

# Patenting research outputs – understanding ownership

As we continue our series on considerations for researchers interested in patenting their research outputs, we turn to some of the finer details of entitlement. This time we ask the question, “Who actually owns the rights to your invention – you or your employer?”

An inventor has the right to be named as such for patent applications filed in the UK at the United Kingdom Intellectual Property Office (UK-IPO). The right to prosecute the application belongs to the applicant, and the right to enforce a granted patent belongs to the proprietor, rather than to the inventor. The Patents Act 1977 states that a patent may be granted “primarily to the inventor or joint inventor”, which means the inventor can be the applicant/proprietor. However, third party agreements and employment contracts entered into before the making of an invention take precedence over an inventor’s default right to the invention, potentially granting the rights to the invention to the third party or employer, respectively.

## Sole inventors

Individuals can make inventions completely on their own, outside of their field of employment and with no third-party involvement. In these cases, if the inventor files a patent application, then they should be entitled to be named as an applicant. Of course, sole inventors working with relatively limited resources are more likely to develop simple mechanical inventions than chemical ones. More often than not, chemical and life sciences-based inventions spin out of an inventor’s work.

## Duties of an employee

An invention made by an employee is taken to belong to their employer if it was made in the course of the employee’s normal, or specifically assigned, duties, assuming those duties might reasonably be expected to result in an invention. Employees in Research and Development departments can generally expect their employer to own the rights to any inventions resulting from their work. Further, although a contract cannot leave an employee in a worse position than is granted by law, it is not simply the employee’s contractual obligations that determine the right to an invention because roles evolve over time. As such, it is not always immediately clear whether an invention results from an employee’s duties, often leading to contested rights.

## The grey area

Areas of contention might include cases where inventions are tangentially, or distantly, related to the employee’s duties, or where they are invented outside of the employee’s contracted hours. For example, a researcher employed to create a new compound might use their initiative to invent a piece of laboratory equipment that aids in that process. The extent to which the researcher used the employer’s premises and/or equipment to develop the invention might determine their rights to the invention, although each case must be examined on its individual facts. Further, researchers at universities are often not contracted to set working hours, in which case it could be argued that any inventions even distantly related to their research are always created “on the clock” and are thus owned by the university.

Even less clear are cases where a researcher uses knowledge acquired during the course of their employment to privately create an invention. Whether or not they arrive at the idea for the invention in their spare time is immaterial. Rather, such matters often hinge on whether the knowledge that led them to the invention is so inextricably linked to their work that their employer could argue that it inevitably resulted from their duties. Again, all matters must be considered on their merits, which can make some disputes lengthy and costly.

## Establish entitlement early

The entitlement of the applicant/proprietor is best established before an application as filed. This will also apply when using the upcoming European Unitary Patent system (as discussed in the Summer 2022 edition of Elements magazine). Patents will only be granted unitary effect, or allowed to opt-out of the system, by the entitled rights holder. The consequences of being locked in or out of the system could be costly, making it more important than ever for researchers and employers to understand their rights to any inventions from the outset.

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