



## **Standing Committee on Patents Study on Inventor Remuneration**

### **Nature of this Study**

- 1) This study is not being presented for a resolution at the Sydney Congress. However, it will be the subject of a plenary session to debate a possible form of draft position that may then be used to invite comments from GOs and other stakeholders. After consideration of all input, the Standing Committee intends to propose a resolution on inventor remuneration for adoption at the Cancun Congress in 2018.

### **Introduction**

- 2) This study concerns the issue of remuneration for employee inventors for inventions made in the course of their employment. Specifically, this study will consider whether and to what degree employee inventors should be compensated in addition to their normal wages for such inventions.
- 3) In some countries, employer rights to employee inventions are regulated by national laws, whereby an employer can acquire the right to an invention made by an employee in a number of ways. In other countries, there is no such regulation. Some countries have various 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. Where this is required, remuneration may be due upon the happening of particular events, e.g. upon filing the initial application, upon issuance of a patent, upon licensing the patent, or at a number of such points. On the other hand, some countries have no such requirements. This creates a complex compliance obligation for international organizations and an unclear compensation regime for inventors.
- 4) The issue becomes even more complex in the context of multinational inventions, i.e. where joint inventors of an invention reside in different countries. This is an increasingly common situation due to the prevalence of international corporations having geographically distributed R&D groups, multinational joint venture projects, international corporate/university collaborations, and other cross-border research projects.
- 5) For the purposes of this questionnaire, multinational inventions are inventions conceived by two or more inventors where different national laws concerning inventorship apply to the inventions.
- 6) Most member states of the EU have some legal framework governing employer rights to employee inventions, as well as employee inventor rights to economic compensation. In addition, there are special provisions governing employee inventor remuneration for the transfer of rights in the invention to the employer in a number of European countries.

- 7) Beyond Europe, codification in this area is not as common. For example, Australia lacks statutory provisions regulating employer rights to inventions developed by employees. In the US, with the exception of certain categories of federal employees, there is no explicit regulation by federal law. Employers' rights to employee inventions may be regulated by state law, and in general practice, employer rights to employee inventions are relatively extensive. Unlike Australia and the US, in Japan and China, employers' rights to employee inventions are regulated by statute. In addition, employee inventors have a right to seek reasonable remuneration for the transfer of the invention to the employer.
- 8) This questionnaire addresses the issue of compensating employee inventors of multinational inventions. For example, how do companies deal with inventions made by inventors in the US and a country with remuneration laws such as Germany or China? Do companies provide compensation only for their employee inventors in the countries requiring remuneration? How is compensation apportioned? These are current and important issues for multinational inventions, both employee inventors and their employers.

### **Previous work of AIPPI**

- 9) AIPPI has previously studied inventor remuneration in the following contexts.
- 10) In the Resolution on Q40 – “The inventions of employees” (Helsinki, 1967), AIPPI resolved that:
  - a) *Unless otherwise provided by domestic laws or in the absence of an agreement between the parties concerned, the following regime should be applied:*
    - i. *The inventions eligible for protection made by the employees belong to the employer when they have been made with the means or experience of the latter or if connected with his type of activity. The employer shall enjoy the right of protecting the invention, in particular by a patent.*

*Except in the case in which the invention is the result of a task entrusted to the employee, and is already remunerated, the employee shall have the right to request (to obtain) a special remuneration or a recompense which, in the absence of an agreement between the parties, shall be determined by a tribunal or by arbitration. This remuneration or this recompense shall take into account the importance of the invention and the contribution of the employee responsible for it.*
    - ii. The employee shall have the right to be named as the inventor in the patent.
    - iii. The inventions made by an employee which do not fall within the above mentioned cases shall be regarded as 'free' inventions and will be the property of the employee.

11) In Q183 – “Employers’ rights to intellectual property” (Geneva, 2004), AIPPI studied the legal frameworks governing relations between employers and employees in the field of intellectual property rights. This study concluded that, taking into account the diversity of rights, harmonisation could initially relate to the statute of intellectual property rights in technical creations, such as patents; and includes such principles as:

- a) *The respect of the principle of the contractual freedom of the parties;*
- b) *The respect of the principle according to which the employer should profit from the right to use the inventions carried out by the employees within the framework of their contract of employment, and in particular when these inventions are carried out in the execution of an inventive mission, and that whatever the particular mode of the transmission of these rights for the benefit of the employer;*
- c) *The litigation concerning the attribution of the rights in this field should come under the responsibility of the Courts which rule in the field of the patents and if it appears useful to envisage a phase of conciliation, it should not be obligatory;*
- d) *The terms of limitation must be relatively short to avoid creating an uncertainty as for the ownership of the rights;*
- e) *And the starting point of the term of limitation must be also given.*
- f) *Lastly, if it appears justified to envisage compensation particularly for the benefit of the authors of inventions which will be transferred to their employer and who would be additional with the wages that they perceive, the criteria for the evaluation of this additional remuneration must be simple so as to avoid any useless dispute.*

12) In Q244 – “Inventorship of multinational inventions” (Rio de Janeiro, 2015), AIPPI studied inventorship of joint inventions where the inventors reside in different countries. This study evidenced a particular strong support for harmonisation of the definition of inventorship, for the ability to correct inventorship after the filing date, and the abolishment or simplification of first filing requirements. The remuneration of the co-inventors was expressly excluded from the scope of the proposals for harmonization due to the breadth of issues encompassed within inventorship per se. Remuneration for multinational inventions was the subject of a dedicated Panel Session at the AIPPI World Congress in Rio de Janeiro in 2015. From that discussion it was clear that inventor remuneration, particularly in the context of multinational inventions, is a significant problem facing employee inventors and employers alike.

## **National/Regional Group:**

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## **Questions**

### **I. Current law and practice**

- 1) Please describe your Group's current law defining ownership of an invention made by an inventor employee and identify the statute, rule or other authority that establishes this law.

**Note: In the following, the term “invention” shall refer to an invention that is in fact patentable (i.e. novel, inventive and industrially applicable).**

**In Austria, inventions by employees are mainly regulated in patent law itself (“Patentgesetz 1970”), sections 6-19.**

**Employees shall be entitled to the grant of a patent for any invention made by them during their employment unless otherwise provided by contract or if employed under public law.**

**An employee's invention shall be regarded as a service invention if its subject matter falls within the sphere of activity of the enterprise in which the employee is active and if**

- a) either the activity that led to the invention forms part of the official duties of the employee, or**
- b) the incentive for the invention by the employee is based on his activity within the enterprise, or**
- c) the making of the invention was substantially facilitated by using the experiences or re- sources of the enterprise.**

- 2) Does your Group's current law relating to ownership of an invention made by an inventor employee distinguish between types of employees, for instance between academic staff in universities and in for-profit organizations, or whether they are employed "to invent" (e.g., do research)?

**Yes, for public employees (employees of universities are to be regarded as public employees in this respect), no contract between employee and employer is required for the employer in order to be entitled to the grant of a patent on the service invention.**

**In addition, the type of position of the inventor employee at the employer and whether he is employed “to invent” is taken into account when assessing the amount of inventor’s compensation due.**

- 3) If your Group's current law prescribes that employers own inventions made by inventor employees, does your law impose an obligation on employers to offer to employees the right to file a patent application, or entitlement to a patent application already filed, in the event the employer does not pursue patent protection?

**No:**

**Even though the employer has made an agreement with the employee in the matter of an employee's invention, he may renounce his right to the invention wholly or partially at any time. In such a case, the employee may request that the employer's rights to the invention be assigned to him to the extent of the renunciation.**

**However, this is not dependent on whether a patent application has been filed. In fact, the employer is not obligated to file a patent application drawn to the invention at all. Instead, the employer may choose to keep the invention secret (and, optionally, use it internally). Independently of whether a patent application has been filed or not, inventor's compensation may be due as long as the employer has not renounced his rights to the invention (including the right to use it internally).**

- 4) Does your Group's current law provide in any statute or other regulation that an inventor employee is entitled to receive remuneration beyond their salary for an invention made by the inventor owner but owned by the employer? If yes, please briefly describe the entitlement.

**Yes:**

**The employee shall be entitled to a reasonable special compensation for assigning to the employer an invention made by him as well as for granting the right of use in respect of such invention.**

- 5) Under your Group's current law, is there any other basis, e.g. common law principles, upon which an inventor employee may claim a right to remuneration beyond their salary for an invention made by the inventor employee but owned by the employer?

**No**

*If your answer to question 4) or 5) is 'yes', please answer remaining questions 6) to 8). If no, please go to question 9)*

- 6) To what extent do the following factors determine whether an inventor employee is entitled to remuneration?
- a) Nature of employment duties;
  - b) Extent to which the invention is relevant to the business of the employer;
  - c) Use of employer time/facilities/resources in generating the invention; and
  - d) Terms of the employment agreement or collective agreement.

**Neither of the above is determinant to any extent. The inventor employee is entitled to remuneration in any case, as long as the employer has laid claim to the invention.**

- 7) When does any right to remuneration arise? What stage(s) during the process for invention creation through to patenting, commercialisation or licensing trigger any right to remuneration?

**As soon as the employer has laid claim to the invention. In practice, Austrian companies often pay a first lump sum when they have laid claim to the invention and a second lump sum when a patent is granted.**

- 8) Is the amount of remuneration codified or variable? If variable, how is it determined? For example, what circumstances affect the amount of remuneration? If the amount of remuneration is based on revenue related to the patent (e.g., licensing revenue), how is that amount determined? What impact, if any, does the number of co-inventors have on the amount of remuneration to which any one of the inventors is entitled?

**The amount of remuneration is variable.**

**In assessing the compensation, the law requires that special attention shall be paid, depending on the circumstances of the case, to**

- a) the economic importance of the invention to the enterprise;**
- b) any other exploitation of the invention that has possibly occurred in Austria or abroad;**
- c) what portion incentives, experiences, preliminary work or resources of the employer's enterprise or internal instructions have contributed to bringing about the invention.**

**Various approaches, such as license analogy, can be used depending on the situation. The number of co-inventors typically affects the amount of remuneration (as a divisor in the calculation). In practice, the amount of compensation tends to be similar to compensation calculated according to German practice.**

- 9) Does contract law (e.g., company employee contracts requiring assignability of inventions to the company) affect any remuneration payable by an employer to an inventor employee?

**No. While contracts can initially stipulate how much, under which circumstances and when compensation is paid to the employee, compensation remains subject to legal review (i.e. to ensure that it is “a reasonable special compensation” as required by law).**

- 10) Does your Group's current law provide for any entitlement to additional remuneration after an employee inventor has already accepted remuneration for the invention? For example, this could arise where the patent value has increased after any initial remuneration entitlement has been paid, and the inventor employee seeks additional compensation for the increased value arising from the issuance of a patent or later commercialisation.

**Yes. The law provides for as follows:**

**(1) Upon request of one of the parties concerned, the compensation may be altered later on at equitable discretion if there has been a substantial change in the circumstances governing the adequacy of the compensation. In no event shall, however, payments be refunded which the employee has received by virtue of any previous assessment. Nor shall payments already effected by virtue of any previous assessment or having become due, be supplemented later on, unless the compensation consists of a single payment.**

**(2) The employee shall be entitled to an alteration of the compensation also where the invention has been assigned to a third party by the employer, if the proceeds gained by the employer with this assignment are in striking disproportion to the compensation allocated to the employee or if the employer continues to participate in the exploitation of the invention, thereby gaining profits that are in striking disproportion to the compensation allocated to the employee.**

**(3) The request according to (1) or (2) shall be made only after expiration of one year from the latest assessment of the compensation.**

11) If remuneration is based on the contribution each inventor made to the invention, how is that contribution determined and how is the remuneration then calculated?

**The law does not prescribe any particular way of calculation (see also answer to question 8).**

12) Does any right to remuneration under your Group's current law apply to inventors located outside your jurisdiction if the employer is located in your jurisdiction?

**Yes. If the parties chose the employment contract to be governed by Austrian law, the Austrian right to remuneration applies. Otherwise, the contract shall be governed by the law of the country in which or, failing that, from which the employee habitually carries out his work in performance of the contract.**

13) Does any right to remuneration under your Group's current law apply to inventors located in your jurisdiction if the employer is located in another jurisdiction?

**Yes, see answer to question 12 above.**

14) If an employee inventor in your jurisdiction is a co-inventor with one or more inventors outside your jurisdiction, does the number of co-inventors or whether they are entitled to remuneration impact the inventor employee's entitlement to remuneration? Does it matter if the employer is in your jurisdiction or outside your jurisdiction?

**The law does not prescribe any particular way of calculation (see also answer to question 8). Typically, the number of co-inventors will have an impact, independently of whether they are entitled to remuneration as the employee's share of the invention is decisive. Whether the employer is in our jurisdiction does not matter, however.**

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

15) If your Group's current law provides inventor employees with a right to remuneration for their inventions:

a) is the law sufficiently clear as to the circumstances under which the right to remuneration arises?

**Yes.**

b) does the law provide sufficient guidance as to how the remuneration is to be determined?

**Yes, as it seems preferable to keep a flexible approach guided by jurisprudence instead of being codified in law.**

c) are there aspects of your law that could be improved to address remuneration of inventor employees?

**No.**

d) are there any proposed reforms of your law with respect to such remuneration?

**No.**

~~16) If your Group's current law does not presently provide inventor employees with a right to remuneration for their inventions:~~

~~a) Should it do so?~~

~~b) Are there any proposals to introduce such rights? If yes, please describe such proposals.~~

## III. Proposals for harmonization

17) Is harmonization in this area desirable?

**No.**

*If yes, please respond to the following questions without regard to your Group's current law.*

*Even if no, please address the following questions to the extent your Group considers your Group's current law could be improved.*



- 18) Please propose a standard for remuneration for employee inventors that your Group considers would be an appropriate international standard, addressing both the circumstances that give rise to remuneration and to the basis for determining it.
- 19) Please provide a standard that your Group considers would be an appropriate international standard for handling issues where employee inventors are located in different countries and the countries have differing laws relating to the remuneration of inventor employees.

**Each employee should receive a remuneration on the basis of the applicable law.**

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