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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 applicable law in Sri Lanka is the Intellectual Property Act no. 36 of 2003, ("the Act") read with the regulations published in Government Gazette Extraordinary No. 1,445/10 of the 17th of May, 2006. The definition of "invention" in section 62(1) of the Act is as follows: "*For the purpose of this part, invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.*" In terms of section 62(2), an invention may be, or may relate to, a product or process. Section 67(1) provides that the right to a patent shall belong to the inventor and section 67(2) provides that where two or more person have jointly made an invention, the right to a patent shall belong to them jointly. Section 67 is subject to the provisions in section 68 of the Act which provides that "*Where the essential element of the invention claimed in a patent application or patent have been unlawfully derived from an invention for which the right to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him*", (subject to certain parameters contained in the two provisos to section 68).

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? This depends on the terms of any contract in place between the two parties and the relationship between them. For instance, if A is the employer and B

is the employee, section 69(1) would apply which provides that: *“In the absence of any provision to the contrary in any contract of employment or for the execution of the work, the right to a patent for an invention made in the performance of such contract of employment or in the execution of such work shall be deemed to accrue to the employer, or the person who commissioned the work, as the case may be; (in this case, A): Provided that where the invention acquires an economic value much greater than the parties could reasonably have foreseen at the time of entering the contract of employment or for the execution of work, as the case may be, the inventor shall be entitled to equitable remuneration which may be fixed by the Court an application made to it in that behalf, in the absence of an agreement between the parties. Section 69(2) provides that “Where an employee whose contract of employment does not require him to engage in any inventive activity, makes in the field of activities of his employer, an invention using data or means placed at his disposal by his employer, the right to the patent for such invention shall be deemed to accrue to the employer, in the absence of any provision to the contrary in the contract of employment: Provided that the employee shall be entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court, taking into account his emoluments an application made to it in that behalf the economic value of the invention and any benefit derived from it by the employer”.* Section 69(3) provides that the rights conferred on the inventor under subsections (1) and (2) of section 69 shall not be restricted by contract. If, however, as per the factual circumstances, both A and B have jointly made the invention, the right to a patent in respect of the invention would belong to them jointly (section 67(2)). Section 67 reads as follows: *“67 (1) Subject to the provisions of section 68 the right to a patent shall belong to the inventor. (2) Where two or more persons have jointly made an invention, the right to a patent shall belong to them jointly. (3) If and to the extent to which two or more persons have made the same invention independently of each other, the person whose application has the earliest filling date or, if priority is claimed, the earliest validly claimed priority date, shall have the right to the patent, so long as that application is not withdrawn, abandoned or rejected.”* It should be noted that in accordance with section 70(1), the inventor shall be named as such in the patent, unless by a declaration in writing signed by him/her or on his/her behalf and submitted to the Director-General of Intellectual Property of the National Intellectual Property Office of Sri Lanka, he/she indicates his/her decision to forgo his/her name being included in the patent. Subsection (2) of section 70 states that the provisions of subsection (1) shall not be modified by the terms of any contract.

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:

The Intellectual Property Act does not define the term “inventor” nor does it define the term “inventorship”. It defines an invention as an “idea of an inventor, which permits in practice the solution to a particular problem in the field of technology.” It is therefore arguably the case that the inventor/(s) is/(are) the person/(s) whose idea/(s) permit/(s) the solution to the problem.

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

no

Please comment:

No, it does not.

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, it does not. It should be noted that in regard to the obtaining of a patent, in terms of section 71(1)(c), if the applicant's ordinary residence or principal place of business is outside Sri Lanka, the applicant shall be represented by an agent who is a resident of Sri Lanka whose name and address shall be given in the application, and the application shall be accompanied by a power of attorney granted to such agent by the applicant.

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?:
	<p>It should be noted at the outset that in terms of section 71(2)(b) of the Act where the applicant for the grant of a patent is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent. Section 71(2)(c) provides that: <i>"The Director-General shall send a copy of the statement referred to in paragraph (b) to the inventor who shall have the right to inspect the application and to receive on payment of the prescribed fee, a copy thereof."</i> Subject to what is stated hereafter the answer to the question is arguably yes in view of the provisions contained in section 75. Section 75 ("Amendment and division of application") provides for amendments to patent applications in the following terms: <i>"An applicant may amend the application, provided that the amendment shall not exceed the limits of the disclosure in the initial application"</i>. The patent application form prescribed in terms of the applicable regulations (form P01) contains two cages numbered IV. which have to be completed with details of the name and the address of the inventor. Form P01 also provides in Cage VI. ("Basis of the Applicant's Right to the Patent".) for the basis of the applicant's right to apply for the patent to be indicated on the said application form by reference to the following categories:</p> <ul style="list-style-type: none"> • <i>"Applicant is the inventor.</i> • <i>Applicant is the legal representative of the inventor.</i> • <i>Applicant is the assignee of the inventor.</i> • <i>Applicant is the owner of the invention which was made-</i> • <i>while the inventor was in the employment of the applicant</i> • <i>by the inventor in the performance of a contract for the execution of work.</i> • <i>Any other (specify): A statement specifying in more detail, the Applicant's (who is not the Inventor) right to apply for the patent accompanies the application (Provide sufficient copies of the statement for all non-applicant inventors)"</i> <p>• <i>Arguably, the right to amend does not, arguably, arise in the following circumstances. Since in terms of section 77(1) of the Act</i></p> <ul style="list-style-type: none"> ◦ <i>the Director General shall record as the filing date of the application, the date of receipt of such an application - provided that on the date of receipt of the application, the application contains [inter alia]: "(b) the name and address of the inventor and, where the applicant is not the inventor, the statement referred to in paragraph (b) of subsection (2) of section 71)"</i>; and • <i>section 77(2) provides that: "Where the Director-General finds, at the time of receipt of the application, that the provisions of subsection (1) have not been complied with, he shall request the applicant to file the required correction within a period of three months from the date of such request", and</i> • <i>section 77(3) provides that "Where the applicant complies with the request referred to in subsection (2), the Director-General shall record as the filing date, the date of receipt of the required correction;</i>

where the applicant fails to so comply the Director-General shall treat the application as null and void."

it is impliedly and arguably the case that if there is an error in regard to the requirements in regard to the manner in which inventorship should be dealt with on the face of Form P01, then the manner of rectifying such an error is only through filing of a required correction in terms of section 77(2) if the Director finds that the requirements contained in section 77(1) have not been complied; and that this is not a matter which can be amended.

a. If yes, what are the requirements and time limits for such correction?

As already noted, section 75(1) provides that: *"An applicant may amend the application, provided that the amendment shall not exceed the limits of the disclosure in the initial application."*

The section does not refer to a time limit. However once a patent has been accepted for grant, it is likely that the National Intellectual Property Office would not then act on a request for amendment. It may also be possible for corrections to be done by way of an application made to the Director-General of Intellectual Property in the manner set out in Part XI, Chapter XXXV, ("Applications to and proceedings before the Director-General and Court") of the Act.

Section 163 of the Intellectual Property Act provides that:

"(1)The Director-General may, on application made in the prescribed manner by or on behalf of the registered owner of an industrial design, patent, trademark or any other registration provided for under the Act, correct any error or make any change-

a. in the name, address or description of the registered owner of any ... patent... or any other registration provided for under the Act;

b. concerning any other particulars relating to the registration of a ... patent or any other registration as may be prescribed."

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?

There is no specific provision in the Act as to what the consequences are if there is an error in the application (request) form tendered to the National Intellectual Property Office, seeking the grant of a patent, if the error is not detected by the Director-General of Intellectual Property. One argument is that such a mistake would arguably and by reference to the provisions in section 77 of the Act, render the patent liable to be declared null and void.

With regard to a substantive error, there is no specific provision in the Act as to what the consequences are.

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:

No.

- 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:

No.

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 Sri Lankan IP Act does not contain a definition of inventorship.

The prevailing national law should be amended by the inclusion of a definition of "inventor" and "inventorship".

The law should be amended to clarify the applicable parameters/criteria by which a person is eligible to be considered as an inventor. This would assist in answering questions such as the extent to which a person has to get involved in the conception of an invention to be considered as an inventor.

- 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?

N/A

- 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?

N/A

- 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 consequences of a mistake in an application form for the grant of a patent in regard to inventorship (whether the error is on the face of the form or a substantive error) should be clarified

III. Proposals for harmonisation

12)	Is harmonisation in this area desirable?
	yes
	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.
	<p>We understand that globally, the definition of inventorship is not clear and that there are many different definitions. In the US we understand that in patent law [http://en.wikipedia.org/wiki/Patent], an inventor is the person [http://en.wikipedia.org/wiki/Person], or persons who contribute to the claims [http://en.wikipedia.org/wiki/Claim_(patent)] of a patentable [http://en.wikipedia.org/wiki/Patentability] invention [http://en.wikipedia.org/wiki/Invention].</p> <p>In other patent law frameworks, however, such as in the European Patent Convention [http://en.wikipedia.org/wiki/European_Patent_Convention] (EPC) and its case law [http://en.wikipedia.org/wiki/Case_law], no explicit, accurate definition of who exactly is an inventor is provided. The position may vary in certain degrees from one European country to another. It would appear that inventorship would generally not be considered to be a patentability criterion under European patent law [http://en.wikipedia.org/wiki/European_patent_law].</p> <p>It would seem that as a matter of U.S. case law, an inventor is the person with "intellectual domination" over the inventive process, and not merely one who assists in its reduction to practice [http://en.wikipedia.org/wiki/Reduction_to_practice].</p> <p>Given these different approaches, it is difficult to formulate a single definition.</p> <p>What is more important in our view is that challenges to the validity of granted patents on the basis of various arguments, premises or notions in regard to concepts of inventorship should not be possible. In our view, granted patents should not be set aside or found to be null and void merely by reason of the fact that there is doubt, an error, or an omission in regard to inventorship. The law could provide for rectification in these circumstances.</p>

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).
	<p>In our view it should be possible to correct an error or omission in regard to inventorship at any time. A time bar for corrections may not be appropriate. That said, corrections of inventorship to pending applications would, practically speaking, likely only arise during the pendency of the application. After grant, it should be possible for an application to be made to the relevant Court.</p>

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.
	<p>First filing requirement should not be a necessary requirement.</p>

16)	If you believe such a requirement is appropriate, please propose an international standard for secrecy
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review requirements that would take into account multinational inventions.

A secrecy review requirement should not be a necessary requirement.

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

The obtaining of a foreign filing license should not be a necessary requirement.

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.

If such an inadvertent failure occurs, such failure should be curable/correctable or repairable or rectifiable under national law.

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.

Where there is an error in regard to inventorship, the widest possible opportunity should be provided for a person aggrieved to have the application or the granted patent cured/corrected/repared/rectified.

Summary

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