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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 Philippine Intellectual Property Code ("IP Code") does not provide a definition for who is considered an "inventor." Under Rule 40(b) of the Rules of Practice in Patent Cases [Administrative Order No. 1-93 ("AO No. 1-93")] of the Bureau of Patents, Trademarks and Technology Transfer, now the Philippine Intellectual Property Office ("IPO"), "if the multiple inventors are named in an application each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application." This provision considers as an inventor one who has made a contribution to the subject matter of at least one claim of the application. However, there is no similar provision under the Revised Implementing Rules and Regulations for Patents, Utility Models and Industrial Designs ("Revised Rules").

In view of the lack of a specific provision for who may be considered an "inventor", it is common practice to list all members of a research team as joint inventors.

For purposes of Non-Prejudicial Disclosure by inventors, Section 25.2 of the IP Code provides that the term "inventor" also includes any person who, at the time of filing of an application, has a right to the patent.

While there is no exact definition of an inventor in the IP Code, it makes a distinction between the

owner of a patent and the inventor, when the invention is made pursuant to a commission. Section 30 of the IP Code provides:

“Section 30. *Inventions Created Pursuant to a Commission.* - 30.1. The person who commissions the work shall own the patent, unless otherwise provided in the contract.

30.2. In case the employee made the invention in the course of his employment contract, the patent shall belong to:

(a) The employee, if the inventive activity is not a part of his regular duties even if the employee uses the time, facilities and materials of the employer.

(b) The employer, if the invention is the result of the performance of his regularly-assigned duties, unless there is an agreement, express or implied, to the contrary.”

Thus, under Section 30 of the IP Code, a person who commissions the work, even though he did not make the invention, owns the right to patent.

In the scenario described in Item 1(a), Section 30 applies regardless of the nationality or situs of the person commissioning the work. Hence, B - the person who made the invention, is the inventor, while A - the person who commissioned the work, is the owner of the patent.

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:

Pursuant to Rule 40(b) of Administrative Order No. 1-93, there is an apparent basis to refer to the claims for purpose of establishing inventorship. However, it is common practice to list all members of a research team as joint inventors.

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

no

Please comment:

The IP Code does not make reference to the citizenship of inventors. Thus, the same rule applies to inventors of all nationalities.

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 IP Code does not make reference to the place where the invention was made. Thus, the same rule applies regardless 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?:

Yes, the inventorship of a patent application may be corrected after the filing date.

Section 58 of the IP Code allows the correction of mistakes in an application upon request of any interested person and payment of the required fee.

“Section 58. *Correction of Mistake in the Application* - On request of any interested person and payment of the prescribed fee, the Director is authorized to correct any mistake in a patent of a formal and clerical nature, not incurred through the fault of the Office.”

Further, Section 59 of the IP Code allows changes to be made on the patent:

“Section 59. *Changes in Patents*. - 59.1. The owner of a patent shall have the right to request the Bureau to make the changes in the patent in order to:

- (a) Limit the extent of the protection conferred by it;
- (b) Correct obvious mistakes or to correct clerical errors; and
- (c) Correct mistakes or errors, other than those referred to in letter (b), made in good faith: Provided, That where the change would result in a broadening of the extent of protection conferred by the patent, no request may be made after the expiration of two (2) years from the grant of a patent and the change shall not affect the rights of any third party which has relied on the patent, as published.”

Moreover, the IPO requires the submission of documents in support of the request for correction of inventorship, such as a Deed of Assignment showing the correct inventorship, or the correct inventorship listing as shown by documents issued by other Patent Offices.

The request for correction may be filed at any time.

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?

Section 67 of the IP Code provides that if a Philippine court has adjudged that a person other than the applicant has the right to the patent, such person may, within three (3) months after the decision has become final:

- (a) Prosecute the application as his own application in place of the applicant;
- (b) File a new patent application in respect of the same invention;
- (c) Request that the application be refused; or
- (d) Seek cancellation of the patent, if one has already been issued.

Moreover, Section 68 of the IP Code provides that if a person, who was deprived of the patent without his consent or through fraud is declared by final court order or decision to be the true and actual inventor, the court shall order for his substitution as patentee, or at the option of the true inventor, cancel the patent, and award actual and other damages in his favor if warranted by the circumstances.

From the foregoing, it appears that only the true and actual inventor who was omitted as such may use the error in the inventorship as basis to cancel the patent.

The law does not distinguish whether the errors are made in good (unintentional) or bad faith (intentional).

The actions indicated in Sections 67 and 68 shall be filed within one (1) year from the date of publication made in accordance with Sections 44 (publication of patent application) and 51 (refusal of the application), respectively. (cf. Section 70 of the IP Code).

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:

Philippine law does not require that an application for a patent claiming an invention made in the Philippines be filed first in the Philippines.

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:

Philippine law does not require that an application for a patent claiming an invention made in the Philippines undergo any secrecy review.

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 IP Code does not define inventorship. The IPO explained that the lack of a definition of inventorship in Philippine patent law is in part due to the removal of the requirement of submitting an Oath of Inventorship. Note that under Section 35 of the previous AO No. 1-93, only the actual inventor may apply for a patent and the application papers must be signed and the necessary oath executed by the inventor, unless the inventor is dead or insane. However, such provision is no longer present under the IP Code or the Revised Rules.

The IPO opined that the reinstatement of a definition of inventorship may be construed as requiring the supposed inventor or inventors to claim inventorship under oath (i.e. through the submission of an Oath of Inventorship). In connection with this, the IPO believes that an Oath of Inventorship should not be made mandatory to obtain a filing date so as to avoid the undue burden on Filipino inventors who may need to have their affidavits notarized and legalized abroad.

Nevertheless, it is submitted that there is a need to provide clear guidance as to who should be named as the inventor or inventors of a patent application.

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?

There is no law requiring first filing of patent applications directed to inventions made in the Philippines.

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 is no law requiring secrecy review of patent applications of inventions made in the Philippines.

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.

The IP Code does not define the term “inventor”. Thus, to provide clear guidance, Philippine laws must first define who is the inventor of an invention claimed in a patent application. In this connection, it is recommended that the most stringent test for inventorship be established in order to avoid penalties arising from the incorrect identification of inventor(s) such as cancellation of the patent under Sections 67 and 68 of the IP Code.

III. Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes
Please comment.:

Yes, harmonisation is desirable in order to respond to the new issues resulting from the increasing cross-country trends in the field of research and development and the expansion of activities of multinational corporations in different countries. The globalization of the invention process necessitates unification of inventorship laws to ensure the protection of investors as well as the rights of inventors. Moreover, harmonisation in this area will facilitate the compliance of applicants with the requirements in each jurisdiction, thus fostering an environment conducive to international cooperation.

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.

We recommend the following definition:

“An inventor is any person who has made a substantial contribution to the conception and/or production of the subject matter of at least one claim of the application covering the invention.”

The foregoing definition emphasizes the importance of having substantial participation in the *conception and/or production* of the invention, such that the contribution of that person is necessary to the realization of the patentable invention itself. Moreover, since it is the claims that define the scope of protection of a patent, inventorship should be based on contribution to the subject matter of at least one (1) claim.

Similarly, we also propose to exclude under this definition persons who, albeit part of a team developing an invention, merely followed orders in the process of producing such without contributing to the design process, nor persons who financed or merely provided material assets for production.

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).

Considering the complicated nature of defining who are inventors, especially in large team development efforts, correction of inventorship should be allowed when an application fails to correctly identify the inventors at the time of filing of the application. Such correction should be allowed whether the application is still pending or a patent has been granted.

If it is the applicant who request for the correction, it should not be necessary to determine whether the error was intentional or unintentional, in order to facilitate the correction of the inventorship.

On the other hand, when the error in the inventorship is used as basis to cancel a patent, it is submitted that it should be specified that the same may only be resorted to if the error was intentional.

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.

In the case of joint multinational inventorship, it is submitted that it is best to leave the decision of where the application should be first filed to the discretion of the parties involved. The grant of such discretion to the parties permits stakeholders to strategically select the country of first filing in order to ensure immediate protection of the invention where it is most needed.

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.

While we do not adhere to a patent system with first filing requirements, we believe that there is a need for governments to perform a pre-filing clearance akin to a secrecy review as regards inventions covering military technology, technology that may compromise national security, technology that are considered national secrets, and/or technology that may prejudice public safety.

In this regard, countries must agree to the establishment of a working list of subject matters that will require clearance and general procedures to determine whether an invention involves any of the matters enumerated above. If an invention includes one of the subject matters that form part of the pre-agreed list, then the applicant must obtain a pre-filing clearance from the country concerned. The countries must agree as to the consequences of failure to undergo pre-filing clearance, aside from loss of patent rights in the country where pre-filing clearance was supposed to have been obtained.

It must be emphasized that pre-filing clearance will be required only for those inventions covering any of the matters falling in the pre-agreed list.

With the foregoing, there is no longer any need for first filing requirements.

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

Based on our answer to Question No. 15, we submit that there is no necessity to require foreign filing licenses since we are of the opinion that the first filing requirement is an undue burden to patent applications involving multinational inventorship.

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.

Inadvertent failure to comply with first filing requirements and security reviews should be amenable to correction by expedient mechanisms. The remedy may be in the form of filing a request for correction/request for secrecy review and payment of the corresponding fee.

However, if the patent involved covers military technology, technology that may compromise national security, or technology that may prejudice public safety, non-compliance with the security review requirement should result in the loss of right over the patent.

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.

In our answer to Question No. 15, we submitted that no first filing requirement should be imposed to provide stakeholders the opportunity to strategically select where patent protection is most immediately needed. However, the question arises as to whether this discretion should be absolute, or whether some limitation is needed.

A limitation to the discretion as to where to first file a patent application may be put in place to safeguard a country's right to control, develop and protect its resources, sciences, technologies, including indigenous knowledge systems and practices. For instance, aside from the proposed pre-filing clearance in our answer to Question No. 16 above, or alternative thereto, a country may require that the patent application be first filed in its jurisdiction where the invention involves resources endemic therein.

Summary

Philippine patent law does not provide a specific definition of inventorship. Nevertheless, it is common practice to list all members of a research team as joint inventors.

Philippine patent law does not distinguish between citizens and non-citizens of the country and does not make reference to the place where the invention was made. The same rule applies wherever the invention was made. Moreover, Philippine law does not require that an application for a patent claiming an invention made in the Philippines be filed first in the Philippines.

In view of the dearth of a definition of inventorship in Philippine statute or jurisprudence, there is a need to provide clear guidance as to who should be named as the inventor or inventors of a patent application. Thus, Philippine patent law must provide a clear definition of who the inventor is. In this connection, the following definition is proposed:

“An inventor is any person who has made a substantial contribution to the conception and/or production of the subject matter of at least one claim of the application covering the invention.”

As regards the issue of joint multinational inventorship, it is submitted that it is best to leave the decision of where first filing of the patent should be made to the discretion of the parties involved. This will permit stakeholders to strategically select the country of first filing in order to ensure immediate protection of the invention where it is most needed. Nevertheless, it is submitted that it is ideal to have secrecy review requirements as regards inventions covering the subject matters of military technology, technology that may compromise national security, technology that are considered national secrets,

and/or technology that may prejudice public safety.

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

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