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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 Poland there is no law defining inventorship. It is solely and completely up to the persons involved with making the invention to decide who will be listed in a patent application.

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:

In Poland there is no law and special regulations defining inventorship.

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

no

Please comment:

See the answer to point 1 above.

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:

See the answer to point 1 above.

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. The requirement is to file with the Polish Patent Office a request for correction of the list of inventors and the documents certifying that the requested correction is legitimate. These documents may include eg. inventors' declarations, court decisions related to the inventorship, etc.

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?

First, the consequences of an error in the stated inventorship (either intentional or unintentional) may include civil claims raised against the applicant(s) and/or the inventor(s) listed in the application. One of the consequences of such claims may be a civil court decision establishing the legitimate inventor(s) and hence the legitimate persons entitled to obtain a patent or to the rights derived from a granted patent.

Once the legitimate inventor(s) has been established by the court decision, the following provisions may apply:

- art. 74 Polish Industrial Property Law - act of 30 June 2000, as amended by act of 23 January 2004 and act of 29 June 2007 (IPL) [intentional or unintentional error – an application may be discontinued, a patent may be revoked or transferred]:

*“Where a patent application has been filed or a patent obtained by a person not entitled thereto, the entitled person may demand that the patent granting proceeding be discontinued or the patent granted be revoked. He may also demand that a patent be granted in his favour or that the patent already granted be transferred to him against reimbursement of the incurred costs of filing of the application or of granting the patent.”*

- art. 304.1 IPL [intentional error - the applicant may be subject to criminal penalties]:

*“Any person who, not being entitled to be granted a patent, a right of protection or a right in registration, files another’s invention, utility model, industrial design or topography of an integrated circuit in order to be granted a patent, a right of protection or a right in registration, shall be liable to a fine, limitation of freedom or imprisonment for a period of up to two years.”*

- art. 75 IPL [unintentional error – prior use rights ]:“1. A person who, acting in good faith, was granted or acquired the patent subsequently transferred to the entitled person under Article 74, or, being in good faith, acquired a license and has exploited the invention for at least one year before a proceeding for the transfer of the patent has been instituted, or within that period has made

*substantial preparations necessary for exploiting the invention, may, subject to payment in favour of the entitled person of compensation at the amount as determined, continue to exploit that invention in his enterprise to the extent to which he had exploited it at the date of institution that proceeding.2. The right to exploit the invention, referred to in paragraph (1) shall, at the request of the person concerned, be recorded in the Patent Register. The right may be transferred to another party only together with the enterprise."*

both in the case of intentional and unintentional error concerning inventorship, the applicant who applied for and/or obtained a patent may be liable to damages.

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:

There is no law imposing a duty of first filing basing on where the invention was made.

However, there is a duty of first filing formulated as follows according to art. 40 IPL:

*"An invention for which a Polish legal person or a Polish national, having his domicile on the territory of the Republic of Poland, wishes to seek patent protection in another country, may only be applied for protection in that country, when first has been applied for protection with the Patent Office."*

As it follows from the above cited art. 40 IPL, it is the nationality and domicile of the applicant (not the inventor) that determines application or non-application of the duty of first filing in Poland.

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:

There is no law requiring that an application for an invention made in Poland undergoes a secrecy review or similar process before it can be filed in another country.

On the other hand, there are secrecy review laws but they are not based on the criterion of where an invention was made and they apply irrespective of whether an application is to be filed abroad or not.

The secrecy review laws include art. 56-62 IPL and a Regulation of the Council of Ministers of 23 July 2002.

• art. 56 IPL:

*"1. An invention made by a Polish national may be considered to be a secret invention, if it concerns national defence or the security of the State.*

*2. The following, in particular, are inventions concerning national defence: new categories of weapons or military equipment and methods of combat.*

*3. The following, in particular, are inventions concerning the security of the State: technical means applied by civil services authorised to carrying out actions and reconnoitring operations, as well as new*

*categories of equipment and material, and methods of use thereof by the said services."*

- art. 62.1 IPL: *"To the extent as agreed between the authorities concerned, the Patent Office shall communicate to the Minister of National Defence, a minister competent in internal affairs or to the Chief of the State Protection Office, lists of the inventions filed concerning national defence or the security of the State as well as, at the request of these authorities, the descriptions and drawings thereof [...]."* The above provisions are applied to all the applications filed with the Polish Patent Office (including European and PCT applications) provided that the invention was made by a Polish national. As a consequence, the first step of the formal examination of all such applications in the Polish Patent Office is the security check. If an application is considered to be secret by the competent authority, then the right to obtain a patent is transferred ex officio to the National Treasury; the applicant is entitled to a compensation under art. 58 and art. 59 IPL. However, the above cited art. 58 and 59 IPL may not be applied to the inventions made jointly by Polish and foreign inventors because such an invention may not be considered secret under art. 56 IPL.

## 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?

No law, no guidance.

- 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?

The existing first filing law (art. 40 IPL) does not address multinational inventions. However, although it imposes the duty of first filing on the Polish applicants having a domicile in Poland, it is unenforceable. Therefore, in the case of a multinational invention filed first outside Poland in breach of art. 40 IPL, there would be no detrimental consequences affecting the applicant(s), the inventor(s) or the application (except those theoretical mentioned in point 6.d above).

Also, the existing first filing law is inconsistent with the secrecy review laws as one applies to the Polish applicants (both natural persons and legal entities) having a domicile in Poland and the other to the inventions made by Polish nationals. Therefore, an open door is left for the applications directed to the inventions concerning defence and security domains, filed by Polish applicants if at least one inventor is not Polish. This is because even if such an application is selected as concerning national security or defence, it may not be considered secret and banned from filing abroad (as it was not made by a Polish national – art. 56 IPL).

In view of the above considerations, the first filing law and the secrecy review laws in Poland do not pose problems to multinational inventions which is good from the point of view of the inventors and the applicants. However, these laws are mutually inconsistent, partly unenforceable and as such they do not properly fulfill their functions from the point of view of the state defence and security.

The law could certainly be improved but it seems extremely difficult to satisfy both the interests of the multinational applicants/inventors and those of the state security.

- 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?
See point 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.

### III. Proposals for harmonisation

12)	Is harmonisation in this area desirable?
	yes Please comment.:
	Yes but only to a limited extent.

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.
	No need for an international standard which would be extremely difficult to establish bearing in mind all the different laws, traditions etc. of different countries as well as different situations in which the inventions are created. This question may be resolved by means of specific agreements between the inventors of a multinational application. Knowing the laws binding them, the inventors/applicants should take care in advance to conclude necessary agreements.

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).
	No time limits, possibility of correction on request of the list of inventors basing on documents to certify that the requested correction is legitimate.  - Intentional or unintentional error - in the case of a patent application filed or a patent obtained by a person not entitled thereto, the entitled person may demand that the patent granting proceeding be discontinued or the patent granted be revoked. He may also demand that a patent be granted in his favor or that the patent already granted be transferred to him. The applicant who applied for and/or obtained a patent may be liable to damages.  - Intentional error - the applicant who applied for and/or obtained a patent may be liable to damages as well as criminal penalties.

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.

It seems that establishing an international standard for first filing requirements would be obviously desirable from the point of view of multinational inventors/applicants. However, it would also be extremely difficult bearing in mind that these requirements are strictly connected with national security laws of each country which constitute a sensitive issue.

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.

Each country should be free to establish their own secrecy review requirements.

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

The countries having first filing requirements should be obliged to ensure that a foreign filing license may be obtained under certain conditions. Each country should be free to establish their own conditions.

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.

First of all, such a standard would have to foresee a procedure to prove that the failure was in fact inadvertent (arguably efficient). If inadvertent - the ability to cure or repair should depend on whether the application was already published or not. If published, it should be established whether the failure could have made any harm. If so, the procedure should include a "late" security review. In terms of an international standard this constitutes a problem (see point 16).

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.

No proposals

#### Summary

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