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**Q244**

## **Inventorship of multinational inventions**

**Responsible Reporters: by Sarah MATHESON, Reporter General John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General Yusuke INUI, Ari LAAKKONEN and Ralph NACK Assistants to the Reporter General**

National/Regional Group	Finland
Contributors name(s)	Kim FINNILÄ, Tord LANGENSKIÖLD, Anne-Mari LUMMEVUO, Pamela LÖNNQVIST, Ben RAPINOJA, Virpi TOGNETTY and Marja TOMMILA
e-Mail contact	kim.finnila@berggren.fi
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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?

In Finland there is no specific law defining inventorship. The Finnish Patents Act (PA) and Patents Decree (PD) regulate the identification of the inventor in an application/patent. The Act on the Right in Employee Inventions (EIA) also gives some guidance.

- The PA, Section 1, stipulates as follows: *"Anyone who has, in any field of technology, made an invention which is susceptible of industrial application, or his or her successor in title, is entitled, on application, to a patent and thereby to the exclusive right to exploit the invention commercially, in accordance with this Act."*
- The EIA, Section 1, stipulates as follows: *"The provisions of this Act apply to inventions patentable in Finland and made by a person employed by another, that is, by an employee."*

However, in legal literature and in case law it has been recognized that an inventor is someone who has made the invention or contributed to the invention.

The Act on Inventions of Importance to the Defence of the Country defines expropriation, filing

applications and subsequent acts on such inventions.

The Act on the Right in Employee Inventions and the Act on the Right in University Inventions define the right to inventions and the relationship between a Finnish entity and an inventor.

- Patents Act[<http://www.prh.fi/en/patentit/lainsaadantoa/patenttilaki.html>] (PA - 15.12.1967/550) Section 7a, Patents Decree[<http://www.prh.fi/en/patentit/lainsaadantoa/patenttiasetus.html>] (PD - 26.9.1980/669), Section 2, 31, 36a; identification of the name and address of inventor, employer's address sufficient.
- Act on Inventions of Importance to the Defence of the Country[<http://www.finlex.fi/en/laki/kaannokset/1967/en19670551?search%5Btype%5D=pika&search%5Bpika%5D=Importance%20for%20the%20defence%2A>] (DIA - 15.12.1967/551); Section 1, expropriation of such inventions against reasonable compensation; Section 2, limits on right to foreign applications for inventor living in Finland.
- Act on the Right in Employee Inventions[<http://www.finlex.fi/en/laki/kaannokset/1967/en19670656?search%5Btype%5D=pika&search%5Bpika%5D=EMPLOYEE%20INVENTIONS>] (EIA - 29.12.1967/656); limited to employee of entity in Finland and inventions patentable in Finland; regulates relationship between employer and employee inventor and right in the invention.
- Decree on the Right to Employees' Inventions[<http://www.finlex.fi/en/laki/kaannokset/haku/?search%5Btype%5D=pika&search%5Bpika%5D=Decree+on+the+Right+to+Employees%27+Inventions&submit=Search>] (EID - 10.6.1988/527); mainly regulates the basis for reasonable compensation as given in the corresponding act.
- Act on the Right in University Inventions[<http://www.wipo.int/edocs/lexdocs/laws/en/fin/fin107en.pdf>] (UIA - 19.5.2006/369); limited to persons in service of Finnish universities and inventions patentable in Finland; regulates relationship between university and person in service of university and right in the invention.

In Finland there is also an act and related regulations on Utility Models (product protection for inventions under an inventive step definition lower than that of the PA). According to case-law, legal doctrine and legal literature the regulatory framework for patentable inventions is also applied to inventions falling under the Act on Utility Model Rights[<http://www.prh.fi/en/hyodyllisyysmallit/lainsaadantoa/hyodyllisyysmallilaki.html>] (10.5.1991/800) and Decree on Utility Model Rights[<http://www.prh.fi/en/hyodyllisyysmallit/lainsaadantoa/hyodyllisyysmalliasetus.html>] (5.12.1991/1419).

- The only requirement would be to name person A and/or B as an inventor in the patent application, the underlying presumption being that they would have contributed to the invention. The right to the invention and the relationship of the inventor and the applicant would be defined by the EIA or the UIA. The latter acts have both a substantive (patentability in Finland) and a territorial (Finland) restriction.

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:

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

	no Please comment:
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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:

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?:
	<ul style="list-style-type: none"> <li>• Adding an inventor to the application requires written consent by the inventor(s) already identified in the application. Further, the applicant has to give a statement on the basis of the applicant's right to the invention vis-à-vis the new inventor.</li> <li>• Removing an inventor from the application requires written consent by the inventor in question.</li> <li>• The corrections can be made as long as the application is pending.</li> <li>• In case a patent has been granted to a person other than the person entitled to it, proceedings before the Market Court may only be instituted by the person claiming entitlement to the patent. Such proceedings shall be brought within one year after the entitled person gained knowledge of the grant of the patent and of any other circumstances on which the proceedings are founded. Proceedings may not be instituted more than three years after the grant of the patent where the proprietor of the patent acted in good faith at the time the patent was granted or assigned to him [PA, Section 52(5)].</li> <li>• Where a patent has been granted to a person other than the person entitled to the patent under Section 1 and where proceedings are instituted by that entitled party, the court shall transfer the patent to that party [PA, Section 53(1)]. Section 52(5) applies vis-à-vis the time limits.</li> </ul> <p>Such proceedings may also be brought before the court during the application phase. This is based on legal literature as well as PD Section, 26a stipulating an obligation on the Finnish Patent Office to inform the applicant of any briefs received that may have an effect on the handling of the application.</p> <ul style="list-style-type: none"> <li>• The matter would have to be decided before the Market Court. The handling of the patent application before the Finnish Patent Office would be suspended until the entitlement has been resolved.</li> </ul>

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?
	<ul style="list-style-type: none"> <li>• Question 1: Finnish legislation is based on an assumption of validity of the identification of the inventor.</li> <li>• Question 2: No.</li> <li>• Question 3: An intentional or unintentional error in the identification of an inventor would not influence the patent right as such. A patent may not be declared invalid on the grounds that the patentee was entitled to a specified part of it only [PA Section 52(3)].</li> </ul>

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:

- 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?

- Yes, in the event it relates to the DIA, kindly see below and question 1 above.

- b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

- According to the DIA, Section 1, an invention that has an importance for the defence of the country and the secrecy of which is importance for the defence, can be expropriated by the government after an application for the invention has been filed. An expropriated invention is subject to reasonable compensation by the state.
- Consequently, there is an assumption of some control of filed applications, although this is not codified in any way:
- If it is obvious that the invention mainly has importance for the defence of the country, neither an inventor residing in Finland nor his right holder has the right to file or to give the right to file an application in a foreign country before an application has been filed in Finland and before 6 months have passed since the application was filed in Finland [DIA, Section 2(1)].
- If it is obvious that the invention mainly has importance for the defence of the country, an inventor residing in Finland or his right holder has to file a European patent application or an international (PCT) patent application with the Finnish Patent and Registration Office [DIA, Section 2(2)].

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

- DIA Section 7, stipulates a secrecy obligation with regard to such defence inventions. DIA Section 8 stipulates criminal sanctions with regard to breaking the secrecy obligation following Sections 2 and 7 of the DIA.

## 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?

- Inventorship is not defined by any statute as noted above under the answers to questions 1-5. Consequently, no clear guidance is available in law as such.
- The present situation gives sufficient flexibility. Case-law and company practice provide instructions that can be considered case by case. The Finnish Group thus considers that the present system does not result in any noteworthy issues.

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?
	<ul style="list-style-type: none"> <li>• No. Cf. Question 7 above and questions 10 and 16 below.</li> </ul>

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?
	<ul style="list-style-type: none"> <li>• With regard to Finland the question would relate to inventions important for the defence of the country, whereby the relevant act refers to inventions made by, or <i>contributed to by</i> a resident in Finland (DIA, Section 2). National sovereignty should thus be sufficiently regulated in this respect.</li> </ul>

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.
	<ul style="list-style-type: none"> <li>• No. The Act on the Right in Employee Inventions (EIA) has been in force since 1967 without any greater amendments. This should confirm its adaptability to the development with regard inventive activity also in a more globalized economy as of today.</li> </ul>

### 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.
	<ul style="list-style-type: none"> <li>• An inventor is a natural person who has made or contributed to the invention, as given in a patent application, either alone or together with other co-inventors respectively.</li> </ul>

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).
	<ul style="list-style-type: none"> <li>• Correction of inventorship should be based on a notification to the relevant patent authority during the pendency of the patent application or after grant of the patent, provided that all the parties involved have agreed to the correction of inventorship.</li> <li>• In case of any dispute regarding inventorship, either during the patent application phase or after a patent has been granted, there should be a fast-track dispute resolution mechanism.</li> <li>• Losing a granted patent right should not be the consequence of an error in the identification of an inventor, independent of whether the error is intentional or unintentional.</li> </ul>

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.

- [In the modern globalized economy], any first filing requirements should be viewed as excessively restrictive and undesirable, excluding inventions relating to national security. Any such territorial requirements could even be considered to have a negative and hindering effect upon inventive activity and inventor recognition caused by complexities with regard to the conception of inventions in multinational entities.

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.

- A secrecy review should be restricted to inventions concerning national security.
- The secrecy review procedure should be available before a possible first filing or in connection with a first filing, and should be conducted within a given and reasonably short time.

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

- The process for obtaining a foreign filing license or a certificate of a related secrecy review should be restricted to inventions concerning national security and should be streamlined and fast.

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.

- Such a standard should be related only to inventions related to national security.
- In such cases, and when a failure is inadvertent and noticed during the patent application phase, it should be possible to petition before the relevant patent authority to rectify a right to file and to continue the prosecution in that country.

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.

- An error, whether intentional or unintentional, in the identification of an inventor should not influence the patent right as such. It should not be possible to invalidate a patent based on such an error.

#### Summary

Finnish legislation does not provide a specific law on inventorship. The Patents Act and the Act on the Right in Employee inventions provide stipulations and rights concerning anyone who has made an invention, the latter act relating to an employed person [in Finland].

Correcting an identification of inventorship can be made in an administrative procedure before the Finnish Patent Office, requiring the consent of the inventor(s) in question. In case of a dispute of entitlement proceedings may be instituted before the Market Court. Any such disputes do not render the patent invalid.

The Finnish Group proposes the following standard definition for inventorship: *“An inventor is a natural person who has made or contributed to the invention, as given in a patent application, either alone or together with other co-inventors respectively.”*

Further, the Finnish Group proposes the following standard relating to multinational inventions: *“An error, whether intentional or unintentional, in the identification of an inventor should not influence the patent right as such. It should not be possible to invalidate a patent based on such an error.”*

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

AIPPI