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GOBHOZALEGALPRACTICE.CO.BW
+267 3116371

Tech Tuesdays With Masa.

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DO EMPLOYEES OWN THE PATENT RIGHTS TO THEIR INVENTIONS?

Suppose you are employed by a technology company, and you create your own invention, who is entitled to hold the patent rights to that invention? Is it you, the inventor? Or is it your employer by virtue of your employment contract?

Last week, we briefly touched on Section 10 of the Industrial Property Act. Subsection 4 of the provision states that where an invention is made in execution of a contract of employment, the right to the patent shall, absent any prior agreement, belong to the employer. While this might suggest that patent rights automatically belong to the employer as long as you are an employee, the attitude of the Courts, as seen in case law, is not always so straightforward.

In the famous case of **Electrolux v. Hudson [1977] FSR 312,** Hudson was employed as senior storekeeper by the Electrolux, which manufactured vacuum cleaners. In collaboration with his wife at home, Hudson devised an adaptor for connecting a dust-bag to a vacuum cleaner, which they sought to patent. Electrolux challenged the application and contended that it was a standard condition of Hudson's employment that employees had to disclose any new inventions to the Company and join with it in applying for a patent. The Court held that Hudson was not employed to carry out research or make inventions. Furthermore, he made the invention at home, with his wife, though using the company's materials. It would have been absurd to impose a restraint upon Hudson in respect to any invention.

Similarly, in Harris' Patent [1985] RPC 14, Harris was employed as a manager at Reiss Engineering. He invented an improved valve for which he subsequently applied for a patent. The company contended that it owned the patent rights by virtue of its status as Harris' employer. It was held that Harris' duties as manager were confined to selling valves and dealing with customers. It was not part of Harris' employment to perform duties that might result in invention, therefore, the patent belonged to Harris.

The law as regards employees' inventions was laid down in Lamb v Evans LR 1893 1 Ch 218, where it was held that:

The mere existence of a contract of service does not per se disqualify a servant from taking out a patent for an invention made by him during his term of service, even though the invention may relate to subject matter germane and useful for his employers.

In **Robb v. Green LR [1895] 2 QB 315** it was held that:

Even though the servant may have made use of his employer's time, servants and materials in bringing his invention to completion, and may have allowed his employers to use the invention while in their employment. All circumstances must be considered in each case.

Takeaway

Regarding the question of whether employees retain ownership of their inventions, our response, though reminiscent of a typical legal answer, is that it depends. As evidenced by the cases cited above, inventions created within the course and scope of one's employment generally belong to the employer. However, exceptions may apply if the employee's role does not primarily involve invention. Nevertheless, each case is decided based on its unique circumstances.

If you have interest in an in-depth discussion on this subject matter or any AI or Intellectual Property issues, feel free to contact us at **info@gobhozalegalpractice.co.bw Tel: 3116371**

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