

Inventorship on patent applications

What is inventorship?

Inventorship means who is listed as an inventor on a patent application.

The criteria for determining inventorship are different to those applied to determining authorship of a publication. The list of inventors is not a political or subjective way to recognise contribution to a project.

An inventor is someone who **conceived** the subject matter of the invention, i.e. made an intellectual contribution. Someone is not an inventor if they only contributed by carrying out experiments to perform or test the invention at the instructions of another.

Why Inventorship is important

By default, the inventors listed on a patent application own the rights to exploit the invention. However, inventors are often under an obligation to assign their rights to another party. The obligation can be by way of employment or other contractual obligation.

This means that the inventors, or their employers/assignees, own the rights to the technology covered by a patent application. If inventorship is incorrect, then ownership can be disputed and in some cases, the patent may be declared invalid. For some technologies, the stakes are high and the cost of incorrect inventorship can be enormous.

This means that the determination of inventorship should be performed thoroughly and correctly. It should also be performed **before** a patent application is filed.

Determining inventorship

Firstly, the invention(s) must be defined. In general, inventions are new materials, compounds, apparatus, methods or combinations of these.

Secondly, it is necessary to decide who **conceived** the invention. In general, an inventor is anyone who:

- Conceived the initial idea which defined the research which led to the invention
- Devised the experiments/materials which form the basis of the patent application
- Carried out any novel experiments disclosed in the patent specification to validate the invention and which required that person to go beyond merely following standard protocol, for example because unexpected practical difficulties had to be overcome
- Interpreted the data disclosed in the patent application, particularly if the data was unexpected or its implications were unclear

it is necessary to decide who conceived the invention



determination of inventorship should be performed thoroughly and correctly... before a patent application is filed

An inventor is not:

- Someone whose only contribution is validating an invention using known standard protocols
- A technician who simply performs experiments or assembles the invention
- The supervisor or department manager of the person who conceived the invention
- Someone whose only contribution to the invention is an obvious element
- Someone whose only contribution is participation in consultations about the invention before or after conception of the invention

Incorrect inventorship

Correction of inventorship at the patent office is generally allowed when the failure to name the correct inventors occurs unintentionally.

However, when there is deceptive intent in naming inventors, the patent can be declared invalid and patent rights are lost.

Collaborators and third parties

Where collaborations lead to patentable inventions, the relative contribution of each collaborator should be carefully considered. Any collaboration agreements should be reviewed to assess ownership of IP.

If a collaborator is an inventor then it is necessary to confirm who owns their rights in the invention. Typically this will be the institution they work for. In such cases, an agreement should be signed between UniServices and the inventor's institution to clarify ownership.

Third parties may also be inventors. This can include contractors, consultants or service providers and ownership of IP rights may not be clear.

In these cases, please provide the relevant information and any contractual documents to UniServices so we can assess legal ownership.

If ownership is uncertain or incorrect this can negatively affect the value of a technology, deter investment and be expensive to fix.

Contact us

UniServices employs several patent attorneys who can assist in determining inventorship. If you have any questions on this topic or are unsure who should be named as an inventor on your invention, please contact an IP Advisor at UniServices.

*when there is
deceptive intent in
naming inventors,
the patent can be
declared invalid and
patent rights are lost*

