

DATAQUEST

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Patent Your Invention

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Q. We are a software service provider based in Bengaluru and work mostly for clients in the US. While working on the product of the client, I got an interesting idea to perform a task more efficiently or I may call it an innovation. If I file for a patent for the same, would I violate service agreement with the client?

Firstly, you need to look into the services agreement in depth, as the terms and conditions of the agreement solely defines scope of the things you can or can't do. If there is a specific clause on Intellectual Property (IP), most likely the whole IP that is developed by your company would be required to be assigned to the client. As far as copyright is concerned, under work-for-hire doctrine, the work created by you might belong to the client as your company has been commissioned by the client to perform a specific task.

As far as patent is concerned, as per law, patent application shall be filed by a person who is a true and first inventor. As per the Indian Patent Law,

true and first inventor does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India. Assessment of your question shall be done in light of this requirement. If you are simply working on the guidelines of the client, you may not be called as true and first inventor. However, if the innovation you have come up with is not part of guidelines of the client, you may be considered as true and first inventor.

Other than the inventorship, it is extremely important to assess whether the innovation fulfils the criteria of patentability (novelty, inventive step, and industrial applicability) or not, that can be assessed by means of a patent search or a novelty search. Now comes the complex question that whether you can file for a patent in your name or not. There are couple of things to be considered, in synchronization with the terms and conditions of the agreement.

Though the inventor's name is essential, the ownership of the patent lies with the assignee.

In the long run, this would not only enhance quality of the services you are offering but also give you chance to obtain ownership over IP by means of IP as an asset gets build up, that might play critical role in valuation of your company. The other option could be that the invention is assigned to the client or even joint ownership with the client can be worked out. Last not the least, read the agreement carefully before signing and you may certainly negotiate on certain aspects of it as far as IP is concerned.

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