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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 statute in force concerning invention is Uruguayan Patent Law No. 17.164 dated September 2, 1999 (hereinafter referred to as "the Patent Law"). The Patent Law does not define inventorship.

Chapter II of the Patent Law refers to the issue of "ownership of patents" (as per article 16 quoted below), and sets the rule that the right to a patent will belong to the inventor or to his successors in title, but fails to address the issue, and does not provide a concept or definition of who will be deemed to be an inventor.

As expressed above, this issue is not addressed by the Patent Law. However, and due to the fact that our law does not define nor limit the term "inventorship", we understand that every person contributing (in a non-frivolous manner) to an invention would be considered an inventor. In the mentioned example, we understand that both A and B would be considered co-inventors.

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:

Uruguayan Patent Law does not define inventorship.

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

no

Please comment:

Please refer to ours answers above regarding the lack of definition of inventorship. However, and due to the fact that our law does not define nor limit the term "inventorship", we understand that the term "inventorship" does not depend on the citizenship of the inventor.

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:

Please refer to ours answers above. However, and due to the fact that our law does not define nor limit the term "inventorship", we understand that the term "inventorship" does not depend on where the invention was made.

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?:

Pursuant to article 30 of the Patent Law, a patent application may be modified, among other things, to rectify errors in the information contained therein.

As to requirements, pursuant to article 30 of the Patent Law, "Patent applications may not be modified, except in the following cases:

*(a) to rectify errors in the data, the text or the graphic representation;*

*(b) to clarify, explain, limit or restrict their subject matter;*

*(c) when required by the examining officials.*

*No modification, rectification or clarification implying an extension of the information in the original application shall be permitted".*

As to time limit, there is no express time limit imposed in the Patent Law to perform such correction. However, since the law refers to the possibility of correcting "Patent applications", it would appear that such corrections may only be performed while the application is pending.

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 Patent Law distinguishes between cases of nullity and invalidity.

Articles 44, 45 and 46 of the Patent Law provide as follows:

“44. Patents shall be null in the following cases:

*(a) if they have been granted in violation of the patentability criteria and requirements set out in this Law;*

*(b) if the description was incomplete or inaccurate and did not allow the subject matter of the invention to be defined;*

*(c) if material not included in the original application is claimed, in accordance with the provisions of this Law.*

45. Patents granted to persons who have no right to obtain them shall be invalid.

*A complaint may be filed by the person who claims to be the true owner within five years from the date of granting the patent or three years from the date on which the invention started to be exploited in Uruguay, whichever expires first.*

46. *When the complaint only relates to all or part of any claim concerning the patent, the decision shall be limited to the claim, whose scope must be defined, where applicable”.*

From the above, it appears that the Patent Law has distinguished between cases of “nullity” (such as the breach of the patentability criteria, art. 44), and cases of “invalidity” (the latter, being subject to a statute of limitations, and which the law would appear to allow to be cured by the lapsing of the term for the alleged owner to claim ownership). In addition, the Patent Law contemplates partial effects of the complaint, in article 45.

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:

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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:

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## 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?
Uruguayan Patent Law does not define inventorship. It would be desirable to have the law provide with such a definition to provide with clear guidance on who should be named as inventor(s) of a given patent application.

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?
As mentioned above, there are no requirements in Uruguay for first filing of patent applications.

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?
No requirement to that end is provided in Uruguay.

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.
N/A.

### III. Proposals for harmonisation

12) Is harmonisation in this area desirable?
no Please comment.:
In the current stage of the legislative evolution in Uruguay, where the law lacks of a definition of inventorship, it is still too early to promote harmonization as regards our jurisdiction.

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.
In the current stage of the legislative evolution in Uruguay, where the law lacks of a definition of inventorship, it is still too early to promote harmonization as regards our jurisdiction.
Every person who contributes, in a non-frivolous manner, to the construction/creation of a patentable invention, will be deemed an inventor, regardless of his/her nationality, citizenship or residence.

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).

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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.

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#### Summary

EN. Uruguayan Patent Law does not contain a definition of inventorship. Similarly, it does not contain requirements for first filing of patent applications in Uruguay for patents claiming an invention made in our country. It does also not contain any provisions concerning a requirement that a patent application claiming an invention made, at least in part, in Uruguay undergo a secrecy review or similar process before it can be filed in another country. Patent applications may be corrected to rectify errors in the data, the text or the graphic representation. Since Uruguay lacks of definitions regarding the above issues, it is too early in our legislative development to propose harmonization principles or standards.

FR. Le droit uruguayen des brevets ne prévoit aucune définition concernant l'inventeur. De même, il n'établit pas d'exigences concernant le premier dépôt de demandes de brevet en Uruguay pour des brevets qui revendiquent une invention créée en territoire uruguayen. Le droit uruguayen ne prévoit pas de dispositions relatives à l'exigence, concernant à une demande de brevet revendiquant une invention créée, en moins en partie, en Uruguay, d'être objet d'un examen secret ou d'un procès

similaire avant de pouvoir être déposée à l'étranger. Les demandes de brevet peuvent être corrigées pour rectifier des erreurs dans les données, le texte ou les images. Étant donné que l'Uruguay n'a pas de définitions relatives aux questions susmentionnées, notre développement législatif n'a pas atteint un niveau où l'on pourrait proposer d'harmoniser les principes ou les standards.

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

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