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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?

This question seems to have two aspects. The first aspect (i) relates to the question of whether or not “directing the efforts of person B” influences inventorship, whereas the second aspect (ii) relates to the question of how inventorship is influenced by different residencies of persons A and B.

(i) With respect to the first question, it is important to first understand the concept of “inventorship” in accordance with German patent law: Although §§ 6 - 8, 37 and 63 PatG^[1] relate to “inventorship”, none of them provides a clear definition of “inventorship” or gives any precise indication of the kind of activity that qualifies for an “invention”.

“Inventorship” is established based on the real act of creating an invention. An invention is thought to have been created as soon as an “inventor” has conceived a complete and, hence, *executable technical teaching*. In a patent application, such technical teaching is ultimately defined – in its most general manner – by the claims. As a result of this definition, an aspect that has been considered during the development, but that has not found its way into the claims – i.e. that may not be subsumed under the subject-matter of the claims – may not be considered a part of that respective “claimed invention”. This is particularly important in cases where more than one person may be considered an inventor, because the subject-matter of the claims may be utilised to determine the concept of the invention and the contribution that each of the supposed inventors may or may not

have made to it.

In that respect, only one (or more) *natural persons* may become inventors under German law. A company, for example, may not be considered an inventor. Other than this requirement of being a natural person, there are no further legal requirements to be an inventor (such as contractual capacity, nationality and so on).

The determination of inventorship goes hand in hand with the right to the patent, since, in accordance with § 6 PatG, 1st sentence, by law the right to the patent belongs to the inventor (or the inventor's legal successor). This idea is generally called the *inventor's principle*. § 6 PatG, 2nd sentence provides for the case where several inventors created the invention jointly and establishes that they obtain the right to the patent jointly. § 6 PatG, 3rd sentence establishes that for several inventors having developed the same invention independently, the rights to the patent belong to that inventor who first applied for a patent at the patent office. In that respect, the *priority of the invention*, i.e. the order in which the invention was actually invented by each of the several inventors, is irrelevant to the question as to who obtains the right to the patent.

The right to the patent lies in the sphere of property rights. It may therefore be transferred from the inventor to a third party, e.g. due to a contractual obligation. However, even upon such transfer, the inventor (or the inventors) retains the personal right to be named as inventors, on the publications relating to the patent.

As an invention is a *technical teaching* that may have been created by involvement of several persons by performing experiments, tests or other actions which ultimately resulted in the inventive concept. Not all of these persons may be considered (co-)inventors in the sense of § 6 PatG.

At present, there is no generalised guideline how to determine (co-)inventorship in German law. Rather, whether a person is to be considered a (co-)inventor has to be decided on a case-by-case basis. In that respect, in order to assess a person's status as (co-)inventor of an invention, German jurisprudence has repeatedly set out two conditions that shall be met by said person.

(a) The person has to make a contribution to the solution of the problem to be solved by the invention, whereby said contribution must not be insignificant with respect to the solution^[2]. Further, said contribution has to be creative, but not necessarily inventive in itself.

(b) Said contribution must be an intellectual one that has to be provided autonomously, i.e. without the specific directing^[3] by other persons.

In detail:

In accordance with consideration (a), a (co-)inventor has to provide a part of the solution of the technical problem, i.e. has to contribute to the technical teaching in a way that is not insignificant for the overall success of the invention and that is also considered *creative*^[4]. The contribution does, however, not have to be inventive in itself. In other words: In order to qualify as a (co-)inventor, a person has to provide a qualified input with respect to one or more of the features of the invention that are a part of the solution of the technical problem, i.e. the technical teaching.

According to consideration (b), this contribution of a (co-)inventor has to be an intellectual one. Thus, a person that provides intellectual input on possible modifications of an inventive concept or on a potential alternative solution to a particular problem may be considered a (co-)inventor. This intellectual contribution does not necessarily have to be a physical act. For example, a person that has provided the theoretical groundwork from which the technical teaching is ultimately developed is equally to be considered a (co-)inventor.

In contrast, a person merely providing for certain requirements without which the invention could not have been made – such as providing laboratory space, financial support or requesting to solve a particular problem without any direction as to how to solve this problem – does not qualify as a (co-)inventor. Likewise, a person conducting an experiment or building a prototype under direct supervision may not be considered a (co-)inventor. These persons are rather considered “(inventor's) assistants”.

Therefore, it becomes apparent that person A may be considered an inventor if the directing of person B's efforts by person A may be considered an intellectual, creative contribution that has not been insignificant to the success of the invention, i.e. that is a part of the technical teaching. For example, if person A has conceived a specific technical solution to a specific technical problem and directs^[5] person B to perform experiments or build a prototype in order to verify said solution, i.e.

provides person B with distinct instructions, person A will be considered the sole inventor of the technical teaching – provided that the result is both, new and inventive. It goes without saying that person B, who has been instructed throughout the process and has not provided any autonomous input at all, would not be considered an inventor in this case, but rather an assistant.

On the other hand, person B may be considered a co-inventor, if both, person A and person B have provided an intellectual, creative contribution that has been significant to the success of the invention in the above-cited sense. This could be case if, for example, person A directs person B to solve a particular technical problem to which person A has already contrived a partial (incomplete) solution and person B completes the work of person A to achieve the solution.

In a further constellation, person A may not be considered an inventor at all, whereas person B could be considered the sole inventor. This would be the case if, for example, person A had only provided direction in the manner of telling person B “Find a solution to this problem”, without providing any hint or pointers to a solution, but merely stating that it must be possible to find one. In that case, the whole process of finding the solution, i.e. finding a technical teaching to arrive at the solution was conducted by person B.

(ii) In relation to the second aspect of the question: Whether or not person A and/or person B have a residency inside or outside Germany has no influence on the question under which circumstances person A and/or person B would be considered an inventor in accordance with *German jurisprudence*^[6].

Footnotes

1. [^] [1] In the following, the abbreviation PatG is used to refer to the German Patents Act. The sign “§” is used to indicate the respective section/article of that Act. The doubled version of this sign “§§” is used to indicate multiple sections/articles.
2. [^] Cf. BGH decision X ZR 103/11 of 18 June 2013, at 8.
3. [^] “Specific” directing in this context means that a person receives a kind of directing that points into a specific direction or to a specific solution of the technical problem.
4. [^] The question which contribution may be considered creative and which not has to be answered on a case-by-case-basis here.
5. [^] specific directing
6. [^] In cases of multinational inventions, the question of inventorship is a question to be answered on the basis of the applicable national law. Thus, the question of whether person A or person B are inventors may be answered differently in cases where another national law (apart from German law) may also be applied. Thus, the determination of inventorship may vary from constellation to constellation. In the following, these different variations shall not be discussed in further detail.

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 as to how an invention was made by one or more inventors and what contributions were made by each of the inventors may only be answered in view of the *entire* technical teaching of an invention. As outlined herein above, the most general concept of such technical teaching may be defined by the claims. However, the question of who invented the technical teaching of a patent is not to be answered on the basis of the claims and the combination of their features alone^[1]. Decisive for the determination of a possible creative contribution to the subject matter of the patent is the entire content of the patent application including description and drawings^[2]. Thus, whether or not a person may be considered an inventor is to be determined on the basis of the patent application as a *whole*^[3].

In case of a single inventor, such an assessment is rather easy: if the subject-matter of the application is both, new and inventive, this single person is to be considered the inventor. However, in cases where more than one person has contributed to the technical teaching of an invention, this technical teaching has to be determined in a more definite manner. In particular, it has to be determined which aspects of the application as a whole relate to the claimed invention and which do not, i.e. which aspects may be subsumed under the claims and which may not. A person may thus be considered a (co)inventor, if said person has contributed^[4] – in accordance with the understanding as defined in sub a.) – to one or more of the aspects of the technical teaching that either already are comprised by a claim or could be made part of a claim in accordance with the disclosure of the original application^[5].

In that respect, it is irrelevant whether the person's contribution may be found as verbatim disclosure within the description, claims or drawings or whether it relates to the technical teaching conferred by the claims as a whole. As a consequence, a limitation of a claim by adding features from a preferred embodiment cannot enlarge the circle of co-inventors, i.e. the maximum number of co-inventors is fixed with the filing of the application^[6]. But the number of inventors may be reduced during prosecution of the patent application if the only technical feature contributed by a co-inventor is finally excluded from the limited claims^[7].

Therefore, a person who has solely contributed to these elements of the description and drawings – the aspects not falling under the scope of any of the claims – may not be considered a co-inventor.

Footnotes

1. [^] Cf. BGH decision X ZR 70/11 of 22 January 2013, at 13.
2. [^] BGH, *id.*
3. [^] Cf. eg. BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung
4. [^] This also includes a person who has provided some kind of directing, which eventually lead to the technical teaching that is conferred by the claimed invention.
5. [^] Cf. BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung, at 18; BGH decision X ZR 70/11 of 22 January 2013, at 14.
6. [^] BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung, at 18.
7. [^] BGH decision X ZR 53/08 of 17 May 2011 – Atemgasdrucksteuerung.

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

no

Please comment:

No, the law of inventorship depends solely on the person(s) of the inventor(s). However, the question of whether German law is applicable for the determination of inventorship in a case where the invention was made at least in part by foreign citizens has not yet been addressed by case law. One possible approach advocated in legal literature is the application of German law if a German national patent application has to be examined.

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Please comment:

No, invention and inventorship are independent of the residency of the inventor(s). However, the question of whether German law is applicable for the determination of inventorship in a case where the invention was made at least in part outside the territory of Germany has not yet been addressed by case law. One possible approach advocated in legal literature is the application of German

law if a German national patent application has to be examined.

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 inventor information on the patent application can be supplemented or corrected after the filing date.

This is provided for by § 63 PatG. Pursuant to § 63 PatG, the inventor has the right to be designated on the published application, on the patent document and on the publication of the grant of the patent. In addition, § 63 PatG confers the inventor the right to correct the inventorship designation.

However, the correction of the inventorship of a patent application does not directly change ownership of the application. As explained, the “real inventor” or his or her successor in right, whose invention has been applied for by a person not so entitled, may request that the patent application is assigned to him. The applicant or proprietor may change the designation of an inventor at any time. Consent of the previously designated inventor(s) is (only) required after the designation has been published on the application, the patent document or the mention of grant^[1].

An inventor may request that an incorrect designation shall be corrected if both the patent applicant or proprietor and the previously designated inventor(s) agree^[2]. The correction can be made if a person has been named incorrectly as an inventor, or if one or several co-inventors have remained undesigned, upon a written application by the true inventor to be filed with the Patent Office. Such an application needs to include a written declaration of consent of the applicant or patent proprietor on the one hand, and the actually involved and previously designated inventor(s) on the other hand, if requested by the Patent Office with certified signatures.

The entitlement to correction of the designation generally arises with the publication of the patent application, the patent document or the mention of grant. However, a correction can already be claimed before the patent document is laid open^[3].

The claim for correction is not tied to the validity of the patent. However, there is no entitlement if the application has already been finally rejected.

The true inventor can enforce the right for a declaration of consent by the patent applicant or proprietor and/or the other designated inventors to the correction before the competent court of law. There is no deadline for this claim because the personal right of the inventor does not become statute-barred. Only the true inventor can enforce the claim in court. The claimant/inventor to be designated generally bears the onus of proof.

The justified designation is only noted on official publications if these have not yet been published. If all publications have been published, the true inventor is still able to prove his inventorship by the publication in the Patent Bulletin and the Register^[4].

Footnotes

1. [^ BPatGE 25, 131.](#)

2. [^ OLG Karlsruhe, GRUR-RR 2003, 328.](#)

3. [^ BGH, GRUR 1969, 133](#)

4. [^ Busse/Keukenschrijver § 63 PatG, Rn. 24 ff.](#)

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?

(i) The potential consequence of an incorrect designation of the inventor is essentially limited to the

fact that the designation (and as a consequence possibly also the ownership right) has to be corrected in the register and/or future publications concerning that patent application upon the disadvantaged party's request. If the correction corresponds to the actual situation and is registered, this does not affect validity or enforceability of the patent.

In fact, the minor importance of inventorship under German law can also be seen from the fact that the statement has only to be submitted within 15 months after the priority of a patent application. Upon request of the applicant, this period may even be extended by the patent office until the grant of the patent. Upon request of the inventor, his/her designation on all publications is omitted. For utility models, a statement does not need to be submitted at all.

The filing of an action for the declaration of consent to the subsequent designation or correction of the same, as mentioned above in the answer to question 4), does not delay the procedure for grant. There is in particular no stay of the examination proceedings^[1].

The incorrect designation of the inventor does not preclude the validity of the patent, even if it was made intentional, because an incorrect designation is no ground for nullity (as stated in §§ 22, 21 PatG). There are no particular sanctions e.g. under criminal law for an incorrect designation, because such misinformation does not entail any disadvantages for the proceedings before the Patent Office or the granted patent <http://de.wikipedia.org/wiki/Erfinderbenennung> - cite_note-benkard-sch.C3.A4fers_Rn_9-7 as they are not causal in relation to the patent grant, see § 37 (1) sentence 3 PatG. They do not constitute elements of obtaining a patent by fraud, either.

(ii) However, since according to § 6 PatG the patent belongs to the inventor or his successor in title, an incorrect designation, together with further prerequisites, may result in a claim to the transfer/nullity of the patent to the actual inventor:

According to § 8 PatG, the person entitled to the invention whose invention has been applied for by a person not so entitled may request that the applicant or the patent proprietor, assigns the patent application or the patent, respectively, to the real inventor. And that is not a question of nationality, because persons deriving their right from a foreign act of conceiving of an invention are also entitled to file claims and sue in this regard. They may invoke the principle of German law according to which their right is not established by the application, but by the inventor's personal right. However, foreign regulations may take effect, in particular in the case of employee inventions, concerning whether or not the right to the invention accrues to the employee or the employer^[2].

In case the application was filed by a person not so entitled, the "real inventor" who is entitled to the invention may assert the right to assign the patent application by an action of law only within two years after publication of the grant of the patent, see § 8 sentence 3 PatG.

Besides that, a ground for nullity may occur if there is not only an incorrect designation, but in fact an usurpation, cf. §§ 22, 21 PatG^[3]. An usurpation may be present if the (registered) applicant has filed an application for an invention without having received the inventor's entitlement to do so. The applicant may step in such a situation, if the application includes inventive subject-matter that was i.e. based on information received from a (not designated) "real" inventor under confidentiality or subject-matter being illegally obtained knowledge of a third party^[4]. As a consequence, there remains a (minor) risk that the application is declared null if it is discovered later that subject-matter of the invention was illegally taken from a (not designated) "real" inventor.

Footnotes

1. [^] *Busse/Keukenschrijver, § 63 PatG, Rn. 30.*
2. [^] *Kraßer, p. 361 f. Sec. 20.*
3. [^] *Beyerlein, Mitt. 2003, p. 65, 67.*
4. [^] *Kraßer, p. 361 f. Sec. 20.*

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:

German law does not require that a patent application be filed first at the German Patent and Trade Mark Office. However, § 52 PatG provides that a patent application which contains a national secret as defined in § 93 of the German Criminal Code (Strafgesetzbuch (StGB)) may be filed abroad only if the German Ministry of Defence has granted approval to do so, which approval may be subject to the fulfillment of certain conditions. Failure to obtain such an approval or meet the conditions of the approval may lead to criminal sanctions. Consequently, a patent application which contains a national secret should be filed first at the German Patent and Trade Mark Office if no approval for filing it abroad has been obtained from the Ministry of Defence and criminal sanctions are to be avoided. For the same reason a European patent application which contains a national secret and a PCT application which contains a national secret should be filed first at the German Patent and Trade Mark Office. If the applicant is in doubt as to whether or not the application contains a national secret, it is advisable to file the application first at the German Patent and Trade Mark Office because every application filed at the German Patent and Trade Mark Office will be examined by the Office to ascertain whether or not the application contains a national secret. If the application does not contain a national secret it may be filed first abroad as a foreign national application, or in case of a European patent application at any filing patent office defined in Art. 75 (1) EPC or, in the case of a PCT application, at any competent Receiving Office including the International Bureau and the European Patent Office.

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?

Preliminary remarks: German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, no matter whether the invention forming the subject of the patent application is made in part or completely in Germany. However, any patent application filed at the German Patent and Trade Mark Office, whether it is a German national application, a PCT application or a European patent application in respect of which the applicant has indicated that the European patent application may contain a national secret, is subject to a secrecy review which is conducted by an examiner of the German Patent and Trade Mark Office with a view to determining whether or not the application contains a national secret. A patent application which does not contain a national secret need not be filed at the German Patent and Trade Mark Office but may be filed directly in another country or at the European Patent Office without it being subjected to a secrecy review or similar process beforehand.

Although German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, it is to be noted that if a secrecy review is conducted by the German Patent and Trademark Office because the patent application has been filed at the German Patent and Trademark Office, the secrecy review is conducted with a view to determining whether or not the application contains a national secret which may be any secret that impacts the national security if disclosed to unauthorized persons. Patent applications that have been deemed to contain a national secret up to now, have disclosed or claimed inventions made in areas such as nuclear, biological and/or chemical weapons, nuclear energy, communication technology, information technology, cryptography, protection against forgery of security and value documents.

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

Although German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, it is to be noted that if a secrecy review is conducted by the German Patent and Trade Mark Office because the patent application has been filed at the German Patent and Trade Mark Office, the secrecy review consists in determining whether or not the application contains a national secret. What is and what is not a national secret does not depend on the patentability of the invention forming the subject of the patent application undergoing a secrecy review. There is no national secret in the case of publications or documents that are accessible to any person due to public use or the inventive concept of which fails to go beyond the general technical knowledge.

If the examiner conducting the secrecy review is of the view that the patent application contains a national secret and in cases of doubt, the German Ministry of Defence has to comment on the examiner's findings before an order of secrecy is issued. Once the examiner has considered the comments made by the Ministry of Defence he or she decides to issue an order of secrecy but only after the applicant has been heard. Once an order of secrecy has been imposed on the application any publication of the application by the Patent Office or the applicant is prohibited.

The secrecy order must be delivered to the applicant pursuant to § 53 PatG within a statutory term of four months after filing of the application. If the secrecy order is not delivered to the applicant by the date of expiry of the afore-mentioned term the applicant can assume that the application need not be kept secret unless the applicant knew that the application contains a national secret. The afore-mentioned term can be extended by two months.

If a secrecy order has been imposed on the patent application and it turns out later on that it was not necessary to issue the secrecy order the order is to be rescinded by the examiner ex-officio, or upon request by the Federal Ministry of Defence or the applicant or patentee. If the order is rescinded, the patent application or a patent granted on the secret application can be published.

Since a secrecy order imposed on a patent application might impair possible exploitation interests of the applicant, he or she is entitled to a legal claim for compensation from the German Government pursuant to § 55 PatG.

A patent application containing a national secret may be filed in another country according to § 52 PatG only with the prior written permission of the Federal Ministry of Defence. Although the character of the invention as a national secret is not eliminated by the permission of the Federal Ministry of Defence, the applicant is entitled to file the application in another country on account and within the scope of the permission. To obtain the permission a request should be made in writing with the Federal Ministry of Defence, listing the countries in which the application is to be filed. Grant of the permission is at the discretion of the Ministry of Defence. The permission is usually granted if the other country agrees to the secrecy and the disclosure of the invention to the authorities of the other country does not impair the national security of the Germany. It is not necessary to file a patent application first in Germany in order to request and obtain the permission from the Federal Ministry of Defence to file a patent application in another country.

The official fees for filing and prosecuting a patent application which is subject to a secrecy order imposed on the application after a secrecy review are not different from those due for a patent application which is not subject to a secrecy order. Also there is no official fee for obtaining the permission from the Federal Ministry of Defence to file a patent application containing a national secret in another country.

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

Although German law does not require that a patent application undergo a secrecy review or similar process before it can be filed in another country, it is to be noted that if a patent application which contains a national secret is filed in another country and a permission to do so has not been obtained or has been denied the applicant may be sentenced to imprisonment of up to five years or

he may be fined. The same applies if a permission has been granted with restrictions and the restrictions are not met.

The applicant will be sentenced only if his failure to comply with the law and the conditions governing the filing of a patent application which contains a national secret was intentional.

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 German Patent law does not define inventorship. The definition and the principles of how it is determined have been developed by case law and legal literature, yet there is no uniform definition. It can be noted that current case law places comparably low requirements on an involvement in an invention. Only contributions which had no influence on the overall success and which are not relevant in respect of the technical solution are insufficient to establish an involvement in an invention^[1].

As concerns the mechanism of becoming an inventor it is often not clear in practice who has made a significant contribution. Usually, the co-inventors agree on this among each other. What is decisive for determining the individual share of an inventor is the significance the individual contributions of the persons involved in the invention have in relation to each other and in relation to the overall inventive achievement^[2]. As a general rule, the technical contribution of a joint inventor has to “affect” the inventive technical solution. Furthermore, an inventor status can be achieved on the basis of a contribution within defining the underlying technical problem on which the invention is based, if this contribution influences the overall success of the invention and already contains a hint for the technical solution^[3].

As outlined above, the assessment of inventorship is somewhat difficult, but in general it can be said that the prerequisites are relatively low. There are no serious consequences for a patent or patent application in case of an incorrect inventor designation. This seems to be an appropriate environment for Germany, where the majority of inventions come from employees and these employees usually decide by themselves who was involved and who not.

Footnotes

1. [^] *BGH GRUR 1966, p. 558- Spanplatten; BGH GRUR 1978, 585- Motorkettensäge, Mitt. 1966, p. 16- Gummielastische Masse II.*
2. [^] *BGH GRUR 1979, 540 (541)- Biedermeiermanschetten.*
3. [^] *Bartenbach/Volz, KommArbEG, § 5 Rn. 47.1*

- 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?

German law does not require first filing of patent applications in Germany. If a patent application is filed at the German Patent and Trade Mark Office, be it as a first filing or a subsequent filing, it undergoes a secrecy review to determine whether or not it contains a national secret irrespectively of whether or not the invention forming the subject of the invention has been made by two or more inventors of the same nationality or different nationalities. Thus there is no law that could be improved to address multinational inventions.

- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address

multinational inventions?

The provisions governing the need for a secrecy review of patent applications filed at the German Patent and Trade Mark Office should be amended to clarify what is and what is not a national secret which, if contained in a patent application, requires an order of secrecy to be imposed on the application. However, such an amendment would not make any difference on whether the invention forming the subject of the application was made by two or more inventors of the same nationality or different nationalities.

In addition, it is suggested that the present statute regarding secrecy review should be amended in a way that it allows to file a patent application, which is considered to disclose an invention which might concern national security, with the competent authorities of the foreign co-inventor(s), or a supranational patent authority to which the secrecy review will be delegated.

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.:

Presently, the question of who is recognised as an inventor of a particular invention may be answered differently in different jurisdictions. In particular, many jurisdictions define “inventorship” or “involvement in an invention” in Case Law with more or less ambiguous instructions to the industry. Considering the increasingly involved multinational teams working on product developments, problems do exist with regard to the actual decision on legally relevant contribution of persons to the inventions. That question is often finally decided by the persons of the team themselves without having a clear understanding of the different (national) requirements. As that decision has different effects on the question of “actual” ownership of patents or patent applications directed to the same invention between the counterparts being subject to different jurisdictions, harmonisation is highly desirable. Harmonisation is even more mandated with respect to first filing and secrecy review requirements, which in extreme cases may lead to the result that no patent application can be filed in any jurisdiction without violating criminal law in one of the jurisdictions where the inventors are domiciled or of which the inventors are nationals. Due to the existing differences, applicants or their agents are oftentimes not aware of the requirements existing in foreign jurisdictions, which may lead to loss of rights in these jurisdictions, or even criminal sanctions.

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.

According to the present Case Law in Germany, inventorship requires an involvement in the development of the teaching by contributing an achievement which exceeds the ordinary skill of the

person skilled in the art, which has substantial influences on the overall success of the inventive achievement, and which is made at least partly on own initiative. Accordingly, contributions that can be excluded from inventorship from the outset are (only) those that had no influence (at all) on the overall success of the invention and which are therefore irrelevant for the solution, or were made according to specific instructions from an inventor or a third party.

To sum up, the prerequisites to acknowledge inventorship is relatively low in Germany allowing many persons involved in a development to be designated as co-inventor for a subsequent patent application. Considering the standing of the inventorship itself that situation significantly supports teamwork and technical progress. But it should also be considered that at the same time incorrect designations can be easily corrected without any significant defect of the rights resulting from the patent.

In countries where more serious sanctions may happen after an incorrect inventor designation it might be helpful to have a slightly stricter definition to reduce the required efforts of the patent proprietor to verify the actual involvement of persons during the development and to reduce the resulting risks. But from our perspective and due to the positive experiences during the last decades with that situation it seems to be more appropriate to mitigate the legal consequences of such an incorrect inventor designation.

As outlined above, the German definition could serve as an appropriate international standard.

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).

(i) The German rules seem to offer appropriate proceedings to correct the inventorship *after a patent application is filed*, because these are flexible to handle, respect all interests and avoid any harmful effect on the validity and enforceability of the patent. It should be noted that the rules of the EPC are structured in a similar fashion, cp. Article 62 and Rule 21 EPC.

Generally no distinction between intent and negligence should be made, because this would simply increase the administrative burden of the patent offices. If this cannot be dispensed with, then it should be left to the national courts where the invention originates from, because that considers the actual situation of the involved persons at the time of the invention.

(ii) As far as the correction of ownership based on an originally incorrect inventor designation is concerned, it is also believed that the rights of the "new" inventor and the already involved parties (in particular also the applicant) are fairly balanced according to the German Law because § 8 PatG establishes a right for assignment within a limited period of time after granting.

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.

A first filing requirement is not appropriate.

The rationale for such a requirement is typically the protection of the secrecy of certain inventions implicating national security or other national interests of the jurisdiction applying the requirement. However, the inventions of the vast majority of patent applications do not fall in this category.

Furthermore, applicants are typically well aware of the fact that their invention is or at least may be relevant for national security or other national interests. Therefore, the goal of protecting the secrecy of such inventions can also be achieved with less far-reaching measures like a secrecy review requirement for certain classes of inventions, or even by simply prohibiting foreign filings of patent applications disclosing inventions which are relevant for national security or other national interests, combined with an offer for a review in case the applicant has doubts, and combined with criminal sanctions in case of noncompliance with the prohibition^[4].

For the applicant who desires to make the first filing abroad, the first filing requirement increases the costs for patent protections, in the best case caused by a requirement to apply for a foreign filing license, and in the worst case by a requirement to file an additional patent application, in the

jurisdiction of the inventor, although the applicant did not intend to do so. The requirement of obtaining a foreign filing license may also substantially delay the filing of the application. For these reasons, a first filing requirement or a general obligation to obtain a foreign filing license unduly burdens applicants and is disproportionate.

Footnotes

1. [^](#) *These secrecy requirements should apply independent of the nationality and/or residency of each of the inventors.*

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 requirement is in general less burdensome for the applicant than a first filing requirement, in particular if it is limited to certain classes of inventions. However, even a secrecy review requirement is not necessary for achieving the goal of preventing the disclosure of inventions which implicate national security or other national interests, and is therefore inappropriate. As mentioned in the answer to question 15, applicants are typically well aware of the fact that their invention is or at least may be relevant for national security or other national interests. The goal of protecting the secrecy of such inventions can be achieved by simply prohibiting foreign filings of patent applications falling in this category, possibly combined with criminal sanctions in case of noncompliance with the prohibition. Harmonisation of the definition of what has to be understood under an *“invention which implicates national security or other national interests”* would be desirable. Since in particular in borderline cases, the applicant may have doubts whether or not his invention falls under the prohibition, secrecy review should be offered as an option, but it should not be mandatory. Moreover, a secrecy review should be carried out solely by the respective Patent Office at which the patent application is filed in order that the applicant will be informed as quickly and cost efficiently as possible as to whether or not the application contains a national secret. No other authority should be involved in the secrecy review such as the Ministry of Defence as in Germany. In order to take account of multinational inventions, secrecy reviews in foreign jurisdictions should not be prohibited by national laws, at least were it is safeguarded that the reviewing agency in the foreign jurisdiction will respect the secrecy of the invention.

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

The Working Guidelines define the term *“foreign filing license”* as *“any procedure or mechanism for obtaining an exemption to a first filing requirement”*. Since under the regime suggested here, there should be no first filing requirement (see answer to question 15 above), a foreign filing license in this sense would not be required. However, where there is a prohibition of foreign patent filing disclosing inventions which implicate national security or other national interests, foreign filing licenses which provide an exception to the prohibition should be available. Such a foreign filing license should be granted where it is safeguarded, e.g. by international or bilateral treaties, that the patent office of the foreign jurisdiction will keep the invention secret¹¹.

Footnotes

1. [^](#) *For multi-jurisdictional inventions which implicate national security or other national interests, a deadlock situation can occur if applying for a foreign filing license in another jurisdiction is prohibited*

by national law because it would involve disclosing the invention to the foreign agency. In this case, it is possible that no patent application can be filed in any jurisdiction. However, since the number of inventions actually implicating national security is small, and the number of such inventions made by a team of multi-jurisdictional inventors is even smaller, this result appears to be acceptable.

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.

Under the regime suggested here, a foreign filing license as defined in the Working Guidelines would not be required. The modified foreign filing license as suggested in the above answer to question 17 only needs to be applied for where the invention implicates national security or other national interests. In the granting procedure for such a foreign filing license, the competent agency assesses whether it is safeguarded, e.g. by international or bilateral treaties, that the patent office of the foreign jurisdiction will keep the invention secret. In a case where the invention indeed implicates national security or other national interests, a cure for inadvertently failing to apply for a license is not desirable because only by means of the application for a foreign filing license, it can be safeguarded that the foreign patent office is informed about the necessity to keep the invention secret.

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.

(none)

Summary

According to German case law, an invention is thought to have been created as soon as a person has conceived of a complete and executable technical teaching. In order to qualify as a co-inventor of an invention, German case law requires that said person (i) has made a contribution to the solution of the problem to be solved by the invention (this contribution must not be an insignificant one with respect to the solution). Further, (ii) said contribution must be one without any specific directing by other persons. Information regarding inventors of a German patent application can easily be supplemented or corrected after the filing date. German law does not require that a patent application be filed first at the German Patent and Trade Mark Office.

In the opinion of the German national group, and in view of the increasing number of patent applications with multinational teams of co-inventors,

- the above requirements of co-inventorship would be an appropriate international standard;
- it would be desirable if it was easy to supplement or correct information regarding inventors after the filing date of a patent application, and no distinction should be made between intentional and unintentional errors;
- secrecy reviews in foreign jurisdictions should not be prohibited by national laws, at least were it is safeguarded that the reviewing agency in the foreign jurisdiction will respect the secrecy of the invention; and
- any first filing requirement, or a general obligation to obtain a foreign filing license, would unduly burden applicants.

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

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