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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?

In French law, there is no legal definition of the inventor.

While the French Intellectual Property Code (CPI) makes reference to “l’inventeur” (the inventor) on a number of occasions when dealing with rights to the patent (Articles L. 611-6 and L. 611-7) or the designation of the inventor on the patent specification (L. 611-9 and

R. 612 (10), it provides no further detail about the criteria by which the concept of inventor is defined.

According to an old and settled doctrine, inventorship is assessed by reference to the means which constitute the invention.

According to Paul Mathélya [translated from the original French]:

*“Whoever conceives and makes the invention has the status of inventor. The invention consists in means capable of achieving a result.*

*Consequently, the inventor is the person who discovers the means. It follows that posing a problem or indicating an objective to be achieved is not inventing, because this is not giving the solution.*

*Accordingly, it has been adjudged that the following do not have the status of inventor:*

- a person who expresses the desire for a result that is to be obtained, while leaving to others the task of finding the means capable of achieving it;*
- the industrialist who, commissioning the creation of a machine, imposes a series of requirements and obligations: specifically, he or she has thus set out the requirements to be met, but has not made an invention.”*

An analysis of the case law, in particular in the area of employee inventions or patent entitlement proceedings, shows that, in various different formulations, this case law is consistent with the above-mentioned legal writing and applies the following criteria:

- it is generally accepted that the designation of a person as an inventor creates a presumption in his or her favour, though this is capable of being rebutted;
- it is regularly noted that the creator must establish that he or she played an active role at the stages of the formalisation, technical development and finalisation of the invention;
- it is stated that a person who claims to be the creator of the invention must establish that he or she contributed to “the inventive step” of the products or devices patented, that is to say that he or she played an essential role in the analysis of the problem to be solved and in the technical solution to be applied to it;
- conversely, it is considered that the following are not sufficient to allow the status of inventor to be claimed:
  - the management and coordination of research works, or even the establishing of the results to be achieved;
- the carrying out of simple tasks of implementation.
- **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?**
- To determine whether A and/or B can be considered to be inventors under French law, it is first necessary to establish the applicable law for determining whether one or more inventors are legitimately designated by a patent application or a patent. French law does not lay down the applicable law for determining inventorship. In the absence of a precise answer in French law as regards the law applicable to the determination of inventorship, the French Group suggests a criterion of a relevant connection in its proposals for reform of the national law and for harmonisation. In view of the foregoing, it is necessary to determine whether a person A, who is located outside of France and who directs the research efforts of a person B who is located in France, could be designated as an inventor, with it being understood that the invention was made in France. If French law is applicable to person A, he or she will be considered to be an inventor if he or she had an active role and did not merely direct and coordinate research works. Person B will be an inventor under French law if he or she made personal efforts which in particular demonstrated an inventive step, but did not merely execute instructions.

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 question here is whether, in order to assess inventorship, it is necessary to refer to all of the patent specification or just to the claims, or alternatively whether the role of the inventor should be determined on a claim by claim basis.

In the decisions, reference is made to the claims of the patent filed, to the "*inventive concepts described in the patent*", or alternatively to the drawings of the patent when diagrams or drawings are also submitted for assessment by the judges ruling on the merits.

In other decisions, reference is additionally made to the claims in particular.

In a decision of the *Tribunal de grande instance* (Regional Court) of Paris of 29 March 2012, the judges ruling on the merits attempted, unusually, to undertake an apportionment of the inventive contribution on a claim by claim basis.

However, in the decisions referred to above, the question of whether, in order to assess inventorship, reference should be made to the entirety of the patent specification or just to the claims, is not specifically posed.

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

no

Please comment:

In French law, there are no legislative or regulatory provisions which define the concept of inventor or which set out the conditions that need to be met in order to claim this status, let alone any indication which would suggest that the nationality of the inventor should be taken into account.

Thus, according to current law and practice, nationality is not *a priori* an element taken into account in determining the right to be considered an inventor.

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:

French law regulates only the question of the rights to the patent, and not the question of the definition of the inventor.

However, certain rules relating to the right to the patent could provide indications as to the law applicable to the determination of the inventors.

Drawing on Article 60 of the European Patent Convention in relation to the right to the patent, and where an international aspect exists, it may be considered that inventorship should be determined in accordance with the same criteria:

- The law of the State in which the employee exercises his principal activity, thus ultimately the place where the invention was made;
- In the alternative, the law of the State in which the employer has the place of business to which the

employee is attached.

However, in the context of multinational inventions involving a number of inventors living or making the invention in different places and who are not within a contractual framework, it is difficult to determine which criterion of connection should be adopted in order to trigger the application of "French law" to the determination of 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?:

It is possible to correct the designation of inventorship subsequent to the filing date of a patent application in France in accordance with the legal framework, procedures and time limits; these depend on the type of patent application filed in France and on the nature of the corrections to be made.

1. *French (national) or European patent applications*

French or European patent applications must include a request for grant, which specifies the family names, given names and full addresses of the inventors (Articles R. 612-3 and R. 612-10 CPI; Article 81 EPC and R. 19(1) EPC). With regard to European patents, if the applicant is not the inventor or is not the sole inventor, this designation must contain a statement indicating the origin of the right to the European patent (Article 81 EPC).

In the absence of any designation of the inventor, the applicant will be sent an invitation to regularise the designation of inventors within a period of sixteen (16) months from the filing of the patent application or, if priority is claimed, from the earliest date of priority from which the patent application benefits (Article R. 612-11 CPI and R. 60(1) EPC).

The French National Institute of Industrial Property (INPI) and the EPO do not verify the accuracy of the designation of the inventor in requests for grant (Article R. 611-15 CPI and R. 19(2) EPC).

If a designation of inventors has been undertaken within the prescribed deadlines, it is still possible to correct it without delay, including after the patent has been granted, by filing a request at the competent Office, mentioning the family names, given names and addresses of the inventors that are to be removed and/or added (Articles R. 611-17 and R. 612-10 CPI; R. 21(1) EPC).

If the request seeks to remove the designation of an inventor, proof of the latter's consent must be provided with the request for the rectification of the designation of inventors (Article R. 611-17 CPI and R. 21(1) EPC). On the other hand, if the request seeks to designate an inventor not mentioned in the request for grant, it does not need to include proof of the latter's consent.

In any event, if the request is presented by a person other than the applicant for or owner of the patent, the consent of one or other of these is required (Article R. 611-17 CPI and R. 21(1) EPC).

1. *PCT application*

The PCT application must include a request specifying the names and addresses of the inventors and the other prescribed data concerning the inventors where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application (Article 4(1)(v), R. 4.1(a)(iv) and R. 4.6(a) PCT).

However, the EPO, acting as a receiving Office, does not require this information to be provided at the stage of the filing of an application (R. 4.1(c)(i) PCT), but it may be provided so as to anticipate the

requirements of other national or regional laws (R. 4.17(i) PCT).

Pursuant to Article 4(4) PCT, failure to indicate in the request the name and other prescribed data concerning the inventor shall have no consequence in France in so far as French national law allows the information relating to the designation of inventors to be regularised after the filing of the patent application.

During the international phase, upon a request presented by the applicant or the receiving Office, the International Bureau shall record changes relating to the designation of inventors within a period of thirty (30) months from the priority date (R. 92*bis* PCT).

Moreover, the applicant may correct the designation of inventors by a notice submitted to the International Bureau of WIPO within a time limit of sixteen (16) months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed (R. 26*ter*(1) PCT). However, in practice, given that the applicant will have available to it the time limit of thirty (30) months provided by Rule 92*bis*, the time limit of sixteen (16) months provided by Rule 26*ter*(1) will not apply.

Following entry into the regional phase (with only entry into the European phase being possible in France), where the designation of the inventor has not yet been made within a period of thirty-one (31) months from the filing of the priority application, the EPO shall invite the applicant to regularise the designation of inventors within a period of two (2) months (R. 163(1) EPC).

After entry into the European phase, the rules applicable to the correction of the designation of inventors for a European application are then applicable.

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?

The possible consequences of an error in the designation of inventor or of the absence of a designation depend on the type of patent application filed in France.

1. *French (national) or European patent applications*

If the absence of the designation of the inventor is not regularised in accordance with the procedures and within the time limits mentioned above (cf. answer to question 4), the patent application will be refused (Article R. 612-45 CPI and R. 60 EPC).

With regard to French patent applications, the applicant cannot be refused the grant of a patent on the basis of an error in the designation of the inventor.

Nor can the applicant's title be cancelled, since errors in the designation of the inventor of any nature whatsoever - whether intentional or unintentional - are not included among the grounds for revocation of patents which are listed exhaustively in Article L. 613-25 of the French Intellectual Property Code. The exhaustive nature of the list of grounds for revocation of patents is an established principle of case law.

The case law has confirmed that the incorrect indication of the inventor is not a ground for the revocation of a patent.

On the other hand, an inventor who should have been designated in this capacity in the patent may seek to hold the patent owner responsible for the error civilly liable on the basis of Article 1382 of the French Civil Code. On that basis, damages have been awarded in particular to compensate the inventor for his or her lost opportunity to profit from such a statement of inventorship vis-à-vis potential

employers.

The case law has also found against the owner of a patent, upholding the existence of a “*violation of the moral right*” of the inventor who should have been designated as such in the patent when that inventor’s entitlement action was nevertheless rejected.

On the other hand, the question of whether the error in the designation of the inventor is of an intentional or unintentional nature is irrelevant in the assessment of the fault which can render its perpetrator civilly liable.

With regard to a European patent application, the incorrect designation of the inventor, whether it be intentional or not, cannot lead to the European patent application being refused.

Nor can it lead to the revocation of the European patent, since it is not included among the grounds of revocation listed in an exhaustive manner in Article 138 of the EPC, unless the incorrect reference also casts doubt on the patent owner’s entitlement (Article 138(e) EPC).

By way of example, an employer files a patent application in respect of an invention referred to as a “*service invention*” (“*invention de mission*”) made by an employee A, wrongly designating as inventor an employee B. This error in the designation of the inventor is not of such a nature as to lead to the revocation of the patent, provided that the employer was entitled to file a patent covering this invention, of which it is the owner, pursuant to Article L. 611-7 of the French Intellectual Property Code. Article 138(e) would therefore be inapplicable in that hypothesis.

Finally, the incorrect designation of the inventor is also not included among the grounds of opposition as set out in Article 100 EPC.

#### 1. PCT application

Pursuant to Article 4(4) PCT, failure to designate the inventor in the request has no consequence in France given that French national law allows the information relating to the designation of inventors to be regularised after the filing of the patent application.

On the other hand, following entry into the regional phase (with only entry into the European phase being possible in France pursuant to Article L. 614-24 CPI), where the designation of inventors has not yet been made within the period of thirty-one (31) months from the filing of the priority application, the EPO invites the applicant to regularise the designation of inventors within a period of two (2) months (R. 163(1) EPC). If the situation is not regularised, the European patent application is refused (R. 163(6) EPC).

The incorrect designation of the inventor, whether it be intentional or not, cannot lead either to the refusal of the international application by the INPI as the receiving Office, or to the revocation of the patent deriving from that application, since this is not mentioned among the grounds of revocation listed exhaustively in Article 138 EPC.

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?

yes

If the answer is yes, please answer the following::

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.

yes

Please comment.:

### **Preliminary Comments**

In French law, non-sensitive inventions, i.e. those whose communication or exploitation are not capable of being prejudicial to the interests of defence or national security, and which are not detrimental to the fundamental interests of the nation, may be the subject of first filings outside of France, except, in the case of a European application or a PCT application, when the applicant has its registered office or domicile in France and is not claiming the priority of a French application, irrespective of the area of technology concerned (Articles L. 614-2 and L. 614-18 of the French Intellectual Property Code).

The two articles L. 614-2 and L. 614-18 of the French Intellectual Property Code are both likewise intended to be applied in the case of joint applicants, provided that one of them meets the conditions imposed.

There is no similar provision for a first filing outside of France.

Specifically, the IP legislative texts do not provide any rules in this regard.

Accordingly, an invention cannot be required to have its first filing in France simply on account of the fact that it incorporates the contributions of a French inventor residing in a foreign country or having his or her domicile in France or working for a company which has its registered office or other offices in France (French subsidiary of a foreign group).

On the other hand, if the slightest doubt exists, it is for the applicant or its representative to ask the *Bureau de la Propriété intellectuelle* (French Intellectual Property Bureau; hereafter "BPI"), an agency of the French Ministry of Defence that is responsible for protecting the secrecy of inventions relevant to national defence, to release it from any potential criminal liability, as is specified by inter-ministerial instruction No. 9062/DN/CAB of 13 February 1973 relating to inventions relevant to national defence.

Essentially, the legal basis of the restrictions on the free disclosure or exploitation of inventions can be found in the French Criminal Code (Articles 410-1, 411-6, 413-9 to 413-12), the French Intellectual Property Code (for French applications: Articles L. 612-8 to L. 612-10; for European applications: Articles L. 614-2 to L. 614-5, for international applications: Articles L. 614-18 to L. 614-20; for penalties: Articles L. 615-13, L. 615-15 and L. 615-16), inter-ministerial instruction No. 9062/DN/CAB of 13 February 1973 and general inter-ministerial instruction on the protection of national defence secrecy No. 1300/SGDN/PSE/SSD of 30 November 2011.

All acts to the detriment of the fundamental interests of the nation, as defined in Articles 410-1, 411-6, 413-9 to 413-12 of the French Criminal Code, are subject to be heavily sanctioned.

Accordingly, for an inventor simply to forward to a foreign country, for a foreign company, the results of study or research activities carried out in France, in such a way as to cause detriment to the fundamental interests of the nation, would expose him or her to the sanctions laid down by the French Criminal Code.

In the case of a patent application which is relevant to defence or, more generally, is to the detriment of the fundamental interests of the nation, and which ought to have remained secret, the applicant and its representative who carry out a first filing in a foreign country or in an international office will likewise fall within the scope of these prohibitions.

Apart from these cases where there is detriment to the defence or the fundamental interests of the nation, a first filing application in a foreign country may be perfectly justified, for example, in the case of a foreign group's research subsidiary which is established in France.

**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.**

The requirement of a first filing in France is not directly linked to the area of technology concerned. It applies to all inventions made in France in the case of European and PCT applications, as long as the applicant has its registered office or domicile in France and is not claiming the priority of a previous filing in France.

However, there exists a list of technologies that are linked with the interests of defence or national security, as mentioned in point 4 of the version of 4 April 2014 of the *"Guide des usages des acteurs de la propriété intellectuelle en matière de sécurité et de défense"* (*"Practice guide for those working in intellectual property in matters of security and defence"*), published by the *Direction Générale de l'Armement* (French Defence Procurement Agency) (April 2014 version).

In the case of work carried out on a cross-border basis by employees of several nationalities, the technical arrangement of 2009, taken in the context of the Lol (*"Letter of Intent"* signed on 6 July 1998 by the ministers of defence of the six main European armaments producers: Germany, Spain, France, Great Britain, Italy and Sweden), regarding the place of first filing provides that, even if the applicant is French or resides in France, if the invention is made by virtue of financing which originates at least in part from one of the other five countries of the Lol, the first filing may take place in that country. The same applies if the invention was made at least in part on the territory of one of those countries. In such a case, the BPI adjudicates and may, where appropriate, lay down the procedures by which the invention is communicated and the filing procedures in the country designated.

The provisions made in the context of the Lol are essentially aimed at patent applications emanating from *"international defence companies"*, but it also appears that they can apply generally to any works undertaken under these circumstances, including those of a civil nature and irrespective of the source of the financing – be it public or private.

In the case of doubt, it is recommended to ask the DGA for a foreign first filing licence.

It is likewise possible to undertake simultaneous filings in the countries in question, alerting the defence authorities of each country.

b) Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.

yes

Please comment.:

In French law, there are no legislative or regulatory provisions relating to *"foreign filing licences"* or to any similar mechanism.

However, there does exist an administrative practice put in place by the *Bureau de la Propriété Intellectuelle* (*"BPI"*), under the auspices of the *Direction Générale de l'Armement* (*"DGA"*) in relation to inventions *"capable of being relevant to national defence"* and/or *"inventions that are sensitive or are presumed to be sensitive"*. This practice is set out in a *"Guide des usages des acteurs de la propriété intellectuelle en matière de sécurité défense"* (*"Practice guide for those working in intellectual property in matters of security and defence"*). This guide is published by the DGA and its most recent version dates from 4 April 2014.

An applicant whose domicile or registered office is located in France cannot file outside of France a

European patent application or PCT application not based on an earlier French priority. On the other hand, it can decide to file a national patent application outside of France.

However, the applicant then runs the risk of acting to the detriment of national defence or national security and of incurring criminal and/or civil liability pursuant to the provisions of the legislation mentioned in the answer to question 6a), by carrying out unauthorised disclosures of information/inventions that are capable of being relevant to national defence and/or are sensitive or presumed to be sensitive.

The filing outside of France of patent applications relating to inventions that are capable of being relevant to national defence and/or are sensitive or presumed to be sensitive must be submitted to the BPI, either to obtain its prior consent or in order to allow it to verify that the invention was made in circumstances where the applicant is French or has its domicile or its registered office in France and where the invention was financed by a country of the "Letter of Intent" or was made at least in part on the territory of one of the countries concerned, in order to permit a first filing in that country.

In practice, the owner of the rights to the invention (or its representative) sends to the BPI (by fax or registered letter) the following information: name and address of the owner of the rights to the invention, name and nationality of the inventors and, optionally, their address and the description of the invention. This description must be complete, but it does not have to follow any particular formalities and, in particular, does not necessarily have to take the form of a patent application with an abstract and claims. It may also be submitted in English (tolerated) and not necessarily in French. In general, the licence is received by fax within 8-10 days.

There is no fee to be paid for requesting and/or obtaining the advance consent of the BPI or for allowing it to verify that the inventions concerned are eligible for a filing in a country of the "Letter of Intent".

c) If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?

yes

Please comment.:

Notwithstanding the lack of specific legal provisions relating to such retroactive licences or authorisations, practical experience tells us that:

- In the event that the invention is not a "sensitive" invention, if the first filing was made in a foreign country without an advance consent and such a consent was necessary, the patent application and the patent resulting from it can continue to exist and licences can be granted. For these same inventions it is likewise possible, with retroactive effect and for the sake of prudence, to request a licence from the Minister responsible for Industrial Property after the first filing in a foreign country has been undertaken.
- On the other hand, in the event that the invention is "sensitive" and that the requirement for filing in France has not been complied with, the situation is very different because there can be no retroactive effect establishing secrecy, given that the application has already been filed at another Office.
- in that case, and if the BPI of the DGA is aware of the invention prior to its disclosure, the DGA generally requires the application to be withdrawn and a further application to be filed in France. This is the case even if the patent application was filed in a country that is a signatory to the Lol. When only part of the content of a patent application is sensitive, the DGA can request that only certain elements of the patent application be withdrawn.
- in the event that the invention should have been kept secret and has been published, the applicant and the inventors will be subject to criminal proceedings. In addition, it would appear that

in specific cases the BPI is asked for retroactive licences, to which it responds. However, the BPI advises against this approach and asks owners of rights to request licences before the act in question (publication, filing outside of France, etc.) becomes effective.

d) How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?

French law does not expressly deal with the case where an invention has been made jointly by an inventor in France and an inventor in another country. Accordingly, the provisions of the French Criminal Code apply to an inventor who is working in France (or is French). The only exception is that if the invention was made in a country that is a party to the agreement known as the "Letter of Intent"(LoI) - namely Germany, Spain, Italy, the United Kingdom and Sweden, in addition to France - or was financed by such a country, a patent application may be filed in that country even if it incorporates the contributions of a French inventor.

e) In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?

yes  
Please comment.:

The fact of filing a request for a foreign filing licence in another country involves a disclosure of the invention to the authorities in that country, and may thus fall within the scope of Article 411-6 of the French Criminal Code if that disclosure is detrimental to the fundamental interests of the nation.

f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?

If a first filing (or a request for a licence) in another country is effectively detrimental to the fundamental interests of the nation, the sanctions can be very severe - i.e. up to 15 years' imprisonment. As acting to the detriment of the fundamental interests of the nation is a crime, this can only arise if the act is committed intentionally.

The act of filing, outside of France, a European patent application or a PCT application of which the applicant (or a joint applicant) is domiciled in France creates exposure to less severe sanctions - a fine of €6000 in all cases and a custodial sentence of up to 5 years if it is detrimental to the interests of national defence (but not to the fundamental interests of the nation, otherwise Art. 410-1 of the French Criminal Code applies). The sanction is incurred only if the violation is intentional.

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?

Preliminary comment

French law requires that a patent application (FR, EP or PCT) filed at the INPI be the subject of an authorisation prior to any disclosure or exploitation (L. 612-9), irrespective of the place where the invention is made. France therefore appears to have adopted the criterion of the place of filing of the patent, and not that of the place where the invention was made.

The applicant has an obligation to keep its invention secret for a period which varies depending on the type of filing (see Table 1 in point b) below). During this period, the patent applications may not be made public and no true copy of the patent application may be issued.

**If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?**

The obligation to obtain an authorisation prior to any disclosure or exploitation applies to any type of invention and does not depend on the area of technology in question.

Moreover, companies authorised by the State to manufacture or trade in military items are obliged, within the period of 8 days after the filing of any patent application involving certain items, to forward to the department responsible the description of the invention that is the subject of the patent (Art. L. 2332-6 of the French Defence Code).

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

According to Articles L. 612-9 and L. 612-10 of the French Intellectual Property Code, the INPI forwards any patent application to the department responsible within 15 days after the filing. When the authorisation is issued, it is notified to the applicant by the minister responsible for industrial property.

The disclosure authorisation is issued by the minister responsible for industrial property, on the advice of the ministry responsible for defence. It becomes effective at the end of a variable period (see Table No. 1 below).

**Table No. 1**

Type of application	First filing	Subsequent filing under the priority of a first filing in France or in a foreign country
French patent application	5 months from the filing date (L. 612-9, para. 3 CPI)	
European patent application	4 months from the filing date (L. 614-4, para. 4 CPI)	14 months from the priority date (L. 614-4, para. 4 CPI)
International application (L.614-22 CPI)	5 months from the filing date (L. 614-20, para. 4 CPI)	13 months from the priority date (L. 614-20, para. 4 CPI)

In the absence of such an authorisation, or at any time, a request for specific authorisation for the purposes of carrying out specific acts of exploitation may be sent directly by the applicant to the

minister responsible for national defence. If he or she grants the requested authorisation, the conditions to which these acts of exploitation are subject are specified. In the absence of any response within two months from the request for authorisation, the request is rejected (Decree No. 2014-1285).

The ministry of defence controls the filings forwarded by INPI. In a very limited number of cases (20 to 40 per year), it extends the prohibition of disclosure or exploitation by an order, at the latest fifteen days before the end of the period defined in Table No. 1.

The extension is made upon the request of the ministry responsible for defence, for a renewable period of one year. It is possible to lodge an appeal before the administrative courts. This extended prohibition may be lifted at any time, subject to the same condition.

The extension of the prohibition ordered then gives a right to compensation for the owner of the patent application, to the extent of the loss suffered.

The prohibitions may be revoked at any time, on the initiative of the ministry of defence, either by the non-renewal of an annual order or by the taking a specific order revoking the prohibitions.

See Art. L. 612-10, R. 612-28 and R.613-42 of the French Intellectual Property Code.

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

Failure to comply with the temporary period of secrecy is punished by provisions included in the French Intellectual Property Code and the French Criminal Code, which may be applied cumulatively.

1. *Penalties laid down in the French Intellectual Property Code* The sanctions are summarised in Table No. 2. **Table No. 2:**

Article of the CPI	Object of the filing of the application	Fine	In the event of prejudice to national defence
L. 615-13	French application	€4500	5 years' imprisonment
L. 615-15	International application	€6000	
L. 615-16	European patent application	€6000	

These penalties are "without prejudice [...] to the more severe penalties laid down in relation to acts detrimental to the security of the State". This term refers to the provisions of the French Criminal Code, which now talks of "detriment to the fundamental interests of the nation".

2. *Penalties laid down in the French Criminal Code*

Two cases should be distinguished:

- the patent application has not yet been the subject of a prohibiting order and is within the temporary prohibition period (see Table No. 1 above).
- the application has been the subject of a prohibiting order: the prohibiting order has the effect of giving the patent application the status of “national defence secret” within the meaning of Article 413-9 of the French Criminal Code. The sanctions are summarised in Table No. 3 below. Given that the applicant is informed of the temporary secrecy obligation by INPI, it should therefore be considered that an applicant who breaches this secrecy obligation does so intentionally. In any case, the sanctions are more severe when the non-compliance occurs after the applicant has been sent a prohibiting order. Finally, the disclosure of a national defence secret often has the effect of causing detriment to the fundamental interests of the nation, which is punished by Articles 411-6 et seq. of the French Criminal Code.

**Table No. 3:**

French Criminal Code	Offence punished	Penalties
Article 413-10 para. 1	It shall be a punishable offence for any person holding such information because of his position or occupation or any permanent or temporary function or mission, in relation to any process, article, document, information, computer network or computerised data or file which is in the nature of a national defence secret, either to destroy, misappropriate, remove or reproduce it, or to give access to it to an unauthorised person or to bring it to the knowledge of the public or of an unauthorised person.	7 years' imprisonment and fine of €100,000 If the applicant has acted recklessly or negligently, punishment reduced to 3 years' imprisonment and fine of €45,000
Article 413-10 para. 2	It shall be a punishable offence for the person holding such information to have permitted access to, to destroy, to misappropriate, to remove, to reproduce or to disclose the process, article, document, information, computer network or computerised data or file referred to in the preceding paragraph.	5 years' imprisonment and fine of €75,000
Article 413-11	It shall be a punishable offence for any person not referred to in Article 413-10 [http://www.legifrance.gouv.fr/affichCodeArticle.do?cidTexte=LEGITEXT000006070719&idArticle=LEGIARTI000006418402&dateTexte=&categorieLien=cid] : 1. to acquire possession, access or obtain knowledge of any process, article, document, information, computer network or computerised data or file which is in the nature of a national defence secret; 2. to destroy, remove or reproduce in any manner whatsoever any such process, article, document, information, computer network or computerised data or file; 3. to bring to the knowledge of the public or of an unauthorised person any such process, article, document, information, computer network or computerised data or file.	5 years' imprisonment and fine of €75,000

## 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?

As discussed in response to question 1, in French law there is no legislative or regulatory provision which defines the concept of inventor. Case law has developed criteria defining this concept over time.

For the purposes of greater legal certainty, the French Group supports adoption of a definition of inventorship based on this interpretation from the case law.

An inventor is a natural person who conceives and/or reduces to practice, alone or with others, an invention. Accordingly, inventorship should be assessed by evaluating, as of the date of the invention, the contribution made to the state of the art known by the inventors on this same invention date.

- 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?

The French Group considers that French law could be improved having regard to inventions that are neither military items nor dual-use items as defined more specifically in Article 1 of Regulation (EC) No 428/2009 of 5 May 2009, that is to say items, including software and technology, which can be used for both civil and military purposes, and which must be the subject of export authorisations.

Accordingly, for inventions which do not fall within either of these two categories, as well as for dual-use technologies which have been the subject of an export authorisation, French law should expressly exempt them from the requirement for first filing in France, including in respect of European applications and PCT applications.

It would no doubt also be necessary to provide a circular from the Minister of Justice (*Garde des Sceaux*) to public prosecutors' offices, or any other appropriate legal text, in order to specify that in those cases the public prosecutors' offices shall not commence proceedings under Articles 410-1, 411-6, and 413-9 to 413-12 of the French Criminal Code.

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?

French law could be improved by making provision for the secrecy procedure for national defence purposes to be limited to priority patent applications filed in France and for it not to extend to French patent applications filed under the priority of a foreign application.

This is because the foreign priority application may be disclosed and/or exploited even before the filing under priority in France. As a consequence, a secrecy procedure in France would place the applicant in a position of legal uncertainty until the authorisation issued by the ministry responsible for industrial property, upon the advice of the ministry responsible for defence, was obtained.

A further possible proposal would be to dispense with the review for national defence purposes of patent applications which relate neither to technologies capable of being incorporated in military items nor to dual-use technologies that have not yet been the subject of an export authorisation.

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

### III. Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Please comment.:

The French Group considers that harmonisation is desirable in order to facilitate the treatment of multinational inventions

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.

The French Group proposes the adoption as an international standard of the definition of inventorship in accordance with the criteria proposed in question 8, i.e. an inventor is a natural person who conceives and/or reduces to practice, alone or with others, an invention. Accordingly, inventorship should be assessed by evaluating, as of the date of the invention, the contribution made to the state of the art known by the inventors on this same invention date.

In addition, with regard to multinational inventions, the French Group proposes the adoption of harmonisation criteria for the purposes of determining the applicable law.

The French Group proposes that the law applicable to the determination of inventorship be that of the contract under which the inventor contributes to the invention.

A distinction should be made depending on whether or not the inventors are employees.

Where the inventor is an employee, the applicable law should therefore be that of his or her contract of employment, which is the contract under which he or she contributes to the invention.

This criterion of connection has the advantage of resulting in the application of one single law for each employee inventor.

To determine the law of the contract of employment, the French Group proposes the adoption on the international level of the criteria proposed by Regulation No 593/2008 (Rome I) of 17 June 2008, according to which the individual employment contract is governed by:

- the law chosen by the parties, with such a choice of law not having the result of depriving the employee of the protection afforded to him by provisions that cannot be derogated from by agreement under the law that, in the absence of choice, would have been applicable (Article 8(1));
- to the extent that the law applicable has not been chosen, the individual employment contract is governed by the law of the country in which or from which the employee habitually carries out his work in performance of the contract (Article 8(2)) or, where the law applicable cannot be determined, by the law of the country where the place of business through which the employee was engaged is situated (Article 8(3)).

In the case of a research contract between several entities involving employee inventors, the French Group recommends:

- specifying in that contract the law applicable to the determination of inventorship;
- signing an amendment to the employment contract of each potential inventor specifying the law applicable to the determination of inventorship in the context of that research,
- with the law applicable to the determination of inventorship preferably being able to be that of the country in which the research activity is centred.

Where the inventor is not an employee, the law applicable to the determination of inventorship could be the law of the contract governing the research, that is to say the contract under which the inventor contributes to the invention.

Absent a contractual clause, the applicable law shall be that of the place of characteristic performance.

In the French Group's view, the place of characteristic performance would be the country in which the invention was conceived and developed, and, in the event of several countries being involved, for each inventor, the country in which he or she made his or her 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).

The French Group is of the view that the rules relating to the correction of the designation of inventors, as they currently exist in France (see above, answer to question 4), are satisfactory.

In any event, the French Group considers that, if an international standard were to be put in place, it would have to allow:

- if there is no designation of inventors at the time of filing of the patent application, the regularisation of the non-designation of inventors within a time limit which is shorter than that for the publication of the patent application, for example sixteen (16) months from the filing of the patent application or, where applicable, from the filing of the corresponding priority application;
- in the event of inventors being designated when the patent application is filed, correction of the designation of inventors (removal or addition of inventors) without any limitation in time and irrespective of the nature of the error in the designation (i.e. regardless of whether or not the error was intentional).

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.

The French Group considers that it is not appropriate to propose an international standard aimed at designating a place of filing of a first patent application when there is no conflict of laws. In this instance, only national law should apply.

On the other hand, the French Group considers that it is appropriate to propose international standards for designating a place of filing of a first patent application in the event of an invention which gives rise to a conflict of laws.

In this case, the criteria such as the place of domicile of the inventor or his or her nationality do not provide a uniform universal response to the question of the place of first filing, and these criteria do not provide increased legal certainty for applicants either.

In this regard, the French Group considers that, for any invention, unless it falls within a category that is subject to prior export authorisation (see below), the governing principle in the case of a research contract or employment contract should be the free choice of the place of filing of a first patent application. Thus, in practice, in most cases, the existence of a research contract or employment contract would allow the parties to decide freely on the question of the place of first filing.

Absent a contractual clause, the law of the country in which the invention was conceived and developed should be chosen and, in the event of a plurality of countries, that of the country in which the research activity is centred.

This principle of free contractual choice or of first filing in accordance with the law of the country in which the invention was developed should be adjusted only with regard to the nature of certain inventions.

Accordingly, inventions relating to a technology which falls within the scope of national regulations applicable to military items or dual-use items which have not been granted a prior export authorisation in accordance with the said regulations (see in particular Community Regulation (EC) No 428/2009 of 5 May 2009 as amended - for which an export authorisation is required) would still be regulated by different national provisions, possibly conflicting.

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 international standard could contain the following provisions:

- Each national law which imposes a secrecy procedure should provide that this procedure be limited to priority patent applications filed in that country.
- Each national law which imposes a secrecy procedure should provide for a mechanism of "*implied authorisation*" upon the expiry of a period of time (which could be harmonised), allowing the applicant to disclose and/or exploit the invention.
- In addition, each national law should provide a possibility for the applicant to ask the local administrative authorities to state their position within a short timeframe regarding the possibility of disclosure and/or exploitation (with there being no need to provide reasons for this at the application stage).
- It would also be possible to provide that patent applications which do not relate to technologies falling within the scope of the regulations relating to military items or dual-use items which have not obtained an advance export authorisation be exempted from being reviewed for national defence purposes.

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

The definition of a standard does not appear to be appropriate.

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.

The aim of requirements for first filing at a predetermined office and of provisions making the possibility of filing a first application in a foreign country subject to authorisation is to prevent sensitive technical information from being communicated in an uncontrolled manner to the administrative authorities of a foreign power.

If these requirements are not complied with, it would seem difficult to cure them since the communication has already taken place.

The applicant may nevertheless withdraw its application prior to publication - and not claim the priority thereof - in order to erase any trace of the filing made in the foreign country in contravention of obligations associated with national security and thus to avoid a wider disclosure.

Partial harmonisation would be possible and desirable with regard to the penalties for an "involuntary" breach of such an obligation. More particularly, it would be possible to provide:

- that the irregular circumstances (from the point of view of national security) of the first filing do not affect the validity or enforceability of the IP rights claiming the priority of this first filing;
- for there to be no penalty - or at most purely financial sanctions - when the breach is involuntary and is not actually detrimental to the fundamental interests of the State whose laws have been contravened.

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.

Certain offices require declarations or assignments on the part of inventors, sometimes in very burdensome forms (signature with a witness, notarised documents, etc.). The French Group would be minded to limit these requirements:

- at least by simplifying the form thereof (simple signature),
- or alternatively to limit the requirements to the PCT filing (without duplication upon entry into national or regional phases) or, as a variant, to the priority filing,
- or alternatively to abolish them.

#### Summary

1. The French group has voted the following definition of an inventor: "An inventor is a natural person who conceives and/or reduces to practice, alone or with others, an invention. Accordingly, inventorship should be assessed by evaluating, as of the date of the invention, the contribution made to the state of the art known by the inventors on this same invention date."
2. Provisions mandating a country of first filing and a control by national defense authorities should only apply to inventions in relation with technologies which are used to design or manufacture warfare or dual use equipment, when the latter have not been granted an export license.
3. For other inventions, the following provisions should be harmonized, only to the extent that such harmonization is necessary to prevent or resolve conflicts of laws:
  - The law to determine inventorship should be the law of the contract whereby the inventor contributes to the invention (research contract, employment contract...) or, by default, the law of the country where the invention was conceived and reduced to practice;
  - The country of first filing should be freely selected by the parties or, by default, should be the one where the research activity which has generated the invention has its main center.

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#### **Q244 : Résumé des propositions du groupe français**

1. Le groupe français a adopté la définition suivante de l'inventeur : « Un inventeur est une personne physique qui conçoit et/ou met au point, seul ou avec d'autres, une invention. Ainsi, la qualité d'inventeur peut s'apprécier en évaluant à la date de l'invention la contribution apportée à l'état de la technique, l'état de la technique étant celui connu des inventeurs à cette même date d'invention. »
2. Les dispositions relatives à une obligation de premier dépôt dans un pays et au contrôle de la Défense nationale ne devraient être applicables qu'aux inventions relatives à des technologies entrant dans la conception ou la fabrication de matériels de guerre ou de matériels à double usage n'ayant pas fait l'objet d'une autorisation préalable d'exportation.
3. Pour les autres inventions, les dispositions suivantes pourraient être harmonisées, uniquement dans la mesure nécessaire pour éviter les conflits de lois:
  - La loi applicable à la détermination de la qualité d'inventeur devrait être celle du contrat en vertu duquel l'inventeur contribue à l'invention (contrat de recherche, contrat de travail ...) ou, à défaut, celle du pays dans lequel l'invention a été conçue et mise au point;
  - Le pays de premier dépôt devrait être celui choisi librement par les parties ou, à défaut, celui dans

lequel est centrée l'activité de R&D ayant donné naissance à l'invention.

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

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