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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?

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

Please comment:

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
	Please comment:
	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
	Please comment:
	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
	If yes, what are the requirements and time limits for such correction?:
	For pending patent applications, the Canadian <i>Patent Act</i> authorizes the Commissioner of Patents to amend the named inventors in certain circumstances ^[1] :
	<ul style="list-style-type: none"> • 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

If no please comment:

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.

- 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 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. ^[1] *Public Service Inventions Act, RSC 1985, c P-32, s. 4.*
2. ^[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. ^[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
	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.
	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
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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.

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