



Industry & Invention
Patent

Utility Patents Ownership, Assignments, and Licensing

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Konomark
Most rights sharable

Patent Ownership

Patent ownership

- the inventor is the owner
- there is no default assignment to employers
 - but employers may get this by the employee's agreement, and virtually every tech-oriented company does
 - an implied assignment is possible
 - with the benefit of such an assignment, a firm can push through an application even without the inventor's cooperation
- courts have recognized employers even without assignment getting a "shop right" by default

Review

What is a license?

Review

Licenses, in general

What is a license?

- It is a permission or consent for the licensee to do something otherwise within the licensor's exclusive rights. ("Exclusive rights" mean the right to exclude others.)
- It is legally cognizable as an affirmative defense to an action for infringement or misappropriation based on some form of intellectual property (copyright, patent, trademark, trade secret, or right of publicity).

Review

Is a license a contract? What's the difference?

Licenses & contracts

Is a license a contract?

Review

- Many courts say so.

"A license is a contract."

Global Communications, Inc. v. Directv, Inc., 4:12CV651-RH/CAS, 2013 WL 11325041, at *2 (N.D. Fla. Aug. 21, 2013) (patent infringement case)

"... a license is a contract ..."

Datatresury Corp. v. Wells Fargo & Co., 522 F.3d 1368, 1371 (Fed. Cir. 2008) (patent infringement case)

"... a license is a contract ..."

Foad Consulting Group, Inc. v. Azzalino, 270 F.3d 821, 828 (9th Cir. 2001)

- **But no, a license is not a contract.**
- **And courts that say a license is a contract almost certainly don't actually mean that ...**

So:

- A license can be one thing exchanged in a contract (like money, goods, warranties)
- But ...
- A license is not a contract.
- And ...
- THERE IS NO SUCH THING AS BREACH OF LICENSE!!!!!!

Patent licenses and assignments

Review

Patent Licenses

- A patent can be validly licensed on a non-exclusive basis by any of its co-owners
- A licensee need only obtain a license from just one co-owner to be protected from liability for infringement
- There is no duty to account among co-owners

Patent Assignments

Patent assignments

- must be in writing
- may be recorded with the USPTO
 - recording an assignment is important, because ...
 - a subsequent purchaser or creditor with a security interest will have a superior claim to an unrecorded assignment!