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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 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.

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§ 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

Please comment:

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

Please comment:

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

Please comment:

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

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

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

If no please comment:

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.

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

If yes please answer the following questions::

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

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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

Please comment.:

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.

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Summary

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