

# PATENT RIGHTS

## INVENTORSHIP, OWNERSHIP, AND PRACTICAL TIPS

### WHO IS AN INVENTOR?

Inventors are those who help **conceive** an aspect of the claimed subject matter in a patent application. Specifically, **conception** related to the substantive and novel aspects of an invention.

A contribution must provide a technical advantage towards the utility of the invention.

### HOW TO DETERMINE INVENTORSHIP

Utilize this two-part test to determine inventorship:

1. Can the inventor explain in enough detail than one of ordinary skill:
  - a. How the invention would work?
  - b. How the invention would be used?
2. Was this contribution towards:
  - a. Substantive Aspect
  - b. A claimed invention or a claimed portion of the invention

### ARE DEVELOPERS & ENGINEERS INVENTORS?

An executor is an engineer or developer under the director of an inventor. In some cases, executors can become an inventor. The general test below can be used to determine if an executor is also an inventor.

1. Who provided the solution to the problem?
2. Was there any undue experimentation?

Prior to beginning work with any contracted engineers or developers, consult with an IP Professional.

## THE IMPORTANCE OF INVENTORSHIP

The United States operates on an inventor-centric patent system.

The two relevant founding principles of our patent system are:

1. True Inventors Can File
2. First True Inventor to File Will Be Awarded the Patent

This means that the first true inventors to file a patent application for their invention are entitled to the Intellectual Property Rights of that patent application.

The default rule is that the inventors own the rights to the patent.

It is illegal and unlawful to conceal or misrepresent inventorship on an application; and, doing so would risk the invalidity of the patent rights or the sharing of those rights with another party.

## PRACTICAL TIPS

1. **Partnership and Operating Agreements** should list Intellectual Property Rights and the disposition of those rights. This may include what happens if the entity dissolves, how to handle non-competition periods, intellectual property rights are central to these questions.

2. **Contractor Agreements** should be considered before commissioning work. Before the work begins, proper agreements need to be in place to address any Intellectual Property Rights issues. All rights should be assigned and transferred to the entity, or designated to be assigned to the company, once the invention takes place. **Employment Agreements** should also cover similar issues.

3. **Be As Inclusive As Possible.** If a patent application is filed without a complete list of inventors it could cause issues in the future.

4. Situations with **hostile inventors** may arise where an inventor does not cooperate in the necessary agreements. Consult with an IP Professional immediately.