

Resolution

Question Q244

Inventorship of Multinational Inventions

Background:

- 1) This Resolution concerns the issue of inventorship of inventions where the inventors reside in different countries, have different citizenship, or have employment contracts under different national laws.
- 2) Due to the prevalence of international corporations having geographically distributed research groups, multinational joint venture projects, international corporate/university collaborations, and other cross-border research projects, and further due to the ease of international communications and exchange of data, international joint inventorship is today a common occurrence.
- 3) The Question leading to this Resolution focused on two issues that are important to multinational inventions: determination of inventorship in the context of multinational inventions; and national requirements relating to foreign filings.
- 4) For the purposes of this Resolution, **multinational inventions** means inventions conceived by two or more inventors where different national laws concerning inventorship apply to at least two of the inventors. For example, a first inventor of citizenship X resides in country X and is a co-inventor of a joint invention co-invented by a second inventor of citizenship Y residing in country Y. However, different national laws may apply if they are of the same citizenship, but reside in different countries, or if they reside in the same country, but are of different citizenship or have employment contracts under different national laws.
- 5) Also for the purposes of this Resolution:
 - a. **first filing requirement** means a procedural requirement that a patent application for an invention – be it all inventions or only inventions in certain technology areas – that is made or partially made in a country be filed first in that country before filing in any other country;
 - b. **foreign filing license** means any procedure or mechanism for obtaining an exemption from a first filing requirement; and
 - c. **secrecy review** refers to a substantive review by a governmental authority of the subject matter of a patent application to determine whether it impairs national security or other national interests, or includes subject matter that must be kept secret.

- 6) The definition of who is an “inventor” differs significantly among the various jurisdictions, with some jurisdictions having no established definition. The importance of making a proper determination of inventorship also varies greatly, from being of no importance at all to being a basis for annulling the patent or holding the patent unenforceable.
- 7) National requirements relating to foreign filings vary significantly from jurisdiction to jurisdiction. In some countries a patent application must be first filed in the country where the invention was made. In some countries, a foreign filing license or procedure for requesting secrecy review prior to foreign filing is available. In other countries, there are no requirements or limitations on foreign filings. Penalties for violation of foreign filing requirements include invalidity of the patent and possible criminal liability.
- 8) Technology export control laws separate from patent filing and secrecy review laws exist to control the export of technology potentially prejudicial to national security and safety.
- 9) As simultaneous compliance with all relevant national laws can be difficult or even impossible, it is highly desirable to have:
 - a. a harmonized definition of inventorship that would be uniformly accepted in the case of multinational inventions; and
 - b. a harmonized process by which multinational inventions could be filed internationally in a manner that complies with legitimate national security interests while avoiding conflicting national foreign filing requirements.
- 10) It is also desirable to adopt international and national provisions which should be aimed at minimizing occurrence of conflict of laws.
- 11) 43 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General of AIPPI and distilled into a Summary Report. The individual Reports and the Summary Report are available on the AIPPI website www.aippi.org. At the AIPPI World Congress in Rio de Janeiro, the subject matter of this Resolution was further discussed within a Working Committee and again in a full Plenary Session, which led to the adoption of the present Resolution by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) A person should be considered a (co-)inventor if they have made an intellectual contribution to the inventive concept. The inventive concept shall be determined on the basis of the entire content of a patent application or patent, including the description, claims and drawings.
- 2) The rule to determine intellectual contribution of an inventor should be consistent regardless of the residency or location of the inventor, their citizenship, the governing law of the employment, or the country in which the intellectual contribution was made.

- 3) Pending a harmonization to this effect, national laws should: (i) take into account provisions whereby the co-inventing parties would elect a single applicable law; and/or (ii) include provisions that would minimize conflict of laws.
- 4) All patent offices should provide administrative mechanisms to record corrections of designation of inventors with respect to a patent application or patent at any time after the filing date.
 - a. Requests for correction of designation of inventors should be allowed if either: (i) all previously named inventors and applicant(s) consent; or (ii) an inventor or applicant/proprietor provides evidence that is *prima facie* sufficient to establish that the request correctly names all co-inventors based on the criteria set out in paragraph 1) above.
 - b. Applicants/proprietors and inventors should not be penalized in cases where the designation of inventors has been corrected. This is without prejudice to any party bringing legal proceedings and obtaining appropriate remedies where its rights are adversely affected by the correction.
 - c. In countries where the designation of the inventors only requires a declaration by the applicant, corrections of the designation of inventors should only require a new declaration by the applicant. Mechanisms available to inventors to complain about the original declaration should be available to complain about the correction.
- 5) No country should impose a first filing requirement, require a foreign filing license, or insist on a prior secrecy review. Notwithstanding, if this cannot be achieved, the following principles should be applied:
 - a. If a first filing requirement is nonetheless maintained, such requirement should not apply to inventions of which a co-inventor is resident in, or who is a citizen of, another country.
 - b. A foreign filing license obtained in a jurisdiction should exempt all co-inventors from first filing obligations in, and obtaining foreign filing licenses from, any other country.
 - c. If a secrecy review or first filing requirement is maintained, foreign filing licenses should be made available at a reasonable cost and within a reasonably short time period. If that time period expires with no answer from the competent body, a tacit consent for foreign filings should apply.
 - d. If a secrecy review is maintained, such review should be limited to predefined technical fields in which inventions could affect national security and safety, and sufficient information should be published about such fields to enable inventors to understand whether a secrecy review is required.
- 6) Governments should have a duty to update secrecy review orders with reasonable frequency. Where the subject matter covered by the secrecy order has become publicly available through a source other than the inventor or applicant, the secrecy order should be lifted.
- 7) Governments should put in place effective means to protect the legitimate interests of parties that may be adversely affected by the imposition or lifting of a secrecy order.

Links

- Working Guidelines
<http://aiippi.org/wp-content/uploads/committees/244/WG244English.pdf>
- Summary Report
<http://aiippi.org/wp-content/uploads/2015/10/SR244English.pdf>
- Group Reports page
<http://aiippi.org/event/2015-aiippi-world-congress/#group-reports>