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AIPPI approves Resolution on Multinational Inventions in Río

Miquel Montañá (Clifford Chance) · Friday, October 16th, 2015

One of the challenges raised by today's inventions, which are often the result of research efforts carried out by teams comprised of scientists based in multiple jurisdictions, is how to comply with national requirements which sometimes entail contradictory obligations. For example, let's imagine a situation where an inventor is subject to the laws of country A and a co-inventor is subject to the laws of country B. If both country A and country B require them to file the patent application first at their respective patent offices, the co-inventors would be placed in an impossible situation.

In an attempt to address this type of concern, at the annual meeting held in Río de Janeiro this week, the AIPPI approved a Resolution on Question Q 244 "Inventorship of Multinational Inventions", which reads as follows:

"**AIPPI resolves that:**

1) A person should be considered a (co-)inventor, if he or she has 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, his or her citizenship, the governing law of the employment, or the country in which the intellectual contribution was made.

3) Pending an 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 which 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. 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 which is *prima facie* sufficient to establish that the request correctly names all co?inventors based on the criteria set out in paragraph 1) above. 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.

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. The 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 having a co-inventor 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."

In this author's opinion, the Resolution has fallen short of the expectations of those who had hoped that the AIPPI would have made more positive and meaningful proposals. The National and Regional Groups had drawn up forty-three highly detailed reports which contrast sharply with the poor text of the Resolution finally approved. However, this Resolution will hopefully be the first step towards paving the way for future harmonization of the laws affecting multinational inventions, for example, in the context of the World Trade Organization.

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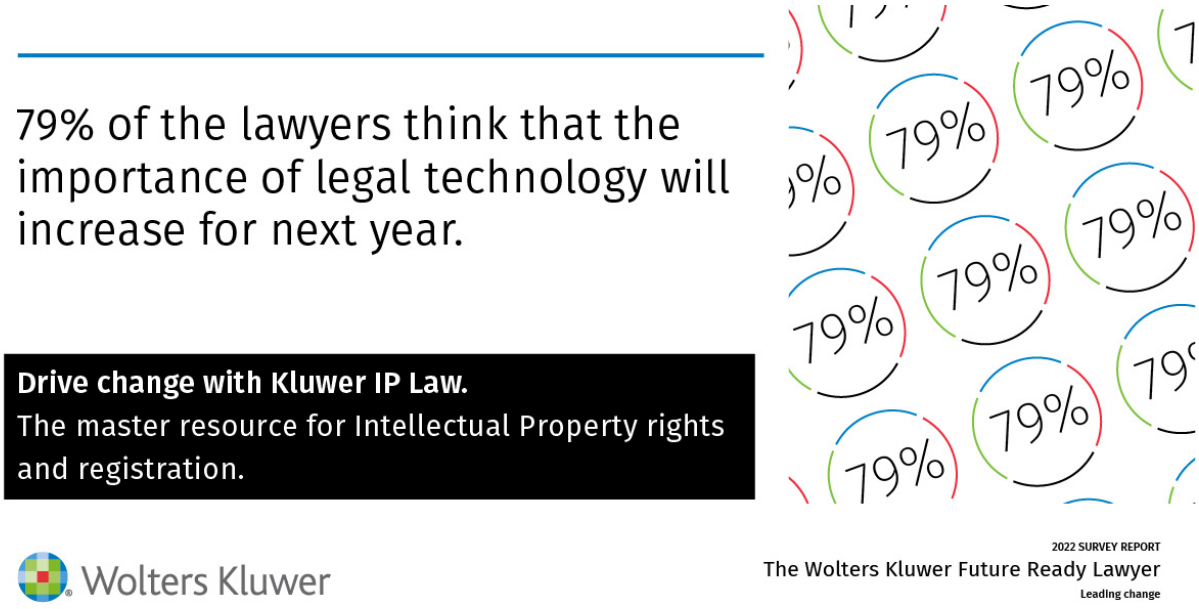

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