

## Determining Inventorship

Steven J. Hultquist

Inventorship is an important legal issue for two reasons. First, there are important ownership implications. In the absence of a contractual arrangement or an employer-employee relationship, inventorship equals ownership, i.e., the inventor owns the invention. An inventor can contractually, grant rights to inventions to another entity. Where there is an employee-employer relationship, the employer may own inventions made by the employee in the normal course of employment.

The ownership implications of inventorship are important when companies and other institutions work together on collaborative research. In such circumstances, two or more institutions may employ inventors and may obtain ownership rights in a single invention. Absent contractual provisions to the contrary, each of these institutions will have a complete right to exploit the invention and the ultimate value of the patent may be seriously damaged by competition between the joint owners.

Additionally, inventorship is an important legal issue because incorrectly identifying inventors can invalidate a patent. Why would inventors be incorrectly identified? Inventors often confuse joint inventorship with co-authorship of a journal article. A co-author can be a mentor or other colleague with whom general discussions were held, a department chairman who had nothing to do with the research personally but who may have funded the work, or perhaps a graduate student or research assistant or other collaborator who carried out specific instructions or provided an important reagent or sample. None of these activities satisfies the legal standard for inventorship.

The key to the legal standard for inventorship is "conception." Conception refers to the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice. For example, conception of a pharmaceutical compound is generally a matter of conceiving of the structure of the compound and its pharmaceutical properties. To constitute joint inventorship, each party must contribute to the conception of the invention. Listing a person as an inventor who did not originally conceive of the invention could jeopardize the validity of a patent.

Because of these ownership and validity issues attached to inventorship, inventors and their employers should work closely with their patent attorneys to ensure that the inventors are accurately identified.