how a competitor will attempt to get around the claims
- **We aim to draft broad claims that are novel, but possibly not inventive**
- **We aim to provide flexibility over certainty**

# Patent claims are set up hierarchically

- **A first broad claim will have a minimum set of features**
- **A series of dependent claims add further features**
  - Typically these features are directed to preferred embodiments (eg efficient implementations)
- **During prosecution we will rely on these features to add patentability**
  - However we don't generally know which are best

# We often appear to repeat ourselves...

- **A patent will typically include several similar claim sets**
- **Each claim set is directed at a different actor in a system or a different implementation**
  - e.g. a communication system will have separate claims sets directed to the transmit side and receive side
  - Patent claims will be directed to a method, an apparatus, a computer program product...
  - This is to capture different infringers

# Patent Claims – Please read them carefully

- **Your feedback is crucial**
  - We understand that patent claims often appear convoluted but your feedback is crucial
- **We are attempting to abstract your invention to prevent work-arounds**
  - Please consider the terms we have used, and how the skilled worker would interpret them

# Writing the Patent Application

- **The patent specification must describe the invention fully**
  - It must include sufficient detail to enable a person skilled in the art to put it into practise
- **Best practice is to include several examples of how to put the invention into practice**
- **We also want to define the expected range over which the invention will work**
  - Include both preferred/efficient implementations, and less preferred/efficient implementations

# The benefits of a comprehensive description

- **Once the application is filed, you generally can't add anything more**
  - For the next 5-10 years you will be limited by what you chose to include, and the specific words you used to describe the invention
- **During prosecution you are only allowed to modify the claims based upon terms and descriptions found in the specification**
  - Some countries have very strict requirements
- **We need to get it right the first time**

# Phase 2- The patent prosecution process

- **Once filed, the application will be (independently) examined by each countries patent office**
  - They will perform searches, identify prior art, and check formalities requirements
- **Examiner's will tend to look at what prior art other examiner's raise**
- **Ultimately each examiner is free to perform additional searching and raise new grounds of rejection**

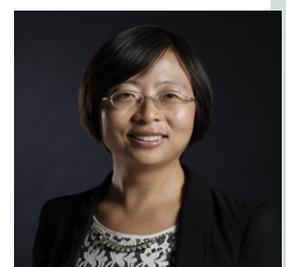
# Our role in the patent examination process

- **Our role is to negotiate with the Examiner**
  - We act in your best interests
- **The Examiner will typically raise objections**
  - Eg lack of novelty, obviousness
- **Our role is to assess the reasonableness of the objections (ie interpret the objection), advise you on possible responses, and then plead your chosen response**

# Other services we provide

- **We can conduct and analyse patentability (eg novelty) searches**
- **We can provide freedom to operate advice**
- **We also provide advice on validity and potential infringement**
- **If the case goes to Court we form part of your legal team to brief the solicitors and barristers who represents you in Court**

# Any Questions?



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