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Do I Have The Right To Refuse To Assign The Patent Rights?
[Kristie Prinz](#)

Q.

I am being asked to sign an "Assignment" agreement related to a process, the company I work for has applied for a patent on. I brought the idea forth and developed the idea into a working process. I was not originally hired to develop this idea and I brought prior knowledge with me before employment.

I did not sign an assignment agreement for intellectual property at the start of employment.

What are my rights? Do I have to sign the document? What happens if I do not sign the agreement?

-- Anonymous

A.

Your question is one that I receive quite often from engineers, and the reality is that this is a tough place to be in.

It is a standard practice in many industries to require employees before they begin a new job to sign an assignment agreement, transferring all right, title, and interest to any intellectual property they develop during the course of that employment. However, you have specifically indicated in your question that you were never asked to sign such an agreement. So, certainly there is no document at this point in time that requires you to transfer rights in your invention to your employer.

Without such an agreement in place, the general rule is that the employer owns the rights to an invention if the employee was hired or directed to resolve a problem by conceiving the invention. In other words, if the employee's job is to conceive or reduce to practice an invention, then the rights in that invention or the patent filed on that invention belong to the employer. According to the facts you have presented, you were not hired to develop the invention and you may even have conceived the invention prior to beginning your employment with your present employer. So, based on the facts you have provided, your employer may not

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really have any real right to the invention you conceived.

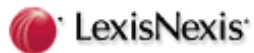
The problem with all of this, however, is that employment is typically at-will, meaning that your employer can fire you at any time for almost any reason, with only a few exceptions. Thus, while you may not be legally required to assign the rights in your invention to your employer, there may be consequences for not doing so. You could very well be putting yourself on a short list to be let go.

In weighing your options, you should take into consideration whether you would likely do anything with the invention if you refused to assign it. Do you have the money to file a patent on it? Hiring an attorney to prosecute a patent is not cheap, and if you do not have the kind of income that would enable you to protect your invention yourself and then do something with it after the fact, it may not be worth putting your employment at risk over the rights to it. I had this discussion with another engineer about a year ago, and this was the deciding factor for him.

My advice is to consult with a patent prosecutor in your jurisdiction to inquire about the cost of filing a patent, in order to determine whether or not this is something you would really want to pursue yourself, and to discuss the specific facts of your case in more detail. Also, you may want to speak with an employment attorney in your jurisdiction to inquire as to whether or not there is any case or statutory law in your jurisdiction to protect employees caught in this situation. After you have spoken to both attorneys, you should be in a better position to make a decision about what option is best for you.

-- *Kristie Prinz*

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