

## 5 KEY TAKEAWAYS

# Managing Inventorship Issues Arising From Inter-Entity Collaborations

**Kilpatrick Townsend** Partners [Patrick Jewik](#) and [Ken Weber](#) recently presented “**Managing Inventorship Issues Arising From Inter-Entity Collaborations**” at the 2019 KTIPS CLE in Palo Alto. This presentation focused on informal inter-entity collaborations and provided practical guidance on how in-house patent counsel can maximize the opportunities for client employees to be included as co-inventors on inventions arising from such collaborations and how to minimize the chances that gratuitous contributions from non-client collaborators will result in them being named as co-inventors.

5 key takeaways from the presentation include:

1

Common Ownership and Joint Research Agreements under 102(c) are the ideal for inter-entity collaborations; but, you should neither expect nor demand this level of formality for all company or academic interactions.

2

Recognize that collegial conversations and discussions at academic conferences are often the genesis of valuable collaborations. You want to be aware that informal collaborations are inevitable, encourage them within proper context and understand the prospective problems that arise from informal inter-entity collaborations. Those problems include allegations of trade secret misappropriations and co-inventorship disputes.

3

Take strategic advantage of the grey area that defines our laws of inventorship. A fulsome understanding of inventorship case law allows us to take proactive steps to maximize opportunity for your clients' R&D employees to be named as inventors and to minimize the chances that gratuitous contributions by non-employee collaborators will result in them being named as co-inventors.

4

Take the time to educate the R&D team members on the rules of engagement with inter-entity collaborators. The rules include: letting the patent professionals know that the collaboration is occurring; understanding what co-inventorship means; actively participating in collaborations; and properly documenting participation efforts.

5

Decisions to omit collaborators as co-inventors will inevitably lead to hurt feelings and negatively impact the collaboration. Whenever possible, take pro-active steps to make inventorship decisions situationally neutral. Take active responsibility for the determination of co-inventorship.

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