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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?

These questions have been answered in view of the New Zealand Patents Act 2013, which was enacted in September 2014. Many pending applications fall under the previous Patents Act 1953, which contained different provisions around inventorship. For example, the 1953 Act required foreign filing permits, which are no longer required under the 2013 Act.

The country of conception or nationality of the inventors is not relevant in determining inventorship. Person A and/or person B may be inventors if they contributed to devising the invention.

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:

Section 5 of the New Zealand Patents Act 2013 defines inventor as 'the actual deviser of the

invention'.

The meaning of 'invention' is not explicitly defined in the Act. The Act does not state whether 'invention' refers to the full disclosure or is limited to the claimed invention. 'Invention' may be interpreted to be what is claimed, because the exclusive rights given by the patent as outlined in section 18 of the Act refer to the invention but would be determined by reference to the claims of the patent. However, the Act refers at different points to language such as 'describe the invention', 'disclose the invention' and 'the invention claimed'.

The Act does not specify if inventorship is determined by the claim content or the whole disclosure. Patentability is specifically defined in relation to 'invention **so far as claimed**'. The language 'so far as claimed' is not used in relation to the invention or inventors.

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

no

Please comment:

The citizenship of the inventors is not relevant to inventorship in New Zealand.

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 country of conception is not relevant to inventorship in New Zealand.

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?:

By way of a correction of error under section 202(2) of the Act. There are no prescribed time limits.

The application for a correction of error or omission must include

- a statement that (i) identifies where the error or omission is thought to have been made; and (ii) includes either a description of the error or omission or a copy of the entry in the patents register, patent, patent application, or other document (as the case requires) with the error or omission clearly identified; and
- evidence (if any) in support of the application.

The correction of error is advertised and subject to an opposition period.

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?

Grounds of challenge that could potentially be relevant in this situation are that the nominated person is not entitled to the patent and/or the grounds of obtaining or attempting to obtain the grant of a patent by fraud, false suggestion, or a misrepresentation.

In the two month period (extendible to three months) after a complete specification becomes open to public inspection, a person can make a request under section 190 of the Act to be named as an inventor in a patent, specification, and patents register. The Commissioner of Patents will name that person as inventor under section 190 if they are satisfied (section 189):

(a) that the person in respect of whom, or by whom, the request or claim is made is the inventor of—

(i) an invention for which a patent application has been made; or

(ii) a substantial part of an invention for which a patent application has been made; and

(b) that the patent application is a direct result of that person being the inventor.

The request must be accompanied by a statement setting out the facts relied on. A request can also be made to the effect that another person should not have been mentioned as an inventor.

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:

Under the 2013 Act this is not required. Under the 1953 Act a person resident in New Zealand could not file an overseas application in any technical area without either first filing in New Zealand or requesting a foreign filing permit. All new applications are filed under the 2013 Act.

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:

Under the 2013 Act this is not required. Under the 1953 Act a person resident in New Zealand could not file an overseas application in any technical area without either first filing in New Zealand or requesting a foreign filing permit. All new applications are filed under the 2013 Act.

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?

There is no clear definition or guidance concerning what contribution is required to be considered the 'actual devisor' of an invention. Further, it is not clear if the Section 189 requirements for being named as an inventor are intended to define what is mean by 'actual devisor', or if those requirements are a subset.

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?

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?

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.

III. Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Please comment.:

Multi-country collaboration is becoming more common. Harmonisation is desirable to prevent conflicting inventor obligations in various countries preventing inventors from obtaining patents or increasing the compliance burden.

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

The Patents Act 2013 defines an inventor with reference to an invention, but does not define the meaning of 'invention'. The Act does not specify if inventorship is determined by the claim content or the whole disclosure. Citizenship or country of conception are not relevant to inventorship in New Zealand. There are no foreign filing limitations in the Act.

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

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