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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 Israel, patent rights are regulated by the Patents Act, 5727-1967 ("**the Patents Act**").

The Patents Act does not provide a definition for the term "inventor"^[1], which has therefore resulted in the term's development by case law. However, to date, no binding Supreme Court precedent has been set that defines the term or demonstrates how the term ought to be defined. Guidance in this vein is drawn from a District Court's decision on an appeal over the Israeli Patents Registrar (hereinafter: "**Registrar**") in the case of CA 49328-10-10 *Shahal Telemedicine Ltd. v. Eli Oren* (2011) (hereinafter: "**Shahal**").

In the *Shahal* case, the court applied the approach adopted by and the precedents used in U.S. courts^[2] and that of the U.K. House of Lords (as it was then)^[3], after holding that they were in line with basic principles of the Patents Act, and **ruled that an inventor is a person who contributed to the conception of an invention (namely, the inventive concept underlying the invention) as distinguished from a person who merely contributed to the subsequent development of the invention (namely, to the invention's reduction to practice).**

To establish whether such contribution had been made, the court ruled that the essence of the invention must first be defined. The court further held that when it comes to defining the essence of

the invention, the overall general impression of the patent application should be given primacy, without giving the claims priority over the specification^[4].

In this case, both person A and person B would have to demonstrate their contribution to the conception of the invention in order to be considered inventors.

In this context it should be noted that, while in the *Shahal* case the court did not directly or explicitly address the question of joint inventors *per se*, it did quote from the **Ethicon** case stating that "[each] joint inventor must generally contribute to the conception of the invention", and by having done so, invited future courts to cite this reference when confronted with cases involving joint inventorship.

Footnotes

1. [^] It should be further noted that the Patents Act does not define what an "Invention" is nor at which point in time the invention is conceived.
2. [^] The court reviewed *Murdock Webbing Company, Inc. v. Dalloz safety, Inc.*, 213 F.Supp. 2d 95, 95 (2002) and several cases that preceded it, *inter alia*, *Edison v. Foote*, 1871 C.D. 80; *Burroughs Wellcome Co. v. Barr Laboratories Inc.*, 40 F.3d 1223 (1994); *Oren Tavory v. NTP., Inc.*, 297 Fed. Appx. 976 (2008); *Ethicon v. US Surgical Corporation*, 135 F.3d 1456, 1460 (1998) ("Ethicon").
3. [^] *Yeda Research and Development Co. Ltd. v. Rhone Poulenc Rorer International Holdings Inc.* [2008] RCP 1.
4. [^] *Relying on the Supreme Court's judgment in CA 407/89 Zuk Or Ltd. v. Car Security Ltd.* (1994).

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?

yes

Please comment:

As stated above, the court in the *Shahal* case found that the inventive concept, contribution to which is necessary to be considered an inventor, should be defined based on the entire patent application, without the claims having priority over the specification.

The prevalent opinion of the practitioners is that when an invention **disclosed** is **not claimed**, the inventor of the disclaimed invention is not entitled to be named as an inventor. However, there is no express and clear precedent to that effect.

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

no

Please comment:

There is no limitation as to the citizenship of the inventor^[1].

Footnotes

1. [^] *There is, however, legislation external to the Patents Act that is not specific to intellectual property or patents: namely, the Commerce with the Enemy Ordinance, 1939. This Ordinance provides that in order to prevent payment to an enemy and in order to maintain possession of enemy property, the Finance Minister is permitted to appoint an executor over property in Israel belonging to a citizen of*

or a company incorporated in a country declared to be at war with Israel, and, inter alia, provide the executor with the authority to seize property and maintain possession thereof until said country is no longer at war with Israel.

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:

The question of whether the law of inventorship depends on where the invention was made is not regulated by the Patents Act nor has it been raised in courts.

In one case^[1] an Israeli Court issued an anti-suit injunction and held that an Israeli Court has jurisdiction to adjudicate a dispute concerning inventorship and ownership of an invention claimed in a U.S. patent that was allegedly based on trade secrets misappropriated in Israel. The court held that the forum that should try the dispute is the forum that has the closest connection to the case at hand (based on the pertinent factors). However, the court did not decide, in its said decision, which substantive law should be applied, whether Israeli law or U.S. law.

Footnotes

1. [^] CC 292/03 *Weiss v. Zumeris (TA Dist., 2004)*; approved - CA *Zumeris v. Weiss (Sup.Ct., 2004)*.

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?:

There is no obligation in the Patents Act, to state the name of the inventor(s). However, inventorship can be mentioned on the application and can be corrected after filing in one of two ways:

- **Section 39** of the Patents Act provides that an inventor of an invention subject of a patent application, or a surviving relative thereof, can demand that his/her name be mentioned as an inventor.
- **Section 40** provides that if an inventor or a surviving relative demanded that his/her name be mentioned, while not owning the invention or the patent, the Registrar will give notice to the owner thereof to the patent or invention owner, and if an opposition was filed with respect thereto, to all parties of that proceeding.

Section 80 of the Patents Regulations provides that the Registrar will give said notice as soon as possible after filing the motion; Section 81 provides that an objection to such motion can be filed within one month of receiving the notice and all rules and regulations that apply to filing an opposition to a patent shall apply. If an objection is filed, the Registrar shall decide on the request after hearing statements from all concerned parties.

The Patents Act does not provide a specific procedure for removing a name of a person erroneously named as inventor. However, it seems that general provisions that apply to amendment of errors in the Patents Registry could be applied to this end as well.

There is no provision in the Patents Act or its regulations placing a limit on the time allotted for filing a motion to list a person as an inventor. **Section 80** of the Patents Regulations^[1] states that if the motion is filed within one month of publication of the acceptance, the Registry, patent's specification and certification will display the name of an inventor. However, the language of the provision does not

disallow the motion from being filed after one month has passed.

Footnotes

1. [^](#) *Patents Regulations (Office practice, Rules of procedures, Documents and Fees), 5728-1968 (hereinafter: "the Patents Regulations")*.

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?

As mentioned above, there is no obligation under Israeli law to mention an inventor(s)'s name on a patent application. Thus it appears that an error *per se* in the stated inventorship yields no consequences.

It could be argued that if one were to be able to show that an error was done in bad faith, with the intention to deceive, there should be consequences affecting the patent (e.g., rendering the patent unenforceable); however, there is no precedent to that effect^[1].

Footnotes

1. [^](#) *We do not address consequences under other non-patent legislation. For example, defrauding the patent office with respect to the inventorship and ownership of the patent in order to conceal assets or avoid taxes may result in criminal liability.*

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.:

Patent applications in certain technical areas and/or where the invention was invented by a state employee may not be filed outside of Israel unless otherwise permitted or stipulated.

The arrangements concerning secrecy reviews and first filing requirements are provided in part one of Chapter F of the Patents Act, which deals with the powers required for maintain the security of the country.

As explained below, a duty of first filing may result from:

(1) with respect to inventions in certain fields of technology - Citizenry, residency, owing a duty of loyalty to the State; or

(2) regardless of the invention's field of technology - the applicant being a State employee.

Field of technology:

- **Section 98** of the Patents Act prohibits foreign first filing of patent applications claiming an invention in the areas of weaponry, ammunition, or others of military value as well as applications determined by the Minister of Defense (hereinafter: "**MoD**") to be subject to a "secrecy review" in accordance with Section 95 of the Patents Act (see further detail in the answer to question (7) below).
- **Section 103** of the Patents Act prohibits foreign first filing of patent applications claiming an invention in nuclear-related technology.

Who is the applicant?

- The field of technology first filing requirement (Sections 98 & 103 above) applies to applicants who are one of the following: an Israeli citizen, permanent resident of Israel, or a person who owes a duty of loyalty to the state (which applies to both individuals and companies). If none of these apply, then the patent application may be filed abroad.
- **Section 138** provides that State employees and similar persons^[1] are required to file patent applications for any of their inventions first in Israel, regardless of the field of technology.

Miscellaneous

Multinational inventions: The Patents Act does not expressly provide that the first filing requirements apply only to inventions conceived in Israel. Literally read, the language of the law is capable of being interpreted as applying to inventions conceived abroad.

Other Dissemination: It should also be noted that the Patents Act only deals with filing an application and not with its assignment or publication. The rules governing assignment and publication (specifically with respect to censorship) are external to the Patents Act and are not specific to intellectual property or patents. For example, The Defense Export Control Law, 5766-2007, which, amongst others, prohibit conducting a defense marketing activity^[2], exporting of defense equipment^[3], transfer of defense know-how^[4] through any means or provision of a defense service, without first obtaining the requisite approvals.

Footnotes

1. [^] *The list is provided in section 137: a State employee, a soldier, a policeman, an employee of several state-owned agencies, or any other person receiving a salary from such agencies who invented an invention during his/her employment or service or within a year following its termination.*
2. [^] *An activity aimed at promoting a defense export transaction, including brokering activity towards a defense export transaction.*
3. [^] *Missile equipment, combat equipment and controlled dual-use equipment (namely, materials and equipment initially intended for civilian use and which are also compatible for defense use).*
4. [^] *Information that is required for the development or production of defense equipment or its use, including information referring to design, assembly, inspection, etc.*

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.:

Subsections (1) and (2) of section 98 provide that applications specified therein (see answer to question (6a) above), including applications subject to secrecy review according to Section 95, may be filed abroad only if;

(1) the applicant was first granted a written permission from the MoD; or

(2) if the applicant first filed an application in Israel and six months have lapsed from the filing date of the Israeli application and the MoD did not issue a secrecy order or such order has been issued and is no longer in force.

It should be noted, that according to Section 95 (to which the provisions of subsections (1) and (2) of section 98 apply) the MoD must render a decision with respect to applications subject to secrecy review within four months. However, the provisions of subsection 98(2) prescribe a six months waiting period from the filing date.

The same procedure, specified in subsection (1) and (2) of section 98, applies with respect to applications where first filing is required according to section 103 (nuclear research), however permission will be granted from a Minister designated by the government, who is currently the prime minister of Israel.

Section 138 provides that civil servants cannot file a patent application outside of Israel unless permission to do so has been granted by a Civil Service Commissioner or another person certified to do so, or six months have lapsed from having given notice of intent to file such application to a Civil Service Commissioner, and it has not been determined that the rights in the invention were assigned to the state or a factory or an institution of the state in which he worked.

The cost of obtaining a foreign filing license is not specified in the Patents Regulation or any other related secondary legislation, and is subject to the discretion of the appropriate office.

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?

no

Please comment.:

We are not familiar with cases that allowed for the obtaining of a foreign filing license retroactively.

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?

As noted above, the Patents Act might apply to inventions conceived by Israeli citizens residing outside of Israel. It follows that patent applications claiming an invention that was made jointly in Israel and with another inventor in another country are also subject to first filing requirements. The nationality of the patent owner does not affect the answer to this question.

This state of the law may result in inventors finding themselves in a "Catch-22" scenario. For example, if the invention was conceived by two inventors, an Israeli inventor and a U.S. co-inventor, and the laws of each country require that the invention be filed first in their country, it is not possible to file in **any country** without violating the first filing requirement. The nationality of the inventors does not seem to play a role here.

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?

no

Please comment.:

It seems that the Patents Law does not prohibit this. Whether or not external laws, such as the Defense Export Control Law, are violated depends of the factual circumstances of the case.

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

Violation of these provisions is a criminal offense. Section 193(a) states, *inter alia*, that failing to comply with the provisions of sections 94, 98, 99, 103, 137 and 138 is punishable by incarceration for up to two years or by receiving a fine.

Criminal liability requires criminal intent (*mens rea*). It would therefore seem that whether the error was intentional or inadvertent is consequential.

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

yes

If yes please answer the following questions.:

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

Yes.

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

Section 95 of the Patents Act empowers the MoD, if it deems necessary, to instruct the Registrar to provide a person designated by the Minister with copies of patent applications of certain types. It also authorizes the Registrar to provide the Minister with copies of applications whose contents relate to or concern the defense of the country or a defense secret. This empowerment allows the MoD to determine whether a secrecy order should be issued in respect of these applications (in accordance with the provisions of section 94; see below).

The list with the types of applications that the MoD may request from the Registrar, or copies thereof, is kept confidential and remains not published.

The MoD must decide within four months whether applications brought before him/her fall within with the purview of Section 95; and if no decision is made, or the allotted time has lapsed, no action will be taken by the Patents Office in respect of the application other than confirmation of its filing.

Section 94 of the Patents Act provides that the MoD is permitted, for purpose of defense of the country including protection of its defense secrets, to issue an order which: (1) instructs the Registrar to refrain from or postpone performing a certain action that it is required/entitled to do by law with respect to an application; (2) prohibits or limits the publication or disclosure of information of an application or information disclosed therein.

According to the provisions of **section 99** the same procedure prescribed in section 94 applies to nuclear related inventions (however, the power to do so is vested in a Minister designated by the government, who is currently the prime minister of Israel).

Section 96 allows the applicant, if he/she wishes, to appeal a secrecy order while it is in force, before a certain tribunal. If there is a change in circumstances, the applicant may lodge an

additional appeal.

In addition, the MoD is required (as a rule of administrative law) to periodically review, at its own initiative, the necessity of continuing to maintain the secrecy order.

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

As regards the applicant, see answer to question (6f) above.

As regards the State, in one instance the State was ordered to compensate an applicant for failing its duty to periodically review the necessity of continuing to maintain the secrecy order.

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 mentioned in the answer to question (1) above, the Patents Act does not provide a definition for the term "inventor" or "inventorship" and there is a paucity of case law to draw clear guidance from.

We believe that it should be clarified or otherwise determined that when an invention **disclosed** is **not claimed**, the inventor of the disclaimed invention is not entitled to be named as an inventor.

Further complication arises simply due to the fact that the process of invention and innovation is a complicated process in itself, and it is difficult to determine whether a contribution made during the process is sufficient to award a certain person with the title of "inventor". However, we do **not** recommend providing a detailed definition of the term "inventorship". At this stage, the term would be best developed by case law.

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?

Yes. As explained above, certain provisions in the Patents Act require first filing with respect to specific areas of technology and specific personnel; however, the Patents Act does not provide a mechanism designed to reconcile contradictory first filing requirements in other jurisdictions. Consequently, one of the inventors of a multinational invention, which is subject to two sets of laws, will necessarily find himself in fault.

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 same answer as the answer to question 9 above applies, as the Patents Act does not provide a mechanism designed to reconcile contradictory secrecy review requirements in other jurisdictions nor does it regulate a situation in which an inventor is required to file a request to obtain a foreign filing license while the application might be subject to a secrecy order.

11)	<p>Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.</p>
	<p>Yes.</p> <p>In addition to creating a mechanism for reconciling contradictory first filing requirements, there should also be a mechanism designated to determine which law would apply to the application at hand.</p> <p>For example, if an invention is filed in Israel by two inventors, one from Israel and one from Country X, and say the term of "inventorship" is defined differently in the two countries (for example, under Israeli law, both parties are co-inventors, whereas in Country X's law, only the Country X inventor is an inventor), then the questions that arise are: Which law do we apply? What would be the criteria in applying such law?</p> <p>We believe that the law governing multinational inventions should be the law of the country in which it was conceived and in cases where the place of conception is not clear, inventorship should be determined based on the law of the country in which the first priority application was filed.</p> <p>As mentioned above, there is no time period for filing a motion to mention an inventor's name. Other sections of the Patents Act provide that the statute of limitation does not apply to, for example, filing a motion to revoke or amend a Patent Term Extension order (Section 64(11)). We believe the same rule should apply with respect to filing a motion to mention an inventor's name.</p>

III. Proposals for harmonisation

12)	<p>Is harmonisation in this area desirable?</p>
	<p>yes</p> <p>Please comment.:</p> <p>Due to the effects of globalization on intellectual property rights, in particular, the international nature of the present-day market and the extent of collaboration between different corporations, which often results in multinational inventions, there is a need to harmonize certain aspects of the law of inventorship.</p> <p>By way of clarification of the foregoing, we note that the most pressing need we see is a need for harmonization of the rules guiding the choice of applicable inventorship laws (our proposal in question 11 would also serve as an appropriate international standard). Such legal harmony will provide the innovative industry with due certainty regarding the inventorship (and consequently ownership) of inventions. We do not see a pressing need for harmonization of substantive inventorship law.</p>

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)	<p>Please provide a definition of inventorship that you believe would be an appropriate international standard.</p>
	<p>The standard developed under U.S. law is appropriate.</p>

14)	<p>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).</p>
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We suggest that it should be possible to correct an error in the identification of inventorship (except in cases of intent to mislead) in a simple procedure, which is not time barred.

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.

With respect to questions 15 (first filing requirements), 16 (secrecy review requirements) and 17 (obtaining a foreign filing license), it would hypothetically be beneficial if there would be a mechanism that would allow applicants of multinational inventors swiftly to obtain a pre-ruling accepted by all relevant countries, regarding the country in which first filing would be made. On a practical level, we doubt that this is achievable.

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.

See answer to question 15 above.

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

See answer to question 15 above.

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.

Discretion in this matter should be left with the country that its law would apply.

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

The term "inventorship" is not defined in the Israeli Patents Act. It has thus been developed by case law, according to which an inventor is a person who contributed to the conception of an invention. Case law has further determined that the inventive concept should be defined based on the entire patent application, without the claims having priority over the specification. However, we believe that it should be clarified or otherwise determined that when an invention **disclosed is not claimed**, the inventor of the disclaimed invention is not entitled to be named as an inventor.

The Israeli Patents Act sets out first filing requirements which may result from: (1) Who is the applicant? And (2) What is the field of technology? In addition, Israeli patent applications are subject to a secrecy review. The Patents Act does not provide a mechanism designed to reconcile similar requirements in

other jurisdictions. We believe that the law governing multinational inventions should be the law of the country in which it was conceived and in cases where the place of conception is not clear, inventorship should be determined based on the law of the country in which the first priority application was filed. Also, we believe it would be beneficial if there existed a mechanism that would allow applicants of multinational inventions to obtain a swift pre-ruling, accepted by all relevant countries, regarding the country in which first filing would be made.

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

AIPPI