

European Opposition Tactic Using Ambiguous Patent Conveyances in Employee Agreements

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Opponents in Europe have been invalidating priority claims in European patent applications using a formalistic challenge. In Europe, in order to have a good priority claim the applicant listed on the priority application must be identical to the applicant listed on the International PCT application, or the successor in title to the applicant must be listed on the PCT application. However, this successor in title must have received legal title in the priority application prior to filing the PCT application. Opponents have been using US case law that distinguishes between language that provides a present assignment (e.g. I hereby assign) and language that creates an obligation of assignment (e.g. I agree to assign) to argue that the successor in title listed on the PCT application did not have legal title until after the PCT application was filed, invalidating the priority claim.

Often provisional patent applications filed in the US have not been assigned prior to converting them to a PCT application. Subsequently, the PCT application has been filed in the name of the assignee without the existence of a present assignment. This forces employer applicants to rely on their employment agreements to ensure a valid priority claim. Thus, the language in the employment agreement can be crucial to keeping valid patents in Europe.

There are a variety of best practices for ensuring valid priority claims in Europe. Which practice is used depends on your specific situation. Actions must be taken proactively to ensure patent validity. One typically cannot wait for the problem to occur and then remedy it later.

If you have concerns regarding your employment agreement our IP and Employment teams would be happy to review your agreements and provide suggestions on shoring up any IP or employment issues that could be present.