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How should companies identify inventors for their patent applications under French, German and US law ?



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French Law - Definition of the inventor

- Art. 611-6 IPC : the invention belongs to the **inventor** or his/her successor in title
- No legal definition of the inventor
- P. MATHELY: « The invention consists of means capable of achieving a result. Consequently, the inventor is the person who discovers the means”
- Analysis of case law: no constant definition
- Paris First Instance Court (18/09/15): “the definition of the inventor is related to the definition of inventive step, consisting in being the author of a technical solution to a technical problem”

French Law - Definition of the inventor

- French Group of AIPPI: *“An inventor is a natural person who conceives and/or reduces to practice, alone or with others, an invention. Accordingly, inventorship should be assessed by evaluating, as of the date of the invention, the contribution made to the state of the art known by the inventors on this same invention date”*.
- An inventor has the right to be named in an application but he can renounce
- Rebuttable presumption of inventorship

French Law – Contribution which is necessary to be considered as inventor

- No specific standard = question of fact
- Must establish that the person played **an active role at the stages of formalization, technical development and finalization of the invention**
- Do not confuse with authorship

Kind of works not sufficient

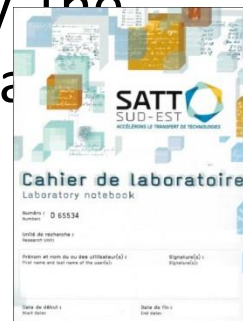
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|---|--------------------------------------|
| ➤ Management and coordination of research works | ➤ Suggesting an idea |
| ➤ Establishing the results to be achieved | ➤ Contributing in an obvious element |
| ➤ Simple tasks of implementation | ➤ Financial contribution |
| ➤ Simple testing operations | ➤ Supervision of routine techniques |
| | ➤ Title of « Department Head » |

French Law – Possible consequences of wrong inventorship

Personnel consequences	<ul style="list-style-type: none">• Feeling to be set aside / Frustration• Lost of peer recognition• Lost vis-à-vis potential employers
Legal consequences	<ul style="list-style-type: none">• No consequences on validity or enforceability (whether intentional or not)• Relative nullity (Decision LIZARARU)• Risk of co-ownership claim (and impact on priority and agreements)
Financial consequences	<ul style="list-style-type: none">• Risk of damages sought by the forgotten inventor (Decisions UNITECNIC and TELECOM DESIGN)• Number of inventors and contribution of each inventor are taken into account for the amount granted to each employee inventor

French Law – Practical guidance

- R&D agreement: inventorship can not be pre-defined
- Timing of the designation: 16 months from the application
- Good record-keeping practices (laboratory notebooks)
- Establish a proper declaration of invention to simplify the inventorship determination (names of the inventors, start and end of contribution...)
- Inventorship review by Patent Attorney



German Law – Definition of the inventor

- § 6 PatG (Patent Act):

“The right to a patent shall belong to the inventor or his successor in title. If two or more persons have jointly made an invention, the right to the patent shall belong to them jointly.”

- Definition of inventor in case law:

- BGH 17.10.2000 – Rollenantriebseinheit; BGH 17.05.2011 – Atemgasdrucksteuerung; BGH 22.01.2013, BGH 18.06.2013: **«creative contribution »**

- not only claims, but:

- entire content of the application including description, figures,
- preferred embodiments, dependent claims
- any advantageous concretisation of the invention
- contribution does not need to be in itself inventive

German Law – Owner of the invention

- (co-)inventor = (co-) ownership
- special rules for employee inventors: ArbeG (Employee Inventor Act)
 - §5 employee: obligation to disclose invention
 - §6 employer: option to claim ownership (legal presumption)
 - §7 transfer of ownership
 - §9 employer: obligation to pay reasonable remuneration (cf. Directives for Remuneration of Employees)

German Law – Contribution which is necessary to be considered as inventor

- creative contribution to the invention as disclosed in the patent application (entire content relevant)

=> any contribution may be relevant, but needs to have a creative character, beyond mere routine measures (« qualified addition »)

no creative contribution

- | | |
|--|--------------------------------------|
| ➤ Simple tasks of implementation based on instructions | ➤ Contributing in an obvious element |
| ➤ Simple testing operations based on instructions | ➤ Financial contribution |
| | ➤ Supervision of routine techniques |

German Law – Possible consequences of wrong inventorship

Legal consequences	<ul style="list-style-type: none">• Fraudulent abstraction: ground for revocation or invalidation (§§21, 22 PatG)• Co-ownership claim (and impact on priority)• Impact on granted licenses
Financial consequences	<ul style="list-style-type: none">• Indemnity for use of the invention / Employee inventor compensation• Impact on distribution of remuneration among co-inventors

German Law – Practical guidance

- Employee inventions:
 - Establish proper handling of the requirements of the German Employee Inventors Act (timelines, formalities)
 - Define coherent company policy for remuneration and recognition of employee inventors; include transparent criteria in communication with employees (e.g. Directives for Remuneration of Employees)
- R&D cooperation:
 - clear contractual allocation of ownership of patent rights
 - documentation of mutual contributions
 - monitor filing activity of parties involved

U.S. Law - Definition of the inventor

- **Primarily Defined By Caselaw:** “*Conception is the touchstone of inventorship*” See *Sewall ... 30 USPQ2d 1356 (Fed. Cir. 1994)*
 - What is Conception ?: “the formation in the mind of the inventor, of a ***definite and permanent idea*** of the ***complete and operative invention...***” See *Hybritech... 231 USPQ 81 (Fed. Cir. 1986)*
 - Definite and permanent Idea: General research plan or goal is not enough, must recognize ultimate result.
 - Complete and operative invention: “Only ordinary skill would be necessary to reduce ... to practice, without extensive research and experimentation” See *Sewall*
 - Reduction to Practice: Related concept, but *not* required
 - Neither Actual (e.g. physical model) nor Constructive (e.g. patent application)
 - Corroboration of Conception:
 - Lab Notebook: Define completed invention; date and witness by non-inventor
 - Meeting minutes, e-mails etc.

U.S. Law – Contribution which is necessary for person to be considered as inventor

- **Claims only:** conception of claimed invention (not Spec.)
 - Can change during prosecution
 - Turns on claim construction *See Univ. Of Pittsburg 573 F.3d 1290 Fed Cir. 2009)*
- **Joint Inventorship:** Some collaboration on conception is needed
 - Type of collaboration: Must at least be aware of each other
 - 35 USC §116: Recognizes modern R&D setting (at different time and/or place)
 - Type of contribution: amount or type need not be same (1 claim)
- **Use services, ideas and aid of others ≠ Joint Inventorship**

Kind of works not sufficient*

- | | |
|--|---|
| ➤ Posing a problem to be solved without a solution
-e.g. Customer Specs | ➤ Author description of Invention
- e.g. co-author; patent drafter |
| ➤ Reduction to Practice
-e.g. outsource prototype
-e.g. patent attorney drafting | ➤ Directed research and/or experimentation
- e.g. Univ. research assistant |
| | ➤ Financial investment in research |

U.S. Law – Implications for Inventorship

- U.S. Constitution: established patent system to reward inventors
- Procedural Safeguards for Inventors: AIA note
 - 35 USC §102: Defines prior art & exceptions based on inventorship
 - 35 USC §115: Application must name inventors & Inv. Declaration reqd.
 - 35 USC §116: Inventors must apply together
 - 35 USC §118: Non-Inventor Applicant must show ownership interest before issue
- 35USC §262 Ownership: Inventor(s) *presumed* owner(s) unless:
 - Written Assignment or Obligation to Assign
 - Employment Agreements: E'ee “hereby assigns” *see Stanford...563 U.S. 776 (2011)*
 - Recorded in the PTO- Translation required
 - Implied Assignment Possible: E'ee “hired to Invent” or fiduciary duty
 - Not so-called “shop rights”
 - Marginal inventor of even one claim *owns entire patent right*
- U.S. Export Controls: For Inventions made in the U.S.
 - Foreign filed patent application without license may invalidate counterpart U.S. Patent
 - Export of U.S. R&D to non-U.S. headquarters

U.S. Law – Possible consequences of wrong inventorship

- **35 USC § 256: Savings Clause**

“ The error of omitting inventors or naming persons who are not inventors *shall not invalidate the patent* in which such error occurred *if* it can be corrected... ”
- **Correction of Inventorship: generally easy**
 - AIA: no longer need to state lack of deceptive intent
 - Application: generally, only Inventor Declaration and Fee
 - Issued Patent:
 - Certificate of Correction (Statement from Inventors and Assignees)
 - Reissue Application
 - Court Order
- **But Patentee may be barred from correcting**
 - Unenforceability due to Inequitable Conduct
 - Omitted Inventor: Patentee failed to satisfy Duty of Disclosure?
 - Inclusion of Non-Inventor: Patentee tried to hide actual prior art?

U.S. Law – Possible consequences of wrong inventorship

Unenforceability	<ul style="list-style-type: none">• Difficult 2 step process<ol style="list-style-type: none">1) Must prove error by <i>clear and convincing evidence</i>2) Must prove intentional misrepresentation also by <i>clear and convincing evidence.</i>
Change of Ownership	<ul style="list-style-type: none">• Patentee loses exclusive rights• Omitted Inventor's revenge<ul style="list-style-type: none">- Rule 291 protest against pending application- § 256 Court action to correct inventorship- may be well funded by accused infringer
Financial	<ul style="list-style-type: none">• Omitted inventor civil damages<ul style="list-style-type: none">- Unenforceability due to Inequitable conduct• Leverage for licensees
Other	<ul style="list-style-type: none">• May unknowingly file foreign application on U.S. Invention without the required license<ul style="list-style-type: none">- generally correctable by retroactive license, but \$

US Law – Practice Tips

- Strategic claim drafting
 - avoid unintended joint inventors
- Ownership agreements
 - Employment Agreements: E'ee “hereby assigns” to E'er
- International R&D
 - Foreign filing licence for inventions made in the U.S.
- Inventorship still Important in U.S. after AIA
 - Inventor Declaration required – possible abandonment
 - Corroborating Evidence of Conception (lab notebooks)
- US Inventors ≠ German Inventors
- No Employee Inventor Act in US
- EDPA