HLK

Inventorship and Ownership in the UK

In the world of patents, inventorship and ownership are two distinct legal principles which go hand-in-hand. Let's find out why this is the case.

Who is the inventor?

The inventor is the 'actual deviser' of the invention to which the patent or application relates.

In order to determine the actual deviser, it is necessary to first identify the inventive concept (or concepts) in the application, and then consider who conceived this inventive concept. Common indicators that someone may be an inventor include:

- they conceived the core idea;
- they used their initiative to go beyond a brief and this led to an inventive concept;
- they identified the significance of a result that led to the invention.

It is a common misconception that anyone who contributed to the work in the patent application is considered an inventor. However, inventorship is distinct from authorship of an academic paper in which it is common for contributors to be credited and authors to be included out of courtesy. Whether or not someone is an inventor is an objective consideration.

Examples of activities that would not, on their own, make someone an inventor include:

- carrying out routine work;
- offering advice;
- supervising a project (but not devising the inventive concept);
- testing the invention;
- carrying out follow up work.

If multiple people contributed to devising the invention, then each person is considered a joint inventor. Recent UK case law has emphasised that each inventor must be a natural person, and so cannot be an AI machine.

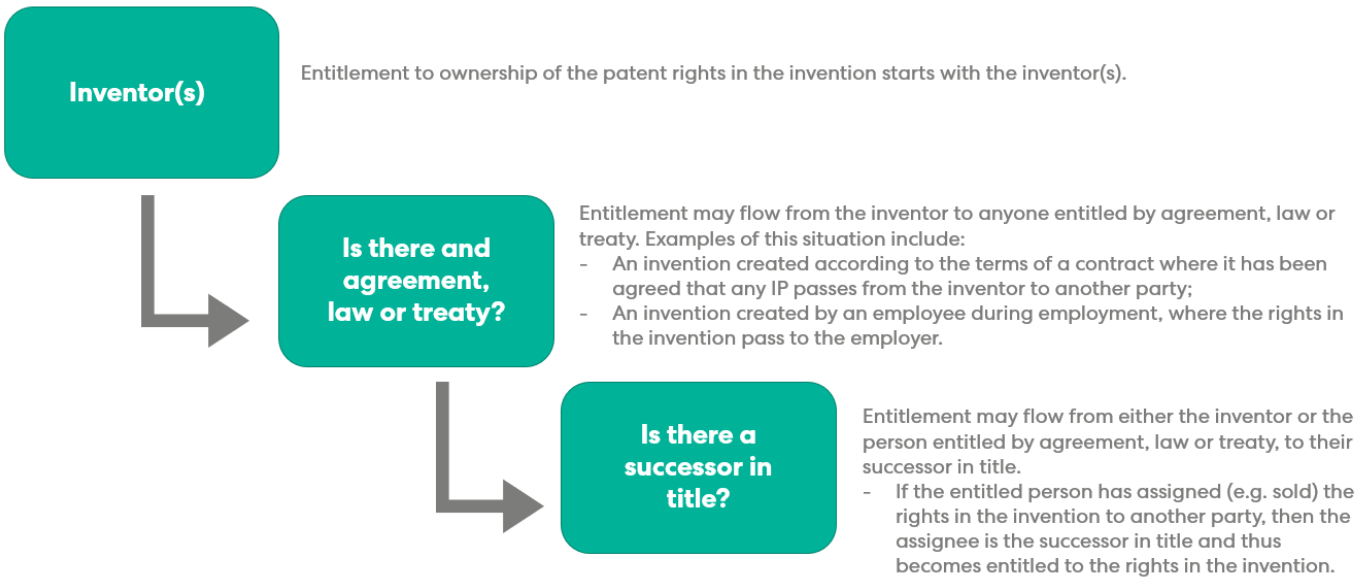
Inventors have the right to be mentioned on the front page of the patent or patent application meaning that the inventors are readily identifiable (although this right can be waived).

Why is the inventor important?

In short, inventorship is important as it determines who is entitled to ownership of a patent or patent application. As a piece of intangible, transferable property, a patent can be owned by any legal person, such as a body corporate, or a natural person.

Entitlement to ownership of the patent rights in the invention starts with the inventor(s) and "flows" from there, as shown in the flow diagram below.

No one else outside the above flow of rights is entitled to the invention.



Inventions created by an employee

In the UK, an invention belongs to an employer if an employee makes the invention in the course of their normal duties, or in the course of other specifically assigned duties, where an invention might reasonably be expected to arise from these duties.

- A researcher might reasonably be expected to devise an invention in their day-to-day work.
- An employee who is not normally involved with research activities might be specifically tasked with an additional research duty on a project, and an invention might reasonably be expected to arise from this additional duty.

An invention also belongs to an employer if an employee makes the invention in the course of their duties, and because of the nature of their duties and responsibilities, they had a special obligation to further the interests of the employer.

- A senior director of a company may have a special obligation to further the interests of the company, and so it is more likely that a senior director's invention belongs to the company than is the case for a junior employee.

Inventions made by an employee in any other circumstances belong to the employee, not the employer. Accordingly, the default assumption is that the inventor is entitled to the invention, and it is the employer who must state that they are entitled to the invention by means of the invention having been devised in any of the above circumstances.

Factors to consider when determining entitlement to an invention may include:

- does the employee's employment contract include research and development activities?

- is the invention in a different technical field from the employee's normal duties?
- does the invention relate to the company's existing or proposed products or services, or is it unrelated?
- did the employee share their ideas relating to the invention with anyone else in the company, such as during internal meetings, presentations, on internal databases or company intranet?

What if the inventor is self-employed?

In this instance, the inventor is generally entitled to the invention. This is particularly common when inventions are devised by self-employed individuals operating as sole traders, such as a self-employed carpenter devising an invention in the workshop.

When does UK law apply?

UK law generally applies to inventions devised in the UK, in UK territorial waters and on the Isle of Man. This is the case regardless of the inventor's nationality.

For employee inventors, UK law applies to employees mainly employed in the UK, or employed by an employer having a place of business in the UK to which the employee was attached. For UK nationals resident abroad and devising an invention abroad for a company overseas, the law in the country in which the invention is devised is likely to apply.

Who can apply for a patent?

In light of the above, you might be forgiven for thinking that only the entitled party can apply for a patent. However, in reality, anyone may apply for a patent, but a patent can only be granted to the entitled party.

This nuance means that it is assumed, in the absence of evidence to the contrary, that the person who makes the application for a patent is entitled to ownership of the patent once granted.

Entitlement disputes

Where one party disputes that an applicant for a patent is entitled to be the (sole) proprietor of the eventual patent, this is termed an entitlement dispute. Fortunately, the Comptroller of the UKIPO has power to decide such disputes and determine who is entitled to ownership of the eventual patent, including whether certain subject matter should be removed from the existing application in order to create a new application for the correctly entitled party.

IP collaboration agreements

It is not uncommon for such an entitlement dispute to arise where two companies collaborate, in the absence of an IP agreement, to devise a new product. When employees of each company contribute to the invention, then entitlement to ownership of the invention will then be shared between the two companies.

Whilst it is perfectly possible for joint applicants to prosecute a patent application through to grant, the differing interests and priorities of the companies may mean that such a situation may result in difficulties. It is therefore often preferable that ownership of the rights in the invention be assigned to one company only, or most preferably, that an IP agreement is made prior to the collaboration.