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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 definitions of inventorship and co-inventorship for the Russian invention patents are provided in Articles 1347-1348 of the Civil Code of the Russian Federation. Concerning Eurasian patent inventorship - it is specified in Rule 9 of the Instruction to the Eurasian Patent Convention.

The Russian law requires that the invention is to be created by joint creative activity to establish co-inventorship. No connection with location (in this country or abroad) is mentioned in the law. It means that inventors should 1) communicate over inventive idea 2) each should make a creative contribution. Inventor separately elaborated same inventions can not be considered as co-inventors. Such inventions should be considered separately.

The Eurasian Patent Law provides very close definition stating that co-inventors are those who created invention by joint creative activity.

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?

yes

Please comment:

Inventorship for Russian invention patent relates to inventions which can be "parts" of applications. Indeed if single application includes several inventions (independent claims) it can include different co-inventors for different inventions.

Same approach is established by the Eurasian patent law for Eurasian patent.

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

no

Please comment:

Inventorship does not depend on citizenship of inventors according the Russian patent law. Same approach is established by the Eurasian patent law for Eurasian 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:

Inventorship does not depend on residency inventors in the Russian patent law. Same approach is established by the Eurasian patent law for Eurasian patent.

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?:

Inventorship for Russian or Eurasian patent application can be corrected after the filing till the grant

(registration and publication) either voluntarily or by Court decision (if there is a dispute on the inventorship). After grant of patent such correction can be done only if Court ordered that.

List of inventors can be corrected voluntarily during the Prosecution of Russian or Eurasian patent application. Documents with signatures of all inventors normally are required by Patent Office as confirmation (along with appropriate office fee).

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?

The Russian law (article 1398 of the Civil Code of the Russian Federation) states that issuance of patent with wrong indication of inventorship is a ground for invalidation of patent in full or in part. Such invalidation Ruling is to be done by Court (now it is under jurisdiction of the Intellectual Property Court). There is now guidance what difference makes intensions but since the court decision should be reasonable and just in case of unintentional omission of inventor - most likely the Ruling will be to invalidate current patent and to grant new with full list of inventors in it.

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.

no

Please comment.:

The Russia law (Article 1395 of the Civil Code) requires that the application for invention created in the Russian Federation is to be first filed in the Russia Patent Office.

There is NO limitation relating to any technology.

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.:

There is NO foreign filing license system in Russia. Invention created in Russia must be first filed in Russia and foreign filing is available after 6 months unless Russia Patent Office notifies applicant that it is prohibited due to the secret character of application.

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?

The residency or nationality of inventors does not matter in establishing inventorship for joint inventions.

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?

no

Please comment.:

It is not a violation.

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

The violation of first filing requirement can be considered as administrative violation and may result in a fine. But if application filed with violation of first filing requirement happened to comprise state secret information (even found as secret afterward) - such violation may result for criminal prosecution for disclosure of state secrets.

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?

There is NO difference for field of art specified in the law.

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

The check if application comprises state secret information is being done automatically without any costs to applicant within 6 months after the filing.

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

If application has been filed with violation of first filing requirement and it happened to comprise state secret information (even found as secret afterward) - such violation may result for criminal prosecution for disclosure of state secrets. During the criminal case public prosecutor should find if accused person new or should have known that the application comprised secret information (the definition of guilt for criminal case must be present).

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?

We believe that the definition of inventorship in the Russia law is rather broad and for this particular situation it does not require specification.

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?

We believe that the law in this part can be amended by exclusion from first filing in Russia rule of applications although created in Russia but have foreign citizens in the inventor's list. It is not reasonably possible to claim state secret of information which legitimately is in the possession of foreign citizens (at least without their direct approval). So the law should include mentioning of Russian citizenship of inventors as requirement for first filing Rule.

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?

The secrecy regulation in the law should cover only inventors who are Russia citizens.

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, we believe that harmonization in that field is recommendable

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.

Those who made invention as a result of joint creative activity are to be named as inventors in the application.

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).

We believe that it can be done upon approval of all inventors indicated in 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.

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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.

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

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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.

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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.

We believe that multinational inventions should be excluded for first filing or state secret regulations.

Summary

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