

How Non-Patent Lawyers Can Help Protect Their Clients' Rights (Part 2 of Two Parts)

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PATENT OWNERSHIP PITFALLS: GET IT IN WRITING

In general, patent rights can be asserted only by the patent owner. Therefore, it is important for your client to make sure it owns the inventions it is entitled to. Establishing and documenting ownership issues can help your client avoid the nightmare of attempting to license, sell, or sue on a patent that it does not actually own.

Employees. In the United States, inventors are presumed to own their inventions unless they assign their rights to another entity. If your client is the employer, your client should require its employees to assign their rights in any inventions they may develop in the course of their employment. The agreement should be a written condition of employment and should require the employee to cooperate in the filing and handling of any patent applications. This clarifies ownership from the outset and may prevent future disputes. Then, when a patent application is filed, the individual inventors should execute an assignment of the patent application, and the assignment should be recorded by the U.S. Patent and Trademark Office to establish a clear chain of title.

Consultants and Joint Developers. When people from different organizations work together, invention ownership issues can get confusing. Having an agreement in place at the beginning of a consultation or joint venture can help prevent these issues from arising.

If your client is working with an independent consultant on a product design, your client should have an agreement specifying that any inventions to which the consultant contributes are owned by your client. The consulting agreement should impose an affirmative duty on the consultant to assign any rights in the invention and to cooperate in the filing and handling of any patent applications. Similarly, if your client is working with another company to jointly develop a new product, the joint development agreement should have a clause that specifies who owns any resulting inventions. If your client's bargaining position precludes it from getting rights to all inventions, the invention clause should be narrowly drawn to avoid losing patent rights in later developed inventions or inventions that are beyond the scope of the joint development effort.

A patent attorney can advise you about invention clauses to include in your clients' employment, consulting, and joint development agreements.

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