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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?

Whoever contributed to the inventive concept would be considered an inventor.

An inventor under English law is the 'actual deviser of the invention'^[1] and a patent may be granted 'primarily to the inventor or joint inventors'^[2].

Whether person A and / or person B would be considered to be an inventor or joint inventors under English law will depend on whether they both together arrived at the invention i.e. they the inventive concept. If for example, A devised the inventive concept and B merely used his common general knowledge to demonstrate that the idea worked then A would be the sole inventor.

Footnotes

1. [^](#) (s.7(3) PA 1977)
2. [^](#) (s.7(1) PA 1977)

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:

Inventorship is determined by contribution to the inventive concept . The assessment of what is the inventive concept is not restricted to the claims. The entire specification^[1] is relevant.

Footnotes

1. [^](#) See for example the Hearing Officer's analysis in BL O/501/14 - Daletech Electronics Ltd v Jemella Ltd applying *Markem v Zipher and Yeda*

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

no

Please comment:

The UK law of inventorship does not depend on the citizenship of the inventor(s).

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, UK law will apply to a UK patent and the inventorship of the same, regardless of where it was invented and by whom.

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?:

UK law allows for amendments to inventorship to be made either during prosecution or after grant of the patent.

There are a number of different ways in which such a correction can be made.

Inventorship may be corrected as a result of entitlement proceedings, which may be brought before the Comptroller^[1] or court to resolve a dispute as to the identity of the true inventor, whether in relation to UK or foreign applications.

Alternatively, if there is simply a mistake in the application as to the identity of the inventor, this can be corrected by the UK Intellectual Property Office (UKIPO) under the procedure for correction of errors.

A change in inventorship may also arise because inventors may also exercise a right to be mentioned in

any granted patent (even if they are not the owner of the patent).

It should be noted that if correcting inventorship changes entitlement^[2], this has the potential to change the priority date in situations where a patent application follows an earlier priority filing. Under Article 4 of the Paris Convention, if a person applying for a patent wishes to claim priority from an earlier priority application, that person must be identical to, or be the successor in title to, the person who made the earlier application.^[3] In the UK, following *Edwards v Cook* ^[4], this means that if the persons making the subsequent application differ from those who made the priority filing, the necessary assignments must be made before the application is filed. Otherwise, entitlement to the priority document will be lost.

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

There are three types of error which may need correction: 1) correction of the owner of the right sought by a third party and necessary because an error in inventorship has resulted in a change of ownership of (or entitlement to) the invention; 2) correction due to the inventor's right to be mentioned; and 3) correction due to error.

Correction to change ownership/entitlement

Where the correction of inventorship leads to a change of ownership of the application/patent (i.e. to entitlement to the invention embodied in the application or patent), then entitlement proceedings to correct ownership may be brought before the Comptroller or court **while the application is pending and up to two years after grant**. The two year post-grant deadline does not apply if the recorded proprietor (i.e. the proprietor not entitled) knew it was not entitled to the patent.

Correction due to inventor's right to be mentioned

UK law provides the right for an inventor to be mentioned as such in any patent granted for the invention. An unmentioned inventor can apply to the comptroller to enforce this right. There is **no time limit** as to when such an application may be made.

Where a person believes an inventor ought not to have been so mentioned as inventor, he or she may at any time apply to the Comptroller for a certificate to that effect. If the comptroller issues such a certificate, he will also correct, by means of an erratum, any copies of the patent which are subsequently distributed.

Correction due to error

The Comptroller may, **at any time**, correct any errors or mistakes in any specification of a patent or application for a patent or any documents filed in connection with a patent or such an application. A request for such a correction is made to the Comptroller.

Footnotes

1. [^] "comptroller" means the Comptroller-General of Patents, Designs and Trade Marks, the senior official at the UK Intellectual Property Office
2. [^] Generally it will, but there are circumstances in which it will not (e.g. if inventorship changes between employees of the same employer)
3. [^] i.e. the same legal person.
4. [^] *Edwards Lifesciences AG v Cook Biotech Incorporated* [2009] EWCH 1304 (Pat)

- 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?

If an error in inventorship leads to an incorrect applicant (i.e. owner of the right), this may be enough for the UK IPO to refuse to grant a patent.

In the UK only the inventor or their successor in title is entitled to the grant of a patent. As such, the amendment of inventorship is considered as a part of entitlement proceedings. Such proceedings can be brought at any time whilst a patent application is pending.

The Comptroller has jurisdiction to determine the question of entitlement to a patent application before grant. The Comptroller can order that:

- An application proceed in different names to those in which it was filed;
- Refuse to grant a patent or order that the application be amended so as to exclude any of the matter in respect of which the question as to entitlement was referred;
- Allow the person who referred the question as to entitlement to file a new application for the material excluded on amendment which can benefit from the filing date of the application in relation to which the referral was made
- Transfer or grant of a licence under the application and fix the terms of the license.

The Comptroller can however decline to deal with any matters regarding entitlement and refer them to the Patents Court.

Can a patent issued from such an application be invalidated or rendered not enforceable on that basis?

The Comptroller has powers to determine entitlement after the grant of the patent provided the reference to the Comptroller is made within two years of grant, unless it can be shown that the registered proprietor knew at the time of grant that he was not entitled to the patent. As with pre-grant applications the Comptroller can decline to consider these issues and refer them to the Patents Court.

Entitlement is a ground of attack on validity, providing that 1) the challenge to validity is brought by someone with a better claim to title; and 2) the challenge to validity is brought within two years from the date of the grant of the patent, unless it can be shown that the registered proprietor of the patent to be revoked knew at the time of the grant of the patent (or transfer of the patent) that he was not entitled to the patent. This attack can be brought before the court or the Comptroller.

The following orders could be granted:

1. An order for the unconditional revocation of the patent;
2. An order that the patent should be revoked unless within a specified time the specification is amended (this amendment can be opposed under s.75 Patents Act).

Does it matter whether the error was intentional or unintentional?

If the error is intentional, this will affect the deadline to challenge the validity of the patent. Where the error is unintentional, the challenge to validity must be brought within two years from the date of the grant of the patent. Where it can be shown that the registered proprietor of the patent to be revoked knew at the time of the grant of the patent (or transfer of the patent) that he was not entitled to the patent, the 2 year deadline does not apply. This attack can be brought before the court or the Comptroller.

- 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.:

The restrictions only apply to applications which contain information relating to military technology, information which is prejudicial to national security or prejudicial to the safety of the public. Public safety is not intended to cover inventions which merely could be dangerous if misused but relates instead to an invention, or information presented in a patent application, which the general public would understand as constituting a threat to their safety and security."^[1]

Footnotes

1. [^] [CIPA Guide to the Patents Acts 7th Edition at 23.02](#)

- 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.

yes

Please comment.:

Yes.

For a patent application to be filed first in another country the foreign filing restrictions require that an applicant obtains a foreign filing permit from the Patent Office^[1] which requires that details of any UK resident applicants or inventors are provided as well as details of the invention. The introduction and summary of invention from the draft patent application will usually provide sufficient detail and the application permit can often be granted within half a day.^[2] There is no government fee for this.

Even when an application is the subject of a secrecy order it may be permitted to form the basis of applications in foreign countries having reciprocal arrangements with this country. An example of such an arrangement is the NATO Agreement for the mutual safeguarding of secrecy of inventions relating to defence and for which applications for patents have been made.

The foreign filing restriction does not apply in respect of an invention for which an application for protection has first been filed abroad by a person resident abroad. Where this has happened, "further applications for the same invention may be filed in other countries by a UK resident without the prior approval of the comptroller."^[3]

Footnotes

1. [^] [Security Section, Room GR70, Intellectual Property Office, Concept House, Cardiff Road, Newport, NP10 8QQ Tel: +44\(0\)16 3381 3558](#)
2. [^] ["Restrictions on the Filing of Patent Applications Abroad by UK Residents"](#)

<http://www.mewburn.com/patents/focus-on-patents/restrictions-on-the-filing-of-patent-applications-abroad-by-uk-residents>[<http://www.mewburn.com/patents/focus-on-patents/restrictions-on-the-filing-of-patent-applications-abroad-by-uk-residents>]

3. [Manual of Patent Practice](#), April 2015, at 23.05

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.:

No.

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?

Residency is the criteria not nationality or citizenship.

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?

yes

Please comment.:

Yes - in certain circumstances.

Our law would be violated but only if the inventor is a resident of the UK and foreign filing restrictions apply because the application contains information relating to military technology, information which is prejudicial to national security or prejudicial to the safety of the public.

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

It is a criminal offence to file an application in contravention of this law and can result in a fine and/or up to two years imprisonment.

It matters if the error is intentional or inadvertent. A person must know or be reckless as to whether filing or causing the application to be filed would contravene the relevant law. A person acting in good faith who believes that the restrictions do not apply will not be guilty of a criminal offence.

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?

A prohibition on publication or further communication of the subject matter is imposed only for

subject matter which might be prejudicial to national security or the safety of the public. The UK Secretary of State provides the UKIPO with a list of technologies which might be considered to be relevant to national security. This list is publically available from the website of the UKIPO. Determining whether subject matter is prejudicial to the safety of the public is left to the Comptroller's discretion.

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

The foreign filing restrictions require that an applicant either:

i. obtains a foreign filing permit from the Patent Office^[1]

Or

i. files first at the UK Patent Office and then waits six weeks before filing abroad (after which, provided no secrecy direction has been given, applications may be made abroad without further formality).

Even when an application is the subject of a prohibition direction it may be permitted to form the basis of applications in foreign countries having reciprocal arrangements with this country. An example of such an arrangement is the NATO Agreement for the mutual safeguarding of secrecy of inventions relating to defence and for which applications for patents have been made. Details of the very special procedures for such conversions and foreign filings will be provided after permission has been granted to file abroad.^[2]

Footnotes

1. [Security Section, Room GR70, Intellectual Property Office, Concept House, Cardiff Road, Newport, NP10 8QQ Tel: +44\(0\)16 3381 3558](#)
2. [Information sourced from the Manual of Patent Practice - January 2015 \(23.04\)](#)

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

It is a criminal offence to file an application in contravention of this law and can result in a fine and/or up to two years imprisonment^[1]. The penalties only apply if the person either knew that they were contravening the law, or was reckless as to whether they were contravening the law.

Footnotes

1. [Section 23\(3\) Patent Act 1977](#)

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 UK law defines inventorship through statute and case law. The case law provides colour to the statute and is sufficiently clear for their purposes. There may be an issue if further definitions of

inventor were added to the current landscape that this may lead to further confusion. There are areas of improvement but the general consensus is that it works well in its current state.

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 United Kingdom does not have such first filing laws other than in areas affecting national security and public safety.

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 UK has laws requiring a secrecy review of patent applications directed to certain inventions made in the UK. Aspects of these laws, including the issues around whether the dissemination of confidential information should be kept outside the patent system. The issues are around, firstly, whether the patent system should be involved in the desire not to disseminate confidential information. Secondly, in this modern age, there is nothing to address of prevent the dissemination of secret information released over the internet prior to a review, or during the review of the patent for secrecy reasons. The claims in the patent may not make it obvious that it has military application.

There is a potential conflict between UK and foreign laws if a patent application has been filed for "secret" subject matter, and was developed by multinational inventors. In these circumstances foreign law may require one of the inventors to first file in their home country whereas UK law may require a UK resident to file first in the UK (if a foreign filing license is not available). This problem may even arise in respect of a sole inventor because UK secrecy provisions apply to UK residents, regardless of nationality, whereas foreign laws may apply to foreign nationals, regardless of residency. This could be an intractable problem for patent applications which include "secret" subject matter.

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.

We consider it somewhat illogical to apply penalties based on the country of filing of patent applications for multinational inventions. If they are multinational inventions the invention will have necessarily already left the country and be known abroad before any patent applications are filed anywhere. Separate laws (perhaps related to national security) seem the appropriate place to control the dissemination of information which a government considers might be prejudicial to the national interest. Using patent filing laws would not correct the dissemination outside the UK which has already happened.

It seems unavoidable that UK law includes some provision for a secrecy review of UK patent applications originating entirely from within the UK (i.e. not multinational inventions). This provides a mechanism for controlling publication or dissemination of information which could be prejudicial to national security. In addition, it seems unavoidable that this secrecy review should be obligatory for inventions made by inventors with a strong connection to the UK (such as residents or nationals). If there was no such restriction then foreign patent applications could be freely filed and become public, to the possible detriment of UK national security.

For these reasons, it is not believed that the secrecy provisions of UK law could be significantly improved to address multinational inventions. The fact that UK's secrecy provisions are triggered only by a narrow range of subject matter makes the system manageable. We suspect that those working in

the relevant narrowly defined fields in the UK are well aware of their obligations and may have other secrecy obligations unrelated to patent law. In this regard, it is welcome that the UK provides a publically available list regarding the types of subject matter that might be considered to be relevant to national security.

III. Proposals for harmonisation

12) Is harmonisation in this area desirable?

yes

Please comment.:

We would strongly support harmonisation in this area and to adopt a simplified procedure in terms of multinational inventorship like in the UK for all technologies other than a narrow range of technologies clearly having possible national security implications..

The growing trend towards globalisation and, in relation to technology focused entities, an increase in the number of research centres that are now based in more than one jurisdiction means that multinational inventorship issues are much more likely to arise. This, together with the lack of alignment in the approach taken towards multinational inventorship in different jurisdictions creates unnecessary and undue legal uncertainty for multinational companies, among other entities, which in turn opens up the door for disputes and litigation to arise in relation to inventorship. This is generally extremely costly, both in terms of time and money, and also detrimental to the advancement of research and development of inventions, which is a key source of revenue for these technology entities, because of the re- allocation of resources to enforcement and litigation activities.

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 believe that any definition of inventorship should take account of the inventive concept or concepts and the assessment of the inventive concept should include an assessment of the whole specification including any claims. A suitable definition might be anyone who made a significant contribution to the formulation of the inventive concept.

The UK Group notes that given the potential for different claims in different countries, or indeed in different divisionals in the same country, there is inevitably scope for different cases deriving from the same application to have different inventors.

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).

It is desirable that incorrect statements of inventorship should be corrected in order to recognize the work of the true inventor(s) of a patent, in principle at any point in time even after grant. The burden in such cases should be on the person seeking correction to show that particular individuals were or were not the true inventors in accordance with the standard articulated in response to the previous question, although in most circumstances any absence of evidence due to the passing of time should be held against the person seeking correction.

However, where a correction could have a further impact on others, such as on ownership (entitlement), right to compensation for employee inventors, right to pursue prosecution/opposition proceedings or even validity (where priority issues are affected), it is appropriate to balance this with the rights of the purported inventors, owners and third parties to rely on the relevant patent register.

In order to achieve that balance, it would be appropriate to provide that any correction does not affect such other issues unless it is (A) sought within a reasonable period of time, (B) carried out with the consent of the affected party or (C) the affected party knew of the mistake at a relevant time.

We believe a reasonable time would be during pendency of the application and within 2 or 3 years of grant of the patent, and that a relevant time would be at the time of grant or of acquisition of the patent, if later.

Finally, if the concept of inventorship and for correction were harmonized, the correction should be available in a single set of proceedings (as is currently the case for entitlement proceedings in relation to patent applications pending before the EPO).

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 UK Group does not believe that a first filing requirement is appropriate, and the difficulties which arise with multinational inventions make such a requirement even less appropriate.

However, if there is such a requirement, it should reflect the reality of where knowledge of the invention is actually located before patent applications are filed. Therefore, any obligation to file in a particular country should be based on residency rather than nationality. With regard to multinational inventions the reality of the matter is that knowledge of the invention is already at least in the countries where the various inventors are resident. The first filing could therefore be in any of those countries where an inventor is resident.

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.

We consider that the patent system is not the right arena to control the dissemination of information potentially prejudicial to national security. This is better done through export control laws rather than as part of the patent filing system itself.

Any secrecy review regime should be limited to exclude technologies whose dissemination clearly has no implications for national security or public safety. The regime should include a publicly available and limited list of the types of technologies which may be the subject of a secrecy order and for which permission should be sought for patent filings abroad. The list should be a harmonized one.

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

Each country will want to have the freedom to assess its national security requirements as it sees fit. An international harmonized and comprehensive list setting out exactly the technologies for which it will and will not be possible to obtain a foreign filing licence seems unrealistic. However, an agreement that foreign filing will only be refused for technologies having national security and public safety implications seems a sensible and valuable compromise.

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.

Criminal prosecution bodies are unlikely to be in a position to give retroactive confirmation that acts committed will not be the subject of future criminal sanctions. The UK regime where criminal sanctions do not apply unless the offence was knowingly or recklessly committed seems a sensible and proportionate compromise. A harmonized list of technologies subject to a first filing or security review requirement should reduce the risk of inadvertent failures to comply.

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.

Summary

The UK Group supports harmonization to adopt a simplified procedure for multinational inventorship for all technologies other than a narrow range of technologies having possible national security implications.

We believe that any definition of inventorship should take account of the inventive concept or concepts and the assessment of the inventive concept should include an assessment of the whole specification including any claims. A suitable definition might be anyone who made a significant contribution to the formulation of the inventive concept. It is desirable that incorrect statements of inventorship should be corrected in order to recognize the work of the true inventor(s) of a patent. However, it is appropriate to balance this with the rights of the purported inventors, owners and third parties to rely on the relevant patent register.

The UK Group does not believe that a first filing requirement is appropriate, and the difficulties which arise with multinational inventions make such a requirement even less appropriate. However, if there is such a requirement, it should be based on residency rather than nationality.

We consider that the patent system is not the right arena to control the dissemination of information potentially prejudicial to national security. This is better done through export control laws rather than as part of the patent filing system itself.

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