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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?

The Taiwan Patent Act stipulates the basic principle regarding inventorship. The corresponding statutes and provisions are provided below.

Article 5 of the Taiwan Patent Act prescribes that the inventor(s), creator(s), or designer(s) is entitled to file a patent application for his invention/utility model/design. According to this article, the inventor(s) is inherently endowed with the right to apply for a patent.

Article 7 of the Taiwan Patent Act prescribes that in the circumstance of inventions made for hire, although the right to apply for a patent and the patent right are vested in the employer or the fund provider, the inventor(s) concerned is entitled to a right to show his name for the inventorship.

Paragraph 5 of Article 96 of the Patent Act prescribes that when the inventorship of a patent is

infringed, the inventor(s) concerned may request to have his/her name indicated or take other measures necessary to recover his/her reputation regarding the inventorship.

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?

Taiwan Patent Act does not exclude the inventorship of person who has made conceptual contributions to the substantive features of the invention. Therefore in this case, both person A and person B, or either one of them, can be considered as the inventor(s) because they are supposed to take the efforts to make the invention. Neither the citizenship of the inventor(s) nor the jurisdiction in which the invention is made is relevant to the inventorship of a patent application.

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:

No, the inventorship is determined based on the entire invention and the patent application as a whole. There is no break down of the inventorship on a claim-by-claim basis, or the drawings, or the examples of embodiments.

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

no

Please comment:

No, the citizenship of the inventor(s) is irrelevant to the inventorship of a patent application.

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, the residency of the inventor(s) is irrelevant to the inventorship of a patent application.

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?:

Yes, the inventorship of a patent application can be corrected after the filing date. However, such correction will affect the establishment of the original filing date, such that when the inventor was person A but then changed later to person B, the filing date will be changed to the date when person B is corrected as the inventor.

There is no time limit for the correction of the inventorship of a patent application, or an issued patent. However, the requirements for the change of the inventorship of a patent are stated below:

- To add inventors, the supporting document for the added inventor(s) and the letter of consent for adding the inventor(s) executed by all of the inventors after addition shall be provided.
- To delete inventor(s), a statement indicating that the inventor(s) to be deleted is not the exact inventor(s) to the invention shall be provided.
- For correction of the inventorship, the reason for incorrect recitation (e.g. translation or typographical errors) and the corresponding supporting documents shall be provided.

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 wrongfully recorded inventorship will not jeopardize the enforceability of an issued patent. According to the Patent Act, the incorrect inventorship is not one of the available grounds for patent invalidation, regardless the incorrect inventorship was recorded intentionally or unintentionally. The legal liability for the actual inventorship shall fall on the applicant of the patent application.

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:

No, there is no restriction that a patent application has to claim an invention made, as a whole or in part, to cover all or any specific field of technology, in Taiwan, nor any requirement that a foreign filing license for filing patent applications outside Taiwan is needed.

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?

no

If no please comment:

No, there is no legal requirement or restriction for an invention made, or at least in part, in Taiwan shall undergo a secrecy review first, before filing a patent application in another country.

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?

Taiwan Patent Act stipulates that an inventor, or his assignee and successor, is entitled to file a patent application. But the entitlement to apply may be other persons when agreed or stipulated to the otherwise. Beyond that, there is no further provision or guidance as to who else should be named as the inventor(s) of a patent application, or which part of the invention shall belong to the specific inventor(s).

Nevertheless, it is always optimistic to have the law prescribing definite rules for the inventorship to a patent, so that the patent applicants or inventor(s) may have a clear guidance to comply with and state the exact inventorship accordingly.

- 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?

Our patent law has no first filing requirement. This question is not applicable in Taiwan.

- 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?

Our patent law has no secrecy review requirement. This question is not applicable in Taiwan.

- 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.

Our patent law allows multinational inventorship to a patent application.

III. Proposals for harmonisation

- 12) Is harmonisation in this area desirable?

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.

- 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).

- 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.

- 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.

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

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

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.

Summary

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

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