



Date: 9th July 2015

## Q244

### Inventorship of multinational inventions

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Date	19-05-2015

#### 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?

Spanish law does not contain any definition of "inventor" or "inventorship". The Spanish Patents Act (Act 11/1986, of 20 March, on Patents) only stipulates in Sec. 10(1) that the "right to the patent belongs to the inventor or his/her assignees", without defining "inventor" or determining the circumstances under which a certain person would qualify as an inventor.

A new Spanish Patents Act is under discussion in the Spanish Parliament (new draft Patents Act of 24 November 2014, hereinafter "the draft new Patents Act"). The absence of a definition of "inventorship" has not changed in the draft legislation.

Important to note is that the inventor may be the applicant, but not necessarily.

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 Spanish Patents Act does not contain any specific provision dealing with multinational inventions. The legal provisions dealing with co-ownership do not provide for any criteria to determine the inventorship in this case.

Person A and/or B would be considered an inventor under Spanish Law insofar he has contributed intellectually to reach the technical solution to the technical problem (See, for instance, Judgement from the Court of Appeal of Barcelona (Sec. 15) nº 249/2014, 16 July 2014).

Under Spanish law, A would be considered as an inventor whose activities would be governed by its country of residence, while B would be considered as a Spanish inventor (see answer to question 3 below).

In this case Sec. 122(2) of the Spanish Patents Act would be relevant. This provision sets forth the presumption, for the purposes of the first filing requirement, that an invention has been made in Spain where the inventor has his/her habitual residence in Spain. This presumption admits evidence to the contrary. This provision remains unchanged in the draft law (Sec. 115(2) of the draft new Patents Act).

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:

No, Spanish law does not contain any provision in this respect

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

no

Please comment:

Spanish law does not contain any provision establishing that the citizenship of the inventor is a condition of inventorship

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

yes

Please comment:

Spanish rules on inventorship apply to inventions made in Spain.

The Spanish Patent Act provides that an invention is presumed to have been made in Spain if the inventors have their residence in Spain, unless it can be proved that the invention has been made elsewhere.

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?:

The inventorship of a patent application can be corrected. To do so, it is necessary to have the explicit agreement of the applicant / patentee and all designated inventors. There is no time limit to make the

correction and it can be done during prosecution of the application and during the whole life of the granted patent.

- 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 Spanish Patents Act establishes in Sec. 112(1)(d) - as a cause of invalidation of the patent - the absence of the right to obtain the patent according to Sec. 10(1) aforementioned (see the answer to question 1). The claim for invalidation must be filed before the Spanish Courts. This provision does not specify whether the absence of the right must be due to an error or to any other circumstance (abuse, fraud, etc.) and does not make any reference to its intentional or unintentional nature. Accordingly, whether or not the error (or any other circumstance determining the invalidity of the patent) was intentional is not relevant for the purpose of invalidation (it can be relevant, though, for the purpose of a damages claim, where appropriate).

Where the patent holder is not entitled to the patent, the legitimate holder may claim the ownership of the invention, instead of the invalidation, before the Spanish courts. The term to file this claim is two years following the date of publication of the mention of grant of the patent, unless the registered holder knew at the time of the grant or at the time of acquiring the patent that he/she was not the holder. Accordingly, in the context of a claim to recover ownership, the intentional/unintentional nature of the error or any other circumstance determining the absence of entitlement is relevant.

- 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.:

Yes. According to Sec. 122(1) of the Spanish Patents Act for the purposes of the secrecy review of patents relating to inventions made in Spain, no foreign patent can be filed within two months from the filing date of the patent application before the SPTO, unless the filing has been done with its express authorization. Under no circumstances will said authorization be granted for those inventions that are of interest to national defence, unless expressly authorized by the Ministry of Defence.

Sec. 122(1) has been amended in the draft new Patents Act. The main changes refer to the term covered by the foreign filing restriction (one month for any patent application, extendable up to four months when the SPTO considers that the invention may be of interest for national defence) and that, it is possible to obtain an authorisation to be entitled to file abroad as a first patent application.

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, the first filing requirement in Spain is not limited to any specific area of technology or limited

such that it does not apply to all inventions made in Spain. Sec.122(1) of the Spanish Patents Act simply refers to "inventions made in Spain".

Furthermore, Sec. 119(1) of the Spanish Patents Act dealing with the secrecy review refers to "all" patent applications. Accordingly, the first filing requirement applies to all patent applications regardless the specific area of technology of the invention.

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.:

No, as stated above in answer to question 6, Sec. 122(1) of the Spanish Patents Act does not provide for a foreign filing license.

The draft new Patents Act in Sec.115 does provide for obtaining a foreign filing license for inventions made totally or partially in Spain.

To obtain it, it is necessary to file a request together with the full application text. The SPTO will perform the corresponding check and will authorize the foreign filing if the invention is not of interest for national security within one month.

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?

no

Please comment.:

The draft new Patents Act does not provide for the retroactive effect of a foreign filing license.

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?

Under Spanish law, the first filing requirement applies based on the residency of the inventor. Unless proof to the country is submitted, it is presumed that the invention has been made in Spain.

The Spanish Patents Act does not provide how to solve the problem of first filing, when part of the invention has been made in Spain and part in another filing country. This is solved in the draft new Patents Act, by providing for a request for a foreign filing license.

This new provision (Sec. 115(2)) reads as follows:

*"For inventions created either completely or partially in Spain, it is possible to request authorisation in order to submit them as the first application for a foreign patent. For that purpose, the applicant must submit the text of the application to the Spanish Patent and Trademark Office so that the examination set out in Article 111.1 can be performed under confidential conditions. The SPTO may require the submission of a translation, if this should be necessary."*

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.:
Spanish law does not contain any specific provision in this respect. No specific provision has been included in the draft new Patents Act either.
Under Spanish law, filing a foreign filing license in the other country would not violate Spanish patent law provided that the license was sought to first file the patent in Spain.

f) What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?
Although the Spanish Patents Act sets forth the first filing requirement for inventions made in Spain, no penalty is foreseen in the Spanish Patents Act if the applicant fails to meet these obligations.
Yet the draft new Patents Act foresees a penalty. Specifically, Secs. 152(2) and 163(2) of the draft provides that failure to comply with the first filing requirement for European patent applications and International patent applications respectively will result in the lack of effect of the patent in Spain.
Whether the failure or error was intentional or inadvertent would not be relevant for the purposes of the application of the above-mentioned provisions.
On the other hand, the intentional disclosure of an invention protected by a secret patent, with a breach of the Spanish patent regulations is considered a criminal offence provided that this affects national security (Sec. 277 of the Spanish Criminal Code). This offence shall be punished by imprisonment between six months and two years plus a financial penalty.

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?
Yes. This secrecy review is regulated in Sec. 119 to 122 of the Spanish Patents Act, and Sec. 16 of the Royal Decree 2245/1986.
No changes are expected in the new patents act about to be approved.
a. If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?
No, this law applies to all areas of technology.
No changes are expected in the new patents act about to be approved.

b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.
The content of all patent applications is kept secret for two months following their date of filing, unless the SPTO authorizes their prior disclosure.

Before expiration of the 2-month period, the SPTO shall extend the period to five months from the date of filing of the application when it considers that the invention reviewed may be of interest for national defence.

If the period has been extended, the SPTO shall inform the applicant of the extension and shall immediately place at the disposal of the Ministry of Defence a copy of the patent application filed.

Finally, where the national defence interests so require, the Ministry of Defence shall contact the SPTO so that before expiration of the period of five months the latter can order that the patent procedure be kept secret and inform the applicant accordingly.

Patents that are granted following the secrecy procedure will be entered in a secret register and will remain secret for one year from the date of being granted. This period may be extended annually and the owner of the patent shall be informed accordingly. In this regard, it is to be noted that:

- The renewal of the secret status does not apply in time of war until one year after the cessation of hostilities; and
- Following a favourable report by the Ministry of Defence, the SPTO may at any time remove the obligation of secrecy imposed on an application or a specific patent.

There is no extra cost associated with this procedure. Furthermore, it should be noted that if the patent is finally granted, and as long as it remains secret, it is not subject to the payment of annual fees.

No changes are expected in the new patents act about to be approved.

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

According to Sec. 121, the owner of a patent may claim compensation from the State for the time during which the patent remains secret.

However, when the owner fails to comply with its secrecy obligation (Sec. 119.5), then Sec. 121.3 establishes that the owner shall lose the right to compensation.

No difference is made whether the disclosure was intentional or inadvertent.

No changes are expected in the new patents act about to be approved.

## 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?

Our law does not give any definition of inventorship. The draft new Patent Act does not give such definition either.

If there was agreement among the countries to reach a common definition, a proper harmonized definition should be contained in our law. Otherwise, it would not be desirable.

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?

Current law. As we have already stated, according to Sec. 122(2) of the Spanish Patents Act, when the **inventor** has his/her habitual residence in Spain it is presumed that the invention has been made in Spain and, therefore, there is the requirement to first file the application of the patent in Spain.

Furthermore, one must also take into account that Royal Decree No. 2424/1986, and Royal Decree 1123/1995, establish that when the **applicant** (not the inventor, therefore the invention could have been made out of Spain) of a European/International patent application has its domicile or headquarters in Spain, or its habitual residence or permanent establishment in Spain, and it does not claim the priority of a previous application in Spain, it must compulsorily file the European/International patent application at the SPTO.

Here, attention should be paid to the fact that no Foreign First Filing License is allowed in either cases. However, currently, Spanish law does not establish any specific sanction in the event the First Filing is not done in Spain.

Draft new Patents Act. The draft new Patents Act has also used both criteria (inventorship and applicant) to determine when an application has to be first filed in Spain. The main novelty in this aspect is that the draft new Patents Act:

- With regard to inventions made in Spain, states the possibility to request a first filing license.

Furthermore, it continues without establishing any specific sanction if such requirement is not fulfilled.

- With regard to European patent applications and international patent applications: it states that failing to comply with the obligation of first filing the application in Spain (which has to be done when the applicant has its domicile, residence, etc., in Spain), will imply that the patent shall not come into effect in Spain (European patents) or that the patent application will not come into effect in Spain (International patents).

Furthermore, in this regard, no possibility of requesting, or obtaining, a first filing license is foreseen.

It would be desirable to improve and harmonize the regulation with other national regulations, trying to use only one criteria (inventorship -inventions made in Spain- vs. domicile of the applicant), or clearly stating which criterion prevails in case they enter into conflict.

If such harmonization is not achieved, Spanish law should at least state the possibility to request a first filing license also for European patent applications and international patent applications when the applicant does reside in Spain.

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?

Please see Section III below.

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.

Please see Section III below.

### III. Proposals for harmonisation

12)	Is harmonisation in this area desirable?
	yes Please comment.:
	Yes, according to the Spanish Group, harmonisation in this area is desirable.

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.
	The inventor should normally be the creator, conceiver and/or originator of any or all of the patentable invention elements / subject matter.  A person that simply organizes the process (by providing funds, infrastructure or administrative services) and / or performs auxiliary functions during the invention process should not normally be considered an inventor.

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).
	Correction of inventorship should be accepted by any patent office, either if the patent is pending or issued. These corrections could be due mainly to two reasons:  a) A correction in the data of the inventors, the addition or deletion of one or more inventors provided by a declaration of the applicant. If this correction is requested by the applicant, the correction should be accepted without requiring anything further.  b) The addition, deletion or substitution of an inventor, requested by an alleged inventor. In these cases, the alleged inventor should file a request and follow the administrative or court proceedings established by the corresponding national law, submitting the corresponding evidence. The correction should only be made if the corresponding deciding bodies consider that the request is acceptable, according to national law.

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 Spanish Group considers that "first filing requirements" are outdated and that, therefore, it would be desirable for countries to cooperate so that this type of requirements are abandoned.  However, the Spanish Group understands that there may be specific circumstances (for example, when an invention may affect national, regional or international security) where measures aimed at preventing the general disclosure of an invention may be justified. To address these situations, the Spanish Group proposes the following standard:  1. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to



the treaty, and according to the law of a party to such treaty the patent application should be filed first in that country, the patent applicant should also be allowed to file its patent application first before any of the countries which are a party to such treaty, provided that the parties to such treaty comprise the country where the invention was made.

2. Subject to paragraph 1, for the purpose of determining whether a country is allowed to require that a patent application for an invention be filed first in that country, the following principles should apply:

a. A country may require that a patent application for an invention be filed first in that country if the invention has been made in that country, regardless of the permanent residence of the inventors.

b. Where the invention has been the result of activities carried out in more than one country:

i. A country may require that a patent application for an invention be filed first in that country if said country is the country where the most substantial intellectual contribution to the invention has been made.

ii. In the absence of evidence to the contrary, it will be presumed that the country where the most substantial intellectual contribution to the invention has been made is the country where the invention was conceived (i.e. the country where the original idea for the invention was proposed). However, where inventors other than the inventors who conceived the invention carried out activities that solved problems not identified by the former, and/or that they could not solve, and solving such problems was necessary to put the invention into practice, the country where the most substantial intellectual contribution to the invention has been made will be presumed to be the country where the activities that solved such problems were carried out.

3. If a country establishes penalties for applicants who fail to comply with First Filing Requirements, such penalties should only apply if the invention concerned is directly related to national defence, and according to the corresponding national authorities, the patent should have been prosecuted in secrecy. Any penalties should be reasonable and commensurate to penalties established for failing to comply with other similar administrative requirements. In particular, such penalties should not include the loss of the rights deriving from the patent application.

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 Spanish Group considers that "secrecy review requirements" are outdated and that, therefore, it would be desirable for countries to cooperate so that these types of requirements are abandoned.

However, as mentioned in our answer to Question 15, the Spanish Group understands that there may be specific circumstances (for example, when an invention may affect national, regional or international security) where measures aimed at preventing the general disclosure of an invention may be justified. To address these situations, the Spanish Group proposes the following standard:

For the purpose of determining which country is entitled to conduct a secrecy review, the following principles should apply:

1. Subject to paragraph 2, under the Rules on Multinational Inventions, a country may only introduce secrecy review procedures in relation to inventions directly related to national defence.

2. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, that country should waive this secrecy review procedure so that the for patent application may be filed first in another country which is a party to such treaty.

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

The Spanish Group suggests the following principles:

1. Countries should introduce procedures allowing patent owners to obtain a Foreign Filing License.
2. Like all Rules on Multinational Inventions, Rules for obtaining a Foreign Filing License should be prepared and applied in an impartial, transparent, predictable, consistent, fair and neutral manner.
3. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, and according to the law of a party to such treaty the patent application should be filed first in that country, that country should accept granting a foreign filing license allowing the patent applicant to file its patent application first before any of the countries which are party to such treaty, provided that the parties to such treaty comprise the country where the invention was made.
4. Procedures for obtaining a Foreign Filing License should comply with the principles of the TRIPS Agreement. In particular, they should be fair and equitable. They should not be unnecessarily complicated or costly, or entail unreasonable time limits or unjustified delays. Parties should have an opportunity for review by a judicial authority of final administrative decisions relating to Foreign Filing Licenses.

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 Spanish Group suggests the following principles:

1. Countries should allow applicants to obtain a retroactive Foreign Filing License when an applicant has failed to comply with a First Filing Requirement or Security Review Requirement.
2. Countries may refuse to grant a retroactive Foreign Filing License when it is established that the applicant intentionally failed to comply with a First Filing Requirement and/or Security Review Requirement.
3. Like all Rules on Multinational Inventions, Rules relating to the rectification of failures to comply with a First Filing Requirement or Security Review Requirement should be prepared and applied in an impartial, transparent, predictable, consistent, fair and neutral manner.
4. Procedures should comply with the principles of the TRIPS Agreement. In particular, they should be fair and equitable. They should not be unnecessarily complicated or costly, or entail unreasonable time limits or unjustified delays. Parties should have an opportunity for review by a judicial authority of final administrative decisions relating to foreign filing licenses.

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 Spanish Group suggests that the members of the World Trade Organization should, in due course, negotiate an international agreement on "multinational inventions" called "Rules on Multinational Inventions" that could be inspired by some of the standards on which the "Agreement on Rules of Origin" is based. As an alternative, new rules governing "multinational inventions" could be introduced in a future amendment of the TRIPS Agreement, although this option would probably be less preferable,

taking into account the foreseeable political difficulties that amending the TRIPS would entail.

"Rules on Multinational Inventions" should be defined as those laws, regulations and administrative determinations of general application applied by countries in order to determine the country in which a patent application for an invention must be filed first, the identity of the inventors, first filing requirements, foreign filing licenses and/or secrecy review requirements.

Under the Rules on Multinational Inventions, a country should only be allowed to require that a patent application for an invention be filed first in that country if the conditions set out in the response to question 15 above are fulfilled.

#### Summary

The Spanish Patents Act does not contain a definition of "invention" or "inventor". In order to determine where the invention took place, the general rule is that when the inventor is habitually resident in Spain, it is assumed, in the absence of evidence to the contrary, that the invention took place in Spanish territory. The application of this rule raises difficulties in cases where the invention is the result of the collective work of inventors residing in different countries, as the Act fails to specifically regulate the matter of "multinational inventions".

In the case of inventions taking place in Spain, the Act establishes that no patent applications may be filed in other countries until two months have passed since the patent was applied for before the Spanish Patents Office, unless the Office authorises it. For inventions related to national defence, this authorisation cannot be granted without the express authorisation of the Ministry of Defence. The draft bill of the Patents Act envisages the possibility for inventions taking place entirely or partially in Spain to obtain an authorisation to file patent applications abroad first.

The Spanish Group considers that harmonisation of rules in this area is desirable. In particular, it considers that the "inventor" should normally be the person who creates, conceives and/or generates the invention. Moreover, the Spanish Group proposes an international standard that would make it possible to overcome some of the practical difficulties derived from the requirement to present the first application in a particular country.

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