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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?

(Article 7 of the Act XXXIII of 1995 on the protection of inventions by patents (in the following Patent Act or PA) 7 defines that "the person who has created the invention shall be deemed to be the inventor".)

Persons who participated in creating the invention should be regarded as inventors independent from their citizenship and country of residence. The inventorship can be divided in parts corresponding to the degree of contribution of the different inventors. The percentual share of the respective inventors can be defined based on their own free will and in the lack of such definition this share should be assumed as equal among the joint inventors.

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 inventorship depends on the contribution of the person to the inventive idea. That is not defined on a claim by claim basis and also not on the content of the drawings or examples, but based on all circumstances that have lead to making the invention. For instance, those who made activities within the normal duties of a man skilled in the art e.g. in the elaboration of the examples, are normally not held as inventors. In case there is no common understanding between the persons who think they are the inventors, the competent court should decide this question. The competent court is the Metropolitan Tribunal of Budapest.

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

no

Please comment:

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

no

Please comment:

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

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

If the inventors and the owner(s) of the patent/patent application agree on the inventorship of a person not named earlier as inventor or on the change of the share of contribution of the respective inventors, then upon a joint request the inventorship in the patent register or in the patent documents will be amended accordingly. If such an agreement is not available or the persons have different positions, then it is the task of the competent court (c.f. above) to decide; in this case the inventorship will be corrected upon filing a request enclosing the final court decision. There is no time limit.

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?

If there is an error in naming the inventors, it can be corrected as defined in the previous point.

If it is not an error but the result of an intentional fraud, i.e. if the invention was made by a separate inventor and the person/applicant has unlawfully taken the invention from him or her and filed the invention, then according to Art. 34 of the Patent Act the real inventor can file a lawsuit against the named inventor(s)/applicant(s) and can request assignment of the patent corresponding to his or her share and can also request the compensation of his or her damages.

According to Article 42 (1)(d) of the Patent Act "the patent shall be revoked ex tunc ..if the patent has been granted to a person who is not entitled to it under this Act". Thus, a third person alternatively to the assignment can request the revocation of a patent if he or she can provide for appropriate proof in this respect.

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

If no please comment:

- a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

- 7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

If yes please answer the following questions::

- a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

(Answer: If the applicant is Hungarian (either by citizenship or residence) and the application has been filed first in Hungary, then there will be a check carried out at the Hungarian Intellectual Property Office (HIPO) within 2 months from the filing date whether the invention needs to be regarded as special from the point of view of national security. It is important to note that the applicants do not have the obligation to file first in Hungary.)

a) No.

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

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

As there is no obligation to file an application first in Hungary, there are no consequences either.

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?

Our committee holds this definition basically sufficient. It would be preferred if the corresponding court decisions were easily and publicly available to provide guidelines.

- 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?

There are no such requirements.

- 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?

As explained earlier such examination is carried out only if the application is filed first in Hungary and if the applicant(s) is(are) Hungarian. For partially foreign applicants this rule does not apply.

- 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.

The present rules are basically correct.

III. Proposals for harmonisation

- 12) Is harmonisation in this area desirable?

yes

Please comment.:

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

We consider that the definition according to the Hungarian Patent Act is correct: the inventor is who has created the invention.

In this definition all persons who have contributed to create the inventive step (or who has created the non obvious part of the invention) should be regarded as inventor(s).

Disclaimer: the persons who have contributed to the making of the invention with using their expectable skills (not exceeding the one that can be expected from the man skilled in the art) are not inventors irrespective for the amount of work done.

Suggestion: for avoiding later disputes it would be advisable to fix the percentual degree of contribution of all inventors.

- 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).

- a. *It is advisable to provide a way for correcting the inventorship.*
- b. *In case all parties agree (inventors and applicants) the correction should be made as a simple registration of the corrected figures according to the unanimous request of the concerned persons/entities. According to our view the correction of unintentional errors belongs to this group.*
- c. *The term "intentional" is not a correct expression. In case there is no common agreement between the concerned parties, a court should decide on this question. Concerning the time limit of such corrections (according to the majority opinion of the working committee: 1 year counted from the date of the decision that grants the patent. (Minority view: there is no need to define any time limit)*

Further comment: this correction cannot cover when an invention has been intentionally stolen from the rightful inventors. Such issues should be decided by the courts.

- 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.

There is no need in our modern age to protect national security with means built in the patent system. The preservation of national security should be provided by means outside the patent system.

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.

There is no need for such a system.

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

Such a standard is not needed as the system is not needed.

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

Such a standard is not needed as the system is not needed.

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.

In this regard a freedom of act is the best solution. The parties (including the inventors and the applicants) should have the power to define where to file first. It would also be advantageous, if these parties could mutually agree before the first filing on the place and law where any disputes concerning inventorship should be resolved and decided, and such a decision should be binding for all other countries where the invention has been filed.

Summary

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The Hungarian Committee considers that there is no need for any examination of patent applications from the point of view of national defense, security or other interests. Similarly, there is no need for limiting the rights of the applicants in which country they wish to file their patent applications first or later claiming the priority of the previous applications(s), i.e. the system requiring in several countries a foreign filing licence has become obsolete. The aspects of national security and interests should be taken into account independent from the patent system. This is because in the IT age the transmission, availability and use of information is so broad and unlimited that patent cases constitute only a negligible fraction. If there are no such requirements, the multinational nature of the inventions (inventors and/or applicants) has no significance. The parties should freely choose in which country to file first.

Errors in designating the inventors should be made correctable if all parties agree, and in case of non-

agreement the decision should be made by a competent court. In multinational inventions it would be advisable if the parties would agree in advance on the country of the decision-making court and of the law to be applied.

It is difficult to define who qualifies as inventor, however, the best approach would be to consider the person(s) as inventor(s) who has (have) created the invention. Those who have not contributed to the inventive step and carried out work that falls within the due obligation of the man skilled in the art should not be qualified as inventors.

Résumé

Le Comité Hongrois considère qu'il n'est pas nécessaire d'examiner les demandes de brevet du point de vue de la défense nationale, de la sûreté nationale ou d'autres intérêts, s'agissant d'une institution sollicitant une autorisation ou une licence, si le propriétaire des droits souhaite déposer une demande de brevet dans des pays étrangers. Les aspects de la sûreté nationale et des intérêts nationaux devraient être pris en compte indépendamment du système des brevets. Cela est dû au fait qu'à l'ère de l'informatique la transmission, la disponibilité et l'utilisation de l'information sont tellement étendues et illimitées que les affaires liées aux brevets n'en constituent qu'une petite fraction. S'il n'existe pas une demande en ce sens, la nature multinationale des inventions (des inventeurs et/ou des demandeurs) n'a pas d'importance. Les parties devraient pouvoir choisir librement le pays où elles déposeront d'abord le brevet.

Les erreurs dans la désignation des inventeurs devraient devenir corrigibles si toutes les parties sont d'accord. En cas de manque d'un accord, la décision devra être prise par une cour compétente. Dans le cas d'inventions multinationales, il serait souhaitable que les parties se mettent d'accord au préalable sur le pays du tribunal qui exerce la juridiction ainsi que de la loi qui sera appliquée.

Il est cependant difficile de définir qui peut être considéré comme inventeur. La meilleure approche serait de définir les personnes qui ont créé l'invention. Il ne faudrait pas qualifier d'inventeurs ceux qui n'ont pas contribué au pas inventif et qui ont effectué un travail faisant partie des obligations d'une personne versée dans la technique du métier.

Zusammenfassung

Die ungarische Kommission steht auf dem Standpunkt, dass aus der Perspektive der Landesverteidigung, der nationalen Sicherheit oder anderer nationaler Interessen keine Notwendigkeit zur Prüfung von Patentanmeldungen besteht. Ebenso ist es nicht notwendig, die Rechte der Anmelder dahingehend einzuschränken, in welchem Land sie ihre Patentanmeldungen zuerst oder später mit Beanspruchung der Priorität einer früheren Anmeldung/früherer Anmeldungen einreichen möchten. D.h. das System, dass in einigen Ländern eine ausländische Einreichungslizenz verlangt wird, ist überholt. Die Aspekte der nationalen Sicherheit und Interessen sollen unabhängig vom Patentsystem Berücksichtigung finden. Grund dafür ist, dass im Informationszeitalter die Übertragung, die Verfügbarkeit und die Nutzung von Informationen so ausgedehnt und unbegrenzt ist, dass Patentangelegenheiten nur einen unbedeutenden Anteil ausmachen. Gibt es keine solchen Anforderungen, ist der multinationale Charakter von Erfindungen (Erfindern und/oder Anmeldern) nicht von Bedeutung. Die Beteiligten sollen frei entscheiden, in welchem Land die erste Anmeldung erfolgen soll.

Fehler bei der Benennung der Erfinder sollen korrigierbar sein, wenn alle Beteiligten einverstanden sind. Wenn kein Einverständnis vorliegt, soll ein zuständiges Gericht die Entscheidung fällen. Bei multinationalen Erfindungen ist es ratsam, wenn sich die Beteiligten im Voraus über das Land des entscheidenden Gerichtes und der anzuwendenden Gesetzgebung einigen.

Es ist schwierig zu definieren, wer als Erfinder eingestuft werden kann. Der beste Ansatz für diese Entscheidung ist, dass die Person(en) als Erfinder gelten, die die Erfindung geschaffen hat/haben. Diejenigen, die nicht zur erfinderischen Tätigkeit beigetragen haben und Arbeit geleistet haben, die zum

Pflichtwissen eines Fachmanns gehört, sollen nach einer solchen Arbeit nicht als Erfinder gelten.

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

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