

Guide to inventorship

This note gives a brief outline of how to determine who is an inventor on a patent application, or a contributor to the technical and commercial success of a research project.

A patent application has just been filed on some research I was involved in. I'm going to be the author on a publication based on that research, does that also make me an inventor?

No, being an inventor on a patent application is not like being an author; there are very specific legal rules for who is named as an inventor.

But if I am not an inventor, can I still benefit from the invention?

Yes! If you are a contributor to the project you may still benefit from commercial success in the same way that the inventors can benefit.

Why is this so important?

Determination of inventorship is a legal question based on facts. This is very different to authorship of a journal publication where listing authors correctly is a research conduct or moral issue, but the publication is still valid if you name an author incorrectly. If the correct inventors are not named on the patent application then this can be challenged in court, and can result in revocation of a granted patent. Don't "courteously" name inventors on an application: if someone is not an inventor then they must not be listed as an inventor.

Who is an inventor?

An inventor is defined in the Patents Act as the "actual deviser of the invention". Therefore we have to determine two things:

- What is the inventive concept, and
- Who formulated the inventive concept?

Determining the inventive concept:

What is at the heart of the invention?

This is normally embedded in the claims of the patent application (the numbered list at the back of the document). However, the patent application as a whole must be considered as well because other features in the application could end up in the claims as the application goes through the patent process.

Determining inventorship:

Who contributed to devising the inventive concept(s)?

This is someone who has had ideas related to the inventive concept or a new way of looking at the discovery. This is not those who performed the experiments to prove that the ideas work.

Who is a contributor?

Contributors are team members who work in various roles on the project and contribute to the success of the project. An inventor is always a contributor, but a contributor is not always an inventor! However, just because someone is a contributor rather than an inventor, this does not mean that their contribution is any less valuable. An invention often makes up a small part of a project, and not all contributors may be involved in the invention.

How can I tell the difference?

Inventor	Contributor
Conceives the idea or is part of the discussion that did, i.e. a 'light bulb moment'	Puts forward a hypothesis
Materially contributes to the development of the invention, e.g. identifying the significance of a result which led to the invention	Builds or tests the invention after the idea has been conceived
Follows the instructions of a supervisor using initiative and creativity to take the idea further (towards the inventive concept)	Carries out instructions of a supervisor without making significant changes over and above those instructions
Provides solutions to problems	Acts as a supervisor on the project but does not contribute to the inventive concept
	Writes up results, formulates and/or publishes a paper

Are supervisors and students always joint inventors?

Not necessarily: students, postdocs and supervisors often work together on a problem, but this is not always the case. Therefore, the student, postdoc and supervisor may be joint inventors or any one of them could be the sole inventor.

How can contributors be rewarded?

During the process of filing a patent application, the project leader will be asked to give a list of contributors to the success of the project – which will include inventors. The project leader will need to agree with all contributors their relative contributions and everybody signs the form to say they agree.

If the project is commercially successful (for example, if the patent is licensed and there is revenue back to the university) then all the contributors (which includes inventors) benefit according to this.