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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?

1) The applicable law is the *Rijksoctrooiwet 1995* (Dutch Patent Act, hereinafter DPA). Dutch law does not define inventorship. It merely provides that the inventor is entitled to the patent. The law assumes that he who applies for a patent is the inventor (Art. 8 DPA).

The European Patent Convention (EPC) also does not provide a definition of "inventor" or "co-inventor" and Art. 74 EPC provides that unless provided otherwise, the European patent application as an object of property shall, in each designated Contracting State and with effect for such State, be subject to the law applicable in that State to national patent applications.

1a) Dutch law does not distinct between inventors located in or outside the Netherlands. So if either person A or person B would apply for a patent, he is considered the inventor. Further in this report, more attention will be paid to the possibilities and requirements for claiming to be mentioned as

inventor in the patent and for claiming ownership of the patent application/patent. The law (Art. 13 DPA) provides that if the invention is made by several persons, who cooperated as a team, they together are entitled to apply for a patent. This will result in a patent that in its entirety is co-owned by the members of the team. Such co-owners can be located in different countries.

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:

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

no

Please comment:

Dutch law of inventorship does not depend on the citizenship of the inventor(s). In the Netherlands, any natural or legal person can, regardless of nationality and/or place of residence, apply for a patent.

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:

Dutch law of inventorship does not depend on where the invention was made (e.g. on the residency of the inventor(s)).

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?:

Under Dutch patent law, inventorship can be corrected after the filing date. An inventor can be added, removed or corrected.

Art. 38 section 2 DPA provides that if the identification of the inventor in the patent application is incorrect, or if a person other than the inventor has declared that the inventor does not wish to be identified as such in the patent, the applicant and inventor may jointly request the Patent Office in writing to make the necessary corrections. In so far as applicable, the request has to be accompanied by written consent of the person wrongly designated as the inventor. There are no time limits for such a correction.

The request should be accompanied by an original deed containing a statement that the details of the inventor(s) are incorrect, the details of the inventor that has to be removed, or if applicable, the name of the inventor that has to be added (or a statement of this inventor that he does not wish to be identified as such in the patent).

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 an error in the stated inventorship leads to an error regarding entitlement (e.g. based on the assumption in Art. 8 DPA), the party entitled to the invention and/or its licensees and/or its pledgees in case the entitled party has obtained a patent for the same invention (Art. 75(1)(e) jo 75(3) DPA) may claim invalidity of the patent. The relevant provisions concern ¹

- a. subject matter taken from another party without that party's consent (Art. 11 DPA);
- b. employees' inventions; inventions made in the course of education; and inventions resulting from research in the service of a university, college or research establishment (Art. 12 DPA);
- c. inventions made by several persons working together under an agreement (Art. 13 DPA). Footnotes

1. ¹ See Art. 60(1) EPC in case of European patents.

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.

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.

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?

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?

Dutch law contains a provision regarding defence-related inventions which could have such effect. This provision - Art. 46 DPA - stipulates that if the applicant knows or should reasonably know that the invention should remain secret for the sake of the security of the Kingdom and/or its allies, the applicant must file a European patent application with the Dutch Patent Office first. It is then up to the Minister of Defence to decide whether the invention must remain secret or whether the application can be forwarded to the EPO. Art. 46 DPA is as such in line with Art. 75(2)(a) EPC. ¹ ²

The Netherlands has not made use of the possibility provided by Art. 75(2)(b) EPC. Hence, Dutch law does not require an application for a patent claiming an invention made in the Netherlands to be filed in the Netherlands first or to require prior authorisation to file in another country.

Footnotes

1. ¹ The article was added to the DPA in 1978 on basis of an agreement of NATO countries (Oct. 21, 1960).
2. ² The article lacks a reference to a PCT application.

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?

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

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?

Only European patent applications must be filed with the national authority *'if the applicant knows or reasonably should know that the content thereof should be kept confidential in the interest of the defence of the kingdom or its allies'* (Art. 46 DPA).

Hence, the law is not technology specific.

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

Following filing of the application, that is forwarded without delay to the defence minister. A government decision is due -at the latest- three weeks prior to the deadline for forwarding applications to the EPO (Art. 77 (3) EPC and R. 37).

If the application is ordered to remain secret, it will not be forwarded to the EPO. Such an application will be deemed to be withdrawn after 14 months following the filing date or priority date (Art. 77 (3) EPC). The applicant can request conversion of his application to a national application, as set out in Art. 135-137 EPC and implemented in Art. 47 and 48 DPA. Payment of a national filing fee and a Dutch translation is required.

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

Generally speaking, any applicant acting against state secrecy interests will risk incurring penal sanctions threatened against disclosing or making public state secrets (i.e. 'information that is to be kept secret in the interest of the state and its allies'). An intentional breach is more severely punishable than an inadvertent but culpable offense (Art. 98 and 98a Penal Code).

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 DPA does not define inventorship. In particular, the DPA does not provide applicants with clear guidance as to who should be named as the inventor(s) of a patent application. Therefore, this question does not apply.

If the question of inventorship is at stake, in case of entitlement issues, it is a matter of factual debate in court proceedings - case law from lower courts only. If inventorship would be defined in the law at the

filing date, the debate would still be about the same after grant (and possibly opposition or nullity proceedings).

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?

As discussed with respect to question 6 the only first filing requirement in Dutch law relates to defence-related inventions. For such inventions it should be made possible to also file in other NATO allied countries.

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?

No, see under 9.

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, we have not identified other issues than the ones described under Questions 8-10.

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.

1. None of the following treaties provides for a definition of 'an inventor':

- the Paris Convention
- the TRIPs agreement
- the Patent Cooperation Treaty
- the European Patent Convention
- the Agreement on the Unitary Patent
- the Unitary Patent Regulation.

2. Also the DPA is silent on the definition of 'an inventor'.

3. In providing for an international standard, we believe one of the key components should be that this is a person who conceived or – in case of multiple inventors – contributed to the conception of the (claimed) invention underlying the invention, so to distinguish from persons who merely contributed to auxiliary aspects of the invention.

4. The concept underlying the invention will normally be the aspects of the invention which are novel

and inventive in view of the prior art (provided of course that clarity and enablement requirements are met). Hence, this will be highly dependent on the specific merits of the case, which can be best assessed by the patent offices and/or the competent courts. Therefore, the Dutch group proposes not to precisely define the underlying inventive concept.

5. We propose to adopt the principle that the ones actually mentioned as inventors in the patent application, should be presumed to indeed be the inventors. This is also in line with the principle that the applicant of a patent is presumed to be entitled to the patent (see e.g. Art. 4A1 Paris Convention, Art. 87 (1) EPC, and Art. 19 Implementing Rules EPC).
6. In case of multiple inventors there might be an issue regarding the applicable laws to establish the inventive concept underlying the invention. In order to solve possible issues of private international law, the Dutch group proposes that this assessment has to be made by the patent offices or the competent courts applying their 'normal' laws when deciding on the validity of the patent (application).
7. The considerations above lead us to the following definition of 'inventor':
 - a. A person who is mentioned as an inventor on the patent application, is presumed to be an inventor of all aspects of the invention, until and as far proven otherwise by a third party challenging this presumption in accordance with the principles set out in the next paragraphs.
 - b. An inventor is a person who conceived the concept underlying the invention. If more persons contributed to the invention, an inventor is a person who contributed to the conception of the underlying inventive concept of the invention.
 - c. The concept underlying an invention are the features of the invention which are considered to be novel and inventive in view of the prior art at the time of filing the patent application - see also the consideration above under 13.6 with regard to the competent authorities to decide upon such issue usually at a much later stage.

- 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).

It is assumed that if the inventors apply themselves, each of the applicants/inventors will have full knowledge of their status as a co-inventor. Any material correction of inventorship (i.e. adding and/or deleting of an inventor) should be unlimited in time.

- 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.

NATO member states should allow filing in every member state.

- 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 under 10 and 15.

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

A foreign filing license should be needed only in countries outside NATO to be issued by NATO

headquarter in Brussels.

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.

This should be dealt with by national law; if an error is made in spite of all due care such error should be repairable retroactively.

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.

NATO members, esp. USA and France, should allow patent applications to be filed in NATO allied states without a foreign filing license.

Summary

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