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Q244

Inventorship of multinational inventions

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|-------------------------|---------------------|
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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?

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

Please comment:

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

Please comment:

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

Please comment:

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

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

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

If no please comment:

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.

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?

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 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.

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

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| 12) | Is harmonisation in this area desirable? |
| | yes |
| | Please comment.: |
| | 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.

| | |
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| 13) | Please provide a definition of inventorship that you believe would be an appropriate international standard. |
| | <p>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:</p> <p>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.</p> |

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| 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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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 jointly 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 filling 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.