

3. *Engagement of employé for the purpose of making improvements in specific articles.*—The accepted doctrine in the United States is, that a contract by which a skilled workman merely agrees, for a stated compensation, to devote his time and services to devising and making improvements in articles manufactured by his employer does not operate so as to vest in the employer an inchoate legal title to the inventions of the workmen or to patents obtained by him for those inventions¹. The workman will not be compelled under such circumstances to assign to the employer the patents which he has taken out in his own name². A contract of this description, however, even if it contains no express provision on the subject³, subjects the employé to an obligation, the nature and extent of which has been thus stated by the Supreme Court of the United States:

"When one is in the employ of another in a certain line of work, and devises an improved method or instrument for doing that work, and uses the property of his employer and the services of other employés to develop and put in practicable form his invention, and explicitly assents to the use by his employer of

¹ *Whiting v. Graves* (1878) 1 Holmes 222, 3 Bann. & Ard. Pat. Cas. 222, Fed. Cas. No. 17,577; *Clark v. Fernoline & Co.* (1889) 23 N.Y.S.R. 964; and cases cited in the next note.

In a case where the only question involved was one of priority, it was laid down that one who is the first discoverer of a process is entitled to a patent therefor, even against one in whose employ he was at the time of the discovery, and at whose request and expense he was making experiments which led to the discovery. *Damon v. Eastwick* (1882) 14 Fed. 40.

Compare the analogous rule, that "one partner acquires no right or interest, legal or equitable, in an invention made by his copartner during the existence of the partnership by reason merely of the copartnership relation, although the invention relates to an improvement in machinery to facilitate the business carried on by the firm, and although the partner making the invention, uses copartnership means in his experiments, and is also bound by the copartnership articles to devote his whole time and attention to the firm business. *Burr v. De La Vergne* (1886) 102 N.Y. 415, citing *Stemmer's Appeal* (1868) 58 Penn. St. 155, 164; *Belcher v. Whittemore*, (1863) 134 Mass. 330.

² *Hapgood v. Hewitt* (1886) 119 U.S. 226; *Dalsell v. Dueber Watch Case Mfg. Co.* (1892) 149 U.S. 315, 37 L. ed. 749, 63 Off. Gaz. 1381, 13 Sup. Ct. Rep. 886; *Clark v. Fernoline Chemical Co.* (1889) 23 N.Y.S.R. 964.

³ For example of cases in which such a stipulation was involved, see *McAleer v. United States* (1893) 150 U.S. 424 (written agreement given in evidence); *Bensley v. Northwestern & Co.* (1896) 26 Fed. 250 (preponderance of evidence held to be in favour of the servant's consent having been given by parol).