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"You Are Not Alone" Co-inventorship Requirements Further Clarified in Germany

Thorsten Bausch (Hoffmann Eitle) · Thursday, April 25th, 2013

The Federal Court of Justice in Germany held in its recent judgment of January 22, 2013 (court docket: X ZR 70/11) that to claim co-inventorship the contribution of the co-inventor need only be found in parts of the description of the patent and does not have to be found in the claims. The Court stated that an invention manifests itself throughout the entire patent specification which includes the claims, the description with examples, and the figures. Therefore, if a co-inventor's contribution is included in the description this is sufficient to establish co-inventorship. The claims of the patent only have a limiting function as they exclude embodiments in constellations where embodiments are contained in the description, but not covered by the claims.

In the underlying case, the inventorship of a drilling tool particularly suited to precisely cut solid metals without becoming blunt was disputed by the parties. The defendant had requested the plaintiff in 2002 to develop a prototype for its customer which was subsequently delivered. Both plaintiff and defendant continued the development of the tool in joint meetings, but the defendant filed a patent application in 2003, indicating its managing director as inventor. The patent was granted in 2006 (EP 1 382 410 B1).

After grant, the plaintiff claimed that the key point of the invention and its technical details, i.e. a drilling machine with three cutting edges and a centering device, had actually been made solely by its employees. The Regional Court Mannheim in its decision of November 24, 2009 (2 O 278/07) and upon appeal the Higher Regional Court of Karlsruhe in its decision of May 11, 2011 (6 U 185/09) both rejected the plaintiff's claim for sole inventorship.

The courts held that the evidence presented could not prove that it was the plaintiff who first had the idea to provide the drilling machine with three edges and a centering device. However, it was proven that the plaintiff had contributed details to the development of the drilling tool, such as a number of details regarding the geometry of the angles of the cutting edges to the cutter head. According to the Higher Regional Court, as these defined angles had not been included as features in the claims, this contribution of details could not serve to establish co-inventorship.

The Federal Court of Justice has now reversed these rulings. The FCJ first confirmed what had been established by the prior instances, namely that the plaintiff could not provide evidence that it had invented the key idea of the invention, i.e. to provide the drilling machine with three edges and a centering device. Therefore it was correct to reject the claim to sole inventorship. However, the Court remanded the case to the Higher Regional Court Karlsruhe for examination of whether the

plaintiff must be considered as a co-owner of the patent since one of its inventors had contributed some of the details of the invention which are mentioned in the description (e.g. par. 16, 23, 32, 35 and 37) and which are to be found in the claims 8 and 9 of the patent. The contribution of the plaintiff thereby specifies the precise embodiments of the drilling tool which are covered by the claims in a more general form and is therefore also a contribution to the invention as a whole.

The Court thereby further clarified and confirmed its two prior decisions in this regard, i.e. “Biedermeiermanschetten” of February 20, 1979 (X ZR 63/77) and “Atemgasdrucksteuerung” of May 17, 2011 (X ZR 53/08). These two decisions established that to determine inventorship not only the patent claims but also the entire patent and the history of the invention have to be taken into account.

This latest decision of the Federal Court of Justice should be taken as a word of warning to anyone in an R&D co-operation to thoroughly check the contributions of individual parties to any inventions and to clearly regulate by contract the rights of each party. This dispute claiming a right to a patent took more than five years and it is still not resolved. This was certainly expensive and not conducive to exploitation of the joint invention.

Esther Pfaff

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