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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?

As such, inventorship is not defined in any Norwegian statute or regulation, and there is no case law defining the term.

Section 1 of the Norwegian Patents Act provides that he or she who makes an invention that can be applied industrially, or his or her successor in title, shall have the right, on application, to be granted a patent for the invention. The only help afforded by this provision is that it clarifies that to be an inventor, you must have made an invention.

One could say that the case law is actually clearer as regards the concept of co-inventorship than inventorship, see our answer to Question 5) below.

The relevance, in general terms, of where the persons that are involved in the research and other activities that lead to an invention are located when the invention is made, is discussed in our answers to Question 3.

Directing somebody's efforts does normally not qualify as making an invention. To be a sole inventor, the person needs to come up with the solution to the technical problem in hand. To be a co-inventor, it suffices to provide an independent intellectual contribution to the invention, see our

answer to Question 5 below.

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:

As mentioned, in Norway there is no law defining inventorship. It rarely happens that inventorship is determined on a claim by claim basis, but it appears conceivable to do so.

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

no

Please comment:

If the applicable law has to be determined by deciding to which country the invention has the closest connection, the citizenship of the inventor(s) will be one of the elements to consider, but not the only one.

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, however it may be relevant when deciding the applicable law.

There is no Norwegian statute that directly governs this issue. The Norwegian Employee Inventions Act provides some guidance, indirectly. Nor is there is any case law determining this question.

The Norwegian Employee Inventions Act, under which Employers have a right to have assigned to them rights in and to patentable inventions made by Employees, applies regardless of where (in which country) the invention was made, as long as the employment contract is governed by Norwegian law. It appears reasonable to take that to mean that, if the inventor is not an employee, the questions relating to entitlement to an invention are to be decided applying the law of the country where the invention was made.

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 are no time limits for correcting the inventorship of an application during prosecution.

The procedure is for the applicant to inform the NIPO in writing. There is no express requirement in the Patents Act or regulations that the originally indicated inventor(s) should approve or consent to the correction, if the applicant is not the inventor or does not represent all inventors. There is no case law to give guidance on this. However it could be argued that a correction of the inventorship, since it implicitly changes the originally recorded inventor's or in inventors' inventorship share(s), would require all inventors' consent.

After grant, the patent owner may correct the inventorship, and similar considerations as those

mentioned in the preceding paragraph apply.

- 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?

At the request of the party entitled to the invention, a patent application may be refused or transferred to the entitled party if the applicant is not entitled. Also at the request of the party entitled, a granted patent may be invalidated or transferred to the entitled pretender if the applicant has no proper title to the invention. In both cases, that will be the situation if the inventor stated is not the true inventor. However, a refusal of grant or an invalidation may only occur if the stated inventor has no title whatsoever to the invention. If the stated inventor was in fact a co-inventor, the pretender's remedy will be to have a share of the ownership of the invention and of the patent transferred to him/her.

Sections 17 and 18 Patents Act set out the conditions for transferring title to a patent application:

"Section 18

If anyone proves to the satisfaction of the Norwegian Industrial Property Office that he, and not the applicant, is entitled to the invention, the Norwegian Industrial Property Office shall, instead of refusing the application for that reason, transfer it to him if he so requests. The transferee shall pay a new application fee."

Section 18 should be read in light of

"Section 17

If anyone claims before the Norwegian Industrial Property Office that he, and not the applicant, is entitled to the invention, the Norwegian Industrial Property Office may, if the question is found doubtful, invite the party concerned to bring the matter before the courts of law within a specified time limit, whilst drawing to his attention that if he does not comply with this requirement, his claim may be disregarded in the further processing of the case."

It is generally accepted that the NIPO, or the courts, may order a partial transfer of the invention, meaning an ownership share, reflecting the parties' inventorship shares.

Entitlement and transfer requests concerning patent applications were mentioned in the main preparatory works of the Patents Act, the joint Nordic travaux préparatoires on the Patents Acts in the Nordic countries, which was published in 1963 (NU 1963:6). The report explains the reasoning behind the proposal to introduce the provisions, but provides no guidance on what the test of entitlement should be (section 18), nor on when the question should be considered doubtful enough for the NIPO to refer the petitioner to institute court proceedings (section 17). However, there is not much else that gives guidance on the application of these provisions.

This is also true of requests for transfer of an issued patent, which are governed by section 53 Patents Act:

"Section 53

If a patent has been granted to someone other than the party entitled thereto under section 1, the court shall, if the entitled party so claims, transfer the patent to him."

The case law concerning transfers of patent applications and transfer of granted patents is also scarce.

A court decision sometimes referred to is a judgment handed down by the Borgarting Court of Appeal in 1988, which concerned entitlement to a granted patent. It states that as a basic rule, for a request for a transfer of the patent to be successful, the pretender should be found to have made a ready invention, which satisfies in itself the requirements of novelty and inventive step, and that the invention of the patent-in-suit, essentially, originates from the materials of the pretender. There is reason to believe that the same test would be applied today when deciding a request for the transfer of a patent application, albeit some have said the test applied in that case was severe on the pretender.

A test for establishing whether a pretender can be recognised as a co-inventor has been set out in some judgments of the district and appellate courts. This test, which is generally accepted in legal doctrine also, requires that to be a co-inventor, you must have made an independent intellectual contribution to the invention. A merely practical contribution does not suffice. However there is no requirement that the contribution made should constitute an invention in its own right. It could suffice if one party has defined the problem, whilst another party has found the solution. The contribution need not be substantial, but insignificant efforts do not qualify.

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.:

Under the Act on Defence Inventions (LOV-1953-06-26-8 om oppfinnelser av betydning for rikets forsvar), anyone who wishes to exploit a defence invention, must either disclose a full description to the Ministry of Defence or file a patent application. The Patent Office will notify the National Security Authority of any patent applications which it considers may cover a defence invention.

Defence inventions are Inventions of importance to the defence of the Realm, provided they are

- made in Norway, or
- the subject of a patent application filed in Norway, or
- owned entirely or in part by someone domiciled in Norway, or if
- someone domiciled in Norway has the right to use them.

Once informed, the National Security Authority will have 4 months (can be extended by 3 months) to decide whether the invention is to be kept secret, and if a patent application has been filed, that the application and any patent issued, should be secret. If that is the situation, the application will not become public. Defence inventions must not be disclosed until the National Security Authority has decided to lift the secrecy. Filing a patent application in other jurisdictions constitutes a disclosure to third parties, and will also lead to full disclosure when the application becomes public. Hence, in actual practice, the inventor of a defence invention, and his successors in title, will be prevented from filing anywhere else than in Norway.

The Defence Inventions Act empowers the Government to make reciprocal treaties with foreign states to the effect that, subject to application in each individual instance from a competent authority of that foreign state, an invention important to the foreign state's defence and which is the subject of a patent application filed in Norway by an applicant domiciled in that foreign state, will be

kept secret and that a patent granted will also be secret. There is a technical agreement within NATO that is relevant for this provision. However, the provision does not allow for any exceptions from the implicit "file first here" rule described above..

- 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.

no

Please comment.:

- 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?

See answers to questions 2 and 3 above.

- 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?

yes

Please comment.:

If the invention is a defence invention, it probably would.

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

If committed intentionally or by negligence, violations of the Defence Inventions Act are punishable by fines or imprisonment for up to one year.

- 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?

See answer to Question 6 above: under the Defence Inventions Act, the Patent Office's duty to notify the National Security Authority of any patent applications for defence inventions implies a duty to screen applications to identify those that are relevant, and which are the covered by the 4 months non-disclosure obligation, and subject to a decision, by secrecy for a longer period of time.

It should also be mentioned that the secrecy and non-disclosure obligations in the Act on Defence Inventions apply not only to patented or patentable inventions, but also to non-patentable

inventions.

This law does not depend on the area of technology disclosed and claimed, as long as the invention is defence relevant.

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

The procedure and timing are set out in our answer to Question 6. As to costs of compliance, there are no duties or charges imposed for the review.

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

Intentional and negligent violations of the Defence Inventions Act are punishable by fines or imprisonment for up to one year.

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 currently no definition of inventorship in Norwegian law. There is room for improvement in this area.

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?

See Question 10.

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?

There appears to be a need for harmonisation on this point. However, harmonisation would require that states give up some of the criteria they currently rely upon to assert their interests and right to conduct secrecy reviews before patent applications are filed in other jurisdictions. It is difficult to see why a state would be amenable to give up this right unless it is on a reciprocal basis, and with safeguards to protect its security interests.

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.

Questions 10 and 9 should be dealt with first.

III. Proposals for harmonisation

12)	Is harmonisation in this area desirable?
	<u>yes</u>
	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.
	Anyone who has made an independent intellectual contribution to an invention shall be considered as the inventor or a co-inventor of the invention. Financial or managerial or administrative support or contributions shall not be taken into consideration. The performance of routine work shall not be considered as an independent intellectual contribution, nor shall the carrying out of work under close instructions from another party. If, in the individual case, the identification of the technical problem that the invention solves adds to the inventive step, the identification of the problem may qualify as an independent intellectual contribution.

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).
	The Norwegian group proposes that the applicant should be in control of corrections of inventorship after a patent application is filed, in the sense that the applicant can request corrections of the inventorship on record, but only to the extent supported by written evidence of assignments of title to him/her and of any interested party's consent to the requested corrections. This means that, in order to register a correction of the inventorship on record, the applicant must submit: <ol style="list-style-type: none">1. Statements of consent from all the inventors whose share of the invention will be affected by the correction, and2. Assignments of title to (shares of) the invention that the applicant did not already have title to.

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.
	The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for first filing requirements.

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.
	The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for secrecy review requirements, noting that the current Norwegian legislation, and presumably the relevant legislation of many other states also is directed at all inventions, be they patented or not, patentable or non-patentable. Hence it is questionable whether harmonisation of patent laws would be sufficient or even appropriate.

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

The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for foreign filing licence.

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.

The Norwegian group does not consider it appropriate to put forward a proposal for an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing or 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.

The Norwegian group has no proposal to make at this time.

Summary

As such, inventorship is not defined in any Norwegian statute or regulation. Case law and legal doctrine appear to be aligned in requiring that to be a co-inventor, it suffices to provide an independent intellectual contribution to the invention.

Directing somebody's efforts does normally not qualify as making an invention.

It rarely happens that inventorship is determined on a claim by claim basis, but it appears conceivable to do so.

The applicable law is determined by deciding to which country the invention has the closest connection, taking into account, i.a. the citizenship of the inventor(s), the residency or place where the invention was made

The inventorship of a patent application can be corrected after the filing date.

As a general rule, Norwegian law does not require that an application for a patent claiming an invention made in Norway, be filed first here. However, if the invention is a defence invention, filing for patent protection elsewhere is unlawful, because it amounts to an illegal disclosure. Hence, in the case of a defence invention, it would violate Norwegian law if a request for a foreign filing license was filed in in another country before being filed in Norway.

If committed intentionally or by negligence, violations of the Defence Inventions Act are punishable by fines or imprisonment for up to one year.

The Norwegian Patent Office has a statutory duty to notify the National Security Authority of any patent applications that concern defence inventions, and therefore monitors filed applications to identify those that are defence related.

Harmonisation of the laws requiring first filing of inventions made in a country and a secrecy review of

patent applications to address, in particular, multinational inventions is an attractive proposition in some ways. However it appears unrealistic, to expect that states would give up their right to conduct secrecy reviews before patent applications are filed in other jurisdictions, unless it is on the basis of reciprocity.

The Norwegian Group believes the following definition of inventorship would be an appropriate international standard:

Anyone who has made an independent intellectual contribution to an invention shall be considered as the inventor or a co-inventor of the invention. Financial or managerial or administrative support or contributions shall not be taken into consideration. The performance of routine work shall not be considered as an independent intellectual contribution, nor shall the carrying out of work under close instructions from another party. If, in the individual case, the identification of the technical problem that the invention solves adds to the inventive step, the identification of the problem may qualify as an independent intellectual contribution.

The Norwegian Group proposes the following *standard for correction of inventorship after a patent application is filed*:

The applicant should be in control of corrections of inventorship after a patent application is filed, and may request corrections of the inventorship on record, but only to the extent supported by written evidence of assignments of title to him/her and of any interested party's consent to the requested corrections. This means that, in order to register a correction of the inventorship on record, the applicant must submit:

1. Statements of consent from all the inventors whose share of the invention will be affected by the correction, and
2. Assignments of title to (shares of) the invention that the applicant did not already have title to.

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