



**ASSOCIATION INTERNATIONALE
POUR LA PROTECTION
DE LA PROPRIETE INTELLECTUELLE**

**INTERNATIONAL ASSOCIATION
FOR THE PROTECTION
OF INTELLECTUAL PROPERTY**

**INTERNATIONALE VEREINIGUNG
FÜR DEN SCHUTZ DES
GEISTIGEN EIGENTUMS**

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OCTOBER 10, 2015 - OCTOBER 14, 2015**

Q244: INVENTORSHIP OF MULTINATIONAL INVENTIONS

**WORKING GUIDELINES, GROUP REPORTS,
SUMMARY REPORTS, RESOLUTIONS**

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AIPPI General Secretariat

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THE QUESTIONS ON THE AGENDA

**WORKING GUIDELINES
GROUP REPORTS
SUMMARY REPORTS
RESOLUTIONS**

LES QUESTIONS A L'ORDRE DU JOUR

**ORIENTATIONS DE TRAVAIL
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DIE FRAGEN DER TAGESORDNUNG

**ARBEITSRICHTLINIEN
BERICHTE DER LANDESGRUPPEN
ZUSAMMENFASSENGE BERICHTE
ENTSCHLIESSUNGEN**

I.

THE QUESTIONS ON THE AGENDA

LES QUESTIONS A L'ORDRE DU JOUR

DIE FRAGEN DER TAGESORDNUNG

The Questions on the Agenda

- Q244 Inventorship of Multinational Inventions
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- Q246 Exceptions and limitations to copyright protection for libraries, archives and educational and research institutions
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- Q245 Tirer indûment profit des marques: parasitisme et « free-riding »
- Q246 Exceptions et limites de la protection du droit d'auteur pour les bibliothèques et archives et pour les instituts de recherche et d'enseignement
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- Q244 Erfinderschaft an multinationalen Erfindungen
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II.

QUESTION Q244

INVENTORSHIP OF MULTINATIONAL INVENTIONS

QUESTION Q244

LA QUALITÉ D'INVENTEUR POUR LES INVENTIONS MULTINATIONALES

FRAGE Q244

ERFINDERSCHAFT AN MULTINATIONALEN ERFINDUNGEN

Working Guidelines

by Sarah MATHESON, Reporter General
John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
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Assistants to the Reporter General

Question Q244

Inventorship of multinational inventions

Introduction

- 1) This Working Question concerns the issue of inventorship of inventions where the inventors reside in different countries. Due to the prevalence of international corporations having geographically distributed research groups, multi-national joint venture projects, international corporate/university collaborations, and other cross-border research projects, and further due to the ease of international communications and exchange of data, international joint inventorship is today a common occurrence.
- 2) International joint inventorship presents a number of substantive and procedural challenges for the patent owner. These challenges include the following.
 - a. **Determination of inventorship.** The laws defining who is considered to be an inventor of an invention claimed in a patent application vary from country to country. Thus, in the case of multinational inventions, different laws concerning inventorship may apply to different inventors. However, the validity or enforceability of multiple patents ultimately issuing in various different countries from a single patent application directed to a multinational invention will depend on the correct identification of inventors according to each country's national laws.
 - b. **Foreign filing restrictions.** Many countries place restrictions on an inventor's ability to file a patent application in a foreign country. These restrictions generally fall in three categories, as set forth below.
 - i. **First filing requirements.** Some countries require that patent applications claiming inventions made in their country be filed first in their country. In the case of multinational inventions, it may be difficult or even impossible for the patent owner to comply simultaneously with the first filing requirements of each of the inventors' home countries.
 - ii. **Foreign filing licenses.** Some countries have a procedure for requesting permission to make the first filing of a patent application in another country. However, these procedures are not available in all jurisdictions and, even where available, they can differ substantially in terms of cost and delay.
 - iii. **Secrecy review.** First filing and foreign filing license requirements generally exist to provide governments with an opportunity to perform a secrecy review prior to a patent application being filed in another country. Some countries require that an invention that is desired to be claimed in a patent application undergo a secrecy review to determine if it relates to certain technology areas that are considered national secrets, or if it otherwise impacts national security, before it may be sent outside the country for the purpose of filing a patent application. Failure to comply with these requirements may result in loss of patent rights or even in criminal sanctions.

- c. **Inventor remuneration.** Some countries have requirements relating to the amount of remuneration an employee must receive for an invention made by the employee and filed in a patent application by the employer. This remuneration may be due at different times, such as at the time of filing the initial application, the time of issuance of a patent, and/or at the time of licensing the patent. These requirements vary from country to country, and some countries have no such requirements. Hence, inventor remuneration is an extremely complex topic in the context of multinational inventions.
 - d. **Ownership of the invention.** The laws relating to who owns an employee-made invention, and the actions necessary to properly vest the ownership rights in the employer, vary from country to country. Hence, inventors of a multinational invention may need to be treated differently depending upon their country of residence or citizenship, the domicile of the employer, and/or the national law of the employment contract.
- 3) Of the various considerations listed above, ownership of the invention and inventor remuneration will not be considered in this Working Question. The topic of ownership of the invention was considered in a series of recent resolutions of AIPPI, as summarized below, and thus need not be revisited at this time. The issue of inventor remuneration has not yet been considered by AIPPI in a Working Question. While this is a very important issue for the topic of multinational inventions, it is beyond the scope of this Working Question, and will be reserved for later study.

Previous work of AIPPI

- 4) AIPPI has previously studied aspects of the subject matter of this Working Question in connection with Q183 - "Employer's rights to intellectual property." In the Resolution on this question (Geneva, 2004), AIPPI considered as follows:
- a) *That the large majority of subject matter protected by intellectual property in today's world is created within the framework of an employment relationship.*
 - b) *That the existence of considerable differences between national laws concerning employers' and employees' rights to intellectual property causes complications and problems for cross border R&D both within multinational enterprises and for cooperation between companies.*
 - c) *That the ownership of the intellectual property rights should be governed by harmonised rules since it has an impact on their prosecution and their enforcement.*
- 5) AIPPI has also studied aspects of the subject matter of this Working Question in connection with consideration of issues relating to co-ownership of inventions. In the Resolution on Q194 - "The Impact of Co-Ownership of Intellectual Property Rights on their Exploitation" (Singapore, 2007), harmonized recommendations included:
- 1) It is recommended that all countries adopt rules in their IP laws concerning the co-ownership of IP rights and that those rules be harmonized.
 - 2) Co-owners should be free to organize their co-ownership arrangements. In the absence of such arrangements national law regulating co-ownership of IP rights should apply.
- 6) In the Resolution on Q194BA – "The Impact of Co-Ownership of Intellectual Property Rights on the Exploitation" (Buenos Aires, 2009), harmonized recommendations included:
- 4) *For the sake of the legal certainty and inasmuch as the national laws are not harmonized on the co-ownership of intellectual property rights, as was held in the Singapore resolution, co-owners of an intellectual property right should be allowed to decide on the choice of law and jurisdiction in connection with resolution of disputes among co-owners.*

When the co-owners of an intellectual property right have not entered into an agreement or have not specified the applicable law in their agreement, that relationship between the co-owners (such as, regarding the right to license, exploit or assign etc.) should be governed by a single law.

In determining this single law, the principles of private international law should apply, preferably by using the principle of closest connection. To this end, it is recommended that among the possible factors for deciding such closest connection are the country where the co-owners are domiciled and the place where the relevant right was predominantly created, first used or first filed.

In view of the importance and complexity of the issue of the law applicable to the relationship between co-owners of intellectual property rights, AIPPI recommends that this issue should be addressed in the context of international regulations and/or treaties. The non-contractual relations between co-owners and third parties shall be governed by the law of the country that confers protection or where the right may be enforced.

- 7) At the Executive Committee in Hyderabad in 2011, a workshop was held entitled “Multinational Inventions – How to Reconcile IP Issues.” Speakers from the United States (US), China, Germany, and India addressed various aspects of this topic. The presentations from that workshop are available on the AIPPI website.

Definitions

- 8) **Multinational Inventions.** For the purposes of this Working Question, **multinational inventions** means inventions having two or more inventors where different national laws concerning inventorship apply to at least two of the inventors. In the most common case, this would involve, for example, a first joint inventor of citizenship X residing in country X who is a co-inventor of an invention with a second joint inventor of citizenship Y residing in country Y. However, different national laws may apply to the (at least) two inventors even if they are of the same citizenship, but reside in different countries. Different national laws may even apply to the two inventors if they reside in the same country, but are of different citizenship or have employment contracts under different national laws.
- 9) **First filing requirement.** For the purposes of this Working Question, a **first filing requirement** means a requirement that a patent application for an invention – be it all inventions or only inventions in certain technology areas – that is made or partially made in a country be filed first in that country before filing in any other country.
- 10) **Foreign filing license.** For the purposes of this Working Question, a **foreign filing license** means any procedure or mechanism for obtaining an exemption to a first filing requirement.
- 11) **Secrecy review.** While the first filing requirement is a procedural requirement, **secrecy review** as used in this Working Question refers to a substantive review by a governmental authority of the subject matter of a patent application to determine whether it implicates national security or other national interests, or includes subject matter that must be kept secret.

Discussion

Determination of inventorship

- 12) Existing laws defining who should be considered an inventor of an invention claimed in a patent application vary from country to country. In the case of a utility patent application with

multiple joint inventors, an individual inventor may have contributed to all, some, or only one of the claims in the application. An individual involved in the research leading to the invention may have contributed to the invention in a way that falls within the definition of inventorship in one country but not in another. In some countries, customary practices may historically take precedence over a strict legal determination of inventorship. For example, it may be a common practice to list all members of a research team as joint inventors, regardless of individual contribution. In some countries, a research team leader or lead professor may be listed as a joint inventor to show respect rather than due to an actual inventive contribution.

- 13) In China, for example, an inventor is a person who makes *creative contributions* to the *substantive features* of an invention. On the other hand, a person who is responsible only for organizational work, who offers facilities for making use of materials and technical means, or who takes part only in other *auxiliary functions*, is not considered to be an inventor. While, from a legal perspective, the “substantive features” refer to those features that distinguish the invention from the closest prior art and thus render the invention patentable, in practice they are generally considered as the act of proposing the original idea of the originally claimed invention.
- 14) Japan has a system similar to that of China. Specifically, only a person who has substantially engaged in the creative process of an invention can be named as an inventor. In contrast, the following persons may not be named as an inventor: (1) a supervisor who simply controls researchers (e.g. provides researchers with a subject without indicating any substantial solution); (2) a person who simply follows instructions from a researcher to collect data or conduct experiments; or (3) a person who contributes to the completion of an invention merely by providing the inventor with funds or facilities. This system has been established by case law.
- 15) In the US, the inventorship determination turns on who “conceived” the invention. Thus, in the case of an invention that results from a team effort, it is necessary to distinguish between the person or persons who contributed to the conception of the invention and the others who merely acted under the direction of the conceiver, for example, to reduce the invention to practice. US patent law (35 U.S.C. §116) specifically addresses joint inventorship:

(a) JOINT INVENTIONS. — When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.
- 16) Indian patent law allows an application for patent to be made by “any person claiming to be the true and first inventor of the invention.” (Patent Act, Section 6(1)). “True and first inventor” is defined as one which “does not include either the first importer of an invention into India, or a person to whom an invention is first communicated outside India.” (Patent Act, Section 2(y)). The term “inventor” is not defined in the Act but has been interpreted generally to mean one who contributes any part of his ingenuity, skill, or technical knowledge towards the invention.
- 17) The European Patent Convention does not provide a definition of “inventor” or “co-inventor”. Thus, inventorship is determined according to national laws. When the Agreement on the Unified Patent Court enters into force, the national courts will remain competent for disputes regarding inventorship of European patents and European patents with unitary effect. The German case law recognizes an inventor as a natural person who has recognized the inventive idea and developed instructions for a technical action in a creative act; a co-inventor is a person who made his or her own creative contributions to the inventive idea. In

the United Kingdom (UK), an inventor is defined as “the actual deviser of the invention,” which generally means one who contributed to a patentable aspect of the invention. Under French case law, an inventor is the person or persons from whom the invention and the inventive step originated.

- 18) If an incorrect indication of inventorship is made on a patent application, the consequences of this error vary from country to country. The issued patent may be held to be invalid or unenforceable in some jurisdictions but not in others. The error may be correctable in some countries, but not in others.
- 19) It is apparent from the examples above that the definition of who is an inventor – if such a definition even exists – varies significantly among different jurisdictions. This presents a serious challenge to ensuring correct indication of inventorship on a patent application in the case of multinational inventions.

Foreign filing restrictions

- 20) Once it has been determined that the joint inventors of a desired patent application are, for example, inventor A in country X and inventor B in country Y, it is then necessary to determine how to comply with national laws relating to first filing requirements, foreign filing licenses and secrecy reviews. These laws, which exist in various forms in some countries and not in others, generally seek to force first filing in the home country so as to provide the government with an opportunity to review the subject matter and ensure that certain categories of information are not transmitted outside the country.
- 21) However, in the example, it should be evident that regardless of where the patent application is ultimately filed, the information has already been exchanged among the inventors due to their joint inventorship. Thus, national laws prohibiting sending certain information out of the country, and the intent if not the letter of the foreign filing requirement, may have been violated by the exchanges of a draft patent application within the research team itself, even before the issue of where to first file the patent application arises.
- 22) As to procedural compliance with the national first filing laws, if both country X and country Y have a first filing requirement, it may be impossible to comply with both laws unless one country has a foreign filing license provision that would allow obtaining a license to file in the other country. Even in this case, the procedure can be complex.
- 23) Consider a jointly made invention with one inventor in the US and another in China. Filing the application first in the US would violate Chinese law. Filing the application first in China would violate US law. Making a request for a foreign filing license in China, which would require describing the invention to the Chinese authorities, could violate US law. However, filing a request for a foreign filing license first in the US, followed by an actual filing first in China, may satisfy both country’s laws (this point is not clear under the relevant law, but many companies follow this practice). It is apparent that the complexity increases exponentially as additional joint inventors from other jurisdictions are added.
- 24) The degree of variation in this area of the law from country to country is extreme. For example, just within Europe, Austria, Estonia, Iceland, Ireland, Latvia, Monaco, San Marino, Serbia, Slovenia, Switzerland and Liechtenstein have no security / first filing provisions. Denmark has provisions that are limited to technologies related to war material or processes for the manufacture of war material. The UK, Germany, and the Netherlands have provisions that are limited to defense-related technologies. France’s and Italy’s security provisions apply irrespective of technology. The German provisions, when implicated by the involved

technology, mandate no disclosure at all, while those of the Netherlands, the UK, France and Italy mandate a first national filing. Among these, obtaining a foreign filing license is possible in France, the UK, Germany and Italy.

- 25) The criteria for application of these provisions also differ among, for example, nationality or domicile of the applicant (Netherlands, France and Italy), residency of the inventor (UK and France), and content of the invention (Germany and Czech Republic). Outside Europe, countries including India, China, Korea (limited to defense-related technology), Russia, and the US have first filing or secrecy review requirements. No such requirements are found in other countries such as Japan, Canada, Australia and Mexico. Countries such as the US and China have provisions to obtain foreign filing licenses, while other countries such as Russia and Spain do not.
- 26) With the continued increase in multinational inventions, the substantive and procedural issues above have become increasingly problematic. A harmonized approach to determining inventorship, and a balanced, harmonized approach to protecting national security interests while providing reasonable, usable, and understandable avenues for compliance with first filing and foreign filing license requirements are strongly needed.

You are invited to submit a Report addressing the questions below. Please refer to the 'Protocol for the preparation of Reports'.

Questions

I. Current law and practice

- 1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.
 - a. *If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?*
 - b. *Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?*
- 2) Does your law of inventorship depend on the citizenship of the inventor(s)?
- 3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?
- 4) Can the inventorship of a patent application be corrected after the filing date in your country?
 - a. If yes, what are the requirements and time limits for such correction?
- 5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?
- 6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

If the answer is yes, please answer the following:

- a. Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
 - b. Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
 - c. If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
 - d. How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
 - e. In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
 - f. What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?
- 7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?
- a. If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?
 - b. If yes, describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
 - c. If yes, describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II. Policy considerations and proposals for improvements of the current law

- 8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?
- 9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?
- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?
- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

III. Proposals for harmonisation

12) Is harmonisation in this area desirable?

If yes, please respond to the following questions without regard to your national or regional laws.

Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Argentina

Report Q244

in the name of the Argentina Group
by Gaston RICHELET and Ignacio SANCHEZ ECHAGUE

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Article 9 of our Patent Law states that unless proven otherwise, the natural person or persons designated as inventors in the patent or utility model application will be presumed to be inventors. The inventor or inventors will have the right to be mentioned in the corresponding Certificate.

Article 9 of the Regulations of the Patent Law establishes that the inventor or the inventors that have assigned their rights may request at any stage of the proceedings to be mentioned in the corresponding Certificate, provided they can prove they are inventors. The corresponding request will be served to the assignee for the period of 30 days. In case there is an opposition to the request, the PTO will decide the matter within 30 days counted as from the response filed by the assignee or from the date of production of the requested proof for the decision of the issue.

Although our Law does not contemplate this specific case and there is no case law in this issue, we consider that the inventor should be considered any person who substantially contributed to the invention. In any event, it should be borne in mind that the location of the inventor should not play any role in this respect.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

Our Law does not rely on a particular part of the patent application to define inventorship.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

As mentioned in Article 9 of the Regulations of the Patent Law the inventor or the inventors that have assigned their rights may request at any stage of the proceedings to be mentioned in the corresponding Certificate, provided they can prove they are inventors.

A request must be filed with the PTO and same will be served to the applicant or assignee. If the latter opposes and does not wish to have said person or persons mentioned as inventors, the PTO has a 30 day term to resolve the matter.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

There are no specific rules covering this matter. However, since the case deals with the right to be mentioned of the inventor (moral rights) we believe the patent issued is not at risk of being invalidated or rendered unenforceable.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

- 7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

no

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) **Policy considerations and proposals for improvements of the current law**

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

Our Patent Law does not provide a clear guidance as to who should be mentioned or named as an inventor. It just states that any person mentioned as an inventor will be presumed to be one.

We consider that it would be advisable to include a definition of who should be considered as an inventor (whoever substantially contributes to the invention).

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

N/A

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

N/A

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

We believe that the system as it stands today is fine.

III.) **Proposals for harmonisation**

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

We consider that a suitable international standard of inventorship could be the one stating that an inventor is whoever substantially contributes to the invention.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

We understand that inventorship should be allowed to be corrected during pendency of the application provided the person requesting to be mentioned as inventor proves his or her condition as such.

After grant only the correction of inventorship due to an intentional error should be allowed. The same proof as mentioned above should be requested.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

We do not believe this requirement to be appropriate.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

We do not believe this requirement to be appropriate.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

We do not believe this requirement to be appropriate.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

N/A

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

We believe no further standards are needed.

Summary

Under our Patent Law any person mentioned as an inventor will be presumed to be an inventor. No definition and no specific circumstances that should be taken into account to determine inventorship are provided.

An inventor that has assigned his or her invention may request at any time to be mentioned in the Certificate.

There is no "foreign filing" requirement in Argentina.

Inventorship should be allowed to be corrected at any time during pendency of the application provided the inventor can prove his or her condition. After grant corrections should be allowed only in case of intentional error.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Australia

Report Q244

in the name of the Australia Group
by Grant FISHER and Peter FRANKE

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Section 15(1) of the Australian Patents Act 1990 (**Patents Act**) provides for who may be granted a patent:

"Subject to this Act, a [patent](#) for an invention may only be granted to a person who:

- (a) is the inventor; or
- (b) would, on the grant of a [patent](#) for the invention, be entitled to have the [patent](#) assigned to the person; or
- (c) derives title to the invention from the inventor or a person mentioned in paragraph (b); or
- (d) is the legal representative of a deceased person mentioned in paragraph (a), (b) or (c)."

As entitlement in each of the above instances requires title to be derived ultimately from the inventor, it is necessary to understand the meaning of inventor in this section. It is also worth noting that section 16(1) of the Patents Act deals with co-ownership of inventions.^[1]

In the leading case of *Polwood Pty Ltd v Foxworth Pty Ltd*^[2] (**Polwood**), the Full Federal Court of Australia adopted a 2 part test for inventorship which:

- (a) first requires an identification of the invention;
- (b) followed by a determination of who contributed to it and when.

Basically, it is a person's contribution to the conception of the invention that is material to the determination of inventorship rather than the verification and reduction to practice of that concept (unless the reduction to practice itself required inventive contribution.)^[3]^[4]

a. If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Person A will be considered an inventor if they have contributed to the inventive concept of the invention.

If person B merely reduced the inventive concept to practice then they are unlikely to be considered an inventor. If person B made a contribution to the inventive concept (or overcame a difficulty in reducing the invention to practice) then they would be considered to be an inventor.

It is a question of fact in each particular case. In *Polwood*, both *Polwood* and *Foxworth* claimed an inventive contribution to the invention. *Polwood* had originally conceived the invention but *Foxworth* subsequently designed and constructed prototypes and ul-

timately an apparatus to implement the concept without any material input from Polwood. The trial judge held that the parties were co-owners as there was joint ownership on the basis of Polwood's entitlement to inventorship of the method claims and Foxworth's entitlement to claims to the apparatus. In the latter respect, the judge found that the design and construction of the apparatus involved inventive merit and inventive skill.

[1] "Subject to any agreement to the contrary, where there are 2 or more patentees: (a) each of them is entitled to an equal undivided share in the patent; and (b) each of them is entitled to exercise the exclusive rights given by the patent for his or her own benefit without accounting to the others; and (c) none of them can grant a licence under the patent, or assign an interest in it, without the consent of the others".

[2] (2008) 165 FCR 527

[3] See Bodkin "Patent Law in Australia" (2nd ed) at paragraph [8040] and Polwood at paragraphs 33 to 54.

[4] See also Crennan J in *JMYB Enterprises Pty Ltd v Camoflag Pty Ltd* (2005) 67 IPR 68 at para 132-133: Eg "Rights in an invention are determined by objectively assessing contributions to the invention, rather than an assessment of the inventiveness of respective contributions."

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

It is necessary to examine the complete specification as a whole (including the claims) to determine the inventive concept that is described or disclosed; it is generally not an analysis on a claim by claim basis.[1]

The Full Court in Polwood in holding that Polwood and Foxworth were co-inventors did not consider it appropriate or necessary to refer the matter back to the trial judge to conduct a review of inventorship on a claim by claim basis.

[1] See Polwood at paragraph 60; see Bodkin at paragraph [8100].

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

There is no requirement that a patent may only be granted to a person who is a citizen of Australia. Section 15(2) of the Patents Act provides that:

"A [patent](#) may be granted to a person whether or not he or she is an Australian citizen."

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

The Australian law of inventorship does not depend on where an invention was made ie there is no requirement that the inventor be a resident of Australia. For example, the idea may be jointly-conceived by scientists working in Australia and the United States.

4) **Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

a. If yes, what are the requirements and time limits for such correction?[1]

It is possible to file an application for leave to amend a patent request to correct the inventorship on a patent application at any time prior to the grant of a patent on the application. It is necessary to file an application under section 104 of the Patents Act together with a Statement of Proposed Amendments, in this case amending the request to show the correct inventors. If a Notice of Entitlement has already been filed, it may be necessary to file a further Notice if, for example, the Notice did not correctly reflect the applicant's entitlement. If a patent has already been granted and the names of the incorrect inventors appear on the Register, it is possible to file an application with the Commissioner of Patents (from 15 April 2013) or with the Federal Court to rectify the Register.[2]

[1] It is also relevant to note that under section 32(1) of the Patents Act: "If a dispute arises between any 2 or more joint applicants in relation to a [patent](#) application whether, or in what manner, the application should proceed, the Commissioner may, on a request made in accordance with the regulations by any of those applicants, make any determinations the Commissioner thinks fit for enabling the application to proceed in the name of one or more of the applicants alone, or for regulating the manner in which it is to proceed, or both, as the case requires."

[2] See sections 191A and 192 of the Patents Act

5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

Errors in the stated inventorship on a patent application or a granted patent can be grounds for opposition or revocation respectively. In both the case of an opposition and a revocation proceeding, there is no requirement that the error was unintentional.[1]

Opposition to a standard patent application

A standard patent application can be opposed on the ground that the nominated person is either:

- (a) not entitled to a grant of the patent for the invention; or
- (b) entitled to a grant of a patent for the invention but only in conjunction with some other person.[2]

Provisions exist for the Commissioner of Patents to grant patents in the names of the eligible person (opponent) or in the joint names of the applicant and the opponent.[3] It is also possible to seek a declaration that certain persons are eligible persons in relation to an application.[4]

An error in the named inventors, where the applicant would still be entitled to the patent (eg through an employment relationship), is not a ground of opposition.

Revocation of a granted patent

The Court may by order revoke a patent either wholly or so far as it relates to a claim on the ground that the patentee is not entitled to the patent.[5]

The effect of this provision has recently been ameliorated by the introduction of a section that provides that a patent is not invalid merely because[6]:

- (a) the patent, or a share in the patent was granted to a person who was not entitled to it; or
- (b) the patent, or a share in the patent, was not granted to a person who was entitled to it.

In addition, for proceedings filed after 13 April 2013, the Patents Act further provides in section 138(4) that:

"A Court must not make a revocation order on the ground that the patentee is not entitled to the patent unless the court is satisfied that, in all of the circumstances, it is just and equitable to do so."

Also, in addition, under section 34, if the Court is satisfied that either:

- (a) one or more persons are eligible persons in relation to an invention so far as claimed in any claim of the patent but that the patentee is not an eligible person; or
 - (b) that the patentee and another person(s) are eligible persons,
- if a complete application is made for the grant of a standard patent by one or more of the declared persons, the Commissioner may grant a patent for the invention, so far as claimed in the original claim to those declared persons jointly. The term of any patent granted under these provisions is limited to the term of the original patent^[7].

[1] Although an intentional error may affect whether a Court would consider such conduct as unjust and inequitable in exercising its discretion to not make a revocation order (see section 138(4) of the Patents Act). It may also give rise to a further ground of revocation eg false suggestion or misrepresentation.

[2] See section 59(a) of the Patents Act

[3] See section 33 of the Patents Act

[4] See section 36 of the Patents Act

[5] Section 138(3)(a). See *Conor Medsystems Inc v University of British Columbia (No. 2)* (2006)68 IPR 217; *University of British Columbia v Conor Medsystems Inc* (2006) 155 FCR 391; *Stack v Brisbane City Council* (1999) 47 IPR 525; Upheld on appeal in *Davies Shepherd Pty Ltd v Stack* (2001) 108 FCR 422

[6] Section 22A of the Patents Act

[7] Section 35 deals with the situation where a patent is revoked under section 137. If the Commissioner is satisfied they may on an application order than another person or persons should be accepted as patentee or patentees and grant a grant a patent with the same priority date as the surrendered patent.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

No, there is no such law in Australia. Applicants may choose to file first in the country of their choice.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

There are in force laws relating to various areas of technology under which dissemination of information may be an offence, in relation to national security, and in relation to nuclear technology (for example relating to nuclear weapons or enrichment of fissile material). In that sense, international filing of patent applications disclosing such material may be an offence.

However, the provisions of s. 152 and s.173 of the Patents Act which deal with such matters assume that there is a patent application which has been filed in Australia, and provide for a review by the patent office after filing. There are no provisions which specifically require a security review before filing in another country.

There are of course other laws that might interfere with the ability to eg supply overseas a military item via intangible means. It is a criminal offence^[1] under the *Defence Trade Controls Act 2012* (Cth) to supply overseas, publish^[2], and/or broker between two overseas countries a military or a dual-use item listed in the Defence and Strategic Goods List via intangible means, if it does not fall within one of the exemptions or the necessary permits or approvals have not been obtained. For example, technology required for the "minimum necessary information for patent applications" is exempt.

^[1] Punishable by imprisonment for 10 years or 2,500 penalty units or both.

^[2] Does not include pre-publication: see section 10(3A).

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

In our view the definition of inventorship will always require some flexibility and adaptation to the specific circumstances of any given invention. The case law sufficiently defines the parties who should be named as inventors.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

We have no such laws.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

We have no such laws prior to foreign filing.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Our laws allow for multinational first filings well as they stand, as we do not require the first filing to be in Australia.

III.) **Proposals for harmonisation**

- 12) **Is harmonisation in this area desirable?**

yes

Yes. Given the proliferation of inventions which are worked on in many countries at once, and the encouragement of collaboration internationally as a key factor in technical innovation, it is not rational to have widely disparate rules on inventorship, or national requirements for first filing in the case of international co-inventorship.

More specifically, in a modern, Internet connected world where an invention may be readily developed by an international team, laws that possibly made sense in a paper and mail based world have become irrelevant to the dissemination of information. An international team means that the information has already left the control of a single nation. It is important that the invention and filing regimes in each country adapt to the reality of international collaborative teams.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

It is necessary to consider a claim, not an invention in the abstract. Different claims may have different inventors. The addition of features in dependant claims may require additional inventors to be added.

As to the test itself, we have discussed this issue extensively within our group. While we are supportive in principle of a clear, simple and objective test, in our view this is not possible.

The concept of inventorship is inextricably bound to the concept of invention. There are many different types of invention. For example, in some instances a team may work together on a technical problem, pursuing various experiments and arriving at a solution. In this case, it is reasonable to treat the whole team as inventors.

In another instance, the invention may rely on a recognition of an underlying problem. In this case, there is likely to be a single genuine inventor, and implementation may be routine. In other cases, there may be a gradual recognition of an unexpected outcome, for example a second medical indication. In this case it may be an individual or a team who can properly be described as the inventors. There are many different ways to arrive at an invention, and the ways inventors contribute depends in part upon the way the invention was developed.

In our view, there can really be no better test than "did the alleged inventor contribute to the invention?". This in turn imports concepts of what is inventive, which is in our view inevitable and desirable. Considering inventorship without regard to the nature and background of the invention is likely to lead to error in identification of the inventors.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

We consider that the standard should be whether the error in naming the inventors was unintentional. This should be available before or after grant. However, after grant, the amendment should be allowable only on a discretionary basis, considering whether this would be just in all the circumstances, including any undue delay in requesting correction by the patentee.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

In our view, first filing requirements are unnecessary. If the interests of national security are required to be protected, then to simply require first filing is rather ineffective to protect such interests, as no other communication is prevented (see also 7(c) and 12 above). We note that in the case of a multinational invention, the information will already not be contained in any specific country.

As a compromise, the specific areas of technology which require a foreign filing license should be prescribed by each country, and no license should be required for other technologies. The latter will in practice include a large majority of inventions. This will also assist the efficiency of issuing such licenses in the infrequent cases where they are required.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

See the response to question 15.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

See the response to question 15.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

Given our responses above, no such ability is required.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

We do not have any other suggestion.

Summary

No restrictions exist on the country of first filing under Australian law, nor is there a requirement for security review or a foreign filing licence.

It is the view of the Australian group that such measures serve no useful purpose and should be abolished. We are supportive of an international standard for determining inventorship, based on the contribution to the claimed invention by the possible inventors.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Austria

Report Q244

in the name of the Austria Group
by Rainer BEETZ

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

There is no direct definition of inventorship in the Austrian Patent Act. The law refers to the inventor in connection with the right to the grant of a patent (§ 4 (1) PatG) and the right to be named as the inventor (§ 20 (1) PatG).

According to recent case law (OPM 27.4.2011; Op2/11) the inventor is the one who recognizes the concept of the invention, whose creative activity leads to the invention (Melullis in Benkard, Patentgesetz¹⁰ [2006] § 6 PatG Rz 33; similar Kraßer, Patentrecht⁶ [2009] 338, and Heath in Munich Gemeinschaftskommentar EPC Art 60 Rz 6). Under a technical invention a technical teaching is to be understood, *ie* instructions to achieve an intended result for solving a technical problem by technical means.

While the invention has to be brought for the patenting process in a linguistic form, the linguistic form as such is irrelevant. Only the factual content of the disclosed technical teaching is relevant. Therefore, the wording of the claims is not decisive for the assessment of inventorship, but the essential content of the patent or the application.

- a) Austrian Patent Law does not make any differentiation based on the location of any of the inventors. If the invention is made by B, B will be considered the inventor. If A does not contribute any creative input, but is merely directing efforts, A would not be an inventor (cf. Op2/11).
- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

In the Austrian Patent Act there is no direct reference to any particular part of the application, it is always generally referred to "the invention". According to case law the claims are not decisive, rather the essential content of the patent or the application (cf. Op 2/11). However, it was also decided that naming an inventor only with respect to specific claims is allowable (OPM 9.10.1991, Op 9/89).

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Austrian law of inventorship is independent of the citizenship of (any of) the inventor(s).

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

It is irrelevant where the invention was made for determining inventorship.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Inventorship can be corrected after the filing date. As determining an inventor at the filing date is not even mandatory in Austria, inventors may be added after the filing date without any specific requirements, in case no inventor was named when filing the application.

Either the inventor or the applicant or the owner may file a request for naming the inventor(s). The request may be filed jointly or – in case multiple persons are authorized – the consent of the other parties has to be shown (§ 20 (4) PatG). In case an already named inventor shall be cancelled, also the consent of this person is required.

The request may be filed at any time.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

There are no particular consequences for an error in the stated inventorship in Austria. Thus, an error in the stated inventorship has no influence on the validity or enforceability of the patent. However, the true inventor may enforce his right to be named.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

Austrian law does not require domestic first filing at all.

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

Austrian law does not require a secrecy review in any case.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

There is no legal definition of inventorship and thus no statutory guidance as to who should be named. However, the definition as set forth in case law according to which anybody whose creative activity has made a contribution to the invention is a (co-)inventor seems reasonable.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

N/A

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

N/A

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

As Austrian law does not provide for first domestic filing or secrecy review there are no difficulties in filing a patent application with inventors of multiple nationalities (stemming from Austrian law).

III.) Proposals for harmonisation

- 12) Is harmonisation in this area desirable?**

yes

Because divergent or even contradicting requirements pose not only an unnecessary burden on the applicant but also legal uncertainty to third parties with regard to potential invalidity/unenforceability of the patent.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

An inventor is any person having made a creative technical contribution to the invention.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

Correction of inventorship should be admissible at any time, ie during pendency of the application and also after grant. It seems reasonable to require the consent of all previously named inventors with any addition or removal of inventors, because it is them who are in a position to verify the justification of adding or removing inventors. Whether the error in naming the correct inventors was intentional or unintentional should not make any difference.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

First filing requirements can lead to irresolvable situations and should therefore be dropped. If indeed maintained, international applications should be considered as valid (single) first filing in all requiring countries.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

Secrecy review requirements can lead to irresolvable situations and should therefore be dropped.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

N/A.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

At least full re-establishment of rights should be possible in all countries having a first filing requirement.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

The most relaxed requirements of all countries of residence of the inventors should be applicable.

Summary

Austrian Patent regulations are very liberal in connection with inventorship. Naming an inventor is not mandatory and Austrian law does not require domestic first filing at all.

Austrian law of inventorship is independent of the citizenship of (any of) the inventor(s) and it is irrelevant where the invention was made for determining inventorship.

Further, Austrian law does not require a secrecy review in any case.

Considering the above, Austrian law does not pose any difficulties in connection with filing a patent application with inventors of multiple nationalities.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Belgium

Report Q244

in the name of the Belgium Group
by Philippe CAMPOLINI, André CLERIX, Eric DE GRYSE, Christian DEKONINCK, Fernand DE VISSCHER, Nele D'HALLEWEYN, Gunther MEYER, Domien OP DE BEECK, Simone VANDEN-WYNCKEL and Koen VANHALST

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Art. XI.9 of the Belgian Code of Economic Law provides that the right to the patent belongs to the "inventor" or its successor in title. However, the Code does not define inventorship. According to the Belgian case law^[1] and the legal literature^[2], each person who has delivered a substantial contribution to the invention, can claim the status of inventor.

The nationality of the inventor is without influence on the question of inventorship. Under art. 191 of the Belgian Constitution and 11 of the Belgian Civil Code, in the absence of a Belgian statutory provision to the contrary, foreigners enjoy the same rights under Belgian law as those awarded to Belgian citizens. This includes the right to be recognized as the inventor of an invention. This is in line with art. 2(1) of the Paris Convention and art. 1(3) and 3 of the TRIPS Agreement. The domicile of an inventor is also without influence on the question of inventorship. This is in line with art. 2(2) of the Paris Convention.

As a consequence of the above, A and B could both be considered as inventors, provided they have delivered a substantial contribution to the invention.

Footnotes

1. [^](#) *Comm. Antwerp, 18 October 2013, IRDI 2014, p. 381 ; RAGB 2013, p. 1438 ; Court of first instance of Liège, 21 January 1999, Ing.-Cons. 1999, p. 420.*
2. [^](#) *M.-C. Janssens en F. Gotzen, Wegwijs in het intellectueel eigendomsrecht, 2012, pp. 232-233.*

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The Belgian case law and legal literature defining inventorship require relying on the invention as claimed. The claimed invention should be considered as a whole. Inventorship is not determined on a claim by claim basis. A substantial contribution to one of the claims is sufficient to be considered as an inventor. The contribution should be assessed on a qualitative basis, and not on a quantitative one.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

See above under question 1.a).

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

See above under question 1.a).

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Art. XI.21 of the Belgian Code of Economic Law provides that when the patent application meets the conditions laid down for obtaining a filing date but not the other legal or regulatory requirements, which includes the designation of the inventor (or, in the absence thereof, an express request of the inventor not to be mentioned), the Belgian IP Office notifies the applicant and gives him the opportunity to regularize its application. Such regularization must be done within 3 months after the receipt of the notification and a regularization fee must be paid within the same period. At the expiration of this period, the application shall be deemed withdrawn if not regularized. The Belgian IP Office does not check the correctness or completeness of the list of designated inventors. It is noted that if no inventor is mentioned, and no express request not to be mentioned is submitted, the application will not proceed to grant because the requirement of art. XI.16, §1, 7° of the Belgian Code of Economic Law is not fulfilled. Not mentioning an inventor does however not affect the grant of a filing date (art. XI.17 of the Belgian Code of Economic Law). If a mistake occurred in the list of designated inventors, and as long as the patent has not been granted, the applicant may also take the initiative to proceed to such regularization, without any invitation by the Office to that effect. Such proactive regularization is also subject to the payment of the prescribed regularization fee.

This procedure clearly allows the applicant to indicate the name(s) of the inventor(s) if he omitted to do so upon filing of the patent application. It should also allow the applicant to correct inventorship if a person has been incorrectly designated as an inventor or if the name of an inventor is missing. Such corrections will be mentioned in the register and should be included in the publication of the granted patent.

In practice, the Belgian IP Office also accepts corrections or additions to the list of designated inventors *after* the patent has been granted. Such corrections after grant will be mentioned in the register (no reissue of the patent).

The above is without prejudice to (i) entitlement proceedings and (ii) proceedings based on the moral right of the inventor:

- A correction or addition to the list of designated inventors in the patent application (or in the granted patent) can have implication on the ownership to the patent and, in case of dispute, give rise to entitlement proceedings according to Art. XI.10 of the Belgian Code of Economic Law.

- A correction or addition to the list of designated inventors in the patent application (or in the granted patent) can also be claimed by an inventor before a court on the basis of its moral right if the applicant does not agree with the requested correction or addition.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

In Belgium, an error – intentional or unintentional – in the stated inventorship on a patent application is without consequence on the validity or enforceability of the patent issued from such application. However, for a patent to be issued, an inventor must be mentioned or an express request stating that the inventor does not wish to be mentioned must have been filed with the Belgian IP Office in accordance with art. XI.13 of the Belgian Code of Economic Law.

The above is without prejudice to the consequences an error in the inventorship may have on the ownership of the patent (application). In this regard, it seems worth mentioning that a dispute on ownership can lead to the invalidation of the patent according to art. XI.57, §1, 4° of the Belgian Code of Economic Law. However, issues relating to the ownership of the patent (application) are outside the scope of this question. Therefore, these aspects are not further developed.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

As to question 6 in general :

In Belgium, there is no first filing requirement in the meaning of question No. 6 and of the working guidelines, i.e. a first filing requirement based on the place where the invention was made.

However, Belgian law contains several legal provisions that can have an effect similar to a first filing requirement, which we consider worth mentioning. These legal provisions are not based on the place where the invention was made, but only on the nationality or residence (or registered office) of the applicant. Distinction is to be made between a Belgian national patent application, a European patent application and an international patent application.

Art. XI.82(2) of the Belgian Code of Economic Law^[1] provides that a European patent application filed by a Belgian applicant or an applicant having his domicile or registered office in Belgium must be filed with the Belgian IP Office if that patent application is of relevance for the defense of the territory or the national security. As said above, this legal provision is not based on the place where the invention was made, but on the nationality or residence (or registered office) of the applicant. As a result, in such a case, the applicant is prevented from filing a European patent application with the European Patent Office. The question whether a patent application is of relevance for the defense of the territory or for the national security must be assessed by the applicant.

A similar rule applies to international patent applications. According to art. XI.91(2) of the Belgian Code of Economic Law^[2], international patent applications must be filed with the Belgian IP Office if they are of relevance for the defense of the territory or for

the national security. Art. XI.91(2) is not explicitly limited to international patent applications filed by applicants with Belgian nationality or having their domicile or registered office in Belgium. However, this limitation results from rule 19(1) of the Regulations under the PCT as the Belgian IP Office is the sole competent Receiving Office for such applications.

These two rules thus only apply to European patent applications (filed according to the EPC) and international patent applications (filed according to the PCT). They do not apply to other types of patent applications. Therefore, they do not prevent the applicant from filing other types of patent applications abroad in the first place, e.g. national patent applications outside Belgium or regional patent applications outside the EPO.

The only provision that limits the possibility for an applicant to file a patent application abroad in the first place is the Act of 10 January 1955 “on the disclosure and implementation of inventions and trade secrets which are of relevance for the defense of the territory or for the national security”. This act contains a very broad provision (art. 1) that prohibits the disclosure of inventions and trade secrets if such disclosure is contrary to the interests of the defense of the territory or national security. It is provided that the author of the disclosure (or the person who caused this disclosure through negligence) shall only be punished if it is established that he couldn’t have ignored that the disclosure was contrary to the interests of the defense of the territory or national security.

A patent application (any type of patent application) filed in a foreign country could be considered as a disclosure in the meaning of this provision^[3]. Therefore, such patent application filed abroad could lead to a breach of this provision, if the applicant cannot have ignored that such disclosure was contrary to the interests of the defense of the territory or national security. The preparatory works of this act make it clear that this can result either from the very nature of the invention or from a joint decision of the Minister of Defense and the Minister of Economy^[4]. In the absence of such joint decision, the preparatory works acknowledge that, for inventions that do *not* concern weapons, it is very difficult to assess if the disclosure would be contrary to the interests of the defense of the territory or national security, and that the act must be applied in a reasonable way^[5].

As to question 6.a) in particular :

The rules referred to above are limited to inventions that are of relevance for the defense of the territory or for the national security. They apply irrespective of the technical area to which the invention belongs.

Footnotes

1. [^] See also art. 3(2) of the Act of 8 July 1977 “approving the following international instruments: 1. Convention on the Unification of Certain Points of Substantive Law on Patents for Invention, done in Strasbourg on 27 November 1963 ; 2. Patent Cooperation Treaty and Regulations, done in Washington on 19 June 1970 ; 3. Convention on the Grant of European Patents (European Patent Convention), Regulations and four protocols, done in Munich on 5 October 1973 ; 4. Convention for the European Patent for the Common Market (Community Patent Convention) and Regulations, made in Luxembourg on 15 December 1975” and art. 2(2) of the Act of 21 April 2007 “containing various provisions relating to the procedure for filing European patent applications and the effects of these applications and of European patents in Belgium”.
2. [^] See also art. 2(2) of the Act of 8 July 1977 “approving the following international instruments: 1. Convention on the Unification of Certain Points of Substantive Law on Patents for Invention, done in Strasbourg on 27 November 1963 ; 2. Patent Cooperation Treaty and Regulations, done in Washington on 19 June 1970 ; 3. Convention on the Grant of European Patents (European Patent Convention), Regulations and four protocols, done in Munich on 5 October 1973 ; 4. Convention for the European Patent for the Common Market (Community Patent Convention) and Regulations, made in Luxembourg on 15 December 1975”.
3. [^] Comp. art. 5 of the Act of 10 January 1955.
4. [^] Exposé des motifs, Sénat, sess. ord., 1952-1953, n° 447, p. 11.
5. [^] Rapport des commissions réunies des affaires économiques et des classes moyennes et de la défense nationale, Sénat, sess. ord., 1953-1954, n° 171, p. 3.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

no

Belgian law does not provide for such a mechanism.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

Not applicable (answer to b) above is no).

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

The first two rules referred to above (art. XI.82(2) and 91(2) of the Belgian Code of Economic Law) only apply to applicants with Belgian nationality or having their domicile or registered office in Belgium. The place where the invention was made, as well as the nationality and residence of the inventor(s), are of no relevance.

A breach of the third rule referred to above (art. 1 of the Act of 10 January 1955) is a criminal offense contrary to the national security. Therefore, this rule applies not only to any disclosure on the Belgian territory (by anyone)^[1], but also to any disclosure abroad by a person having the Belgian nationality or having its domicile in Belgium^[2] or even by a foreigner^[3]. Belgian criminal law also applies to criminal offenses partially committed on the Belgian territory, provided that one of the “material” constitutive or aggravating elements of the offense has been realized on the Belgian territory^[4].

Footnotes

1. [^](#) Art. 3 of the Criminal Code.
2. [^](#) Art. 4 of the Criminal Code, juncto art. 6, 1° of the Act of 17 avril 1878 containing the preliminary title of the Code of criminal proceedings.
3. [^](#) Art. 4 of the Criminal Code, juncto art. 10, 1° of the Act of 17 avril 1878 containing the preliminary title of the Code of criminal proceedings.
4. [^](#) Cass., 23 January 1979, Pas., I, p. 582 ; Cass., 4 février 1986, Pas., I, p. 664.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

yes

Such request for a foreign filing license would not violate art. XI.82(2) and 91(2) of the Code of Economic Law, which only prohibit the *patent application* to be filed outside Belgium under the circumstances mentioned above. However, art. 1 of the Act of 10 January 1955 could be violated if the request for a foreign filing license filed in the third country discloses the invention (which is normally the case as the foreign IP office needs to assess the content of the patent application in view of their national criteria).

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

The Act of 10 January 1955 provides that the author of the disclosure shall be punished with imprisonment from six months to five years and a fine of 3.000 to 30.000 Euros, or one of these penalties. If the disclosure has been caused by its negligence, he shall be punished with imprisonment of one month to one year and a fine of 600 to 6.000 Euros, or one of these penalties. These penalties should also apply to any breach of art. XI.82(2) and 91(2) of the Code of Economic Law, given that a patent application filed in violation of these provisions would constitute a disclosure contrary to art. 1 of the Act of 10 January 1955.

- 7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

As to question 7 in general :

Belgian law does not require that a patent application claiming an invention made, at least in part, in Belgium undergoes a secrecy review or similar process *before it can be filed in another country*. However, the Act of 10 January 1955 provides the possibility for the Minister of Defense to review any patent application upon its filing, in order to determine if specific measures need to be taken in order to ensure the defense of the territory or the national security.

As to question 7.a) in particular :

No, such review can concern any patent application, in any area of technology.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

The Minister of Economy may bring any patent application, upon its filing, to the knowledge of the Minister of Defense, in order to determine if specific measures need to be taken in order to ensure the defense of the territory or the national security. The Minister of Defense may also, for the same purpose, take the initiative to review any patent application upon its filing. The specific measures that can be taken by the Minister of Economy and the Minister of Defense (jointly) can consist of a temporary prohibition to disclose the invention or the determination of temporary exploitation conditions. If it is established that temporary exploitation conditions are not sufficient to ensure the defense of the territory or the national security, other measures can be taken, such as a temporary prohibition to exploit the invention, a temporary right for the State to exploit the invention (on an exclusive or non-exclusive basis) or the obligation for the applicant to provide the State with a complete knowledge of the invention. According to the information provided by the Belgian IP Office, such secrecy review is extremely rare in Belgium.

If a patent application undergoes a review by the Minister of Defense, the applicant is informed without delay. From that moment, he is prohibited, unless expressly authorized, to disclose the invention claimed in the patent application, which includes a prohibition to file a patent application abroad, to assign the rights to the application or to grant a license. If needed, the grant of the patent can be suspended. Within three months, the Minister of Defense informs the Minister of Economy, whether or not spe-

cific measures as indicated above must be taken. A decision must be taken by the Ministers jointly within six months after the filing of the patent application. Such decision must be notified to the applicant without delay.

During such review and thereafter for the duration of the prohibition to disclose the invention, if such measure has been taken, the administration is obliged to ensure the secrecy of the patent or patent application.

As the patent prosecution is suspended during the review and thereafter when non-disclosure measures have been taken by the Ministers, the patent application will not be published nor can the request for the novelty search and the corresponding written opinion be submitted. Once the prohibition is withdrawn, the applicant can submit this request by paying the search fee within 13 months.

Even if the patent prosecution is suspended, the patent applicant must still pay the maintenance fees due to keep the patent application alive.

Although the patent application is placed under secrecy, the patent applicant can, upon authorisation by the Ministers, use his patent application to claim conventional priority if filing in those countries with whom Belgium has concluded an agreement in this respect. These countries will then also place their national patent applications, claiming priority from this Belgian patent application, under secrecy according to their national procedures. Such an agreement exists among the NATO member states^[1].

The measures referred to above (including the limitations applicable during the review) may be withdrawn partially or totally at any time, by a joint decision of the Ministers. This withdrawal may be requested by the patent applicant or owner.

The patent applicant who has been subject to such measures has the right to obtain a compensation. The same applies to the patent owner who has been subject to specific measures, such as temporary exploitation conditions, after grant of the patent.

Footnotes

1. [^](#) *Agreement for the mutual safeguarding of secrecy of inventions relating to defence and for which applications for patents have been made, signed in Paris on 21 September 1960.*

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

The Act of 10 January 1955 provides that the author of a disclosure contrary to the measures referred to above (during the review or thereafter) shall be punished with an imprisonment of six months to five years and a fine of 3.000 to 30.000 Euros, or one of these penalties. If the disclosure has been caused by someone's negligence, this person shall be punished with an imprisonment of one month to one year and a fine of 600 to 6.000 Euros, or one of these penalties. Breaches of the other measures referred to above (decided after the review) are punished by an imprisonment of one month to one year and a fine of 600 to 6.000 Euros, or one of these penalties.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

As indicated above, Belgian law does not define inventorship. This definition is given by the Belgian case law and the legal literature. A legal definition of inventorship, if possible harmonized at the international level, is desirable to help applicants and patent attorneys.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

It can be difficult for an applicant to assess whether an invention is of relevance for the defense of the territory or the national security. Given the criminal sanctions applicable in case of breach of the rules referred to under question No. 6, clear guidance should be available. In particular, the influence of the multinational character of the invention on the assessment should be clarified. It should be possible for the applicant to know with a sufficient degree of certainty if the patent application can be filed abroad without breaching these legal provisions.

In addition, given their broad scope *ratione personae* and the fact that they are not necessarily based on the same criteria as in other countries (nationality or residence of the inventors, place where the invention was made, etc), the provisions referred to above are likely to apply in situations where first filing requirements imposed by foreign countries apply cumulatively. In the absence of harmonization, the following aspects of Belgian law should at least be improved:

- A statutory possibility to obtain a foreign filing license from the Belgian IP Office (or from the Ministers) should be foreseen.
- It should be foreseen that the application filed abroad for a foreign filing license does not constitute a breach of art. 1 of the Act of 10 January 1955.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

As stated above, the secrecy review is not automatic in Belgium. Only patent applications that are specifically identified by the Minister of Defense will be subject to a review and, during such review, to a prohibition to file a patent application abroad.

The problem of this system is that foreign patent applications may already have been filed before the Minister of Defense had the time to realize that the invention at stake could be of relevance for the defense of the territory or the national security. This could lead to sanctions based on art. 1 of the Act of 10 January 1955 if it can be established that the applicant should have known that the filing of the patent application abroad was contrary to the interests of the defense of the territory or national security (see above).

The Belgian workgroup proposes to foresee an automatic prohibition to file abroad during a short period of time (7 days for instance), but only if the Belgian patent filing was the first filing. Unless an objection is raised, subsequent foreign patent filings should be allowed.

In addition, multinational inventors should also be allowed to exchange texts with foreign patent attorneys on a confidential basis during the secrecy review.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

The question raises the issue whether the system of first filing requirement and secrecy review at national level is not outdated. It is suggested that the defense of the territory and the national security can be ensured through other means.

If this system is not abolished, it should at least be harmonized at international level (see below). Competing first filing requirements should be avoided, as well as competing secrecy reviews.

The secrecy review could be performed by a central administration common to several countries (for example, NATO).

Foreign filing licenses should be available in any case.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

See below for more details.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

Any person who has delivered a creative and substantial contribution to the invention as claimed should be considered as an inventor.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

The patent applicant or owner should always have the right to file a request for correction of inventorship, whether the error was intentional or unintentional. The requirements for the registration of such correction should be merely formal. All inventors (including those added and/or cancelled in the requested correction) should be notified without delay.

In case the correction is challenged, then a claim should be filed before a court, either by an inventor (alleged or designated) on the basis of its moral right or, in case the correction has a consequence on ownership, by the interested owner (alleged or designated) via entitlement proceedings. The filing of such claim should be registered by the Office. If the patent has not been granted yet, the grant procedure should only be suspended in case of entitlement proceedings.

Such correction proceedings should not per se affect the validity or enforceability of the patent.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

The Belgian working group is of the opinion that a first filing requirement does not need to be maintained.

However, if it had to be maintained, it should be harmonized at international level and based exclusively on the nationality or registered office of the applicant. If there are several applicants, it should only apply to the first applicant mentioned in the patent application. If the applicant has several nationalities or registered offices in multiple countries, he should be able to choose between them to determine where to file first. In order to avoid problems, the nationality or domicile of the inventors should not be taken into account, nor the place where the invention was made. The first filing requirement should not be limited to a specific technology.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

Implementing such an international standard, would conflict with the sovereignty of each country in defining what, for that country, secrecy is and whether non-disclosure measures have to be taken with regard to a particular invention.

However, it should be avoided that several countries perform a secrecy review of the same invention. One single secrecy review should be performed by the country where the patent application has been first filed according to the rule proposed under question No 15.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

If the system proposed above were to be adopted, there would be no objective necessity for a system of foreign filing license, as there would never be two competing first filing requirements.

However, the system could be maintained to offer applicants the possibility to first file in a country other than their country of nationality. Each country could determine its own standard for obtaining a foreign filing license.

If the system proposed above was not adopted, it should at least be ensured that any country with a first filing requirement automatically proposes the possibility to request a foreign filing license.

Each country should also provide that a request for foreign filing license filed abroad does not constitute a breach of the first filing (or disclosure) requirement. Each country could establish a list of "allied" countries (at least at some levels, such as at the EU level) for which the foreign filing license should be automatically granted if the administration does not react within a very short time period (7 days for example).

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

If the applicant omitted to request a foreign filing license, he should be able to request such a license with retroactive effect if he can establish that the failure to file the request on time occurred in spite of all due care required by the circumstances having been exercised.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Not applicable.

Summary

In Belgium, **inventorship** is only defined by the case law and legal literature. This can lead to practical difficulties. An harmonized definition of inventorship is desirable.

In Belgium, **corrections** of inventorship are admitted during and after the grant procedure. Such corrections are without consequence on the validity or enforceability of the patent. This could become an international standard.

In Belgium, there is no **first filing requirement** based on the place where the invention was made. However, Belgian law contains a very broad provision that prohibits the disclosure of inventions if such disclosure is contrary to the interests of the defense or national security. Any foreign patent application and any application for a foreign filing license filed abroad could fall within the scope of this provision. This legal provision should be abolished or clarified. If first filing requirements are not abolished, an international standard ensuring that only one such requirement applies in each case should be adopted, e.g. based on the nationality or registered office of the applicant. In the absence of such standard, it should be ensured that applications for foreign filing licenses are always possible.

Secrecy review is not automatic in Belgium. However, the Minister of Defense has the right to submit any Belgian patent application to such review, in which case any disclosure, including a foreign filing, is forbidden, unless expressly authorized. The grant procedure of

such patent application is suspended for the duration of the review and thereafter in case of secrecy order. If secrecy review is not abolished, it should at least be ensured that it is only performed by the country of first filing.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Not applicable.

Brazil

Report Q244

in the name of the Brazil Group
by Ricardo CARDOSO DA COSTA BOCLIN and Ana Claudia MAMEDE CARNEIRO

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

There is no formal definition for inventorship and this issue is regulated by the IP Law 9279/96.

It is not required that patent applications originated in Brazil or made by Brazilian inventors be first filed in Brazil, nor that specific technology categories must be examined under secrecy review. However, there is the exception of the art. 75 from Brazilian IP law which defines that patent applications originated in Brazil which can be from interest to national defense should be analyzed by the competent authority and, if considered from national defense interest, its examination will occur under secrecy review and its filing abroad is only accepted under express authorization of the competent authority.

In this sense it is desirable an international harmonization to: (i) guide the definition of the inventorship; (ii) standardize the first filing requirements; and (iii) standardize the secrecy review, to facilitate and guide the filing of multinational inventions, considering that this is a growing global reality.

Inventorship is ruled by our Industrial Property Law in the following articles:

Article 6 - The author of an invention or of a utility model will be assured the right to obtain a patent that guarantees to him the property, under the terms established by this law.

§ 1 - In the absence of proof to the contrary, the applicant is presumed to have the right to obtain a patent.

§ 2 - A patent may be applied for by the author, his heirs or successors, by the assignee or by whoever the law or a work or service contract determines to be the owner.

§ 3 - When an invention or utility model is created jointly by two or more persons, the patent may be applied for by all or any one of them, by naming and qualifying the others to guarantee their respective rights.

§ 4 - The author will be named and qualified, but may request his authorship not to be divulged.

Article 7 - If two or more authors have independently devised the same invention or utility model, the right to obtain a patent will be assured to whoever proves the earliest filing, independently of the dates of invention or creation.

Sole Paragraph - The withdrawal of an earlier filing without producing any effects will give priority to the first later filing.

CHAPTER XIV INVENTIONS AND UTILITY MODELS MADE BY EMPLOYEES OR SUPPLIERS OF SERVICES

Article 88 - An invention or utility model will belong exclusively to the employer when it results from a work contract being executed in Brazil and the object of which is research or the exercise of inventive activity or when such results from the nature of the services for which the employee was contracted.

§1 - Except when there are express contractual provisions to the contrary, remuneration for the work to which this article refers will be limited to the salary agreed upon.

§ 2 - In the absence of proof to the contrary, an invention or utility model for which a patent is requested by an employee within 1 (one) year from the extinction of the contract of employment will be considered as having been developed while the contract was in force.

Article 89 - An employer, who is the proprietor of a patent, may grant the employee, who is the author of the invention or improvement, participation in the economic gains resulting from the exploitation of the patent, as a result of negotiation with the interested party or as provided for by a norm of the undertaking.

Sole Paragraph - The participation referred to in this article will not in any way be incorporated into the salary of the employee.

Article 90 - An invention or utility model developed by an employee will belong exclusively to the employee provided that it is unconnected to his work contract and when it does not result from the use of resources, means, data, materials, installations or equipment of the employer.

Article 91 - The ownership of an invention or utility model will be common, in equal parts, when it results from the personal contribution of the employee and from resources, data, means, materials, installations or equipment of the employer, without prejudice to express contractual provisions to the contrary.

§ 1 - When there is more than one employee, the part due to them will be divided equally between all of them, except when agreed to the contrary.

§ 2 - The employer will be guaranteed the right to an exclusive license for exploitation and the employee will be guaranteed fair remuneration.

§ 3 - Exploitation of the subject matter of the patent, in the absence of an agreement, must be initiated by the employer within 1 (one) year counted from the date of grant, under pain of the property in the patent being transferred to the exclusive ownership of the employee, without prejudice to the hypothesis of lack of exploitation for legitimate reasons.

§ 4 - In the case of assignment, any of the co-owners may exercise the right of preference under identical conditions.

Article 92 - The provisions of the preceding articles, as far as they are applicable, apply to the relationship between an autonomous worker or a trainee and the contracting undertaking and between contracting and contracted undertakings.

Article 93 - The provisions of this Chapter, as far as they are applicable, apply to entities of the direct or indirect and foundational, federal, state or municipal, Public Administration.

Sole Paragraph - In the hypothesis of article 88, a reward corresponding to part of the value of the advantages obtained as a result of the application or the patent will be guaranteed to the inventor, under the terms and conditions provided for in the statutes or internal regulations of the entity to which this article refers.

a) There is no guidance or restrictions to whom is considered inventor in the current Brazilian IP law. Thus, under the law, person A and person B will be considered inventors if they are said as being such.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

No, there is no guidance to define the inventorship in the current Brazilian IP law.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, there is no difference in the law to inventorship. It is independent from its citizenship.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, there is no differentiation in the law for any location where the invention was made.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

The correction can be filed through a petition with a declaration of the inventors. There is no time limit for such correction.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

According to Article 6, §4, of the Brazilian IP Law, the inventor will be named and qualified, but it may be requested that his/her name is not published.

Furthermore, a patent that is granted contrary to the provisions of the Brazilian IP Law shall be null (Article 46 of our current IP Law) and in case of non-compliance with the provisions of said Article 6, the inventor may alternatively bring suit in court for adjudication of the patent (Article 49 of the same Law). There is no difference if the error was intentional or unintentional.

Therefore, in principle, a patent application with an error in the stated inventorship may be null, independently if the error was intentional or unintentional. However, we are not aware of any challenge of the validity of a patent based on an error of inventorship. Furthermore, it should be taken into account that the inventorship can be corrected at any time.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

No. A patent application claiming an invention made in Brazil may be first filed in another country.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Only for applications originated in Brazil and considered from interest for national defense by the competent institution. In this case, it is prohibited the filing abroad of the patent application, except by express authorization by the competent institution.

It is important to note that there is no definition for applications considered from "interest for national defense" in the IP law.

a) No. The secrecy review is applicable for patent application of interest for national defense originated in Brazil.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

According to Brazilian IP law nº9279/96, art. 75, a patent application originated in Brazil in which the object is of interest to national defense will be processed in secrecy. The BPTO will send the application immediately to the competent institution of the Executive Authorities for the purpose of providing, in 60 days, an opinion regarding secrecy. In this case, it is prohibited the filing abroad of the patent application, except by express authorization by the competent institution.

There are no additional costs in the patenting process if the application is considered of interest to national defense. Furthermore, the art. 75, §3, says that a compensation is guaranteed whenever this implies a restriction to the rights of the applicant or patentee.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

There are no specific considerations in the law to possible consequences of failing to comply with this specific law, intentional or not. There is only a general article in which a patent that is granted contrary to the provisions of the Brazilian IP Law shall be null (Article 46 of our current IP Law).

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

In the current Brazilian IP law there is no definition of inventorship.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

There is no law requiring first filing of patent application directed to inventions made in Brazil.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

The law is not specific for national or multinational inventions, only for patent application originated in Brazil in which the object is of interest to national defense. Improvements can be done in the law such as a definition of a deadline for evaluating if the application is considered from interest to national defense or not by the competent authority and definition of the compensation whenever this implies a restriction to the rights of the applicant or patentee.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

There are no restrictions for filing a patent application having multinational inventorship.

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

Inventorship is who had an active contribution in the development of the inventive concept independently from any manual work, i.e., someone who contributed only with manual work, and not with the inventive concept, cannot be considered inventor.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

In an unintentional error, the correction should be made through a petition with a declaration of all inventors. In the case of an intentional error, the harmed inventor may entry with a court action alleging inequitable conduct and showing the participation in some stage of the invention development.

In an unintentional error, the correction should be simply made before the Patent Office through a petition with a declaration of all inventors. In the case of an intentional error, and the named inventors do not agree to voluntarily include the name of the missing inventor, the harmed inventor may entry with a court action alleging inequitable conduct and showing the participation in some stage of the invention development.

As to the timing, in both cases, there would be no time limit.

Still, whenever the invention involves compensation or bonus, the late recognized inventor should receive retroactive compensation.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

Since inventions created by a group of multinational inventors are indeed common nowadays, we believe that a first filing requirement is not appropriate, since it may represent a serious hurdle to the IP system that may lead to rejection of the patent application or the annulment of the patent in certain countries.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

The secrecy review requirement would be appropriated for patent application of interest for national defense respecting the first filing requirement as mentioned in the item 15 above.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

Based on the replies for questions 15 and 16, a license would depend on each country considers as of national defense, and so it is hard to standard a procedure for this purpose.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

In a scenario where first filing requirement is in force, we believe that a procedure for the reinstatement of inventorship's rights would be interesting so as to excuse an inadvertent failure to comply with a first filing requirement.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

There would be a standard for writing the name of the inventors foreseeing cases wherein (i) the surname contains prepositions such as "Da Silva" ("Da" is a preposition linking the name and surname or linking surnames used in Brazilian names) and (ii) "Jr." should be understood as a single surname or complement of a surname.

There would be no need to indicate the occupation of the inventor, just mention him/her as an inventor or a researcher.

Further, there would have an indication of the inventor as male or female gender.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Bulgaria

Report Q244

in the name of the Bulgaria Group
by Iveta BORISOVA and Vasil PAVLOV

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

According to the Bulgarian Law on Patent and Utility Models Registration (the Law) both persons A and B will be considered as inventors. The inventor shall have the right to be mentioned in the patent application as well as in the publication of the patent invention. This right is personal and non-transferable^[1].

However, the Bulgarian Patent Office has a right ex officio to see that the inventor (joint inventors) is mentioned in the application or the patent.

^[1] Article 3 of Law on patent and utility models registrations (title amended, State Gazette No.64/2006)

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Bulgarian Patent Law does not define inventorship rely on or look to a particular part of the patent application. This matter may be subject of a private agreement between all inventors, where the contribution of each of them may be determined on a claim by claim basis, determined on the content of the drawings or examples, or determined.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The Bulgarian law does not depend on the citizenship of the inventor(s). Any person qualified as an inventor shall have the right to be mentioned in a Bulgarian Patent Application.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

The Bulgarian law does not provide any restrictions in respect to where it was made the invention.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

According to the Bulgarian Law, the inventorship can be corrected either:

1/ during the examination proceedings in the application until such time as a decision is taken;

2/ or in disputes to determine the true inventor(s). Such disputes are heard by the Sofia City Court. Based on the enforceable court decision, the Patent Office shall enter the name of the inventor or inventors on the granted patent.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

There is not any requirement in the Law an application to be invalidated or rendered not enforceable on that basis of an error in the stated inventorship on a patent application.

All disputes concerning the determination of the true inventors are a subject of court claim before Sofia City Court. If the dispute is raised during the examination proceeding of patent application, the Court will stop the proceeding until the Patent Office granted a decision of the patent application. According to Bulgarian Law based on the enforceable court decision, the Patent Office shall enter the name of the inventor or inventors on the granted patent

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

The Bulgarian Law does not provide an application for patent claiming invention in only one technical area or in all technical areas to be filed first in our country.

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

No, the secrecy does not depend on the area of technology that is disclosed and claimed in the patent application

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

According to the Bulgarian Law each application filed with the Bulgarian Patent Office by a Bulgarian applicant, resident or having business place in Bulgaria, including PCT applications, undergoes in a one month period after filing a secrecy review for classified information^[1]. The applicant whose application does not undergo the secrecy review, may continue the procedure as secret application.

At the present moment the Law provides a special separate group of patents, so called "Secret patents" under special claim of the applicant for secrecy of its application. For such applications/patents any publication is not provided. For filing, examination, granting and maintenance of a secret patent any official fees are not provided. Only formality examination is provided. The patent which undergoes the formal requirements, receives a granted number and only this number shall be published without any other bibliographical data. Periodically all secret applications/patents undergo secrecy review and the level of secrecy may be removed. The authorities competent to determine the information security classification level and to remove the level of classification of secret applications/patents shall be the Ministry of the Interior and the Ministry of Defence.

The applicant shall be invited to pay in three months term publication, issuance and all maintenance fees of a patent which secrecy level has been removed. After publication, the patent becomes a part of state of the art. The applicant may file a request for search and examination

Where the application has been filed as a secret patent application and, after the examination, no security classification level has been determined by the competent authorities, the Patent Office shall inform the applicant that the application contains no secret invention and shall ask for his express consent for the application to be examined in accordance with the ordinary provisions. In case no such consent is received within three months, the application shall be deemed to be withdrawn.

The procedure of determining the information security classification level and removal thereof with

respect to applications and secret patents is specified in a Secret Patents Regulation adopted by the Council of Ministers. This Regulation regulates the procedure for determining the presence of classified information and the classification level of information security and the removal of the security classification contained in the applications for grant of patents, hereinafter referred to "secret orders" and "secret patents".

[1] Article 25 of Bulgaria Law "Bulgarian citizens with a permanent address in the Republic of Bulgaria or legal persons with a principle place of business in the Republic of Bulgaria shall have the right to seek patents for their inventions abroad after the examination referred to Article 45a).

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

According to the Law, where the application has been filed as a secret patent application and, after the examination, no security classification level has been determined by the competent authorities, the Patent Office shall inform the applicant that the application contains no secret invention and shall ask for his express consent for the application to be examined in accordance with the ordinary provisions. In case no such consent is received within three months, the application shall be deemed to be withdrawn.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

Bulgarian Patent Law does not define inventorship. According to our opinion it will be better the inventorship to be mentioned in the Law, that the relationships between the inventors are subject of inventorship agreement.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

The Bulgarian Law does not provide an application for patent to be filed first in our country

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

According to the Bulgarian Law we do not see any aspects that could be improved to address multinational inventions.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

According to the Bulgarian Law we do not see any aspects that could be improved to facilitate filing of patent applications having multinational inventions.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

no

The Bulgarian Law is harmonized to a satisfactory extent as regards multinational inventions.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

N/A

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

N/A

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

N/A

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

N/A

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

N/A

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

N/A

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

N/A

Summary

The inventorship is defined in the Bulgarian Law on Patent and Utility Models Registrations (the Law) adopted in 1993 with last amendments in 2012.

The determination of inventorship hinges upon two points:

- An inventor is a person who contributes to the conception of an invention;
- Two or more persons who collaborate to produce the invention through aggregate efforts.

However, according to the Bulgarian Supreme Court practice (Preliminary ruling decision No 6 from 1979) inventor, accordingly co-inventor is not the person/s who just manages the organisation/firm which provides materials, technics or premises to the inventor/s, as well as person/s that only provide technical support of the inventorship process.

According to the Law, the inventor is considered as the person who has made an invention. If the invention was made by several persons, the latter shall be recognized as joint inventors.^[1]

^[1] Article 2 of Law on patent and utility models registrations (title amended, State Gazette No.66/2002)

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

N/A

CA-Caribbean Regional-Group

Report Q244

in the name of the CA-Caribbean Regional-Group Group
by Edy Guadalupe PORTAL

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The Salvadorian Intellectual Property Law does not make any distinction in regards to the nationality of the inventors. Article 117 only states that the right to a patent will be granted to the inventor, and in case that the invention is made by more than one inventor, all the intervening parties will be considered inventors.

As a compulsory requirement, the nationality of the inventors must be incorporated in the patent application.

As the Salvadorian Intellectual Property Law does not make a distinction to this regard, both intervening parties would be considered inventors.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

Does not apply, as all intervening parties would be considered inventors. Inventorship can be inventor of part of the patent or they can be inventors of the whole patent. There are no regulations in this regard. Accordingly, under our Law inventorship can be determined on a claim by claim basis or can be determined by the whole patent or by a part of it. However, for purposes of obtaining a patent certificate all the inventors are considered as inventors of the whole patent. However, if the applicant requests that one inventors must be considered as an inventor of only part of the patent, then the assignment document must reflect this fact.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, it does not.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, it does not.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

If the correction pertains to a typo or any other formal mistake, it can be made at any moment before the patent certificate is issued.

If the correction pertains to an error in the identity of an inventor (change of inventor), it should be changed before the patent certificate is issued. To this regards the patent documents must be amended, and a new power of attorney and assignment document must be filed.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

No, the patent would not be deemed invalid or not enforceable. In order to change the stated inventorship a certificate rectification request must be filed. It does not matter whether the error was intentional or unintentional.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

If the answer is yes, please answer the following:

- a. Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b. Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c. If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d. How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e. In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f. What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

- a. If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b. If yes, describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c. If yes, describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

Salvadorian Intellectual Property Law does not provide a definition of inventorship, it only determines that the creator of the invention is granted the patent right. Therefore we consider that a definition should be included in order to provide the patent applicants with a clear guidance as to who should be named as inventor.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Does not apply.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Does not apply.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

As the Salvadorian Intellectual Property Law does not make a distinction between national and foreign inventors, there are no aspects to be improved.

III.) **Proposals for harmonisation**

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

Inventorship should be defined taking into consideration that the inventor must have taken part in the conception and not only in the reduction to practice stage of the invention. Inventorship, the recognition of a person as an inventor due to his/her intervention in the creation of an invention, when the intervention pertains to the conception process, and not only to the reduction to practice stage, and who has contributed to the claims of a patentable invention.

- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

Standard correction would require the filing of a petition to correct or amend the application, and a document signed by the persons who are being deleted and by the persons who are being added, as well as the filing of amended power of attorney and assignment documents if applicable.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

I don't believe such requirement would be appropriate.

- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

I don't believe such requirement would be appropriate.

- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

I don't believe such requirement would be appropriate, as patent filing licenses are not compulsory to all countries.

- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

I don't believe that first filing requirements should be compulsory and failure to comply with such requisite should be easily corrected by allowing the filing of the patent application in the country where the first filing requirements are compulsory.

- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

I consider that no obstacles should be set for the registration of multinational inventions.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Canada

Report Q244

in the name of the Canada Group
by Matthew ZISCHKA, Jean-Charles GRÉGOIRE, Charles BOULAKIA, Kevin SHIPLEY, Santosh
CHARI, Val COTTRILL and Fraser ROWAND

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The test for determining who is an “inventor” is not codified in Canada. Instead, case law provides guidance. The Supreme Court of Canada has articulated the following test:

An inventor is:

- a. the person who first conceives of a new idea or discovers a new thing that is the invention; and
- b. the person that sets the conception or discovery into a practical shape.

That is, in Canada, an inventor must contribute in some way to the inventive concept that forms the basis of the patent application.^[1] Merely identifying problems with existing products or generating a list of desirable product features based on customer feedback is not sufficient.^[2]

Inventors must be natural persons.^[3]

The act of conceiving a new idea is distinguished from mere testing or verification. For the conception/discovery requirement to be satisfied, “the invention for which patent protection is sought must have originated in the inventor’s own mind”. An inventor must not have borrowed the idea for the invention from someone else.^[4]

However, a person need not be the sole originator of the invention. Rather, any person who contributed to the inventive concept may qualify as a co-inventor. The contribution may be of “minor importance”, as long as it is an “inventive” contribution.

By contrast, those who helped the invention to completion, but whose ingenuity is directed to verification rather than contribution to the original inventive concept are not co-inventors.^[5]

A general idea, however, is not enough to constitute invention. Rather, the inventor must have reduced the idea to a “definite and practical shape”. This may be accomplished by a written or oral description of the invention or by putting the invention into physical practice.^[6]

Reduction of an idea to physical practice satisfies the definite and practical shape requirement regardless of whether the invention is an apparatus, process, or a combination.^[7]

However, it is less clear exactly what kind of description is sufficient to have reduced the invention into “definite and practical shape”. Filing of a patent application is not required. The Supreme Court of Canada has held that the description must be one that

“affords the means of making that which is invented”.^[8] The Court has also articulated the requirement as: the written description must be sufficient to “enable a person skilled in the art to make the invention defined by the conflict claims without the exercise of inventive ingenuity.”^[9]

The location of the inventors is not relevant to assessing inventorship. Accordingly, for person A and/or B to be considered an inventor under Canadian law, A and/or B must only have contributed to the inventive concept.

Footnotes

1. [^](#) *Apotex v Wellcome Foundation (2000)*, 10 CPR (4th) 65 (FCA) at 77, *aff'd* 2002 SCC 77 at paras 96-97 [“AZT-SCC”].
2. [^](#) *Drexan Energy Systems Inc. v The Commissioner of Patents*, 2014 FC 887 at para 29.
3. [^](#) *Sarnoff Corporation v Attorney General of Canada*, 2008 FC 712, *aff'd* 2009 FCA 142.
4. [^](#) *Supra* note 1; *Gerrard Wire Typing Machines Co. Ltd. of Canada v Cary Manufacturing Co.*, [1926] ExCR 170 at para 23 [“Gerrard Wire”].
5. [^](#) AZT-SCC, *supra* note 1 at para 99; *supra* note 2 at paras 24, 26; *Gerrard Wire*, *ibid* at para 32.
6. [^](#) *Weatherford Canada Ltd. et al v Corlac Inc. et al*, 2010 FC 602 at para 239, *aff'd* on this issue 2011 FCA 228 at paras 99-110 [“Weatherford”]; *Christiani and Nielson v Rice*, [1930] SCR 443 at paras 31, 41, *aff'd* [1931] AC 770 (PC) [“Christiani”].
7. [^](#) *Lubrizol Corp v Imperial Oil (1992)*, 45 CPR (3d) 449 at para 34 (FCA).
8. [^](#) *Christiani*, *supra* note 6 at para 36.
9. [^](#) *Koehring Canada Ltd. v Owens-Illinois Inc. (1980)*, 52 CPR (2d) 1 at 11 (FCA).

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

The key consideration in determining inventorship is whether a person contributed to the inventive concept of the invention.^[1]

Typically, the inventive concept is reflected in the claims, and there is authority for the proposition that “any question of inventorship or date of invention must be tested against language of the patent claims, which alone define the exclusive right conveyed by the patent grant”.^[2]

Footnotes

1. [^](#) AZT-SCC, *supra* note 1 at para 96.
2. [^](#) *Comstock Canada v Electec Ltd (1991)*, 38 CPR (3d) 29 at para 71 (FCTD).

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Citizenship is irrelevant to inventorship in Canada.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Residency/location is irrelevant to inventorship in Canada.

4) **Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

For pending patent applications, the Canadian *Patent Act* authorizes the Commissioner of Patents to amend the named inventors in certain circumstances^[1]:

- s. 31 (3) Where an application is filed by joint applicants and it subsequently appears that one or more of them has had no part in the invention, the prosecution of the application may be carried on by the remaining applicant or applicants on satisfying the Commissioner by affidavit that the remaining applicant or applicants is or are the sole inventor or inventors.
- s. 31(4) Where an application is filed by one or more applicants and it subsequently appears that one or more further applicants should have been joined, the further applicant or applicants may be joined on satisfying the Commissioner that he or they should be so joined, and that the omission of the further applicant or applicants had been by inadvertence or mistake and was not for the purpose of delay.

“Applicants” includes inventors.^[2]

For issued patents, the Canadian Federal Court has exclusive jurisdiction^[3] to amend entries in the records of the Patent Office relating to inventorship, and a court order is necessary to amend the inventorship information of an issued patent.

Question 4(a)

For an application, correction may be made prior to issue. Affidavit evidence may be required.

For an issued patent, the applicant seeking such an order must submit evidence to convince the court on the balance of probabilities that the order should be issued. Importantly, a court order is required even if the failure to list the proper inventors was due to a clerical error or an inadvertent mistake on the part of the patentee and the application for an amendment is uncontested.^[4] An applicant, or an assignee, is required to notify any persons claiming an interest in the patent, and if there is a pending infringement case involving the patent at issue, any persons that may have a defence that could be affected by the order sought.^[5]

There is no specific deadline for making corrections to inventorship. Prompt correction is prudent.

Footnotes

1. [^](#) *Patent Act, RSC 1985, c P-4, s. 31(4)*.
2. [^](#) *Patent Act, RSC 1985, c P-4, s. 2*.
3. [^](#) *Patent Act, RSC 1985, c P-4, s. 52*.
4. [^](#) *Dr. Falk Pharma GmbH v The Commissioner of Patents, 2014 FC 1117*.
5. [^](#) *Micromass UK Ltd. v The Commissioner of Patents, 2006 FC 117 at para 14*. Note: the Canadian Patent Act is becoming PLT compliant and will change these requirements relating to correction of inventorship. Section 49 of the Canadian Patent Act as amended by Bill C-43 allows a patent or patent application to be transferred without formalities and recorded without supporting evidence.

5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

Incorrect attribution of inventorship may be the basis for invalidating a patent if the attribution is a material allegation.^[1] Where, however, the erroneous identification of an inventor does not affect the ownership of or entitlement to the patent, the error may not be “material”.^[2] Further, a failure to name inventor(s) would not appear to render the patent void if the allegation was not willfully made for the purpose of misleading.^[3]

Footnotes

1. [^](#) *Patent Act, RSC 1985, c P-4, s 53(1)*.
2. [^](#) *DEC International Inc v AL Lacombe & Associates Ltd (1989)*, 26 CPR (3d) 193 at 214 (FCTD); *Procter & Gamble Co v Bristol Myers Canada Ltd (1978)*, 39 CPR (2d) 145 at 156-157 (FCTD), *aff'd (1979)*, 42 CPR (2d) 33 (FCA).
3. [^](#) *Weatherford, supra note 6; 671905 Alberta Inc. v Q'Max Solutions Inc., 2003 FCA 241 at para 32*.

6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

no

There generally is no requirement to first file in Canada. However, patent applications for inventions made by government employees or that are otherwise owned by the Government require Ministerial approval before disclosure or filing abroad.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Only inventions that are made by Government employees or are otherwise owned by the Government require Ministerial approval before disclosure or patent application filing abroad. [\[1\]](#)

Applications for certain technologies may otherwise be the subject of secrecy review. However, there is no prohibition on foreign filings

Sections 20 and 21 of the Canadian *Patent Act* confer authority on the Canadian government to keep certain inventions, including those “vital to the defence of Canada” from publication “in order to preserve the safety of the State”.^[2] However, detailed procedures and guidelines governing the issuance of Secrecy Orders do not appear to be publicly available.

For inventions relating to nuclear energy, section 22 of Canada’s *Patent Act* requires that the applications shall be reported to the Canadian Nuclear Safety Commission prior to examination or publication. However, the provision does not provide a mechanism for the Commissioner to prevent examination or publication, and does not place burden on applicants to report to the Commissioner prior to filing.

Footnotes

1. [^](#) *Public Service Inventions Act, RSC 1985, c P-32, s. 4.*
2. [^](#) *Patent Act, RSC 1985, c P-4, ss. 20, 21.*

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

Where secrecy is appropriate, the application will not publish until the secrecy order is removed.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Section 27 of the *Security of Information Act*^[1] provides consequences for the unauthorized disclosure of information relating to certain inventions, including those “vital to the defence of Canada” from publication “in order to preserve the safety of the State”. Punishment includes conviction with up to 14 years imprisonment or summary conviction with up to 12 months imprisonment and/or a fine up to \$2000.

Footnotes

1. [^](#) *Security of Information Act, RSC, 1985, c O-5, s. 27.*

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

The definition of inventor or inventorship could be codified for greater clarity.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

N/A

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

These provisions are rarely used. However, there should be a clear mechanism formalized by Regulations or Statute for situations requiring a secrecy review that may arise.

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

No comment.

III.) Proposals for harmonisation

- 12) Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

Whether a person is an inventor should be assessed with reference to contribution to the claims.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

During pendency of applications, changes to inventorship should be straightforward, particularly if made by an authorized representative/agent. Possibly an explanation/affidavit could be required.

To limit costs, an administrative mechanism should be provided after issuance – perhaps through national/regional patent offices.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

We do not believe that such a requirement is appropriate.

First filing requirements appear to serve two purposes: 1) to limit export of certain technologies, and limit the disclosure/export of such technologies; and 2) to promote national patent application filings.

Insofar as any first filing requirement serves to limit export or disclosure of inventions, such first filing requirements should be abolished and instead be subsumed in export control/secretcy laws (e.g. US ITAR) more generally. In today's age, national patent offices are poor proxies to control export/disclosure of technology. In the absence of further controls, they are virtually ineffective in controlling such export/disclosure. In the case of multinational inventions technology export, by way of collaboration, will already have occurred.

Insofar as any first filing requirement serves to promote national patent application filings, such a requirement should be abolished in view of another mechanism (e.g. tax credit) to promote national patent application filings.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

Multinational inventions already rely on the sharing of information between nationals/residents of different countries. If such sharing is inappropriate, it may be addressed through export control or secrecy laws rather than patent laws.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

Please see response to question 15.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

There should be a mechanism that allows an applicant to retroactively cure or repair an inadvertent failure to comply with the first filing requirement or where compliance was not possible – as may be the case where national laws conflict.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

No comment.

Summary

Under Canadian law, the location, citizenship or residency of inventors is not relevant in determining who is an inventor. There is no general requirement to file first in Canada when a Canadian inventor or applicant is involved. Canadian government employees require Ministerial approval before disclosure or foreign filing of a patent application. Applications for certain technologies may be subject to secrecy review, but there is no prohibition on foreign filing and there are no detailed procedures or guidelines for conduct of a secrecy review. The Canadian Group is of the view that there should be no domestic first filing requirements and that any state secrecy concerns are better dealt with through export control/disclosure legislation and rules, and not through patent legislation.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

China

Report Q244

in the name of the China Group
by Yali SHAO

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

According to Rule 13 of the Implementing Regulations of the Patent Law of China, an "inventor" means any person who makes creative contributions to the substantive features of an invention. Any person who, during the course of accomplishing the invention, is responsible only for organizational work, or who only offers facilities for making use of material and technical means, or who only takes part in other auxiliary functions, shall not be considered as inventor.

In China, the inventorship has no relation to the residence of an inventor. If person A and person B, no matter where they live, jointly make creative contributions to the substantive features of the invention, both of them should be considered as inventors. However, if person A directs the effects of person B only to the extent of organizing person B's work, person A should not be considered as an inventor in China.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The Patent Law of China does not define inventorship based on any particular part of the patent application. Anyone who makes creative contributions to the substantive features of an invention should be considered as an inventor of the application.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The establishment of inventorship does not depend on the citizenship of the inventor(s) under the Patent Law of China.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

The establishment of inventorship does not depend on where the invention was made under the Patent Law of China.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

The inventorship of a patent application can be corrected after the filing date in China upon request with related statement of agreement or evidence.

Under the current Patent Law of China,

(1) Where the name of an inventor is requested to be corrected due to the change of the inventor's name, a request for correction shall be submitted together with the certifying document proving the change of the name;

(2) Where the name of an inventor is requested to be corrected due to writing errors, a request for correction shall be submitted together with a declaration signed by the inventor and the document certifying the identification of the inventor;

(3) Where the name of an inventor is requested to be corrected due to the Chinese translation, a request for correction shall be submitted together with a declaration of the inventor;

(4) Where the request to make a change is due to failure to fill in the name of inventor or his wrong name filled in, the certifying document signed or sealed by all the applicants (or patentees) and all the inventors before the change shall be submitted;

(5) Where the request to make a change is due to the dispute over the eligibility of the inventorship, the request for correction of inventorship shall be submitted together with legal documents provided by an administrative authority for patent affairs, a court or an arbitration organization regarding the resolution of such dispute.

There is no specific time limit, but it is advisable to request for the correction ASAP from time of finding the incorrect.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

No severe consequence can be caused by an error in the stated inventorship on a patent application in China considering the fact that correction of inventorship is allowable in China. An error in the stated inventorship does not constitute a reason for invalidating or not enforcing an issued patent. No provision is particularly provided by the Chinese Patent Law for the situation where the error was intentional. However, since the intentional behavior obviously violates the principle of good faith under the General Provisions of the Civil Law and it may constitute a fraud, punishment may be applied if a legal consequence is caused by such intentional behavior.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

China does not require an application for a patent claiming an invention made in China to be first filed in China. However, for such an application, a secrecy review is required before the application is first filed abroad.

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

According to Article 20 of the Patent Law of China, where any entity or individual intends to file an application for patent abroad for any invention or utility model developed in China, it or he shall request in advance the patent administration department under the State Council (the SIPO) for confidentiality examination.

According to Rule 8 of the Implementing Regulations of the Patent Law of China, an invention made in China means the substantive contents of the technical solution of the invention were made within the territory of China. Therefore, "an invention made in China" is determined by the geographical location where the invention is conducted and completed. It has no relation with the nationality of the inventor(s).

The confidentiality examination, or in other words, secrecy review, is required for all technical areas. Any invention made in China must undergo a secrecy review process before it can be filed in another country.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

According to Rule 8 of the Implementing Regulations of the Patent Law of China, where an applicant intends to file an application for patent abroad for an invention made in China, there are three modes to complete the procedure of secrecy review:

(1).If the applicant intends to first file the application abroad without a Chinese filing first, a request for secrecy review shall be filed in advance with SIPO. SIPO will conduct the secrecy review, and issue a notification to the applicant promptly where the application is possibly to be handled as a secret. If the applicant fails to receive the notification of possible secret within 4 months from the date of filing the secrecy review request, the applicant is free to file the application in any foreign country or interna-

tional organization. If the applicant receives the notification of possible secret, he will receive a final notification that notifies whether the application is determined to be secret within 6 months from the date of filing the secrecy review request.

Under this mode of requesting secrecy review, a Chinese description for the technical solution of the invention must be submitted together with the request for secrecy review.

(2). If the applicant intends to second file the application abroad after a Chinese first filing, a request for secrecy review is still required before it can be filed abroad. The behavior of first filing the patent application in China does not meet formality requirement of filing a request for secrecy review. That is, a separate request for secrecy review needs to be filed along with or after the filing of the Chinese application. Considering the time needed for SIPO to review and issue a notification of result, the request for secrecy review should be at least 6 months before the expiration of Paris Convention deadline if the Chinese application is intended to be claimed as a priority.

Under this mode of requesting secrecy review, since a Chinese application was filed in advance, no additional description for the invention is needed.

(3). If the applicant files the application as a PCT application with SIPO as the Receiving Office, a request for secrecy review is deemed as being simultaneously filed, that is, no separate request for secrecy review is needed to be filed.

Under this mode of requesting secrecy review, the PCT application may be filed in Chinese or English. No Chinese translation is needed in case that the PCT application is filed in English, which may save the applicant's cost on translation.

No official fee is charged by SIPO for requesting secrecy review. However, the applicant may need to pay service fees (including translation fees) for related services provided by the law firm or patent agency with which he entrusted the matter.

An applicant who disagrees with the decision issued by SIPO for not allowing the application to be filed abroad, could request an administrative reconsideration, according to provisions of the Administrative Reconsideration Law of the People's Republic of China and the Administrative Reconsideration Procedure of State Intellectual Property Office of China.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

The violation of procedure of security clearance under Article 20, clause 1 of the Patent Law of China may result in the refusal of granting a corresponding Chinese application according to Article 20, clause 4 of the Patent Law of China. Even if the corresponding Chinese application is granted due to lacking of related information during the substantive examination, the granted patent could be invalidated since such violation is a legal reason for invalidating a Chinese patent.

No criminal punishment is regulated by the Patent Law of China. However, in case that the invention made in China belongs to technology restricted or prohibited from export, the foreign filing without the consent from SIPO may be treated as technology export, and therefore, criminal punishment such as crime of divulging national secrets could be applied under the Regulations on Technology Importation and Exportation Administration, especially if the failing to comply with this law is done intentionally. The inadvertency is not an excuse for impunity.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

The Patent Law of China does not define inventorship based on any particular part of the patent application. Anyone who makes creative contributions to the substantive features of an invention should be considered as the inventor of the application. On the other hand, a

person who is responsible only for organizational work, who offers facilities for making use of materials and technical means, or who takes part only in other auxiliary functions, is not considered to be an inventor. While, from a legal perspective, the “substantive features” refer to those features that distinguish the invention from the closest prior art and thus render the invention patentable, in practice they are generally considered as the act of proposing the original idea of the originally claimed invention.

Therefore, we believe the definition of inventorship is sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

China does not require first filing of patent applications directed to inventions made in China.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

According to the Patent law of China, secrecy review is required for all types of inventions made in China. No specific prescription is provided by the law regarding how a multinational invention should undergo the secrecy review procedure. However, in practice, a “multinational invention” may be distinguished as a “single national invention” based on the fact where the substantive contents of the technical solution of the invention are made.

Under the current Patent Law of China, a multinational invention should be regarded as an invention made in China if the substantive contents of the technical solution of the invention were made within the territory of China, and therefore, secrecy review by the SIPO is required if the applicant wishes to first file the invention application abroad.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

Under the current Patent Law of China, after receiving an applicant’s request for security review, SIPO will conduct the secrecy review, and issue a notification to the applicant promptly where the application is possibly to be handled as a secret. If the applicant fails to receive the notification of possible secret within 4 months from the date of filing the secrecy review request, the applicant is free to file the application in any foreign country or international organization. If the applicant receives the notification of possible secret, he will receive a final notification that notifies whether the application is determined to be secret within 6 months from the date of filing the secrecy review request.

Therefore, according to the law, it may take up to 6 months for an applicant to receive the final decision on whether a foreign filing is allowed from SIPO.

In practice, however, SIPO usually conducts the security review very quickly:

- If the request for security review is submitted together with a Chinese patent application, the initial notification regarding the security review is usually issued simultaneously with the filing receipt of the patent application;
- If the request for security review is separately submitted, after filing or without filing a Chinese patent application, the initial notification regarding the security review is usually issued within one month.

In view of the above, we think it is advisable that China considers to reduce the legal time periods of 4 months for an initial notification and 6 months for a final notification to, for example, respectively 2 months for an initial notification and 4 months for a final notification, so that an applicant does not need to worry that he still needs to submit the security review request 6 months before he can actually file the application abroad.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Yes, harmonization is desirable in this area.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

Instead of listing all members of a research team as joint inventors regardless of individual contribution, or listing a research team leader or lead professor as a joint inventor to show respect rather than judging based on an actual inventive contribution, we believe the definition to an inventor prescribed in the Patent Law of China is recommended:

An "inventor" means any person who makes creative contributions to the substantive features of an invention. Any person who, during the course of accomplishing the invention, is responsible only for organizational work, or who only offers facilities for making use of material and technical means, or who only takes part in other auxiliary functions, shall not be considered as inventor. The "substantive features" refer to those features that distinguish the invention from the closest prior art and thus render the invention patentable.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

In our opinion, the correction of the inventorship should be allowed during the pendency of an application and valid term of the corresponding patent no matter whether the incorrectness is made intentionally or unintentionally. The invoking of the correction procedure should be based upon the request of a related party, e.g., the applicant or the inventor(s).

In view of the above opinion, we propose the following standard for correction of inventorship after a patent application is filed:

Any correction of inventorship after a patent application is filed shall be initiated upon the request of an applicant or an inventor of the applicant during the pendency of the application by completing the following legal procedure:

(1).Where the name of an inventor is requested to be corrected, a request for correction shall be submitted together with the evidence of the correct name of the inventor;

(2).Where the request to make a change is due to failure to fill in the name of inventor or his wrong name filled in, the certifying document signed or sealed by all the applicants (or patentees) and all the inventors before the change shall be submitted;

(3).Where the request to make a change is due to the dispute over the eligibility of the inventorship, the request for correction of inventorship shall be submitted together with legal documents provided by an administrative authority for patent affairs, a court or an arbitration organization regarding the resolution of such dispute.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

Since the purposes of first filing requirements, foreign filing licenses and secrecy reviews are all generally seeking to provide the government with an opportunity to review the subject matter and ensure that certain categories of information are not transmitted outside the country,

it would be better if one of the first filing requirements, foreign filing licenses and secrecy reviews, instead of all of them, is adopted as a filing requirement for the multinational inventions.

We suggest adopting the secrecy review as the filing requirement for the application because secrecy review procedure is more operable than the other two systems. For example, an application for an invention jointed made in two countries could be granted in the two countries if both countries adopt a secrecy review system. However, if the two countries both have first filing requirements, no patent is obtainable from the two countries without violating one country's requirement.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

In our opinion, in order to provide the government with an opportunity to review the subject matter and ensure that certain categories of information are not transmitted outside the country, secrecy review is required before any patent application claiming an invention made domestically is filed abroad.

Similar with the modes used in China, there could be three modes to complete the procedure of international standard for secrecy review:

(1) If the applicant intends to first file the application in a foreign country without a domestic filing first, a request for secrecy review shall be filed in advance with its Intellectual Property Office (IPO). IPO will conduct the secrecy review, and issue a notification to the applicant promptly where the application is possibly to be handled as a secret. If the application passes the secrecy review, then this application should be free to be filed abroad.

Under this mode of requesting secrecy review, a description for the technical solution of the invention must be submitted together with the request for secrecy review.

(2) If the applicant intends to second file the application in a foreign country after a domestic first filing, a request for secrecy review is still required before it can be filed in a foreign country. The behavior of first filing the patent application domestically does not meet formality requirement of filing a request for secrecy review. That is, a separate request for secrecy review needs to be filed along with or after the filing of the domestic application.

Under this mode of requesting secrecy review, since a domestic application was filed in advance, no additional description for the invention is needed.

(3) If the applicant files the application as a PCT application with an IPO as the Receiving Office, a request for secrecy review is deemed as being simultaneously filed, that is, no separate request for secrecy review is needed to be filed.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

As mentioned in the above item 15), we suggest adopting secrecy review as the filing requirement for the multinational inventions, rather than the foreign filing license.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

In our opinion, since the secrecy review is used to provide the government with an opportunity to review the subject matter and ensure that certain categories of information are not transmitted outside the country, it would be unfair if those applications which fail to comply with the secrecy review requirement could still be granted. Therefore, the applicants should pay extra attention to this aspect of the procedure for their applications.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Most importantly, the definition to a multinational invention shall be unified. It is better that the “multination” is distinguished by the geographical locations where the research is conducted without considering the citizenship of inventor(s) involved in the research or the laws under which the employment contracts are signed.

Summary

Under the Patent Law of China, an “inventor” means any person who makes creative contributions to the substantive features of an invention. Any person who, during the course of accomplishing the invention, is responsible only for organizational work, or who only offers facilities for making use of material and technical means, or who only takes part in other auxiliary functions, shall not be considered as inventor. The inventorship does not rely on or look to a particular part of the patent application, and is not affected by the citizenship or the residency of the inventor(s). The inventorship can be corrected after filing in China upon request plus agreement or evidence.

For an invention made in China, or a multinational invention of which the substantive contents of the invention were made in China, instead of first filing requirement, China requires a secrecy review for all technical areas before the application can be filed abroad. “An invention made in China” is determined by the geographical location where the invention is conducted and completed. A “multinational invention” may be distinguished as a “single national invention” based on the fact where the substantive contents of the invention are made. If a PCT application is filed with SIPO as the receiving office, no separate request is required for the security review, otherwise, a request for security review together with Chinese description for the technical solution or a request for security review after the filing of a Chinese application is required before filing the application abroad.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Czech Republic

Report Q244

in the name of the Czech Republic Group
by Michal HAVLIK

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Under the Czech Patent Act, an inventor is the person who made the invention by its creative work. Therefore, it would have to be assessed to what degree were the contributions of persons A and B of creative intellectual nature in contrast to organizational activity or support in preparing drawings or calculations and the like.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

No, co-inventorship is not determined on claim by claim basis. The Czech Patent Act states that co-inventors have the right to patent in the scope in which they contributed to creating the invention. The shares of the co-inventors are to be determined by agreement of the co-inventors or upon failure to reach an agreement by court.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

In practice, such correction is most often the registration of additional inventor. Such correction in the register of the Office requires consent of all existing registered inventors. There are no time limits for such change.

If there is a dispute over the right to patent, it must be submitted to the court. The Office shall suspend examination proceedings on the patent application while the court litigation is pending.

- 5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

If a court determines that another person is entitled to the patent other than the person stated in the application as filed, the Office shall record as the patent (application) owner such person as determined by the court.

- 6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

no

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

- 7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

no

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

In the view of the Group, the general definition is sufficient and there is no practical or empirical evidence in the Czech Republic that the definition would require amendment.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Not applicable.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Not applicable.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Not applicable.

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

The Group is of the opinion that the international definition should be based on the contribution to the inventive or creative essence of the invention.

- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

The Group holds the view that international standards should be liberal and that it should be possible to correct inventorship at any time provided that there is agreement of the inventors

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

The Group thinks that first filing requirement is contrary to the reality of the 21st century as to multinational inventions and believes that the first filing requirement should be abandoned as an international standard.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

The Group thinks that secrecy review requirements are contrary to the reality of the 21st century as to multinational inventions and believes that secrecy review requirements should be abandoned as an international standard.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

The Group thinks that foreign filing license requirements are contrary to the reality of the 21st century as to multinational inventions and believes that foreign filing license requirements should be abandoned as an international standard.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

See the above.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

No additional comments.

Summary

Under Czech law, an inventor is the person who made the invention by its creative work. In case of plurality of inventors, the shares of the co-inventors are to be determined by agreement of the co-inventors or upon failure to reach an agreement by court. For correction of inventors in the register, the Office requires consent of all existing registered inventors. If there is a dispute over the right to patent, it must be submitted to the court. The Czech National Group is of the view that national law requirement of first filing, secrecy review or foreign filing do not correspond to the social and economic reality of 21st century and as such should be abandoned.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Denmark

Report Q244

in the name of the Denmark Group
by Nicolaj BORDING, Jeppe BRINCK-JENSEN, Thomas ROSLEFF BAEKMARK, Ejvind CHRISTIANSEN, Ulla KLINGE, Sanne BANG OLSEN, Peter-Ulrik PLESNER, Sture RYGAARD, Casper STRUVE and Ania Pacyk NIELSEN

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Introductory remarks

There is no statutory definition of inventorship under Danish law.

According to the Danish Patents Act, Section 1, subsection 1, *any person who has made an invention which is susceptible of industrial application, or his successor in title, shall, in accordance with this Act, have the right on application to be granted a patent for the invention and thereby obtain an exclusive right to exploit the invention commercially. Inventions may be patented within all areas of technology.*

However, as indicated above, this does not imply a definition of "inventorship", but merely sets forth the rights a person has, if that person *is* an inventor.

The European Patent Convention, which Denmark has adhered to, does not provide a definition of "inventorship" either.

There is very little Danish case law (or legal theory) dealing with the issue of "inventorship", and the little there is provides scarce guidance of a general nature to the issue. Danish courts generally tend to go for pragmatic solutions based on the specific facts of the case rather than developing legal criteria of general application. However, it would appear that Danish courts have considered it - in relation to the issue of joint inventorship - sufficient to enjoy inventor's rights (i.e. for someone to be considered a co-inventor) that a person is *the originator of the idea or the originator of the idea on the basis of which the invention is developed*, cf. the valve judgment (U.2004.1018H) below.

In the Pfaff judgment (U.1988.991H) the Danish Supreme Court, considered the consequences of a drawing of an idea on the back side of the Danish director's flight ticket during a flight trip. The drawing was shown to a subsupplier who developed the idea and started production of the product. The subsupplier filed a patent application in his own name. The Supreme Court found that the director came up with the idea and gave the subsupplier the assignment of developing the idea into a tool. As no agreement had been made between them regarding the right to a possible patent, the Supreme Court ruled that they had a joint right to the invention.

In another Supreme Court judgment (U.2004.1018H), A was employed as a sales consultant in company B, producing valves. A had an idea for a new valve. A presented the idea to B, which launched a development project based on the idea, which led to B applying for Danish, international and US patents. In the patent application A was

listed as an inventor, along with two employees from B's development department. In connection with the patent applications, A transferred the right to the invention to B but made a claim for compensation. The Supreme Court agreed with A's argument that he should be regarded as the originator/author of the idea on the basis of which the valve was developed (according to A's job description and his working conditions, his contribution to the invention was considered to be beyond what he could be reasonably assumed to have performed in a position as a sales consultant).

In yet another Supreme Court case (U.2004.1802H), A had invented a system for loading and shipping of decorative greenery and Christmas trees onto pallets during his employment with G. A filed a patent application in his own name. In the meantime, G began producing and selling the system, as G and A agreed to share profits equally. A was dismissed a few years later and G became aware of the existence of the patent. G requested the patent transferred to him. A started an in-house production and sale of pallets. The Supreme Court found that A had made the invention through his employment, and the utilization fell within G's work field. G was therefore entitled to have the patent transferred to him. The Supreme Court also found that G had a claim against A, and that it was at least the same size as his share of the profits (i.e. half of the profit). In addition, most Danish patent practitioners and scholars would most likely agree, and this probably also follows implicitly from the limited case law (cf. the courts use of the word "originator") that a person, who only carries out unoriginal, routine work involving no independent creative efforts, is not a (co-)inventor, as inventorship presumably requires an independent, intellectual contribution to/directed at the invention as such. There are no geographical requirements associated with acquiring inventor's rights under Danish law. Accordingly, it does not matter that the decisive inventive efforts, cf. above, are made outside Denmark in relation to the originator being considered an inventor under Danish law.

Answer to a)

There is no authority dealing specifically with this aspect of inventorship.

The Danish group believes that, assuming B does not make any independent, intellectual contributions of his own to/directed at the invention, but only passively follows instructions from A, B would not be considered an inventor. If A, on the other hand, by his instructions/directions or otherwise makes independent intellectual contributions to/directed at the invention which would make him an/the "originator of the (inventive) idea", then, presumably, A would be considered an inventor or co-inventor under Danish law. In this regard, it would most likely not matter that A is located outside Denmark when it is presumed in the question that Danish law applies (i.e. we assume that the choice of law, notwithstanding private international law rules, is Danish law).

Conversely, if B's efforts do amount to independent, intellectual contributions to the invention, then B would be considered a co-inventor of the invention. Again, the geographical issue of A's and/or B's location does not matter for deciding the issue of inventorship under Danish law.

If both A and B contribute with independent, intellectual contributions, they would be considered co-inventors. Again, the geographical issue of A's and/or B's location does not matter for deciding the issue of inventorship under Danish law.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The Danish Patents Act or case law does not determine this. However, as the claims define the scope of the invention, the Danish group finds that inventorship would in principle be determined on a claim-by-claim basis, but it cannot be excluded that

other parts of the patent/patent application would have significance as well, if e.g. these parts contain independent, intellectual contributions directed at the invention and somehow contribute to the realization of the invention.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, inventorship does not depend on citizenship, provided that Danish law applies. However, citizenship could affect the choice of law.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, inventorship does not depend on where the invention has been made or residency of the inventors, provided that Danish law applies. However, residency could affect the choice of law.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Yes, both a voluntary correction before the Danish Patent and Trademark Office (hereafter referred to as "DKPTO") and a "hostile" request for acknowledgment of co-inventorship or rightful inventorship can be filed. There are no special requirements or time limits for a voluntary correction, except that it should be made during pendency of the application.

One or more named inventors must always be stated in the application form.

An inventor, who is stated in the application form, can only be deleted subject to his consent. Joinder of one or more co-inventors does not require consent from the originally named inventor(s) if filed by the applicant, his (successor-in-title) or his attorney (DKPTO guidelines).

This procedure is in accordance with Art.81 EPC, as implemented in Rules 57(f) and 21(1) EPC.

Requests for acknowledgement of co-inventorship or transfer of the application to a person claiming to be the rightful inventor are dealt with under question 5.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

If any person claims before the Danish Patent Office that he, and not the applicant, is entitled to the invention, the DKPTO may, if it finds the question doubtful, invite him to bring it before the courts within a time limit to be specified. If the invitation is not complied with, the DKPTO may disregard the claim when deciding on the patent application (Danish Patents Act, section 17). If legal proceedings are commenced concerning the right to the invention, the proceedings at the DKPTO are suspended until a final decision has been given in the legal proceedings. If the result of the legal proceedings is that he, and not the applicant, is entitled to the invention, the DKPTO shall transfer the application to him if he so requests (Danish Patents Act, section 18).

A patent may be revoked by a court decision according to the Danish Patents Act, section 52, if the patent has been granted notwithstanding that the requirements in section 1 are not complied with, i.e. either the inventor or his successor in title (the applicant) is not the true inventor/applicant.

A patent, however, may not be revoked in its entirety on the ground that the patent holder was only partially entitled to the patent, cf. section 52 (2) of the Patents Act.

Proceedings that the patent has been granted to another person than the person solely entitled thereto may, according to Danish Patents Act, section 52 (4), only be instituted by the person claiming to be entitled to the patent. Such proceedings shall be instituted within 1 year after the entitled person has obtained knowledge of the grant of the patent. If the proprietor of the patent acted in good faith when the patent was granted or when he acquired the patent, the proceedings may not be instituted later than 3 years after the grant of the patent.

Thus proceedings regarding entitlement may only be instituted by the person claiming to be entitled to the patent in question. The question of intentional or unintentional error influences the time frame within which entitlement proceedings may be commenced, see above.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

According to the Danish Patents Act, Section 70 and the Consolidate Secret Patents Act, an application for a patent in the technical area of war materials and the manufacture of war materials must be filed first in Denmark by applicants residing in Denmark, i.e. if the invention is owned by a person residing in Denmark or an enterprise residing in Denmark or by a Danish institution (Section 2a(1) of the Danish Secret Patents Act).

The meaning of "war materials" (Section 1(2) of the Consolidate Secret Patents Act) is defined by Danish Royal decree No. 21 of 30 January 1960 to be articles in the following types of material, which is exclusively or substantially intended for use in warfare, including parts and accessories for such articles. The list of war materials include 8 points, i.a. 1) weapons and ammunition; 2) chemical weapons; 3) equipment for protection against and to combat the effects of such weapons and ammunitions in 1 and 2; 4) Parachute equipment, stretcher equipment, field materials such as bridge materials, road building materials, airfield materials; 5) material for use in command of artillery and navigation, including sights and radar material; 6) equipment for protection against observation, including camouflage equipment or equipment intended to mislead or impede warfare; 7) Equipment designed to impede or prevent movement, including obstruction materials; 8) Materials, tools and machines, which by their nature exclusively or substantially are intended for the manufacture of the materials mentioned in 1 to 7.

We note that with respect to known filing restrictions for reasons of national security the International Bureau of WIPO has compiled the following list for the PCT contracting states: http://www.wipo.int/pct/en/texts/nat_sec.html

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

no

No, the Consolidated Secret Patents Act does not appear to provide explicitly for such mechanism. Rather, it is up to the owner (residing in Denmark or Danish institution) of the invention to ensure that inventions relating to war materials defined under section 1 of the Consolidated Secret Patents Act are filed first with the Danish Patent Office in order not to be in violation of section 2a(1) of the Consolidated Secret Patents Act (see LFF1977-1978.1.120, "Til § 1, nr. 1."), and thereby avoid the risk of punishment by fines or by imprisonment of not more than 1 year unless severer punishment is provided for (section 11(1) of the Consolidated Secret Patents Act).

The assessment as to whether or not it is required for the sake of the defence of Denmark to grant an invention as a secret patent is only assessed upon filing a patent application first in Denmark (section 2 of the Consolidated Secret Patents Act), and only after filing such a patent application is it possible to request authorization from the Danish Ministry of Defence to e.g. file the patent application in a foreign state (section 3(1) of the Consolidated Secret Patents Act).

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

See above.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

Danish law does not take into account the citizenship of the inventors or the residency of the inventors. In matters relating to secret patents, the law applies based on the residency of the owner.

Accordingly, the residency of the patent owner affects this answer, as the Consolidated Secret Patents Law applies to the residency of the applicant as well as to Danish institution applicants regardless of its residing country (section 2a(1) of the Danish Secret Patents Act).

Joint owners are not explicitly covered by the Consolidated Secret Patents Act, so the following assumes that a joint owner is an owner in the sense of section 2a(1). Accordingly, a Danish institution or a company residing in Denmark, owning the rights to an invention for war material jointly with a foreign company residing outside of Denmark must according to section 2a(1) of the Danish Consolidated Secret Patents Act first file a patent application in Denmark. This may be in collision with foreign law which has corresponding provisions or uses an inventor-based filing right definition.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

yes

In relation to Danish law it would violate the law as given in the Consolidated Secret Patents Act only to the extent that: if the owner of the application has his place of residency in Denmark and; if the contents of the application would be encompassed by the Secret Patents Act; then a request by any inventor irrespective of nationality for a foreign filing license filed in another country before the application being filed in Denmark would be in violation of the Secret Patents Act.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

Failure to comply with the Secret Patents Act entails the risk of punishment by fines or by imprisonment of not more than 1 year unless severer punishment is provided for (section 11(1) of the Act). Liability and sanctions would be assessed by the courts in a trial following regular judicial procedures.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

The law applies to the technical area of war materials and the manufacture of war materials as defined in the Consolidated Secret Patents Act and the Danish Royal decree No. 21 of 30 January 1960 (see the discussion above in relation to question 6).

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

For war materials the rules would incur somewhat higher costs, as further steps and secrecy obligations apply.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Failure to comply with the Secret Patents Act entails the risk of punishment by fines or by imprisonment of not more than 1 year unless severer punishment is provided for (section 11(1) of the Consolidated Secret Patents Act). Liability and sanctions would be assessed by the courts in a trial following regular judicial procedures.

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

Inventorship is not defined.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

In Denmark the rules requiring national first filing only apply to inventions of "war materials". The Danish group agrees that national first filing rules should only apply in relation to war materials.

The Danish group further supports the self-assessment principle used in Denmark.

The Danish rules (relating to war materials) do not address a situation of multinational inventions where owners/inventors with residency/nationality in different countries including Denmark have a common right to the invention. The Danish group recommends that such rules are introduced at least on a regional basis.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

See above.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

No.

III.) **Proposals for harmonisation**

- 12) **Is harmonisation in this area desirable?**

yes

Yes, if made the right way.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

The Danish group suggests that inventorship requires an independent, intellectual contribution to/directed at the invention.

- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

The Danish group is of the opinion that correction of inventorship should be as simple as possible. Thus, it should not be a requirement to show that whichever error occurred "unintentionally" or "without deceptive intent". The Danish standard described under Question 4, according to which the deletion of an originally named inventor requires his consent, while joinder of one or more co-inventors does not require consent from the originally named inventor(s), if filed by the applicant, his successor in title or his attorney, might serve as a suitable international standard.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

The Danish group does not believe that it is in the interest of multinational companies with multinational inventions to have to file first in certain countries.

The Danish group finds that national first filing rules should only apply to inventions of war materials.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

The Danish group is of the opinion that review related to war materials is appropriate, but we would suggest a process similar to the Danish model of "self-assessment" by the applicant. This would significantly reduce the burden of secrecy reviews across the globe and enhance the possibilities of multinational scientific and technological cooperation.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

The Danish group is of the opinion that there should not be any requirement of foreign filing licenses except for inventions of war materials. The international standard for obtaining a foreign filing license should be a "self-assessment" model (see above reply to question 9).

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

The answer to the above question depends in large on whether the application has been published or not.

If the application remains unpublished at the time the filing error is discovered, a simple retroactive filing check by the relevant national patent office should suffice as remedy.

If the application is published, national laws governing liability and sanctions become effective.

Where a self-assessment system like the Danish filing system is in place, an unintentional error in the self-assessment should be curable.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

The Danish group has no additional suggestions.

Summary

Inventorship is a concept not defined under Danish law and there is limited case law on this subject. The Danish group suggests that an independent, intellectual contribution to/directed at the invention is required for inventorship.

There is only a first filing requirement for applicants residing in Denmark in relation to secret patents, i.e. patents filed in the area of war materials and the manufacture of war materials, cf. Section 70 of the Danish Patents Act. The meaning of 'war materials' and the specific rules relating thereto are set out in the Consolidated Secret Patents Act. The first filing requirement for inventions of war materials is based on a self-assessment principle.

With regard to multinational inventions, i.e. inventions made jointly by an inventor in Denmark and an inventor in another country, in all areas other than war materials, there are no first filing requirements. In matters relating to war materials, Danish law applies if the owner of the patent resides in Denmark, as defined in Section 2a (1) of the Consolidated Secret Patents Act. Joint inventorship/ownership is not addressed by the Secret Patents Act and the Act does not provide for a first filing license.

The Danish group is of the opinion that harmonization in the area of inventorship is desirable and proposes that first filing rules should only apply to inventions of war materials. Moreover, the Danish group suggests that the standard for obtaining a foreign filing license should be based on a self-assessment principle and should address situations of multinational inventions.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

The Danish group has no additional comments.

Egypt

Report Q244

in the name of the Egypt Group
by Magda HAROUN and Mona ABBAS

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The Egyptian Intellectual Property Law No. 82 of 2002 ("IP Law") does not define the "inventor". Article 6 of the IP Law states that the right to the patent shall belong to the inventor or his successor in title; and if two or more persons have jointly made an invention, the right to the patent shall belong to them jointly and equally, unless they have agreed otherwise. A person directing the efforts of an inventor without actual contribution to the invention may not qualify as an inventor. In the present case, person B would always be named an inventor and person A would only be named an inventor if he/she creatively contributed to the invention.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The IP does not provide details on how to define inventorship. It is determined by the Patent Office looking at the invention as a whole including claims, drawings and other elements of the patent application.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The IP Law does not make inventorship dependant on the citizenship of the inventor(s).

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, the IP Law does not make inventorship dependant on where the invention was made. However, according to Article 4 of the IP Law, any natural or juridical person whether Egyptian or foreigner who belong to or have business in a WTO member State

or in a State that reciprocates with Egypt may benefit from the provisions of the IP Law including the right to file patent applications with the Egyptian Patent Office. This relates to who can apply for a patent application and benefit from the IP Law.

- 4) **Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

Yes, the inventorship of a patent application can be corrected after the filing date in Egypt, by adding an inventor.

By using a legalized declaration letter from the inventors. There is no time limit for doing so.

- 5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

In case of an error in the stated inventorship on a patent application in Egypt, the Egyptian Patent Office or any concerned party may request from the Administrative Courts to add information to the patent applications that was omitted or to amend any incorrect information or to delete incorrect information. This applies to stated inventorship. In addition, under general rules, the person entitled to be named as inventor may also have a cause of action for compensation against the applicant, particularly if the error was intentional.

- 6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

no

No, the IP Law does not require than an application claiming an invention made in Egypt be filed first in Egypt.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

No, the IP Law does not require than an application claiming an invention made in Egypt undergo a secrecy review or similar process before it can be filed in another country.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

The IP Law does not define inventorship. It is suggested that the law should be amended to define inventorship and provide some guidelines in this regard.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The IP Law does not require first filing.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The IP Law does not require a secrecy review for an application claiming an invention made in Egypt before it can be filed in another country.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

Generally, the IP Law can be amended to provide definitions for inventorship and joint inventorship. This will facilitate filing of patent applications whether or not having multinational inventorship.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

An effective contribution in the work leading to the inventorship.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

A sworn declaration of the inventors stating that the omitted inventor was part of the working team and is entitled to inventorship. There should not be any timing requirements in this regards.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

We are not of the opinion that first filing should be required, particularly with the increase of multinational inventorship, and the difficulties, efforts and costs involved with complying with such requirement.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

We are not of the opinion that first filing should be required. In addition, secrecy review requirements in particular are difficult to harmonise as these relate mostly to military and defense technologies and each jurisdiction will insist on maintain its standards.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

We are not of the opinion that obtaining a foreign filing license should be required, particularly with the increase in multinational inventorship, and the difficulties, efforts and costs involved with complying with such requirement.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

In cases of multinational inventorship, if two more countries have laws requiring first filing or secrecy reviews whereby the applicant would be violating the laws of one or both of the jurisdictions, it is proposed that in these cases the laws of each jurisdiction contain an exception from the requirements provided that the application is first filed or subject-

ed to secrecy review in the other jurisdiction(s) having the same requirement. Although we note that this proposition is not likely to be accepted by many jurisdictions, particularly the secrecy review requirement.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

N/A

Summary

Summary

The Egyptian Intellectual Property Law No. 82 of 2002 ("IP Law") does not define the "inventor", "joint inventors" or "multiple inventorship". The Egyptian Patent Office currently looks at the invention as a whole. We are of the opinion that the IP Law should be amended to include definitions for these terms. The IP also does not make inventorship dependant on the citizenship of the inventor(s) or where the invention was made.

Inventorship of a patent application can be corrected after the filing date in Egypt through a legalized declaration from the inventors and there is no time limit to do so. Errors in inventorship can be corrected by an application with the competent courts. Intentional errors may subject the application to compensation.

The IP Law does not have first filing or secrecy review requirements as defined in the Working Guidelines.

Generally, the IP Law can be amended to provide definitions for inventorship and joint inventorship. This will facilitate filing of patent applications whether or not having multinational inventorship.

As international joint inventorship is becoming a common place, harmonization in this area is desired. Harmonisation should cover the definition of inventorship and multinational inventorship, standards for correcting errors in inventorship, regulation of first filing and secrecy review requirements to avoid violations of one jurisdiction's laws to comply with another's.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

N/A

Estonia

Report Q244

in the name of the Estonia Group
by Raul KARTUS and Prof. Ants KUKRUS

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Estonian Patents Act § 13 Author of invention:

(1) The author of an invention (hereinafter author) is a natural person who has created an invention as a result of his or her inventing activities.

(2) If an invention is created as a result of the joint inventing activities of several natural persons, such persons are joint authors.

(3) In the case of joint inventorship, all rights arising from the inventorship are exercised by the authors jointly, including the right to apply for a patent and to become the proprietor of the patent, unless they have entered into a written agreement which prescribes otherwise.

Location of the person does not play any role in the identification of inventorship.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The law defines that joint inventorship is determined by the joint inventing activities. The Estonian law defining inventorship does not look to any particular part of the patent application.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Inventorship in a patent application can be corrected at any time after the filing date of a patent application upon the request of the applicant or patent owner.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

In accordance with the Estonian Patents Act any dispute concerning inventorship shall be resolved in court after the publication of a patent application. Any natural person who finds that he or she is the inventor may file an action with a court against the applicant or, after the grant of a patent, against the patent owner for recognition of his or her inventorship. Inventorship may also be contested by a successor of such person. If inventorship is recognised, the person may contest the applicant or patent owner in the course of the same case. If the action is satisfied in the case of a patent application, the person has the right to continue applying for the patent in his or her own name, revoke the patent application and file a new patent application with the same filing date, or revoke the patent application. In the case of a patent, the person has the right to register the patent unamended or subject to amendments in his or her own name, or revoke the patent.

In accordance with the Estonian Penal Code disclosure of an invention of another person in his or her own name is punishable by a pecuniary punishment or up to three years imprisonment. The same act, if committed by a legal person, is punishable by a pecuniary punishment.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

Except invention under the agreement between certain states for the mutual safeguarding of secrecy of inventions relating to defence and for which applications for patents have been made.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

In case of dispute between persons inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named inventors.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

It could be stipulated that where the law requires first filing of patent applications directed to inventions made in particular country, the law of this particular country would apply also to inventorship.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The same requirement as in the previous point (9).

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

In case of applications without requiring first filing of patent applications in certain country or requiring a secrecy review, the law of the country of domicile of the inventor applies with respect to the inventorship.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

The inventor is a natural person who has created an invention as a result of his or her inventing activities. If an invention is created as a result of the joint inventing activities of several natural persons, such persons are co-inventors.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

Inventorship can be corrected by the applicant in case of unintentional error at any time during pendency of the application. Intentional errors can be corrected by court decision at any time during the entire life of patent and thereafter.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

There is no need for a standard.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

In case of such inventions secrecy regulations of the particular country apply to all the inventors.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

There is no need for a standard.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

There is no need for a standard.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Summary

Inventor is a natural person who has created an invention as a result of his or her inventing activities. If an invention is created as a result of the joint inventing activities of several natural persons, such persons are co-inventors. Location of the person does not play any role in the identification of inventorship. Inventorship in a patent application can be corrected at any time after the filing date of a patent application upon the request of the applicant or patent owner. It should be punishable by a pecuniary punishment or imprisonment if the error in the stated inventorship on a patent application was made intentionally. In case of dispute between persons inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named inventors. Where the law requires first

filing of patent applications directed to inventions made in particular country or it requires a secrecy review, the law of this particular country would also apply to inventorship. There is no need for a standard for first filing requirements, for obtaining a foreign filing license and a security review requirements.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Finland

Report Q244

in the name of the Finland Group
by Kim FINNILÄ, Tord LANGENSKIÖLD, Anne-Mari LUMMEVUO, Pamela LÖNNQVIST, Ben
RAPINOJA, Virpi TOGNETTY and Marja TOMMILA

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

In Finland there is no specific law defining inventorship. The Finnish Patents Act (PA) and Patents Decree (PD) regulate the identification of the inventor in an application/patent. The Act on the Right in Employee Inventions (EIA) also gives some guidance.

- The PA, Section 1, stipulates as follows: *"Anyone who has, in any field of technology, made an invention which is susceptible of industrial application, or his or her successor in title, is entitled, on application, to a patent and thereby to the exclusive right to exploit the invention commercially, in accordance with this Act."*
- The EIA, Section 1, stipulates as follows: *"The provisions of this Act apply to inventions patentable in Finland and made by a person employed by another, that is, by an employee."*

However, in legal literature and in case law it has been recognized that an inventor is someone who has made the invention or contributed to the invention.

The Act on Inventions of Importance to the Defence of the Country defines expropriation, filing applications and subsequent acts on such inventions.

The Act on the Right in Employee Inventions and the Act on the Right in University Inventions define the right to inventions and the relationship between a Finnish entity and an inventor.

- [Patents Act](#) (PA - 15.12.1967/550) Section 7a, [Patents Decree](#) (PD - 26.9.1980/669), Section 2, 31, 36a; identification of the name and address of inventor, employer's address sufficient.
- [Act on Inventions of Importance to the Defence of the Country](#) (DIA - 15.12.1967/551); Section 1, expropriation of such inventions against reasonable compensation; Section 2, limits on right to foreign applications for inventor living in Finland.
- [Act on the Right in Employee Inventions](#) (EIA - 29.12.1967/656); limited to employee of entity in Finland and inventions patentable in Finland; regulates relationship between employer and employee inventor and right in the invention.
- [Decree on the Right to Employees' Inventions](#) (EID – 10.6.1988/527); mainly regulates the basis for reasonable compensation as given in the corresponding act.
- [Act on the Right in University Inventions](#) (UIA - 19.5.2006/369); limited to persons in service of Finnish universities and inventions patentable in Finland; regulates relationship between university and person in service of university and right in the invention.

In Finland there is also an act and related regulations on Utility Models (product protection for inventions under an inventive step definition lower than that of the PA). According to case-law, legal doctrine and legal literature the regulatory framework for patentable inventions is also applied to inventions falling under the [Act on Utility Model Rights](#) (10.5.1991/800) and [Decree on Utility Model Rights](#) (5.12.1991/1419).

- The only requirement would be to name person A and/or B as an inventor in the patent application, the underlying presumption being that they would have contributed to the invention. The right to the invention and the relationship of the inventor and the applicant would be defined by the EIA or the UIA. The latter acts have both a substantive (patentability in Finland) and a territorial (Finland) restriction.

b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

- Adding an inventor to the application requires written consent by the inventor(s) already identified in the application. Further, the applicant has to give a statement on the basis of the applicant's right to the invention vis-à-vis the new inventor.
- Removing an inventor from the application requires written consent by the inventor in question.
- The corrections can be made as long as the application is pending.
- In case a patent has been granted to a person other than the person entitled to it, proceedings before the Market Court may only be instituted by the person claiming entitlement to the patent. Such proceedings shall be brought within one year after the entitled person gained knowledge of the grant of the patent and of any other circumstances on which the proceedings are founded. Proceedings may not be instituted more than three years after the grant of the patent where the proprietor of the patent acted in good faith at the time the patent was granted or assigned to him [PA, Section 52(5)].
- Where a patent has been granted to a person other than the person entitled to the patent under Section 1 and where proceedings are instituted by that entitled party, the court shall transfer the patent to that party [PA, Section 53(1)]. Section 52(5) applies vis-à-vis the time limits.

Such proceedings may also be brought before the court during the application phase. This is based on legal literature as well as PD Section, 26a stipulating an obligation on the Finnish Patent Office to inform the applicant of any briefs received that may have an effect on the handling of the application.

- The matter would have to be decided before the Market Court. The handling of the patent application before the Finnish Patent Office would be suspended until the entitlement has been resolved.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

- Question 1: Finnish legislation is based on an assumption of validity of the identification of the inventor.
- Question 2: No.
- Question 3: An intentional or unintentional error in the identification of an inventor would not influence the patent right as such. A patent may not be declared invalid on the grounds that the patentee was entitled to a specified part of it only [PA Section 52(3)].

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

- Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- Does this law depend on the area of technology that is disclosed and claimed in the patent application?
 - Yes, in the event it relates to the DIA, kindly see below and question 1 above.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- According to the DIA, Section 1, an invention that has an importance for the defence of the country and the secrecy of which is importance for the defence, can be expropriated by the government after an application for the invention has been filed. An expropriated invention is subject to reasonable compensation by the state.
 - Consequently, there is an assumption of some control of filed applications, although this is not codified in any way:
 - If it is obvious that the invention mainly has importance for the defence of the country, neither an inventor residing in Finland nor his right holder has the right to file or to give the right to file an application in a foreign country before an application has been filed in Finland and before 6 months have passed since the application was filed in Finland [DIA, Section 2(1)].
 - If it is obvious that the invention mainly has importance for the defence of the country, an inventor residing in Finland or his right holder has to file a European patent application or an international (PCT) patent application with the Finnish Patent and Registration Office [DIA, Section 2(2)].
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?
- DIA Section 7, stipulates a secrecy obligation with regard to such defence inventions. DIA Section 8 stipulates criminal sanctions with regard to breaking the secrecy obligation following Sections 2 and 7 of the DIA.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**
- Inventorship is not defined by any statute as noted above under the answers to questions 1-5. Consequently, no clear guidance is available in law as such.
 - The present situation gives sufficient flexibility. Case-law and company practice provide instructions that can be considered case by case. The Finnish Group thus considers that the present system does not result in any noteworthy issues.
- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**
- No. Cf. Question 7 above and questions 10 and 16 below.
- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**
- With regard to Finland the question would relate to inventions important for the defence of the country, whereby the relevant act refers to inventions made *by, or contributed to by* a resident in Finland (DIA, Section 2). National sovereignty should thus be sufficiently regulated in this respect.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

- No. The Act on the Right in Employee Inventions (EIA) has been in force since 1967 without any greater amendments. This should confirm its adaptability to the development with regard inventive activity also in a more globalized economy as of today.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

- An inventor is a natural person who has made or contributed to the invention, as given in a patent application, either alone or together with other co-inventors respectively.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

- Correction of inventorship should be based on a notification to the relevant patent authority during the pendency of the patent application or after grant of the patent, provided that all the parties involved have agreed to the correction of inventorship.
- In case of any dispute regarding inventorship, either during the patent application phase or after a patent has been granted, there should be a fast-track dispute resolution mechanism.
- Losing a granted patent right should not be the consequence of an error in the identification of an inventor, independent of whether the error is intentional or unintentional.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

- [In the modern globalized economy], any first filing requirements should be viewed as excessively restrictive and undesirable, excluding inventions relating to national security. Any such territorial requirements could even be considered to have a negative and hindering effect upon inventive activity and inventor recognition caused by complexities with regard to the conception of inventions in multinational entities.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

- A secrecy review should be restricted to inventions concerning national security.
- The secrecy review procedure should be available before a possible first filing or in connection with a first filing, and should be conducted within a given and reasonably short time.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

- The process for obtaining a foreign filing license or a certificate of a related secrecy review should be restricted to inventions concerning national security and should be streamlined and fast.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

- Such a standard should be related only to inventions related to national security.
- In such cases, and when a failure is inadvertent and noticed during the patent application phase, it should be possible to petition before the relevant patent authority to rectify a right to file and to continue the prosecution in that country.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

- An error, whether intentional or unintentional, in the identification of an inventor should not influence the patent right as such. It should not be possible to invalidate a patent based on such an error.

Summary

Finnish legislation does not provide a specific law on inventorship. The Patents Act and the Act on the Right in Employee inventions provide stipulations and rights concerning anyone who has made an invention, the latter act relating to an employed person [in Finland].

Correcting an identification of inventorship can be made in an administrative procedure before the Finnish Patent Office, requiring the consent of the inventor(s) in question. In case of a dispute of entitlement proceedings may be instituted before the Market Court. Any such disputes do not render the patent invalid.

The Finnish Group proposes the following standard definition for inventorship: *“An inventor is a natural person who has made or contributed to the invention, as given in a patent application, either alone or together with other co-inventors respectively.”*

Further, the Finnish Group proposes the following standard relating to multinational inventions: *“An error, whether intentional or unintentional, in the identification of an inventor should not influence the patent right as such. It should not be possible to invalidate a patent based on such an error.”*

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

France

Report Q244

in the name of the France Group

by Christian NGUYEN-VAN-YEN, Corinne VEDEL, Sabine AGE, Olivier BLANCHEREAU, Thomas BOUVET, Didier BOULINGUIEZ, Agathe CAILLÉ, Pauline DEBRÉ, Raphaëlle DEQUIRE-PORTIER, Blandine FINAS TRONEL, Pierre GENDRAUD, Francis HAGEL, Patricia HEC, Jonathan HINKSON, Florence JACQUAND, Louis JESTAZ, François LEGRAND, Catherine MATEU, Marta MENDES MOREIRA, Jean-Baptiste MILIEN, Catherine MOUGET GONIOT, Marc NEVANT, Beatrice ORES, Henri POUBLAN, Enrico PRIORI, Stanislas ROUX VAILLARD, Thierry SUEUR, Jérôme TASSI, Gaston VEDEL, Romain VIRET and Marie WORSMSER

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

In French law, there is no legal definition of the inventor.

While the French Intellectual Property Code (CPI) makes reference to “*l’inventeur*” (the inventor) on a number of occasions when dealing with rights to the patent (Articles L. 611-6 and L. 611-7) or the designation of the inventor on the patent specification (L. 611-9 and R. 612-10), it provides no further detail about the criteria by which the concept of inventor is defined.

According to an old and settled doctrine, inventorship is assessed by reference to the means which constitute the invention.

According to Paul Mathély [translated from the original French]:

“Whoever conceives and makes the invention has the status of inventor. The invention consists in means capable of achieving a result.

Consequently, the inventor is the person who discovers the means. It follows that posing a problem or indicating an objective to be achieved is not inventing, because this is not giving the solution.

Accordingly, it has been adjudged that the following do not have the status of inventor:

- a person who expresses the desire for a result that is to be obtained, while leaving to others the task of finding the means capable of achieving it;*
- the industrialist who, commissioning the creation of a machine, imposes a series of requirements and obligations: specifically, he or she has thus set out the requirements to be met, but has not made an invention.”*

An analysis of the case law, in particular in the area of employee inventions or patent entitlement proceedings, shows that, in various different formulations, this case law is consistent with the above-mentioned legal writing and applies the following criteria:

- it is generally accepted that the designation of a person as an inventor creates a presumption in his or her favour, though this is capable of being rebutted;
- it is regularly noted that the creator must establish that he or she played an active role at the stages of the formalisation, technical development and finalisation of the invention;

- it is stated that a person who claims to be the creator of the invention must establish that he or she contributed to “the inventive step” of the products or devices patented, that is to say that he or she played an essential role in the analysis of the problem to be solved and in the technical solution to be applied to it;
- conversely, it is considered that the following are not sufficient to allow the status of inventor to be claimed:
 - the management and coordination of research works, or even the establishing of the results to be achieved;
- the carrying out of simple tasks of implementation.

- **If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?**

- To determine whether A and/or B can be considered to be inventors under French law, it is first necessary to establish the applicable law for determining whether one or more inventors are legitimately designated by a patent application or a patent. French law does not lay down the applicable law for determining inventorship. In the absence of a precise answer in French law as regards the law applicable to the determination of inventorship, the French Group suggests a criterion of a relevant connection in its proposals for reform of the national law and for harmonisation.

In view of the foregoing, it is necessary to determine whether a person A, who is located outside of France and who directs the research efforts of a person B who is located in France, could be designated as an inventor, with it being understood that the invention was made in France.

If French law is applicable to person A, he or she will be considered to be an inventor if he or she had an active role and did not merely direct and coordinate research works.

Person B will be an inventor under French law if he or she made personal efforts which in particular demonstrated an inventive step, but did not merely execute instructions.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The question here is whether, in order to assess inventorship, it is necessary to refer to all of the patent specification or just to the claims, or alternatively whether the role of the inventor should be determined on a claim by claim basis.

In the decisions, reference is made to the claims of the patent filed, to the “*inventive concepts described in the patent*”, or alternatively to the drawings of the patent when diagrams or drawings are also submitted for assessment by the judges ruling on the merits.

In other decisions, reference is additionally made to the claims in particular.

In a decision of the *Tribunal de grande instance* (Regional Court) of Paris of 29 March 2012, the judges ruling on the merits attempted, unusually, to undertake an apportionment of the inventive contribution on a claim by claim basis.

However, in the decisions referred to above, the question of whether, in order to assess inventorship, reference should be made to the entirety of the patent specification or just to the claims, is not specifically posed.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

In French law, there are no legislative or regulatory provisions which define the concept of inventor or which set out the conditions that need to be met in order to claim this status, let alone any indication which would suggest that the nationality of the inventor should be taken into account.

Thus, according to current law and practice, nationality is not *a priori* an element taken into account in determining the right to be considered an inventor.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

French law regulates only the question of the rights to the patent, and not the question of the definition of the inventor.

However, certain rules relating to the right to the patent could provide indications as to the law applicable to the determination of the inventors.

Drawing on Article 60 of the European Patent Convention in relation to the right to the patent, and where an international aspect exists, it may be considered that inventorship should be determined in accordance with the same criteria:

- The law of the State in which the employee exercises his principal activity, thus ultimately the place where the invention was made;
- In the alternative, the law of the State in which the employer has the place of business to which the employee is attached.

However, in the context of multinational inventions involving a number of inventors living or making the invention in different places and who are not within a contractual framework, it is difficult to determine which criterion of connection should be adopted in order to trigger the application of "French law" to the determination of inventorship.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

It is possible to correct the designation of inventorship subsequent to the filing date of a patent application in France in accordance with the legal framework, procedures and time limits; these depend on the type of patent application filed in France and on the nature of the corrections to be made.

1. French (national) or European patent applications

French or European patent applications must include a request for grant, which specifies the family names, given names and full addresses of the inventors (Articles R. 612-3 and R. 612-10 CPI; Article 81 EPC and R. 19(1) EPC). With regard to European patents, if the applicant is not the inventor or is not the sole inventor, this designation must contain a statement indicating the origin of the right to the European patent (Article 81 EPC).

In the absence of any designation of the inventor, the applicant will be sent an invitation to regularise the designation of inventors within a period of sixteen (16) months from the filing of the patent application or, if priority is claimed, from the earliest date of priority from which the patent application benefits (Article R. 612-11 CPI and R. 60(1) EPC).

The French National Institute of Industrial Property (INPI) and the EPO do not verify the accuracy of the designation of the inventor in requests for grant (Article R. 611-15 CPI and R. 19(2) EPC).

If a designation of inventors has been undertaken within the prescribed deadlines, it is still possible to correct it without delay, including after the patent has been granted, by filing a request at the competent Office, mentioning the family names, given names and addresses of the inventors that are to be removed and/or added (Articles R. 611-17 and R. 612-10 CPI; R. 21(1) EPC).

If the request seeks to remove the designation of an inventor, proof of the latter's consent must be provided with the request for the rectification of the designation of inventors (Article R. 611-17 CPI and R. 21(1) EPC). On the other hand, if the request seeks to designate an inventor not mentioned in the request for grant, it does not need to include proof of the latter's consent.

In any event, if the request is presented by a person other than the applicant for or owner of the patent, the consent of one or other of these is required (Article R. 611-17 CPI and R. 21(1) EPC).

1. *PCT application*

The PCT application must include a request specifying the names and addresses of the inventors and the other prescribed data concerning the inventors where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application (Article 4(1)(v), R. 4.1(a)(iv) and R. 4.6(a) PCT).

However, the EPO, acting as a receiving Office, does not require this information to be provided at the stage of the filing of an application (R. 4.1(c)(i) PCT), but it may be provided so as to anticipate the requirements of other national or regional laws (R. 4.17(i) PCT).

Pursuant to Article 4(4) PCT, failure to indicate in the request the name and other prescribed data concerning the inventor shall have no consequence in France in so far as French national law allows the information relating to the designation of inventors to be regularised after the filing of the patent application.

During the international phase, upon a request presented by the applicant or the receiving Office, the International Bureau shall record changes relating to the designation of inventors within a period of thirty (30) months from the priority date (R. 92*bis* PCT).

Moreover, the applicant may correct the designation of inventors by a notice submitted to the International Bureau of WIPO within a time limit of sixteen (16) months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed (R. 26*ter*(1) PCT). However, in practice, given that the applicant will have available to it the time limit of thirty (30) months provided by Rule 92*bis*, the time limit of sixteen (16) months provided by Rule 26*ter*(1) will not apply.

Following entry into the regional phase (with only entry into the European phase being possible in France), where the designation of the inventor has not yet been made within a period of thirty-one (31) months from the filing of the priority application, the EPO shall invite the applicant to regularise the designation of inventors within a period of two (2) months (R. 163(1) EPC).

After entry into the European phase, the rules applicable to the correction of the designation of inventors for a European application are then applicable.

5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

The possible consequences of an error in the designation of inventor or of the absence of a designation depend on the type of patent application filed in France.

1. *French (national) or European patent applications*

If the absence of the designation of the inventor is not regularised in accordance with the procedures and within the time limits mentioned above (cf. answer to question 4), the patent application will be refused (Article R. 612-45 CPI and R. 60 EPC).

With regard to French patent applications, the applicant cannot be refused the grant of a patent on the basis of an error in the designation of the inventor.

Nor can the applicant's title be cancelled, since errors in the designation of the inventor of any nature whatsoever – whether intentional or unintentional – are not included among the grounds for revocation of patents which are listed exhaustively in Article L. 613-25 of the French Intellectual Property Code. The exhaustive nature of the list of grounds for revocation of patents is an established principle of case law.

The case law has confirmed that the incorrect indication of the inventor is not a ground for the revocation of a patent.

On the other hand, an inventor who should have been designated in this capacity in the patent may seek to hold the patent owner responsible for the error civilly liable on the basis of Article 1382 of the French Civil Code. On that basis, damages have been awarded in particular to compensate the inventor for his or her lost opportunity to profit from such a statement of inventorship vis-à-vis potential employers.

The case law has also found against the owner of a patent, upholding the existence of a “*violation of the moral right*” of the inventor who should have been designated as such in the patent when that inventor's entitlement action was nevertheless rejected.

On the other hand, the question of whether the error in the designation of the inventor is of an intentional or unintentional nature is irrelevant in the assessment of the fault which can render its perpetrator civilly liable.

With regard to a European patent application, the incorrect designation of the inventor, whether it be intentional or not, cannot lead to the European patent application being refused.

Nor can it lead to the revocation of the European patent, since it is not included among the grounds of revocation listed in an exhaustive manner in Article 138 of the EPC, unless the incorrect reference also casts doubt on the patent owner's entitlement (Article 138(e) EPC).

By way of example, an employer files a patent application in respect of an invention referred to as a “*service invention*” (“*invention de mission*”) made by an employee A, wrongly designating as inventor an employee B. This error in the designation of the inventor is not of such a nature as to lead to the revocation of the patent, provided that the employer was entitled to file a patent covering this invention, of which it is the owner, pursuant to Article L. 611-7 of the French Intellectual Property Code. Article 138(e) would therefore be inapplicable in that hypothesis.

Finally, the incorrect designation of the inventor is also not included among the grounds of opposition as set out in Article 100 EPC.

1. *PCT application*

Pursuant to Article 4(4) PCT, failure to designate the inventor in the request has no consequence in France given that French national law allows the information relating to the designation of inventors to be regularised after the filing of the patent application.

On the other hand, following entry into the regional phase (with only entry into the European phase being possible in France pursuant to Article L. 614-24 CPI), where the designation of inventors has not yet been made within the period of thirty-one (31) months from the filing of the priority application, the EPO invites the applicant to regularise the designation of inventors within a period of two (2) months (R. 163(1) EPC). If the situation is not regularised, the European patent application is refused (R. 163(6) EPC).

The incorrect designation of the inventor, whether it be intentional or not, cannot lead either to the refusal of the international application by the INPI as the receiving Office, or to the revocation of the patent deriving from that application, since this is not mentioned among the grounds of revocation listed exhaustively in Article 138 EPC.

6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

Preliminary Comments

In French law, non-sensitive inventions, i.e. those whose communication or exploitation are not capable of being prejudicial to the interests of defence or national security, and which are not detrimental to the fundamental interests of the nation, may be the subject of first filings outside of France, except, in the case of a European application or a PCT application, when the applicant has its registered office or domicile in France and is not claiming the priority of a French application, irrespective of the area of technology concerned (Articles L. 614-2 and L. 614-18 of the French Intellectual Property Code).

The two articles L. 614-2 and L. 614-18 of the French Intellectual Property Code are both likewise intended to be applied in the case of joint applicants, provided that one of them meets the conditions imposed.

There is no similar provision for a first filing outside of France.

Specifically, the IP legislative texts do not provide any rules in this regard.

Accordingly, an invention cannot be required to have its first filing in France simply on account of the fact that it incorporates the contributions of a French inventor residing in a foreign country or having his or her domicile in France or working for a company which has its registered office or other offices in France (French subsidiary of a foreign group).

On the other hand, if the slightest doubt exists, it is for the applicant or its representative to ask the *Bureau de la Propriété intellectuelle* (French Intellectual Property Bureau; hereafter "BPI"), an agency of the French Ministry of Defence that is responsible for protecting the secrecy of inventions relevant to national defence, to release it from any potential criminal liability, as is specified by inter-ministerial instruction No. 9062/DN/CAB of 13 February 1973 relating to inventions relevant to national defence.

Essentially, the legal basis of the restrictions on the free disclosure or exploitation of inventions can be found in the French Criminal Code (Articles 410-1, 411-6, 413-9 to 413-12), the French Intellectual Property Code (for French applications: Articles L. 612-8 to L. 612-10; for European applications: Articles L. 614-2 to L. 614-5, for international applications: Articles L. 614-18 to L. 614-20; for penalties: Articles L. 615-13, L. 615-15 and L. 615-16), inter-ministerial instruction No. 9062/DN/CAB of 13 February 1973 and general inter-ministerial instruction on the protection of national defence secrecy No. 1300/SGDN/PSE/SSD of 30 November 2011.

All acts to the detriment of the fundamental interests of the nation, as defined in Articles 410-1, 411-6, 413-9 to 413-12 of the French Criminal Code, are subject to be heavily sanctioned.

Accordingly, for an inventor simply to forward to a foreign country, for a foreign company, the results of study or research activities carried out in France, in such a way as to cause detriment to the fundamental interests of the nation, would expose him or her to the sanctions laid down by the French Criminal Code.

In the case of a patent application which is relevant to defence or, more generally, is to the detriment of the fundamental interests of the nation, and which ought to have remained secret, the applicant and its representative who carry out a first filing in a foreign country or in an international office will likewise fall within the scope of these prohibitions.

Apart from these cases where there is detriment to the defence or the fundamental interests of the nation, a first filing application in a foreign country may be perfectly justified, for example, in the case of a foreign group's research subsidiary which is established in France.

Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

The requirement of a first filing in France is not directly linked to the area of technology concerned. It applies to all inventions made in France in the case of European and PCT applications, as long as the applicant has its registered office or domicile in France and is not claiming the priority of a previous filing in France.

However, there exists a list of technologies that are linked with the interests of defence or national security, as mentioned in point 4 of the version of 4 April 2014 of the *"Guide des usages des acteurs de la propriété intellectuelle en matière de sécurité et de défense"* (*"Practice guide for those working in intellectual property in matters of security and defence"*), published by the *Direction Générale de l'Armement* (French Defence Procurement Agency) (April 2014 version).

In the case of work carried out on a cross-border basis by employees of several nationalities, the technical arrangement of 2009, taken in the context of the Lol (*"Letter of Intent"* signed on 6 July 1998 by the ministers of defence of the six main European armaments producers: Germany, Spain, France, Great Britain, Italy and Sweden), regarding the place of first filing provides that, even if the applicant is French or resides in France, if the invention is made by virtue of financing which originates at least in part from one of the other five countries of the Lol, the first filing may take place in that country. The same applies if the invention was made at least in part on the territory of one of those countries. In such a case, the BPI adjudicates and may, where appropriate, lay down the procedures by which the invention is communicated and the filing procedures in the country designated.

The provisions made in the context of the Lol are essentially aimed at patent applications emanating from *"international defence companies"*, but it also appears that they can apply generally to any works undertaken under these circumstances, including those of a civil nature and irrespective of the source of the financing – be it public or private.

In the case of doubt, it is recommended to ask the DGA for a foreign first filing licence. It is likewise possible to undertake simultaneous filings in the countries in question, alerting the defence authorities of each country.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

In French law, there are no legislative or regulatory provisions relating to *"foreign filing licences"* or to any similar mechanism.

However, there does exist an administrative practice put in place by the *Bureau de la Propriété Intellectuelle* (*"BPI"*), under the auspices of the *Direction Générale de l'Armement* (*"DGA"*) in relation to inventions *"capable of being relevant to national defence"* and/or *"inventions that are sensitive or are presumed to be sensitive"*. This practice is set out in a *"Guide des usages des acteurs de la propriété intellectuelle en matière de sécurité défense"* (*"Practice guide for those working in intellectual property in matters of security and defence"*). This guide is published by the DGA and its most recent version dates from 4 April 2014.

An applicant whose domicile or registered office is located in France cannot file outside of France a European patent application or PCT application not based on an earlier French priority. On the other hand, it can decide to file a national patent application outside of France.

However, the applicant then runs the risk of acting to the detriment of national defence or national security and of incurring criminal and/or civil liability pursuant to the provisions of the legislation mentioned in the answer to question 6a), by carrying out unauthorised disclosures of information/inventions that are capable of being relevant to national defence and/or are sensitive or presumed to be sensitive.

The filing outside of France of patent applications relating to inventions that are capable of being relevant to national defence and/or are sensitive or presumed to be sensitive must be submitted to the BPI, either to obtain its prior consent or in order to allow it to verify that the invention was made in circumstances where the applicant is French or has its domicile or its registered office in France and where the invention was financed by a country of the "Letter of Intent" or was made at least in part on the territory of one of the countries concerned, in order to permit a first filing in that country.

In practice, the owner of the rights to the invention (or its representative) sends to the BPI (by fax or registered letter) the following information: name and address of the owner of the rights to the invention, name and nationality of the inventors and, optionally, their address and the description of the invention. This description must be complete, but it does not have to follow any particular formalities and, in particular, does not necessarily have to take the form of a patent application with an abstract and claims. It may also be submitted in English (tolerated) and not necessarily in French. In general, the licence is received by fax within 8-10 days.

There is no fee to be paid for requesting and/or obtaining the advance consent of the BPI or for allowing it to verify that the inventions concerned are eligible for a filing in a country of the "Letter of Intent".

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

yes

Notwithstanding the lack of specific legal provisions relating to such retroactive licences or authorisations, practical experience tells us that:

- In the event that the invention is not a "sensitive" invention, if the first filing was made in a foreign country without an advance consent and such a consent was necessary, the patent application and the patent resulting from it can continue to exist and licences can be granted. For these same inventions it is likewise possible, with retroactive effect and for the sake of prudence, to request a licence from the Minister responsible for Industrial Property after the first filing in a foreign country has been undertaken.
- On the other hand, in the event that the invention is "sensitive" and that the requirement for filing in France has not been complied with, the situation is very different because there can be no retroactive effect establishing secrecy, given that the application has already been filed at another Office.
- in that case, and if the BPI of the DGA is aware of the invention prior to its disclosure, the DGA generally requires the application to be withdrawn and a further application to be filed in France. This is the case even if the patent application was filed in a country that is a signatory to the Lol. When only part of the content of a patent application is sensitive, the DGA can request that only certain elements of the patent application be withdrawn.
- in the event that the invention should have been kept secret and has been published, the applicant and the inventors will be subject to criminal proceedings. In addition, it would appear that in specific cases the BPI is asked for retroactive licences, to which it responds. However, the BPI advises against this approach and asks owners of rights to request licences before the act in question (publication, filing outside of France, etc.) becomes effective.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

French law does not expressly deal with the case where an invention has been made jointly by an inventor in France and an inventor in another country. Accordingly, the provisions of the French Criminal Code apply to an inventor who is working in France (or is French). The only exception is that if the invention was made in a country that is a party to the agreement known as the "Letter of Intent"(LoI) – namely Germany, Spain, Italy, the United Kingdom and Sweden, in addition to France – or was financed by such a country, a patent application may be filed in that country even if it incorporates the contributions of a French inventor.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

yes

The fact of filing a request for a foreign filing licence in another country involves a disclosure of the invention to the authorities in that country, and may thus fall within the scope of Article 411-6 of the French Criminal Code if that disclosure is detrimental to the fundamental interests of the nation.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

If a first filing (or a request for a licence) in another country is effectively detrimental to the fundamental interests of the nation, the sanctions can be very severe – i.e. up to 15 years' imprisonment. As acting to the detriment of the fundamental interests of the nation is a crime, this can only arise if the act is committed intentionally.

The act of filing, outside of France, a European patent application or a PCT application of which the applicant (or a joint applicant) is domiciled in France creates exposure to less severe sanctions – a fine of €6000 in all cases and a custodial sentence of up to 5 years if it is detrimental to the interests of national defence (but not to the fundamental interests of the nation, otherwise Art. 410-1 of the French Criminal Code applies). The sanction is incurred only if the violation is intentional.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Preliminary comment

French law requires that a patent application (FR, EP or PCT) filed at the INPI be the subject of an authorisation prior to any disclosure or exploitation (L. 612-9), irrespective of the place where the invention is made. France therefore appears to have adopted the criterion of the place of filing of the patent, and not that of the place where the invention was made.

The applicant has an obligation to keep its invention secret for a period which varies depending on the type of filing (see Table 1 in point b) below). During this period, the patent applications may not be made public and no true copy of the patent application may be issued.

If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?

The obligation to obtain an authorisation prior to any disclosure or exploitation applies to any type of invention and does not depend on the area of technology in question.

Moreover, companies authorised by the State to manufacture or trade in military items are obliged, within the period of 8 days after the filing of any patent application involving certain items, to forward to the department responsible the description of the invention that is the subject of the patent (Art. L. 2332-6 of the French Defence Code).

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

According to Articles L. 612-9 and L. 612-10 of the French Intellectual Property Code, the INPI forwards any patent application to the department responsible within 15 days after the filing. When the authorisation is issued, it is notified to the applicant by the minister responsible for industrial property.

The disclosure authorisation is issued by the minister responsible for industrial property, on the advice of the ministry responsible for defence. It becomes effective at the end of a variable period (see Table No. 1 below).

Table No. 1

Type of application	First filing	Subsequent filing under the priority of a first filing in France or in a foreign country
French patent application	5 months from the filing date (L. 612-9, para. 3 CPI)	
European patent application	4 months from the filing date (L. 614-4, para. 4 CPI)	14 months from the priority date (L. 614-4, para. 4 CPI)
International application (L.614-22 CPI)	5 months from the filing date (L. 614-20, para. 4 CPI)	13 months from the priority date (L. 614-20, para. 4 CPI)

In the absence of such an authorisation, or at any time, a request for specific authorisation for the purposes of carrying out specific acts of exploitation may be sent directly by the applicant to the minister responsible for national defence. If he or she grants the requested authorisation, the conditions to which these acts of exploitation are subject are specified. In the absence of any response within two months from the request for authorisation, the request is rejected (Decree No. 2014-1285).

The ministry of defence controls the filings forwarded by INPI. In a very limited number of cases (20 to 40 per year), it extends the prohibition of disclosure or exploitation by an order, at the latest fifteen days before the end of the period defined in Table No. 1. The extension is made upon the request of the ministry responsible for defence, for a renewable period of one year. It is possible to lodge an appeal before the administrative courts. This extended prohibition may be lifted at any time, subject to the same condition.

The extension of the prohibition ordered then gives a right to compensation for the owner of the patent application, to the extent of the loss suffered.

The prohibitions may be revoked at any time, on the initiative of the ministry of defence, either by the non-renewal of an annual order or by the taking a specific order revoking the prohibitions.

See Art. L. 612-10, R. 612-28 and R.613-42 of the French Intellectual Property Code.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Failure to comply with the temporary period of secrecy is punished by provisions included in the French Intellectual Property Code and the French Criminal Code, which may be applied cumulatively.

1. Penalties laid down in the French Intellectual Property Code

The sanctions are summarised in Table No. 2.

Table No. 2:

Article of the CPI	Object of the filing of the application	Fine	In the event of prejudice to national defence
L. 615-13	French application	€4500	5 years' imprisonment
L. 615-15	International application	€6000	
L. 615-16	European patent application	€6000	

These penalties are "without prejudice [...] to the more severe penalties laid down in relation to acts detrimental to the security of the State". This term refers to the provisions of the French Criminal Code, which now talks of "detriment to the fundamental interests of the nation".

2. Penalties laid down in the French Criminal Code

Two cases should be distinguished:

- the patent application has not yet been the subject of a prohibiting order and is within the temporary prohibition period (see Table No. 1 above).
- the application has been the subject of a prohibiting order: the prohibiting order has the effect of giving the patent application the status of "national defence secret" within the meaning of Article 413-9 of the French Criminal Code. The sanctions are summarised in Table No. 3 below.

Given that the applicant is informed of the temporary secrecy obligation by INPI, it should therefore be considered that an applicant who breaches this secrecy obligation does so intentionally. In any case, the sanctions are more severe when the non-compliance occurs after the applicant has been sent a prohibiting order.

Finally, the disclosure of a national defence secret often has the effect of causing detriment to the fundamental interests of the nation, which is punished by Articles 411-6 et seq. of the French Criminal Code.

Table No. 3:

French Criminal Code	Offence punished	Penalties
Article 413-10 para. 1	It shall be a punishable offence for any person holding such information because of his position or occupation or any permanent or temporary function or mission, in relation to any process, article, document, information, computer network or computerised data or file which is in the nature of a national defence secret, either to destroy, misappropriate, remove or reproduce it, or to give access to it to an unauthorised person or to bring it to the knowledge of the public or of an unauthorised person.	7 years' imprisonment and fine of €100,000 If the applicant has acted recklessly or negligently, punishment reduced to

Article 413-10 para. 2	It shall be a punishable offence for the person holding such information to have permitted access to, to destroy, to misappropriate, to remove, to reproduce or to disclose the process, article, document, information, computer network or computerised data or file referred to in the preceding paragraph.	3 years' imprisonment and fine of €45,000
Article 413-11	It shall be a punishable offence for any person not referred to in Article 413-10 : 1. to acquire possession, access or obtain knowledge of any process, article, document, information, computer network or computerised data or file which is in the nature of a national defence secret; 2. to destroy, remove or reproduce in any manner whatsoever any such process, article, document, information, computer network or computerised data or file; 3. to bring to the knowledge of the public or of an unauthorised person any such process, article, document, information, computer network or computerised data or file.	5 years' imprisonment and fine of €75,000

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

As discussed in response to question 1, in French law there is no legislative or regulatory provision which defines the concept of inventor. Case law has developed criteria defining this concept over time.

For the purposes of greater legal certainty, the French Group supports adoption of a definition of inventorship based on this interpretation from the case law.

An inventor is a natural person who conceives and/or reduces to practice, alone or with others, an invention. Accordingly, inventorship should be assessed by evaluating, as of the date of the invention, the contribution made to the state of the art known by the inventors on this same invention date.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The French Group considers that French law could be improved having regard to inventions that are neither military items nor dual-use items as defined more specifically in Article 1 of Regulation (EC) No 428/2009 of 5 May 2009, that is to say items, including software and technology, which can be used for both civil and military purposes, and which must be the subject of export authorisations.

Accordingly, for inventions which do not fall within either of these two categories, as well as for dual-use technologies which have been the subject of an export authorisation, French law should expressly exempt them from the requirement for first filing in France, including in respect of European applications and PCT applications.

It would no doubt also be necessary to provide a circular from the Minister of Justice (*Garde des Sceaux*) to public prosecutors' offices, or any other appropriate legal text, in order to specify that in those cases the public prosecutors' offices shall not commence proceedings under Articles 410-1, 411-6, and 413-9 to 413-12 of the French Criminal Code.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

French law could be improved by making provision for the secrecy procedure for national defence purposes to be limited to priority patent applications filed in France and for it not to extend to French patent applications filed under the priority of a foreign application.

This is because the foreign priority application may be disclosed and/or exploited even before the filing under priority in France. As a consequence, a secrecy procedure in France would place the applicant in a position of legal uncertainty until the authorisation issued by the ministry responsible for industrial property, upon the advice of the ministry responsible for defence, was obtained.

A further possible proposal would be to dispense with the review for national defence purposes of patent applications which relate neither to technologies capable of being incorporated in military items nor to dual-use technologies that have not yet been the subject of an export authorisation.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

No

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

The French Group considers that harmonisation is desirable in order to facilitate the treatment of multinational inventions

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

The French Group proposes the adoption as an international standard of the definition of inventorship in accordance with the criteria proposed in question 8, i.e. an inventor is a natural person who conceives and/or reduces to practice, alone or with others, an invention. Accordingly, inventorship should be assessed by evaluating, as of the date of the invention, the contribution made to the state of the art known by the inventors on this same invention date.

In addition, with regard to multinational inventions, the French Group proposes the adoption of harmonisation criteria for the purposes of determining the applicable law.

The French Group proposes that the law applicable to the determination of inventorship be that of the contract under which the inventor contributes to the invention.

A distinction should be made depending on whether or not the inventors are employees.

Where the inventor is an employee, the applicable law should therefore be that of his or her contract of employment, which is the contract under which he or she contributes to the invention.

This criterion of connection has the advantage of resulting in the application of one single law for each employee inventor.

To determine the law of the contract of employment, the French Group proposes the adoption on the international level of the criteria proposed by Regulation No 593/2008 (Rome I) of 17 June 2008, according to which the individual employment contract is governed by:

- the law chosen by the parties, with such a choice of law not having the result of depriving the employee of the protection afforded to him by provisions that cannot be derogated from by agreement under the law that, in the absence of choice, would have been applicable (Article 8(1));
- to the extent that the law applicable has not been chosen, the individual employment contract is governed by the law of the country in which or from which the employee habitually carries out his work in performance of the contract (Article 8(2)) or, where the law applicable cannot be determined, by the law of the country where the place of business through which the employee was engaged is situated (Article 8(3)).

In the case of a research contract between several entities involving employee inventors, the French Group recommends:

- specifying in that contract the law applicable to the determination of inventorship;
- signing an amendment to the employment contract of each potential inventor specifying the law applicable to the determination of inventorship in the context of that research,
- with the law applicable to the determination of inventorship preferably being able to be that of the country in which the research activity is centred.

Where the inventor is not an employee, the law applicable to the determination of inventorship could be the law of the contract governing the research, that is to say the contract under which the inventor contributes to the invention.

Absent a contractual clause, the applicable law shall be that of the place of characteristic performance.

In the French Group's view, the place of characteristic performance would be the country in which the invention was conceived and developed, and, in the event of several countries being involved, for each inventor, the country in which he or she made his or her contribution to the invention.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

The French Group is of the view that the rules relating to the correction of the designation of inventors, as they currently exist in France (see above, answer to question 4), are satisfactory. In any event, the French Group considers that, if an international standard were to be put in place, it would have to allow:

- if there is no designation of inventors at the time of filing of the patent application, the regularisation of the non-designation of inventors within a time limit which is shorter than that for the publication of the patent application, for example sixteen (16) months from the filing of the patent application or, where applicable, from the filing of the corresponding priority application;
- in the event of inventors being designated when the patent application is filed, correction of the designation of inventors (removal or addition of inventors) without any limitation in time and irrespective of the nature of the error in the designation (i.e. regardless of whether or not the error was intentional).

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

The French Group considers that it is not appropriate to propose an international standard aimed at designating a place of filing of a first patent application when there is no conflict of laws. In this instance, only national law should apply.

On the other hand, the French Group considers that it is appropriate to propose international standards for designating a place of filing of a first patent application in the event of an invention which gives rise to a conflict of laws.

In this case, the criteria such as the place of domicile of the inventor or his or her nationality do not provide a uniform universal response to the question of the place of first filing, and these criteria do not provide increased legal certainty for applicants either.

In this regard, the French Group considers that, for any invention, unless it falls within a category that is subject to prior export authorisation (see below), the governing principle in the case of a research contract or employment contract should be the free choice of the place of filing of a first patent application. Thus, in practice, in most cases, the existence of a research contract or employment contract would allow the parties to decide freely on the question of the place of first filing.

Absent a contractual clause, the law of the country in which the invention was conceived and developed should be chosen and, in the event of a plurality of countries, that of the country in which the research activity is centred.

This principle of free contractual choice or of first filing in accordance with the law of the country in which the invention was developed should be adjusted only with regard to the nature of certain inventions.

Accordingly, inventions relating to a technology which falls within the scope of national regulations applicable to military items or dual-use items which have not been granted a prior export authorisation in accordance with the said regulations (see in particular Community Regulation (EC) No 428/2009 of 5 May 2009 as amended – for which an export authorisation is required) would still be regulated by different national provisions, possibly conflicting.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

The international standard could contain the following provisions:

- Each national law which imposes a secrecy procedure should provide that this procedure be limited to priority patent applications filed in that country.
- Each national law which imposes a secrecy procedure should provide for a mechanism of “*implied authorisation*” upon the expiry of a period of time (which could be harmonised), allowing the applicant to disclose and/or exploit the invention.
- In addition, each national law should provide a possibility for the applicant to ask the local administrative authorities to state their position within a short timeframe regarding the possibility of disclosure and/or exploitation (with there being no need to provide reasons for this at the application stage).
- It would also be possible to provide that patent applications which do not relate to technologies falling within the scope of the regulations relating to military items or dual-use items which have not obtained an advance export authorisation be exempted from being reviewed for national defence purposes.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

The definition of a standard does not appear to be appropriate.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

The aim of requirements for first filing at a predetermined office and of provisions making the possibility of filing a first application in a foreign country subject to authorisation is to prevent sensitive technical information from being communicated in an uncontrolled manner to the administrative authorities of a foreign power.

If these requirements are not complied with, it would seem difficult to cure them since the communication has already taken place.

The applicant may nevertheless withdraw its application prior to publication – and not claim the priority thereof – in order to erase any trace of the filing made in the foreign country in contravention of obligations associated with national security and thus to avoid a wider disclosure.

Partial harmonisation would be possible and desirable with regard to the penalties for an “involuntary” breach of such an obligation. More particularly, it would be possible to provide:

- that the irregular circumstances (from the point of view of national security) of the first filing do not affect the validity or enforceability of the IP rights claiming the priority of this first filing;
- for there to be no penalty – or at most purely financial sanctions – when the breach is involuntary and is not actually detrimental to the fundamental interests of the State whose laws have been contravened.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Certain offices require declarations or assignments on the part of inventors, sometimes in very burdensome forms (signature with a witness, notarised documents, etc.). The French Group would be minded to limit these requirements:

- at least by simplifying the form thereof (simple signature),
- or alternatively to limit the requirements to the PCT filing (without duplication upon entry into national or regional phases) or, as a variant, to the priority filing,
- or alternatively to abolish them.

Summary

1. The French group has voted the following definition of an inventor: “An inventor is a natural person who conceives and/or reduces to practice, alone or with others, an invention. Accordingly, inventorship should be assessed by evaluating, as of the date of the invention, the contribution made to the state of the art known by the inventors on this same invention date.”
2. Provisions mandating a country of first filing and a control by national defense authorities should only apply to inventions in relation with technologies which are used to design or manufacture warfare or dual use equipment, when the latter have not been granted an export license.
3. For other inventions, the following provisions should be harmonized, only to the extent that such harmonization is necessary to prevent or resolve conflicts of laws:
 - The law to determine inventorship should be the law of the contract whereby the inventor contributes to the invention (research contract, employment contract...) or, by default, the law of the country where the invention was conceived and reduced to practice;
 - The country of first filing should be freely selected by the parties or, by default, should be the one where the research activity which has generated the invention has its main center.

Q244 : Résumé des propositions du groupe français

1. Le groupe français a adopté la définition suivante de l’inventeur : « Un inventeur est une personne physique qui conçoit et/ou met au point, seul ou avec d’autres, une invention. Ainsi, la qualité d’inventeur peut s’apprécier en évaluant à la date de l’invention la contribution apportée à l’état de la technique, l’état de la technique étant celui connu des inventeurs à cette même date d’invention. »

2. Les dispositions relatives à une obligation de premier dépôt dans un pays et au contrôle de la Défense nationale ne devraient être applicables qu'aux inventions relatives à des technologies entrant dans la conception ou la fabrication de matériels de guerre ou de matériels à double usage n'ayant pas fait l'objet d'une autorisation préalable d'exportation.
3. Pour les autres inventions, les dispositions suivantes pourraient être harmonisées, uniquement dans la mesure nécessaire pour éviter les conflits de lois:
 - La loi applicable à la détermination de la qualité d'inventeur devrait être celle du contrat en vertu duquel l'inventeur contribue à l'invention (contrat de recherche, contrat de travail ...) ou, à défaut, celle du pays dans lequel l'invention a été conçue et mise au point;
 - Le pays de premier dépôt devrait être celui choisi librement par les parties ou, à défaut, celui dans lequel est centrée l'activité de R&D ayant donné naissance à l'invention.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Germany

Report Q244

in the name of the Germany Group
by Jochen EHLERS, Matthias RÖßLER, Dietmar HAUG, Christof KARL and Dietmar HAUG

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

This question seems to have two aspects. The first aspect (i) relates to the question of whether or not “directing the efforts of person B” influences inventorship, whereas the second aspect (ii) relates to the question of how inventorship is influenced by different residencies of persons A and B.

(i) With respect to the first question, it is important to first understand the concept of “inventorship” in accordance with German patent law: Although §§ 6 – 8, 37 and 63 PatG^[1] relate to “inventorship”, none of them provides a clear definition of “inventorship” or gives any precise indication of the kind of activity that qualifies for an “invention”.

“Inventorship” is established based on the real act of creating an invention. An invention is thought to have been created as soon as an “inventor” has conceived a complete and, hence, *executable technical teaching*. In a patent application, such technical teaching is ultimately defined – in its most general manner – by the claims. As a result of this definition, an aspect that has been considered during the development, but that has not found its way into the claims – i.e. that may not be subsumed under the subject-matter of the claims – may not be considered a part of that respective “claimed invention”. This is particularly important in cases where more than one person may be considered an inventor, because the subject-matter of the claims may be utilised to determine the concept of the invention and the contribution that each of the supposed inventors may or may not have made to it.

In that respect, only one (or more) *natural persons* may become inventors under German law. A company, for example, may not be considered an inventor. Other than this requirement of being a natural person, there are no further legal requirements to be an inventor (such as contractual capacity, nationality and so on).

The determination of inventorship goes hand in hand with the right to the patent, since, in accordance with § 6 PatG, 1st sentence, by law the right to the patent belongs to the inventor (or the inventor’s legal successor). This idea is generally called the *inventor’s principle*. § 6 PatG, 2nd sentence provides for the case where several inventors created the invention jointly and establishes that they obtain the right to the patent jointly. § 6 PatG, 3rd sentence establishes that for several inventors having developed the same invention independently, the rights to the patent belong to that inventor who first applied for a patent at the patent office. In that respect, the *priority of the invention*, i.e. the order in which the invention was actually invented by each of the several inventors, is irrelevant to the question as to who obtains the right to the patent.

The right to the patent lies in the sphere of property rights. It may therefore be transferred from the inventor to a third party, e.g. due to a contractual obligation. However, even upon such transfer, the inventor (or the inventors) retains the personal right to be named as inventors, on the publications relating to the patent.

As an invention is a *technical teaching* that may have been created by involvement of several persons by performing experiments, tests or other actions which ultimately resulted in the inventive concept. Not all of these persons may be considered (co-)inventors in the sense of § 6 PatG.

At present, there is no generalised guideline how to determine (co-)inventorship in German law. Rather, whether a person is to be considered a (co-)inventor has to be decided on a case-by-case basis. In that respect, in order to assess a person's status as (co-)inventor of an invention, German jurisprudence has repeatedly set out two conditions that shall be met by said person.

(a) The person has to make a contribution to the solution of the problem to be solved by the invention, whereby said contribution must not be insignificant with respect to the solution^[2]. Further, said contribution has to be creative, but not necessarily inventive in itself.

(b) Said contribution must be an intellectual one that has to be provided autonomously, i.e. without the specific directing^[3] by other persons.

In detail:

In accordance with consideration (a), a (co-)inventor has to provide a part of the solution of the technical problem, i.e. has to contribute to the technical teaching in a way that is not insignificant for the overall success of the invention and that is also considered *creative*^[4]. The contribution does, however, not have to be inventive in itself. In other words: In order to qualify as a (co-)inventor, a person has to provide a qualified input with respect to one or more of the features of the invention that are a part of the solution of the technical problem, i.e. the technical teaching.

According to consideration (b), this contribution of a (co-)inventor has to be an intellectual one. Thus, a person that provides intellectual input on possible modifications of an inventive concept or on a potential alternative solution to a particular problem may be considered a (co-)inventor. This intellectual contribution does not necessarily have to be a physical act. For example, a person that has provided the theoretical groundwork from which the technical teaching is ultimately developed is equally to be considered a (co-)inventor.

In contrast, a person merely providing for certain requirements without which the invention could not have been made – such as providing laboratory space, financial support or requesting to solve a particular problem without any direction as to how to solve this problem – does not qualify as a (co-)inventor. Likewise, a person conducting an experiment or building a prototype under direct supervision may not be considered a (co-)inventor. These persons are rather considered "(inventor's) assistants".

Therefore, it becomes apparent that person A may be considered an inventor if the directing of person B's efforts by person A may be considered an intellectual, creative contribution that has not been insignificant to the success of the invention, i.e. that is a part of the technical teaching. For example, if person A has conceived a specific technical solution to a specific technical problem and directs^[5] person B to perform experiments or build a prototype in order to verify said solution, i.e. provides person B with distinct instructions, person A will be considered the sole inventor of the technical teaching – provided that the result is both, new and inventive. It goes without saying that person B, who has been instructed throughout the process and has not provided any autonomous input at all, would not be considered an inventor in this case, but rather an assistant.

On the other hand, person B may be considered a co-inventor, if both, person A and person B have provided an intellectual, creative contribution that has been significant to the success of the invention in the above-cited sense. This could be case if, for example, person A directs person B to solve a particular technical problem to which

person A has already contrived a partial (incomplete) solution and person B completes the work of person A to achieve the solution.

In a further constellation, person A may not be considered an inventor at all, whereas person B could be considered the sole inventor. This would be the case if, for example, person A had only provided direction in the manner of telling person B "Find a solution to this problem", without providing any hint or pointers to a solution, but merely stating that it must be possible to find one. In that case, the whole process of finding the solution, i.e. finding a technical teaching to arrive at the solution was conducted by person B.

(ii) In relation to the second aspect of the question: Whether or not person A and/or person B have a residency inside or outside Germany has no influence on the question under which circumstances person A and/or person B would be considered an inventor in accordance with *German jurisprudence*^[6].

Footnotes

1. [^] [1] In the following, the abbreviation PatG is used to refer to the German Patents Act. The sign "§" is used to indicate the respective section/article of that Act. The doubled version of this sign "§§" is used to indicate multiple sections/articles.
2. [^] Cf. BGH decision X ZR 103/11 of 18 June 2013, at 8.
3. [^] "Specific" directing in this context means that a person receives a kind of directing that points into a specific direction or to a specific solution of the technical problem.
4. [^] The question which contribution may be considered creative and which not has to be answered on a case-by-case-basis here.
5. [^] specific directing
6. [^] In cases of multinational inventions, the question of inventorship is a question to be answered on the basis of the applicable national law. Thus, the question of whether person A or person B are inventors may be answered differently in cases where another national law (apart from German law) may also be applied. Thus, the determination of inventorship may vary from constellation to constellation. In the following, these different variations shall not be discussed in further detail.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The question as to how an invention was made by one or more inventors and what contributions were made by each of the inventors may only be answered in view of the *entire* technical teaching of an invention. As outlined herein above, the most general concept of such technical teaching may be defined by the claims. However, the question of who invented the technical teaching of a patent is not to be answered on the basis of the claims and the combination of their features alone^[1]. Decisive for the determination of a possible creative contribution to the subject matter of the patent is the *entire* content of the patent application including description and drawings^[2]. Thus, whether or not a person may be considered an inventor is to be determined on the basis of the patent application *as a whole*^[3].

In case of a single inventor, such an assessment is rather easy: if the subject-matter of the application is both, new and inventive, this single person is to be considered the inventor. However, in cases where more than one person has contributed to the technical teaching of an invention, this technical teaching has to be determined in a more definite manner. In particular, it has to be determined which aspects of the application as a whole relate to the claimed invention and which do not, i.e. which aspects may be subsumed under the claims and which may not. A person may thus be considered a (co)inventor, if said person has contributed^[4] – in accordance with the understanding as defined in sub a.) – to one or more of the aspects of the technical teaching that ei-

ther already are comprised by a claim or could be made part of a claim in accordance with the disclosure of the original application^[5].

In that respect, it is irrelevant whether the person's contribution may be found as verbatim disclosure within the description, claims or drawings or whether it relates to the technical teaching conferred by the claims as a whole. As a consequence, a limitation of a claim by adding features from a preferred embodiment cannot enlarge the circle of co-inventors, i.e. the maximum number of co-inventors is fixed with the filing of the application^[6]. But the number of inventors may be reduced during prosecution of the patent application if the only technical feature contributed by a co-inventor is finally excluded from the limited claims^[7].

Therefore, a person who has solely contributed to these elements of the description and drawings – the aspects not falling under the scope of any of the claims – may not be considered a co-inventor.

Footnotes

1. [^](#) Cf. BGH decision X ZR 70/11 of 22 January 2013, at 13.
2. [^](#) BGH, *id.*
3. [^](#) Cf. eg. BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung
4. [^](#) This also includes a person who has provided some kind of directing, which eventually lead to the technical teaching that is conferred by the claimed invention.
5. [^](#) Cf. BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung, at 18; BGH decision X ZR 70/11 of 22 January 2013, at 14.
6. [^](#) BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung, at 18.
7. [^](#) BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, the law of inventorship depends solely on the person(s) of the inventor(s). However, the question of whether German law is applicable for the determination of inventorship in a case where the invention was made at least in part by foreign citizens has not yet been addressed by case law. One possible approach advocated in legal literature is the application of German law if a German national patent application has to be examined.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, invention and inventorship are independent of the residency of the inventor(s). However, the question of whether German law is applicable for the determination of inventorship in a case where the invention was made at least in part outside the territory of Germany has not yet been addressed by case law. One possible approach advocated in legal literature is the application of German law if a German national patent application has to be examined.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

The inventor information on the patent application can be supplemented or corrected after the filing date.

This is provided for by § 63 PatG. Pursuant to § 63 PatG, the inventor has the right to be

designated on the published application, on the patent document and on the publication of the grant of the patent. In addition, § 63 PatG confers the inventor the right to correct the inventorship designation.

However, the correction of the inventorship of a patent application does not directly change ownership of the application. As explained, the “real inventor” or his or her successor in right, whose invention has been applied for by a person not so entitled, may request that the patent application is assigned to him.

The applicant or proprietor may change the designation of an inventor at any time. Consent of the previously designated inventor(s) is (only) required after the designation has been published on the application, the patent document or the mention of grant^[1].

An inventor may request that an incorrect designation shall be corrected if both the patent applicant or proprietor and the previously designated inventor(s) agree^[2]. The correction can be made if a person has been named incorrectly as an inventor, or if one or several co-inventors have remained undesigned, upon a written application by the true inventor to be filed with the Patent Office. Such an application needs to include a written declaration of consent of the applicant or patent proprietor on the one hand, and the actually involved and previously designated inventor(s) on the other hand, if requested by the Patent Office with certified signatures.

The entitlement to correction of the designation generally arises with the publication of the patent application, the patent document or the mention of grant. However, a correction can already be claimed before the patent document is laid open^[3].

The claim for correction is not tied to the validity of the patent. However, there is no entitlement if the application has already been finally rejected.

The true inventor can enforce the right for a declaration of consent by the patent applicant or proprietor and/or the other designated inventors to the correction before the competent court of law. There is no deadline for this claim because the personal right of the inventor does not become statute-barred. Only the true inventor can enforce the claim in court. The claimant/inventor to be designated generally bears the onus of proof.

The justified designation is only noted on official publications if these have not yet been published. If all publications have been published, the true inventor is still able to prove his inventorship by the publication in the Patent Bulletin and the Register^[4].

Footnotes

1. [^](#) *BPatGE 25, 131.*
2. [^](#) *OLG Karlsruhe, GRUR-RR 2003, 328.*
3. [^](#) *BGH, GRUR 1969, 133*
4. [^](#) *Busse/Keukenschrijver § 63 PatG, Rn. 24 ff.*

5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

(i) The potential consequence of an incorrect designation of the inventor is essentially limited to the fact that the designation (and as a consequence possibly also the ownership right) has to be corrected in the register and/or future publications concerning that patent application upon the disadvantaged party's request. If the correction corresponds to the actual situation and is registered, this does not affect validity or enforceability of the patent.

In fact, the minor importance of inventorship under German law can also be seen from the fact that the statement has only to be submitted within 15 months after the priority of a patent application. Upon request of the applicant, this period may even be extended by the patent office until the grant of the patent. Upon request of the inventor, his/her designation on all publications is omitted. For utility models, a statement does not need to be submitted at all.

The filing of an action for the declaration of consent to the subsequent designation or cor-

rection of the same, as mentioned above in the answer to question 4), does not delay the procedure for grant. There is in particular no stay of the examination proceedings^[1].

The incorrect designation of the inventor does not preclude the validity of the patent, even if it was made intentional, because an incorrect designation is no ground for nullity (as stated in §§ 22, 21 PatG). There are no particular sanctions e.g. under criminal law for an incorrect designation, because such misinformation does not entail any disadvantages for the proceedings before the Patent Office or the granted patent^{http://de.wikipedia.org/wiki/Erfinderbeneennung - cite_note-benkard-sch.C3.A4fers_Rn_9-7} as they are not causal in relation to the patent grant, see § 37 (1) sentence 3 PatG. They do not constitute elements of obtaining a patent by fraud, either.

(ii) However, since according to § 6 PatG the patent belongs to the inventor or his successor in title, an incorrect designation, together with further prerequisites, may result in a claim to the transfer/nullity of the patent to the actual inventor:

According to § 8 PatG, the person entitled to the invention whose invention has been applied for by a person not so entitled may request that the applicant or the patent proprietor, assigns the patent application or the patent, respectively, to the real inventor. And that is not a question of nationality, because persons deriving their right from a foreign act of conceiving of an invention are also entitled to file claims and sue in this regard. They may invoke the principle of German law according to which their right is not established by the application, but by the inventor's personal right. However, foreign regulations may take effect, in particular in the case of employee inventions, concerning whether or not the right to the invention accrues to the employee or the employer^[2].

In case the application was filed by a person not so entitled, the "real inventor" who is entitled to the invention may assert the right to assign the patent application by an action of law only within two years after publication of the grant of the patent, see § 8 sentence 3 PatG.

Besides that, a ground for nullity may occur if there is not only an incorrect designation, but in fact an usurpation, cf. §§ 22, 21 PatG^[3]. An usurpation may be present if the (registered) applicant has filed an application for an invention without having received the inventor's entitlement to do so. The applicant may step in such a situation, if the application includes inventive subject-matter that was i.e. based on information received from a (not designated) "real" inventor under confidentiality or subject-matter being illegally obtained knowledge of a third party^[4]. As a consequence, there remains a (minor) risk that the application is declared null if it is discovered later that subject-matter of the invention was illegally taken from a (not designated) "real" inventor.

Footnotes

1. [^] *Busse/Keukenschrijver*, § 63 PatG, Rn. 30.

2. [^] *Kraßer*, p. 361 f. Sec. 20.

3. [^] *Beyerlein*, *Mitt.* 2003, p. 65, 67.

4. [^] *Kraßer*, p. 361 f. Sec. 20.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

German law does not require that a patent application be filed first at the German Patent and Trade Mark Office. However, § 52 PatG provides that a patent application which contains a national secret as defined in § 93 of the German Criminal Code (Strafgesetzbuch (StGB)) may be filed abroad only if the German Ministry of Defence has granted approval to do so, which approval may be subject to the fulfillment of certain conditions. Failure to obtain such an approval or meet the conditions of the approval may lead to criminal sanctions. Consequently, a patent application which contains a national secret should be filed first at the German Patent and Trade Mark Office if no approval for filing it abroad has been ob-

tained from the Ministry of Defence and criminal sanctions are to be avoided. For the same reason a European patent application which contains a national secret and a PCT application which contains a national secret should be filed first at the German Patent and Trade Mark Office. If the applicant is in doubt as to whether or not the application contains a national secret, it is advisable to file the application first at the German Patent and Trade Mark Office because every application filed at the German Patent and Trade Mark Office will be examined by the Office to ascertain whether or not the application contains a national secret. If the application does not contain a national secret it may be filed first abroad as a foreign national application, or in case of a European patent application at any filing patent office defined in Art. 75 (1) EPC or, in the case of a PCT application, at any competent Receiving Office including the International Bureau and the European Patent Office.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Preliminary remarks: German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, no matter whether the invention forming the subject of the patent application is made in part or completely in Germany. However, any patent application filed at the German Patent and Trade Mark Office, whether it is a German national application, a PCT application or a European patent application in respect of which the applicant has indicated that the European patent application may contain a national secret, is subject to a secrecy review which is conducted by an examiner of the German Patent and Trade Mark Office with a view to determining whether or not the application contains a national secret. A patent application which does not contain a national secret need not be filed

at the German Patent and Trade Mark Office but may be filed directly in another country or at the European Patent Office without it being subjected to a secrecy review or similar process beforehand.

Although German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, it is to be noted that if a secrecy review is conducted by the German Patent and Trademark Office because the patent application has been filed at the German Patent and Trademark Office, the secrecy review is conducted with a view to determining whether or not the application contains a national secret which may be any secret that impacts the national security if disclosed to unauthorized persons. Patent applications that have been deemed to contain a national secret up to now, have disclosed or claimed inventions made in areas such as nuclear, biological and/or chemical weapons, nuclear energy, communication technology, information technology, cryptography, protection against forgery of security and value documents.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

Although German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, it is to be noted that if a secrecy review is conducted by the German Patent and Trade Mark Office because the patent application has been filed at the German Patent and Trade Mark Office, the secrecy review consists in determining whether or not the application contains a national secret. What is and what is not a national secret does not depend on the patentability of the invention forming the subject of the patent application undergoing a secrecy review. There is no national secret in the case of publications or documents that are accessible to any person due to public use or the inventive concept of which fails to go beyond the general technical knowledge.

If the examiner conducting the secrecy review is of the view that the patent application contains a national secret and in cases of doubt, the German Ministry of Defence has to comment on the examiner's findings before an order of secrecy is issued. Once the examiner has considered the comments made by the Ministry of Defence he or she decides to issue an order of secrecy but only after the applicant has been heard. Once an order of secrecy has been imposed on the application any publication of the application by the Patent Office or the applicant is prohibited.

The secrecy order must be delivered to the applicant pursuant to § 53 PatG within a statutory term of four months after filing of the application. If the secrecy order is not delivered to the applicant by the date of expiry of the afore-mentioned term the applicant can assume that the application need not be kept secret unless the applicant knew that the application contains a national secret. The afore-mentioned term can be extended by two months.

If a secrecy order has been imposed on the patent application and it turns out later on that it was not necessary to issue the secrecy order the order is to be rescinded by the examiner ex-officio, or upon request by the Federal Ministry of Defence or the applicant or patentee. If the order is rescinded, the patent application or a patent granted on the secret application can be published.

Since a secrecy order imposed on a patent application might impair possible exploitation interests of the applicant, he or she is entitled to a legal claim for compensation from the German Government pursuant to § 55 PatG.

A patent application containing a national secret may be filed in another country according to § 52 PatG only with the prior written permission of the Federal Ministry of Defence. Although the character of the invention as a national secret is not eliminated by the permission of the Federal Ministry of Defence, the applicant is entitled to file the application in another country on account and within the scope of the permission. To obtain the permission a request should be made in writing with the Federal Ministry of

Defence, listing the countries in which the application is to be filed. Grant of the permission is at the discretion of the Ministry of Defence. The permission is usually granted if the other country agrees to the secrecy and the disclosure of the invention to the authorities of the other country does not impair the national security of the Germany. It is not necessary to file a patent application first in Germany in order to request and obtain the permission from the Federal Ministry of Defence to file a patent application in another country.

The official fees for filing and prosecuting a patent application which is subject to a secrecy order imposed on the application after a secrecy review are not different from those due for a patent application which is not subject to a secrecy order. Also there is no official fee for obtaining the permission from the Federal Ministry of Defence to file a patent application containing a national secret in another country.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Although German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, it is to be noted that if a patent application which contains a national secret is filed in another country and a permission to do so has not been obtained or has been denied the applicant may be sentenced to imprisonment of up to five years or he may be fined. The same applies if a permission has been granted with restrictions and the restrictions are not met.

The applicant will be sentenced only if his failure to comply with the law and the conditions governing the filing of a patent application which contains a national secret was intentional.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

The German Patent law does not define inventorship. The definition and the principles of how it is determined have been developed by case law and legal literature, yet there is no uniform definition. It can be noted that current case law places comparably low requirements on an involvement in an invention. Only contributions which had no influence on the overall success and which are not relevant in respect of the technical solution are insufficient to establish an involvement in an invention^[1].

As concerns the mechanism of becoming an inventor it is often not clear in practice who has made a significant contribution. Usually, the co-inventors agree on this among each other. What is decisive for determining the individual share of an inventor is the significance the individual contributions of the persons involved in the invention have in relation to each other and in relation to the overall inventive achievement^[2]. As a general rule, the technical contribution of a joint inventor has to "affect" the inventive technical solution. Furthermore, an inventor status can be achieved on the basis of a contribution within defining the underlying technical problem on which the invention is based, if this contribution influences the overall success of the invention and already contains a hint for the technical solution^[3].

As outlined above, the assessment of inventorship is somewhat difficult, but in general it can be said that the prerequisites are relatively low. There are no serious consequences for a patent or patent application in case of an incorrect inventor designation. This seems to be an appropriate environment for Germany, where the majority of inventions come from employees and these employees usually decide by themselves who was involved and who not.

Footnotes

1. [^](#) *BGH GRUR 1966, p. 558- Spanplatten; BGH GRUR 1978, 585- Motorkettensäge, Mitt. 1966, p. 16- Gummielastische Masse II.*
2. [^](#) *BGH GRUR 1979, 540 (541)- Biedermeiermanschetten.*
3. [^](#) *Bartenbach/Volz, KommArbEG, § 5 Rn. 47.1*

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

German law does not require first filing of patent applications in Germany. If a patent application is filed at the German Patent and Trade Mark Office, be it as a first filing or a subsequent filing, it undergoes a secrecy review to determine whether or not it contains a national secret irrespectively of whether or not the invention forming the subject of the invention has been made by two or more inventors of the same nationality or different nationalities. Thus there is no law that could be improved to address multinational inventions.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The provisions governing the need for a secrecy review of patent applications filed at the German Patent and Trade Mark Office should be amended to clarify what is and what is not a national secret which, if contained in a patent application, requires an order of secrecy to be imposed on the application. However, such an amendment would not make any difference on whether the invention forming the subject of the application was made by two or more inventors of the same nationality or different nationalities.

In addition, it is suggested that the present statute regarding secrecy review should be amended in a way that it allows to file a patent application, which is considered to disclose an invention which might concern national security, with the competent authorities of the foreign co-inventor(s), or a supranational patent authority to which the secrecy review will be delegated.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

No.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Presently, the question of who is recognised as an inventor of a particular invention may be answered differently in different jurisdictions. In particular, many jurisdictions define "inventorship" or "involvement in an invention" in Case Law with more or less ambiguous instructions to the industry. Considering the increasingly involved multinational teams working on product developments, problems do exist with regard to the actual decision on legally relevant contribution of persons to the inventions. That question is often finally decided by the persons of the team themselves without having a clear understanding of the different (national) requirements. As that decision has different effects on the question of "actual" ownership of patents or patent applications directed to the same invention between the counterparts being subject to different jurisdictions, harmonisation is highly desirable.

Harmonisation is even more mandated with respect to first filing and secrecy review require-

ments, which in extreme cases may lead to the result that no patent application can be filed in any jurisdiction without violating criminal law in one of the jurisdictions where the inventors are domiciled or of which the inventors are nationals. Due to the existing differences, applicants or their agents are oftentimes not aware of the requirements existing in foreign jurisdictions, which may lead to loss of rights in these jurisdictions, or even criminal sanctions.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

According to the present Case Law in Germany, inventorship requires an involvement in the development of the teaching by contributing an achievement which exceeds the ordinary skill of the person skilled in the art, which has substantial influences on the overall success of the inventive achievement, and which is made at least partly on own initiative. Accordingly, contributions that can be excluded from inventorship from the outset are (only) those that had no influence (at all) on the overall success of the invention and which are therefore irrelevant for the solution, or were made according to specific instructions from an inventor or a third party.

To sum up, the prerequisites to acknowledge inventorship is relatively low in Germany allowing many persons involved in a development to be designated as co-inventor for a subsequent patent application. Considering the standing of the inventorship itself that situation significantly supports teamwork and technical progress. But it should also be considered that at the same time incorrect designations can be easily corrected without any significant defect of the rights resulting from the patent.

In countries where more serious sanctions may happen after an incorrect inventor designation it might be helpful to have a slightly stricter definition to reduce the required efforts of the patent proprietor to verify the actual involvement of persons during the development and to reduce the resulting risks. But from our perspective and due to the positive experiences during the last decades with that situation it seems to be more appropriate to mitigate the legal consequences of such an incorrect inventor designation.

As outlined above, the German definition could serve as an appropriate international standard.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

(i) The German rules seem to offer appropriate proceedings to correct the inventorship *after a patent application is filed*, because these are flexible to handle, respect all interests and avoid any harmful effect on the validity and enforceability of the patent. It should be noted that the rules of the EPC are structured in a similar fashion, cp. Article 62 and Rule 21 EPC. Generally no distinction between intent and negligence should be made, because this would simply increase the administrative burden of the patent offices. If this cannot be dispensed with, then it should be left to the national courts where the invention originates from, because that considers the actual situation of the involved persons at the time of the invention.

(ii) As far as the correction of ownership based on an originally incorrect inventor designation is concerned, it is also believed that the rights of the "new" inventor and the already involved parties (in particular also the applicant) are fairly balanced according to the German Law because § 8 PatG establishes a right for assignment within a limited period of time after granting.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

A first filing requirement is not appropriate.

The rationale for such a requirement is typically the protection of the secrecy of certain inventions implicating national security or other national interests of the jurisdiction applying the requirement. However, the inventions of the vast majority of patent applications do not fall in this category. Furthermore, applicants are typically well aware of the fact that their invention is or at least may be relevant for national security or other national interests. Therefore, the goal of protecting the secrecy of such inventions can also be achieved with less far-reaching measures like a secrecy review requirement for certain classes of inventions, or even by simply prohibiting foreign filings of patent applications disclosing inventions which are relevant for national security or other national interests, combined with an offer for a review in case the applicant has doubts, and combined with criminal sanctions in case of noncompliance with the prohibition^[1].

For the applicant who desires to make the first filing abroad, the first filing requirement increases the costs for patent protections, in the best case caused by a requirement to apply for a foreign filing license, and in the worst case by a requirement to file an additional patent application, in the jurisdiction of the inventor, although the applicant did not intend to do so. The requirement of obtaining a foreign filing license may also substantially delay the filing of the application.

For these reasons, a first filing requirement or a general obligation to obtain a foreign filing license unduly burdens applicants and is disproportionate.

Footnotes

1. [^] *These secrecy requirements should apply independent of the nationality and/or residency of each of the inventors.*

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

A secrecy review requirement is in general less burdensome for the applicant than a first filing requirement, in particular if it is limited to certain classes of inventions. However, even a secrecy review requirement is not necessary for achieving the goal of preventing the disclosure of inventions which implicate national security or other national interests, and is therefore inappropriate.

As mentioned in the answer to question 15, applicants are typically well aware of the fact that their invention is or at least may be relevant for national security or other national interests. The goal of protecting the secrecy of such inventions can be achieved by simply prohibiting foreign filings of patent applications falling in this category, possibly combined with criminal sanctions in case of noncompliance with the prohibition. Harmonisation of the definition of what has to be understood under an *“invention which implicates national security or other national interests”* would be desirable.

Since in particular in borderline cases, the applicant may have doubts whether or not his invention falls under the prohibition, secrecy review should be offered as an option, but it should not be mandatory. Moreover, a secrecy review should be carried out solely by the respective Patent Office at which the patent application is filed in order that the applicant will be informed as quickly and cost efficiently as possible as to whether or not the application contains a national secret. No other authority should be involved in the secrecy review such as the Ministry of Defence as in Germany.

In order to take account of multinational inventions, secrecy reviews in foreign jurisdictions should not be prohibited by national laws, at least were it is safeguarded that the reviewing agency in the foreign jurisdiction will respect the secrecy of the invention.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

The Working Guidelines define the term “foreign filing license” as “any procedure or mechanism for obtaining an exemption to a first filing requirement”. Since under the regime suggested here, there should be no first filing requirement (see answer to question 15 above), a foreign filing license in this sense would not be required.

However, where there is a prohibition of foreign patent filing disclosing inventions which implicate national security or other national interests, foreign filing licenses which provide an exception to the prohibition should be available. Such a foreign filing license should be granted where it is safeguarded, e.g. by international or bilateral treaties, that the patent office of the foreign jurisdiction will keep the invention secret^[1].

Footnotes

1. [^] *For multi-jurisdictional inventions which implicate national security or other national interests, a deadlock situation can occur if applying for a foreign filing license in another jurisdiction is prohibited by national law because it would involve disclosing the invention to the foreign agency. In this case, it is possible that no patent application can be filed in any jurisdiction. However, since the number of inventions actually implicating national security is small, and the number of such inventions made by a team of multi-jurisdictional inventors is even smaller, this result appears to be acceptable.*

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Under the regime suggested here, a foreign filing license as defined in the Working Guidelines would not be required. The modified foreign filing license as suggested in the above answer to question 17 only needs to be applied for where the invention implicates national security or other national interests.

In the granting procedure for such a foreign filing license, the competent agency assesses whether it is safeguarded, e.g. by international or bilateral treaties, that the patent office of the foreign jurisdiction will keep the invention secret. In a case where the invention indeed implicates national security or other national interests, a cure for inadvertently failing to apply for a license is not desirable because only by means of the application for a foreign filing license, it can be safeguarded that the foreign patent office is informed about the necessity to keep the invention secret.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

(none)

Summary

According to German case law, an invention is thought to have been created as soon as a person has conceived of a complete and executable technical teaching. In order to qualify as a co-inventor of an invention, German case law requires that said person (i) has made a contribution to the solution of the problem to be solved by the invention (this contribution must not be an insignificant one with respect to the solution). Further, (ii) said contribution must be one without any specific directing by other persons.

Information regarding inventors of a German patent application can easily be supplemented or corrected after the filing date. German law does not require that a patent application be filed first at the German Patent and Trade Mark Office.

In the opinion of the German national group, and in view of the increasing number of patent applications with multinational teams of co-inventors,

- the above requirements of co-inventorship would be an appropriate international standard;
- it would be desirable if it was easy to supplement or correct information regarding inventors after the filing date of a patent application, and no distinction should be made between intentional and unintentional errors;
- secrecy reviews in foreign jurisdictions should not be prohibited by national laws, at least where it is safeguarded that the reviewing agency in the foreign jurisdiction will respect the secrecy of the invention; and
- any first filing requirement, or a general obligation to obtain a foreign filing license, would unduly burden applicants.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Greece

Report Q244

in the name of the Greece Group
by Helen PAPACONSTANTINOIU and Eleni KOKKINI

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The notion of inventorship and co-inventorship is foreseen in Greek law No. 1733/1987, Art. 6, that states that "the right to a patent shall belong to the inventor or to the beneficiary in accordance with paragraphs 4, 5, and 6 and to his/her general or special successors in title", without providing a concrete definition of the inventorship. The same article further defines co-inventorship as the situation in which "two or more persons have made an invention jointly, provided that there exists no other agreement" and regulates the inventorship in the employer-employee relationship, making a clear distinction between free inventions, services inventions and dependent inventions. If the person B only follows directions issued by the person A, without a parallel development of individual contribution that has led to the invention, then only the person A is considered to be the inventor under Greek law and practice. However, if the person B has contributed creatively to the invention, either as a whole or in part of it, then both persons will be considered to be joint inventors.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Greek law does not determine inventorship on a claim by claim basis, or on the basis of the drawings, the examples or other part of the invention.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The law of inventorship is applied in accordance with the principle of territoriality and the lex loci protectionis. However, Greek law foresees a first filing requirement when the inventor is a Greek citizen.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

According to the Greek lex fori, the law of inventorship depends on the place where protection for the invention is sought, i.e. where a patent has been applied for (principle of territoriality).

4) Can the inventorship of a patent application be corrected after the filing date in your country?

no

No correction of the applicant(s) and the inventor(s) name is possible after the filing in the national patent procedure.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

In the case of an (obviously intentional) error in the stated inventorship on a patent application, the true inventor may request his/her recognition as the true inventor and/or patent owner by filing a relevant action before civil courts.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

Greek law requires that any invention made by a Greek citizen—either in Greece or abroad—be filed in Greece first, independent of the specific area of technology concerned.

If one of more inventors claiming an invention is a Greek citizen, he/she has to file the patent in Greece first, in order to comply with Greek patent law requirements.

Greek law does not explicitly include any provision regarding the request by a Greek citizen in another country for a foreign filing license. However, if an invention concerns national defence issues, any information or announcement concerning this invention in a foreign country is prohibited by law and any person who does not comply with this prohibition is liable under criminal law.

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

A patent application has to undergo a secrecy review, if the invention has been made by a Greek citizen. The place of residence and the place where the invention has been made is irrelevant.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

Greek law does not provide for a concrete definition of inventorship, with the exception of inventions made by employees. The courts have developed, though, general guidelines as to the inventorship. It is therefore suggested that a concrete definition be introduced, in order to clarify the issue.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

Greek laws could provide specific guidance as to how multinational inventions should be dealt with, if more than one applicable jurisdictions have a first filing requirement.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

Greek laws could provide specific guidance as to how multinational inventions should be dealt with, if more than one applicable jurisdictions have a secrecy review requirement.

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Not applicable.

III.) Proposals for harmonisation

- 12) Is harmonisation in this area desirable?**

yes

The harmonization is desirable in this area, as this is the only way to resolve the complicated issues that are raised from the multinational collaborations that lead to the invention

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

A common definition should include the intellectual contribution to the invention, thus excluding from the definition mere common ideas that do not lead necessarily to the invention, as well as the execution of the instructions provided by another person.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

It should be possible to correct the inventorship by providing a relevant declaration by all applicants within the four months period foreseen by Greek law for the completion of the patent application or other equivalent pendency time limits. It goes without saying that such an "amicable" correction should only be possible in the case of unintentional errors. Intentional errors should only be dealt with in the course of a court procedure, as this is also foreseen under the current Greek law regime.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

We believe that an international standard for first filing requirements for multinational inventions is necessary, in order to resolve possible conflicts. We are of the opinion that this would only be possible either in the form of bilateral agreements or with the implementation of a joint filing mechanism with the cooperation of patent offices in different jurisdictions.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

We do not think that setting an international standard for secrecy review requirements would be easy or even desirable, considering that these requirements concern the sovereignty of each country.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

We do not think that harmonization in the field of the granting of a foreign filing license could be easy. We deem it more appropriate to have an international standard for first filing requirements, as explained above under 15.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Curing or repairing an inadvertent failure to comply with a first filing requirement or a security review requirement with a retroactive effect is not possible according to our opinion, as it is contrary to the nature of the relevant obligation. However, we believe that any possible consequences, such as criminal liability, should be milder in case of unintentional failure/omission.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Not applicable.

Summary

A concrete definition for inventorship should be introduced into Greek law. Furthermore, specific guidance should be provided as to how multinational inventions should be dealt with, if more than one applicable jurisdictions have a first filing or a secrecy review requirement.

The harmonization is desirable, in order to resolve the complicated issues raised from the multinational research collaborations. A harmonized definition should include the intellectual contribution to the invention, thus excluding mere ideas that do not lead necessarily to the invention, as well as the mere execution of instructions.

It should be possible to correct the inventorship by providing a relevant declaration by all applicants within the pendency time limits. Such an "amicable" correction should only be possible in the case of unintentional errors. Intentional errors should be dealt with in the course of a court procedure.

An international standard for first filing requirements for multinational inventions is necessary, possibly either in the form of bilateral agreements or with the implementation of a joint filing mechanism with the cooperation of patent offices in different jurisdictions.

Setting an international standard for secrecy review requirements or in the field of the granting of a foreign filing license may not be easy or even desirable, considering that these requirements concern the sovereignty of each country.

Curing or repairing an inadvertent failure to comply with a first filing or security review requirement with a retroactive effect may not be possible. However, possible consequences should be milder in case of unintentional failure.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Hungary

Report Q244

in the name of the Hungary Group
by Michael LANTOS, Imre MOLNAR, Jozsef TALAS, Eva SOMFAI, Eszter SZAKACS, Gabor HARANGOZO and Andras CSERNY

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

(Article 7 of the Act XXXIII of 1995 on the protection of inventions by patents (in the following Patent Act or PA) 7 defines that "the person who has created the invention shall be deemed to be the inventor".)

Persons who participated in creating the invention should be regarded as inventors independent from their citizenship and country of residence. The inventorship can be divided in parts corresponding to the degree of contribution of the different inventors. The percentual share of the respective inventors can be defined based on their own free will and in the lack of such definition this share should be assumed as equal among the joint inventors.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The inventorship depends on the contribution of the person to the inventive idea. That is not defined on a claim by claim basis and also not on the content of the drawings or examples, but based on all circumstances that have led to making the invention. For instance, those who made activities within the normal duties of a man skilled in the art e.g. in the elaboration of the examples, are normally not held as inventors. In case there is no common understanding between the persons who think they are the inventors, the competent court should decide this question. The competent court is the Metropolitan Tribunal of Budapest.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

If the inventors and the owner(s) of the patent/patent application agree on the inventorship of a person not named earlier as inventor or on the change of the share of contribution of the respective inventors, then upon a joint request the inventorship in the patent register or in the patent documents will be amended accordingly. If such an agreement is not available or the persons have different positions, then it is the task of the competent court (c.f. above) to decide; in this case the inventorship will be corrected upon filing a request enclosing the final court decision. There is no time limit.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

If there is an error in naming the inventors, it can be corrected as defined in the previous point.

If it is not an error but the result of an intentional fraud, i.e. if the invention was made by a separate inventor and the person/applicant has unlawfully taken the invention from him or her and filed the invention, then according to Art. 34 of the Patent Act the real inventor can file a lawsuit against the named inventor(s)/applicant(s) and can request assignment of the patent corresponding to his or her share and can also request the compensation of his or her damages.

According to Article 42 (1)(d) of the Patent Act "the patent shall be revoked ex tunc ..if the patent has been granted to a person who is not entitled to it under this Act". Thus, a third person alternatively to the assignment can request the revocation of a patent if he or she can provide for appropriate proof in this respect.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

(Answer: If the applicant is Hungarian (either by citizenship or residence) and the application has been filed first in Hungary, then there will be a check carried out at the Hungarian Intellectual Property Office (HIPO) within 2 months from the filing date whether the invention needs to be regarded as special from the point of view of national security. It is important to note that the applicants do not have the obligation to file first in Hungary.)

a) No.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

As there is no obligation to file an application first in Hungary, there are no consequences either.

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

Our committee holds this definition basically sufficient. It would be preferred if the corresponding court decisions were easily and publicly available to provide guidelines.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There are no such requirements.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

As explained earlier such examination is carried out only if the application is filed first in Hungary and if the applicant(s) is(are) Hungarian. For partially foreign applicants this rule does not apply.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

The present rules are basically correct.

III.) **Proposals for harmonisation**

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

We consider that the definition according to the Hungarian Patent Act is correct: the inventor is who has created the invention.

In this definition all persons who have contributed to create the inventive step (or who has created the non obvious part of the invention) should be regarded as inventor(s).

Disclaimer: the persons who have contributed to the making of the invention with using their expectable skills (not exceeding the one that can be expected from the man skilled in the art) are not inventors irrespective for the amount of work done.

Suggestion: for avoiding later disputes it would be advisable to fix the percentual degree of contribution of all inventors.

- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

- a. *It is advisable to provide a way for correcting the inventorship.*
- b. *In case all parties agree (inventors and applicants) the correction should be made as a simple registration of the corrected figures according to the unanimous request of the concerned persons/entities. According to our view the correction of unintentional errors belongs to this group.*
- c. *The term "intentional" is not a correct expression. In case there is no common agreement between the concerned parties, a court should decide on this question. Concerning the time limit of such corrections (according to the majority opinion of the working committee: 1 year counted from the date of the decision that grants the patent. (Minority view: there is no need to define any time limit)*

Further comment: this correction cannot cover when an invention has been intentionally stolen from the rightful inventors. Such issues should be decided by the courts.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

There is no need in our modern age to protect national security with means built in the patent system. The preservation of national security should be provided by means outside the patent system.

- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

There is no need for such a system.

- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

Such a standard is not needed as the system is not needed.

- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

Such a standard is not needed as the system is not needed.

- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

In this regard a freedom of act is the best solution. The parties (including the inventors and the applicants) should have the power to define where to file first. It would also be advantageous, if these parties could mutually agree before the first filing on the place and law where any disputes concerning inventorship should be resolved and decided, and such a decision should be binding for all other countries where the invention has been filed.

Summary

Summary

The Hungarian Committee considers that there is no need for any examination of patent applications from the point of view of national defense, security or other interests. Similarly, there is no need for limiting the rights of the applicants in which country they wish to file their patent applications first or later claiming the priority of the previous applications(s), i.e. the system requiring in several countries a foreign filing licence has become obsolete. The aspects of national security and interests should be taken into account independent from the patent system. This is because in the IT age the transmission, availability and use of information is so broad and unlimited that patent cases constitute only a negligible fraction. If there are no such requirements, the multinational nature of the inventions (inventors and/or applicants) has no significance. The parties should freely choose in which country to file first. Errors in designating the inventors should be made correctable if all parties agree, and in case of non-agreement the decision should be made by a competent court. In multinational inventions it would be advisable if the parties would agree in advance on the country of the decision-making court and of the law to be applied.

It is difficult to define who qualifies as inventor, however, the best approach would be to consider the person(s) as inventor(s) who has (have) created the invention. Those who have not contributed to the inventive step and carried out work that falls within the due obligation of the man skilled in the art should not be qualified as inventors.

Résumé

Le Comité Hongrois considère qu'il n'est pas nécessaire d'examiner les demandes de brevet du point de vue de la défense nationale, de la sûreté nationale ou d'autres intérêts, s'agissant d'une institution sollicitant une autorisation ou une licence, si le propriétaire des droits souhaite déposer une demande de brevet dans des pays étrangers. Les aspects de la sûreté nationale et des intérêts nationaux devraient être pris en compte indépendamment du système des brevets. Cela est dû au fait qu'à l'ère de l'informatique la transmission, la disponibilité et l'utilisation de l'information sont tellement étendues et illimitées que les affaires liées aux brevets n'en constituent qu'une petite fraction. S'il n'existe pas une demande

en ce sens, la nature multinationale des inventions (des inventeurs et/ou des demandeurs) n'a pas d'importance. Les parties devraient pouvoir choisir librement le pays où elles déposent d'abord le brevet.

Les erreurs dans la désignation des inventeurs devraient devenir corrigibles si toutes les parties sont d'accord. En cas de manque d'un accord, la décision devra être prise par une cour compétente. Dans le cas d'inventions multinationales, il serait souhaitable que les parties se mettent d'accord au préalable sur le pays du tribunal qui exerce la juridiction ainsi que de la loi qui sera appliquée.

Il est cependant difficile de définir qui peut être considéré comme inventeur. La meilleure approche serait de définir les personnes qui ont créé l'invention. Il ne faudrait pas qualifier d'inventeurs ceux qui n'ont pas contribué au pas inventif et qui ont effectué un travail faisant partie des obligations d'une personne versée dans la technique du métier.

Zusammenfassung

Die ungarische Kommission steht auf dem Standpunkt, dass aus der Perspektive der Landesverteidigung, der nationalen Sicherheit oder anderer nationaler Interessen keine Notwendigkeit zur Prüfung von Patentanmeldungen besteht. Ebenso ist es nicht notwendig, die Rechte der Anmelder dahingehend einzuschränken, in welchem Land sie ihre Patentanmeldungen zuerst oder später mit Beanspruchung der Priorität einer früheren Anmeldung/früherer Anmeldungen einreichen möchten. D.h. das System, dass in einigen Ländern eine ausländische Einreichungslizenz verlangt wird, ist überholt. Die Aspekte der nationalen Sicherheit und Interessen sollen unabhängig vom Patentsystem Berücksichtigung finden. Grund dafür ist, dass im Informationszeitalter die Übertragung, die Verfügbarkeit und die Nutzung von Informationen so ausgedehnt und unbegrenzt ist, dass Patentangelegenheiten nur einen unbedeutenden Anteil ausmachen. Gibt es keine solchen Anforderungen, ist der multinationale Charakter von Erfindungen (Erfindern und/oder Anmeldern) nicht von Bedeutung. Die Beteiligten sollen frei entscheiden, in welchem Land die erste Anmeldung erfolgen soll.

Fehler bei der Benennung der Erfinder sollen korrigierbar sein, wenn alle Beteiligten einverstanden sind. Wenn kein Einverständnis vorliegt, soll ein zuständiges Gericht die Entscheidung fällen. Bei multinationalen Erfindungen ist es ratsam, wenn sich die Beteiligten im Voraus über das Land des entscheidenden Gerichtes und der anzuwendenden Gesetzgebung einigen.

Es ist schwierig zu definieren, wer als Erfinder eingestuft werden kann. Der beste Ansatz für diese Entscheidung ist, dass die Person(en) als Erfinder gelten, die die Erfindung geschaffen hat/haben. Diejenigen, die nicht zur erfinderischen Tätigkeit beigetragen haben und Arbeit geleistet haben, die zum Pflichtwissen eines Fachmanns gehört, sollen nach einer solchen Arbeit nicht als Erfinder gelten.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Independent member 1

Report Q244

in the name of the Independent member 1 Group
by Crystal CHEN, Thomas TSAI and Candy CHEN

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The Taiwan Patent Act stipulates the basic principle regarding inventorship. The corresponding statutes and provisions are provided below.

Article 5 of the Taiwan Patent Act prescribes that the inventor(s), creator(s), or designer(s) is entitled to file a patent application for his invention/utility model/design. According to this article, the inventor(s) is inherently endowed with the right to apply for a patent.

Article 7 of the Taiwan Patent Act prescribes that in the circumstance of inventions made for hire, although the right to apply for a patent and the patent right are vested in the employer or the fund provider, the inventor(s) concerned is entitled to a right to show his name for the inventorship.

Paragraph 5 of Article 96 of the Patent Act prescribes that when the inventorship of a patent is infringed, the inventor(s) concerned may request to have his/her name indicated or take other measures necessary to recover his/her reputation regarding the inventorship.

a. If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Taiwan Patent Act does not exclude the inventorship of person who has made conceptual contributions to the substantive features of the invention. Therefore in this case, both person A and person B, or either one of them, can be considered as the inventor(s) because they are supposed to take the efforts to make the invention. Neither the citizenship of the inventor(s) nor the jurisdiction in which the invention is made is relevant to the inventorship of a patent application.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

No, the inventorship is determined based on the entire invention and the patent application as a whole. There is no break down of the inventorship on a claim-by-claim basis, or the drawings, or the examples of embodiments.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, the citizenship of the inventor(s) is irrelevant to the inventorship of a patent application.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, the residency of the inventor(s) is irrelevant to the inventorship of a patent application.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Yes, the inventorship of a patent application can be corrected after the filing date. However, such correction will affect the establishment of the original filing date, such that when the inventor was person A but then changed later to person B, the filing date will be changed to the date when person B is corrected as the inventor.

There is no time limit for the correction of the inventorship of a patent application, or an issued patent. However, the requirements for the change of the inventorship of a patent are stated below:

- To add inventors, the supporting document for the added inventor(s) and the letter of consent for adding the inventor(s) executed by all of the inventors after addition shall be provided.
- To delete inventor(s), a statement indicating that the inventor(s) to be deleted is not the exact inventor(s) to the invention shall be provided.
- For correction of the inventorship, the reason for incorrect recitation (e.g. translation or typographical errors) and the corresponding supporting documents shall be provided.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

The wrongfully recorded inventorship will not jeopardize the enforceability of an issued patent. According to the Patent Act, the incorrect inventorship is not one of the available grounds for patent invalidation, regardless the incorrect inventorship was recorded intentionally or unintentionally. The legal liability for the actual inventorship shall fall on the applicant of the patent application.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

No, there is no restriction that a patent application has to claim an invention made, as a whole or in part, to cover all or any specific field of technology, in Taiwan, nor any requirement that a foreign filing license for filing patent applications outside Taiwan is needed.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

No, there is no legal requirement or restriction for an invention made, or at least in part, in Taiwan shall undergo a secrecy review first, before filing a patent application in another country.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

Taiwan Patent Act stipulates that an inventor, or his assignee and successor, is entitled to file a patent application. But the entitlement to apply may be other persons when agreed or stipulated to the otherwise. Beyond that, there is no further provision or guidance as to who else should be named as the inventor(s) of a patent application, or which part of the invention shall belong to the specific inventor(s). Nevertheless, it is always optimistic to have the law prescribing definite rules for the inventorship to a patent, so that the patent applicants or inventor(s) may have a clear guidance to comply with and state the exact inventorship accordingly.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Our patent law has no first filing requirement. This question is not applicable in Taiwan.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Our patent law has no secrecy review requirement. This question is not applicable in Taiwan.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Our patent law allows multinational inventorship to a patent application.

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.
- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).
- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.
- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.
- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.
- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.
- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Indonesia

Report Q244

in the name of the Indonesia Group
by Cita CITRAWINDA and Cita CITRAWINDA

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

There is no specific provision on the type or scope of contribution to the Invention. The article only stipulates "**acting together implementing an idea ...**" and "**... produced jointly...**" However, based on the situation above, according to Indonesian Patent Law, both parties may agree they are the Inventors; or Person A can be considered as the Inventor since person A directs the efforts of Person B, unless agreed otherwise by Person A; and Person B considered as the Inventor (*Article 1 of Patent Law of Republic Indonesia No. 14/2001: (3) Inventor is a person or several persons acting together implementing an idea poured in an activity resulting in an invention.*

Joint of the inventorship point of view:

Article 10 point (2) of Law No. 14/2001 regarding Patent:

"If an Invention is produced jointly by several persons, the right on the Invention shall belong to the relevant Inventors".

Article 11 of Patent Law of Republic Indonesia No. 14/2001:

"Unless proven otherwise, those who are firstly declared as the Inventor in the Application shall be deemed to be the Inventor".

Based on Indonesian Patent Law, No detail explanation about definition of joint inventorship/multinational invention which includes: first filing requirement, foreign filing licenses nor secrecy review.

No definition sufficient to provide patent applicants with clear guidance about multinational invention.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Inventorship is defined based on the patent as a whole.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

yes

Article 24 para (2) letter c, requires applications to specify the full name and nationality of the Inventor (s).

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

There is no requirement on where the Invention was made.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Amendment of filing particulars, including inventorship is possible before grant of the patent, by filing a request for amendment and payment of the relevant processing fee and supported by a Statement of Change of Inventorship.

Article 23 para (1) of Patent Law of Republic Indonesia No. 14/2001 stipulates that:
"If an application is filed by a person other than the Inventor, the Application must be furnished with a statement with adequate supporting evidence that he is entitled to the said Invention".

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

There is no specific provisions regulating this situation. However, the possible consequences are that the true inventor may submit an objection regarding the inventorship supported by strong evidence showing that he is the true inventor.

A patent issued from such an application can be invalidated through Commercial Court. It is matter if the error was intentional.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

- a. If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b. If yes, describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c. If yes, describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Policy Considerations and Proposals for Improvements of the Current Law

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

The Indonesian Patent Law provides a broad definition of inventorship, with no distinction in regards to the scope of contributions. Hence, in the case of several persons are involved in the process, all of them shall be named as Inventors.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Non applicable

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Non applicable

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Multinational inventorship in a Patent application is possible in Indonesia.

III.) **Proposals for harmonisation**

- 12) **Is harmonisation in this area desirable?**

no

It is unforeseen within the next five years.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

If an application is filed with a wrong inventor, the Application must be corrected by furnishing with a statement supporting evidence that he is entitled to the said Invention (for unintentional error) during the pendency of the application.

If the error is intentional, the true Inventor may file a lawsuit to the Commercial Court to have his name included in the Patent Certificate (violation of moral rights) during the pendency of the application or after patent is granted.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

In the case of multinational inventions, the patent application claiming inventions might be filed first in any of the countries agreed by multinational inventors.

- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

For those inventions which relate to certain technology areas that are considered national secrets, or if it otherwise impacts national security, prior to a patent application being filed in another country, should undergo a secrecy review. Failure to comply with this requirements may result in loss of patent rights.

- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

Not appropriate

- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

Failure to comply with a first filing requirement, the Applicant may submit appropriate documents with payment of fine.

Failure to comply with a security review requirement, may result in loss of patent rights.

- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Israel

Report Q244

in the name of the Israel Group
by Eran BAREKET

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

In Israel, patent rights are regulated by the Patents Act, 5727-1967 (**"the Patents Act"**). The Patents Act does not provide a definition for the term "inventor"^[1], which has therefore resulted in the term's development by case law. However, to date, no binding Supreme Court precedent has been set that defines the term or demonstrates how the term ought to be defined. Guidance in this vein is drawn from a District Court's decision on an appeal over the Israeli Patents Registrar (hereinafter: **"Registrar"**) in the case of CA 49328-10-10 *Shahal Telemedicine Ltd. v. Eli Oren* (2011) (hereinafter: **"Shahal"**). In the *Shahal* case, the court applied the approach adopted by and the precedents used in U.S. courts^[2] and that of the U.K. House of Lords (as it was then)^[3], after holding that they were in line with basic principles of the Patents Act, and **ruled that an inventor is a person who contributed to the conception of an invention (namely, the inventive concept underlying the invention) as distinguished from a person who merely contributed to the subsequent development of the invention (namely, to the invention's reduction to practice).**

To establish whether such contribution had been made, the court ruled that the essence of the invention must first be defined. The court further held that when it comes to defining the essence of the invention, the overall general impression of the patent application should be given primacy, without giving the claims priority over the specification^[4]. In this case, both person A and person B would have to demonstrate their contribution to the conception of the invention in order to be considered inventors.

In this context it should be noted that, while in the *Shahal* case the court did not directly or explicitly address the question of joint inventors *per se*, it did quote from the **Ethicon** case stating that "[each] joint inventor must generally contribute to the conception of the invention", and by having done so, invited future courts to cite this reference when confronted with cases involving joint inventorship.

Footnotes

1. [^] It should be further noted that the Patents Act does not define what an "Invention" is nor at which point in time the invention is conceived.
2. [^] The court reviewed *Murdock Webbing Company, Inc. v. Dalloz safety, Inc.*, 213 F.Supp. 2d 95, 95 (2002) and several cases that preceded it, *inter alia*, *Edison v. Foote*, 1871 C.D. 80; *Burroughs Wellcome Co. v. Barr Laboratories Inc.*, 40 F.3d 1223 (1994); *Oren Tavory v. NTP., Inc.*, 297 Fed. Appx. 976 (2008); *Ethicon v. US Surgical Corporation*, 135 F.3d 1456, 1460 (1998) ("*Ethicon*").

3. [^](#) *Yeda Research and Development Co. Ltd. v. Rhone Poulenc Rorer International Holdings Inc.* [2008] RCP 1.
4. [^](#) *Relying on the Supreme Court's judgment in CA 407/89 Zuk Or Ltd. v. Car Security Ltd.* (1994).

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

As stated above, the court in the *Shahal* case found that the inventive concept, contribution to which is necessary to be considered an inventor, should be defined based on the entire patent application, without the claims having priority over the specification. The prevalent opinion of the practitioners is that when an invention **disclosed** is **not claimed**, the inventor of the disclaimed invention is not entitled to be named as an inventor. However, there is no express and clear precedent to that effect.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

There is no limitation as to the citizenship of the inventor^[1].

Footnotes

1. [^](#) *There is, however, legislation external to the Patents Act that is not specific to intellectual property or patents: namely, the Commerce with the Enemy Ordinance, 1939. This Ordinance provides that in order to prevent payment to an enemy and in order to maintain possession of enemy property, the Finance Minister is permitted to appoint an executor over property in Israel belonging to a citizen of or a company incorporated in a country declared to be at war with Israel, and, inter alia, provide the executor with the authority to seize property and maintain possession thereof until said country is no longer at war with Israel.*

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

The question of whether the law of inventorship depends on where the invention was made is not regulated by the Patents Act nor has it been raised in courts.

In one case^[1] an Israeli Court issued an anti-suit injunction and held that an Israeli Court has jurisdiction to adjudicate a dispute concerning inventorship and ownership of an invention claimed in a U.S. patent that was allegedly based on trade secrets misappropriated in Israel. The court held that the forum that should try the dispute is the forum that has the closest connection to the case at hand (based on the pertinent factors). However, the court did not decide, in its said decision, which substantive law should be applied, whether Israeli law or U.S. law.

Footnotes

1. [^](#) *CC 292/03 Weiss v. Zumeris (TA Dist., 2004); approved - CA Zumeris v. Weiss (Sup.Ct., 2004).*

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

There is no obligation in the Patents Act, to state the name of the inventor(s). However, inventorship can be mentioned on the application and can be corrected after filing in one of two ways:

- **Section 39** of the Patents Act provides that an inventor of an invention subject of a patent application, or a surviving relative thereof, can demand that his/her name be mentioned as an inventor.
- **Section 40** provides that if an inventor or a surviving relative demanded that his/her name be mentioned, while not owning the invention or the patent, the Registrar will give notice to the owner thereof to the patent or invention owner, and if an opposition was filed with respect thereto, to all parties of that proceeding.

Section 80 of the Patents Regulations provides that the Registrar will give said notice as soon as possible after filing the motion; Section 81 provides that an objection to such motion can be filed within one month of receiving the notice and all rules and regulations that apply to filing an opposition to a patent shall apply. If an objection is filed, the Registrar shall decide on the request after hearing statements from all concerned parties.

The Patents Act does not provide a specific procedure for removing a name of a person erroneously named as inventor. However, it seems that general provisions that apply to amendment of errors in the Patents Registry could be applied to this end as well.

There is no provision in the Patents Act or its regulations placing a limit on the time allotted for filing a motion to list a person as an inventor. **Section 80** of the Patents Regulations^[1] states that if the motion is filed within one month of publication of the acceptance, the Registry, patent's specification and certification will display the name of an inventor. However, the language of the provision does not disallow the motion from being filed after one month has passed.

Footnotes

1. [^] *Patents Regulations (Office practice, Rules of procedures, Documents and Fees), 5728-1968 (hereinafter: "the Patents Regulations")*.

5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

As mentioned above, there is no obligation under Israeli law to mention an inventor(s)'s name on a patent application. Thus it appears that an error *per se* in the stated inventorship yields no consequences.

It could be argued that if one were to be able to show that an error was done in bad faith, with the intention to deceive, there should be consequences affecting the patent (e.g., rendering the patent unenforceable); however, there is no precedent to that effect^[1].

Footnotes

1. [^] *We do not address consequences under other non-patent legislation. For example, defrauding the patent office with respect to the inventorship and ownership of the patent in order to conceal assets or avoid taxes may result in criminal liability.*

6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

Patent applications in certain technical areas and/or where the invention was invented by a state employee may not be filed outside of Israel unless otherwise permitted or stipulated.

The arrangements concerning secrecy reviews and first filing requirements are provided in part one of Chapter F of the Patents Act, which deals with the powers required for maintain the security of the country.

As explained below, a duty of first filing may result from:

- (1) with respect to inventions in certain fields of technology - Citizenry, residency, owing a duty of loyalty to the State; or
- (2) regardless of the invention's field of technology - the applicant being a State employee.

Field of technology:

- **Section 98** of the Patents Act prohibits foreign first filing of patent applications claiming an invention in the areas of weaponry, ammunition, or others of military value as well as applications determined by the Minister of Defense (hereinafter: "**MoD**") to be subject to a "secrecy review" in accordance with Section 95 of the Patents Act (see further detail in the answer to question (7) below).
- **Section 103** of the Patents Act prohibits foreign first filing of patent applications claiming an invention in nuclear-related technology.

Who is the applicant?

- The field of technology first filing requirement (Sections 98 & 103 above) applies to applicants who are one of the following: an Israeli citizen, permanent resident of Israel, or a person who owes a duty of loyalty to the state (which applies to both individuals and companies). If none of these apply, then the patent application may be filed abroad.
- **Section 138** provides that State employees and similar persons^[1] are required to file patent applications for any of their inventions first in Israel, regardless of the field of technology.

Miscellaneous

Multinational inventions: The Patents Act does not expressly provide that the first filing requirements apply only to inventions conceived in Israel. Literally read, the language of the law is capable of being interpreted as applying to inventions conceived abroad.

Other Dissemination: It should also be noted that the Patents Act only deals with filing an application and not with its assignment or publication. The rules governing assignment and publication (specifically with respect to censorship) are external to the Patents Act and are not specific to intellectual property or patents. For example, The Defense Export Control Law, 5766-2007, which, amongst others, prohibit conducting a defense marketing activity^[2], exporting of defense equipment^[3], transfer of defense know-how^[4] through any means or provision of a defense service, without first obtaining the requisite approvals.

Footnotes

1. [^] The list is provided in section 137: a State employee, a soldier, a policeman, an employee of several state-owned agencies, or any other person receiving a salary from such agencies who invented an invention during his/her employment or service or within a year following its termination.
2. [^] An activity aimed at promoting a defense export transaction, including brokering activity towards a defense export transaction.
3. [^] Missile equipment, combat equipment and controlled dual-use equipment (namely, materials and equipment initially intended for civilian use and which are also compatible for defense use).
4. [^] Information that is required for the development or production of defense equipment or its use, including information referring to design, assembly, inspection, etc.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

Subsections (1) and (2) of section 98 provide that applications specified therein (see answer to question (6a) above), including applications subject to secrecy review according to Section 95, may be filed abroad only if;

(1) the applicant was first granted a written permission from the MoD; or

(2) if the applicant first filed an application in Israel and six months have lapsed from the filing date of the Israeli application and the MoD did not issue a secrecy order or such order has been issued and is no longer in force.

It should be noted, that according to Section 95 (to which the provisions of subsections (1) and (2) of section 98 apply) the MoD must render a decision with respect to applications subject to secrecy review within four months. However, the provisions of subsection 98(2) prescribe a six months waiting period from the filing date.

The same procedure, specified in subsection (1) and (2) of section 98, applies with respect to applications where first filing is required according to section 103 (nuclear research), however permission will be granted from a Minister designated by the government, who is currently the prime minister of Israel.

Section 138 provides that civil servants cannot file a patent application outside of Israel unless permission to do so has been granted by a Civil Service Commissioner or another person certified to do so, or six months have lapsed from having given notice of intent to file such application to a Civil Service Commissioner, and it has not been determined that the rights in the invention were assigned to the state or a factory or an institution of the state in which he worked.

The cost of obtaining a foreign filing license is not specified in the Patents Regulation or any other related secondary legislation, and is subject to the discretion of the appropriate office.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

We are not familiar with cases that allowed for the obtaining of a foreign filing license retroactively.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

As noted above, the Patents Act might apply to inventions conceived by Israeli citizens residing outside of Israel. It follows that patent applications claiming an invention that was made jointly in Israel and with another inventor in another country are also subject to first filing requirements. The nationality of the patent owner does not affect the answer to this question.

This state of the law may result in inventors finding themselves in a "Catch-22" scenario. For example, if the invention was conceived by two inventors, an Israeli inventor and a U.S. co-inventor, and the laws of each country require that the invention be filed first in their country, it is not possible to file in **any country** without violating the first filing requirement. The nationality of the inventors does not seem to play a role here.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

no

It seems that the Patents Law does not prohibit this. Whether or not external laws, such as the Defense Export Control Law, are violated depends of the factual circumstances of the case.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

Violation of these provisions is a criminal offense. Section 193(a) states, *inter alia*, that failing to comply with the provisions of sections 94, 98, 99, 103, 137 and 138 is punishable by incarceration for up to two years or by receiving a fine. Criminal liability requires criminal intent (*mens rea*). It would therefore seem that whether the error was intentional or inadvertent is consequential.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Yes.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

Section 95 of the Patents Act empowers the MoD, if it deems necessary, to instruct the Registrar to provide a person designated by the Minister with copies of patent applications of certain types. It also authorizes the Registrar to provide the Minister with copies of applications whose contents relate to or concern the defense of the country or a defense secret. This empowerment allows the MoD to determine whether a secrecy order should be issued in respect of these applications (in accordance with the provisions of section 94; see below).

The list with the types of applications that the MoD may request from the Registrar, or copies thereof, is kept confidential and remains not published.

The MoD must decide within four months whether applications brought before him/her fall within with the purview of Section 95; and if no decision is made, or the allotted time has lapsed, no action will be taken by the Patents Office in respect of the application other than confirmation of its filing.

Section 94 of the Patents Act provides that the MoD is permitted, for purpose of defense of the country including protection of its defense secrets, to issue an order which: (1) instructs the Registrar to refrain from or postpone performing a certain action that it is required/entitled to do by law with respect to an application; (2) prohibits or limits the publication or disclosure of information of an application or information disclosed therein.

According to the provisions of **section 99** the same procedure prescribed in section 94 applies to nuclear related inventions (however, the power to do so is vested in a Minister designated by the government, who is currently the prime minister of Israel).

Section 96 allows the applicant, if he/she wishes, to appeal a secrecy order while it is in force, before a certain tribunal. If there is a change in circumstances, the applicant may lodge an additional appeal.

In addition, the MoD is required (as a rule of administrative law) to periodically review, at its own initiative, the necessity of continuing to maintain the secrecy order.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

As regards the applicant, see answer to question (6f) above.

As regards the State, in one instance the State was ordered to compensate an applicant for failing its duty to periodically review the necessity of continuing to maintain the secrecy order.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

As mentioned in the answer to question (1) above, the Patents Act does not provide a definition for the term "inventor" or "inventorship" and there is a paucity of case law to draw clear guidance from.

We believe that it should be clarified or otherwise determined that when an invention **disclosed** is **not claimed**, the inventor of the disclaimed invention is not entitled to be named as an inventor.

Further complication arises simply due to the fact that the process of invention and innovation is a complicated process in itself, and it is difficult to determine whether a contribution made during the process is sufficient to award a certain person with the title of "inventor". However, we do **not** recommend providing a detailed definition of the term "inventorship". At this stage, the term would be best developed by case law.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Yes. As explained above, certain provisions in the Patents Act require first filing with respect to specific areas of technology and specific personnel; however, the Patents Act does not provide a mechanism designed to reconcile contradictory first filing requirements in other jurisdictions. Consequently, one of the inventors of a multinational invention, which is subject to two sets of laws, will necessarily find himself in fault.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

The same answer as the answer to question 9 above applies, as the Patents Act does not provide a mechanism designed to reconcile contradictory secrecy review requirements in other jurisdictions nor does it regulate a situation in which an inventor is required to file a request to obtain a foreign filing license while the application might be subject to a secrecy order.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Yes.

In addition to creating a mechanism for reconciling contradictory first filing requirements, there should also be a mechanism designated to determine which law would apply to the application at hand.

For example, if an invention is filed in Israel by two inventors, one from Israel and one from Country X, and say the term of "inventorship" is defined differently in the two countries (for example, under Israeli law, both parties are co-inventors, whereas in Country X's law, only the Country X inventor is an inventor), then the questions that arise are: Which law do we apply? What would be the criteria in applying such law?

We believe that the law governing multinational inventions should be the law of the country in which it was conceived and in cases where the place of conception is not clear, inventorship should be determined based on the law of the country in which the first priority application was filed.

As mentioned above, there is no time period for filing a motion to mention an inventor's name. Other sections of the Patents Act provide that the statute of limitation does **not apply** to, for example, filing a motion to revoke or amend a Patent Term Extension order (Section 64(11)). We believe the same rule should apply with respect to filing a motion to mention an inventor's name.

III.) **Proposals for harmonisation**

12) **Is harmonisation in this area desirable?**

yes

Due to the effects of globalization on intellectual property rights, in particular, the international nature of the present-day market and the extent of collaboration between different corporations, which often results in multinational inventions, there is a need to harmonize certain aspects of the law of inventorship.

By way of clarification of the foregoing, we note that the most pressing need we see is a need for harmonization of the rules guiding the choice of applicable inventorship laws (our proposal in question 11 would also serve as an appropriate international standard). Such legal harmony will provide the innovative industry with due certainty regarding the inventorship (and consequently ownership) of inventions. We do not see a pressing need for harmonization of substantive inventorship law.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

The standard developed under U.S. law is appropriate.

14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

We suggest that it should be possible to correct an error in the identification of inventorship (except in cases of intent to mislead) in a simple procedure, which is not time barred.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

With respect to questions 15 (first filing requirements), 16 (secrecy review requirements) and 17 (obtaining a foreign filing license), it would hypothetically be beneficial if there would be a mechanism that would allow applicants of multinational inventors swiftly to obtain a pre-ruling accepted by all relevant countries, regarding the country in which first filing would be made. On a practical level, we doubt that this is achievable.

- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

See answer to question 15 above.

- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

See answer to question 15 above.

- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

Discretion in this matter should be left with the country that its law would apply.

- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

None.

Summary

The term "inventorship" is not defined in the Israeli Patents Act. It has thus been developed by case law, according to which an inventor is a person who contributed to the conception of an invention. Case law has further determined that the inventive concept should be defined based on the entire patent application, without the claims having priority over the specification. However, we believe that it should be clarified or otherwise determined that when an invention **disclosed** is **not claimed**, the inventor of the disclaimed invention is not entitled to be named as an inventor.

The Israeli Patents Act sets out first filing requirements which may result from: (1) Who is the applicant? And (2) What is the field of technology? In addition, Israeli patent applications are subject to a secrecy review. The Patents Act does not provide a mechanism designed to reconcile similar requirements in other jurisdictions. We believe that the law governing multinational inventions should be the law of the country in which it was conceived and in cases where the place of conception is not clear, inventorship should be determined based on the law of the country in which the first priority application was filed. Also, we believe it would be beneficial if there existed a mechanism that would allow applicants of multinational inventions to obtain a swift pre-ruling, accepted by all relevant countries, regarding the country in which first filing would be made.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Italy

Report Q244

in the name of the Italy Group
by Lamberto LIUZZO, Stefania BERGIA, Filippo FERRONI, Enrico GATTI, Fernanda SARZI-SARTORI, Renato SGARBI, Alessandro SPINA and Stefano VATTI

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Inventorship in such situations must be evaluated on a case-by-case basis. The Italian case law in this regard is rather scant.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The Italian patent law establishes that the scope of protection is defined by patent claims. However, there is no legal basis allowing to define inventorship on a claim-by-claim basis, nor on any other specific part of the patent/patent application.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The Italian Industrial Property Code does not provide a definition of inventorship. Hence, no answer can be given to this question.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

As explained above, the Italian Industrial Property Code does not provide a definition of inventorship. Hence, no answer can be given to this question.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

According to article 119(2) of the Italian Industrial Property Code, an incomplete or erroneous designation may be corrected only by filing a request accompanied by a declaration of consent of the person previously designated, and if the request is not filed by the applicant or the owner of the patent or registration, also by a declaration of consent of that party. This article prescribes no time limits.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

According to article 118(1) of the Italian Industrial Property Code, whoever is entitled to do so under this Code may file an application for registration of a patent application.

Article 118(2) states that if by a final judgment it is determined that the right to registration of the patent belongs to a person other than the one who filed the application, such person may, if the industrial property title has not yet been issued, and within three months of the judgment becoming final:

- a) take over the application for the patent or registration in his own name, assuming the capacity as the applicant for all purposes;*
- b) file a new application for a patent or registration whose starting date, to the extent that its content does not exceed that of the first application or refers to an object that is essentially identical to that of the first application, dates back to the date of filing or priority of the initial application, which in any case ceases to have effect; in the case of a trademark, file a new application for registration, whose starting date, to the extent that the trademark contained in it is essentially identical to that of the first application, dates back to the date of filing or priority of the initial application, which in any case ceases to have effect;*
- c) obtain the rejection of the application.*

According to Article 118(3), if the patent has been issued or the registration made in the name of a person other than the entitled party, the latter may do one of the following:

- a. obtaining the transfer of the patent or certificate of registration to his name by way of a judgment, starting on the date of the filing;*
- b. claiming the nullity of the patent or registration granted to the person who was not entitled to it.*

According to Article 118(4), after two years from the date of publication of the granting of the patent for an invention, utility model, new plant variety, or from the publication of the granting of the registration of a topography of semiconductor products, without the entitled person having made use of one of the rights under paragraph 3, nullity may be claimed by whoever has an interest to do so. This provision does not apply to registrations of trademarks and designs.

A possible intentional error has in principle no influence on the procedure of Article 118.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

no

The area of technology is not relevant in the frame of Article 198 of the Italian Industrial Property Code.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

According to Article 198(1) authorization of the Ministry of Economic Development may be given in the form of a foreign filing license. A petition for a foreign filing license must identify the Applicant and indicate the title of the invention. An abstract of the invention with possible drawings, as well as a power of attorney and a list of the inventors shall be attached to the petition.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

The Italian Industrial Property Code does not provide any indication in this regard.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

If an inventor of the team or group of inventors is resident in Italy, the first patent application shall be filed with the Italian Patent Office as established by the Article 198(1) of the Italian Industrial Property Code. Alternatively, a foreign filing license shall be requested. The nationality of the patent owner is not relevant.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

no

The filing of a foreign filing license in another country does not affect the provisions about the national filing of Article 198(1) of the Italian Industrial Property Code.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

Unless the act constitutes a more serious crime, violation of the provisions of Article 198(1) shall be punished with a fine or with detention. If violation is committed when authorization has been denied, detention of not less than one year shall apply.

- 7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

See under question 6(a)

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

See under question 6(b)

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

See answer to question 6(f)

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

As explained above, the Italian Industrial Property Code does not provide a definition of inventorship. Hence, no answer can be given to this question.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

In our view, the provisions of the Italian patent law are appealing for foreign inventors, because no binding provisions exist for inventors that are not resident in Italy.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

In our view, the provisions of the Italian patent law are adequate and the request of a foreign filing license is a quick, effective and inexpensive procedure for filing patent applications abroad.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

In our view, there are no other aspects of the Italian patent law that should be improved.

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

Harmonization of provisions ruling inventorship of multinational inventions is desirable.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

In our view and in line with the approach of the European Patent Convention, a definition of inventorship is not strictly necessary. However, a possible definition of inventorship should consider who conceived the invention and reduced it to practice.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

In our view, the Italian Article 119 of the Italian Industrial Property Code provides a good standard for correction of inventorship after a patent application is filed. See the answer to question 4.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

Provided that the national defence of a country requires that a first filing application be evaluated by the Ministry of Defense of that country, the possibility of obtaining a foreign filing license should be available so as to facilitate and promote the activity of international R&D teams.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

In our view the Article 198(1) of the Italian Industrial Property Code provides a good standard for national first filings, also considering that, according to Articles 149 and 151 of the Italian Industrial Property Code, the same provisions also concern first filings of European and international patent applications.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

In our view, the present Italian procedure for obtaining a foreign filing license provides a good standard. As explained in our answer to question 6, a petition for a foreign filing license should identify the Applicant and indicate the title of the invention. Moreover, as established by Article 149(2) of the Italian Industrial Property Code, an abstract of the invention with possible drawings, as well as a list of the inventors should be attached to the petition. A power of attorney should also be filed if the request is made by a professional representative on behalf of the applicant.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

In our view, the whole provisions Article 118 of the Italian Industrial Property Code provide a good standard. See the answer to question 5.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

Summary

The Italian Industrial Property Code does not provide a definition of inventorship.

An inventor has a moral right to the invention and shall be mentioned in the patent application. The Italian Patent Office does not check correctness of the indication of owner and assumes that the indication is correct. Inventorship of a patent application may anyway be corrected after the filing date and reliefs are available to claim entitlement to file an application for registration of a patent application when the owner's rights have been violated.

The Italian patent law provides no legal basis allowing to define inventorship on a claim by claim basis, nor on any other specific part of the patent/patent application.

Persons residing in the territory of the Country may not, without the authorization of the Ministry of Economic Development, file their patent applications only with the offices of foreign Countries or the European Patent Office or the International Office of the World Intellectual Property Organization as the receiving office, if those applications relate to objects that could be useful for the defense of the Country.

Violation of these provisions shall be punished with a fine or with detention.

An authorization of the Ministry of Economic Development may be obtained in a short time in the form of a foreign filing license. The request of a foreign filing license is a quick, effective and inexpensive procedure for filing patent applications abroad.

Harmonization of provisions ruling inventorship of multinational inventions is desirable. In this regard, the provisions of the Italian patent law are appealing for foreign inventors, either alone or working in a, possibly international, team, because no binding provisions exist for inventors that are not resident in Italy.

The possibility of obtaining a foreign filing license should be available so as to facilitate and promote the activity of international R&D teams.

As far as entitlement and correction of inventorship are concerned, the Italian Industrial Property Code provides good standards after a patent application is filed.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Japan

Report Q244

in the name of the Japan Group
by Takeo NASU, Yuzuru OKABE, Atsushi AOKI, Makoto ASANO, Katsuomi ISOGAI, Kan OTANI,
Kay KONISHI, Sumiko KOBAYASHI, Hideki TAKAISHI, Shigeki TAKEUCHI and Kinshiro TSUKUDA

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

According to judicial precedents, "inventorship" is considered as stated above. That is, if person A [ii] conceived of the means for solving the problem, he/she is highly likely to be considered to be an inventor. [i] If person A only presented the problem, he/she may be considered to be an inventor if the problem itself is a feature of the invention. For example, in "Tokyo District Court decision dated 31 Jan 2006, *Hanrei Jihou* No. 1929, at 92," the court ruled that "the idea in question that has not gone through the aforementioned experiment is a mere research theme ..., and it cannot become the invention in question." Based on this ruling, the court denied the inventorship of the plaintiff. Moreover, in "Tokyo District Court decision dated 27 Feb 2007, *Hanrei Times* No. 1270, at 367," the court ruled as follows: The plaintiff "committed nothing more than general or comprehensive administrative actions, and there are no circumstances based on which the plaintiff should be considered to have given specific directions and have actually participated in the aforementioned creative act beyond said administrative action" Based on this ruling, the court denied the inventorship of the plaintiff. Incidentally, the fact of person A's being located outside Japan has no relation because the place of invention has no relation under the Japanese law (however, there is a de facto problem that person A cannot get involved in experiment, etc. as he/she is located outside Japan).

Person B is highly likely to be considered to be an inventor [ii] if he/she conceived of the means for solving the problem even if person A gave directions to person B. [iii] If person B only confirmed that the problem is solved, he/she is not considered to be an inventor in many cases. However, person B tends to be considered to be an inventor in areas in which effects are poorly predictable, such as the chemical area. For example, in "Tokyo District Court decision dated 23 Mar 2007 (2005 (Wa) No. 8359)," the court found the inventorship of such a person. If both person A and person B are inventors, they are joint inventors.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

Under the Japanese law, inventorship is determined on a claim by claim basis. Therefore, if a claim is deleted, changed or restricted, etc. in the amendment or correction process, inventorship is changed ex-post facto in relationship to the relevant claim.

For example, "Tokyo District Court decision dated 26 Jan 2006, *Hanrei Jihou* No. 1943, at 85" was rendered in a case demanding remuneration for an employee invention. In this case, the court held that "the inventorship and the rates of contribution of joint inventors should be found with respect to each claim at the time of filing of the application or at the time of laying open of the application and each claim at the time of registration (if any correction is made, each claim after the correction)."

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No (Not provided under law).

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No (Not provided under law).

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

An amendment of proceedings can be made only while the application is pending (Article 17, paragraph (1) of the Patent Act).

It is necessary to submit written oaths of persons who are inventors before and after the amendment (oaths of all persons who are stated in the Inventor(s) column in the application before the change to the effect that the person is not a true inventor and oaths of all persons who are to be stated in said column after the amendment to the effect that the person is a true inventor) (21.50, 126.70, Formality Examination Manual).

There is no law concerning such amendment made after the registration of establishment of a patent right.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

An error in the stated inventorship itself does not become an obstacle to enforcement of a patent right. As an error in the stated inventorship does not serve as a ground for invalidation, a defense of invalidity (Article 104-3 of the Patent Act) is not directly established based on such an error.

However, if such an error is alleged to constitute a misappropriated application or a violation of the provisions on joint applications (Article 123, paragraph (1), item (ii) of the Patent Act), a defense of invalidity (Article 104-3 of the Patent Act) is established because such application or violation serves as a ground for invalidation. Consequently, it is impossible to enforce the relevant right.

In addition, if such an error is alleged to constitute a misappropriated application or a violation of the provisions on joint applications, assignment of the whole or part of the relevant patent (the right to obtain a patent) may be required (Article 74 of the Patent Act).

Furthermore, in the context of an actor who enforces the right to demand remuneration for an employee invention, the stated inventorship is erroneous, and there may be the cases in which a true inventor makes a claim (Article 35 of the Patent Act).

Under the Japanese Patent Act, whether or not an error in the stated inventorship was intentional is considered not to affect the conclusion. In Japan, there is no punitive provision.

In "IP High Court decision dated 29 Mar 2007, *Hanrei Times* No. 1241, at 219," the court held as follows: In relation to a company that is the applicant, "the act of the defendant in the first instance of asserting that both of the aforementioned persons are not inventors in an action for remuneration for an employee invention filed by the plaintiff in the first instance, who was considered to be the inventor, is deemed as an act of publicly asserting a matter that differs from the content, which was stated pursuant to Article 36, paragraph (1), item [ii] of the Patent Act and submitted to the Japan Patent Office that is a state organ. Such act goes against good faith and is not permissible unless there are special circumstances (estoppel)." However, in many judicial precedents, the court finds inventorship based on evidence according to free conviction without being biased by the inventorship stated in the application.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

No (Not required under law).

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

no

No (Not required under law).

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) **Policy considerations and proposals for improvements of the current law**

8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

There is no definition of inventorship in the text of law. Inventorship is defined by case law. According to case law, there are two theories. However, there is no special problem because the same conclusion is drawn based on either theory.

9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

No (Not required under law).

10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

No (Not required under law).

11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

· Raising awareness of the erroneous finding of inventorship

Awareness of the problem of the erroneous finding of inventorship seems to be low in Japan. For example, attendees to an application review meeting are sometimes selected as inventors without careful consideration. Awareness-raising is desired to improve these situations from the perspective of filing of applications having multinational inventorship. As one of the means therefor, it is considered to be worth considering, for example, putting a definition of inventorship in the statutory form.

· Unification of standards for Secret Prior Art

Some countries have laws providing that a patent application shall be refused based on Secret Prior Art, and some other countries also have laws providing that even in such cases, a patent application shall exceptionally not be refused if the inventors of the Secret Prior Art and of the patent application are the same. The standards for the application of exceptions differ among countries. With regard to joint applications, it is required in Japan that all of the inventors of an earlier application and those of a latter application are entirely the same.

A multinational invention is basically considered to be a joint invention made by multiple persons. In order to facilitate filing of applications for joint inventions (multinational inventions), it is a good idea to unify relevant provisions to the provision to the effect that a patent application shall not be refused based on Secret Prior Art if some of the inventors of the latter application are the same as those of the Secret Prior Art.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Definition of inventorship: Yes

If countries adopt different definitions of inventorship, inventorship may differ in each country. If there is also a country where an error in the stated inventorship is subject to a sanction, it is rough on right holders. Incidentally, harmonization should also be achieved in relation to the issues of whether finding of inventorship is determined on a claim by claim basis or based on the content disclosed in the entire description.

First filing requirement, a secrecy review and a foreign filing license: Unification is not necessarily desirable.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

Standard: Dividing the process of establishment of an invention into two stages, conception of an idea and reduction to practice thereof, and defining inventorship as follows: If a provided idea is new, the person who provided the idea is an inventor, and the person who reduced to practice said new idea becomes a joint inventor unless the reduction to practice is obvious to persons ordinarily skilled in the art.

Reason: An idea should be objectively read from the description, and it does not change in relationship to prior art documents. Therefore, the basis of finding of inventorship will not be turned upside down due to discovery of a new prior art document.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

· Where an error in the stated inventorship is unintentional (where the applicant has not known that the stated inventorship is erroneous) and it causes no unexpected disadvantage to any third party, correction should be made possible without any time constraint. This is because there is ordinarily no special reason for protecting infringers and other third parties on the grounds of an error in the stated inventorship.

On the other hand, where an error in the stated inventorship is intentional (where the applicant has known that the stated inventorship is erroneous), if correction of the stated inventorship harms the interests of a third party, the applicant is considered not to be permitted, under the doctrine of estoppel, to assert that persons stated as inventors are not true inventors. Assumed example cases are cases of demanding remuneration for an employee invention, the inventor's right to reputation, or a misappropriation or a violation of the provisions

on joint applications. As a juridical precedent, there is a case of demanding remuneration for an employee invention in which the court determined that the employee, who is the applicant, "is not permitted" to refuse a claim for value based on the allegation that a person stated as the inventor is not a true inventor "unless there are special circumstances" because such act "goes against good faith (estoppel)" (IP High Court decision dated 29 Mar 2007, *Hanrei Jihou* No. 1972, at 135)

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

- It is preferable that there is no first filing requirement. The following international standard is desirable if first filing requirements are necessary.
- Although whether it is the place of invention or the nationality of the inventors that serves as a basis for the occurrence of a first filing requirement becomes a problem, in either case, if a joint invention is a multinational invention as a result and there are multiple countries that impose a first filing requirement on the invention, the applicant shall be permitted to file a first application in any of those countries.
- A clear standard for the subject of application of first filing requirements (limited to enumerated subjects) is necessary.
- It is desirable to limit areas to which first filing requirements apply to the requisite minimum. For example, such areas may be limited to the area of advanced military-only art.
- It may be convenient for applicants if they can determine whether their own applications fall under the areas to which first filing requirements apply by themselves.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

- It is preferable that there is no secrecy review. The following international standard is desirable if a secrecy review is necessary.
- Applications subject to a secrecy review are limited to the requisite minimum, that is, advanced military-only art.
- A clear standard for the subject of application (limited to enumerated subjects) is necessary.
- The international standard provides that an application shall not become subject to secrecy unless a ruling of secrecy is issued within the prescribed period.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

- It is preferable that there is no foreign filing license system. The following international standard is desirable if a foreign filing license system is necessary.
Applications that require a foreign filing license are limited to applications in the same areas as the areas to which first filing requirements apply.
- A clear standard for the subject of application (limited to enumerated subjects) is necessary.
- The international standard provides that a ruling granting a foreign filing license shall be deemed to have been issued unless a ruling refusing the grant of a foreign filing license is issued within the prescribed period.
- It is made possible to file a request for a foreign filing license before filing an application in a country in which said request is filed.
- The content of an international standard (for a secrecy review) to obtain a foreign filing license is as stated in the answer to Q16. However, if an applicant is entrusted with selection of cases subject to first filing requirements, he/she is expected to fulfill the requirements by having a secrecy review conducted on the cases "that may become subject to the requirements," which are peripheral to the cases considered to be subject to the requirements, through first filing in order to avoid the situation where the applicant is subsequently considered to have failed to fulfill the requirements (situation stated in Q18). Some of such peripheral cases are

considered to be based on the premise of a foreign filing. Therefore, it is desirable that a time limit, such as half a year after a first filing, is set (clearly stipulated) in relation to a notice of a ruling concerning the grant of a foreign filing license and that there is a standard that a foreign filing license is deemed to have been granted unless such a notice is issued within the time limit.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

- It is appropriate to permit the imposition of a disadvantage on the applicant if a failure to comply with a first filing requirement was intentional.
- It is desirable that the following standard is set: If an applicant failed to comply with a first filing requirement or a security review requirement due to negligence, the failure is cured or repaired if the applicant files an application again by disclosing the status of applications filed in other countries after taking such procedures as waiver and withdrawal to put the applications filed in other countries into the status that they are not disclosed before they are disclosed.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

- Regarding a definition of requirements for establishment of joint inventorship
An invention must have been jointly made for the establishment of joint inventorship, and a joint invention must have been jointly made both subjectively and objectively.
However, even where part of an invention was subjectively jointly made and another part was independently made, the invention as a whole should be found to be a joint invention if it fulfills certain requirements.
In other words, if part of an invention that was jointly made alone is not found to involve an inventive step but can be considered to be a feature of the invention, the invention as a whole should be found to be a joint invention.

According to one popular theory, a joint invention must have been jointly made both subjectively and objectively.

A possible example case is as follows: A and B conducted joint development and invented an automobile that is recognized as being novel and involving an inventive step; and B invented a structure wherein the rearview mirror of said automobile is slightly improved while keeping it secret from A after the end of the joint development or during the joint development, and independently filed a patent application for a structure wherein said rearview mirror is added to said automobile.

In this case, if said rearview mirror itself has a technical significance based on which it is found to involve an inventive step, there is room for the approval of B's independent patent right. However, if said rearview mirror has no substantial technical value and falls under the scope of being "(substantially) identical" as set forth in Article 29-2 of the Japanese Patent Act, it is unreasonable to approve B's independent patent right in relation to the structure wherein said rearview mirror is added to said automobile, and it is desired that the structure is considered to be a joint invention of A and B.

However, according to one popular theory, the invention becomes B's independent invention as there is no subjective relationship between A and B in relation to said rearview mirror.

Some say that such conclusion is unreasonable and that such an invention should be found to have been jointly made as a "deemed joint invention." However, this theory is not necessarily favored by the majority.

As one of the solutions, it is hoped that law will provide that an invention is found to have been jointly made as a "deemed joint invention" despite lack of a subjective relationship between the parties if the part in which the parties have no subjective relationship has no substantial technical value and falls under the scope of being "(substantially) identical" as set forth in Article 29-2 of the Japanese Patent Act.

· Clarifying the scope of application of a secrecy review

One of the means for avoiding the problem caused by a secrecy review seems to be not conducting multinational research and development in the areas in which inventions subject to a secrecy review are created, on the premise that the concept of a "country" in a multinational relationship refers not to nationality but to the place where an invention is created. If standards for the areas and scope to which a secrecy review applies in all countries with a secrecy review system are made clear, it would be possible to make clear the countries from which one should stay away in multinational research and development or the areas in which there is no problem with conducting multinational research and development, including such countries.

Summary

Inventorship in Japan

In Japan, there is no statute defining "inventorship," and judicial precedents provides that an inventor is a person "who contributed to the completion of a feature of an invention in a creative manner in the process of conceiving an idea for solving the problem and reduced to practice the idea". Inventorship does not depend on the citizenship of the inventor(s) or where the invention was made. There is no first filing requirement, a secrecy review requirement or a foreign filing license.

Awareness of the problem of the erroneous finding of inventorship seems to be low in Japan. For example, attendees to an application review meeting are sometimes selected as inventors without careful consideration. Awareness-raising is desired to improve these situations from the perspective of filing of applications having multinational inventorship. As one of the means therefor, it is considered to be worth considering, for example, putting a definition of inventorship in the statutory form.

International Harmonization

Inventorship

The Japan group considered that harmonization in definition of inventorship is desirable. If countries adopt different definitions of inventorship, inventorship may differ in each country. If there is also a country where an error in the stated inventorship is subject to a sanction, it is rough on right holders.

Our proposed standard for inventorship is dividing the process of establishment of an invention into two stages, conception of an idea and reduction to practice thereof, and defining inventorship as follows: If a provided idea is new, the person who provided the idea is an inventor, and the person who reduced to practice said new idea becomes a joint inventor unless the reduction to practice is obvious to persons ordinarily skilled in the art.

An idea should be objectively read from the description, and it does not change in relationship to prior art documents. Therefore, the basis of finding of inventorship will not be turned upside down due to discovery of a new prior art document.

Where an error in the stated inventorship is unintentional (where the applicant has not known that the stated inventorship is erroneous) and it causes no unexpected disadvantage to any third party, correction should be made possible without any time constraint. This is because there is ordinarily no special reason for protecting infringers and other third parties on the grounds of an error in the stated inventorship.

On the other hand, where an error in the stated inventorship is intentional (where the applicant has known that the stated inventorship is erroneous), if correction of the stated inventorship harms the interests of a third party, the applicant is considered not to be permitted, under the doctrine of estoppel, to assert that persons stated as inventors are not true inventors.

First filing requirement, Secrecy review or Foreign filing license

It is considered that unification is not necessarily desirable for first filing requirement, secrecy review requirements or a foreign filing license.

However, the following international standards are desirable if they are necessary.

A clear standard for the subject of application (limited to enumerated subjects) is necessary. It is desirable to limit areas to which those requirements apply to the requisite minimum. For example, such areas may be limited to the area of advanced military-only art.

It is desirable that a time limit, such as half a year after a first filing, is set (clearly stipulated) in relation to a notice of a ruling concerning the grant of a foreign filing license and that there is a standard that a foreign filing license is deemed to have been granted unless such a notice is issued within the time limit. If an applicant is entrusted with selection of cases subject to first filing requirements, he/she is expected to fulfill the requirements by having a secrecy review conducted on the cases "that may become subject to the requirements," which are peripheral to the cases considered to be subject to the requirements, through first filing in order to avoid the situation where the applicant is subsequently considered to have failed to fulfill the requirements. Some of such peripheral cases are considered to be based on the premise of a foreign filing. Therefore, the time limit manner stated above would be preferable for an applicant.

One of ideas for avoiding the problem caused by a secrecy review seems to be not conducting multinational research and development in the areas in which inventions subject to a secrecy review are created, on the premise that the concept of a "country" in a multinational relationship refers not to nationality but to the place where an invention is created. If standards for the areas and scope to which a secrecy review applies in all countries with a secrecy review system are made clear, it would be possible to make clear the countries from which one should stay away in multinational research and development or the areas in which there is no problem with conducting multinational research and development, including such countries.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Because contributors fields does not have enough, I put one more contributor's name here.
Contributor: Tachiki NAGAI
And also Question No.1) does not have field、 I post it below.

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.
Article 2, paragraph (1) of the Patent Act: "Invention" = "highly advanced creation of technical ideas utilizing the laws of nature"

There is no law defining "inventorship." According to judicial precedents, "inventorship" is considered as follows. Incidentally, the finding of "inventorship" becomes an issue with respect to each provision concerning a claim for remuneration for an employee invention, the inventor's right to reputation, and misappropriation and violation of the provisions on joint

applications. However, the court does not adopt a different method (rule) of finding "inventorship" with respect to each context, and scholars also do not adopt such a different method with respect to each provision.

An inventor is a person "who contributed to the completion of a feature of an invention in a creative manner in the process of conceiving an idea for solving the problem and reducing to practice the idea." There is a judicial precedent wherein the court ruled that "a feature of an invention refers to a part in the structure of the invention described in the scope of claims that is not seen in prior art, that is, a part that provides a basis for a means for solving the problem that is peculiar to the invention" (IP High Court decision dated 30 Sept 2008, 2007 (Gyo Ke) No. 10278). Here, the "means for solving the problem that is peculiar to the invention (= part that is not seen in prior art)" is an idea for solving the problem as a technical idea, and the part "that provides a basis" therefor means a claimed structure wherein said technical idea is materialized.

There are roughly two theories for the specific process of identifying "inventorship." Under the theory favored by the majority, features of an invention (parts in the structure of the invention described in the scope of claims that are not seen in prior art, that is, parts that provide a basis for the means for solving the problem that is peculiar to the invention) are first found, and then, [i] the person who presented the problem, [ii] the person who conceived of the means for solving the problem, and [iii] the person who confirmed that the problem is solved are found.

After that, as a legal determination, the person who made a substantial or important contribution, or a contribution that had not been obvious to persons ordinarily skilled in the art, in the process of creation of the technical idea is determined to be the "inventor" out of those who fall under [i] to [iii] above. In general, the person mentioned in [ii] is important in many cases. This theory is a standard, which was shown, for example, in "Supreme Court decision dated 13 Oct 1977, *Minshu* Vol. 31, No. 6, at 805" and in "Supreme Court decision dated 3 Oct 1986, *Minshu* Vol. 40, No. 6, at 1068," and it has been followed in many decisions rendered by lower courts.

Although the two-stage theory has been adopted in only a few judicial precedents, it is influential among scholars. Under this theory, the process of establishment of an invention is divided into two stages, conception of an idea and reduction to practice thereof. If a provided idea is new, the person who provided the idea is an inventor, and the person who reduced to practice said new idea becomes a joint inventor unless the reduction to practice is obvious to persons ordinarily skilled in the art. This two-stage theory is proposed in *Overview of Patent Law 13th Edition* (authored by Kosaku Yoshifuji). [i] "Tokyo High Court decision dated 24 Dec 1991, *Hanrei Jihou* No. 1417, at 108" is a judicial precedent in which the court ruled that the person who reduced to practice a publicly known idea and completed an invention is an inventor, and [ii] "Tokyo High Court decision dated 24 Apr 1976, *Torikeshi-shu* 1976, at 449" is cited as a judicial precedent in which the court ruled that the person who reduced to practice a new idea is a joint inventor unless the reduction to practice falls under matters that are obvious to persons ordinarily skilled in the art.

With regard to these theories, in the former theory, features of an invention are first determined while, in the latter theory, the process of establishment of an invention is first divided into two stages and whether each stage is a feature of the invention is determined. Although the orders of the processes in these two theories are reverse, the theories are considered to be the same in terms of the conclusion. In the judicial precedents listed above, the court does not clearly distinguish these theories, and rather, it seems that two ways of organizing the processes of finding in the judicial precedents, the theory favored by the majority and the two-stage theory, are possible.

The problem is the finding of features of an invention in each case. In particular, the chemical area is considered to be special. In said area, whether a specific structure produces a desirable effect is not clear without conducting experiment in many cases. Therefore, a person who confirmed that a specific structure produces a desirable effect also tends to be considered to be an inventor as a person who actually got involved in the completion of the invention.

For example, in "IP High Court decision dated 29 May 2008, *Hanrei Jihou* No. 2018, at 146," the court held as follows: "In the chemical area, even if a certain singular phenomenon is confirmed, that fact should not be considered to immediately mean that the relevant technical idea can be used as one that is specific and objective as to enable any person ordinarily skilled in the art to work. There arise cases where clarification, including repeatability of the phenomenon and confirmation of the effect thereof, is necessary." The court then ruled that the plaintiff's contribution does not go far enough to do so, and denied the inventorship of the plaintiff.

Mexico

Report Q244

in the name of the Mexico Group
by Daniel SANCHEZ, Laura COLLADA, Victor GARRIDO, Héctor CHAGOYA, Octavio ESPEJO
and Daniel SÁNCHEZ

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Inventorship is defined in the Mexican Industrial Property Law (IPL) as follows:

Article 9 provides that the natural person that makes an invention, utility model or industrial design has the exclusive right to use such invention, utility model or industrial design.

Article 10bis. The right to obtain a patent or a registration shall belong to the inventor or designer, as the case may be, without prejudice to the provisions of Article 14 of this Law. If two or more persons have made the invention, utility model or industrial design jointly, the right to obtain the patent or registration shall belong to them jointly.

Article 13 provides that the natural person(s) appearing in the application as inventor(s), is/are presumed to be the inventor(s) of the patent or registration.

- a. If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Mexican law is silent regarding express means for determining inventorship.

However, as mentioned before, the person(s) appearing as the inventor(s) in the application is/are presumed to be the inventor(s). In this regard, if both A and B are both named in the application, they both would be deemed as inventors.

Now then, if there is not agreement regarding inventorship, the following must be considered. According to Article 10 BIS of the IPL, if the invention, utility model or industrial design was made by two or more persons jointly, the right to obtain a patent or registration belongs to them all in conjunction.

The natural person (inventor) that MAKES an invention (a human creation) shall have the rights for using it pursuant to Art. 9, of the IPL. This means that both, person A and B could be considered inventors for the purposes of the patent under Mexican law because both were instrumental in reducing the invention to practice. The invention could

not have been made without the knowledge and ideas of person A but it would also have been impossible to make without the skills of person B. These facts lead to the inevitable conclusion that the invention was the result of the joint effort of both persons, that is, the invention was made jointly. Accordingly, there is no doubt that Article 10 Bis of the IPL is applicable and the right to obtain a patent (reserved to inventors under Art. 9), belongs to both A and B in conjunction.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

- 2) **Does your law of inventorship depend on the citizenship of the inventor(s)?**

no

- 3) **Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?**

no

- 4) **Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

There is no time limit provided by the IPL, thus it is understood that this can be done during the validity of the patent.

As to the requirements, the change must be proved with documents showing why the inventorship changes are required.

In other words, in case an inventor has to be incorporated to the application, documents such as affidavits with the consent of the inventor(s) must be filed before the Patents Office, in order for this to proceed.

Likewise, for removing an inventor, documents with the consent of all the inventors should be filed. This may be achieved through a civil action before a Federal Civil Court; in any case the inventors must prove why the person that will be removed does not have the right to be mentioned as inventor.

- 5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

Since the inventorship may be corrected at any time, at first glance we would say that this does not lead to invalidation or no enforceability. In this case, the intentionality is not relevant since as mentioned before, inventorship is correctable.

However, we must consider that in case a conflict between the inventors is raised, the inventor claiming that he was not included in the application could file an invalidity action pursuant to section IV of Article 78 of the IPL, on the basis that the patent was granted to a person that was not entitled to it. In this case the intentionality will matter

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

The IPL does not require that a patent application claiming an invention made in Mexico has to be filed first in our country.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

The IPL does not require that a patent application claiming an invention made, at least in part in Mexico has to undergo a secrecy review or any other similar process, before it can be filed in another country

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

As mentioned before the IPL provides an inventorship presumption, however, the law provides that inventor is the natural person that makes an invention.

Likewise, the IPL defines invention, thus, we consider that it is understood that inventor is the natural person making a human creation to transform energy or matter to benefit and satisfy human needs.

Such invention is defined by the corresponding claims, thus the participation of the inventors, in the making of the invention, must be included in such claims.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Since the IPL does not require first filing requirement for patent applications of inventions made in Mexico, this question cannot be responded.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Since the IPL does not require a secrecy review of patent applications of inventions made in Mexico, this question cannot be responded.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

As mentioned before, the IPL does not provide special provisions regarding multinational inventorship, thus all the inventors are treated the same.

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

The following definition is proposed:

Inventor is the natural person(s) that makes an invention as claimed in a patent application, as defined in the law, which contributed directly and effectively to its creation process

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

First of all, correction of inventorship should be allowed at any time, i.e. during the pendency of the application and after it has been granted.

Name corrections and other errors similar in nature should be corrected with a simple petition filed by the applicant or patent owner.

Now, in case there is no conflict regarding the inclusion or removal of one or several inventors, the correction should be accepted by filing a written consent of all the inventors in case of addition of one or more inventors. In case of removal of inventors with their mere written consent should be sufficient. In cases where consent of inventors to be removed cannot be obtained, with the written consent of all remaining inventors.

In case a conflict in this regard is faced, this is, if one of the inventors is not included or does not want to be removed, a petition filed by the interested party should be received by the Patent Office.

In this petition the interested party should file all the evidence to prove: that he participated in the creation of the invention thus having the right to be included or to remain as inventor; and, the other inventors should have the right to file evidence proving that the petitioner does not contributed to the creation process does not having the right to be included or remain as inventor.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

First filing requirements should not be considered appropriate regarding multinational inventions.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

Secrecy reviews requirements should not be considered appropriate regarding multinational inventions

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

This requirement is not appropriate.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

This requirement is not appropriate.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

Multinational inventions should not be treated differently nor have special standards for inventors based on their nationality.

Summary

The Mexican Industrial Property Law (MIPL) defines inventorship in articles 9, 10bis and 13, providing that a natural person making an invention, utility model or industrial design has the exclusive right to use such invention, utility model or industrial design.

The right to obtain a patent or a registration belongs to the inventor or designer. If two or more persons have made the invention, utility model or industrial design jointly, the right to obtain the patent or registration shall belong to them jointly.

Likewise, the natural person(s) appearing in the application as inventor(s), is/are presumed to be the inventor(s) of the patent or registration.

On the other hand, the MIPL does not rely on or look to a particular part of the patent application nor provide special provisions regarding the citizenship of the inventor(s) or the place where the invention was made.

However, the inventorship of a patent application can be corrected after the filing date in Mexico, without having time limits but the validity of the patent.

As to the requirements for these corrections, the solicitor has to prove, with documents, why the inventorship changes are required.

In case a conflict between the inventors is raised, the inventor claiming that he was not included in the application could file an invalidity action pursuant to section IV of Article 78 of the MIPL, on the basis that the patent was granted to a person that was not entitled to it.

Finally, the MIPL does not provide special rules regarding first filing requirements, secrecy review or multinational inventorship for patent applications of inventions made in Mexico.

In light of the foregoing the conclusion is that harmonization in this area is desirable.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Netherlands

Report Q244

in the name of the Netherlands Group
by Addick LAND, Tim ISERIEF, Judith KRENS, Kim TAN, Hendrik Jan ZONNEVELD, Fleur TUINZ-
ING, Francis VAN VELSEN, Paul STEINHAUSER, Jasper GROOT KOERKAMP, Bart JANSEN,
Arnout GIESKE, Gerjjan KUIPERS, Paul REESKAMP, Otto SWENS, Ricardo DIJKSTRA, Erik VISSCH-
ER and Tjibbe DOUMA

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

1) The applicable law is the *Rijksoctrooiwet 1995* (Dutch Patent Act, hereinafter DPA). Dutch law does not define inventorship. It merely provides that the inventor is entitled to the patent. The law assumes that he who applies for a patent is the inventor (Art. 8 DPA).

The European Patent Convention (EPC) also does not provide a definition of "inventor" or "co-inventor" and Art. 74 EPC provides that unless provided otherwise, the European patent application as an object of property shall, in each designated Contracting State and with effect for such State, be subject to the law applicable in that State to national patent applications.

1a) Dutch law does not distinct between inventors located in or outside the Netherlands. So if either person A or person B would apply for a patent, he is considered the inventor. Further in this report, more attention will be paid to the possibilities and requirements for claiming to be mentioned as inventor in the patent and for claiming ownership of the patent application/patent. The law (Art. 13 DPA) provides that if the invention is made by several persons, who cooperated as a team, they together are entitled to apply for a patent. This will result in a patent that in its entirety is co-owned by the members of the team. Such co-owners can be located in different countries.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Dutch law of inventorship does not depend on the citizenship of the inventor(s). In the Netherlands, any natural or legal person can, regardless of nationality and/or place of residence, apply for a patent.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Dutch law of inventorship does not depend on where the invention was made (e.g. on the residency of the inventor(s)).

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Under Dutch patent law, inventorship can be corrected after the filing date. An inventor can be added, removed or corrected.

Art. 38 section 2 DPA provides that if the identification of the inventor in the patent application is incorrect, or if a person other than the inventor has declared that the inventor does not wish to be identified as such in the patent, the applicant and inventor may jointly request the Patent Office in writing to make the necessary corrections. In so far as applicable, the request has to be accompanied by written consent of the person wrongly designated as the inventor. There are no time limits for such a correction.

The request should be accompanied by an original deed containing a statement that the details of the inventor(s) are incorrect, the details of the inventor that has to be removed, or if applicable, the name of the inventor that has to be added (or a statement of this inventor that he does not wish to be identified as such in the patent).

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

If an error in the stated inventorship leads to an error regarding entitlement (e.g. based on the assumption in Art. 8 DPA), the party entitled to the invention and/or its licensees and/or its pledgees in case the entitled party has obtained a patent for the same invention (Art. 75(1)(e) jo 75(3) DPA) may claim invalidity of the patent. The relevant provisions concern ^[1]

- a. subject matter taken from another party without that party's consent (Art. 11 DPA);
- b. employees' inventions; inventions made in the course of education; and inventions resulting from research in the service of a university, college or research establishment (Art. 12 DPA);
- c. inventions made by several persons working together under an agreement (Art. 13 DPA).

Footnotes

1. [^] See Art. 60(1) EPC in case of European patents.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

Dutch law contains a provision regarding defence-related inventions which could have such effect. This provision – Art. 46 DPA – stipulates that if the applicant knows or should reasonably know that the invention should remain secret for the sake of the security of the Kingdom and/or its allies, the applicant must file a European patent application with the Dutch Patent Office first. It is then up to the Minister of Defence to decide whether the invention must remain secret or whether the application can be forwarded to the EPO. Art. 46 DPA is as such in line with Art. 75(2)(a) EPC. ^{[1], [2]} The Netherlands has not made use of the possibility provided by Art. 75(2)(b) EPC. Hence, Dutch law does not require an application for a patent claiming an invention made in the Netherlands to be filed in the Netherlands first or to require prior authorisation to file in another country.

Footnotes

1. [^] *The article was added to the DPA in 1978 on basis of an agreement of NATO countries (Oct. 21, 1960).*
2. [^] *The article lacks a reference to a PCT application.*

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Only European patent applications must be filed with the national authority *‘if the applicant knows or reasonably should know that the content thereof should be kept confidential in the interest of the defence of the kingdom or its allies’* (Art. 46 DPA). Hence, the law is not technology specific.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

Following filing of the application, that is forwarded without delay to the defence minister. A government decision is due -at the latest- three weeks prior to the deadline for forwarding applications to the EPO (Art. 77 (3) EPC and R. 37).

If the application is ordered to remain secret, it will not be forwarded to the EPO. Such an application will be deemed to be withdrawn after 14 months following the filing date or priority date (Art. 77 (3) EPC). The applicant can request conversion of his application to a national application, as set out in Art. 135-137 EPC and implemented in Art. 47 and 48 DPA. Payment of a national filing fee and a Dutch translation is required.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Generally speaking, any applicant acting against state secrecy interests will risk incurring penal sanctions threatened against disclosing or making public state secrets (i.e. 'information that is to be kept secret in the interest of the state and its allies'). An intentional breach is more severely punishable than an inadvertent but culpable offense (Art. 98 and 98a Penal Code).

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

The DPA does not define inventorship. In particular, the DPA does not provide applicants with clear guidance as to who should be named as the inventor(s) of a patent application. Therefore, this question does not apply.

If the question of inventorship is at stake, in case of entitlement issues, it is a matter of factual debate in court proceedings - case law from lower courts only. If inventorship would be defined in the law at the filing date, the debate would still be about the same after grant (and possibly opposition or nullity proceedings).

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

As discussed with respect to question 6 the only first filing requirement in Dutch law relates to defence-related inventions. For such inventions it should be made possible to also file in other NATO allied countries.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

No, see under 9.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

No, we have not identified other issues than the ones described under Questions 8-10.

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

1. None of the following treaties provides for a definition of 'an inventor':
 - the Paris Convention
 - the TRIPs agreement
 - the Patent Cooperation Treaty
 - the European Patent Convention
 - the Agreement on the Unitary Patent
 - the Unitary Patent Regulation.
2. Also the DPA is silent on the definition of 'an inventor'.
3. In providing for an international standard, we believe one of the key components should be that this is a person who conceived or – in case of multiple inventors – contributed to the conception of the (claimed) invention underlying the invention, so to distinguish from persons who merely contributed to auxiliary aspects of the invention.
4. The concept underlying the invention will normally be the aspects of the invention which are novel and inventive in view of the prior art (provided of course that clarity and enablement requirements are met). Hence, this will be highly dependent on the specific merits of the case, which can be best assessed by the patent offices and/or the competent courts. Therefore, the Dutch group proposes not to precisely define the underlying inventive concept.
5. We propose to adopt the principle that the ones actually mentioned as inventors in the patent application, should be presumed to indeed be the inventors. This is also in line with the principle that the applicant of a patent is presumed to be entitled to the patent (see e.g. Art. 4A1 Paris Convention, Art. 87 (1) EPC, and Art. 19 Implementing Rules EPC).
6. In case of multiple inventors there might be an issue regarding the applicable laws to establish the inventive concept underlying the invention. In order to solve possible issues of private international law, the Dutch group proposes that this assessment has to be made by the patent offices or the competent courts applying their 'normal' laws when deciding on the validity of the patent (application).
7. The considerations above lead us to the following definition of 'inventor':
 - a. A person who is mentioned as an inventor on the patent application, is presumed to be an inventor of all aspects of the invention, until and as far proven otherwise by a third party challenging this presumption in accordance with the principles set out in the next paragraphs.
 - b. An inventor is a person who conceived the concept underlying the invention. If more persons contributed to the invention, an inventor is a person who contributed to the conception of the underlying inventive concept of the invention.
 - c. The concept underlying an invention are the features of the invention which are considered to be novel and inventive in view of the prior art at the time of filing the patent application - see also the consideration above under 13.6 with regard to the competent authorities to decide upon such issue usually at a much later stage.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

It is assumed that if the inventors apply themselves, each of the applicants/inventors will have full knowledge of their status as a co-inventor. Any material correction of inventorship (i.e. adding and/or deleting of an inventor) should be unlimited in time.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

NATO member states should allow filing in every member state.

- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

See under 10 and 15.

- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

A foreign filing license should be needed only in countries outside NATO to be issued by NATO headquarter in Brussels.

- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

This should be dealt with by national law; if an error is made in spite of all due care such error should be repairable retroactively.

- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

NATO members, esp. USA and France, should allow patent applications to be filed in NATO allied states without a foreign filing license.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

New Zealand

Report Q244

in the name of the New Zealand Group
by Michael BROWN and Laura HOLLINGSWORTH

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

These questions have been answered in view of the New Zealand Patents Act 2013, which was enacted in September 2014. Many pending applications fall under the previous Patents Act 1953, which contained different provisions around inventorship. For example, the 1953 Act required foreign filing permits, which are no longer required under the 2013 Act.

The country of conception or nationality of the inventors is not relevant in determining inventorship. Person A and/or person B may be inventors if they contributed to devising the invention.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Section 5 of the New Zealand Patents Act 2013 defines inventor as 'the actual deviser of the invention'.

The meaning of 'invention' is not explicitly defined in the Act. The Act does not state whether 'invention' refers to the full disclosure or is limited to the claimed invention. 'Invention' may be interpreted to be what is claimed, because the exclusive rights given by the patent as outlined in section 18 of the Act refer to the invention but would be determined by reference to the claims of the patent. However, the Act refers at different points to language such as 'describe the invention', 'disclose the invention' and 'the invention claimed'.

The Act does not specify if inventorship is determined by the claim content or the whole disclosure. Patentability is specifically defined in relation to 'invention **so far as claimed**'. The language 'so far as claimed' is not used in relation to the invention or inventors.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The citizenship of the inventors is not relevant to inventorship in New Zealand.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

The country of conception is not relevant to inventorship in New Zealand.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

By way of a correction of error under section 202(2) of the Act. There are no prescribed time limits.

The application for a correction of error or omission must include

- a statement that (i) identifies where the error or omission is thought to have been made; and (ii) includes either a description of the error or omission or a copy of the entry in the patents register, patent, patent application, or other document (as the case requires) with the error or omission clearly identified; and
- evidence (if any) in support of the application.

The correction of error is advertised and subject to an opposition period.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Grounds of challenge that could potentially be relevant in this situation are that the nominated person is not entitled to the patent and/or the grounds of obtaining or attempting to obtain the grant of a patent by fraud, false suggestion, or a misrepresentation.

In the two month period (extendible to three months) after a complete specification becomes open to public inspection, a person can make a request under section 190 of the Act to be named as an inventor in a patent, specification, and patents register. The Commissioner of Patents will name that person as inventor under section 190 if they are satisfied (section 189):

(a) that the person in respect of whom, or by whom, the request or claim is made is the inventor of—

- (i) an invention for which a patent application has been made; or
 - (ii) a substantial part of an invention for which a patent application has been made; and
- (b) that the patent application is a direct result of that person being the inventor.

The request must be accompanied by a statement setting out the facts relied on. A request can also be made to the effect that another person should not have been mentioned as an inventor.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

Under the 2013 Act this is not required. Under the 1953 Act a person resident in New Zealand could not file an overseas application in any technical area without either first filing in New Zealand or requesting a foreign filing permit. All new applications are filed under the 2013 Act.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

Under the 2013 Act this is not required. Under the 1953 Act a person resident in New Zealand could not file an overseas application in any technical area without either first filing in New Zealand or requesting a foreign filing permit. All new applications are filed under the 2013 Act.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

There is no clear definition or guidance concerning what contribution is required to be considered the 'actual devisor' of an invention. Further, it is not clear if the Section 189 requirements for being named as an inventor are intended to define what is meant by 'actual devisor', or if those requirements are a subset.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**
- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**
- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

Multi-country collaboration is becoming more common. Harmonisation is desirable to prevent conflicting inventor obligations in various countries preventing inventors from obtaining patents or increasing the compliance burden.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**
- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**
- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**
- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**
- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**
- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**
- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

Summary

The Patents Act 2013 defines an inventor with reference to an invention, but does not define the meaning of 'invention'. The Act does not specify if inventorship is determined by the claim content or the whole disclosure. Citizenship or country of conception are not relevant to inventorship in New Zealand. There are no foreign filing limitations in the Act.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Norway

Report Q244

in the name of the Norway Group
by Amund Brede SVENDSEN and Felix REIMERS

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

As such, inventorship is not defined in any Norwegian statute or regulation, and there is no case law defining the term.

Section 1 of the Norwegian Patents Act provides that he or she who makes an invention that can be applied industrially, or his or her successor in title, shall have the right, on application, to be granted a patent for the invention. The only help afforded by this provision is that it clarifies that to be an inventor, you must have made an invention.

One could say that the case law is actually clearer as regards the concept of co-inventorship than inventorship, see our answer to Question 5) below.

The relevance, in general terms, of where the persons that are involved in the research and other activities that lead to an invention are located when the invention is made, is discussed in our answers to Question 3.

Directing somebody's efforts does normally not qualify as making an invention. To be a sole inventor, the person needs to come up with the solution to the technical problem in hand. To be a co-inventor, it suffices to provide an independent intellectual contribution to the invention, see our answer to Question 5 below.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

As mentioned, in Norway there is no law defining inventorship. It rarely happens that inventorship is determined on a claim by claim basis, but it appears conceivable to do so.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

If the applicable law has to be determined by deciding to which country the invention has the closest connection, the citizenship of the inventor(s) will be one of the elements to consider, but not the only one.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, however it may be relevant when deciding the applicable law.

There is no Norwegian statute that directly governs this issue. The Norwegian Employee Inventions Act provides some guidance, indirectly. Nor is there any case law determining this question.

The Norwegian Employee Inventions Act, under which Employers have a right to have assigned to them rights in and to patentable inventions made by Employees, applies regardless of where (in which country) the invention was made, as long as the employment contract is governed by Norwegian law. It appears reasonable to take that to mean that, if the inventor is not an employee, the questions relating to entitlement to an invention are to be decided applying the law of the country where the invention was made.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

There are no time limits for correcting the inventorship of an application during prosecution. The procedure is for the applicant to inform the NIPO in writing. There is no express requirement in the Patents Act or regulations that the originally indicated inventor(s) should approve or consent to the correction, if the applicant is not the inventor or does not represent all inventors. There is no case law to give guidance on this. However it could be argued that a correction of the inventorship, since it implicitly changes the originally recorded inventor's or inventors' inventorship share(s), would require all inventors' consent.

After grant, the patent owner may correct the inventorship, and similar considerations as those mentioned in the preceding paragraph apply.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

At the request of the party entitled to the invention, a patent application may be refused or transferred to the entitled party if the applicant is not entitled. Also at the request of the party entitled, a granted patent may be invalidated or transferred to the entitled pretender if the applicant has no proper title to the invention. In both cases, that will be the situation if the inventor stated is not the true inventor. However, a refusal of grant or an invalidation may only occur if the stated inventor has no title whatsoever to the invention. If the stated inventor was in fact a co-inventor, the pretender's remedy will be to have a share of the ownership of the invention and of the patent transferred to him/her.

Sections 17 and 18 Patents Act set out the conditions for transferring title to a patent application:

"Section 18

If anyone proves to the satisfaction of the Norwegian Industrial Property Office that he, and not the applicant, is entitled to the invention, the Norwegian Industrial Property Office shall, instead of refusing the application for that reason, transfer it to him if he so requests. The transferee shall pay a new application fee."

Section 18 should be read in light of

"Section 17

If anyone claims before the Norwegian Industrial Property Office that he, and not the applicant, is entitled to the invention, the Norwegian Industrial Property Office may, if the question is found doubtful, invite the party concerned to bring the matter before the courts of law within a specified time limit, whilst drawing to his attention that if he does not comply with this requirement, his claim may be disregarded in the further processing of the case."

It is generally accepted that the NIPO, or the courts, may order a partial transfer of the invention, meaning an ownership share, reflecting the parties' inventorship shares.

Entitlement and transfer requests concerning patent applications were mentioned in the main preparatory works of the Patents Act, the joint Nordic travaux préparatoires on the Patents Acts in the Nordic countries, which was published in 1963 (NU 1963:6). The report explains the reasoning behind the proposal to introduce the provisions, but provides no guidance on what the test of entitlement should be (section 18), nor on when the question should be considered doubtful enough for the NIPO to refer the petitioner to institute court proceedings (section 17). However, there is not much else that gives guidance on the application of these provisions.

This is also true of requests for transfer of an issued patent, which are governed by section 53 Patents Act:

"Section 53

If a patent has been granted to someone other than the party entitled thereto under section 1, the court shall, if the entitled party so claims, transfer the patent to him."

The case law concerning transfers of patent applications and transfer of granted patents is also scarce. A court decision sometimes referred to is a judgment handed down by the Borgarting Court of Appeal in 1988, which concerned entitlement to a granted patent. It states that as a basic rule, for a request for a transfer of the patent to be successful, the pretender should be found to have made a ready invention, which satisfies in itself the requirements of novelty and inventive step, and that the invention of the patent-in-suit, essentially, originates from the materials of the pretender. There is reason to believe that the same test would be applied today when deciding a request for the transfer of a patent application, albeit some have said the test applied in that case was severe on the pretender.

A test for establishing whether a pretender can be recognised as a co-inventor has been set out in some judgments of the district and appellate courts. This test, which is generally accepted in legal doctrine also, requires that to be a co-inventor, you must have made an independent intellectual contribution to the invention. A merely practical contribution does not suffice. However there is no requirement that the contribution made should constitute an invention in its own right. It could suffice if one party has defined the problem, whilst another party has found the solution. The contribution need not be substantial, but insignificant efforts do not qualify.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

Under the Act on Defence Inventions (LOV-1953-06-26-8 om oppfinnelser av betydning for rikets forsvar), anyone who wishes to exploit a defence invention, must either disclose a full description to the Ministry of Defence or file a patent application. The Patent Office will notify the National Security Authority of any patent applications which it considers may cover a defence invention.

Defence inventions are Inventions of importance to the defence of the Realm, provided they are

- made in Norway, or
- the subject of a patent application filed in Norway, or
- owned entirely or in part by someone domiciled in Norway, or if
- someone domiciled in Norway has the right to use them.

Once informed, the National Security Authority will have 4 months (can be extended by 3 months) to decide whether the invention is to be kept secret, and if a patent application has been filed, that the application and any patent issued, should be secret. If that is the situation, the application will not become public. Defence inventions must not be disclosed until the National Security Authority has decided to lift the secrecy. Filing a patent application in other jurisdictions constitutes a disclosure to third parties, and will also lead to full disclosure when the application becomes public. Hence, in actual practice, the inventor of a defence invention, and his successors in title, will be prevented from filing anywhere else than in Norway.

The Defence Inventions Act empowers the Government to make reciprocal treaties with foreign states to the effect that, subject to application in each individual instance from a competent authority of that foreign state, an invention important to the foreign state's defence and which is the subject of a patent application filed in Norway by an applicant domiciled in that foreign state, will be kept secret and that a patent granted will also be secret. There is a technical agreement within NATO that is relevant for this provision. However, the provision does not allow for any exceptions from the implicit "file first here" rule described above..

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

no

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

See answers to questions 2 and 3 above.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

yes

If the invention is a defence invention, it probably would.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

If committed intentionally or by negligence, violations of the Defence Inventions Act are punishable by fines or imprisonment for up to one year.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

See answer to Question 6 above: under the Defence Inventions Act, the Patent Office's duty to notify the National Security Authority of any patent applications for defence inventions implies a duty to screen applications to identify those that are relevant, and which are the covered by the 4 months non-disclosure obligation, and subject to a decision, by secrecy for a longer period of time.

It should also be mentioned that the secrecy and non-disclosure obligations in the Act on Defence Inventions apply not only to patented or patentable inventions, but also to non-patentable inventions.

This law does not depend on the area of technology disclosed and claimed, as long as the invention is defence relevant.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

The procedure and timing are set out in our answer to Question 6. As to costs of compliance, there are no duties or charges imposed for the review.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Intentional and negligent violations of the Defence Inventions Act are punishable by fines or imprisonment for up to one year.

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

There is currently no definition of inventorship in Norwegian law. There is room for improvement in this area.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

See Question 10.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There appears to be a need for harmonisation on this point. However, harmonisation would require that states give up some of the criteria they currently rely upon to assert their interests and right to conduct secrecy reviews before patent applications are filed in other jurisdictions. It is difficult to see why a state would be amenable to give up this right unless it is on a reciprocal basis, and with safeguards to protect its security interests.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

Questions 10 and 9 should be dealt with first.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

Anyone who has made an independent intellectual contribution to an invention shall be considered as the inventor or a co-inventor of the invention. Financial or managerial or administrative support or contributions shall not be taken into consideration. The performance of routine work shall not be considered as an independent intellectual contribution, nor shall the carrying out of work under close instructions from another party. If, in the individual case, the identification of the technical problem that the invention solves adds to the inventive step, the identification of the problem may qualify as an independent intellectual contribution.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

The Norwegian group proposes that the applicant should be in control of corrections of inventorship after a patent application is filed, in the sense that the applicant can request corrections of the inventorship on record, but only to the extent supported by written evidence of assignments of title to him/her and of any interested party's consent to the requested corrections. This means that, in order to register a correction of the inventorship on record, the applicant must submit:

1. Statements of consent from all the inventors whose share of the invention will be affected by the correction, and
2. Assignments of title to (shares of) the invention that the applicant did not already have title to.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for first filing requirements.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for secrecy review requirements, noting that the current Norwegian legislation, and presumably the relevant legislation of many other states also is directed at all inventions, be they patented or not, patentable or non-patentable. Hence it is questionable whether harmonisation of patent laws would be sufficient or even appropriate.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for foreign filing licence.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing or security review requirement.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

The Norwegian group has no proposal to make at this time.

Summary

As such, inventorship is not defined in any Norwegian statute or regulation. Case law and legal doctrine appear to be aligned in requiring that to be a co-inventor, it suffices to provide an independent intellectual contribution to the invention.

Directing somebody's efforts does normally not qualify as making an invention.

It rarely happens that inventorship is determined on a claim by claim basis, but it appears conceivable to do so.

The applicable law is determined by deciding to which country the invention has the closest connection, taking into account, i.a. the citizenship of the inventor(s), the residency or place where the invention was made

The inventorship of a patent application can be corrected after the filing date.

As a general rule, Norwegian law does not require that an application for a patent claiming an invention made in Norway, be filed first here. However, if the invention is a defence invention, filing for patent protection elsewhere is unlawful, because it amounts to an illegal disclosure. Hence, in the case of a defence invention, it would violate Norwegian law if a request for a foreign filing license was filed in another country before being filed in Norway. If committed intentionally or by negligence, violations of the Defence Inventions Act are punishable by fines or imprisonment for up to one year.

The Norwegian Patent Office has a statutory duty to notify the National Security Authority of any patent applications that concern defence inventions, and therefore monitors filed applications to identify those that are defence related.

Harmonisation of the laws requiring first filing of inventions made in a country and a secrecy review of patent applications to address, in particular, multinational inventions is an attractive proposition in some ways. However it appears unrealistic, to expect that states would give up their right to conduct secrecy reviews before patent applications are filed in other jurisdictions, unless it is on the basis of reciprocity.

The Norwegian Group believes the following definition of inventorship would be an appropriate international standard:

Anyone who has made an independent intellectual contribution to an invention shall be considered as the inventor or a co-inventor of the invention. Financial or managerial or administrative support or contributions shall not be taken into consideration. The performance of routine work shall not be considered as an independent intellectual contribution, nor shall the carrying out of work under close instructions from another party. If, in the individual case, the identification of the technical problem that the invention solves adds to the inventive step, the identification of the problem may qualify as an independent intellectual contribution.

The Norwegian Group proposes the following *standard for correction of inventorship after a patent application is filed*:

The applicant should be in control of corrections of inventorship after a patent application is filed, and may request corrections of the inventorship on record, but only to the extent supported by written evidence of assignments of title to him/her and of any interested party's consent to the requested corrections. This means that, in order to register a correction of the inventorship on record, the applicant must submit:

1. Statements of consent from all the inventors whose share of the invention will be affected by the correction, and
2. Assignments of title to (shares of) the invention that the applicant did not already have title to.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Paraguay

Report Q244

in the name of the Paraguay Group
by Victor ABENTE BRUN

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Our National law does not provide an express definition of inventor. Our Patent Law N° 1360/2000 "Patents of Invention", only establishes the rights to obtain the patent registration in our Country, in order to grant the right of use of the invention and the right to prohibit a third party to do so.

The right to obtain a patent registration in our country is granted to the inventor or his successors with possibility to transfer the same through assignment or succession. Also, describes different scenarios in which will be considered at the time to grant a patent registration, namely:

If the invention has been made by two or more people, the right to obtain the patent registration will be granted under the same conditions.

If the same invention has been made independently by different people, the patent registration rights will be granted to the person or his successor, who filed first the patent application or claims priority rights with the earliest date for that invention.

If the invention has been made under the compliance or execution of a work project or service contract or employment contract, the patent registration rights will be granted to the person contracting the work project or service, or the employer, as appropriate, unless otherwise provided by contract.

If the an employee, which is not was not required, by contract, to make an inventive activity, makes an invention in the field of activities of his employer, or using data or means to which he had access by virtue of his employment, must communicate the invention to his employer. If the employer has interest in the invention, his must notify to the employee in a period of 30 days the acknowledgement of the invention in order to be considered his ownership on the rights to register the invention. The employee will have the right to an equitable compensation taking into account the estimated value of the invention. Such compensation is irrevocable.

Finally, in all cases the inventor will have the imprescriptible right to be known as the author of the invention and will be mentioned as such in the granted patent and all documents and official publications related to the same, unless expressly waives this right. However, it will be null and void any agreement, in which, the inventor resigns to his right to be mentioned, before the invention is made.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No. According to our National Patent Law, a patent application could be applied by a natural or legal person national or foreign.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Yes. According to our National Patent Law, the applicant can modify or correct his application, before its publication and any time of the proceedings, but this may not involve the change of object of the invention nor an extension of the disclosure contained in the initial application. If the modification or correction is been made after the substantive examination and affects some of the technical documents, an additional examination could be ordered

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

When a patent or utility model application is has been applied or granted by a person not entitled to obtain, or in detriment of another person who is entitled to, the affected person can may claim his rights before the Judicial Authority competent in this matter requesting the transference of the pending application or granted patent or the recognition as the co applicant or co-owner of the invention. Also, he can sue for damages. The rights to filed this action will prescribe after 10 years from the dated in when the patent is granted or two years from the date that the invention had begun to be used in our Country, always taking into account the earliest expiration date. The action will not prescribe if the people who obtain the patent registration had applied in bad faith.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

It is not a requirement in our country

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

No, it is not a requirement in our country.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

In our opinion, is not necessary to make any changes in this regard.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

In our opinion, is not necessary to make any changes in this regard

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

In our opinion, is not necessary to make any changes in this regard

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

Since our current national patent law makes no distinction with regard to nationality or domicile of the applicant, in our opinion, is not necessary to make any changes or improvements in this regard

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

In our opinion, it would be desirable to harmonize the laws and doctrine in this area in order to facilitate to the patent owner(s) with different nationalities the procedural steps to obtain a patent registration.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

In our opinion, the term "inventor" is the person who contributes any part of his ingenuity, skill, or technical knowledge towards the invention regardless his nationality or domicile.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

In our opinion, the applicant could be able to correct the stated inventorship of his patent application at any time of the proceeding of patent registration, as long as this error was unintentional, by submitting a writ requesting the correction along with supporting documents. If the error was intentional in detriment of the actual inventor, the same could sue for damages and request to the competent authority the transference of the pending application the recognition as the co applicant or co-owner of the invention

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

In our opinion, this requirement for first filling must be required if the invention is intended to be used in the country in where the invention was made and regardless of the nationality or domicile of the inventor(s).

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

In our opinion, this requirement should be should be entrusted to the Patent Office at the time of substantive examination in order to preserve the rights of the applicant, and if the patent application that contains areas that are considered of national secret or affect national security, are rejected ex officio by the Patent Office

- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

In our opinion, there are no specific proposals in this regard.

- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

In our opinion, there are no specific proposals in this regard

- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

In our opinion, there are no specific proposals in this regard

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Peru

Report Q244

in the name of the Peru Group
by Adriana BARRERA

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) **Current law and practice**

1) **Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.**

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

First of all, it is important to mention that the law that applies to Peru with respect to Intellectual Property Rights is Decision 486, Common Intellectual Property Regime, which applies to the countries that are members of the Andean Community (The Decision). In addition to the Decision, we have also a national law: Legislative Decree No. 1075, which complements the Decision (DL 1075).

With respect to inventorship, we must say that neither the Decision nor the DL 1075, defines such term. In this sense, The Decision establishes that the right to a patent belongs to the inventor and that it may be assigned or transferred by succession. However, it does not define the term "inventor", or what has to do a person in order to be recognized as the inventor.

- a. **If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?**

According to the Decision, which applies to Peru in this matter, both person A and B would be considered co-inventors and therefore, they shall share the right to patent the invention.

However, if they would have made the same invention independently, the patent shall be granted to the person or assignee with the first filing date or, where priority is claimed, date of application.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

As we have mentioned on the previous questions, there is no definition regarding Inventorship in Peruvian national and regional regulations.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, according to the applicable laws (the Decision and DL 1075) the inventorship in Peru does not depend on the citizenship of the inventor. In this sense, if the patent application is filed in Peru, the Peruvian Patent Office will grant the protection after the proper analysis, despite the citizenship of the inventor.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, according to the applicable laws (the Decision and DL 1075) the inventorship in Peru does not depend on where the invention was made. In this sense, if the invention was made e.g. in China and the inventor or patent owner wants to protect his rights in Peru, it is completely viable.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Yes, according to the Decision and the DL 1075, the person that files a patent application may, at any time during the proceeding, request the modification of the application, but that modification may not involve extending the scope of protection beyond the use indicated in the initial application.

Neither the Decision nor the DL 1075 refers expressly to the modification of the inventorship. However, in our experience we have learned that it is possible. As a forth mentioned the only part that can not be modified is the extension of scope of protection.

The applicant may, likewise, request the correction of any material error.

a. If yes, what are the requirements and time limits for such correction?

According to DL 1075 the requirement to request the correction of the application, which includes the modification of the inventorship, is the payment of an administrative fee.

With respect to the time limit to request such modification, it can be the filed at any time during the proceeding, meaning that it has to be before the Patent Office issues his final decision regarding the granting of the patent.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

With respect to an error regarding the inventorship in a patent application has, neither the Decision nor the DL 1075 do establish a specific provision. However, if the error was intentional other regulation would apply. Specifically, the applicable laws would be law 27444-General Law of Administrative Proceedings (for giving false information) and Legislative Decree 1044- which regulates Unfair Competition. In this case, the application could be invalidated.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

No, Peruvian national law does not require that an application for a patent claiming an invention made in our country be filed first here. In this sense, it will depend on where the patent owner would desire to protect his rights regarding this patent.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

No, Peruvian national law does not require that an application for a patent claiming an invention made in our country undergoes a secrecy review or similar process before it can be filed in another country. In this sense, it will depend on where the patent owner would desire to protect his rights regarding this patent.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

- 8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

As it was mentioned before neither the Decision nor DL 1075 define inventorship.

- 9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

It does not apply to our country. As we have mentioned before, it is not required by Peruvian law that if the invention has been made in Peru, the patent application must be filed there before. It is possible that the inventor files the application in another country first.

- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

It does not apply to our country. As we have mentioned before, it is not required by Peruvian law that an invention made in Peru must follow a secrecy review first.

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Yes, we consider that a proper definition of "inventorship" should be included in Peruvian law in order to facilitate the filing of patent application having multinational inventorship.

III.) Proposals for harmonisation

- 12) Is harmonisation in this area desirable?**

yes

Yes, we consider that harmonization in the area of Inventorship of multinational inventions is desirable.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

We believe that the following definition of inventorship would be an appropriate international standard: *"a person who has substantially engaged in the creative process of an invention can be named as an inventor."*

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

We consider that if there is an unintentional error regarding inventorship after a patent application is filed, the person named as an inventor in error or the person who should have been named as the inventor should file the following documents in order to correct the inventorship:

- (1) A request to correct the inventorship including the inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship was unintentional
- (3) An oath or declaration by the actual inventor or inventors
- (4) The applicable fee

The timing to correct this error will be during the pendency of the application.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

We consider that first filing requirement should apply to the country where the invention has been made. In this sense, the citizenship would not be considered for first filing requirements. This criteria will facilitate multinational inventions.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

In our opinion an international standard for secrecy review requirements should be for national security matters or national interest matters.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

We believe 6 months would be appropriate for obtaining a foreign filing license. Also, a clearance to file a foreign license must be obtained before any foreign filings are made. Clearance can be obtained either by filing a domestic patent application along with a request for clearance, or by filing an international (Patent Cooperation Treaty) application.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

We consider that a penalty for failure to comply with the law should apply. Depending on the severity of the case the penalties could be disciplinary or economic sanctions.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

We consider that the countries that establish as a first filing requirement the residency of the inventors, should give a clear definition on who will be considered a "resident". Also, all the countries should have a clear definition of who is considered to be an inventor.

Summary

We consider that harmonization in the area of Inventorship of multinational inventions is desirable and necessary. Most countries should have similar criteria with respect to first filing requirements and standard definitions for the following terms: inventorship, residency, secrecy review, among others. We believe that the following definition of inventorship would be an appropriate international standard: *“a person who has substantially engaged in the creative process of an invention can be named as an inventor.”*

Also, there should be an international standard for secrecy review requirements. We consider that a patent application should be reviewed by the correspondent national authority in case it involves matters of national security or national interest.

Finally, we believe that if most countries had the same criteria for first filing requirements, either the country where the patent has been invented, the residency of the inventor or the citizenship of the inventor, the patent applications including inventorship of multinational inventions would be able to comply with most countries' regulations.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Philippines

Report Q244

in the name of the Philippines Group
by Rowanie NAKAN and Maria Carmela MARANAN

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The Philippine Intellectual Property Code ("IP Code") does not provide a definition for who is considered an "inventor." Under Rule 40(b) of the Rules of Practice in Patent Cases [Administrative Order No. 1-93 ("AO No. 1-93")] of the Bureau of Patents, Trademarks and Technology Transfer, now the Philippine Intellectual Property Office ("IPO"), "if the multiple inventors are named in an application each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application." This provision considers as an inventor one who has made a contribution to the subject matter of at least one claim of the application. However, there is no similar provision under the Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs ("Revised Rules").

In view of the lack of a specific provision for who may be considered an "inventor", it is common practice to list all members of a research team as joint inventors.

For purposes of Non-Prejudicial Disclosure by inventors, Section 25.2 of the IP Code provides that the term "inventor" also includes any person who, at the time of filing of an application, has a right to the patent.

While there is no exact definition of an inventor in the IP Code, it makes a distinction between the owner of a patent and the inventor, when the invention is made pursuant to a commission. Section 30 of the IP Code provides:

"Section 30. *Inventions Created Pursuant to a Commission.* - 30.1. The person who commissions the work shall own the patent, unless otherwise provided in the contract.

30.2. In case the employee made the invention in the course of his employment contract, the patent shall belong to:

(a) The employee, if the inventive activity is not a part of his regular duties even if the employee uses the time, facilities and materials of the employer.

(b) The employer, if the invention is the result of the performance of his regularly-assigned duties, unless there is an agreement, express or implied, to the contrary."

Thus, under Section 30 of the IP Code, a person who commissions the work, even though he did not make the invention, owns the right to patent.

In the scenario described in Item 1(a), Section 30 applies regardless of the nationality or situs of the person commissioning the work. Hence, B – the person who made the invention, is the inventor, while A – the person who commissioned the work, is the owner of the patent.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Pursuant to Rule 40(b) of Administrative Order No. 1-93, there is an apparent basis to refer to the claims for purpose of establishing inventorship. However, it is common practice to list all members of a research team as joint inventors.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The IP Code does not make reference to the citizenship of inventors. Thus, the same rule applies to inventors of all nationalities.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

The IP Code does not make reference to the place where the invention was made. Thus, the same rule applies regardless where the invention was made.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Yes, the inventorship of a patent application may be corrected after the filing date.

Section 58 of the IP Code allows the correction of mistakes in an application upon request of any interested person and payment of the required fee.

"Section 58. Correction of Mistake in the Application – On request of any interested person and payment of the prescribed fee, the Director is authorized to correct any mistake in a patent of a formal and clerical nature, not incurred through the fault of the Office."

Further, Section 59 of the IP Code allows changes to be made on the patent:

"Section 59. Changes in Patents. - 59.1. The owner of a patent shall have the right to request the Bureau to make the changes in the patent in order to:

(a) Limit the extent of the protection conferred by it;

(b) Correct obvious mistakes or to correct clerical errors; and

(c) Correct mistakes or errors, other than those referred to in letter (b), made in good faith: Provided, That where the change would result in a broadening of the extent of protection conferred by the patent, no request may be made after the expiration of two (2) years from the grant of a patent and the change shall not affect the rights of any third party which has relied on the patent, as published."

Moreover, the IPO requires the submission of documents in support of the request for correction of inventorship, such as a Deed of Assignment showing the correct inventorship, or the correct inventorship listing as shown by documents issued by other Patent Offices.

The request for correction may be filed at any time.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Section 67 of the IP Code provides that if a Philippine court has adjudged that a person other than the applicant has the right to the patent, such person may, within three (3) months after the decision has become final:

- (a) Prosecute the application as his own application in place of the applicant;
- (b) File a new patent application in respect of the same invention;
- (c) Request that the application be refused; or
- (d) Seek cancellation of the patent, if one has already been issued.

Moreover, Section 68 of the IP Code provides that if a person, who was deprived of the patent without his consent or through fraud is declared by final court order or decision to be the true and actual inventor, the court shall order for his substitution as patentee, or at the option of the true inventor, cancel the patent, and award actual and other damages in his favor if warranted by the circumstances.

From the foregoing, it appears that only the true and actual inventor who was omitted as such may use the error in the inventorship as basis to cancel the patent.

The law does not distinguish whether the errors are made in good (unintentional) or bad faith (intentional).

The actions indicated in Sections 67 and 68 shall be filed within one (1) year from the date of publication made in accordance with Sections 44 (publication of patent application) and 51 (refusal of the application), respectively. (*cf.* Section 70 of the IP Code).

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

Philippine law does not require that an application for a patent claiming an invention made in the Philippines be filed first in the Philippines.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

Philippine law does not require that an application for a patent claiming an invention made in the Philippines undergo any secrecy review.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

The IP Code does not define inventorship. The IPO explained that the lack of a definition of inventorship in Philippine patent law is in part due to the removal of the requirement of submitting an Oath of Inventorship. Note that under Section 35 of the previous AO No. 1-93, only the actual inventor may apply for a patent and the application papers must be signed and the necessary oath executed by the inventor, unless the inventor is dead or insane. However, such provision is no longer present under the IP Code or the Revised Rules.

The IPO opined that the reinstatement of a definition of inventorship may be construed as requiring the supposed inventor or inventors to claim inventorship under oath (i.e. through the submission of an Oath of Inventorship). In connection with this, the IPO believes that an Oath of Inventorship should not be made mandatory to obtain a filing date so as to avoid the undue burden on Filipino inventors who may need to have their affidavits notarized and legalized abroad.

Nevertheless, it is submitted that there is a need to provide clear guidance as to who should be named as the inventor or inventors of a patent application.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There is no law requiring first filing of patent applications directed to inventions made in the Philippines.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There is no law requiring secrecy review of patent applications of inventions made in the Philippines.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

The IP Code does not define the term “inventor”. Thus, to provide clear guidance, Philippine laws must first define who is the inventor of an invention claimed in a patent application. In this connection, it is recommended that the most stringent test for inventorship be established in order to avoid penalties arising from the incorrect identification of inventor(s) such as cancellation of the patent under Sections 67 and 68 of the IP Code.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Yes, harmonisation is desirable in order to respond to the new issues resulting from the increasing cross-country trends in the field of research and development and the expansion of activities of multinational corporations in different countries. The globalization of the invention process necessitates unification of inventorship laws to ensure the protection of investors as well as the rights of inventors. Moreover, harmonisation in this area will facilitate the compliance of applicants with the requirements in each jurisdiction, thus fostering an environment conducive to international cooperation.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

We recommend the following definition:

“An inventor is any person who has made a substantial contribution to the conception and/or production of the subject matter of at least one claim of the application covering the invention.”

The foregoing definition emphasizes the importance of having substantial participation in the *conception and/or production* of the invention, such that the contribution of that person is necessary to the realization of the patentable invention itself. Moreover, since it is the claims that define the scope of protection of a patent, inventorship should be based on contribution to the subject matter of at least one (1) claim.

Similarly, we also propose to exclude under this definition persons who, albeit part of a team developing an invention, merely followed orders in the process of producing such without contributing to the design process, nor persons who financed or merely provided material assets for production.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

Considering the complicated nature of defining who are inventors, especially in large team development efforts, correction of inventorship should be allowed when an application fails to correctly identify the inventors at the time of filing of the application. Such correction should be allowed whether the application is still pending or a patent has been granted.

If it is the applicant who request for the correction, it should not be necessary to determine whether the error was intentional or unintentional, in order to facilitate the correction of the inventorship.

On the other hand, when the error in the inventorship is used as basis to cancel a patent, it is submitted that it should be specified that the same may only be resorted to if the error was intentional.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

In the case of joint multinational inventorship, it is submitted that it is best to leave the decision of where the application should be first filed to the discretion of the parties involved. The grant of such discretion to the parties permits stakeholders to strategically select the country of first filing in order to ensure immediate protection of the invention where it is most needed.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

While we do not adhere to a patent system with first filing requirements, we believe that there is a need for governments to perform a pre-filing clearance akin to a secrecy review as regards inventions covering military technology, technology that may compromise national security, technology that are considered national secrets, and/or technology that may prejudice public safety.

In this regard, countries must agree to the establishment of a working list of subject matters that will require clearance and general procedures to determine whether an invention involves any of the matters enumerated above. If an invention includes one of the subject matters that form part of the pre-agreed list, then the applicant must obtain a pre-filing clearance from the country concerned. The countries must agree as to the consequences of failure to undergo pre-filing clearance, aside from loss of patent rights in the country where pre-filing clearance was supposed to have been obtained.

It must be emphasized that pre-filing clearance will be required only for those inventions covering any of the matters falling in the pre-agreed list.

With the foregoing, there is no longer any need for first filing requirements.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Based on our answer to Question No. 15, we submit that there is no necessity to require foreign filing licenses since we are of the opinion that the first filing requirement is an undue burden to patent applications involving multinational inventorship.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Inadvertent failure to comply with first filing requirements and security reviews should be amenable to correction by expedient mechanisms. The remedy may be in the form of filing a request for correction/request for secrecy review and payment of the corresponding fee.

However, if the patent involved covers military technology, technology that may compromise national security, or technology that may prejudice public safety, non-compliance with the security review requirement should result in the loss of right over the patent.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

In our answer to Question No. 15, we submitted that no first filing requirement should be imposed to provide stakeholders the opportunity to strategically select where patent protection is most immediately needed. However, the question arises as to whether this discretion should be absolute, or whether some limitation is needed.

A limitation to the discretion as to where to first file a patent application may be put in place to safeguard a country's right to control, develop and protect its resources, sciences, technologies, including indigenous knowledge systems and practices. For instance, aside from the proposed pre-filing clearance in our answer to Question No. 16 above, or alternative thereto, a country may require that the patent application be first filed in its jurisdiction where the invention involves resources endemic therein.

Summary

Philippine patent law does not provide a specific definition of inventorship. Nevertheless, it is common practice to list all members of a research team as joint inventors.

Philippine patent law does not distinguish between citizens and non-citizens of the country and does not make reference to the place where the invention was made. The same rule applies wherever the invention was made. Moreover, Philippine law does not require that an application for a patent claiming an invention made in the Philippines be filed first in the Philippines.

In view of the dearth of a definition of inventorship in Philippine statute or jurisprudence, there is a need to provide clear guidance as to who should be named as the inventor or inventors of a patent application. Thus, Philippine patent law must provide a clear definition of who the inventor is. In this connection, the following definition is proposed:

"An inventor is any person who has made a substantial contribution to the conception and/or production of the subject matter of at least one claim of the application covering the invention."

As regards the issue of joint multinational inventorship, it is submitted that it is best to leave the decision of where first filing of the patent should be made to the discretion of the parties involved. This will permit stakeholders to strategically select the country of first filing in order to ensure immediate protection of the invention where it is most needed. Nevertheless, it is submitted that it is ideal to have secrecy review requirements as regards inventions covering the subject matters of military technology, technology that may compromise national security, technology that are considered national secrets, and/or technology that may prejudice public safety.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Poland

Report Q244

in the name of the Poland Group
by Katarzyna KARCZ

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

In Poland there is no law defining inventorship. It is solely and completely up to the persons involved with making the invention to decide who will be listed in a patent application.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

In Poland there is no law and special regulations defining inventorship.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

See the answer to point 1 above.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

See the answer to point 1 above.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

There are no time limits. The requirement is to file with the Polish Patent Office a request for correction of the list of inventors and the documents certifying that the requested correction is legitimate. These documents may include eg. inventors' declarations, court decisions related to the inventorship, etc.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

First, the consequences of an error in the stated inventorship (either intentional or unintentional) may include civil claims raised against the applicant(s) and/or the inventor(s) listed in the application. One of the consequences of such claims may be a civil court decision establishing the legitimate inventor(s) and hence the legitimate persons entitled to obtain a patent or to the rights derived from a granted patent.

Once the legitimate inventor(s) has been established by the court decision, the following provisions may apply:

- art. 74 Polish Industrial Property Law - act of 30 June 2000, as amended by act of 23 January 2004 and act of 29 June 2007 (IPL) [intentional or unintentional error – an application may be discontinued, a patent may be revoked or transferred]:

“Where a patent application has been filed or a patent obtained by a person not entitled thereto, the entitled person may demand that the patent granting proceeding be discontinued or the patent granted be revoked. He may also demand that a patent be granted in his favour or that the patent already granted be transferred to him against reimbursement of the incurred costs of filing of the application or of granting the patent.”

- art. 304.1 IPL [intentional error - the applicant may be subject to criminal penalties]:

“Any person who, not being entitled to be granted a patent, a right of protection or a right in registration, files another’s invention, utility model, industrial design or topography of an integrated circuit in order to be granted a patent, a right of protection or a right in registration, shall be liable to a fine, limitation of freedom or imprisonment for a period of up to two years.”

- art. 75 IPL [unintentional error – prior use rights]:

“1. A person who, acting in good faith, was granted or acquired the patent subsequently transferred to the entitled person under Article 74, or, being in good faith, acquired a license and has exploited the invention for at least one year before a proceeding for the transfer of the patent has been instituted, or within that period has made substantial preparations necessary for exploiting the invention, may, subject to payment in favour of the entitled person of compensation at the amount as determined, continue to exploit that invention in his enterprise to the extent to which he had exploited it at the date of institution that proceeding.

2. The right to exploit the invention, referred to in paragraph (1) shall, at the request of the person concerned, be recorded in the Patent Register. The right may be transferred to another party only together with the enterprise.”

both in the case of intentional and unintentional error concerning inventorship, the applicant who applied for and/or obtained a patent may be liable to damages.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

There is no law imposing a duty of first filing basing on where the invention was made.

However, there is a duty of first filing formulated as follows according to art. 40 IPL:

“An invention for which a Polish legal person or a Polish national, having his domicile on the territory of the Republic of Poland, wishes to seek patent protection in another country, may only be applied for protection in that country, when first has been applied for protection with the Patent Office.”

As it follows from the above cited art. 40 IPL, it is the nationality and domicile of the applicant (not the inventor) that determines application or non-application of the duty of first filing in Poland.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

There is no law requiring that an application for an invention made in Poland undergoes a secrecy review or similar process before it can be filed in another country.

On the other hand, there are secrecy review laws but they are not based on the criterion of where an invention was made and they apply irrespective of whether an application is to be filed abroad or not.

The secrecy review laws include art. 56-62 IPL and a Regulation of the Council of Ministers of 23 July 2002.

- art. 56 IPL:

"1. An invention made by a Polish national may be considered to be a secret invention, if it concerns national defence or the security of the State.

2. The following, in particular, are inventions concerning national defence: new categories of weapons or military equipment and methods of combat.

3. The following, in particular, are inventions concerning the security of the State: technical means applied by civil services authorised to carrying out actions and reconnoitring operations, as well as new categories of equipment and material, and methods of use thereof by the said services."

- art. 62.1 IPL:

"To the extent as agreed between the authorities concerned, the Patent Office shall communicate to the Minister of National Defence, a minister competent in internal affairs or to the Chief of the State Protection Office, lists of the inventions filed concerning national defence or the security of the State as well as, at the request of these authorities, the descriptions and drawings thereof [...]."

The above provisions are applied to all the applications filed with the Polish Patent Office (including European and PCT applications) provided that the invention was made by a Polish national. As a consequence, the first step of the formal examination of all such applications in the Polish Patent Office is the security check.

If an application is considered to be secret by the competent authority, then the right to obtain a patent is transferred ex officio to the National Treasury; the applicant is entitled to a compensation under art. 58 and art. 59 IPL.

However, the above cited art. 58 and 59 IPL may not be applied to the inventions made jointly by Polish and foreign inventors because such an invention may not be considered secret under art. 56 IPL.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

No law, no guidance.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The existing first filing law (art. 40 IPL) does not address multinational inventions. However, although it imposes the duty of first filing on the Polish applicants having a domicile in Poland, it is unenforceable. Therefore, in the case of a multinational invention filed first outside Poland in breach of art. 40 IPL, there would be no detrimental consequences affecting the applicant(s), the inventor(s) or the application (except those theoretical mentioned in point 6.d above).

Also, the existing first filing law is inconsistent with the secrecy review laws as one applies to the Polish applicants (both natural persons and legal entities) having a domicile in Poland and the other to the inventions made by Polish nationals. Therefore, an open door is left for the applications directed to the inventions concerning defence and security domains, filed by Polish applicants if at least one inventor is not Polish. This is because even if such an application is selected as concerning national security or defence, it may not be considered secret and banned from filing abroad (as it was not made by a Polish national – art. 56 IPL).

In view of the above considerations, the first filing law and the secrecy review laws in Poland do not pose problems to multinational inventions which is good from the point of view of the inventors and the applicants. However, these laws are mutually inconsistent, partly unenforceable and as such they do not properly fulfill their functions from the point of view of the state defence and security.

The law could certainly be improved but it seems extremely difficult to satisfy both the interests of the multinational applicants/inventors and those of the state security.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

See point 9.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

No.

III.) **Proposals for harmonisation**

- 12) **Is harmonisation in this area desirable?**

yes

Yes but only to a limited extent.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

No need for an international standard which would be extremely difficult to establish bearing in mind all the different laws, traditions etc. of different countries as well as different situations in which the inventions are created. This question may be resolved by means of specific agreements between the inventors of a multinational application. Knowing the laws binding them, the inventors/applicants should take care in advance to conclude necessary agreements.

- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

No time limits, possibility of correction on request of the list of inventors basing on documents to certify that the requested correction is legitimate.

- Intentional or unintentional error - in the case of a patent application filed or a patent obtained by a person not entitled thereto, the entitled person may demand that the patent granting proceeding be discontinued or the patent granted be revoked. He may also demand that a patent be granted in his favor or that the patent already granted be transferred to him. The applicant who applied for and/or obtained a patent may be liable to damages.

- Intentional error – the applicant who applied for and/or obtained a patent may be liable to damages as well as criminal penalties.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

It seems that establishing an international standard for first filing requirements would be obviously desirable from the point of view of multinational inventors/applicants. However, it would also be extremely difficult bearing in mind that these requirements are strictly connected with national security laws of each country which constitute a sensitive issue.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

Each country should be free to establish their own secrecy review requirements.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

The countries having first filing requirements should be obliged to ensure that a foreign filing license may be obtained under certain conditions. Each country should be free to establish their own conditions.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

First of all, such a standard would have to foresee a procedure to prove that the failure was in fact inadvertent (arguably efficient). If inadvertent - the ability to cure or repair should depend on whether the application was already published or not. If published, it should be established whether the failure could have made any harm. If so, the procedure should include a "late" security review. In terms of an international standard this constitutes a problem (see point 16).

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

No proposals

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Republic of Korea

Report Q244

in the name of the Republic of Korea Group
by Jin Hwan KIM

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The Korean Patent Act and its related laws do not provide a definition of inventor, and the definition of inventor in Korea has been established by case laws. According to the Korean case laws, only a person who has substantially engaged in the creative process of an invention can be considered as an inventor.

As discussed above, person A or person B can be considered as an inventor only when he/she has substantially engaged in the creative process of the invention.

Thus, person A can be an inventor when he/she has provided, added or supplemented a concrete idea to accomplish the invention. If person A has simply controlled person B (e.g. provides person B with a subject without indicating any substantial solution) or has merely provided person B with funds or facilities, person A may not be considered as an inventor in Korea.

Further, in order for person B to become an inventor, person B should have made creative contributions to the substantive features of the invention. If person B has simply followed instructions from person A to collect data or conduct experiments, person B may not be considered as inventor in Korean.

Meanwhile, the citizenship or residence of person A and person B does not affect their inventorship in Korean.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

Although the Korean laws do not provide guidance as to determining inventorship on which basis, it is generally admitted that a person can be considered as an inventor when he/she has contributed to establish a creative feature of an element (except for a known element) of an invention (i.e., a claim) included in a patent application.

2) **Does your law of inventorship depend on the citizenship of the inventor(s)?**

no

3) **Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?**

no

4) **Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

Before allowance of a patent application, the inventorship can be corrected without limitations. After the allowance, the inventorship can be corrected only when the error is obvious. The obvious error includes, for example, a name change of an inventor, a wrong description of an inventor's resident-registration number (only for Korean inventors), a repetition of a same inventor, etc.

5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

Basically, an error in the inventorship does not affect the validity or enforceability of the patent, provided that there is no error in the applicant(s) of the patent application. That is, even when there is an error (intentional or unintentional) in the stated inventorship on the patent application, if the right to obtain a patent has been duly transferred from the inventor(s) to the applicant(s), the patent will be safe. For example, in Korea, it is common to list all members of a research team as joint inventors regardless of individual contribution to an invention. Such an intentional error in the inventorship does not constitute a ground for invalidation of the patent, provided that the patent applicant (e.g., a company) has received the right to obtain a patent from all of the true inventors.

6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

no

The Korean Patent Act does not have any express provisions requiring that an invention developed in Korea be first filed in Korea or filed abroad after first obtaining a foreign filing license. That is, the Korean Patent Act does not prohibit the filing of a patent application for an invention developed in Korea, initially in a foreign country.

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

Under the Korean Patent Act, generally, no prior "foreign filing license or approval" is required for filing a patent application in a foreign country.

However, the Korean Intellectual Property Office may prohibit a patent applicant from filing a patent application in a foreign country, if necessary for the purposes of national defense under Article 41 of the Korean Patent Act. Please note that the Korean Intellectual Property Office can determine whether to prohibit foreign filing only based upon review of a Korean patent application. In other words, if no patent application is filed in Korea, then the prohibition of Article 41 of the Korean Patent Act cannot apply.

On a related note, in connection with foreign filing, the assignment of the right to an invention (originated from Korea whether it is invented by a Korean national or by a non-Korean national) to a foreign entity may be subject to regulations related to the export of technology (subject to the technical fields of the technologies at issue) as follows:

(i) Regulation on National Core Technology under the Industrial Technology Disclosure Prevention and Protection Act ("ITDPPA")

In general, the purpose of the ITDPPA is to prevent illegal disclosure of "industrial technology" and to regulate export (e.g., the assignment and transfer) of the "National Core Technology." The National Core Technology refers to industrial technologies having a high technical or economic value, or a high growth potential in the domestic/foreign market, and whose disclosure outside of Korea poses a serious threat to the national security or economy. Although the ITDPPA does not specifically define "export," one definition of "export" may include the transfer (assignment or licensing) of an invention disclosure, a patent application or a patent.

(ii) Regulation on Strategic Goods under the Foreign Trade Act ("FTA") and Technology Development Promotion Act ("TDPA")

There is another set of statutes relating to export control of technology. Under the FTA, the TDPA and the Combined Notice on the Export/Import of Strategic Goods and Technology promulgated by relevant ministries (the "Notice"), "export" of "strategic technology" is regulated. Under Article 2 of the Presidential Decree of the FTA, the definition of "export" includes:

(i) transfer or grant of exclusive or non-exclusive license by a "resident" to a "non-resident" of patent rights, utility model rights, design rights, trademark rights protected by Korean laws; and (ii) transfer of intangible goods in an electronic form through information technology network from a "resident" of Korea to a "non-resident". The Notice also lists the types of technology considered to be "strategic technology." The FTA defines exports as the transfer or grant of exclusive or non-exclusive license by a "resident" to a "non-resident" of patent rights. From this, it may be reasoned that any invention conceived by a "resident" would be subject to the provisions of the FTA, TDPA and the Notice.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

As discussed in 1) above, only a person who has substantially engaged in the creative process of an invention can be considered as an inventor under the Korean case laws, and the determination of inventorship is conducted on a claim-by-claim basis. It may be neither necessary nor desirable to make a uniform and more-detailed definition of inventor since it can vary depending on the fields of technology and also on the advance in technology. In that sense, the definition of inventor established by the Korean case laws could be considered as being an appropriate definition of inventor.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There are no requirements for the first filing in Korea under the Korean laws.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There are no requirements for the secrecy review before a foreign filing under the Korean laws.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

Since no prior foreign filing license or approval is required for filing a patent application in a foreign country under the Korean laws, generally, multinational inventions originated, at least in part, from Korea can be freely filed in a foreign country without limitations.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Such harmonization may be necessary and desirable. However, it may be difficult or even impossible since this area relates to the national interest of each country.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

As discussed in 8) above, a comprehensive and broader definition of inventor would be suitable for the international standard, such as, for example, that only a person who has substantially engaged in the creative process of an invention can be considered as an inventor, as being established by the Korean case laws.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

As an international standard for correction of inventorship, it may be desirable to allow the correction only for unintentional errors during pendency of the patent application. As for the allowable scope of correction, it may be desirable to include addition of an omitted inventor as well as correction of any description errors on the inventorship in the patent application.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

We believe that the first filing requirements are not necessary.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

We believe that the secrecy review requirements are not necessary.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Since we believe that the first filing requirements are not necessary, the foreign filing license is not applicable.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Since we believe that the first filing requirements and the secrecy review requirements are not necessary, such an international standard is not applicable.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Summary

As an international standard, an expansive definition of inventorship would be suitable, such as, for example, that only a person who has substantially engaged in the creative process of an invention can be considered as an inventor. Further, it is proposed to allow correction of inventorship after filing of a patent application only for unintentional errors and during pendency of the patent application. As for multinational inventions (and also for other inventions), we don't believe first filing and secrecy review requirements are necessary. Thus, we proposed, for the international harmonization, that the first filing and secrecy review requirements should be repealed in the countries that have such requirements.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Russian Federation

Report Q244

in the name of the Russian Federation Group
by Aleksey ZALESOV

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The definitions of inventorship and co-inventorship for the Russian invention patents are provided in Articles 1347-1348 of the Civil Code of the Russian Federation. Concerning Eurasian patent inventorship – it is specified in Rule 9 of the Instruction to the Eurasian Patent Convention.

The Russian law requires that the invention is to be created by joint creative activity to establish co-inventorship. No connection with location (in this country or abroad) is mentioned in the law. It means that inventors should 1) communicate over inventive idea 2) each should make a creative contribution. Inventor separately elaborated same inventions can not be considered as co-inventors. Such inventions should be considered separately.

The Eurasian Patent Law provides very close definition stating that co-inventors are those who created invention by joint creative activity.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

Inventorship for Russian invention patent relates to inventions which can be "parts" of applications. Indeed if single application includes several inventions (independent claims) it can include different co-inventors for different inventions.

Same approach is established by the Eurasian patent law for Eurasian patent.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Inventorship does not depend on citizenship of inventors according the Russian patent law. Same approach is established by the Eurasian patent law for Eurasian patent.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Inventorship does not depend on residency inventors in the Russian patent law. Same approach is established by the Eurasian patent law for Eurasian patent.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Inventorship for Russian or Eurasian patent application can be corrected after the filing till the grant (registration and publication) either voluntarily or by Court decision (if there is a dispute on the inventorship). After grant of patent such correction can be done only if Court ordered that.

List of inventors can be corrected voluntarily during the Prosecution of Russian or Eurasian patent application. Documents with signatures of all inventors normally are required by Patent Office as confirmation (along with appropriate office fee).

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

The Russian law (article 1398 of the Civil Code of the Russian Federation) states that issuance of patent with wrong indication of inventorship is a ground for invalidation of patent in full or in part. Such invalidation Ruling is to be done by Court (now it is under jurisdiction of the Intellectual Property Court). There is now guidance what difference makes intentions but since the court decision should be reasonable and just in case of unintentional omission of inventor – most likely the Ruling will be to invalidate current patent and to grant new with full list of inventors in it.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

no

The Russia law (Article 1395 of the Civil Code) requires that the application for invention created in the Russian Federation is to be first filed in the Russia Patent Office. There is NO limitation relating to any technology.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

no

There is NO foreign filing license system in Russia. Invention created in Russia must be first filed in Russia and foreign filing is available after 6 months unless Russia Patent Office notifies applicant that it is prohibited due to the secret character of application.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

The residency or nationality of inventors does not matter in establishing inventorship for joint inventions.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

no

It is not a violation.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

The violation of first filing requirement can be considered as administrative violation and may result in a fine. But if application filed with violation of first filing requirement happened to comprise state secret information (even found as secret afterward) – such violation may result for criminal prosecution for disclosure of state secrets.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

There is NO difference for field of art specified in the law.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

The check if application comprises state secret information is being done automatically without any costs to applicant within 6 months after the filing.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

If application has been filed with violation of first filing requirement and it happened to comprise state secret information (even found as secret afterward) – such violation may result for criminal prosecution for disclosure of state secrets. During the criminal case public prosecutor should find if accused person new or should have known that the application comprised secret information (the definition of guilt for criminal case must be present).

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

We believe that the definition of inventorship in the Russia law is rather broad and for this particular situation it does not require specification.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

We believe that the law in this part can be amended by exclusion from first filing in Russia rule of applications although created in Russia but have foreign citizens in the inventor's list. It is not reasonably possible to claim state secret of information which legitimately is in the possession of foreign citizens (at least without their direct approval). So the law should include mentioning of Russian citizenship of inventors as requirement for first filing Rule.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

The secrecy regulation in the law should cover only inventors who are Russia citizens.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

No

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

Yes, we believe that harmonization in that field is recommendable

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

Those who made invention as a result of joint creative activity are to be named as inventors in the application.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

We believe that it can be done upon approval of all inventors indicated in the application.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

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- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

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- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

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- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**

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- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

We believe that multinational inventions should be excluded for first filing or state secret regulations.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Singapore

Report Q244

in the name of the Singapore Group
by Woon Chooi YEW and Winnie THAM

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

An inventor is defined in Section 2 of the Singapore Patents Act (Cap. 221) as follows: "inventor", in relation to an invention, means the actual deviser of the invention and "joint inventor" shall be construed accordingly

However, the phrase "the actual deviser of the invention" is not further defined in the Patents Act but has been interpreted by the Court in the case of *Dien Ghin Electronic (S) Pte Ltd v Khek Tai Ting* [2011] 3 SLR 227 to mean the natural person who "came up with the inventive concept" or has contributed to the "formulation of the inventive concept". Individuals who merely "contributed to the claim" in the form of "non-patentable integers derived from the prior art" would not be considered as inventors.

Person A would be considered an inventor under Singapore law if he contributed to the formulation of the inventive concept, even though the precise details of how the inventive concept may be realised into a functional product may be worked out by other persons.

Person B would be considered as an inventor under Singapore law if his contribution to the invention goes beyond the "non-patentable integers derived from the prior art" such that he has contributed to the formulation of the inventive concept. For example, he would not be considered an inventor if he merely assisted in carrying out the experiments as per the instructions of Person A, cleaned up the equipment in the laboratories or supplied the necessary starting materials.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

In determining whether a person is an inventor within the meaning of Section 2 of the Patents Act, the court would first identify the inventive concept in the patent application, followed by determining whether that person has contributed to the inventive concept.

The phrase “inventive concept” is not defined in the Patents Act. Though the High Court in *Dien Ghin* did not specify the approach taken in identifying the inventive concept (i.e. whether only the claims are considered or whether the claims, together with the description and drawings are considered), the inventive concept identified by the court in that case is clearly derived from the independent claims of the patent application in question.

This approach is supported by Section 113 of the Patents Act, which states that an invention in a patent application shall be taken to be that specified in the claims as interpreted by the description and any drawings contained in the patent specification.

Therefore, the inventive concept should be identified or derived from the claims, as interpreted by the description and any drawings contained in the patent specification.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

The Singapore law of inventorship does not depend on the citizenship of the inventor(s).

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

The Singapore law of inventorship does not depend on where the invention was made.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

The inventorship of a patent application can be corrected after the filing date in Singapore. Correction can take various forms, for example:

- correction of the name or address of the inventors
- addition of additional inventors
- removal of inventors

Correction of name of inventors This is a simple process and can be done at any time by filing the requisite form. The Registrar may request for proof of the alteration.

Addition of additional inventors or removal of inventors

Rule 17(1) of the Patents Rules provides that any application for the addition or removal of inventors shall be made on a prescribed form and accompanied by a statement setting out fully the facts relied upon. The Registrar will send a copy of the application and grounds to the patent owner, inventors and other interested parties, and they may oppose the application if they object to the same. Where there are no objections by the patent owner or the named inventor(s) or where the objections are resolved in the applicant’s favour, the Registrar may include the applicant as an inventor to the patent application or issue a certificate removing the inventor.

Time limits for correction of inventorship

There are no time limits for the correction of inventorship.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

In responding to this question, we assume that an “error in the stated inventorship” means either an individual was named as an inventor when he should not have been named, or an individual was not named as an inventor when he should have been.

The following are possible consequences of an error in the stated inventorship on a patent application in Singapore:

a) Any person (including a third party) may apply to the Registrar to add an individual as an inventor pursuant to Section 24(1), or to remove an individual from being named as an inventor pursuant to Section 24(3) of the Patents Act. If there are no issues, the relevant action would be taken without affecting the patent.

b) If errors in the inventorship affects the entitlement to grant, and an application is filed pursuant to Section 20(1) of the Patents Act by a person alleging that he is entitled to the patent, the Registrar may refuse to allow the patent application to proceed to grant. On the other hand, the Registrar may, pursuant to Section 21 of the Patents Act, allow the application to proceed to grant, and then deal with the issue as though it is referred under Section 47(1) of the Patents Act (see paragraph c).

c) In the case of a granted patent, any person claiming a proprietary interest to a granted patent may refer the question of proprietorship to the Registrar pursuant to Section 47(1) of the Patents Act, and the Registrar may make such orders as he deems fit, including adding the applicant as a proprietor. However, the Registrar would not be able to order the patent to be revoked unless an application was also made under Section 80 (see paragraph d), even where the Registrar finds that the patent was granted to a person not entitled to be granted that patent (whether alone or with other persons).

d) In the case of a granted patent, the Registrar (or the court) may revoke the patent (upon the application of any person under Section 80) on the basis that:

- the patent was granted to a person who is not entitled to be granted the patent or
- the patent was obtained fraudulently, on any misrepresentation or on non-disclosure or inaccurate disclosure of material information.

An intentional error in the stated inventorship on a patent application may amount to fraud. Even if the error was unintentional, it could amount to a misrepresentation if it actually deceived the Registrar into granting the patent.

If the error is intentional, generally, the consequences will be more severe as the Registrar has the powers to make the appropriate orders.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

no

The law is not limited to a specific area of technology and applies to all inventions made in Singapore by a person resident in Singapore.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

Yes. A person resident in Singapore may request for grant of written authority by the Registrar pursuant to Section 34 of the Patent Act ("**Foreign Filing Licence**") for an invention to be filed first in another country. A Foreign Filing Licence is referred to as "National Security Clearance" in Singapore.

Section 34 of the Patents Act states that no person resident in Singapore shall, without written authority granted by the Registrar, file or cause to be filed outside Singapore an application for a patent for an invention. However, the requirement applies where the person filing or causing the application to be filed is **resident** in Singapore, and not necessarily where the invention is made in Singapore.

Any application outside Singapore will have to be filed at least two months after the date of filing in Singapore.

Thus, Singapore law requires that an application for a patent claiming an invention made in Singapore be first filed in Singapore, if the inventor(s) and/or the applicant is resident in Singapore.

Any person requesting for a Foreign Filing Licence must submit a form to the Intellectual Property Office of Singapore ("**IPOS**") giving details of the person seeking the Foreign Filing Licence, the country in which protection is sought and the technology cluster of the invention. This form must also be accompanied by a brief summary of the invention and the drawings.

IPOS would generally respond in less than 5 working days upon receipt of the application. The request is made online or manually via the Service Bureau if the online application cannot be made, but the latter will be slower. If the subject matter of the invention involves defence or national security, the processing of the application may take a longer period, sometimes even 1 to 2 months.

Additionally, where urgent consideration of the application is required, the applicant is encouraged to inform IPOS via telephone before such an application is made.

No official fees are payable to obtain a Foreign Filing Licence.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

A Foreign Filing Licence cannot be obtained retroactively.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

It is necessary to obtain a Foreign Filing Licence only where an inventor or an applicant of a patent application for an invention is a **resident** of Singapore. A resident includes a person who, at the material time, is residing in Singapore by virtue of a valid pass lawfully issued to him under the Immigration Act (Cap. 133) to enter and remain in Singapore for any purpose. The citizenship of the inventor and the nationality of the patent owner are therefore not relevant in ascertaining whether it is necessary to obtain a Foreign Filing Licence.

Where the invention was made jointly by an inventor resident in Singapore (“**Resident Inventor**”) and an inventor resident outside Singapore (“**Non-Resident Inventor**”), a patent application for the invention can be filed first in a country outside of Singapore *by the Non-Resident Inventor* pursuant to Section 34(2) of the Patents Act. Although the requirement to obtain a Foreign Filing Licence does not apply to a patent application for an invention filed first in a country outside of Singapore *by the Non-Resident Inventor*, the Resident Inventor may still be in contravention of Section 34 of the Patents Act if he/she *caused the patent application to be filed first outside Singapore*.

Hence, it is prudent to obtain a Foreign Filing Licence as long as there is one Resident Inventor.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

no

Filing a request for a Foreign Filing Licence in another country does not amount to filing or causing a patent application to be filed in that country and therefore, would not amount to a contravention of Section 34(1) of the Patents Act (which requires applications to be first filed in Singapore except where the Registrar has granted written authority otherwise).

The criminal sanctions for contravention of Section 34 of the Patents Act only applies where any person “*files or causes to be filed an application for the grant of a patent in contravention of*” Section 34(1).

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

Contravention of the requirement for first filing in Singapore is a criminal offence and any person convicted of such an offence is liable to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 2 years or to both.

The inadvertency of the error would be taken into consideration in deciding the quantum of fines imposed on the person who contravened Section 34 of the Patents Act. The IPOS website states that where the failure to obtain a Foreign Filing Licence is inadvertent, the Registrar *may*, after considering the facts of the case, compound the offence upon payment of a sum of money not exceeding \$2,000, and no further proceedings will be taken against that person.

- 7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

The Patents Act requires Secrecy Review to be conducted for all areas of technology. However, it is very likely that operationally, Secrecy Review is only conducted for those areas of technology where inventions are likely to be prejudicial to the defence of Singapore or safety of the public.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

After a patent application is filed in Singapore, Section 33 of the Patents Act requires the Registrar to give directions to prohibit or restrict the publication of the patent or the communication of information contained in the patent application if the Registrar is of the opinion that the patent application contains information which is prejudicial to the defence of Singapore or the safety of the public ("**Secrecy Review**").

A Secrecy Review will be conducted by the Registrar whenever a patent application is filed in Singapore (whether as a domestic application or as an application under the PCT). It is an automatic process and there are no costs associated with this review.

The Registrar has to notify the Minister of the patent application and the Registrar's directions, and the Minister will decide whether to affirm the Registrar's decision or to make some other order.

A patent application can only be filed outside of Singapore if no directions have been given under Section 33 of the Patent Act prohibiting the publication of the patent or the communication of information relating to the patent, or where all such directions have been revoked.

If the Registrar wishes to prohibit the disclosure of the invention, the Registrar has to give directions within 2 months of the filing of the patent application.

One condition for granting a Foreign Filing Licence is that the Registrar must not have issued directions prohibiting the disclosure of the invention pursuant to Section 33.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Failure to comply with the directions given by the Registrar pursuant to Section 33 is a criminal offence and any person convicted of such an offence shall be liable on conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 2 years or to both.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

An inventor is defined in Section 2 of the Patents Act to mean "the *actual deviser* of the invention".

The phrase "the *actual deviser* of the invention" does not provide clear guidance as to who should be named as inventor(s) of a patent application. This phrase has been interpreted by the courts as meaning a natural person who has contributed to the "formulation of the inventive concept". However, the phrase "inventive concept" itself is a nebulous concept which is difficult to identify. It is recognised that it may not be possible to be very specific about how the identification of the "inventive concept" is to be done.

Nevertheless, to provide clearer guidance to the inventors, the phrase "actual deviser" and "inventive concept" should be defined in the Patents Act.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

A Foreign Filing Licence is needed for a first filing overseas where an inventor or an applicant is resident in Singapore. However, the term “person resident in Singapore” is not clearly defined. It is defined as including a person who is residing in Singapore by virtue of a valid pass lawfully issued to him under the Immigration Act. This may possibly include persons who are visiting Singapore on a social visit pass for a short period.

Considering the fact that inventions may have inventors who reside in different countries, and also the fact that other countries are also likely to have similar provisions requiring a Foreign Filing Licence for resident inventors, there is a real need for harmonisation of laws relating to Foreign Filing Licences.

As an invention may take place over a long period of time, and an inventor may be resident in several countries during the period of invention, it is not inconceivable that an inventor may have to apply for Foreign Filing Licences in more than one country!

The law provides that “no person resident in Singapore” shall cause a first filing of an application overseas without obtaining a Foreign Filing Licence. It is not clear whether this section only applies to persons resident in Singapore at any time during the period of the invention or only at the time of the proposed first filing overseas. It is proposed that this Section be amended such that it only applies to persons resident in Singapore at the time of the proposed first filing overseas. This will ensure that the Singapore Patents Act does not apply to persons outside the jurisdiction of Singapore, and any foreign inventor/applicant who ceases to be resident in Singapore would only be governed by the laws in the country where he is resident.

In most cases, inventors do not make the decision as to where the application is to be filed. Hence the obligation to obtain a Foreign Filing Licence should not be imposed on inventors, but should be imposed on applicants only.

It should also be permissible for Foreign Filing Licences to be obtained retroactively, provided that such application to obtain the Foreign Filing Licence is made before any publication of the patent application.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

Section 33 of the Patents Act requires the Registrar to carry out Secrecy Review when an application is filed in the Registry “whether under the Act or any treaty or international convention”. This is wide enough to include PCT applications entering national phase in Singapore, which can cause hardship to foreign applicants. The Patents Act should therefore be amended to clarify the scope of this section. The scope of this section should not be so wide that it covers PCT applications filed overseas entering national phase in Singapore, since the Registrar would not have the ability to prevent the publication of such applications if they had not entered national phase in Singapore.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

Scope of Section 34(1)

This section provides that “no person resident in Singapore” shall cause a first filing of an application overseas without obtaining a Foreign Filing Licence. It is not clear whether this section only applies to persons resident in Singapore at any time during the period of the invention or only at the time of the proposed first filing overseas. It is proposed that this Section be amended such that it only applies to persons resident in Singapore at the time of the proposed first filing overseas. This will ensure that the Singapore Patents Act does not ap-

ply to persons outside the jurisdiction of Singapore, and any foreign inventor/applicant who ceases to be resident in Singapore would only be governed by the laws in the country where he is resident.

Section 34(2)

The requirement for a Foreign Filing Licence should be limited to cases where there are Resident Inventors. It clearly does not apply to patent applications where all the inventors are Non-Resident Inventors.

In the case where there are both Resident and Non-resident Inventors, the requirement to obtain a Foreign Filing Licence should still be applicable. As mentioned above, Section 34(2) which allows a Non-Resident Inventor to file overseas without a Foreign Filing Licence introduces uncertainty, especially where there are both Resident and Non-Resident Inventors.

Hence, the scope of Section 34(1) and (2) should be clarified as to the obligations of the Resident Inventor when the Non-Resident Inventor first files overseas.

The issue is whether the Resident Inventor could be considered to have caused the Non-Resident Inventor to first file the application overseas, and therefore be liable to punishment.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Harmonisation is desirable. See proposals below.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

Proposed definition of an inventor

“An inventor is a natural person who has materially contributed to the inventive concept of the invention as set out in the claims and as interpreted by the description and any drawings contained in the patent application, excluding any elements and/or features that are part of the state of the art, and excluding any person who is acting upon the directions of another.”

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

Standard for correction of inventorship

There should be a simple process for the voluntary correction of inventorship by an applicant/patentee where the failure to include or remove the inventor(s) was unintentional or inadvertent. In such cases, there should be no consequences in relation to the patent.

Where the failure to include the inventor(s) or the inclusion of non-inventors was intentional or if it appears to the Registrar to be questionable, more serious consequences should follow. The Registrar should have the power to revoke the patent.

Timing requirements

There should not be any time limits for the correction of inventorship.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

The first filing requirement should apply irrespective of the technologies involved. The requirement should apply in all cases where there is a Resident Inventor. The section which allows a Non-Resident Inventor to file overseas creates uncertainty as regards the obligation of the Resident Inventor and clarifications should be made as to the obligations of the Resident inventor when the Non-Resident Inventor first files overseas.. The Section should only apply where the inventors/applicants are resident in Singapore at the time of the proposed first filing overseas.

In most cases, inventors do not make the decision as to where the application is to be filed. Hence the obligation to obtain a Foreign Filing Licence should not be imposed on inventors, but should be imposed on applicants only.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

Secrecy reviews should be conducted only where the application is first filed in a country, or where a Foreign Filing Licence is sought. It should not apply to foreign PCT applications entering national phase in the country.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing licence.

A foreign filing licence should be granted unless the invention is prejudicial to the national defence or safety of the public. Where a foreign filing licence is not granted, any further disclosure of the invention should be clearly prohibited.

In the case of an application with inventors from different jurisdictions, each inventor may be required by the laws of his country to obtain a foreign filing licence. Hence, details of the invention would have to be disclosed to the authorities of different jurisdictions in order to obtain foreign filing licences. Any such disclosure prior to the issue of directions prohibiting disclosure should not be considered to be in contravention of any laws.

In most cases, inventors do not make the decision as to where the application is to be filed. Hence the obligation to obtain a Foreign Filing Licence should not be imposed on inventors, but should be imposed on applicants only.

The cost for obtaining the grant of foreign filing licence should not be too onerous or too prohibitive and the authorities should not take too long to grant a foreign filing licence.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

An inadvertent failure to comply with a first filing requirement should be cured or repaired by the retroactive filing of foreign filing licence. Security review should be automatically carried out by the authorities, as in the case of Singapore. It should not be the obligation of the applicants to voluntarily submit their applications for security review as applicants view their invention from a commercial angle, whereas the authorities view the invention from a security angle which may not be apparent to a commercial entity. Applicants may inadvertently be liable if they fail to submit an invention for security review.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**

We do not have any proposals other than what have been proposed above.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Spain

Report Q244

in the name of the Spain Group
by Miquel MONTAÑA, Alicia ARROYO, Agueda BONDIA, Luis-Afonso DURÁN, Javier FERNÁNDEZ-LASQUETTY, Santiago JORDÁ, Elena MOLINA, Juan Carlos QUERO and Nicolas RUIZ

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Spanish law does not contain any definition of "inventor" or "inventorship". The Spanish Patents Act (Act 11/1986, of 20 March, on Patents) only stipulates in Sec. 10(1) that the "right to the patent belongs to the inventor or his/her assignees", without defining "inventor" or determining the circumstances under which a certain person would qualify as an inventor.

A new Spanish Patents Act is under discussion in the Spanish Parliament (new draft Patents Act of 24 November 2014, hereinafter "the draft new Patents Act"). The absence of a definition of "inventorship" has not changed in the draft legislation.

Important to note is that the inventor may be the applicant, but not necessarily.

a. If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The Spanish Patents Act does not contain any specific provision dealing with multinational inventions. The legal provisions dealing with co-ownership do not provide for any criteria to determine the inventorship in this case.

Person A and/or B would be considered an inventor under Spanish Law insofar he has contributed intellectually to reach the technical solution to the technical problem (See, for instance, Judgement from the Court of Appeal of Barcelona (Sec. 15) nº 249/2014, 16 July 2014).

Under Spanish law, A would be considered as an inventor whose activities would be governed by its country of residence, while B would be considered as a Spanish inventor (see answer to question 3 below).

In this case Sec. 122(2) of the Spanish Patents Act would be relevant. This provision sets forth the presumption, for the purposes of the first filing requirement, that an invention has been made in Spain where the inventor has his/her habitual residence in Spain. This presumption admits evidence to the contrary. This provision remains unchanged in the draft law (Sec. 115(2) of the draft new Patents Act).

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

No, Spanish law does not contain any provision in this respect

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Spanish law does not contain any provision establishing that the citizenship of the inventor is a condition of inventorship

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

yes

Spanish rules on inventorship apply to inventions made in Spain. The Spanish Patent Act provides that an invention is presumed to have been made in Spain if the inventors have their residence in Spain, unless it can be proved that the invention has been made elsewhere.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

The inventorship of a patent application can be corrected. To do so, it is necessary to have the explicit agreement of the applicant / patentee and all designated inventors. There is no time limit to make the correction and it can be done during prosecution of the application and during the whole life of the granted patent.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

The Spanish Patents Act establishes in Sec. 112(1)(d) - as a cause of invalidation of the patent - the absence of the right to obtain the patent according to Sec. 10(1) aforementioned (see the answer to question 1). The claim for invalidation must be filed before the Spanish Courts. This provision does not specify whether the absence of the right must be due to an error or to any other circumstance (abuse, fraud, etc.) and does not make any reference to its intentional or unintentional nature. Accordingly, whether or not the error (or any other circumstance determining the invalidity of the patent) was intentional is not relevant for the purpose of invalidation (it can be relevant, though, for the purpose of a damages claim, where appropriate).

Where the patent holder is not entitled to the patent, the legitimate holder may claim the ownership of the invention, instead of the invalidation, before the Spanish courts. The term to file this claim is two years following the date of publication of the mention of grant of the patent, unless the registered holder knew at the time of the grant or at the time of acquiring the patent that he/she was not the holder. Accordingly, in the context of a claim to recover ownership, the intentional/unintentional nature of the error or any other circumstance determining the absence of entitlement is relevant.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

Yes. According to Sec. 122(1) of the Spanish Patents Act for the purposes of the secrecy review of patents relating to inventions made in Spain, no foreign patent can be filed within two months from the filing date of the patent application before the SPTO, unless the filing has been done with its express authorization. Under no circumstances will said authorization be granted for those inventions that are of interest to national defence, unless expressly authorized by the Ministry of Defence.

Sec. 122(1) has been amended in the draft new Patents Act. The main changes refer to the term covered by the foreign filing restriction (one month for any patent application, extendable up to four months when the SPTO considers that the invention may be of interest for national defence) and that, it is possible to obtain an authorisation to be entitled to file abroad as a first patent application.

If the answer is yes, please answer the following:

- a. Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

No, the first filing requirement in Spain is not limited to any specific area of technology or limited such that it does not apply to all inventions made in Spain. Sec.122(1) of the Spanish Patents Act simply refers to "inventions made in Spain".

Furthermore, Sec. 119(1) of the Spanish Patents Act dealing with the secrecy review refers to "all" patent applications. Accordingly, the first filing requirement applies to all patent applications regardless the specific area of technology of the invention.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

no

No, as stated above in answer to question 6, Sec. 122(1) of the Spanish Patents Act does not provide for a foreign filing license.

The draft new Patents Act in Sec.115 does provide for obtaining a foreign filing license for inventions made totally or partially in Spain.

To obtain it, it is necessary to file a request together with the full application text. The SPTO will perform the corresponding check and will authorize the foreign filing if the invention is not of interest for national security within one month.

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

The draft new Patents Act does not provide for the retroactive effect of a foreign filing license.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

Under Spanish law, the first filing requirement applies based on the residency of the inventor. Unless proof to the country is submitted, it is presumed that the invention has been made in Spain.

The Spanish Patents Act does not provide how to solve the problem of first filing, when part of the invention has been made in Spain and part in another country. This is solved in the draft new Patents Act, by providing for a request for a foreign filing license.

This new provision (Sec. 115(2)) reads as follows:

"For inventions created either completely or partially in Spain, it is possible to request authorisation in order to submit them as the first application for a foreign patent. For that purpose, the applicant must submit the text of the application to the Spanish Patent and Trademark Office so that the examination set out in Article 111.1 can be performed under confidential conditions. The SPTO may require the submission of a translation, if this should be necessary."

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

no

Spanish law does not contain any specific provision in this respect. No specific provision has been included in the draft new Patents Act either.

Under Spanish law, filing a foreign filing license in the other country would not violate Spanish patent law provided that the license was sought to first file the patent in Spain.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

Although the Spanish Patents Act sets forth the first filing requirement for inventions made in Spain, no penalty is foreseen in the Spanish Patents Act if the applicant fails to meet these obligations.

Yet the draft new Patents Act foresees a penalty. Specifically, Secs. 152(2) and 163(2) of the draft provides that failure to comply with the first filing requirement for European patent applications and International patent applications respectively will result in the lack of effect of the patent in Spain.

Whether the failure or error was intentional or inadvertent would not be relevant for the purposes of the application of the above-mentioned provisions.

On the other hand, the intentional disclosure of an invention protected by a secret patent, with a breach of the Spanish patent regulations is considered a criminal offence provided that this affects national security (Sec. 277 of the Spanish Criminal Code). This offence shall be punished by imprisonment between six months and two years plus a financial penalty.

- 7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Yes. This secrecy review is regulated in Sec. 119 to 122 of the Spanish Patents Act, and Sec. 16 of the Royal Decree 2245/1986.

No changes are expected in the new patents act about to be approved.

- a. If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?

No, this law applies to all areas of technology.

No changes are expected in the new patents act about to be approved.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

The content of all patent applications is kept secret for two months following their date of filing, unless the SPTO authorizes their prior disclosure.

Before expiration of the 2-month period, the SPTO shall extend the period to five months from the date of filing of the application when it considers that the invention reviewed may be of interest for national defence.

If the period has been extended, the SPTO shall inform the applicant of the extension and shall immediately place at the disposal of the Ministry of Defence a copy of the patent application filed.

Finally, where the national defence interests so require, the Ministry of Defence shall contact the SPTO so that before expiration of the period of five months the latter can order that the patent procedure be kept secret and inform the applicant accordingly.

Patents that are granted following the secrecy procedure will be entered in a secret register and will remain secret for one year from the date of being granted. This period may be extended annually and the owner of the patent shall be informed accordingly.

In this regard, it is to be noted that:

- The renewal of the secret status does not apply in time of war until one year after the cessation of hostilities; and

- Following a favourable report by the Ministry of Defence, the SPTO may at any time remove the obligation of secrecy imposed on an application or a specific patent.

There is no extra cost associated with this procedure. Furthermore, it should be noted that if the patent is finally granted, and as long as it remains secret, it is not subject to the payment of annual fees.

No changes are expected in the new patents act about to be approved.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

According to Sec. 121, the owner of a patent may claim compensation from the State for the time during which the patent remains secret.

However, when the owner fails to comply with its secrecy obligation (Sec. 119.5), then Sec. 121.3 establishes that the owner shall lose the right to compensation.

No difference is made whether the disclosure was intentional or inadvertent.

No changes are expected in the new patents act about to be approved.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

Our law does not give any definition of inventorship. The draft new Patent Act does not give such definition either.

If there was agreement among the countries to reach a common definition, a proper harmonized definition should be contained in our law. Otherwise, it would not be desirable.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Current law. As we have already stated, according to Sec. 122(2) of the Spanish Patents Act, when the **inventor** has his/her habitual residence in Spain it is presumed that the invention has been made in Spain and, therefore, there is the requirement to first file the application of the patent in Spain.

Furthermore, one must also take into account that Royal Decree No. 2424/1986, and Royal Decree 1123/1995, establish that when the **applicant** (not the inventor, therefore the invention could have been made out of Spain) of a European/International patent application has its domicile or headquarters in Spain, or its habitual residence or permanent establishment in Spain, and it does not claim the priority of a previous application in Spain, it must compulsorily file the European/International patent application at the SPTO.

Here, attention should be paid to the fact that no Foreign First Filing License is allowed in either cases. However, currently, Spanish law does not establish any specific sanction in the event the First Filing is not done in Spain.

Draft new Patents Act. The draft new Patents Act has also used both criteria (inventorship and applicant) to determine when an application has to be first filed in Spain. The main novelty in this aspect is that the draft new Patents Act:

· With regard to inventions made in Spain, states the possibility to request a first filing license.

Furthermore, it continues without establishing any specific sanction if such requirement is not fulfilled.

· With regard to European patent applications and international patent applications: it states that failing to comply with the obligation of first filing the application in Spain (which has to be done when the applicant has its domicile, residence, etc., in Spain), will imply that the patent shall not come into effect in Spain (European patents) or that the patent application will not come into effect in Spain (International patents).

Furthermore, in this regard, no possibility of requesting, or obtaining, a first filing license is foreseen.

It would be desirable to improve and harmonize the regulation with other national regulations, trying to use only one criteria (inventorship –inventions made in Spain- vs. domicile of the applicant), or clearly stating which criterion prevails in case they enter into conflict.

If such harmonization is not achieved, Spanish law should at least state the possibility to request a first filing license also for European patent applications and international patent applications when the applicant does reside in Spain.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Please see Section III below.

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

Please see Section III below.

III.) Proposals for harmonisation

- 12) Is harmonisation in this area desirable?**

yes

Yes, according to the Spanish Group, harmonisation in this area is desirable.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

The inventor should normally be the creator, conceiver and/or originator of any or all of the patentable invention elements / subject matter.

A person that simply organizes the process (by providing funds, infrastructure or administrative services) and / or performs auxiliary functions during the invention process should not normally be considered an inventor.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

Correction of inventorship should be accepted by any patent office, either if the patent is pending or issued. These corrections could be due mainly to two reasons:

a) A correction in the data of the inventors, the addition or deletion of one or more inventors provided by a declaration of the applicant. If this correction is requested by the applicant, the correction should be accepted without requiring anything further.

b) The addition, deletion or substitution of an inventor, requested by an alleged inventor. In these cases, the alleged inventor should file a request and follow the administrative or court proceedings established by the corresponding national law, submitting the corresponding evidence. The correction should only be made if the corresponding deciding bodies consider that the request is acceptable, according to national law.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

The Spanish Group considers that "first filing requirements" are outdated and that, therefore, it would be desirable for countries to cooperate so that this type of requirements are abandoned.

However, the Spanish Group understands that there may be specific circumstances (for example, when an invention may affect national, regional or international security) where measures aimed at preventing the general disclosure of an invention may be justified. To address these situations, the Spanish Group proposes the following standard:

1. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, and according to the law of a party to such treaty the patent application should be filed first in that country, the patent applicant should also

be allowed to file its patent application first before any of the countries which are a party to such treaty, provided that the parties to such treaty comprise the country where the invention was made.

2. Subject to paragraph 1, for the purpose of determining whether a country is allowed to require that a patent application for an invention be filed first in that country, the following principles should apply:

a. A country may require that a patent application for an invention be filed first in that country if the invention has been made in that country, regardless of the permanent residence of the inventors.

b. Where the invention has been the result of activities carried out in more than one country:

i. A country may require that a patent application for an invention be filed first in that country if said country is the country where the most substantial intellectual contribution to the invention has been made.

ii. In the absence of evidence to the contrary, it will be presumed that the country where the most substantial intellectual contribution to the invention has been made is the country where the invention was conceived (i.e. the country where the original idea for the invention was proposed). However, where inventors other than the inventors who conceived the invention carried out activities that solved problems not identified by the former, and/or that they could not solve, and solving such problems was necessary to put the invention into practice, the country where the most substantial intellectual contribution to the invention has been made will be presumed to be the country where the activities that solved such problems were carried out.

3. If a country establishes penalties for applicants who fail to comply with First Filing Requirements, such penalties should only apply if the invention concerned is directly related to national defence, and according to the corresponding national authorities, the patent should have been prosecuted in secrecy. Any penalties should be reasonable and commensurate to penalties established for failing to comply with other similar administrative requirements. In particular, such penalties should not include the loss of the rights deriving from the patent application.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

The Spanish Group considers that "secrecy review requirements" are outdated and that, therefore, it would be desirable for countries to cooperate so that these types of requirements are abandoned.

However, as mentioned in our answer to Question 15, the Spanish Group understands that there may be specific circumstances (for example, when an invention may affect national, regional or international security) where measures aimed at preventing the general disclosure of an invention may be justified. To address these situations, the Spanish Group proposes the following standard:

For the purpose of determining which country is entitled to conduct a secrecy review, the following principles should apply:

1. Subject to paragraph 2, under the Rules on Multinational Inventions, a country may only introduce secrecy review procedures in relation to inventions directly related to national defence.

2. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, that country should waive this secrecy review procedure so that the for patent application may be filed first in another country which is a party to such treaty.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

The Spanish Group suggests the following principles:

1. Countries should introduce procedures allowing patent owners to obtain a Foreign Filing License.
2. Like all Rules on Multinational Inventions, Rules for obtaining a Foreign Filing License should be prepared and applied in an impartial, transparent, predictable, consistent, fair and neutral manner.
3. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, and according to the law of a party to such treaty the patent application should be filed first in that country, that country should accept granting a foreign filing license allowing the patent applicant to file its patent application first before any of the countries which are party to such treaty, provided that the parties to such treaty comprise the country where the invention was made.
4. Procedures for obtaining a Foreign Filing License should comply with the principles of the TRIPS Agreement. In particular, they should be fair and equitable. They should not be unnecessarily complicated or costly, or entail unreasonable time limits or unjustified delays. Parties should have an opportunity for review by a judicial authority of final administrative decisions relating to Foreign Filing Licenses.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

The Spanish Group suggests the following principles:

1. Countries should allow applicants to obtain a retroactive Foreign Filing License when an applicant has failed to comply with a First Filing Requirement or Security Review Requirement.
2. Countries may refuse to grant a retroactive Foreign Filing License when it is established that the applicant intentionally failed to comply with a First Filing Requirement and/or Security Review Requirement.
3. Like all Rules on Multinational Inventions, Rules relating to the rectification of failures to comply with a First Filing Requirement or Security Review Requirement should be prepared and applied in an impartial, transparent, predictable, consistent, fair and neutral manner.
4. Procedures should comply with the principles of the TRIPS Agreement. In particular, they should be fair and equitable. They should not be unnecessarily complicated or costly, or entail unreasonable time limits or unjustified delays. Parties should have an opportunity for review by a judicial authority of final administrative decisions relating to foreign filing licenses.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

The Spanish Group suggests that the members of the World Trade Organization should, in due course, negotiate an international agreement on "multinational inventions" called "Rules on Multinational Inventions" that could be inspired by some of the standards on which the "Agreement on Rules of Origin" is based. As an alternative, new rules governing "multinational inventions" could be introduced in a future amendment of the TRIPS Agreement, although this option would probably be less preferable, taking into account the foreseeable political difficulties that amending the TRIPS would entail.

"Rules on Multinational Inventions" should be defined as those laws, regulations and administrative determinations of general application applied by countries in order to determine the country in which a patent application for an invention must be filed first, the identity of the inventors, first filing requirements, foreign filing licenses and/or secrecy review requirements.

Under the Rules on Multinational Inventions, a country should only be allowed to require that a patent application for an invention be filed first in that country if the conditions set out in the response to question 15 above are fulfilled.

Summary

The Spanish Patents Act does not contain a definition of "invention" or "inventor". In order to determine where the invention took place, the general rule is that when the inventor is habitually resident in Spain, it is assumed, in the absence of evidence to the contrary, that the invention took place in Spanish territory. The application of this rule raises difficulties in cases where the invention is the result of the collective work of inventors residing in different countries, as the Act fails to specifically regulate the matter of "multinational inventions".

In the case of inventions taking place in Spain, the Act establishes that no patent applications may be filed in other countries until two months have passed since the patent was applied for before the Spanish Patents Office, unless the Office authorises it. For inventions related to national defence, this authorisation cannot be granted without the express authorisation of the Ministry of Defence. The draft bill of the Patents Act envisages the possibility for inventions taking place entirely or partially in Spain to obtain an authorisation to file patent applications abroad first.

The Spanish Group considers that harmonisation of rules in this area is desirable. In particular, it considers that the "inventor" should normally be the person who creates, conceives and/or generates the invention. Moreover, the Spanish Group proposes an international standard that would make it possible to overcome some of the practical difficulties derived from the requirement to present the first application in a particular country.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Sri Lanka

Report Q244

in the name of the Sri Lanka Group
by John WILSON and Pradeepika GUNAWARDHANE

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The applicable law in Sri Lanka is the Intellectual Property Act no. 36 of 2003, ("the Act") read with the regulations published in Government Gazette Extraordinary No. 1,445/10 of the 17th of May, 2006. The definition of "invention" in section 62(1) of the Act is as follows: *"For the purpose of this part, invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology."* In terms of section 62(2), an invention may be, or may relate to, a product or process. Section 67(1) provides that the right to a patent shall belong to the inventor and section 67(2) provides that where two or more person have jointly made an invention, the right to a patent shall belong to them jointly. Section 67 is subject to the provisions in section 68 of the Act which provides that *"Where the essential element of the invention claimed in a patent application or patent have been unlawfully derived from an invention for which the right to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him"*, (subject to certain parameters contained in the two provisos to section 68).

a. If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law? This depends on the terms of any contract in place between the two parties and the relationship between them. For instance, if A is the employer and B is the employee, section 69(1) would apply which provides that: *"In the absence of any provision to the contrary in any contract of employment or for the execution of the work, the right to a patent for an invention made in the performance of such contract of employment or in the execution of such work shall be deemed to accrue to the employer, or the person who commissioned the work, as the case may be; (in this case, A): Provided that where the invention acquires an economic value much greater than the parties could reasonably have foreseen at the time of entering the contract of employment or for the execution of work, as the case may be, the inventor shall be entitled to equitable remuneration which may be fixed by the Court an application made to it in that behalf, in the absence of an agreement between the parties. Section 69(2) provides that "Where an employee whose contract of employment does not require him to engage in any inventive activity, makes in the field of activities of his employer, an invention using data or means placed at his disposal by his employer, the right to the patent for such invention shall be deemed to accrue to the employer, in the absence of any provision to the contrary in the contract of employment: Provided that the employee shall be entitled to*

equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court, taking into account his emoluments an application made to it in that behalf the economic value of the invention and any benefit derived from it by the employer". Section 69(3) provides that the rights conferred on the inventor under subsections (1) and (2) of section 69 shall not be restricted by contract. If, however, as per the factual circumstances, both A and B have jointly made the invention, the right to a patent in respect of the invention would belong to them jointly (section 67(2)). Section 67 reads as follows: "67 (1) Subject to the provisions of section 68 the right to a patent shall belong to the inventor. (2) Where two or more persons have jointly made an invention, the right to a patent shall belong to them jointly. (3) If and to the extent to which two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date, shall have the right to the patent, so long as that application is not withdrawn, abandoned or rejected." It should be noted that in accordance with section 70(1), the inventor shall be named as such in the patent, unless by a declaration in writing signed by him/her or on his/her behalf and submitted to the Director-General of Intellectual Property of the National Intellectual Property Office of Sri Lanka, he/she indicates his/her decision to forgo his/her name being included in the patent. Subsection (2) of section 70 states that the provisions of subsection (1) shall not be modified by the terms of any contract.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

The Intellectual Property Act does not define the term "inventor" nor does it define the term "inventorship". It defines an invention as an "idea of an inventor, which permits in practice the solution to a particular problem in the field of technology." It is therefore arguably the case that the inventor/(s) is/(are) the person/(s) whose idea/(s) permit/(s) the solution to the problem.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, it does not.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, it does not. It should be noted that in regard to the obtaining of a patent, in terms of section 71(1)(c), if the applicant's ordinary residence or principal place of business is outside Sri Lanka, the applicant shall be represented by an agent who is a resident of Sri Lanka whose name and address shall be given in the application, and the application shall be accompanied by a power of attorney granted to such agent by the applicant.

4) **Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

It should be noted at the outset that in terms of section 71(2)(b) of the Act where the applicant for the grant of a patent is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent. Section 71(2)(c) provides that: *"The Director-General shall send a copy of the statement referred to in paragraph (b) to the inventor who shall have the right to inspect the application and to receive on payment of the prescribed fee, a copy thereof."* Subject to what is stated hereafter the answer to the question is arguably yes in view of the provisions contained in section 75. Section 75 ("Amendment and division of application") provides for amendments to patent applications in the following terms: *"An applicant may amend the application, provided that the amendment shall not exceed the limits of the disclosure in the initial application"*. The patent application form prescribed in terms of the applicable regulations (form P01) contains two cages numbered IV. which have to be completed with details of the name and the address of the inventor. Form P01 also provides in Cage VI. ("Basis of the Applicant's Right to the Patent".) for the basis of the applicant's right to apply for the patent to be indicated on the said application form by reference to the following categories:

- *"Applicant is the inventor.*
- *Applicant is the legal representative of the inventor.*
- *Applicant is the assignee of the inventor.*
- *Applicant is the owner of the invention which was made-*
- *while the inventor was in the employment of the applicant*
- *by the inventor in the performance of a contract for the execution of work.*
- *Any other (specify): A statement specifying in more detail, the Applicant's (who is not the Inventor) right to apply for the patent accompanies the application (Provide sufficient copies of the statement for all non-applicant inventors)"*

- *Arguably, the right to amend does not, arguably, arise in the following circumstances. Since in terms of section 77(1) of the Act*
 - *the Director General shall record as the filing date of the application, the date of receipt of such an application - provided that on the date of receipt of the application, the application contains [inter alia]: "(b) the name and address of the inventor and, where the applicant is not the inventor, the statement referred to in paragraph (b) of subsection (2) of section 71)"*; and
- *section 77(2) provides that: "Where the Director-General finds, at the time of receipt of the application, that the provisions of subsection (1) have not been complied with, he shall request the applicant to file the required correction within a period of three months from the date of such request", and*
- *section 77(3) provides that "Where the applicant complies with the request referred to in subsection (2), the Director-General shall record as the filing date, the date of receipt of the required correction; where the applicant fails to so comply the Director-General shall treat the application as null and void."*

it is impliedly and arguably the case that if there is an error in regard to the requirements in regard to the manner in which inventorship should be dealt with on the face of Form P01, then the manner of rectifying such an error is only through filing of a required correction in terms of section 77(2) if the Director finds that the requirements contained in section 77(1) have not been complied; and that this is not a matter which can be amended.

a. If yes, what are the requirements and time limits for such correction?

As already noted, section 75(1) provides that: *"An applicant may amend the application, provided that the amendment shall not exceed the limits of the disclosure in the initial application."*

The section does not refer to a time limit. However once a patent has been accepted for grant, it is likely that the National Intellectual Property Office would not then act on a request for amendment. It may also be possible for corrections to be done by way of an application made to the Director-General of Intellectual Property in the manner set out in Part XI, Chapter XXXV, ("Applications to and proceedings before the Director-General and Court") of the Act.

Section 163 of the Intellectual Property Act provides that:

"(1)The Director-General may, on application made in the prescribed manner by or on behalf of the registered owner of an industrial design, patent, trademark or any other registration provided for under the Act, correct any error or make any change-
a. in the name, address or description of the registered owner of any ... patent... or any other registration provided for under the Act;
b. concerning any other particulars relating to the registration of a ... patent or any other registration as may be prescribed."

- 5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

There is no specific provision in the Act as to what the consequences are if there is an error in the application (request) form tendered to the National Intellectual Property Office, seeking the grant of a patent, if the error is not detected by the Director-General of Intellectual Property. One argument is that such a mistake would arguably and by reference to the provisions in section 77 of the Act, render the patent liable to be declared null and void.

With regard to a substantive error, there is no specific provision in the Act as to what the consequences are.

- 6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

no

No.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

No.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

The Sri Lankan IP Act does not contain a definition of inventorship.

The prevailing national law should be amended by the inclusion of a definition of "inventor" and "inventorship".

The law should be amended to clarify the applicable parameters/criteria by which a person is eligible to be considered as an inventor. This would assist in answering questions such as the extent to which a person has to get involved in the conception of an invention to be considered as an inventor.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

N/A

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

N/A

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

The consequences of a mistake in an application form for the grant of a patent in regard to inventorship (whether the error is on the face of the form or a substantive error) should be clarified

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

We understand that globally, the definition of inventorship is not clear and that there are many different definitions. In the US we understand that in [patent law](#), an inventor is the [person](#), or persons who contribute to the [claims](#) of a [patentable invention](#).

In other patent law frameworks, however, such as in the [European Patent Convention](#) (EPC) and its [case law](#), no explicit, accurate definition of who exactly is an inventor is provided. The position may vary in certain degrees from one European country to another. It would appear that inventorship would generally not be considered to be a patentability criterion under [European patent law](#).

It would seem that as a matter of U.S. case law, an inventor is the person with "intellectual domination" over the inventive process, and not merely one who assists in its [reduction to practice](#).

Given these different approaches, it is difficult to formulate a single definition.

What is more important in our view is that challenges to the validity of granted patents on the basis of various arguments, premises or notions in regard to concepts of inventorship should not be possible. In our view, granted patents should not be set aside or found to be null and void merely by reason of the fact that there is doubt, an error, or an omission in regard to inventorship. The law could provide for rectification in these circumstances.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

In our view it should be possible to correct an error or omission in regard to inventorship at any time. A time bar for corrections may not be appropriate. That said, corrections of inventorship to pending applications would, practically speaking, likely only arise during the pendency of the application. After grant, it should be possible for an application to be made to the relevant Court.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

First filing requirement should not be a necessary requirement.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

A secrecy review requirement should not be a necessary requirement.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

The obtaining of a foreign filing license should not be a necessary requirement.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

If such an inadvertent failure occurs, such failure should be curable/correctable or repairable or rectifiable under national law.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Where there is an error in regard to inventorship, the widest possible opportunity should be provided for a person aggrieved to have the application or the granted patent cured/corrected/repared/rectified.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Sweden

Report Q244

in the name of the Sweden Group
by Jonas WESTERBERG, Louise JONSHAMMAR, Lisa EURENIUS, Kristian FREDRIKSON, Ivan
HJERTMAN, Wendela HÅRDEMARK, Ia MODIN, Jan MODIN and Anna TARRING

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

There is no explicit definition of inventorship in Swedish law. Reference to inventorship restricts itself to what is stated in Chapter 1 Section 1 of the Swedish Patents Act regarding who may be granted patent for an invention. The act states that any person, who has made an invention which is susceptible of industrial application, or his or her successor in title, may upon application obtain a patent for the invention in Sweden. Some guidance on the application of the law in relation to inventorship can be found in the assessment of co-inventorship.

The relevance of the location of the individuals involved is dealt with separately under the answers to questions 2 and 3.

The inventor is the person having intellectually generated the invention, the person having conceived of the innovative step beyond prior art. Should several persons have independently contributed to the final result which is the invention, they are all co-inventors.

Being regarded as co-inventor requires having independently and intellectually contributed to the finalised invention. In general, such contribution shall express innovative technical problem solving and constitute a part of the inventive step. Mere assistance in the research process which lacks independence, such as the performance of routine tasks or compilation of information pertaining to prior art, shall thus not be regarded as contributing to the invention.

Whether person A and person B are to be considered inventors, separately or jointly, depends on the nature of the directions and instructions given by person A to person B.

The instructions given by person A may, on the one hand, be a mere suggestion to solve a problem; an expressed vision of a desired result without an associated notion regarding how the desired result may be reached. Should person B, relying only on his/her own intellectual capacity, conceive an invention, when working under such directions and instructions from person A, then person B is to be considered the sole inventor of the invention. Person A will not have contributed to the invention as such; the mere desire for a solution to a problem will not in itself contribute to a new invention and will thus not constitute grounds for co-inventorship.

It may on the other hand be the case that already the instructions themselves contain the invention as such. Person A may have identified not only the problem but also a potential solution, which in itself would constitute an invention. Person A may there-

after instruct person B to perform actions aimed at verifying the hypothesis of person A. Given that the hypothesis proves to be true, the invention would already have been finalised when the instructions were given and person A shall be regarded as the sole inventor of such an invention.

It is however not unusual that intellectual contributions from both person A and person B are essential for the invention, in which case both A and B shall be regarded as co-inventors of the invention.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Swedish law, lacking a definition of how to define inventorship, does not relate inventorship to any special part of a patent application. However, as the scope of protection of the patent will comprise only the scope of the claims, to be considered inventor or co-inventor, the independent intellectual contribution to the invention should be found in the patent claims.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No. Swedish law applies to the issue of inventorship for all Swedish national patent applications and under its rules the inventorship issue and right to apply for a patent in Sweden is not affected by the inventor's citizenship.

To the extent patents for Sweden are granted by the European Patent Office (the EPO) according to the European Patent Convention (the EPC), Swedish courts have jurisdiction over disputes concerning patent applications according to the "Act on the jurisdiction of Swedish courts in certain actions in the area of patent law"

Said act provides that Swedish courts have jurisdiction in disputes concerning entitlement to EPO patent applications (including those based on inventorship) if and to the extent the applicant is domiciled in Sweden or if the plaintiff is domiciled in Sweden and the applicant is domiciled in a non-contracting state. There is no express provision on applicable law in these cases. Swedish courts would generally apply the principle of closest connection to decide on the choice of law issue and one factor would likely be where the invention was made (see below regarding choice of law regarding employee inventions being subject to an EP patent application).

In respect of disputes concerning employee inventions, Swedish courts furthermore have jurisdiction if a) the invention was made by the employee while he/she was working in Sweden or, if its unclear where the employee was working, if he/she was linked to a permanent establishment in Sweden during the relevant point of time, or b) the parties have agreed on Swedish jurisdiction. Swedish law applies in disputes according to a) above. In disputes according to b) above, the law of the country where the employee was working when he/she made the invention shall apply. If it is unclear where the employee was working, the law of the country where the permanent establishment to which the employee was linked during the relevant point of time, shall apply.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, but it can affect the choice of law (see above). See also the specific rules regarding defence inventions (the Swedish Act on Defence Inventions (FUL)) in the answer to question 7 below.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

After filing the patent application but before grant of the patent, the applicant may file a request of change or correction of inventorship with the Swedish Patent and Registration Office (the PRV) at any time. No formality requirements apply and the applicant does not need to file any documents to support the request.

Historically, the PRV would request that the applicant filed a consent from the other inventors if an inventor were to be added or removed from the application (for removal, the inventor to be removed also needed to give his/her consent). However, case law from the Court of the Patent Appeals suggested that the information provided in a patent application – including the formal requirements – is the property of the applicant alone and that the inventors have no say in any formality relating to the application.

After patent grant, it may still be possible to correct inventorship but special requirements apply.

Historically, the PRV was of the opinion that the information regarding the inventor/-s was information that could not be changed after grant of the patent. A court decision that the information was wrong would of course be binding, and lead to a change in the register. The Court of Patent Appeals changed the practice of the Patent Office with a decision saying that if the patentee claims that the patent register holds wrongful information, the Patent Office must apply Section 27 of the Administrative Procedure Act to the request for change in the register (see below).

The patentee may request recordal of changes to the patent register after grant. When the patentee requests that an inventor is removed from or added to the patent register, the PRV shall try the request with the application of Section 27 of the Administrative Procedure Act.

Hence, if the decision to grant the patent includes incorrect information about the inventor/-s, it may be corrected by the same authority that granted the patent. This means that corrections of inventorship in the patent register for European patents that have been granted by the EPO and validated in Sweden, cannot be done by applying Section 27 of the Administrative Procedure Act.

The Swedish Patents Act has one section concerning proper title to the invention (Section 17) and one section concerning proper title to the patent (Section 53). In practice, these sections have been interpreted as also covering inventor's rights, i.e. that a person may claim to be the proper inventor or co-inventor to an invention/a patent. Inventorship may therefore be corrected by filing a claim of proper title regarding inventorship with the district court.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

A patent may be granted to anyone who has made an invention, or to his/her successor in title (Section 1 of the Swedish Patents Act).

As described in the answer to question 4 above, during the patent application proceedings, before grant, claims for proper title of the invention may be brought before the Patent Office or the district (civil) court. If it is proven before the Patent Office that the proper title to the invention belongs to another person than the inventor/-s specified in the patent application, the Patent Office shall transfer the application (or part of the application) to that person, if

he/she so demands. If the person awarded inventorship or co-inventorship does not request a transfer of the patent application, the application must be dismissed since a patent may only be granted to the true inventor or his/her successor in title.

A patent may be invalidated if it has been granted despite the fact that the requirements under Section 1 are not fulfilled (Section 25 and 52 of the Swedish Patents Act, i.e. both in opposition proceedings before the Patent Office and as a result of a claim for invalidity in civil court). This includes applicant's lack of proper title to the invention claimed. However, third party's entitlement to a share of the invention is not grounds for invalidation.

In neither of these circumstances/proceedings, does it matter if the error was intentional/unintentional.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

No, the relevant provisions apply regardless of area of technology per se but to Swedish defence inventions only.

A Swedish defence invention is an invention concerning military equipment made in Sweden or owned by a physical or legal person domiciled in Sweden. A defence invention can be an invention in any area of technology.

According to Section 79 of the Swedish Patents Act and Section 10 of the Swedish Act on Defence Inventions (FUL), a patent application for a Swedish defence invention, which is to be maintained confidential according to FUL provisions, may only be filed with the consent of the Swedish government.

Consent to filing a patent application outside of Sweden may only be given if confidentiality can be maintained also in the foreign state. Sweden currently has bilateral agreements with the United States, the United Kingdom, France, Germany and Italy, allowing for confidentiality after filing in those states. A framework agreement concerning measures to facilitate the restructuring and operation of the European defence industry has been signed by Sweden and the above mentioned European states with the addition of Spain. Pursuant to this framework agreement, an implementing arrangement has been agreed upon. A Swedish defence invention cannot be prosecuted as a European patent application, but must be pursued as national patent applications in Sweden and in the above mentioned European states.

Section 5 FUL states that any person wishing to file a patent application for a Swedish defence invention by filing an international patent application or a European patent application with a receiving office other than the PRV, shall first apply for a secrecy review.

Thus, in principle, an applicant is free to file a first patent application for an invention made in Sweden in a different state. However, if the applicant considers that the invention may be classified as a Swedish defence invention, a secrecy review should be carried out before filing abroad.

For an invention which could classify as a defence invention also in a foreign state, the situation is not entirely clear. In the implementing arrangement mentioned above, it is agreed that, for an invention conceived within the context of a transnational defence contract or other transnational defence activities, a first patent application should be filed in the state in which the invention was made "entirely or mainly". For example, if a party based in the UK places a defence related contract in Sweden and an invention is conceived under this contract, a first patent application should be filed in Sweden, even though the invention may classify as a British defence invention.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

For national applications filed with the PRV as well as for European patent applications and international patent applications filed with the PRV as a receiving office, the PRV is responsible for assessing whether the invention may be a Swedish defence invention. If so, the application is handed over for a confidentiality assessment to the Swedish Defence Material Administration (the FMV).

Anyone who wants to make public, or otherwise disclose, a Swedish defence invention shall apply for such a confidentiality assessment, as shall anyone who wants to file a European patent application or an international patent application with a receiving office other than the PRV.

If the FMV finds that it is of significant importance for the national defence that the invention is kept confidential, it sends the application and its motivated decision to the Swedish Review Board for Defence Inventions for a final assessment. If the Review Board agrees with the FMV's assessment, it shall issue an order that the invention may not be made public or otherwise be disclosed without authorization.

The confidentiality assessment must be finished within three months from the date of filing with the PRV, or, if priority is claimed, within 13 months from the priority date. If not, the invention cannot be kept confidential under FUL provisions.

If it is ordered that the invention is to be kept confidential, the applicant may request the government to assume ownership of the invention. The government shall pay reasonable compensation for all damages caused by the order.

If the invention is found to be of significant importance for the national defence, the government may order that the invention can be used by or for the government, or that all rights to the invention shall be expropriated and ceded to the government. The government shall in this case pay reasonable compensation for the rights to the invention and for the additional damage caused by the order.

The procedure of secrecy review is free of charge for the applicant.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

The intentional filing in a foreign state of a patent application which should be kept confidential, is a criminal offence punishable by fine or imprisonment for a maximum of one year.

It could further be noted that foreign defence inventions, for which a patent application is filed in Sweden, can only be maintained confidential in Sweden if there is a bilateral agreement between Sweden and the foreign state, and if the invention has been requested to be kept confidential in the foreign state.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

There is no definition of inventorship in Swedish law.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

N/A

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

Yes. The Swedish group believes that it would simplify matters if the decisive criteria for when/where to file a secrecy review would relate only to the applicant instead of also including where the invention was made. As a suggestion, the domicile of the applicant could be made the decisive criteria.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

The Swedish group has not identified any specific aspects where precise suggestions can be made. However, an idea for improvement that could be made the subject of further studies and discussions is presented at the end of this report.

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

The Swedish group realises the challenges of trying to define universal criteria for inventorship without being either too general or too detailed. The suggestion below shall thus be seen as a starting point for further discussions.

“For the purpose of patent law in general and issues of entitlement to inventions and patents in particular, a person shall be considered to be an inventor of an invention if he/she has made a significant intellectual contribution to one or more features of the invention and such feature(s):

1. are contained in a written disclosure as a whole and, in the case of a granted patent, also defined in at least one of the patent claims, and
2. distinguish the invention from the relevant prior art in a manner that makes it novel and non-obvious.

A contribution shall not be considered to be significant to the extent it only involves administrative or financial support, measures normally being taken by the person skilled in the particular art, or routine work carried out on the basis of detailed instructions from others.

If appropriate, in case the assessment of inventive step is made by a problem-solution approach, consideration should be made as to whether the person has contributed significantly to solving the relevant problem or to the identification of the problem if such identification is considered to have contributed to the inventive step.

In case of a granted patent, the assessment should be made on a claim by claim basis. However, only those claims having features that contribute to distinguishing the invention over the prior art, or solving the objective technical problem, should be considered.”

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

The Swedish group suggests that the information concerning inventors and inventorship provided by the applicant(s) from time to time shall be presumed to be correct until specifically challenged by someone other than the applicant(s). This would mean the applicant could at all times correct/change the information on inventors at will. In case an inventor is said to no longer be an inventor, a notice of this fact should be sent to that inventor by the Patent Office to allow for possible objections.

In case the correctness of the information provided by the applicant(s) is challenged by a third party, the Patent Office should nevertheless be entitled to rely thereon unless such third party submits proof that it has taken legal action to have its claim for inventorship established by a competent court. Once such proof of legal action has been submitted, the Patent Office shall have the possibility to stay the further handling of the patent application in case the applicant’s title to the invention is not supported by the documentation before it.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

The Swedish group does not consider it appropriate to provide for a first national filing requirement.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

The Swedish group realises the need for secrecy reviews.

The Swedish group suggests that the criteria for where a secrecy review shall be made shall be the domicile of the (intended) applicant or applicants. In case of several applicants, the domicile of the majority of them or the first stated applicant can be decisive. Said party or parties are those who have both legal and de facto control over the information intended to be included in the application, and their country of domicile would also have jurisdiction to enforce the requirement for a secrecy review.

In case a country otherwise wishes to prevent its nationals (individuals or legal entities) from communicating sensitive technology to foreign countries, this should be handled by other legislation than patent law.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

The Swedish group does not consider it appropriate to provide for a first national filing requirement or foreign filing license.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

The Swedish group is generally not in favour of a first filing requirement and do not propose any way of curing a possible failure to adhere to such requirement.

In respect of a failure to comply with a secrecy review, it is obviously difficult for the applicant to repair once the information concerning the invention has been disclosed to the patent office(s) in other countries/regions (or even become public as part of the prosecution process).

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

The Swedish group has discussed a possible abolishment of the requirement of stating the names of the inventors in a patent application in case the stated ground for the applicant's acquisition of the rights to the invention is an employer/employee relationship with the inventor and the applicant represents that the inventor has waived the right to be named as such.

This would open the possibility to file patent applications on the result of research made in multinational groups of companies, without having to include the names of the inventors and consequently no detailed assessment of inventorship would have to be made for purpose of those patent filings.

To avoid misunderstanding, the intention would not be to abolish any rights of employee inventors as such, but just to remove the absolute requirement for stating the name of the inventor in the prosecution process and thereby facilitating the administrative handling of patent applications. Even so, this proposal raises many issues that would have to be looked into further as a separate working question.

Summary

There is no explicit definition of inventorship in Swedish law but it is clear that something more than routine work and working under instructions from others is required in order to claim inventorship. The inventive contribution shall in principle be directed to what is claimed as the invention in a (patent) application. Erroneous information on inventors in an application can be corrected by the applicant both during the prosecution of the application and after grant. The consequences of an error in respect of inventorship involves the possibility for the proper inventor (or successor in title) to claim a transfer of all or part of (in case of co-inventorship) the application or patent to the entitled person or invalidating the patent (not in case of co-inventorship).

There is no discrimination between national and foreign inventors although there are some choice of law rules implemented for EPC patent applications, which in some cases will involve that foreign law applies to the issue of inventorship.

There is no general requirement for a first filing in Sweden but inventions concerning military equipment made in Sweden or owned by a physical or legal person domiciled in Sweden (defence inventions) are subject to a notification requirement and secrecy review. Such review may then result in a requirement for governmental consent to the filing of patent applications abroad.

The Swedish group suggests a harmonized definition of inventorship, the inventor being a person who has made a significant intellectual contribution to one or more features of the invention, and also discussed some relaxation of the requirement for stating inventorship in respect of inventions which are the result of intragroup research. The latter is however suggested as the topic of a separate Q.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Switzerland

Report Q244

in the name of the Switzerland Group
by Simon STRAESSLE, Konrad BECKER, Andrea CARREIRA, Marcus EHNLE, Thomas HAEFELE
RACIN, Renee HANSMANN, Thomas KRETSCHMER, Paul PLISKA, Beat RAUBER, Axel REMDE,
Martin SPERRLE, Hannes SPILLMANN, Marco ZARDI and Andri HESS

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

In the Swiss law there is no explicit definition of “*inventorship*”. In particular, Swiss statutory law does not define the substantive requirements for a person contributing to the making of an invention to be considered an inventor. It is left to the courts to establish and describe such requirements.

With respect to the rights associated with the status of an inventor, Article 3(1) of the Swiss Patent Act sets forth the general principle that the inventor, his/her successor in title, or a third party owning the invention under any other title has the right to the legal position of a patentee, the right to file a patent application, and the right to the grant of the patent. These rights can only be established in a natural person who has fully conceived the inventive idea.

A reduction to practice of the invention is not necessary; the technical details which may be found by routine work do not have to be elaborated, it is sufficient if the conceptual idea has been developed to such a degree that someone of ordinary skill in the relevant field can understand and work the invention.

If several people contribute to the inventive idea, they are to be considered joint inventors.

The creator(s) of the inventive concept are the inventor(s).

This general principle is supplemented by employment law provisions. On the one hand, Article 332 of the Code of Obligations states an exception to the principle that the right to the grant of a patent originally belongs to a natural person. Pursuant to this provision, an invention produced by an employee in the course of his/her work for the employer and in performance of his/her contractual obligations automatically and *ab initio* belongs to the employer by virtue of the employment. Accordingly, the employer has the right to the legal position of an applicant or patentee. On the other hand, if the invention is performed in the course of the employee’s work but not in performance of his/her contractual obligations, the employer may reserve the right to acquire such an invention. Any invention produced otherwise belongs, as a free invention, to the inventor.

The inalienable right of the inventor to be mentioned always remains with the inventor. The inventor(s) may, however, waive the right to be mentioned.

The European Patent Convention (EPC) does not explicitly define the term “*inventorship*” either. According to Article 60(1) EPC, “*the right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee, the right to a European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has the place of business to which the employee is attached.*”

Basically, the EPC refers to national law when it comes to define the term “*inventorship*”.

The case of several inventors is not explicitly dealt with in the EPC. Rule 19(1) EPC refers to the case that the applicant is *not the sole inventor*.

a) If, on the one hand, the efforts of person B are directed by person A such that person B is not involved in the creation of the technical solution to the problem addressed by the invention but merely acts under person A’s instructions, or in other words, if person B is not contributing to the inventive idea, person B is not considered an inventor under Swiss law. Only if person B contributes to the inventive idea, person B may be regarded as one of the inventors.

If, on the other hand, person A only hints general directions but is not supporting person B in defining or solving the technical problem addressed by the invention, or if A only supports circumstantially by contributing funds or means without being involved in the creative act, person A is not considered an inventor under Swiss law.

With respect to the question of who is considered an inventor of an invention for which patent protection is sought in Switzerland, it does not matter where a person is domiciled or from where a person contributes to the making of the invention. The Swiss Federal Code on Private International Law provides that intellectual property rights shall be governed by the laws of the state in which protection is sought. Accordingly, with respect to an invention that shall be protected in Switzerland, Swiss law determines who shall be considered an inventor regardless of where individual contributions to the invention have been made.

In this matter, the EPC refers to national law.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

No, Swiss law does not rely on or look to a particular part of the patent application.

According to Article 51 of the Swiss Patent Act, the invention must be defined in one or more claims. The inventor’s right to be mentioned does, however, not depend on whether his/her contribution is finally covered by the granted claims.

The EPC refers to national law.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No, Swiss law does not. The EPC refers to national law.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No, Swiss law does not. See above answer to question 1)a. The EPC refers to national law.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Yes, it can be done under Swiss law.

Also the EPC offers a mechanism for correcting a wrong designation of inventorship.

Under Swiss law, upon request of the applicant or the proprietor, and only with the consent of the wrongly designated person, an incorrect designation of an inventorship may be corrected. Adding an inventor does not require the consent of the already named inventor(s). There is no time limit involved for altering the statement of inventorship. If it is desired to include the correction in an official patent publication, the correction must be filed before completion of the technical preparations for publication. Any correction will, however, be included in the public patent register. The same procedure applies under the EPC. There is no time limit involved for altering the statement of inventorship.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Under Swiss law and the EPC, such a type of error has no *erga omnes* effects. Such errors do not render a patent invalid or unenforceable, and third parties cannot challenge the validity or enforceability of a patent on that ground. Only the rightful inventor (or his/her successor in title, or a third party owning the invention under any other title) has the right to take legal action to enforce his/her right to the position of the applicant or proprietor under Swiss law or the EPC. In this context, the rightful owner may also file, under Swiss law, a nullity suit against the patent.

An action for assignment against a defendant acting in good faith must be filed within two years from publication of the patent. There is, however, no filing dead line in case of an action against a defendant acting in bad faith. The fact that the error was intentional may be used to establish bad faith.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

No, Swiss law does not. The EPC refers to national law.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
 - e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
 - f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?
- 7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

no

No, Swiss law does not. The EPC refers to national law.

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) **Policy considerations and proposals for improvements of the current law**

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

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- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

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- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

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- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

No, there are not. The Swiss law imposes no specific requirements on applicants of patent applications having multinational inventorship.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

A practical definition of inventorship without undue burden to construe its terms seems to be elusive. The following aspects should be considered:

- inventorship shall be attributed only to a natural person who contributes to the creative concept underlying the invention;
- the definition shall be flexible enough to accommodate all present and future fields of technology;
- the definition shall not include a reduction-to-practice requirement.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

Written request by proprietor or applicant. Consent of the wrongly named. No requirements as to intentional/unintentional. No time limit.

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

Such a requirement is considered not appropriate

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

Such a requirement is considered not appropriate.

Accordance of a filing date shall not be delayed. If a secrecy review is required, it should be possible to request and obtain a decision thereon retroactively, within the priority year and before any publication.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Such a requirement is considered not appropriate.

Accordance of a filing date shall not be delayed. If a filing license is required, it should be possible to request and obtain a decision thereon retroactively, within the priority year and before any publication.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

A first filing requirement or a security review requirement is considered an undue burden on the applicant; accordingly, such requirements are not supported. The standards proposed above shall apply irrespective of whether the failure to comply is inadvertent or not.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

If national requirements under items 15) to 17) under current status cannot be abolished, a central deposit for filing application documents should be established in order to secure a filing date without breach of any national law. Said central deposit shall be independent and neither accessible to the public nor to any official body.

Summary

In Swiss law there is no explicit definition of “inventorship”; in particular, Swiss statutory law does not define the substantive requirements for a person to be considered an inventor. The difficult task of establishing such requirements is left to the courts. Also, Swiss law does not lay down any specific provision for patent applications with multinational inventorship. Place of residence and nationality of the inventor are irrelevant to the Swiss law. Furthermore, Swiss law does not stipulate any requirements regarding first filing of patent applications or secrecy review of subject-matters of inventions. In these questions, the European Patent Convention confines itself to referring to national law.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Turkey

Report Q244

in the name of the Turkey Group
by Kadriye AKDAG, Nese DUYGU, Ezgi BAKLACI, Leman TANDOGAN, Ekrem SOYLU, Murat BASMACI, Olgac NACAICI, Neriman Dilek YILDIRIM, Nevin ONER, Aysel KORKMAZ and Kadriye AKDAG

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

It is stated in Art. 11 of the Patent Decree Law No. 551 that the right to a patent shall belong to the inventor (natural person) or to his successor in title. Therefore, the provision does not directly define the inventor and the concept of invention and has left this matter to the practice and doctrine.

There is no legal obstacle for A from abroad and B mentioned in the example to be the inventors of the same invention. Also the Decree Law does not make a mention of under which conditions A and B shall be the inventors; instead, it is stated in Article 11 that more than one person may be the inventor. Thus, it can be noted that no limitation applies with regard to nationality, citizenship or residency.

That being said, the Turkish doctrine containing references to the international doctrine points out the following points: That A being manager of B in Turkey will not be sufficient for establishing a joint inventorship. The provided contribution is required to affect the obtained result. Likewise, even if A is only a financier of B or someone providing aid in laboratory and in terms of equipments or only giving ideas or only providing information about the completed experiments, or only carrying out laboratory measurements, or only suggesting a technical problem, A shall not be the inventor.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

No. As noted in the question, the Decree Law does not require someone to have made a percentage of the invention or to have written a certain number of claims down, and there also is no prerequisite for making a distinction of which claims and drawings shall belong to and those details are required to be expressed. According to Art. 85 of the Decree Law, it is provided that the ownership regarding

an invention shall be governed by the agreement between the parties if there is such agreement, or in the absence of such agreement, by the provisions of the Civil Code concerning Joint Ownership.

- 2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

No. There is no discrimination in our legislation.

- 3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

No. There is no rule found about this matter in our legislation. Only in Art. 128 of the Decree Law No. 551, where the inventor of a secret patent is domiciled in Turkey, the invention shall be deemed to have been realized in Turkey.

- 4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

In accordance with our legislation, you can add a new inventor in connection with a patent while the patent application process is in progress and after the patent certificate is issued. However, there is no way to remove the name of an existing inventor from the application.

There is not a time limit in our legislation. In order to add a new inventor to an invention, it is necessary to submit a petition to the Turkish Patent Institute and to specify whether the invention was made under contract or independently.

- 5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Incorrectly identifying an inventor in a patent and its consequences are stipulated in Article 12 of the Patent Decree Law No. 551 which discusses "Usurpation of the Right to a Patent". According to this article, incorrectly identifying an inventor shall result in invalidation of the patent.

The consequences of initiating an invalidation action pursuant to Article 129 for such purpose are specified in Article 12 of the Patent Decree Law. Where the invalidation action initiated on the basis of this provision is resolved in favour of the plaintiff claiming to be the inventor, the plaintiff is entitled to request one of the following courses of action within three months after the judgement has become *res judicata*. Those rights are;

- i. Right to request that the prior application for patent be accepted as his application and be further prosecuted as such,
- ii. Right to file a new application for the same invention (Such an application shall be prosecuted as of the date of filing of the first application and in such case, the application subject to usurpation shall be invalid),
- iii. Or right to request that the application subject to usurpation be rejected.

As regards the faith of the applicant, it will not be incorrect to say that the law deems the applicant here as acting in bad-faith in consideration that the title of the relevant article is identified as "usurpation" of the right to a patent.

6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

no

Our legislation does not contain such a practice.

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

All of the national applications filed at the Turkish Patent Institute and the international applications filed through the Turkish Patent Institute are examined whether they are related to national defense or not. If the application concerns national defense, it is necessary to get a permission from the Ministry of National Defense in order to file the application in foreign countries as well.

All of the applications are checked in terms of national defense.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

Pursuant to Art. 125 of the Patent Decree Law in which secret patents are discussed, the contents of an application for patent shall be kept secret, for a time period of two months, as of the date of filing of the application unless the Institute decides to disclose same earlier, and the Institute may decide to extend this term up to five months as of the date of filing of the application.

The Institute may consider that the invention is important for national defense in cooperation with the Ministry of National Defense. The Ministry of National Defense is entitled to examine all of the patent applications under the conditions of secrecy provision beforehand. If it is a matter of national defense interests, the Ministry of National Defense may request, before the expiration of the 5 month period, the Institute to examine the patent application in accordance with the criteria of secrecy and to notify the applicant of this situation.

The Ministry of National Defense may permit the applicant to use the application in part or full within the frame of the specified rules upon request of the applicant. There is no liability to pay annuity fees (Art. 127 of the Decree Law).

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

Our legislation does not contain such a practice.

II.) Policy considerations and proposals for improvements of the current law

- 8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

Our legislation does not contain a direct and clear definition of inventorship. The only description regarding the inventorship in the Turkish patent legislation is given among the descriptions which do not affect grant of patent to an application, which reads as "any person who, at the date of filing the application, has the right to the patent shall be deemed an "inventor" according to Art. 8/2 of the Patent Decree Law. Also, according to Art. 11 the right to a patent shall belong to the person who makes the invention (inventor).

- 9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

There is no limitation on this matter in our legislation.

- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The Patent Decree Law No. 551 does not contain any provision in relation with regard to the secrecy of multinational inventions. Therefore, we do not have any suggestion of improvement on this matter

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

There is no article defined in regard to multinational inventorship in the Decree Law.

III.) Proposals for harmonisation

- 12) Is harmonisation in this area desirable?

yes

The practices in this field must be harmonized by bringing international regulations. We are in the opinion that "First filing" necessity which is applied in some countries should be removed and restrictions should not be done in the definition of inventorship by adopting a liberal perspective. Otherwise, we believe that it will cause the spread of the "First filing" necessity in many countries, including Turkey

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

Any person who contributes to the creation of an invention, including the owner of the idea should be entitled to be inventor.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

In case of unintentional faults and as long as an agreement is reached between the parties, any correction should be able to be made on the details of the inventor and new inventor should be able to be added for an application at any phase of the application process.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

Our legislation does not impose a first filing requirement and we believe that such limitation should not apply in any country. An application should be able to be made in a desired country depending on the consensus of the inventors.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

Since the Patent Decree Law does not make a distinction of national or multinational invention in terms of secrecy review, there is no need to adopt a new provision with regard to multinational inventions.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Since the Patent Decree Law does not impose a first filing requirement, foreign filing license is not a matter in question

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

We think that first filing requirement should not be imposed.

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

No.

Summary

The concept of the inventor or invention does not directly defined in the Patent Decree Law No. 551 or in the doctrine. According to our legislation, all of the contributors can be defined as inventor. Besides, a new inventor can be added in connection with a patent while the patent application process is in progress and after the patent certificate is issued. However, an inventor cannot be withdrawn after the application process is started. If there is incorrect declaration of an inventor, correction can be done before Turkish Patent Institute if the parties are in agreement. If the parties are not in agreement, it will deemed to be usurpation and the disagreement will be settled by courts. According to our legislation there is no first filing obligation. We are in the opinion that an harmonization in this area is desirable. We believe that "First filing" necessity which is applied in some countries should be removed and restrictions should not be done in the definition of inventorship by adopting a liberal perspective. Otherwise, we believe that it will cause the spread of the "First filing" necessity in many countries, including Turkey.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

No.

United Kingdom

Report Q244

in the name of the United Kingdom Group
by Jan VLECK, Christopher STOTHERS, Dominic ADAIR, Nick BENNETT, Jennifer HODKINSON,
Duncan RIBBONS, Trevor COOK, Richard MILLER, Peter ARROWSMITH, Emily O'NEILL, Elizabeth
BLAIR, Victoria GARNER, Laura WHITING, Daniel BROOKS and Beatriz SAN MARTIN

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Whoever contributed to the inventive concept would be considered an inventor.

An inventor under English law is the 'actual deviser of the invention' ^[1] and a patent may be granted 'primarily to the inventor or joint inventors' ^[2].

Whether person A and / or person B would be considered to be an inventor or joint inventors under English law will depend on whether they both together arrived at the invention i.e. they the inventive concept. If for example, A devised the inventive concept and B merely used his common general knowledge to demonstrate that the idea worked then A would be the sole inventor.

Footnotes

1. [^] (s.7(3) PA 1977)
2. [^] (s.7(1) PA 1977)

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Inventorship is determined by contribution to the inventive concept . The assessment of what is the inventive concept is not restricted to the claims. The entire specification ^[1] is relevant.

Footnotes

1. [^] See for example the Hearing Officer's analysis in BL O/501/14 – Daletech Electronics Ltd v Jemella Ltd applying *Markem v Zipher and Yeda*

2) **Does your law of inventorship depend on the citizenship of the inventor(s)?**

no

The UK law of inventorship does not depend on the citizenship of the inventor(s).

3) **Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?**

no

No, UK law will apply to a UK patent and the inventorship of the same, regardless of where it was invented and by whom.

4) **Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

UK law allows for amendments to inventorship to be made either during prosecution or after grant of the patent.

There are a number of different ways in which such a correction can be made.

Inventorship may be corrected as a result of entitlement proceedings, which may be brought before the Comptroller^[1] or court to resolve a dispute as to the identity of the true inventor, whether in relation to UK or foreign applications.

Alternatively, if there is simply a mistake in the application as to the identity of the inventor, this can be corrected by the UK Intellectual Property Office (UKIPO) under the procedure for correction of errors.

A change in inventorship may also arise because inventors may also exercise a right to be mentioned in any granted patent (even if they are not the owner of the patent).

It should be noted that if correcting inventorship changes entitlement^[2], this has the potential to change the priority date in situations where a patent application follows an earlier priority filing. Under Article 4 of the Paris Convention, if a person applying for a patent wishes to claim priority from an earlier priority application, that person must be identical to, or be the successor in title to, the person who made the earlier application.^[3] In the UK, following *Edwards v Cook*^[4], this means that if the persons making the subsequent application differ from those who made the priority filing, the necessary assignments must be made before the application is filed. Otherwise, entitlement to the priority document will be lost.

a. **If yes, what are the requirements and time limits for such correction?**

There are three types of error which may need correction: 1) correction of the owner of the right sought by a third party and necessary because an error in inventorship has resulted in a change of ownership of (or entitlement to) the invention; 2) correction due to the inventor's right to be mentioned; and 3) correction due to error.

Correction to change ownership/entitlement

Where the correction of inventorship leads to a change of ownership of the application/patent (i.e. to entitlement to the invention embodied in the application or patent), then entitlement proceedings to correct ownership may be brought before the Comptroller or court **while the application is pending and up to two years after grant**. The two year post-grant deadline does not apply if the recorded proprietor (i.e. the proprietor not entitled) knew it was not entitled to the patent.

Correction due to inventor's right to be mentioned

UK law provides the right for an inventor to be mentioned as such in any patent granted for the invention. An unmentioned inventor can apply to the comptroller to enforce this right. There is **no time limit** as to when such an application may be made.

Where a person believes an inventor ought not to have been so mentioned as inventor, he or she may at any time apply to the Comptroller for a certificate to that effect. If the comptroller issues such a certificate, he will also correct, by means of an erratum, any copies of the patent which are subsequently distributed.

Correction due to error

The Comptroller may, **at any time**, correct any errors or mistakes in any specification of a patent or application for a patent or any documents filed in connection with a patent or such an application. A request for such a correction is made to the Comptroller.

Footnotes

1. [^] *“comptroller” means the Comptroller-General of Patents, Designs and Trade Marks, the senior official at the UK Intellectual Property Office*
2. [^] *Generally it will, but there are circumstances in which it will not (e.g. if inventorship changes between employees of the same employer)*
3. [^] *i.e. the same legal person.*
4. [^] *Edwards Lifesciences AG v Cook Biotech Incorporated [2009] EWCH 1304 (Pat)*

5) **What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?**

If an error in inventorship leads to an incorrect applicant (i.e. owner of the right), this may be enough for the UK IPO to refuse to grant a patent.

In the UK only the inventor or their successor in title is entitled to the grant of a patent. As such, the amendment of inventorship is considered as a part of entitlement proceedings. Such proceedings can be brought at any time whilst a patent application is pending.

The Comptroller has jurisdiction to determine the question of entitlement to a patent application before grant. The Comptroller can order that:

- An application proceed in different names to those in which it was filed;
- Refuse to grant a patent or order that the application be amended so as to exclude any of the matter in respect of which the question as to entitlement was referred;
- Allow the person who referred the question as to entitlement to file a new application for the material excluded on amendment which can benefit from the filing date of the application in relation to which the referral was made
- Transfer or grant of a licence under the application and fix the terms of the license.

The Comptroller can however decline to deal with any matters regarding entitlement and refer them to the Patents Court.

Can a patent issued from such an application be invalidated or rendered not enforceable on that basis?

The Comptroller has powers to determine entitlement after the grant of the patent provided the reference to the Comptroller is made within two years of grant, unless it can be shown that the registered proprietor knew at the time of grant that he was not entitled to the patent. As with pre-grant applications the Comptroller can decline to consider these issues and refer them to the Patents Court.

Entitlement is a ground of attack on validity, providing that 1) the challenge to validity is brought by someone with a better claim to title; and 2) the challenge to validity is brought within two years from the date of the grant of the patent, unless it can be shown that the registered proprietor of the patent to be revoked knew at the time of the grant of the patent (or transfer of the patent) that he was not entitled to the patent. This attack can be brought before the court or the Comptroller.

The following orders could be granted:

1. An order for the unconditional revocation of the patent;
2. An order that the patent should be revoked unless within a specified time the specification is amended (this amendment can be opposed under s.75 Patents Act).

Does it matter whether the error was intentional or unintentional?

If the error is intentional, this will affect the deadline to challenge the validity of the patent. Where the error is unintentional, the challenge to validity must be brought within two years from the date of the grant of the patent. Where it can be shown that the registered proprietor of the patent to be revoked knew at the time of the grant of the patent (or transfer of the patent) that he was not entitled to the patent, the 2 year deadline does not apply. This attack can be brought before the court or the Comptroller.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

yes

The restrictions only apply to applications which contain information relating to military technology, information which is prejudicial to national security or prejudicial to the safety of the public. Public safety is not intended to cover inventions which merely could be dangerous if misused but relates instead to an invention, or information presented in a patent application, which the general public would understand as constituting a threat to their safety and security."^[1]

Footnotes

1. [^] [CIPA Guide to the Patents Acts 7th Edition at 23.02](#)

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

Yes.

For a patent application to be filed first in another country the foreign filing restrictions require that an applicant obtains a foreign filing permit from the Patent Office^[1] which requires that details of any UK resident applicants or inventors are provided as well as details of the invention. The introduction and summary of invention from the draft patent application will usually provide sufficient detail and the application permit can often be granted within half a day.^[2] There is no government fee for this.

Even when an application is the subject of a secrecy order it may be permitted to form the basis of applications in foreign countries having reciprocal arrangements with this country. An example of such an arrangement is the NATO Agreement for the mutual safeguarding of secrecy of inventions relating to defence and for which applications for patents have been made.

The foreign filing restriction does not apply in respect of an invention for which an application for protection has first been filed abroad by a person resident abroad. Where this has happened, "further applications for the same invention may be filed in other countries by a UK resident without the prior approval of the comptroller."^[3]

Footnotes

1. [^ Security Section, Room GR70, Intellectual Property Office, Concept House, Cardiff Road, Newport, NP10 8QQ Tel: +44\(0\)16 3381 3558](#)
2. [^ "Restrictions on the Filing of Patent Applications Abroad by UK Residents" <http://www.mewburn.com/patents/focus-on-patents/restrictions-on-the-filing-of-patent-applications-abroad-by-uk-residents>](#)
3. [^ Manual of Patent Practice, April 2015, at 23.05](#)

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

no

No.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

Residency is the criteria not nationality or citizenship.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

yes

Yes – in certain circumstances.

Our law would be violated but only if the inventor is a resident of the UK and foreign filing restrictions apply because the application contains information relating to military technology, information which is prejudicial to national security or prejudicial to the safety of the public.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

It is a criminal offence to file an application in contravention of this law and can result in a fine and/or up to two years imprisonment.

It matters if the error is intentional or inadvertent. A person must know or be reckless as to whether filing or causing the application to be filed would contravene the relevant law. A person acting in good faith who believes that the restrictions do not apply will not be guilty of a criminal offence.

- 7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

A prohibition on publication or further communication of the subject matter is imposed only for subject matter which might be prejudicial to national security or the safety of the public. The UK Secretary of State provides the UKIPO with a list of technologies

which might be considered to be relevant to national security. This list is publically available from the website of the UKIPO. Determining whether subject matter is prejudicial to the safety of the public is left to the Comptroller's discretion.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

The foreign filing restrictions require that an applicant either:

- i. obtains a foreign filing permit from the Patent Office^[1]
- Or
- ii. files first at the UK Patent Office and then waits six weeks before filing abroad (after which, provided no secrecy direction has been given, applications may be made abroad without further formality).

Even when an application is the subject of a prohibition direction it may be permitted to form the basis of applications in foreign countries having reciprocal arrangements with this country. An example of such an arrangement is the NATO Agreement for the mutual safeguarding of secrecy of inventions relating to defence and for which applications for patents have been made. Details of the very special procedures for such conversions and foreign filings will be provided after permission has been granted to file abroad.^[2]

Footnotes

1. [^](#) *Security Section, Room GR70, Intellectual Property Office, Concept House, Cardiff Road, Newport, NP10 8QQ Tel: +44(0)16 3381 3558*
2. [^](#) *Information sourced from the Manual of Patent Practice – January 2015 (23.04)*

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

It is a criminal offence to file an application in contravention of this law and can result in a fine and/or up to two years imprisonment^[1]. The penalties only apply if the person either knew that they were contravening the law, or was reckless as to whether they were contravening the law.

Footnotes

1. [^](#) *Section 23(3) Patent Act 1977*

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

The UK law defines inventorship through statute and case law. The case law provides colour to the statute and is sufficiently clear for their purposes. There may be an issue if further definitions of inventor were added to the current landscape that this may lead to further confusion. There are areas of improvement but the general consensus is that it works well in its current state.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

The United Kingdom does not have such first filing laws other than in areas affecting national security and public safety.

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The UK has laws requiring a secrecy review of patent applications directed to certain inventions made in the UK. Aspects of these laws, including the issues around whether the dissemination of confidential information should be kept outside the patent system. The issues are around, firstly, whether the patent system should be involved in the desire not to disseminate confidential information. Secondly, in this modern age, there is nothing to address of prevent the dissemination of secret information released over the internet prior to a review, or during the review of the patent for secrecy reasons. The claims in the patent may not make it obvious that it has military application.

There is a potential conflict between UK and foreign laws if a patent application has been filed for "secret" subject matter, and was developed by multinational inventors. In these circumstances foreign law may require one of the inventors to first file in their home country whereas UK law may require a UK resident to file first in the UK (if a foreign filing license is not available). This problem may even arise in respect of a sole inventor because UK secrecy provisions apply to UK residents, regardless of nationality, whereas foreign laws may apply to foreign nationals, regardless of residency. This could be an intractable problem for patent applications which include "secret" subject matter.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

We consider it somewhat illogical to apply penalties based on the country of filing of patent applications for multinational inventions. If they are multinational inventions the invention will have necessarily already left the country and be known abroad before any patent applications are filed anywhere. Separate laws (perhaps related to national security) seem the appropriate place to control the dissemination of information which a government considers might be prejudicial to the national interest. Using patent filing laws would not correct the dissemination outside the UK which has already happened.

It seems unavoidable that UK law includes some provision for a secrecy review of UK patent applications originating entirely from within the UK (i.e. not multinational inventions). This provides a mechanism for controlling publication or dissemination of information which could be prejudicial to national security. In addition, it seems unavoidable that this secrecy review should be obligatory for inventions made by inventors with a strong connection to the UK (such as residents or nationals). If there was no such restriction then foreign patent applications could be freely filed and become public, to the possible detriment of UK national security.

For these reasons, it is not believed that the secrecy provisions of UK law could be significantly improved to address multinational inventions. The fact that UK's secrecy provisions are triggered only by a narrow range of subject matter makes the system manageable. We suspect that those working in the relevant narrowly defined fields in the UK are well aware of their obligations and may have other secrecy obligations unrelated to patent law. In this regard, it is welcome that the UK provides a publically available list regarding the types of subject matter that might be considered to be relevant to national security.

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

We would strongly support harmonisation in this area and to adopt a simplified procedure in terms of multinational inventorship like in the UK for all technologies other than a narrow range of technologies clearly having possible national security implications..

The growing trend towards globalisation and, in relation to technology focused entities, an increase in the number of research centres that are now based in more than one jurisdiction means that multinational inventorship issues are much more likely to arise. This, together with the lack of alignment in the approach taken towards multinational inventorship in different jurisdictions creates unnecessary and undue legal uncertainty for multinational companies, among other entities, which in turn opens up the door for disputes and litigation to arise in relation to inventorship. This is generally extremely costly, both in terms of time and money, and also detrimental to the advancement of research and development of inventions, which is a key source of revenue for these technology entities, because of the re-allocation of resources to enforcement and litigation activities.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

We believe that any definition of inventorship should take account of the inventive concept or concepts and the assessment of the inventive concept should include an assessment of the whole specification including any claims. A suitable definition might be anyone who made a significant contribution to the formulation of the inventive concept.

The UK Group notes that given the potential for different claims in different countries, or indeed in different divisionals in the same country, there is inevitably scope for different cases deriving from the same application to have different inventors.

14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

It is desirable that incorrect statements of inventorship should be corrected in order to recognize the work of the true inventor(s) of a patent, in principle at any point in time even after grant. The burden in such cases should be on the person seeking correction to show that particular individuals were or were not the true inventors in accordance with the standard articulated in response to the previous question, although in most circumstances any absence of evidence due to the passing of time should be held against the person seeking correction. However, where a correction could have a further impact on others, such as on ownership (entitlement), right to compensation for employee inventors, right to pursue prosecution/opposition proceedings or even validity (where priority issues are affected), it is appropriate to balance this with the rights of the purported inventors, owners and third parties to rely on the relevant patent register.

In order to achieve that balance, it would be appropriate to provide that any correction does not affect such other issues unless it is (A) sought within a reasonable period of time, (B) carried out with the consent of the affected party or (C) the affected party knew of the mistake at a relevant time.

We believe a reasonable time would be during pendency of the application and within 2 or 3 years of grant of the patent, and that a relevant time would be at the time of grant or of acquisition of the patent, if later.

Finally, if the concept of inventorship and for correction were harmonized, the correction should be available in a single set of proceedings (as is currently the case for entitlement proceedings in relation to patent applications pending before the EPO).

15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

The UK Group does not believe that a first filing requirement is appropriate, and the difficulties which arise with multinational inventions make such a requirement even less appropriate.

However, if there is such a requirement, it should reflect the reality of where knowledge of the invention is actually located before patent applications are filed. Therefore, any obligation to file in a particular country should be based on residency rather than nationality. With regard to multinational inventions the reality of the matter is that knowledge of the invention is already at least in the countries where the various inventors are resident. The first filing could therefore be in any of those countries where an inventor is resident.

16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

We consider that the patent system is not the right arena to control the dissemination of information potentially prejudicial to national security. This is better done through export control laws rather than as part of the patent filing system itself.

Any secrecy review regime should be limited to exclude technologies whose dissemination clearly has no implications for national security or public safety. The regime should include a publicly available and limited list of the types of technologies which may be the subject of a secrecy order and for which permission should be sought for patent filings abroad. The list should be a harmonized one.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Each country will want to have the freedom to assess its national security requirements as it sees fit. An international harmonized and comprehensive list setting out exactly the technologies for which it will and will not be possible to obtain a foreign filing licence seems unrealistic. However, an agreement that foreign filing will only be refused for technologies having national security and public safety implications seems a sensible and valuable compromise.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Criminal prosecution bodies are unlikely to be in a position to give retroactive confirmation that acts committed will not be the subject of future criminal sanctions. The UK regime where criminal sanctions do not apply unless the offence was knowingly or recklessly committed seems a sensible and proportionate compromise. A harmonized list of technologies subject to a first filing or security review requirement should reduce the risk of inadvertent failures to comply.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Summary

The UK Group supports harmonization to adopt a simplified procedure for multinational inventorship for all technologies other than a narrow range of technologies having possible national security implications.

We believe that any definition of inventorship should take account of the inventive concept or concepts and the assessment of the inventive concept should include an assessment of the whole specification including any claims. A suitable definition might be anyone who made a significant contribution to the formulation of the inventive concept. It is desirable that incorrect statements of inventorship should be corrected in order to recognize the work of the true inventor(s) of a patent. However, it is appropriate to balance this with the rights of the purported inventors, owners and third parties to rely on the relevant patent register.

The UK Group does not believe that a first filing requirement is appropriate, and the difficulties which arise with multinational inventions make such a requirement even less appropriate. However, if there is such a requirement, it should be based on residency rather than nationality.

We consider that the patent system is not the right arena to control the dissemination of information potentially prejudicial to national security. This is better done through export control laws rather than as part of the patent filing system itself.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

United States of America

Report Q244

in the name of the United States of America Group
by Bea KOEMPEL-THOMAS and Robert WELLS

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

In the United States of America (U.S.) 35 U.S.C. 115 requires that the correct inventor(s) be named in a patent application. In addition, 35 U.S.C. 116 establishes guidelines for joint inventorship by stating that "Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent." No statute identifies the definition of inventorship per se. Rather, the definition for inventorship is established by case law. MPEP 2137.01 summarizes relevant case law. In general, the definition of inventorship can be simply stated: "The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor. . . . Insofar as defining an inventor is concerned, reduction to practice, per se, is irrelevant." *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993). "[T]here is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf." In re DeBaun, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, "one who suggests an idea of a result to be accomplished, rather than the means of accomplishing it, is not an coinventor." *Ex parte Smernoff*, 215 USPQ 545, 547 (Bd. App. 1982). In addition, "In arriving at . . . conception [the inventor] may consider and adopt ideas and materials derived from many sources [such as] a suggestion from an employee, or hired consultant . . . so long as he maintains intellectual domination of the work of making the invention down to the successful testing, selecting or rejecting as he goes . . . even if such suggestion [or material] proves to be the key that unlocks his problem." *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965).

As stated above, the key to inventorship in the U.S. is who conceived the invention. *Se-wall v. Walters*, 21 F.3d. 411 (Fed. Cir. 1994). Whether person A or B is an inventor, or both are joint inventors, depends on what is claimed, and who conceived the subject claimed. If A's direction to B is to "provide me with a better widget" and B conceives of such a widget, B would be the inventor. If A directs B to, for example, "reduce to practice a widget having elements (a), (b) and (c)," the combination that is ultimately claimed, then A would be the inventor. If A directs B to produce a widget having elements (a) and (b), and B conceives and produces a widget having elements (a), (b) and (c), the combination ultimately claimed, A and B would be joint inventors.

MPEP 2137.01(IV) states that persons “that merely acted under the direction and supervision of the conceivers” are not inventors. Thus, person B would never be considered an inventor and person A would be considered an inventor if person A conceived the invention. The location of persons A and B inside or outside the U.S. is not relevant to the inventorship determination.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

yes

In the U.S. inventorship is determined based on the contribution to the subject matter in the claims. 35 U.S.C. 116(a)(3) states that “[i]nventors may apply for a patent jointly even though . . . each did not make a contribution to the subject matter of every claim of the patent.” (Emphasis added). MPEP 2137 also states that “the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent. . . .” (Emphasis added). Further, for joint inventorship, “[t]he inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named inventors. . . . A coinventor need not make a contribution to every claim of a patent. A contribution to one claim is enough.” MPEP 2137.01(V). Regarding means-plus-function claims, “[t]he contributor of any disclosed means of a means-plus-function claim element is a joint inventor as to that claim, unless one asserting sole inventorship can show that the contribution of that means was simply a reduction to practice of the sole inventor’s broader concept.” *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460-63, 45 USPQ2d 1545, 1548-1551 (Fed Cir. 1998). As such, the inventor or joint inventors are those identified in the cover sheet of the application, or if a cover sheet is not filed, in the application papers filed unless applicant files a paper including the processing fee supplying the name or names of the inventor or joint inventors. 37 CFR 1.41(c).

- 2) Does your law of inventorship depend on the citizenship of the inventor(s)?**

no

- 3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?**

no

- 4) Can the inventorship of a patent application be corrected after the filing date in your country?**

yes

With the America Invents Act (AIA), certain changes were made to the patent statutes enacted by Congress and the administrative rules (also known as regulations) promulgated by the USPTO. Because the changes to the law did not change the fundamental notion of a corrective process, this answer will only refer to the current law with general applicability for corrective requests filed on or after September 16, 2012. The patent statutes allow for inventorship to be corrected in pending patent applications (35 U.S.C. §116) and patents (35 U.S.C. §256). In general, corresponding administrative rules have been promulgated by the USPTO for pending patent applications (37 CFR §1.48) and patents (37 CFR § 1.324)

(note that separate rules apply to reissue applications and contested proceedings before the Patent Trial and Appeal Board, which for the purpose of maintaining conciseness will not be further elaborated on here). Upon filing, nonprovisional applications identify the entire inventive entity (legal names of all inventors) in an Application Data Sheet (ADS), and inventors must file a declaration before patent grant. Corrective procedures are outlined below for (1) a nonprovisional application, (2) a provisional application and (3) a patent. (Correction of inventorship in a pending nonprovisional application may also be obtained by filing a continuing application under 37 CFR 1.53 without the need for filing a request under 37 CFR 1.48, although the requirements for a request filed on or after September 16, 2012 are minimal. MPEP §602.01(c)III.) Statutes and rules do not expressly set time limits for correction, but separate procedures are called out for pending nonprovisional applications versus patents. Although provisional applications will expire, there is no prohibition to correcting a provisional application after its expiration.

1. Nonprovisional Application

(a) Incorrect or Adding Inventors

To correct inventorship in a nonprovisional application where the ADS or inventor's declaration (or oath) has already been filed:

- a request signed by the practitioner;
- a new inventor's declaration by the inventor(s) being added;
- an ADS in mark-up form under 37 CFR §1.76(c) identifying the legal names of all inventors; and
- a processing fee set forth in the rules (37 CFR §1.17) if filed after the first Office Action on the merits or if a statement is filed that the correction is being made due solely to cancellation of claims.

(b) Removing Inventors

To remove an inventor in a nonprovisional application where the ADS or inventor's declaration (or oath) has already been filed:

- a request signed by the practitioner;
- an ADS in mark-up form under 37 CFR §1.76(c) identifying the legal names of all inventors; and
- a processing fee set forth in the rules (37 CFR §1.17) if filed after the first Office Action on the merits or if a statement is filed that the correction is being made due solely to cancellation of claims.

2. Provisional Application

Any request to correct or change inventorship in a provisional application after a cover sheet with inventor information or ADS has been filed (note that no inventor's declaration is required in a provisional application):

- a request signed by the practitioner;
- an ADS in mark-up form under 37 CFR §1.76(c) identifying the legal names of all inventors; and
- a processing fee set forth in the rules (37 CFR §1.17).

3. Patent

To correct inventorship after issuance (under 35 U.S.C. §256(b) a federal court may also order the correction of inventorship), a petition must be accompanied with a certificate of correction and include the following:

- a statement from each person being added as an inventor;
- a statement from each person currently named as an inventor where named inventors must either agree or have no disagreement with the addition of named inventor(s);
- a statement from all assignees agreeing to the change of inventorship;
- a processing fee for correcting inventorship in a patent set forth in the rules (37 CFR §1.20).

While a certificate of correction under 35 U.S.C. §256 is the most common way to correct inventorship of a patent, other methods of correcting inventorship also exist in the U.S. For instance, inventorship may also be corrected by filing a reissue application under 35 U.S.C. §251. See MPEP 1402.II. Inventorship can also be corrected without a certificate of correction where a patent is subject to ex parte reexamination proceedings. See MPEP 2258.IV.F.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Examiners in examining U.S. patent applications must reject applications where inventorship errors are identified. *PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315, 1321 (Fed. Cir. 2000); see also, Manual of Patent Examining Procedure §2137.01, 9th ed. (Mar. 2014) (“For applications subject to the first inventor to file provisions of the AIA . . . the claims should be rejected under 35 U.S.C. 101 and 35 U.S.C. 115 for failing to set forth the correct inventorship . . . for applications not subject to the first inventor to file provisions, the claims should be rejected under pre-AIA 35 U.S.C. 102(f).”). An issued U.S. patent can be held invalid for an error in stated inventorship. *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1350 (Fed. Cir. 1998) (“When a party asserts invalidity under § 102(f) due to nonjoinder, a district court should first determine whether there exists clear and convincing proof that the alleged unnamed inventor was in fact a co-inventor.”). An inventorship error in an issued U.S. patent can be corrected, however, even during litigation. 35 U.S.C. § 256 (2012); *Pannu*, 155 F.3d at 1350 (“Upon such a finding of incorrect inventorship, a patentee may invoke section 256 to save the patent from invalidity. Accordingly, the patentee must then be given an opportunity to correct inventorship pursuant to that section. Nonjoinder may be corrected ‘on notice and hearing of all parties concerned’ and upon a showing that the error occurred without any deceptive intent on the part of the unnamed inventor.”). Historically, a U.S. patent could be held unenforceable for inequitable conduct for a material misrepresentation regarding inventorship with an intent to deceive the Patent Office. *PerSeptive Biosystems, Inc.*, 225 F.3d at 1322. In the U.S., patent ownership rights are held by the individual inventor unless they have been assigned. *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248 (Fed. Cir. 1993) (“At the heart of any ownership analysis lies the question of who first invented the subject matter at issue, because the patent right initially vests in the inventor who may then, barring any restrictions to the contrary, transfer that right to another, and so forth.”). Also, each owner of a patent must consent to bringing suit under a patent. *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1468 (Fed. Cir. 1998) (“Further, as a matter of substantive patent law, all co-owners must ordinarily consent to join as plaintiffs in an infringement suit. Consequently, ‘one co-owner has the right to impede the other co-owner’s ability to sue infringers by refusing to voluntarily join in such a suit.’”); see also, 35 U.S.C. § 262 (“In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.”). Even with the availability of 35 U.S.C. § 256, a defendant in a patent lawsuit may seek to create an avenue to licensing a patent by demonstrating that the stated set of inventors erroneously excluded an inventor who has not assigned to the party bringing the action. The America Invents Act (AIA), 35 U.S.C. § 256 was amended to strike the provision indicating that innocent error is required for correcting inventorship. At least one U.S. District Court has held that the revision to 35 U.S.C. § 256 does not preclude a U.S. patent from being held unenforceable for inequitable conduct for intentional and material misrepresentations regarding inventorship. *Cyber Acoustics, LLC v. Belkin Int’l, Inc.*, 988 F. Supp. 2d 1236, (D. Or. 2013) (“Cyber availed itself of 35 U.S.C. § 256(a) and petitioned the PTO directly for a Certificate of Correction, which was granted on October 18, 2013. The streamlined correction process under the Leahy–Smith America Invents Act (“AIA”), however, does not affect any inquiry into the inequitable conduct claim

pending before this Court. In fact, although the AIA removed all inquiries into subjective issues of intent to correct inventorship, these changes do not restrict judicial relief based on inequitable conduct.” (internal citations omitted)).

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

yes

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

no

No, but if a patent application is to be filed in another country first, a foreign filing license must be obtained before doing so. 37 C.F.R. 5.11 (or retroactively through 37 C.F.R. 5.25(a)).

NOTE: This response addresses the questions as posed from the perspective of patent application filing requirements before the USPTO and obtaining foreign filing licenses from that agency. HOWEVER, it does not address the additional and independent restrictions concerning U.S. law restricting the export of technology developed in the U.S. Such export control laws extend to transferring technical data to a foreign national, even if that person is present within the U.S. or potentially accessing U.S. technical data on a computer from outside the U.S.

- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

Yes. The U.S. provides two ways of obtaining a foreign filing license. First, a petition for a foreign filing license can be filed before filing any application in a foreign patent office and without filing a U.S. patent application first. (37 C.F.R. 5.11(a)). Upon grant of the petition, i.e., the foreign filing license is granted, the applicant can file the patent application in a foreign country first.

Second, a patent application filed in the U.S. for an invention made in the U.S. is considered to include an automatic petition for a foreign filing license. (37 C.F.R. 5.12(a)) If the initial automatic petition is not granted, a subsequent petition may also be filed and must include a fee of \$50/\$100/\$200 for a micro/small/large entity. (37 C.F.R. 5.12(b)).

Petitions may be expedited by hand delivering or faxing the petition to the USPTO's Licensing and Review Office. When such an expedited petition for a foreign filing license is filed, the license will be granted within three business days from the receipt of the petition, absent any national security concerns.

If there is not a corresponding U.S. or international application filed in the U.S., the petition must also include a legible copy of the material upon which a license is desired. This copy will be used as the measure of the license. (37 C.F.R. 5.13)

If there is a corresponding U.S. application on file, the petition must identify that application by application number, filing date, inventor, and title, but a copy of the material upon which the license is desired is not required. (37 C.F.R. 5.14)

Further, a foreign filing license is NOT required if the application is not subject to a secrecy order, and was filed at least six months prior to the date on which the application is filed in a foreign country. (37 C.F.R. 5.11(e)(2))

- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

yes

Yes. (37 C.F.R. 5.25(a)) However, granting a retroactive foreign filing license is discretionary and not automatic. The petitioner must include a verified statement containing (i) an averment that the subject matter in question was not under a secrecy order at the time it was filed abroad and that it is not currently under a secrecy order, (ii) a showing that the license has been diligently sought after discovery of the proscribed foreign filing, and (iii) an explanation of why the material was filed abroad through error without the required license first having been obtained.

- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

Apart from requiring a foreign filing license for an invention made in the U.S., it does not require the citizenship or resident status of the inventor to be stated. The U.S. examination process does not inquire about where the invention was made.

No, this does not apply to based on the citizenship of the inventor or the residency of the inventor.

No, the nationality of the patent owner does not affect the answer.

- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

yes

Yes. However, a foreign filing license can be obtained retroactively from the USPTO with a verified statement containing (i) an averment that the subject matter in question was not under a secrecy order at the time it was filed abroad and that it is not currently under a secrecy order, (ii) a showing that the license has been diligently sought after discovery of the proscribed foreign filing, and (iii) an explanation of why the material was filed abroad through error without the required license first having been obtained. In some technology areas this may present an issue both in the U.S. as well in other countries. For example, typical national security interest technologies, e.g. nuclear, weapons, etc.

NOTE: As at the outset of this response, we note again that this response does not address the potential issue of violation of U.S. export control law. Violation of those laws can result in criminal and civil, and administrative penalties.

However, 35 USC §184 states that "Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent." This can include sending documents to a local foreign agent even if he has not filed the application until after a foreign filing license is granted.

This is perhaps the most complicated issue where multinational "invention" occurs, i.e., where the facts are reasonably clear in a given case that the contribution of the collaborators indicates the "invention was made" in both the U.S. and the non-US country.

If the invention were clearly “made” in only one country then the question of filing in a country other than the country where in the invention was made must be carefully managed in terms of the timing of releasing the invention information in compliance with 37 CFR 5.11(b) and 5.11 (c).

It is readily foreseeable that in some cases it will not be reasonably clear whether the “invention was made” wholly in one country, or both. The current U.S. law on this is unclear for lack of guidance from USPTO or litigation at courts on this phrase.

An increasingly common situation is where a multinational company has research and development based both inside and outside the U.S. For example, in common situations, there is at least one U.S. inventor and at least one non-U.S. national or located inventor, e.g. a citizen or resident of the UK or China and foreign filing licenses are needed from the U.S. and the UK or China. One way of complying with the US, UK or Chinese regulations is to file for U.S. expedited foreign filing license first and then to obtain the UK or Chinese foreign filing license after U.S. foreign filing license was granted. Those and other cross-border compliance issues often depend on the wording of local laws.

- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

Failing to comply with this law bars any patent(s) from such a patent application or renders any patent(s) issued from such an application invalid. 35 U.S.C. §185. Violating an order of secrecy may further result in a fine of not more than \$10,000 and/or imprisonment of not more than two years. 35 U.S.C. §186.

NOTE: As at the outset of this response, we note again that this response does not address the potential issue of violation of U.S. export control law. Violation of those laws can result in criminal and civil, and administrative penalties.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

Under the U.S. patent law, a foreign filing license is required before applying for patent in a foreign patent office or any international agency other than the U.S. receiving office, if the invention is made in the U.S. Filing of a patent application in the USPTO for inventions made in the U.S. is considered to include a petition for foreign filing license for the subject matter of the application. An applicant can also petition for a foreign filing license before filing an application. See *37 C.F.R. 5.12 & 5.13*.

All provisional applications, non-provisional applications and international applications filed in the USPTO are screened for issuance of a foreign filing license. The filing receipt issued by the USPTO will indicate either that a foreign filing license is granted or that the application is under secrecy review. If an application is indicated as under secrecy review, the application has been referred to a government agency for national security review. In the U.S., the secrecy review should last no longer than six months. At the end of six months from filing, a foreign filing license is automatically granted unless a secrecy order is issued. See *Id.*

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

The law varies depending upon whether the U.S. Government has a property interest in the particular invention. If the government has a property interest, paragraph 1 of 35 U.S.C. § 181 requires that-

- Whenever publication or disclosure by the publication of an application or by the grant of a patent... might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent

If the government has no property interest in the invention, paragraphs 2-3 of 35 U.S.C. § 181 requires that-

- Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent ...might, in the opinion of the Commissioner of Patents, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States . . .
- . . . If, in the opinion of the Atomic Energy Commission, the ..., the publication or disclosure of the invention ... would be detrimental to the national security, ... the Commissioner of Patents shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent . . .

The procedure for implementation of these laws is initially defined in MPEP § 115, which states:

- All provisional applications filed under 35 U.S.C. 111(b), nonprovisional applications filed under 35 U.S.C. 111(a), and international applications filed under the PCT, in the U.S. Patent and Trademark Office (USPTO) are reviewed for the purposes of issuance of a foreign filing license pursuant to 35 U.S.C. 184. See also 37 CFR 5.1(b). These applications are screened upon receipt in the USPTO for subject matter that, if disclosed, might impact the national security. Such applications are referred to the appropriate agencies for consideration of restrictions on disclosure of the subject matter as provided for in 35 U.S.C. 181.

35 U.S.C. § 184(a) also requires, regarding applying in a foreign country, that-

- Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent...

Where screening of a patent application per MPEP § 115 results in a determination that its disclosure "might" be "be detrimental to the national security," MPEP § 130 nonetheless requires that-

- Secrecy Order cases are examined for patentability as in other cases, but will not be passed to issue; nor will an interference or derivation be instituted where one or more of the conflicting cases is classified or under Secrecy Order . . .

If prosecution of the application is unsuccessful, as-

- In case of a final rejection, while such action must be properly replied to, and an appeal, if filed, must be completed by the applicant to prevent abandonment, such appeal will not be set for hearing by the Patent Trial and Appeal Board until the Secrecy Order is removed, unless specifically ordered by the Commissioner for Patents . . .

If prosecution of the application is successful, and-

- . . . is in condition for allowance, a notice of allowability (Form D-10) is issued, thus closing the prosecution . . .

The procedure regarding successful prosecution is further defined in MPEP § 1304.01, stating that-

- "Secrecy Order" applications are not sent to issue even when all of the claims have been allowed. Instead of mailing a Notice of Allowance, a D-10 Notice is sent.

- If the “Secrecy Order” in an application is withdrawn after the D-10 notice is mailed, the application should then be treated like an ordinary application in condition for allowance.”

The Applicant/Inventor seeking to recover costs incurred by the secrecy order has two options provided under the law.

First, 35 U.S.C. § 183 states that-

- An applicant... whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that... his application is otherwise in condition for allowance... and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure . . .

But failure to reach an agreement between the Applicant and the government, on the amount of damages, may significantly limit the amount actually awarded, as 35 U.S.C. § 183 also states that-

- If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use.

The Applicant can challenge the award of 75% compensation, as 35 U.S.C. § 183 additionally provides that-

- A claimant may bring suit against the United States in the United States Court of Federal Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government.

Second, the Applicant/Inventor may wait until a patent issues to seek recovery for damages, as 35 U.S.C. § 183 also provides that-

- ...The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the United States Court of Federal Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government..

However, judicial interpretation of the phrase “compensation for the damage caused by the order of secrecy” as used in 35 U.S.C. § 183, is that it must be “actual damages.” *Constant v. United States*, 617 F.2d 239, 244 (Ct. Cl. 1980) (“*We think the consensus at the hearings was that neither the courts nor the administrative agencies would permit purely speculative damages, but that there would have to be “real concrete evidence of damage,” (Id. at 32, Statement of P. J. Federico, Examiner-in-Chief, U.S. Patent Office), “actual damages..”*).

Although the plaintiff’s claim to five types of damages in *Constant* was dismissed, the costs to the Applicant/Inventor may be in the form of:

1. lost profits due to interference of the secrecy order with potential business opportunities, including limited marketability of the product, by requiring compensation only with respect to the government’s taking and use of the technology for a period of time, as a result of the disclosure in a patent application;
2. expenses incurred by attempts to seek rescission of the secrecy order;
3. costs associated with a delay in the filing of foreign patent applications, or the inability to file within the 1 year period prescribed by the Paris convention for applications not filed under the PCT;
4. costs associated with the inability to obtain loans required for development of the technology;
5. damages for interference with the right to compete; and
6. out-of-pocket business losses.

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

35 U.S.C. § 182 sets forth:

- [t]he invention disclosed in an application for patent subject to an order made pursuant to section 181 may be held abandoned upon its being established by the Commissioner of Patents that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner of Patents. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner of Patents shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention. [Emphasis added].

35 U.S.C. §186 sets forth:

- [w]hoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever willfully, in violation of the provisions of section 184, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than \$10,000 or imprisoned for not more than two years, or both. [Emphasis added].

There are stiff penalties for violations of a secrecy order. Under 35 U.S.C. § 182, if an inventor publishes, discloses or files for a patent on that invention in a foreign country without the consent of the Commissioner, the invention may be held abandoned. The abandonment shall constitute forfeiture of the invention. In addition, under 35 U.S.C. § 186, an inventor who, without due authorization willfully publishes or discloses the invention, or who willfully files a foreign patent application, “shall, upon conviction, be fined not more than \$10,000 or imprisoned for not more than two years, or both.” Even an inadvertent disclosure will cause the invention to be abandoned. However, for the penalties under 35 U.S.C. § 186 to attach, the publication or disclosure must be willful.

II.) Policy considerations and proposals for improvements of the current law

- 8) **If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

Defining inventorship through case law cannot lead to a precise scientific definition as to who should be named as the inventor(s) of a patent application. Whether the definition is “sufficient” depends on whether scientific precision is the goal. Measured by the general ability to name inventors in the ordinary course of patent prosecution, the small number of disputes over inventorship, and the difficulty in arriving at a precise framework, the definition is sufficient. Bear in mind that a problem in having a definition based on legal precedent is that the Federal Circuit or the U.S. Supreme Court could significantly alter the definition and render it insufficient in future decisions.

The U.S. Patent Office does not determine or question inventorship during prosecution, but a reminder may be provided in response to claim amendments that it may be necessary to amend the inventors named in the application because of the amendments. The lack of involvement by the Patent Office during routine prosecution prevents the lack of precision from causing problems for inventors.

Inventors who are omitted, and their employers, are the likely challengers to the proper naming of inventors. Challengers can present inventorship issues for determination in the Patent Office or in Court. Before the America Invents Act (AIA), competing applications could be filed in the Patent Office by an omitted inventor, and an interference declared to resolve issues over who the inventor(s) are. With the first inventor to file regime enacted by the AIA, derivation proceedings in the Patent Office are available to resolve assertions that another derived the invention claimed in a post-AIA application.

Identifying who “conceived” an invention is the crux of the inventorship inquiry. Interference case law provides guidance on the level of contribution to the conception of an invention necessary to be named an inventor. Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also. **MPEP 2137.01** summarizes additional relevant case law.

9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

The U.S. does not absolutely require first filing for inventions made in the U.S. The foreign filing license process enables filing outside the U.S. first. (37 C.F.R. 5.11(a)).

10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

Yes. The laws could provide guidance regarding how the U.S. would seek to govern a conflict. It seems as if the law should also seek to inquire if foreign nationals are involved in developing the invention (i.e., are co-inventors), which would be apparent from the ADS, and then a different set of rules would apply. But determining exactly what rules would apply seems, in part, to fall outside of only the purview of patent law. Contractual agreements should/are made between employees and companies, and legal agreements between parent companies and subsidiaries. Harmonization would seem to require treaty agreements with various nations, particularly those with a requirement that inventors must first file in their own country.

As the multinational inventions being discussed are limited to inventions made in this country, the U.S. Government has jurisdictional authority to impose its laws on the foreign national inventor. Therefore, the aspects of the law that should be improved are the aspects that govern the compensation/remuneration of the taker of the invention. 35 USC § 183 limits the recovery to 75%, by stating in-part:

- An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal represen-

tatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. [Emphasis added].

A more just and equitable compensation arrangement would allow for a world-wide economic analysis to be used in the compensation for damages.

The U.S. patent law provides that a foreign filing license is required before an application for patent for inventions made in the U.S. can be filed in any foreign patent office or international agency other than the U.S. receiving office. The U.S. patent law also provides that no foreign filing license is required if the invention was not made in the U.S. See *37 C.F.R. 5.11*. However, the U.S. patent law provides no guidelines on what is considered to be "made in the U.S." When an invention results from collaborations among inventors from different countries, it is often difficult, if not impossible, to identify in which country the invention was made. Sometimes, an invention can only be considered partly made in the U.S. In other cases, it may be legally determined under the patent law of two or more countries that an invention was made in each of the two or more countries. No provision is set forth in the U.S. patent law on whether a foreign filing license is required for a patent application for an invention that is only partly made in the U.S. or that is made in the U.S. and another country.

11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

No

III.) Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

As a reference point, a definition of U.S. inventorship is set forth below.

In the United States of America (U.S.) **35 U.S.C. 115** requires that the correct inventor(s) be named in a patent application. In addition, **35 U.S.C. 116** establishes guidelines for joint inventorship by stating that "Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent." No statute identifies the definition of inventorship *per se*. Rather, the definition for inventorship is established by case law. **MPEP 2137.01** summarizes relevant case law. In general, the definition of inventorship can be simply stated: "The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor. . . . Insofar as defining an inventor is concerned, reduction to practice, *per se*, is irrelevant." *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993). "[T]here is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf." *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, "one who suggests an idea of a result to be accomplished, rather than the means of accomplishing it, is not an inventor." *Ex parte Smernoff*, 215 USPQ 545, 547 (Bd. App. 1982). In addition, "In arriving at . . . conception [the inventor] may consider and

adopt ideas and materials derived from many sources [such as] a suggestion from an employee, or hired consultant . . . so long as he maintains intellectual domination of the work of making the invention down to the successful testing, selecting or rejecting as he goes . . . even if such suggestion [or material] proves to be the key that unlocks his problem." *Morse v. Porter*, 155 USPQ 280, 283 (Bd. Pat. Inter. 1965).

It would be beneficial to establish uniformity in determining inventorship in order to ensure correct indication of inventorship in the case of multinational inventions. A harmonised system could adopt the U.S. system of determining inventorship based on conception of what is claimed, which results in a fair and reasonable determination of inventorship. The harmonised system could also adopt a harmonised definition of conception, based on a mental concept of what is invented and claimed, and determined by corroborated evidence.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

Whenever in an application or issued patent ("Patent Asset") an individual who is not an inventor is named, or an inventor is not named, the Patent Asset will be corrected on the application of all Parties with proof of the facts and such other requirements as may be imposed. Parties comprise the individuals and Owners to be added or removed from the Patent Asset. With correction under this Section, omitting inventors or naming of individuals who are not inventors will not support a defense to an issued patent. This Section will not negative any defense to an issued patent under the doctrine of "unclean hands" (also known as "inequitable conduct") as may exist in the pertinent jurisdiction.

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

For applications involving multinational inventions i.e., involving conflicting first filing requirements of two or more countries and which do not come under the umbrella of technology for which the secrecy review seeks to prevent the filing thereof abroad (e.g., technology that includes national secrets or impacts national security), the involved countries shall allow filing in either country as the first filing through a joint filing mechanism wherein a filing in either country which identifies the countries in which first filing for such application is required is deemed to be filed in each affected country on the same day and considered as having been filed first in the respective country.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

Harmonization in this area is very difficult as each sovereign country has a right to decide on the types of inventions it desires to keep secret. In addition, the industries in various countries can be quite different and varied and therefore, what makes sense in one country may not make sense in other countries. A country with a weapons/defense industry cannot impose its will on a country without such industry.

We did feel as if the "formalities" of secrecy review (filing requirements and foreign filing license) may have some opportunities for harmonization.

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

For applications which come under the umbrella of technology for which the secrecy review seeks to prevent the filing thereof abroad (e.g., technology that includes national secrets or impacts national security), an international standard may not be appropriate. For example, the fact that multi-national joint inventors are sharing technology across borders (including electronically in all forms or where a non-citizen residing in a foreign country collaborates and shares potentially barred technology) may not be something that should be remedied by a universal international standard.

Should an international standard be deemed appropriate, however, any requirements for obtaining a foreign filing license should seek to balance competing interests in patent policy, such as national security interests versus the burden on parties involved in providing and obtaining a foreign filing license. For example, since the purpose of the submission for a foreign filing license differs from the patent application itself, at least because the submission is focused on allowing national security considerations and/or other concerns to be investigated rather than claiming subject matter, the submission should not require the same level of patent drafting craftsmanship as the patent application. Since any subject matter to be claimed has to be disclosed in the patent application, claims themselves (which can be time consuming to draft) should not be needed in the submission for obtaining a foreign filing license. Rather, a description of what is covered by the patent application, that may include illustrative drawings and/or any other relevant information or material(s) that would assist in the determination whether a foreign filing license should be granted, should be a sufficient submission. Such a submission would likely be less burdensome on the applicant to prepare, and thus could be prepared more quickly (e.g., in view of a pending disclosure) and/or less expensively. Similarly, such a submission would likely be examined in less time than a patent application drafted in legalese.

Where there are inventors from different countries and each of the inventors' respective countries require a foreign license, an international standard would allow load balancing to occur between the different patent offices. For example, under an international standard, one foreign filing license request that is acceptable to each/all of several involved patent offices could be prepared and filed in several countries. Approving the request by a first patent office may inform the decisions of other patent offices and/or may enable the other patent offices to allow the request automatically as a matter of deference.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

A retroactive approval should be possible where:

1. the subject matter of the patent application does not come under the umbrella of technology for which the secrecy review seeks to prevent the filing thereof abroad (e.g., technology that includes national secrets or impacts national security); and
2. failing to comply was unintentional and occurred through error and without deceptive intent by the patent applicant. Implementation should be strict and require the submission of verified statements, declarations, affidavits or other means to submit evidence under oath from those with personal knowledge including copies of supportive documents demonstrating the truthfulness of the information contained therein.

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

If an incorrect indication of inventorship is made on a patent application, the consequences of this error vary from country to country. The issued patent may be held to be invalid or unenforceable in some jurisdictions but not in others. The error may be correctable in some countries, but not in others.

We would propose:

1. That a significant and growing part of subject matter protected by intellectual property in today's world is created within the framework of multinational jurisdictions encompassing collaborative research projects having multiple inventors domiciled in multiple countries.
2. That the existence of considerable differences between national laws concerning how to correct inventorship to intellectual property causes complications and problems for cross border R&D both within multinational enterprises and for cooperation between companies.
3. That the correction of inventorship in pending patent applications and patent grants should be governed by harmonised rules since it affects their prosecution and their enforcement.
4. That progress has been made towards establishing a unified approach for the public and stakeholders to access basic patent file information known as the Global Dossier.
5. That the corrective procedure rules should initially at least provide for correction of inventorship before an administrative agency, generally this will be a national/regional patent office, and that the rules should provide for uniform data fields, at least in part, that allow for an automated process to initiate changes across multiple counterpart patent assets with an ultimate goal to have a centralized automated approach to correct inventorship in multiple jurisdictions in a simple and cost effective way. [Harmonisation in determination of inventorship will make this goal more achievable.]

Summary

In the U.S., a key to inventorship is “conception”—contribution to the subject matter in the claims. Caselaw provides guidance on the level of contribution to the conception of an invention necessary to be named an inventor. A harmonised system should determine inventorship based on conception of what is claimed. Conception should be based on a mental concept of what is invented and claimed, and determined by corroborated evidence.

In the U.S., pending patent applications must be rejected where inventorship errors are identified. But the USPTO does not determine or question inventorship during prosecution. Issued U.S. patents can be held invalid for an error in stated inventorship, but can be corrected, even during litigation. A harmonised system should allow correction of inventorship of applications or issued patents, and should not negative any defense in litigation under the doctrine of “unclean hands.”

The U.S. does not have a first filing requirement, but does require foreign filing licenses, and a secrecy review process. Secrecy review requirements depend on the exigencies of each country, making harmonisation difficult and likely undesirable. For applications involving technologies that do not implicate a secrecy review requirement, a harmonised system should regard filing through a joint filing mechanism as the first filing in each respective country. Where inventors are from different countries, an approved foreign filing license request should inform the decisions of other patent offices. Inadvertent failure to comply with first filing requirements should be retroactively curable for applications that would not require secrecy review.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Uruguay

Report Q244

in the name of the Uruguay Group
by Gustavo FISCHER and Juan LAPENNE

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

1.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

The statute in force concerning invention is Uruguayan Patent Law No. 17.164 dated September 2, 1999 (hereinafter referred to as "the Patent Law"). The Patent Law does not define inventorship.

Chapter II of the Patent Law refers to the issue of "ownership of patents" (as per article 16 quoted below), and sets the rule that the right to a patent will belong to the inventor or to his successors in title, but fails to address the issue, and does not provide a concept or definition of who will be deemed to be an inventor.

As expressed above, this issue is not addressed by the Patent Law. However, and due to the fact that our law does not define nor limit the term "inventorship", we understand that every person contributing (in a non-frivolous manner) to an invention would be considered an inventor. In the mentioned example, we understand that both A and B would be considered co-inventors.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Uruguayan Patent Law does not define inventorship.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Please refer to our answers above regarding the lack of definition of inventorship. However, and due to the fact that our law does not define nor limit the term "inventorship", we understand that the term "inventorship" does not depend on the citizenship of the inventor.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Please refer to our answers above. However, and due to the fact that our law does not define nor limit the term "inventorship", we understand that the term "inventorship" does not depend on where the invention was made.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

Pursuant to article 30 of the Patent Law, a patent application may be modified, among other things, to rectify errors in the information contained therein.

As to requirements, pursuant to article 30 of the Patent Law, "Patent applications may not be modified, except in the following cases:

(a) to rectify errors in the data, the text or the graphic representation;

(b) to clarify, explain, limit or restrict their subject matter;

(c) when required by the examining officials.

No modification, rectification or clarification implying an extension of the information in the original application shall be permitted".

As to time limit, there is no express time limit imposed in the Patent Law to perform such correction. However, since the law refers to the possibility of correcting "Patent applications", it would appear that such corrections may only be performed while the application is pending.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

The Patent Law distinguishes between cases of nullity and invalidity.

Articles 44, 45 and 46 of the Patent Law provide as follows:

"44. Patents shall be null in the following cases:

(a) if they have been granted in violation of the patentability criteria and requirements set out in this Law;

(b) if the description was incomplete or inaccurate and did not allow the subject matter of the invention to be defined;

(c) if material not included in the original application is claimed, in accordance with the provisions of this Law.

45. Patents granted to persons who have no right to obtain them shall be invalid.

A complaint may be filed by the person who claims to be the true owner within five years from the date of granting the patent or three years from the date on which the invention started to be exploited in Uruguay, whichever expires first.

46. When the complaint only relates to all or part of any claim concerning the patent, the decision shall be limited to the claim, whose scope must be defined, where applicable".

From the above, it appears that the Patent Law has distinguished between cases of "nullity" (such as the breach of the patentability criteria, art. 44), and cases of "invalidity" (the latter, being subject to a statute of limitations, and which the law would appear to allow to be cured by the lapsing of the term for the alleged owner to claim ownership). In addition, the Patent Law contemplates partial effects of the complaint, in article 45.

6) **Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?**

no

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- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) **Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?**

no

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- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

- 8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?**

Uruguayan Patent Law does not define inventorship. It would be desirable to have the law provide with such a definition to provide with clear guidance on who should be named as inventor(s) of a given patent application.

- 9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

As mentioned above, there are no requirements in Uruguay for first filing of patent applications.

- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

No requirement to that end is provided in Uruguay.

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

N/A.

III.) Proposals for harmonisation

- 12) Is harmonisation in this area desirable?**

no

In the current stage of the legislative evolution in Uruguay, where the law lacks of a definition of inventorship, it is still too early to promote harmonization as regards our jurisdiction.

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.**

In the current stage of the legislative evolution in Uruguay, where the law lacks of a definition of inventorship, it is still too early to promote harmonization as regards our jurisdiction.

Every person who contributes, in a non-frivolous manner, to the construction/creation of a patentable invention, will be deemed an inventor, regardless of his/her nationality, citizenship or residence.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

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- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**
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- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**
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- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**
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- 18) **Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.**
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- 19) **Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.**
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Summary

EN. Uruguayan Patent Law does not contain a definition of inventorship. Similarly, it does not contain requirements for first filing of patent applications in Uruguay for patents claiming an invention made in our country. It does also not contain any provisions concerning a requirement that a patent application claiming an invention made, at least in part, in Uruguay undergo a secrecy review or similar process before it can be filed in another country. Patent applications may be corrected to rectify errors in the data, the text or the graphic representation. Since Uruguay lacks of definitions regarding the above issues, it is too early in our legislative development to propose harmonization principles or standards.

FR. Le droit uruguayen des brevets ne prévoit aucune définition concernant l'inventeur. De même, il n'établit pas d'exigences concernant le premier dépôt de demandes de brevet en Uruguay pour des brevets qui revendiquent une invention créée en territoire uruguayen. Le droit uruguayen ne prévoit pas de dispositions relatives à l'exigence, concernant à une demande de brevet revendiquant une invention créée, en moins en partie, en Uruguay, d'être objet d'un examen secret ou d'un procès similaire avant de pouvoir être déposée à l'étranger. Les demandes de brevet peuvent être corrigées pour rectifier des erreurs dans les données, le texte ou les images. Étant donné que l'Uruguay n'a pas de définitions relatives aux questions susmentionnées, notre développement législatif n'a pas atteint un niveau où l'on pourrait proposer d'harmoniser les principes ou les standards.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

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Venezuela

Report Q244

in the name of the Venezuela Group
by Carlos PACHECO

Grace period for patents

Questions

The Groups are invited to answer the following questions under their national laws.

I.) Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

- a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

Both persons, A and B, are considered as inventors according to the Patent Law. Both persons, A and B, are considered as inventors according to the Patent Law.

- b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

The correction can be filed at any stage of the Patent application process before the granting, by means of a voluntary brief.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

In the event of an intentional or unintentional error regarding an inventor's name, address or citizenship, such error must be corrected before the granting of the Patent; otherwise, the Patent application will be considered as abandoned.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.
- b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.
- c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?
- d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?
- e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?
- f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

no

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?
- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

II.) Policy considerations and proposals for improvements of the current law

8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

Inventorship is not defined in the Venezuelan Patent Law.

- 9) **If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

This kind of law does not exist on the Venezuela legal system.

- 10) **If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?**

This kind of law does not exist on the Venezuela legal system.

- 11) **Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.**

III.) Proposals for harmonisation

- 12) **Is harmonisation in this area desirable?**

yes

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) **Please provide a definition of inventorship that you believe would be an appropriate international standard.**

Inventor is an individual that devises, creates or conceives an innovating solution to a technical problem.

- 14) **Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).**

The Patent application petitioner or a Patent holder can file at any moment for the correction of an inventor's name, address or citizenship, to an intentional or unintentional error before the Patent Office, by means of a voluntary brief.

- 15) **If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.**

We consider this requirement it is not appropriate.

- 16) **If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.**

We consider this requirement it is not appropriate.

- 17) **If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.**

We consider this requirement it is not appropriate.

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.
- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

Summary

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

Summary Report

Question 244

Inventorship of Multinational Inventions

by Sarah MATHESON, Reporter General
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Assistants to the Reporter General

This Question concerns the issue of inventorship of joint inventions where the inventors reside in different countries. Due to the prevalence of international corporations having geographically distributed research groups, multinational joint venture projects, international corporate/university collaborations, and other cross-border research projects, and further due to the ease of international communications and exchange of data, international joint inventorship is today a common occurrence. This Question focuses on two issues that are important to multinational inventions: determination of inventorship in the context of multinational inventions; and national requirements relating to foreign filings.

Definitions

- 1) **Multinational inventions.** For the purposes of this Question, *multinational inventions* means inventions having two or more inventors where different national laws concerning inventorship apply to at least two of the inventors. In the most common case, this would involve, for example, a first joint inventor of citizenship X residing in country X who is a co-inventor of an invention with a second joint inventor of citizenship Y residing in country Y. However, different national laws may apply to the (at least) two inventors even if they are of the same citizenship, but reside in different countries. Different national laws may even apply to the two inventors if they reside in the same country, but are of different citizenship or have employment contracts under different national laws.
- 2) **First filing requirement.** For the purposes of this Question, a *first filing requirement* means a requirement that a patent application for an invention – be it all inventions or only inventions in certain technology areas – that is made or partially made in a country be filed first in that country before filing in any other country.
- 3) **Foreign filing license.** For the purposes of this Question, a *foreign filing license* means any procedure or mechanism for obtaining an exemption to a first filing requirement.
- 4) **Secrecy review.** While the first filing requirement is a procedural requirement, secrecy review as used in this Question refers to a substantive review by a governmental authority of the subject matter of a patent application to determine whether it implicates national security or other national interests, or includes subject matter that must be kept secret.

The Reporter General has received reports from the following Groups and Independent Members in alphabetical order: Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, Central American & Caribbean Regional Group, China, Czech Republic, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, Independent Member (Taiwan), Indonesia, Israel, Italy, Japan, Mexico, Netherlands, New Zealand, Norway, Paraguay, Peru, Philippines, Poland, Republic of Korea, Russian Federation, Singapore, Spain, Sri Lanka, Sweden, Switzerland, Turkey, United Kingdom, United States of America, Uruguay,

and Venezuela. 43 reports were received in total. All of the Reports were very helpful and assisted greatly.

The Reports provide a comprehensive review of national and regional laws and policies relating to inventorship of multinational inventions. This Summary Report does not attempt to reproduce the detailed responses given by each Group or Member. If any question arises as to the exact position in a particular jurisdiction, reference should be made to the original Reports. See <https://www.aippi.org/>.

A summary of the Reports received follows. Where percentages of responses are given, they are to the nearest 1%.

In Part IV below, some conclusions have been drawn in order to provide guidance to the Working Committee for this Question.

I. Current law and practice

- 1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

Most Reports indicate that while their patent statute refers to “inventor(s)”, the statute does not define inventorship explicitly. Eight Reports indicate that their statute does include a definition of inventorship; these definitions generally refer in some sense to the concept of creation: China, “any person who makes creative contributions to the substantive features of an invention”; Czech Republic, “the person who made the invention by its creative work”; Estonia, “person who has created an invention as a result of his or her inventing activities”; Hungary, “the person who has created the invention shall be deemed to be the inventor”; Russian Federation, “creative contribution”; Sri Lanka, “invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology”; Singapore and United Kingdom, “actual deviser of the invention.”

Many Reports indicate that, while not statutory, a definition of inventorship has been developed through case law or literature. These definitions vary significantly, but generally look for contribution to an inventive concept: Australia, “contribution to conception of the invention”; Austria, “the one who recognizes the concept of the invention”; Belgium, “each person who has delivered a substantial contribution to the invention”; Canada, “the person who first conceives of a new idea or discovers a new thing that is the invention, and the person that sets the conception or discovery into a practical shape”; Denmark, “the originator of the idea on the basis of which the invention is developed”; Finland, “someone who has made the invention or contributed to the invention”; France, “whoever conceives and makes the invention has the status of inventor ... [t]he invention consists in means capable of achieving a result ... [c]onsequently, the inventor is the person who discovers the means”; Germany, “creative contribution to the technical teaching that is not insignificant”; Independent Member (Taiwan), “ a person who has made conceptual contributions to the substantive features of the invention”; Israel, “a person who contributed to the conception of the invention”; Japan, “conceived of the means for solving the problem”; New Zealand, “contributed to devising the invention”; Norway, “solution to the technical problem .. [or] an independent intellectual contribution to the invention”; Republic of Korea, “a person who has substantially engaged in the creative process of an invention”; Spain, “contributed intellectually to reach the technical solution to the technical problem”; Sweden, “the person having intellectually generated the invention, the person having conceived of the innovative step beyond prior art”; Switzerland, “creator(s) of the inventive concept”; US, “threshold question in determining inventorship is who conceived the invention”; and Uruguay, “every person contributing (in a non-frivolous manner) to an invention.”

The Reports from Argentina, Brazil, Mexico, noted that the listed inventor is presumed to be the inventor. The Report from Poland indicates that it is “solely and completely up to the persons involved with making the invention to decide who will be listed in a patent application.”

- a. If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

With regard to the effect of the residency of the inventors, the Spanish Group notes, under Spanish law, person A would be an inventor whose activities would be governed by its country of residence, while person B would be considered as a Spanish inventor. All other Reports addressing this sub-question indicate that the residency or location of the inventors would make no difference to the inventorship determination.

With regard to the issue of who would be considered an inventor, a strong majority of reports indicate that this would depend on whether one or both of person A and person B contributed to the inventive concept or means for solving the technical problem. As explained, for example, by the US Group:

Whether person A or B is an inventor, or both are joint inventors, depends on what is claimed, and who conceived the subject claimed. If A's direction to B is to “provide me with a better widget” and B conceives of such a widget, B would be the inventor. If A directs B to, for example, “reduce to practice a widget having elements (a), (b) and (c),” the combination that is ultimately claimed, then A would be the inventor. If A directs B to produce a widget having elements (a) and (b), and B conceives and produces a widget having elements (a), (b) and (c), the combination ultimately claimed, A and B would be joint inventors.

- b. Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

80% of the responding Reports answered this question in the negative, indicating either that the law would consider inventorship based on the application as a whole, or that there is no specific guidance on this point. For example, the Australian Group indicates, “It is necessary to examine the complete specification as a whole (including the claims) to determine the inventive concept that is described or disclosed; it is generally not an analysis on a claim by claim basis.” Similarly, the German Group notes, “[d]ecisive for the determination of a possible creative contribution to the subject matter of the patent is the entire content of the patent application including description and drawings. Thus, whether or not a person may be considered an inventor is to be determined on the basis of the patent application as a whole.” (Citations omitted).

The Reports that answered this question in the affirmative generally note that because the inventive concept is defined by the claims, conception of or contribution to the inventive concept must be considered based on the language of the claims. For example, the Canadian Report explains,

The key consideration in determining inventorship is whether a person contributed to the inventive concept of the invention. Typically, the inventive concept is reflected in the claims, and there is authority for the proposition that “any question of inventorship or date of invention must be tested against language of the patent claims, which alone define the exclusive right conveyed by the patent grant.” (Citations omitted).

The Japanese Report notes that inventorship is determined on a claim by claim basis:

Under the Japanese law, inventorship is determined on a claim by claim basis. Therefore, if a claim is deleted, changed or restricted, etc. in the amendment or correction process, inventorship is changed ex-post facto in relationship to the relevant claim.

Similarly, the US Group notes that “[i]n the US inventorship is determined based on the contribution to the subject matter in the claims. The Report from the Republic of Korea also indicates that inventorship would be considered based upon contribution to a creative feature of an element (except for a known element) of an invention, i.e., a claim.

The Reports from the Russian Federation (referring to both Russian and Eurasian patent law) and Singapore note that inventorship would be determined based on examining the inventions set forth in the independent claims.

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

All received Reports answered this question in the negative with the exception of the Report from the Indonesian Group, which notes that the nationality of the inventor(s) must be specified on the application.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

All received Reports answered this question in the negative with the exception of the Report from the Spanish Group, which notes,

Spanish rules on inventorship apply to inventions made in Spain. The Spanish Patent Act provides that an invention is presumed to have been made in Spain if the inventors have their residence in Spain, unless it can be proved that the invention has been made elsewhere.

A number of Reports note the difficulty of determining the choice of law in the case of multinational inventorship. For example, the French Report observes,

French law regulates only the question of the rights to the patent, and not the question of the definition of the inventor. However, certain rules relating to the right to the patent could provide indications as to the law applicable to the determination of the inventors. Drawing on Article 60 of the European Patent Convention in relation to the right to the patent, and where an international aspect exists, it may be considered that inventorship should be determined in accordance with the same criteria:

- The law of the State in which the employee exercises his principal activity, thus ultimately the place where the invention was made;
- In the alternative, the law of the State in which the employer has the place of business to which the employee is attached.

However, in the context of multinational inventions involving a number of inventors living or making the invention in different places and who are not within a contractual framework, it is difficult to determine which criterion of connection should be adopted in order to trigger the application of “French law” to the determination of inventorship.

4) Can the inventorship of a patent application be corrected after the filing date in your country?

All Reports answered this question in the affirmative with the exception of the Report from Greece, which indicates that no correction of the applicant(s) or the inventor(s) name is possible after filing in the national patent procedure.

a. If yes, what are the requirements and time limits for such correction?

With the exception of Greece, all Reports indicate that there is a mechanism to correct inventorship after the national filing date. However, the requirements and time limits vary significantly from jurisdiction to jurisdiction. The Independent Member notes that in Taiwan if inventorship is changed from inventor A to inventor B, the filing date of the application will be changed to the date of the correction. The Turkish Group reports that a petition to add a new inventor to an application can be made at any time, but there is no way to remove the name of an existing inventor from an application.

A majority of Reports indicate that a voluntary correction to inventorship may be made before grant of the application, but that a different procedure – typically involving a court action – is required to correct inventorship after grant. The requirements for a voluntary correction also vary; some jurisdictions require only a request whereas others require a declaration of the inventors / applicant and a showing of inadvertence or mistake. Four Group Reports indicate that consent of the affected inventor is required to remove that inventor from an application.

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

38% of the Reports indicate that there are no consequences of an error in the stated inventorship other than correction of the error. The Reports from Israel, Japan, New Zealand and Singapore note that an application may be refused grant, or a patent invalidated, in the case of misappropriation or fraud.

Another 38% of the Reports explain that a patent application or issued patent may be refused grant, revoked, or transferred upon an action by the true inventor. Hence, in these jurisdictions a third-party challenge to validity on the basis of an error in stated inventorship is not available. A minority of Reports indicate that an error in stated inventorship would be a grounds for refusal of grant (14%) or revocation upon a third-party action (12%).

All Reports indicate that the intentional or unintentional nature of the error is not a decisive factor. However, several Groups note that an intentional error might rise to the level of misappropriation or fraud, and thus could lead to unenforceability or nullity on that basis. The Australian Group notes that an intentional error may weigh on a court's equitable discretion of whether to issue a revocation order. The Danish and U.K. Groups note that the time period for taking action by an unnamed, true inventor is affected by whether the error was intentional or unintentional.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

Thirteen of the 42 responding Reports answer this question in the affirmative (Belgium, Denmark, France, Indonesia, Israel, Italy, Netherlands, Norway, Russian Federation, Singapore, Spain, United Kingdom, United States). The remaining 29 Reports indicate that no such requirement exists in their jurisdiction. The Spanish Group Report explains the current Spanish Patents Act as follows:

when the inventor has his/her habitual residence in Spain it is presumed that the invention has been made in Spain and, therefore, there is the requirement to first file the application of the patent in Spain. Furthermore, one must also take into account that Royal Decree No. 2424/1986, and Royal Decree 1123/1995, establish that when the applicant (not the inventor, therefore the invention could have been made out of Spain) of a European/ International patent application has its domicile or headquarters in Spain, or its habitual

residence or permanent establishment in Spain, and it does not claim the priority of a previous application in Spain, it must compulsorily file the European/International patent application at the SPTO. Here, attention should be paid to the fact that no Foreign First Filing License is allowed in either cases. However, currently, Spanish law does not establish any specific sanction in the event the First Filing is not done in Spain.

If the answer is yes, please answer the following:

- a. Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain

Of the 13 Reports that answered “yes” to question 6 above, five of the Reports indicate that the first filing requirements apply to all inventions made in their country, without regard to technical area (Italy, Russian Federation, Singapore, Spain, and US). The remaining eight Reports indicate that first filing requirements apply only to national security-related inventions (and, in the case of Israel, to inventions by State employees).

- b. Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it

Seven of the Reports indicate that a foreign filing license or similar mechanism is available to permit a first filing in another country. Generally, these licenses may be issued upon request, or issued automatically in response to an original national filing.

- c. If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

Only two of the Reports (France and US) indicate availability of a retroactive foreign filing license (although it is not automatically granted).

- d. How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

All of the responding Reports indicate that their law applies to an inventor in their country who makes or contributes to an invention. Two of the Reports indicate that their law would also apply to a citizen working abroad. The French Group Report notes that if the invention was made in a country that is a party to the “Letter of Intent” agreement, namely Germany, Spain, Italy, the UK and Sweden, or was financed by such a country, a patent application may be filed in that country even if it incorporates the contribution of a French inventor.

The Danish, Israeli, and US Group Reports note the potentially problematic nature of first filing requirements in the international context. For example, the Israeli Group Report explains,

As noted above, the Patents Act might apply to inventions conceived by Israeli citizens residing outside of Israel. It follows that patent applications claiming an invention that was made jointly in Israel and with another inventor in another country are also subject to first filing requirements. The nationality of the patent owner does not affect the answer to this question. This state of the law may result in inventors finding themselves in a “Catch 22” scenario. For example, if the invention was conceived by two inventors, an Israeli inventor and a US co-inventor, and the laws of each country require that the invention be filed first in their country, it is not possible to file in any country without violating the first filing requirement.

- e. In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

Six of the responding Reports indicate this would be a violation, five indicate that it would not (except in the case of national security-related applications).

- f. What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

All of the responding Reports indicate the potential for a fine or criminal prosecution, depending on whether the application contains national security-related information. The Spanish and US Group Reports indicate that patent invalidity or abandonment may also be a consequence. Most Reports note that an inadvertent error would be less likely to face criminal penalties.

- 7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

Exactly half of the Reports answered this question in the affirmative and half in the negative. The Polish Group Report notes that although Polish law does not require a secrecy review before foreign filing, there is nonetheless a secrecy law that applies to any invention made by a Polish national (regardless of residency) that would require a secrecy review of any patent application related to such an invention if it relates to national security. The Canadian Group Report notes that only inventions made by government employees or that are otherwise owned by the government require Ministerial approval before disclosure or patent application filing abroad. Applications in certain technology areas also may be subject to security review, but there is no prohibition on foreign filings.

- a. If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?

11 of the 21 Reports that answered question 7 in the affirmative indicate that a secrecy review is conducted on all applications regardless of technology. The Report from the Dutch Group explains that European patent applications must only be filed with the national authority "if the applicant knows or reasonably should know that the content thereof should be kept confidential in the interest of the defence of the kingdom or its allies." The remaining nine Reports indicate that the law relating to secrecy review applies only to technologies relating to national security.

- b. If yes, describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

Slightly more than 50% of the Reports indicate that security review is automatic upon filing, with time periods for issuing a secrecy order ranging from 6 weeks to 6 months. In all jurisdictions where a secrecy provision exists, the patent office may prohibit disclosure and foreign filings (except for those cases where a secrecy agreement exists among countries) if the application is found to contain subject matter important to national security. In the other jurisdictions, secrecy review is conducted upon request or upon referral by the patent office. The Chinese Group Report indicates that a PCT application filed with SIPO is deemed to be a request for secrecy review and foreign filing authorization; any other national application would require the filing of a request for authorization before foreign filing takes place.

- c. If yes, describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

12 of the 21 affirmatively-responding Reports on question 7 indicate that the consequences of failing to comply with this law may include criminal penalties. The Reports from Brazil, Hungary, and Turkey indicate that there are not specific consequences. Three Reports indicate administrative consequences: Bulgaria (withdrawal of application); China (refusal of grant); and the US (abandonment as of date of violation). The Spanish Group Report notes a consequence in the form of loss of right to compensation for secrecy designation.

II. Policy considerations and proposals for improvements of the current law

- 8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

Of the 30 Reports that responded to this question, 15 suggest that adding a legal definition of inventorship to the statutes or regulations would be desirable. The Spanish Group Report qualified this by saying it would be desirable only if the definition was internationally harmonized.

Fourteen of the 30 responding Reports indicate that the current law in their jurisdiction is acceptable as is, and that no (additional) formal definition of inventorship is necessary. The Group from Israel notes that while it would prefer not to codify a definition of inventorship, it would be desirable to clarify in the Patents Act that when an invention is disclosed but not claimed in a patent application, the inventor of the unclaimed invention should not be listed as an inventor of the claimed invention.

- 9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

Fifteen Reports responded to this question as applicable to the laws of their jurisdiction. Of these, five suggest the need to specifically address the multinational invention situation in the patent law. Two of those five further recommend an internationally or at least regionally harmonized approach. The Belgian Report recommends that additional certainty or guidance is needed as to which inventions are relevant for the defence of the territory or national security, particularly in the multinational inventorship scenario. The French Report recommends that all applications except those directed to military or dual-use technologies should be exempted from the first filing requirements. The Dutch report suggests that it should be made possible to file defense-related inventions in other NATO countries. The Polish Report suggests that the first filing and secrecy laws, which are currently in conflict, could be revised for greater clarity and effectiveness. The Report from the Russian Federation suggests that applications with at least one non-Russian citizen should be exempt from the foreign filing requirement, noting,

We believe that the law in this part can be amended by exclusion from first filing in Russia rule of applications although created in Russia but have foreign citizens in the inventor's list. It is not reasonably possible to claim state secret of information which legitimately is in the possession of foreign citizens (at least without their direct approval). So the law should include mentioning of Russian citizenship of inventors as requirement for first filing Rule.

The Spanish Group Report suggests that the first filing criteria could be harmonized and simplified, or if harmonization is not possible Spanish law should at least allow the possibility to request a foreign filing license for European and International applications when the applicant resides in Spain.

In contrast, four Reports indicate that no improvements are necessary to address multinational inventions.

- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

Twenty-two Reports responded to this question as applicable to the laws of their jurisdiction. Of these, seven Reports indicate that no improvements are necessary to address multinational inventions. In this regard, the Report from Finland notes that contribution to an invention by a resident of Finland is already contemplated in the law: “[w]ith regard to Finland the question would relate to inventions important for the defense of the country, whereby the relevant act refers to inventions made by, or contributed to by a resident in Finland (DIA, Section 2).” The Report from the Hungarian Group similarly notes that security examination is carried out only if the application is filed first in Hungary and the applicant(s) is (are) Hungarian – for partially foreign applicants this rule does not apply.

The Belgian Group Report suggests: 1) an automatic prohibition to file abroad during a short period of time (7 days for instance), but only if the Belgian patent filing was the first filing. Unless an objection is raised, subsequent foreign patent filings should be allowed; and 2) multinational inventors should also be allowed to exchange texts with foreign patent attorneys on a confidential basis during the secrecy review. The Brazilian Group Report similarly suggests definition of a deadline for evaluating relevance to national security interests.

The Canadian Group Report notes that although these provisions are rarely used in Canada, there should be a clear mechanism formalized by Regulations or Statute for situations requiring a secrecy review that may arise.

The French Group Report suggests that French law could be improved by making provision for the secrecy procedure for national security purposes to be limited to priority patent applications filed in France and for it not to extend to French patent applications filed under the priority of a foreign application. Further, as noted in the answer to question 9 above, the French Group Report suggests to dispense with the review for national security purposes of patent applications that relate neither to technologies capable of being incorporated in military items nor to dual-use technologies that have not yet been the subject of an export authorisation.

The German Group Report recommends: 1) the provisions governing the need for a secrecy review of patent applications filed at the German Patent and Trade Mark Office should be amended to clarify what is and what is not a national secret which, if contained in a patent application, requires an order of secrecy to be imposed on the application. However, such an amendment would not make any difference on whether the invention forming the subject of the application was made by two or more inventors of the same nationality or different nationalities; and 2) it is suggested that the present statute regarding secrecy review should be amended in a way that it allows to file a patent application, which is considered to disclose an invention which might concern national security, with the competent authorities of the foreign co-inventor(s), or a supranational patent authority to which the secrecy review will be delegated.

The Greek, Israeli, U.K., and US Group Reports suggest that specific guidance or policy is needed for dealing with multinational inventions where more than one applicable jurisdiction has a secrecy review requirement. The U.K. Group explains,

there is a potential conflict between UK and foreign laws if a patent application has been filed for “secret” subject matter, and was developed by multinational inventors. In these circumstances foreign law may require one of the inventors to first file in their home country whereas UK law may require a UK resident to file first in the UK (if a foreign filing license is not available). This problem may even arise in respect of a sole inventor because UK secrecy provisions apply to UK residents, regardless of nationality, whereas

foreign laws may apply to foreign nationals, regardless of residency. This could be an intractable problem for patent applications which include "secret" subject matter.

The US Group Report similarly notes,

the US patent law provides no guidelines on what is considered to be "made in the US" When an invention results from collaborations among inventors from different countries, it is often difficult, if not impossible, to identify in which country the invention was made. Sometimes, an invention can only be considered partly made in the US. In other cases, it may be legally determined under the patent law of two or more countries that an invention was made in each of the two or more countries. No provision is set forth in the US patent law on whether a foreign filing license is required for a patent application for an invention that is only partly made in the US or that is made in the US and another country.

The US Group Report further suggests that the law limiting the amount of compensation for the taking of an invention could be replaced with a more just and equitable compensation arrangement would allow for a world-wide economic analysis to be used in the compensation for damages.

The Norwegian Group Report notes that harmonization is needed in this area, but that this would be difficult unless a reciprocal system were in place with adequate safeguards.

The Report from the Russian Group suggests that the secrecy regulation in the law should cover only inventors who are Russian citizens.

The Singapore Group Report recommends that the scope of the Patents Act be limited so as to exclude PCT applications filed overseas and entering national phase in Singapore, since the Registrar would not have the ability to prevent the publication of such applications outside of Singapore in any event.

The Swedish Group believes that it would simplify matters if the decisive criteria for when/where to file a secrecy review would relate only to the applicant instead of also including where the invention was made and suggests that the domicile of the applicant could be made the decisive criterion.

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

The Belgian Group Report raises the question of whether the system of first filing requirements and secrecy review at national level is not outdated. It suggests that the defense of the territory and the national security can be ensured through other means. The Report further notes that if this system is not abolished, it should at least be harmonized at international level. Competing first filing requirements should be avoided, as well as competing secrecy reviews. The secrecy review could be performed by a central administration common to several countries (for example, NATO). Foreign filing licenses should be available in any case.

The Chinese Group Report recommends to reduce the current time periods of 4 months for an initial secrecy notification (in response to a request for security review) and 6 months for a final notification to, for example, 2 and 4 months, respectively.

The Egyptian Group Report notes that, generally, the IP Law can be amended to provide definitions for inventorship and joint inventorship as this will facilitate filing of patent applications whether or not having multinational inventorship.

The Report from the Estonian Group suggests that in the case of applications that are not required to be first filed in a certain country and do not require a secrecy review, the law of the country of domicile of the inventor should apply with respect to inventorship.

The Israeli Group Report notes several areas for potential improvement:

In addition to creating a mechanism for reconciling contradictory first filing requirements, there should also be a mechanism designated to determine which law would apply to the application at hand. For example, if an invention is filed in Israel by two inventors, one from Israel and one from Country X, and say the term of “inventorship” is defined differently in the two countries (for example, under Israeli law, both parties are co-inventors, whereas in Country X’s law, only the Country X inventor is an inventor), then the questions that arise are: Which law do we apply? What would be the criteria in applying such law? We believe that the law governing multinational inventions should be the law of the country in which it was conceived and in cases where the place of conception is not clear, inventorship should be determined based on the law of the country in which the first priority application was filed.

As mentioned above, there is no time period for filing a motion to mention an inventor’s name. Other sections of the Patents Act provide that the statute of limitation does not apply to, for example, filing a motion to revoke or amend a Patent Term Extension order (Section 64(11)). We believe the same rule should apply with respect to filing a motion to mention an inventor’s name.

The Japanese Group Report points out the need for understanding of inventorship issues in other jurisdictions, and also considers multinational inventions in the context of secret prior art:

Raising awareness of the erroneous finding of inventorship

- *Awareness of the problem of the erroneous finding of inventorship seems to be low in Japan. For example, attendees to an application review meeting are sometimes selected as inventors without careful consideration. Awareness-raising is desired to improve these situations from the perspective of filing of applications having multinational inventorship. As one of the means therefor, it is considered to be worth considering, for example, putting a definition of inventorship in the statutory form.*

Unification of standards for Secret Prior Art

- *Some countries have laws providing that a patent application shall be refused based on Secret Prior Art, and some other countries also have laws providing that even in such cases, a patent application shall exceptionally not be refused if the inventors of the Secret Prior Art and of the patent application are the same. The standards for the application of exceptions differ among countries. With regard to joint applications, it is required in Japan that all of the inventors of an earlier application and those of a latter application are entirely the same.*
- *A multinational invention is basically considered to be a joint invention made by multiple persons. In order to facilitate filing of applications for joint inventions (multinational inventions), it is a good idea to unify relevant provisions to the provision to the effect that a patent application shall not be refused based on Secret Prior Art if some of the inventors of the latter application are the same as those of the Secret Prior Art.*

The Report from the Philippines Group suggests that the IP Code be amended to define the term, “inventor,” and suggests that the most stringent test for inventorship be established in order to avoid penalties arising from the incorrect identification of inventors.

The Singapore Group Report recommends clarifying the law as it relates to “residents” of Singapore:

Scope of Section 34(1)

This section provides that “no person resident in Singapore” shall cause a first filing of an application overseas without obtaining a Foreign Filing Licence. It is not clear whether

this section only applies to persons resident in Singapore at any time during the period of the invention or only at the time of the proposed first filing overseas. It is proposed that this Section be amended such that it only applies to persons resident in Singapore at the time of the proposed first filing overseas. This will ensure that the Singapore Patents Act does not apply to persons outside the jurisdiction of Singapore, and any foreign inventor/applicant who ceases to be resident in Singapore would only be governed by the laws in the country where he is resident.

Section 34(2)

The requirement for a Foreign Filing Licence should be limited to cases where there are Resident Inventors. It clearly does not apply to patent applications where all the inventors are Non-Resident Inventors.

In the case where there are both Resident and Non-resident Inventors, the requirement to obtain a Foreign Filing Licence should still be applicable. As mentioned above, Section 34(2) which allows a Non-Resident Inventor to file overseas without a Foreign Filing Licence introduces uncertainty, especially where there are both Resident and Non-Resident Inventors. Hence, the scope of Section 34(1) and (2) should be clarified as to the obligations of the Resident Inventor when the Non-Resident Inventor first files overseas. The issue is whether the Resident Inventor could be considered to have caused the Non-Resident Inventor to first file the application overseas, and therefore be liable to punishment.

The Report from Sri Lanka suggests that consequences of a mistake in an application form for the grant of a patent in regard to inventorship (whether the error is on the face of the form or a substantive error) should be clarified.

The U.K. Group Report suggests that secrecy and first filing rules should apply only to U.K. patent applications originating entirely from within the U.K., and should not apply to multinational inventions:

We consider it somewhat illogical to apply penalties based on the country of filing of patent applications for multinational inventions. If they are multinational inventions the invention will have necessarily already left the country and be known abroad before any patent applications are filed anywhere. Separate laws (perhaps related to national security) seem the appropriate place to control the dissemination of information which a government considers might be prejudicial to the national interest. Using patent filing laws would not correct the dissemination outside the UK which has already happened.

It seems unavoidable that UK law includes some provision for a secrecy review of UK patent applications originating entirely from within the UK (i.e. not multinational inventions). This provides a mechanism for controlling publication or dissemination of information which could be prejudicial to national security. In addition, it seems unavoidable that this secrecy review should be obligatory for inventions made by inventors with a strong connection to the UK (such as residents or nationals). If there were no such restriction then foreign patent applications could be freely filed and become public, to the possible detriment of UK national security.

For these reasons, it is not believed that the secrecy provisions of UK law could be significantly improved to address multinational inventions. The fact that UK's secrecy provisions are triggered only by a narrow range of subject matter makes the system manageable. We suspect that those working in the relevant narrowly defined fields in the UK are well aware of their obligations and may have other secrecy obligations unrelated to patent law. In this regard, it is welcome that the UK provides a publically available list regarding the types of subject matter that might be considered to be relevant to national security.

The remaining 31 Group Reports either indicated that no further proposals were envisioned, or did not comment in response to this question.

III. Proposals for harmonisation

12) Is harmonisation in this area desirable?

All but three of the Reports (Bulgaria, Indonesia, and Uruguay) indicate that harmonization in this area is desirable. The general need for harmonisation in the international context is explained, for example, by the Australian Group Report:

Given the proliferation of inventions which are worked on in many countries at once, and the encouragement of collaboration internationally as a key factor in technical innovation, it is not rational to have widely disparate rules on inventorship, or national requirements for first filing in the case of international co-inventorship. More specifically, in a modern, Internet connected world where an invention may be readily developed by an international team, laws that possibly made sense in a paper and mail based world have become irrelevant to the dissemination of information. An international team means that the information has already left the control of a single nation. It is important that the invention and filing regimes in each country adapt to the reality of international collaborative teams.

Similar comments were raised by the Austrian, French, Greek, Italian, New Zealand, Paraguay, Philippines, and U.K. Groups. The German Group Report addresses the need for harmonisation from the perspective of determination of inventorship and first filing / secrecy provisions:

Presently, the question of who is recognised as an inventor of a particular invention may be answered differently in different jurisdictions. In particular, many jurisdictions define "inventorship" or "involvement in an invention" in Case Law with more or less ambiguous instructions to the industry. Considering the increasingly involved multinational teams working on product developments, problems do exist with regard to the actual decision on legally relevant contribution of persons to the inventions. That question is often finally decided by the persons of the team themselves without having a clear understanding of the different (national) requirements. As that decision has different effects on the question of "actual" ownership of patents or patent applications directed to the same invention between the counterparts being subject to different jurisdictions, harmonisation is highly desirable.

Harmonisation is even more mandated with respect to first filing and secrecy review requirements, which in extreme cases may lead to the result that no patent application can be filed in any jurisdiction without violating criminal law in one of the jurisdictions where the inventors are domiciled or of which the inventors are nationals. Due to the existing differences, applicants or their agents are oftentimes not aware of the requirements existing in foreign jurisdictions, which may lead to loss of rights in these jurisdictions, or even criminal sanctions.

The Israeli Group Report stresses the need for harmonisation of the rules governing choice of applicable inventorship law, but does not see a pressing need for harmonisation of substantive inventorship law. Conversely, the Japanese Group Report stresses the need for international harmonisation of the definition of inventorship, to avoid cost or loss of rights due to an error in stated inventorship under a certain country's laws. The Japanese Group Report also suggests that harmonisation should be further achieved in relation to whether determination of inventorship is made on a claim by claim basis or based on the content of the entire disclosure.

13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

34 Reports provided proposed definitions of inventorship. Although this reflects a strong consensus that a harmonized definition is desirable, and while there are strong themes relating to contribution, creative involvement, and conception, there is substantial diversity in the actual language of the proposed definitions. The numbers in parenthesis indicate the number of Reports supporting this or substantially similar language.

- Made or contributed to the invention (2)
- Substantial contribution to the invention (1)
- Substantial contribution to the conception and/or production of the subject matter of at least one claim covering the invention (1)
- Creative technical contribution to the invention (1)
- Creative and substantial contribution to the invention (2)
- Substantial engagement in the creative process of the invention (1)
- Active contribution in development of the inventive concept (1)
- Joint creative activity (1)
- Participation in (or contributes to) the conception of the invention (3)
- Conceived and reduced to practice the invention (1)
- Conceived and/or reduced to practice the invention (2)
- Contribution to the inventive or creative essence of the invention (1)
- Contributed directly and effectively to creation of the invention (1)
- Contributes in a non-frivolous manner to the construction / creation of a patentable invention (1)
- Significant contribution to the formulation of the inventive concept (1)
- Significant intellectual contribution to one or more features of the invention, where such features: 1. are contained in a written disclosure as a whole and, in the case of a granted patent, also defined in at least one of the patent claims; and 2. Distinguish the invention from the relevant prior art in a manner that makes it novel and non-obvious (1)
- Independent, intellectual contribution to the invention (3)
- Contributes to the creative concept underlying the invention (1)
- Conceived or contributed to conception of the underlying concept of the invention (2)
- Effective contribution in the work leading to the inventorship (1)
- Creator, conceiver, and/or originator of any or all patentable elements of the invention (1)
- Created invention as a result of his/her inventing activities (2)
- Contributes any part of his/her ingenuity, skill, or technical knowledge to the invention (1)
- Devises, creates, or conceives an innovating solution to a technical problem (1)
- involvement in the development of the teaching by contributing an achievement which exceeds the ordinary skill of the person skilled in the art, which has substantial influences on the overall success of the inventive achievement, and which is made at least partly on own initiative (1)

A common theme throughout is that most reports talk about inventors being those who contribute in some way to the conception of the invention. Of these proposed definitions, seven Reports propose that inventorship be determined based upon the invention as defined in the claims. The remaining reports support an entire disclosure support or are silent on this issue.

The French Group Report suggests, with regard to the choice of inventorship law issue, that the law applicable to the determination of inventorship should be the law of the contract under which the inventor contributes to the invention. The Sri Lankan Group suggests that, in lieu of an international standard of inventorship, granted patents should not be set aside or invalidated due to errors or omissions in the listed inventorship. The Polish and Italian Group Reports indicate that an international standard for definition of inventorship is not necessary.

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

38 Reports proposed standards for correction of inventorship, 100% of which support availability of correction. However, there is wide diversity as to many details of the standard. The number in parenthesis indicates the number of Reports that supported the listed aspect of a potential standard.

- Voluntary, liberal pre-grant standard (8)
- Discretionary after grant (1)
- Consent of affected inventors (4)
- Consent of all inventors (9)
- Consent of applicant / owner (4)
- Unintentional error only 3
- Intentional error only (post grant) (1)
- Intent not relevant (6)
- Patent office proceeding post-grant (2)
- Court proceeding post-grant (2)
- No time limit (18)
- 1 year from grant date (1)
- 2-3 years from grant date (1)

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

Of the 36 Reports that answered this question, a significant majority of 26 Reports indicate a belief that first filing requirements are outdated and no longer necessary, particularly in the context of multinational inventions.

The Australian Group Report, while expressing a preference for no first filing requirements, proposes as a compromise limiting first filing requirements to specific areas of technology that would be prescribed by each country. The Spanish Group Report, while also expressing a preference for no first filing requirements, proposes the following detailed standard:

The Spanish Group understands that there may be specific circumstances (for example, when an invention may affect national, regional or international security) where measures

aimed at preventing the general disclosure of an invention may be justified. To address these situations, the Spanish Group proposes the following standard:

1. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, and according to the law of a party to such treaty the patent application should be filed first in that country, the patent applicant should also be allowed to file its patent application first before any of the countries which are a party to such treaty, provided that the parties to such treaty comprise the country where the invention was made.
2. Subject to paragraph 1, for the purpose of determining whether a country is allowed to require that a patent application for an invention be filed first in that country, the following principles should apply:
 - a. A country may require that a patent application for an invention be filed first in that country if the invention has been made in that country, regardless of the permanent residence of the inventors.
 - b. Where the invention has been the result of activities carried out in more than one country:
 - i. A country may require that a patent application for an invention be filed first in that country if said country is the country where the most substantial intellectual contribution to the invention has been made.
 - ii. In the absence of evidence to the contrary, it will be presumed that the country where the most substantial intellectual contribution to the invention has been made is the country where the invention was conceived (i.e. the country where the original idea for the invention was proposed). However, where inventors other than the inventors who conceived the invention carried out activities that solved problems not identified by the former, and/or that they could not solve, and solving such problems was necessary to put the invention into practice, the country where the most substantial intellectual contribution to the invention has been made will be presumed to be the country where the activities that solved such problems were carried out.
3. If a country establishes penalties for applicants who fail to comply with First Filing Requirements, such penalties should only apply if the invention concerned is directly related to national defence, and according to the corresponding national authorities, the patent should have been prosecuted in secrecy. Any penalties should be reasonable and commensurate to penalties established for failing to comply with other similar administrative requirements. In particular, such penalties should not include the loss of the rights deriving from the patent application.

The Austrian Group Report, which also expresses a preference for no first filing requirements, submits an alternate proposal where international applications would be considered as valid (single) first filing in all requiring countries. The Belgian Group Report, again expressing a preference for no first filing requirements, suggests an alternative where any such requirements are harmonised on the international level and are based exclusively on the nationality or registered office of the applicant.

The French Group Report proposes a standard under which choice of law relating to first filing would be harmonised, and free choice of country of first filing, based on applicable law, would be available for inventions related to unrestricted technologies. Inventions relating to technology such as military items or dual use technologies would still be regulated by different, potentially conflicting, national requirements.

The Indonesian Group Report proposes a standard whereby, in the case of multinational inventions, the first filing could be made in any country agreed by the multinational inventors. The Israeli Group Report raises the possibility of obtaining a “pre-ruling” accepted by all relevant countries in the case of a conflict of first filing requirements. The Italian Group Report suggests that foreign filing licenses should always be available. The Dutch Group Report proposes that NATO member states should allow filing in every member state.

The Paraguay Group Report suggests that the requirement for first filing must be required if the invention is intended to be used in the country in where the invention was made and regardless of the nationality or domicile of the inventor(s). The Philippines Group Report suggests that the country of first filing should be left entirely to the discretion of the parties involved.

The Polish Group Report, while noting that an international standard for first filing requirements would be desirable for multinational inventors/applicants, believes such a standard would be extremely difficult given the national security implications. The Singapore Group Report suggests that the first filing requirement should apply irrespective of the technologies involved and should apply in all cases where there is a resident inventor. The US Group Report proposes a joint filing mechanism among or between involved countries:

For applications involving multinational inventions i.e., involving conflicting first filing requirements of two or more countries and which do not come under the umbrella of technology for which the secrecy review seeks to prevent the filing thereof abroad (e.g., technology that includes national secrets or impacts national security), the involved countries shall allow filing in either country as the first filing through a joint filing mechanism wherein a filing in either country which identifies the countries in which first filing for such application is required is deemed to be filed in each affected country on the same day and considered as having been filed first in the respective country.

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

Of the 36 Reports that responded to this question, 14 Groups indicate a preference for no secrecy review requirements, 9 Groups propose a standard that would provide for security review of national security-related technologies only (two of which propose a non-mandatory self-assessment system), and 9 Groups indicate that national laws should control and a harmonized international standard is not appropriate. The Israeli and Dutch Group Reports repeat their proposals from question 15 above. The Italian Group proposes its national standard. The Chinese Group Report provides a detailed proposal, based on its national law:

In our opinion, in order to provide the government with an opportunity to review the subject matter and ensure that certain categories of information are not transmitted outside the country, secrecy review is required before any patent application claiming an invention made domestically is filed abroad.

Similar with the modes used in China, there could be three modes to complete the procedure of international standard for secrecy review:

- (1) *If the applicant intends to first file the application in a foreign country without a domestic filing first, a request for secrecy review shall be filed in advance with its Intellectual Property Office (IPO). IPO will conduct the secrecy review, and issue a notification to the applicant promptly where the application is possibly to be handled as a secret. If the application passes the secrecy review, then this application should be free to be filed abroad.*

Under this mode of requesting secrecy review, a description for the technical solution of the invention must be submitted together with the request for secrecy review.

- (2) *If the applicant intends to second file the application in a foreign country after a domestic first filing, a request for secrecy review is still required before it can be filed in a foreign country. The behavior of first filing the patent application domestically does not meet formality requirement of filing a request for secrecy review. That is, a separate request for secrecy review needs to be filed along with or after the filing of the domestic application.*

Under this mode of requesting secrecy review, since a domestic application was filed in advance, no additional description for the invention is needed.

- (3) *If the applicant files the application as a PCT application with an IPO as the Receiving Office, a request for secrecy review is deemed as being simultaneously filed, that is, no separate request for secrecy review is needed to be filed.*

- 17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Of the 35 Reports that responded to this question, 15 Reports indicate a preference for no foreign filing license requirements, eight Reports indicate that an international standard for obtaining a foreign filing license would not be appropriate and national laws should apply, and four Reports suggest that foreign filing licenses be limited to national security-related technologies only. The Belgian and Singapore Group Reports suggest that, if there are foreign filing license requirements, then it should be agreed that filing a request for a foreign filing license in one country is not a violation of first filing or disclosure laws of another.

The Chinese Group Report and the Israeli Group Report make reference to their proposals reproduced above. The Italian Group Report proposes the Italian standard for obtaining a foreign filing license. The Dutch Group Report suggests that foreign filing licenses be required outside of NATO member countries only.

The Japanese Group Report, while expressing a preference for no foreign filing license requirements, proposes the following standard:

- *It is preferable that there is no foreign filing license system. The following international standard is desirable if a foreign filing license system is necessary.*
- *Applications that require a foreign filing license are limited to applications in the same areas as the areas to which first filing requirements apply.*
- *A clear standard for the subject of application (limited to enumerated subjects) is necessary.*
- *The international standard provides that a ruling granting a foreign filing license shall be deemed to have been issued unless a ruling refusing the grant of a foreign filing license is issued within the prescribed period.*
- *It is made possible to file a request for a foreign filing license before filing an application in a country in which said request is filed.*
- *The content of an international standard (for a secrecy review) to obtain a foreign filing license is as stated in the answer to Q16. However, if an applicant is entrusted with selection of cases subject to first filing requirements, he/she is expected to fulfill the requirements by having a secrecy review conducted on the cases "that may become subject to the requirements," which are peripheral to the cases considered to be subject to the requirements, through first filing in order to avoid the situation where the applicant is subsequently considered to have failed to fulfill the requirements (situation stated in*

Q18). *Some of such peripheral cases are considered to be based on the premise of a foreign filing. Therefore, it is desirable that a time limit, such as half a year after a first filing, is set (clearly stipulated) in relation to a notice of a ruling concerning the grant of a foreign filing license and that there is a standard that a foreign filing license is deemed to have been granted unless such a notice is issued within the time limit.*

The Polish Group Report suggests that while each country should be free to establish their own conditions, countries having first filing requirements should be obliged to ensure that a foreign filing license may be obtained under reasonable conditions.

The Spanish Group Report proposes the following standard:

- *Countries should introduce procedures allowing patent owners to obtain a Foreign Filing License.*
- *Like all Rules on Multinational Inventions, Rules for obtaining a Foreign Filing License should be prepared and applied in an impartial, transparent, predictable, consistent, fair and neutral manner.*
- *If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, and according to the law of a party to such treaty the patent application should be filed first in that country, that country should accept granting a foreign filing license allowing the patent applicant to file its patent application first before any of the countries which are party to such treaty, provided that the parties to such treaty comprise the country where the invention was made.*
- *Procedures for obtaining a Foreign Filing License should comply with the principles of the TRIPS Agreement. In particular, they should be fair and equitable. They should not be unnecessarily complicated or costly, or entail unreasonable time limits or unjustified delays. Parties should have an opportunity for review by a judicial authority of final administrative decisions relating to Foreign Filing License*

- 18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Of the 43 Reports that responded to this question, 9 Reports indicate that an inadvertent failure to comply should be curable retroactively, although these reports disagree as to whether this cure is applicable to national security-related technologies. For example, the Philippines Group Report proposes the following standard:

- *Inadvertent failure to comply with first filing requirements and security reviews should be amenable to correction by expedient mechanisms. The remedy may be in the form of filing a request for correction/request for secrecy review and payment of the corresponding fee.*
- *However, if the patent involved covers military technology, technology that may compromise national security, or technology that may prejudice public safety, non-compliance with the security review requirement should result in the loss of right over the patent.*

Eight Reports indicate that there should be no such ability to cure, because the underlying first filing and security review requirements should not exist. Seven Reports suggest that a standard is not appropriate in this area. The Chinese and Greek Group Reports argue that a retroactive cure should not be allowed at all, while the German Group Report suggests that a retroactive cure is not appropriate for filing or disclosure errors relating to national security-related technologies. In contrast, the Austrian Group Report suggests that full reestablishment of rights should be available.

The Group Reports from Denmark and Poland note that the availability of any cure should depend on whether publication has occurred. The Indonesian Group Report proposes that while failure to comply with a first filing requirement may be cured by filing appropriate documents and a fee, failure to comply with secrecy requirements may result in a loss of rights. The Italian Group Report proposes the Italian standard.

The Japanese Group Report proposes a standard as follows:

- *It is appropriate to permit the imposition of a disadvantage on the applicant if a failure to comply with a first filing requirement was intentional.*
- *It is desirable that the following standard is set: If an applicant failed to comply with a first filing requirement or a security review requirement due to negligence, the failure is cured or repaired if the applicant files an application again by disclosing the status of applications filed in other countries after taking such procedures as waiver and withdrawal to put the applications filed in other countries into the status that they are not disclosed before they are disclosed.*

The Spanish Group Report suggests the following principles:

- *Countries should allow applicants to obtain a retroactive Foreign Filing License when an applicant has failed to comply with a First Filing Requirement or Security Review Requirement.*
- *Countries may refuse to grant a retroactive Foreign Filing License when it is established that the applicant intentionally failed to comply with a First Filing Requirement and/or Security Review Requirement.*
- *Like all Rules on Multinational Inventions, Rules relating to the rectification of failures to comply with a First Filing Requirement or Security Review Requirement should be prepared and applied in an impartial, transparent, predictable, consistent, fair and neutral manner.*
- *Procedures should comply with the principles of the TRIPS Agreement. In particular, they should be fair and equitable. They should not be unnecessarily complicated or costly, or entail unreasonable time limits or unjustified delays. Parties should have an opportunity for review by a judicial authority of final administrative decisions relating to foreign filing licenses*

- 19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

The Austrian Group suggests that the most relaxed requirements of all countries of residence of the inventors should be applicable.

The Chinese Group suggests that the most important item is the harmonisation of "multinational" to mean the geographical locations where the research is conducted without considering the citizenship of the inventors or the laws under which the employment contracts are signed.

The Finnish Group suggests that in no case should an error in the identification of an inventor, whether intentional or unintentional, be grounds for invalidating a patent.

The Report from Hungary argues that freedom to act is the best solution; namely, that the parties should be free to choose where to file first.

The Japanese Group makes the following proposal regarding the requirements for joint inventorship and secrecy reviews:

- An invention must have been jointly made for the establishment of joint inventorship, and a joint invention must have been jointly made both subjectively and objectively. However, even where part of an invention was subjectively jointly made and another part was independently made, the invention as a whole should be found to be a joint invention if it fulfills certain requirements. In other words, if part of an invention that was jointly made alone is not found to involve an inventive step but can be considered to be a feature of the invention, the invention as a whole should be found to be a joint invention.
- According to one popular theory, a joint invention must have been jointly made both subjectively and objectively. A possible example case is as follows: A and B conducted joint development and invented an automobile that is recognized as being novel and involving an inventive step; and B invented a structure wherein the rearview mirror of said automobile is slightly improved while keeping it secret from A after the end of the joint development or during the joint development, and independently filed a patent application for a structure wherein said rearview mirror is added to said automobile.
- In this case, if said rearview mirror itself has a technical significance based on which it is found to involve an inventive step, there is room for the approval of B's independent patent right. However, if said rearview mirror has no substantial technical value and falls under the scope of being "(substantially) identical" as set forth in Article 29-2 of the Japanese Patent Act, it is unreasonable to approve B's independent patent right in relation to the structure wherein said rearview mirror is added to said automobile, and it is desired that the structure is considered to be a joint invention of A and B. However, according to one popular theory, the invention becomes B's independent invention as there is no subjective relationship between A and B in relation to said rearview mirror.
- Some say that such conclusion is unreasonable and that such an invention should be found to have been jointly made as a "deemed joint invention." However, this theory is not necessarily favored by the majority. As one of the solutions, it is hoped that law will provide that an invention is found to have been jointly made as a "deemed joint invention" despite lack of a subjective relationship between the parties if the part in which the parties have no subjective relationship has no substantial technical value and falls under the scope of being "(substantially) identical" as set forth in Article 29-2 of the Japanese Patent Act.
- Clarifying the scope of application of a secrecy review
- One of the means for avoiding the problem caused by a secrecy review seems to be not conducting multinational research and development in the areas in which inventions subject to a secrecy review are created, on the premise that the concept of a "country" in a multinational relationship refers not to nationality but to the place where an invention is created. If standards for the areas and scope to which a secrecy review applies in all countries with a secrecy review system are made clear, it would be possible to make clear the countries from which one should stay away in multinational research and development or the areas in which there is no problem with conducting multinational research and development, including such countries.

The Mexican Group Report suggests that multinational inventions should not be treated differently nor have special standards for inventors based on their nationality.

The Russian Group Report indicates that multinational inventions should be excluded from first filing and state secret regulations.

The US Group Report makes the following proposal regarding correction of inventorship:

- If an incorrect indication of inventorship is made on a patent application, the consequences of this error vary from country to country. The issued patent may be held to be invalid or unenforceable in some jurisdictions but not in others. The error may be correctable in some countries, but not in others.

- *We would propose:*
- *That a significant and growing part of subject matter protected by intellectual property in today's world is created within the framework of multinational jurisdictions encompassing collaborative research projects having multiple inventors domiciled in multiple countries.*
- *That the existence of considerable differences between national laws concerning how to correct inventorship to intellectual property causes complications and problems for cross border R&D both within multinational enterprises and for cooperation between companies.*
- *That the correction of inventorship in pending patent applications and patent grants should be governed by harmonised rules since it affects their prosecution and their enforcement.*
- *That progress has been made towards establishing a unified approach for the public and stakeholders to access basic patent file information known as the Global Dossier.*
- *That the corrective procedure rules should initially at least provide for correction of inventorship before an administrative agency, generally this will be a national/regional patent office, and that the rules should provide for uniform data fields, at least in part, that allow for an automated process to initiate changes across multiple counterpart patent assets with an ultimate goal to have a centralized automated approach to correct inventorship in multiple jurisdictions in a simple and cost effective way. [Harmonisation in determination of inventorship will make this goal more achievable.]*

The Swiss Group Report suggests that if national requirements relating to questions 15-17 cannot be abolished, a central deposit for filing patent applications could be established to secure a filing date without any breach of national law.

The Spanish Group suggests that the members of the World Trade Organization should, in due course, negotiate an international agreement on "multinational inventions" called "Rules on Multinational Inventions" that could be inspired by some of the standards on which the "Agreement on Rules of Origin" is based. As an alternative, new rules governing "multinational inventions" could be introduced in a future amendment of the TRIPS Agreement, although this option would probably be less preferable, taking into account the foreseeable political difficulties that amending the TRIPS would entail.

The Swedish Group notes that it has discussed a possible abolishment of the requirement of stating the names of the inventors in a patent application in case the stated ground for the applicant's acquisition of the rights to the invention is an employer/employee relationship with the inventor and the applicant represents that the inventor has waived the right to be named as such. This would open the possibility to file patent applications on the result of research made in multinational groups of companies, without having to include the names of the inventors and consequently no detailed assessment of inventorship would have to be made for purpose of those patent filings.

IV. Conclusions

Multinational inventorship

The Group Reports evidence strong support for harmonization of the definition of inventorship. Many Groups indicated support for codifying a definition of inventorship in their patent law to provide additional clarity and guidance. However, while the suggested definitions for inventorship are mostly closely related in substance, they vary significantly in the form of expression. The key terms found in many of the proposed definitions are "substantial" or "effective" participation in or contribution to conception of an invention claimed in a patent or patent application.

Correction of inventorship

The Group Reports strongly support the ability to correct inventorship after the filing date. However, there are differences as to the permitted time delays (the most support being for no time restrictions), differences in pre- versus post-grant procedures, and the effect of an unintentional versus intentional error. Despite these differences, a substantial level of consensus exists as to the fundamental concepts.

First filing requirements

The Group Reports express strong support for abolishment or, at least, simplification of first filing requirements. If first filing requirements cannot be abolished entirely, then there is very strong support for ensuring that the "Catch 22" situation of multinational inventors residing in countries with conflicting first filing requirements is avoided. Abolishment of first filing requirements in favour of technology-limited security reviews to protect national interests may find some traction among the Groups.

Secrecy reviews

Although many Reports would support abolition of secrecy reviews, other Reports note that this is the purview of national laws and an international standard would not be appropriate. A number of comments address making secrecy reviews less burdensome, by limited the technical subject matter required to be submitted for review and by shortening the time allotted for secrecy review.

Cure of violations of first filing and secrecy review requirements

The Reports represent the full range of possible options in responding to this issue, from arguing for the full reestablishment of rights in all cases, to allowing cure for inadvertent violations only, to allowing no cure whatsoever. Some Reports suggest different rules for violations involving national security-related technologies versus unrestricted technologies, and others suggest different rules for violating a first filing requirement versus a security review. Overall, most support is in the middle; seeking a balance between allowing cure for a genuinely inadvertent error and providing appropriate motivation for applicants to comply with national requirements.

Resolution

Question Q244

Inventorship of Multinational Inventions

Background:

- 1) This Resolution concerns the issue of inventorship of inventions where the inventors reside in different countries, have different citizenship, or have employment contracts under different national laws.
- 2) Due to the prevalence of international corporations having geographically distributed research groups, multinational joint venture projects, international corporate/university collaborations, and other cross-border research projects, and further due to the ease of international communications and exchange of data, international joint inventorship is today a common occurrence.
- 3) The Question leading to this Resolution focused on two issues that are important to multinational inventions: determination of inventorship in the context of multinational inventions; and national requirements relating to foreign filings.
- 4) For the purposes of this Resolution, **multinational inventions** means inventions conceived by two or more inventors where different national laws concerning inventorship apply to at least two of the inventors. For example, a first inventor of citizenship X resides in country X and is a co-inventor of a joint invention co-invented by a second inventor of citizenship Y residing in country Y. However, different national laws may apply if they are of the same citizenship, but reside in different countries, or if they reside in the same country, but are of different citizenship or have employment contracts under different national laws.
- 5) Also for the purposes of this Resolution:
 - a. **first filing requirement means** a procedural requirement that a patent application for an invention – be it all inventions or only inventions in certain technology areas – that is made or partially made in a country be filed first in that country before filing in any other country;
 - b. **foreign filing license** means any procedure or mechanism for obtaining an exemption from a first filing requirement; and
 - c. **secrecy review** refers to a substantive review by a governmental authority of the subject matter of a patent application to determine whether it impairs national security or other national interests, or includes subject matter that must be kept secret.
- 6) The definition of who is an “inventor” differs significantly among the various jurisdictions, with some jurisdictions having no established definition. The importance of making a proper determination of inventorship also varies greatly, from being of no importance at all to being a basis for annulling the patent or holding the patent unenforceable.
- 7) National requirements relating to foreign filings vary significantly from jurisdiction to jurisdiction. In some countries a patent application must be first filed in the country where the invention was made. In some countries, a foreign filing license or procedure for requesting secrecy review prior to foreign filing is available. In other countries, there are no requirements

or limitations on foreign filings. Penalties for violation of foreign filing requirements include invalidity of the patent and possible criminal liability.

- 8) Technology export control laws separate from patent filing and secrecy review laws exist to control the export of technology potentially prejudicial to national security and safety.
- 9) As simultaneous compliance with all relevant national laws can be difficult or even impossible, it is highly desirable to have:
 - a. a harmonized definition of inventorship that would be uniformly accepted in the case of multinational inventions; and
 - b. a harmonized process by which multinational inventions could be filed internationally in a manner that complies with legitimate national security interests while avoiding conflicting national foreign filing requirements.
- 10) It is also desirable to adopt international and national provisions which should be aimed at minimizing occurrence of conflict of laws.
- 11) 43 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General of AIPPI and distilled into a Summary Report. The individual Reports and the Summary Report are available on the AIPPI website www.aippi.org. At the AIPPI World Congress in Rio de Janeiro, the subject matter of this Resolution was further discussed within a Working Committee and again in a full Plenary Session, which led to the adoption of the present Resolution by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) A person should be considered a (co-)inventor if they have made an intellectual contribution to the inventive concept. The inventive concept shall be determined on the basis of the entire content of a patent application or patent, including the description, claims and drawings.
- 2) The rule to determine intellectual contribution of an inventor should be consistent regardless of the residency or location of the inventor, their citizenship, the governing law of the employment, or the country in which the intellectual contribution was made.
- 3) Pending a harmonization to this effect, national laws should: (i) take into account provisions whereby the co-inventing parties would elect a single applicable law; and/or (ii) include provisions that would minimize conflict of laws.
- 4) All patent offices should provide administrative mechanisms to record corrections of designation of inventors with respect to a patent application or patent at any time after the filing date.
 - a. Requests for correction of designation of inventors should be allowed if either: (i) all previously named inventors and applicant(s) consent; or (ii) an inventor or applicant/proprietor provides evidence that is prima facie sufficient to establish that the request correctly names all co inventors based on the criteria set out in paragraph 1) above.
 - b. Applicants/proprietors and inventors should not be penalized in cases where the designation of inventors has been corrected. This is without prejudice to any party bringing legal proceedings and obtaining appropriate remedies where its rights are adversely affected by the correction.

- c. In countries where the designation of the inventors only requires a declaration by the applicant, corrections of the designation of inventors should only require a new declaration by the applicant. Mechanisms available to inventors to complain about the original declaration should be available to complain about the correction.
- 5) No country should impose a first filing requirement, require a foreign filing license, or insist on a prior secrecy review. Notwithstanding, if this cannot be achieved, the following principles should be applied:
 - a. If a first filing requirement is nonetheless maintained, such requirement should not apply to inventions of which a co-inventor is resident in, or who is a citizen of, another country.
 - b. A foreign filing license obtained in a jurisdiction should exempt all co-inventors from first filing obligations in, and obtaining foreign filing licenses from, any other country.
 - c. If a secrecy review or first filing requirement is maintained, foreign filing licenses should be made available at a reasonable cost and within a reasonably short time period. If that time period expires with no answer from the competent body, a tacit consent for foreign filings should apply.
 - d. If a secrecy review is maintained, such review should be limited to predefined technical fields in which inventions could affect national security and safety, and sufficient information should be published about such fields to enable inventors to understand whether a secrecy review is required.
 - 6) Governments should have a duty to update secrecy review orders with reasonable frequency. Where the subject matter covered by the secrecy order has become publicly available through a source other than the inventor or applicant, the secrecy order should be lifted.
 - 7) Governments should put in place effective means to protect the legitimate interests of parties that may be adversely affected by the imposition or lifting of a secrecy order.

Links:

- Working Guidelines
<http://aippi.org/wp-content/uploads/committees/244/WG244English.pdf>
- Summary Report
<http://aippi.org/wp-content/uploads/2015/10/SR244English.pdf>
- Group Reports page
<http://aippi.org/event/2015-aippi-world-congress/#group-reports>

Résolution

Question Q244

La Qualité d'Inventeur dans les Inventions Multinationales

Rappelant que:

- 1) Cette Résolution concerne la qualité d'inventeur dans les inventions pour lesquelles les inventeurs résident dans des pays différents, ont des nationalités différentes, ou encore ont des contrats de travail régis par des lois nationales différentes.
- 2) En raison de l'importance des entreprises internationales ayant des centres de recherche répartis dans le monde, des projets multinationaux de joint ventures, des collaborations internationales entre entreprises et/ou universités et autres projets de recherche transfrontaliers, en raison également des facilités de communication et d'échange de données internationaux, les co-inventions internationales sont fréquentes de nos jours.
- 3) La Question ayant conduit à cette Résolution s'est intéressée principalement à deux sujets importants au regard des inventions multinationales : la détermination de la qualité d'inventeur dans le contexte d'inventions multinationales ; et les exigences nationales en matière de dépôt à l'étranger.
- 4) Dans le cadre de cette résolution, les, **inventions multinationales** sont les inventions réalisées par deux ou plusieurs inventeurs pour lesquelles des lois nationales différentes s'appliquent quant à la qualité d'inventeur pour au moins deux inventeurs. Par exemple, un premier inventeur de nationalité X réside dans un pays X et est co-inventeur d'une invention avec un second inventeur de nationalité Y résidant dans un pays Y. Cependant, des lois nationales différentes peuvent s'appliquer également s'ils sont de même nationalité mais résident dans des pays différents, ou s'ils résident dans le même pays, mais ont des nationalités différentes ou des contrats de travail régis par des lois différentes.
- 5) Dans le cadre de cette Résolution :
 - a. L'**obligation de premier dépôt** correspond à l'obligation selon laquelle une demande de brevet pour une invention – quelle qu'elle soit ou dans certains domaines technologiques seulement – qui est réalisée pour tout ou partie dans un pays, doit faire l'objet d'un premier dépôt dans ce pays avant de pouvoir être déposée dans tout autre pays ;
 - b. L'**autorisation de dépôt à l'étranger** correspond à toute procédure ou mécanisme permettant d'obtenir une exemption à l'obligation de premier dépôt ; et
 - c. L'**examen au titre de la mise au secret** renvoie à un examen réalisé par une autorité gouvernementale de l'objet de la demande de brevet afin de déterminer s'il impacte la sécurité nationale ou tout autre intérêt national, ou s'il inclut des éléments devant être maintenus secrets.
- 6) La définition d' « inventeur » diffère largement entre les juridictions, certaines juridictions n'ayant pas de définition précise. L'importance d'une désignation correcte des inventeurs varie également significativement : elle peut être sans conséquence ou au contraire être une cause de nullité d'un brevet ou le rendre inopposable.

- 7) Les exigences nationales en matière de dépôts à l'étranger varient significativement d'une juridiction à l'autre. Dans certains pays une demande de brevet doit d'abord être déposée dans le pays dans lequel l'invention a été réalisée. Dans d'autres pays, une autorisation de dépôt à l'étranger peut être demandée ou une procédure de demande d'examen au titre de la mise au secret existe afin de rendre possible un dépôt à l'étranger. Dans d'autres pays, il n'y a ni exigence ni limitation aux dépôts à l'étranger. Les sanctions en cas de manquement aux dispositions relatives au dépôt à l'étranger peuvent aller jusqu'à l'invalidation du brevet et engagent parfois la responsabilité pénale.
- 8) Des lois régissant l'export de technologies, distinctes des lois régissant le dépôt de brevet et l'examen de mise au secret, existent pour contrôler l'export de technologies pouvant porter atteinte à la sécurité ou à la sûreté nationales.
- 9) La conformité simultanée à des lois nationales différentes pouvant être difficile voire impossible, il est souhaitable d'avoir :
 - a. une définition harmonisée de la qualité d'inventeur qui serait acceptée par tous en cas d'inventions multinationales; et
 - b. un procédé harmonisé permettant de déposer les inventions multinationales n'importe où dans le monde sans enfreindre les intérêts nationaux légitimes et en évitant les conflits dus aux exigences nationales pour les dépôts à l'étranger.
- 10) Il est également souhaitable d'adopter des dispositions nationales et internationales qui viseraient à minimiser l'occurrence des conflits de lois.
- 11) 43 Rapports ont été reçus des Groupes Nationaux et Régionaux de l'AIPPI et de Membres Indépendants détaillant et analysant les législations nationales et régionales en relation avec la présente Résolution. Ces rapports ont été revus par le Rapporteur Général de l'AIPPI et distillés dans un Rapport de Synthèse. Ces Rapports individuels ainsi que le Rapport de Synthèse sont disponibles sur le site de l'AIPPI www.aippi.org. Au Congrès Mondial de l'AIPPI à Rio de Janeiro, le contenu de la présente Résolution a été discuté d'abord au sein de la Commission de Travail et ensuite en Séance Plénière, ce qui a conduit à l'adoption de la présente Résolution par le Comité Exécutif de l'AIPPI.

l'AIPPI adopte la Résolution suivante :

- 1) Une personne devrait être considérée comme (co)inventeur, si elle a eu une contribution intellectuelle au concept inventif. Ce concept inventif devrait être déterminé sur la base du contenu intégral de la demande de brevet, incluant la description, les revendications et les dessins.
- 2) La règle permettant de définir la contribution intellectuelle d'un inventeur devrait être cohérente quels que soient la résidence ou la localisation de l'inventeur, sa nationalité, la loi régissant son contrat de travail, ou le pays dans lequel la contribution intellectuelle a été réalisée.
- 3) Dans l'attente d'une telle harmonisation, les lois nationales devraient (i) prendre en compte les dispositions par lesquelles les parties co-inventrices auraient choisi une loi applicable unique et/ou (ii) inclure des dispositions minimisant les conflits de lois.
- 4) Tous les offices de brevets devraient disposer de mécanismes administratifs pour enregistrer les corrections de désignation d'inventeur d'une demande de brevet ou d'un brevet, et ce à n'importe quel moment après la date de dépôt.

- a. Ces demandes de correction devraient être accordées si (i) tous les inventeurs précédemment cités et le(s) déposant(s) y consentent, ou (ii) si un inventeur ou le déposant/titulaire apporte des éléments de preuve suffisants *prima facie* à établir que cette requête désigne correctement tous les co-inventeurs selon les critères énoncés au paragraphe 1) ci-dessus.
 - b. Le(s) déposant(s)/titulaire(s) et les inventeurs ne devraient pas être pénalisés si la désignation d'inventeur est corrigée et ce, sans préjudice pour toute autre partie dont les droits auraient été affectés par cette correction et qui intenterait une procédure judiciaire et obtiendraient des mesures appropriées.
 - c. Dans les pays pour lesquels la désignation d'inventeur intervient sur simple déclaration du déposant, les corrections de désignation d'inventeur devraient se faire sur simple nouvelle déclaration du déposant. Les procédures disponibles pour les inventeurs pour se plaindre de la déclaration initiale devraient être également disponibles pour se plaindre de cette correction.
- 5) Aucun pays ne devrait imposer d'obligation de premier dépôt, ni exiger d'autorisation de dépôt à l'étranger, ni même imposer un examen préalable pour mise au secret. Nonobstant, si cela ne peut pas être mis en œuvre, les principes suivants devraient être appliqués :
- a. Si l'obligation de premier dépôt est maintenue, cette obligation ne devrait pas s'appliquer pour les inventions ayant un co-inventeur résidant dans un autre pays ou citoyen de cet autre pays.
 - b. Une autorisation de dépôt à l'étranger obtenue dans une juridiction devrait exempter les autres co-inventeurs de leurs obligations de premier dépôt ou d'obtention d'une autorisation de dépôt à l'étranger pour tout autre pays.
 - c. Si un examen pour mise au secret ou une obligation de premier dépôt est maintenu, des autorisations de dépôt à l'étranger devraient pouvoir être obtenues à un coût raisonnable et dans un délai raisonnablement court. À l'issue de ce délai, si aucune réponse n'est apportée par l'autorité compétente, un accord tacite pour des dépôts à l'étranger devrait en résulter.
 - d. Si un examen pour mise au secret est maintenu, cet examen devrait être limité à des domaines techniques prédéfinis pour lesquels les inventions sont susceptibles d'affecter la sécurité ou la sûreté nationales, et une information suffisante devrait être publiée à propos de ces domaines afin de permettre aux inventeurs de déterminer si un examen pour mise au secret est requis.
- 6) Les gouvernements devraient avoir l'obligation de revoir à fréquence raisonnable les décisions de mise au secret. Lorsqu'un sujet soumis à la mise au secret est devenu public du fait d'une source autre que les inventeurs et le déposant, la mise au secret devrait être levée.
- 7) Les gouvernements devraient mettre en place des mesures effectives pour protéger les intérêts légitimes des parties qui pourraient être affectées par la mise au secret ou sa levée.

Links:

- Orientations de travail
<http://aippi.org/wp-content/uploads/committees/244/WG244English.pdf>
- Rapport de synthèse
<http://aippi.org/wp-content/uploads/2015/10/SR244English.pdf>
- Rapports des groupes
http://aippi.org/committee/?committee_type=11&status=Active

Resolution

Frage Q244

Erfindereigenschaft bei multinationalen Erfindungen

Hintergrund:

- 1) Diese Resolution betrifft die Frage der Erfindereigenschaft bei Erfindungen, bei denen die Erfinder ihren Wohnsitz in verschiedenen Ländern haben, unterschiedliche Staatsangehörigkeit haben oder Arbeitsverträge haben, die verschiedenen nationalen Gesetzen unterliegen.
- 2) Aufgrund der weiten Verbreitung internationaler Unternehmen mit geografisch verteilten Forschungsgruppen, multinationaler Joint Venture Projekte, internationaler Kooperationen zwischen Unternehmen und Universitäten und anderer grenzüberschreitender Forschungsprojekte, und weiterhin wegen den vereinfachten Möglichkeiten internationaler Kommunikation und internationalen Datenaustauschs kommen internationale Erfindergemeinschaften heutzutage häufig vor.
- 3) Die Frage, die zu dieser Resolution geführt hat, konzentriert sich auf zwei Themen, die für multinationale Erfindungen wichtig sind: Bestimmung der Erfindereigenschaft im Zusammenhang mit multinationalen Erfindungen und nationale Erfordernisse in Bezug auf Auslandsanmeldungen.
- 4) Im Sinne dieser Resolution sind **multinationale Erfindungen** Erfindungen mit zwei oder mehr Erfindern, bei denen für mindestens zwei der Erfinder unterschiedliche nationale Gesetze in Bezug auf die Erfindereigenschaft anwendbar sind. In einem weitverbreiteten Beispiel hat ein erster Miterfinder mit Staatsangehörigkeit X seinen Wohnsitz in Land X und hat die Erfindung gemeinschaftlich mit dem Staatsangehörigen Y gemacht, der seinen Wohnsitz in Land Y hat. Unterschiedliche nationale Gesetze können auch dann anwendbar sein, wenn sie die gleiche Staatsangehörigkeit besitzen, aber in verschiedenen Ländern ihren Wohnsitz haben, oder wenn sie ihren Wohnsitz im gleichen Land haben, aber unterschiedliche Staatsangehörigkeiten haben oder Arbeitsverträge haben, die den Gesetzen unterschiedlicher Länder unterliegen.
- 5) Weiterhin gilt für die Zwecke dieser Resolution:
 - a. **Erstanmeldungserfordernis** bedeutet ein Verfahrenserfordernis, nach dem eine Patentanmeldung für eine Erfindung – seien es alle Erfindungen oder nur Erfindungen auf bestimmten technischen Gebieten –, die in einem Land gemacht wurde oder teilweise gemacht wurde, in diesem Land einzureichen ist, bevor sie in irgendeinem anderen Land eingereicht wird;
 - b. **Auslandsanmeldegenehmigung** sind alle Verfahren oder Mechanismen zum Erlangen einer Befreiung vom Erstanmeldeerfordernis; und
 - c. **Geheimhaltungsüberprüfung** bezieht sich auf eine materielle Überprüfung des Gegenstands einer Patentanmeldung durch eine Behörde, um zu bestimmen, ob sie die nationale Sicherheit oder andere nationale Interessen berührt, oder einen Gegenstand enthält, der geheim gehalten werden muss.
- 6) Die Definition dessen, wer ein „Erfinder“ ist, unterscheidet sich zwischen den verschiedenen Rechtsordnungen erheblich, wobei es in manchen Rechtsordnungen keine feststehende Definition gibt. Die Bedeutung einer korrekten Bestimmung der Erfindereigenschaft variiert

ebenfalls start, von „überhaupt keine Bedeutung“ bis dahin, dass sie eine Grundlage dafür bildet, das Patent zu widerrufen oder für nicht durchsetzbar zu erklären.

- 7) Nationale Erfordernisse in Bezug auf Auslandsanmeldungen unterscheiden sich stark zwischen den verschiedenen Rechtsordnungen. In manchen Ländern muss eine Patentanmeldung zuerst in dem Land gemacht werden, in dem die Erfindung gemacht wurde. In manchen Ländern ist eine Auslandsanmeldegenehmigung oder ein Verfahren zur Beantragung einer Geheimhaltungsüberprüfung erhältlich. In anderen Ländern gibt es keine Erfordernisse oder Beschränkungen für Auslandsanmeldungen. Sanktionen für die Missachtung von Auslandsanmeldungserfordernissen umfassen die Nichtigkeit des Patents oder eine mögliche strafrechtliche Haftung.
- 8) Getrennt von den Gesetzen über die Anmeldung von Patenten und Geheimhaltungsüberprüfung gibt es Technologieexportkontrollgesetze, um Export von Technologie zu steuern, der möglicherweise für die nationale Sicherheit schädlich ist.
- 9) Da es schwierig bis unmöglich sein kann, alle einschlägigen nationalen Gesetze gleichzeitig einzuhalten, ist Folgendes äußerst wünschenswert:
 - a. eine harmonisierte Definition der Erfindereigenschaft, die im Falle von multinationalen Erfindungen einheitlich akzeptiert wird; und
 - b. ein harmonisiertes Verfahren, durch das multinationale Erfindungen auf eine Weise angemeldet werden könnten, die mit legitimen nationalen Sicherheitsinteressen in Einklang steht, während sich widersprechende nationale Auslandsanmeldungserfordernisse vermieden werden.
- 10) Es ist auch wünschenswert, internationale und nationale Bestimmungen zu erlassen, die darauf gerichtet sein sollten, das Auftreten von Rechtskonflikten zu vermeiden.
- 11) Von den nationalen und regionalen Gruppen der AIPPI wurden 43 Berichte eingesandt, die detaillierte Informationen und Analysen der nationalen und regionalen Rechtsordnungen in Bezug auf diese Resolution liefern. Diese Berichte wurden vom Generalberichterstatter ausgewertet und in einen Zusammenfassenden Bericht destilliert. Diese individuellen Berichte sowie der Zusammenfassende Bericht sind auf der Webseite der AIPPI verfügbar (www.aippi.org). Während des Weltkongresses der AIPPI in Rio de Janeiro wurde der Gegenstand dieser Resolution in einem Arbeitsausschuss und sodann in einer Plenarsitzung näher diskutiert, was zur Annahme der vorliegenden Resolution durch den Geschäftsführenden Ausschuss der AIPPI geführt hat.

AIPPI beschließt:

- 1) Eine Person sollte als (Mit-)Erfinder gelten, wenn sie einen intellektuellen Beitrag zum erfinderischen Konzept gemacht hat. Das erfinderische Konzept soll auf der Grundlage des gesamten Inhalts einer Patentanmeldung oder eines Patents einschließlich Beschreibung, Ansprüchen und Zeichnungen bestimmt werden.
- 2) Die Regel zur Bestimmung des intellektuellen Beitrags eines Erfinders sollte einheitlich sein, unabhängig vom Wohnsitz oder Aufenthaltsort des Erfinders, von seiner Staatsangehörigkeit, dem auf das Arbeitsverhältnis anwendbaren Recht oder dem Land, in dem der intellektuelle Beitrag gemacht wurde.
- 3) Solange eine Harmonisierung diesbezüglich im Gange ist, sollten nationale Gesetze (i) Bestimmungen berücksichtigen, mit denen die Miterfinderparteien ein einziges anwendbares Recht wählen und/oder (ii) Bestimmungen umfassen, die Rechtskonflikte minimieren würden.

- 4) Alle Patentämter sollten Verwaltungsmechanismen bereitstellen, um Berichtigungen der Erfinderbenennung in Bezug auf eine Patentanmeldung oder ein Patent jederzeit nach dem Anmeldedatum einzutragen.
 - a. Anträge auf Berichtigung der Erfinderbenennung sollten genehmigt werden, wenn entweder (i) alle vorher genannten Erfinder und der oder die Anmelder zustimmen, oder (ii) ein Erfinder oder Anmelder/Inhaber Beweise dafür erbringt, die *prima facie* für den Nachweis ausreichen, dass der Antrag alle Miterfinder gemäß den oben in Absatz 1 aufgestellten Kriterien benennt.
 - b. Anmelder/Inhaber und Erfinder sollten in Fällen, in denen die Erfinderbenennung berichtigt wurde, nicht bestraft werden. Davon unberührt bleiben die Rechte einer Partei, die ein Rechtsverfahren wegen Beeinträchtigung ihrer Rechte durch die Berichtigung anstrebt und geeignete Abhilfe erhält.
 - c. In Ländern, in denen die Erfinderbenennung nur eine Erklärung durch den Anmelder benötigt, sollte die Berichtigung der Erfinderbenennung nur eine neue Erklärung durch den Anmelder voraussetzen. Diejenigen Mechanismen, die den Erfindern zur Beschwerde über die ursprüngliche Benennung zur Verfügung stehenden, sollten für die Beschwerde über die Berichtigung zur Verfügung stehen.
- 5) Kein Land sollte ein Erstanmeldungserfordernis auferlegen, eine Auslandsanmeldegenehmigung oder auf eine vorherige Geheimhaltungsüberprüfung verlangen. Ungeachtet dessen sollten, wenn dies nicht erreicht werden kann, die folgenden Prinzipien angewendet werden:
 - a. Wenn ein Erstanmeldungserfordernis dennoch beibehalten wird, sollte ein solches Erfordernis nicht auf Erfindungen anwendbar sein, bei denen ein Miterfinder seinen Wohnsitz in einem anderen Land hat oder ein Staatsangehöriger eines anders Lands ist.
 - b. Eine in einem Staat erlangte Auslandsanmeldegenehmigung sollte alle Miterfinder von Erstanmeldungserfordernissen in einem anderen Land und von der Pflicht, eine Auslandsanmeldegenehmigung von einem andern Land zu erhalten befreien.
 - c. Wenn eine Geheimhaltungsüberprüfung oder ein Erstanmeldungserfordernis beibehalten wird, sollten Auslandsanmeldegenehmigungen zu angemessenen Kosten und innerhalb angemessener kurzer Frist erhältlich sein. Wenn diese Frist ohne Antwort der zuständigen Behörde abläuft, sollte stillschweigende Zustimmung zu Auslandsanmeldungen gelten.
 - d. Wenn eine Geheimhaltungsüberprüfung beibehalten wird, sollte eine solche Überprüfung auf vorbestimmte technische Gebiete beschränkt sein, in denen Erfindungen die nationale Sicherheit berühren könnten, und ausreichende Informationen über solche Gebiete sollten veröffentlicht werden, um es Erfindern zu ermöglichen, zu verstehen, ob eine Geheimhaltungsüberprüfung notwendig ist.
- 6) Staaten sollten die Pflicht haben, Geheimhaltungsüberprüfungsanordnungen in angemessenen Abständen zu aktualisieren. Wenn der von der Geheimhaltungsanordnung betroffene Gegenstand durch eine andere Quelle als den Erfinder oder Anmelder öffentlich zugänglich wurde, sollte die Geheimhaltungsanordnung aufgehoben werden.
- 7) Staaten sollten effektive Mittel bereitstellen, um die legitimen Interessen von Parteien zu schützen, die durch das Verhängen oder die Aufhebung einer Geheimhaltungsanordnung nachteilig betroffen sind.

Links

- Arbeitsrichtlinien
<http://aippi.org/wp-content/uploads/committees/244/WG244English.pdf>
- Zusammenfassender Bericht
<http://aippi.org/wp-content/uploads/2015/10/SR244English.pdf>
- Berichte der Landesgruppen
<http://aippi.org/event/2015-aippi-world-congress/#group-reports>

Resolución

Pregunta Q244

Autoría de la invención de invenciones multinacionales

Antecedentes:

- 1) Esta Resolución hace referencia al problema de la autoría de la invención de las invenciones en las que los inventores residen en distintos países, tienen distinta nacionalidad o tienen contratos de empleo en virtud de distintas leyes nacionales.
- 2) Debido al predominio de empresas internacionales con grupos de investigación distribuidos geográficamente, proyectos multinacionales de empresas conjuntas, colaboraciones internacionales entre empresas y universidades y otros proyectos de investigación transfronterizos, y además debido a la facilidad de las comunicaciones internacionales y el intercambio de datos, la autoría de la invención conjunta internacional es algo habitual en la actualidad.
- 3) La Pregunta que da lugar a esta Resolución se centró en dos asuntos que son importantes para las invenciones multinacionales: la determinación de la autoría de la invención en el contexto de invenciones multinacionales y los requisitos nacionales relativos a las presentaciones en el extranjero.
- 4) A efectos de esta Resolución, “**invenciones multinacionales**” significa invenciones concebidas por dos o más inventores en las que se aplican distintas leyes nacionales sobre la autoría de la invención a por lo menos dos de los inventores. Por ejemplo, un primer inventor de nacionalidad X reside en el país X y es coinventor de una invención conjunta coinventada por un segundo inventor de nacionalidad Y que reside en el país Y. Sin embargo, pueden aplicarse distintas leyes nacionales si ambos son de la misma nacionalidad pero residen en distintos países, o si residen en el mismo país pero son de distinta nacionalidad o tienen contratos de empleo en virtud de distintas leyes nacionales.
- 5) También a efectos de esta Resolución:
 - a. **requisito de primera presentación** significa un requisito procedimental de que una solicitud de patente para una invención –ya se trate de todas las invenciones o sólo invenciones en ciertas áreas tecnológicas– que se realiza o se realiza parcialmente en un país se presente primero en ese país antes de presentarse en cualquier otro país;
 - b. **licencia de presentación en el extranjero** significa cualquier procedimiento o mecanismo para obtener una exención de un requisito de primera presentación; y
 - c. **revisión de secreto** se refiere a una revisión sustancial del objeto de una solicitud de patente por parte de una autoridad gubernamental para determinar si afecta a la seguridad nacional o a otros intereses nacionales, o si incluye un objeto que debe mantenerse en secreto.
- 6) La definición de quién es “inventor” difiere significativamente entre las distintas jurisdicciones, e incluso algunas jurisdicciones no tienen una definición establecida. La importancia de determinar debidamente la autoría de la invención también varía enormemente, desde no tener ninguna importancia en absoluto hasta constituir una base para anular la patente o hacer que la patente sea inejecutable.

- 7) Los requisitos nacionales relativos a las presentaciones en el extranjero varían significativamente de una jurisdicción a otra. En algunos países, una solicitud de patente debe presentarse en primer lugar en el país en el que se llevó a cabo la invención. En algunos países, está disponible una licencia de presentación en el extranjero o un procedimiento para solicitar la revisión de secreto antes de la presentación en el extranjero. En otros países, no hay requisitos o limitaciones sobre presentaciones en el extranjero. Entre las sanciones por violar requisitos de presentación en el extranjero se incluyen la invalidez de la patente y una posible responsabilidad penal.
- 8) Existen leyes de control de exportaciones de tecnología separadas de las leyes de presentación de patentes y revisión de secreto para controlar la exportación de tecnología potencialmente perjudicial para la seguridad nacional.
- 9) Puesto que el cumplimiento simultáneo de todas las leyes nacionales relevantes puede ser difícil o incluso imposible, es muy conveniente contar con:
 - a. una definición armonizada de la autoría de la invención que se aceptara de forma uniforme en caso de invenciones multinacionales; y
 - b. un proceso armonizado por el que las invenciones multinacionales podrían presentarse internacionalmente de un modo que cumpla los intereses legítimos de seguridad nacional al mismo tiempo que se evite entrar en conflicto con los requisitos nacionales de presentación en el extranjero.
- 10) También es recomendable adoptar disposiciones nacionales e internacionales que deberían intentar disminuir la existencia de conflicto de leyes.
- 11) Se recibieron 43 Informes de Grupos Nacionales y Regionales y Miembros Individuales de la AIPPI que proporcionaban información detallada y análisis sobre leyes nacionales y regionales relativas a esta Resolución. Estos Informes fueron revisados por el Relator General de la AIPPI y se condensaron en un Informe Resumen. Los distintos Informes y el Informe Resumen están disponibles en el sitio web de la AIPPI www.aippi.org. En el Congreso Mundial de la AIPPI en Río de Janeiro, el objeto de esta Resolución se siguió debatiendo en una Comisión de Trabajo y de nuevo en una Sesión Plenaria completa, que dio lugar a la adopción de la presente Resolución por parte del Comité Ejecutivo de la AIPPI.

La AIPPI resuelve que:

- 1) Una persona debería ser considerada (co)inventora si ha contribuido de forma intelectual al concepto inventivo. El concepto inventivo se determinará sobre la base de todo el contenido de una solicitud de patente o patente, incluyendo la descripción, las reivindicaciones y los dibujos.
- 2) La norma para determinar la contribución intelectual de un inventor debería ser coherente sin importar la residencia o ubicación del inventor, su nacionalidad, la ley aplicable del empleo o el país en el que se realizó la contribución intelectual.
- 3) A falta de una armonización a este efecto, las leyes nacionales deberían (i) tener en cuenta disposiciones por las que las partes coinventoras elegirían una única ley aplicable; y/o (ii) incluir disposiciones que disminuirían el conflicto de leyes.
- 4) Todas las oficinas de patentes deberían proporcionar mecanismos administrativos para registrar correcciones de la designación de inventores con respecto a una solicitud de patente o una patente en cualquier momento después de la fecha de presentación.

- a. Las solicitudes para corregir la designación de inventores deberían permitirse si (i) todos los inventores y solicitantes previamente designados están de acuerdo o si (ii) un inventor o solicitante/propietario proporciona pruebas *prima facie* suficientes para establecer que la solicitud nombra correctamente a todos los coinventores en función de los criterios establecidos en el párrafo 1 anterior.
 - b. Los solicitantes/propietarios e inventores no deberían ser penalizados en casos en los que la designación de inventores se haya corregido, esto sin perjuicio de que cualquier parte incoe un procedimiento legal y obtenga remedios apropiados cuando sus derechos se vean afectados de forma adversa por la corrección.
 - c. En países en los que la designación de los inventores únicamente requiera una declaración por parte del solicitante, las correcciones de la designación de inventores únicamente deberían requerir una nueva declaración por parte del solicitante. Mecanismos disponibles para que los inventores reclamen sobre la declaración original deberían existir para reclamar sobre la corrección.
- 5) Ningún país debería imponer un requisito de primera presentación, requerir una licencia de presentación en el extranjero ni insistir en una revisión previa de secreto. Sin embargo, si no se puede conseguir lo anterior, deberían aplicarse los siguientes principios:
- a. Si no obstante se mantiene un requisito de primera presentación, dicho requisito no debería aplicarse a invenciones de las que un coinventor es residente en, o es ciudadano de otro país.
 - b. Una licencia de presentación en el extranjero obtenida en una jurisdicción debería eximir a todos los coinventores de las obligaciones de primera presentación en cualquier otro país y de obtener licencias de presentación en el extranjero de cualquier otro país.
 - c. Si se mantiene una revisión de secreto o requisito de primera presentación, las licencias de presentación en el extranjero deberían facilitarse a un coste razonable y en un periodo de tiempo razonablemente breve. Si dicho periodo de tiempo expira sin respuesta por parte del organismo competente, debería aplicarse un consentimiento tácito para las presentaciones en el extranjero.
 - d. Si se mantiene una revisión de secreto, dicha revisión debería limitarse a campos técnicos predefinidos en los que las invenciones podrían afectar a la seguridad nacional, y debería publicarse información suficiente sobre dichos campos para permitir a los inventores entender si se necesita una revisión de secreto.
- 6) Los gobiernos deberían tener el deber de actualizar las órdenes de revisión de secreto con una frecuencia razonable. En caso de que el objeto cubierto por la orden de secreto se haya hecho público mediante una fuente distinta al inventor o solicitante, la orden de secreto debería alzarse.
- 7) Los gobiernos deberían poner en práctica medios eficaces para proteger los intereses legítimos de partes que pudieran verse afectadas de forma adversa por la imposición o alzamiento de una orden de secreto.

Enlaces

- Guías de trabajo („Working Guidelines”)
<http://aippi.org/wp-content/uploads/committees/244/WG244English.pdf>
- Informe de síntesis („Summary Report”)
<http://aippi.org/wp-content/uploads/2015/10/SR244English.pdf>
- Informes de los grupos
<http://aippi.org/event/2015-aippi-world-congress/#group-reports>

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