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Q My former business partner and I were directors of a small company. We filed a UK patent application to protect an invention of ours, which subsequently became one of the company's best-selling products. He recently left the company, following a disagreement over the direction of the business. I have now received a letter from him informing me that he owns the patent covering the product and that the company should stop making and selling the product. What can I do?

A I assume that the writer and his former partner jointly devised the invention of the patent. As an inventor the writer has a legal right to be so named on the patent. If the writer is not already so named, he could apply to the Patent Office to have this rectified.

If the former partners were employees of the company when they made the invention, then under UK patent law the invention would be taken to belong to the company, because as directors they would have had a special obligation to further the company's interests.

In that instance, the company would have a strong case that it is properly entitled to the patent and the company could bring proceedings in order to have the patent transferred to it.

On the other hand, if the former partners jointly made the invention at a time when they were not employed by the company, then the patent should properly be co-owned between them.

In this case, the writer would be entitled to do for his own benefit anything in respect of the invention which would otherwise be an infringement of the patent, without the consent of or the need to account to the former partner.

From the company's point of view this would be sub-optimal, since it would not own the patent and its activities could amount to infringement of the patent. Assigning or licensing a share of the patent from the writer

to the company could only be done with the consent of the former partner, which may not be easy to obtain. However, the consent of all of the proprietors of a patent is not required in order to bring proceedings for infringement; hence the former partner could sue the company for patent infringement.

Given the apparent time frame (for example, the product is sufficiently long-standing to have become the company's best seller) it may be that even if the former partner has some personal rights to the patent, he might be considered to have provided his acquiescence to the company operating under the umbrella afforded by the patent. Hence, a court may find that the former partner had at least implied a licence to the company, thereby enabling the company to escape a future claim for patent infringement.

As with all such matters, the devil is in the detail and the writer should consider seeking the advice of a qualified patent attorney.

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