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Q244

Inventorship of multinational inventions

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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

Please comment:

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

Please comment:

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

Please comment:

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

If yes, what are the requirements and time limits for such correction?:

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

If no please comment:

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.

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

If no please comment:

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

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 Please comment.:
	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 of 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
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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.

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

Considering the above, Austrian law does not pose an 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.