



Patents - *Inventors & Ownership*

Karen Mongey (IP Manager) | August 2023



Acknowledgment of Country

I would like to begin by acknowledging the Turrabal as the Traditional Owners of the land that we're meeting on today. I pay my respect to their Elders past and present and I recognise their continuing connection and custodianship of the lands, seas, and waters throughout Australia.





Overview

- Intellectual Property (IP)
- What is a patent?
- Inventorship (Patents) & Ownership – Why does it matter?
- Joint Ownership (Patents)
- Background IP Vs Project IP



What is Intellectual Property?

Anytime you create something new and original, you are creating IP.

Australia's IP Laws provide a legal framework to protect your creative ideas through IP rights.



The IP System

Registered IP

Plant Breeder's Rights

Protects the commercial rights of new plant varieties

Patents

Protects the functions or features of a device, substance, method or process that is new, inventive and useful

Designs

Protects the overall visual appearance of new and distinctive products

Trade Marks

distinguish goods or services of one trader from those of another



Unregistered IP

Copyright

Protects the owner's original expression of an idea when put in material form

Trade Secrets

Protects confidential information, including secret formulas, processes and methods

Circuit Layouts

Protects the layout of integrated circuits, such as computer





Patents



A patent may be granted only for a new, inventive and tangible invention (“*manner of manufacture*”)



This protection gives the owner the exclusive right to determine how the patent can be used and who can use it.



Protection lasts for 20 years, and up to 25 years for pharmaceuticals.



Patents – suggested business benefits

- To achieve **optimal impact** from your research
- **Financial sustainability** - financial returns to reinvest in research
- To attract productive, world class **collaborations** and other external engagement **opportunities**
- IP assets - Currency to **access** another party's IP or to stop competitors from **blocking** your research



Inventions from Healthcare space (Australia)

- Medical Devices
- Pharmaceuticals/therapeutics
 - Products
 - Process
 - Uses
- Diagnostic methods
- Methods of Treatment

- **Excluded:** Humans and biological processes for their generation



Inventions from SVHS

Therapeutics and methods of treating obesity/cachexia

- Aveo Pharmaceutical – therapeutic antibody for treatment of (inhibit GDF15)
- Novo Nordisk – phase I trial for treatment of obesity (GDF15)
- Roche Diagnostics – clinical assay for CVD

Ventricular Assist Devices (VAD)

- Improvements to existing commercial VAD

Inventorship! It's a fundamental issue

"... a patent ... may only be granted to a person who:

- (a) Is the inventor; or*
- (b) ... [is] entitled to have the patent assigned to [it];*
- (c) [otherwise] derives title to the invention ...; or*
- (d) Is the legal representative of a deceased person ..."*



- Determines Entitlement/Ownership
- Incorrect entitlement at grant is a ground of invalidity

Inventors - Why does it matter?

Too few!

- The patent could be invalidated (unenforceable!)
- Or allow a competitor to acquire a share of the patent

Too many!

- Patentee may not be entitled and the patent be invalid





Who is an **inventor**?

The concept of who is an inventor is difficult to define under patent law but essentially it is a person who, when faced with a problem, *materially contributed* to its solution.

- **Amount of contribution is irrelevant**
- The question is whether there was a contribution or not.
- If there was contribution, was it significant in quality



“But for the involvement of person X, would we have arrived at the invention?”



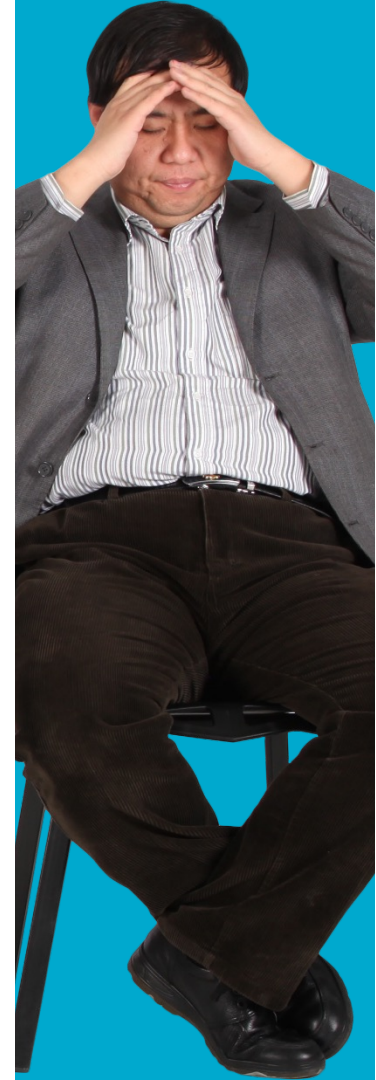
Different to “Inventive Contribution” – commercial meaning

Negotiated position for sharing commercialisation revenue



Entitlement/Ownership - Typical issues:

- No true inventor has been named
- One or more additional inventors should have been named
- One or more named inventors are not true inventors
- Disputes between employers / employees
- Disputes between collaborators / partners
- Disputes between inventors and consultants
- No clear chain of title between inventors and applicant / patentees
- Invention not conceived in course of employer / employee relationship and no valid assignment in place





Passport Agreement

Background IP

IP owned by the Partner or Collaborator (contributor) **that is needed for performance of the research**

Project IP

IP arising from the research/project
Who will be the PIP Owner?

Where a patent arises – will need to address Inventorship



Passport Agreement – Joint Ownership (Patents)

- Each co-owner is entitled to use the rights without needing the consent of the other co-owners.
- None of the co-owners may grant a licence or assign their share of the rights, without the consent of all the other co-owners.





Uni. of Western Australia v Gray [2009] FCAFC 116

Dr Gray was involved in three microsphere related inventions for treatment of cancer

Inventions were developed over long period during his tenure at different institutions

Gray assigned to Sirtex for shares (valued at A\$60-90 million)

KEY TAKEAWAY – Never assume ownership!

Thank you

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