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Challenges raised by multinational inventions to be discussed at the next AIPPI Annual Meeting in October: some proposals from Spain

Miquel Montañá (Clifford Chance) · Friday, August 21st, 2015

One of the issues which will be discussed at the next annual meeting of AIPPI, due to take place in Rio de Janeiro in October 2015, is Q244, entitled “Inventorship of multinational inventions.”

In today’s world, it is becoming increasingly frequent for inventions to be the outcome of teamwork conducted by persons from different jurisdictions. This, coupled with the lack of a universally-accepted concept of “inventor” and the “local first-filing requirement” contained in the laws of many countries, raises formidable challenges for applicants. Sometimes they are confronted with legal requirements from several countries which cannot be simultaneously fulfilled, which places applicants in an impossible position.

The Spanish Group of AIPPI has offered its two cents to this debate. For example, it has proposed a definition of “inventorship” whereby “the inventor should normally be the creator, conceiver and/or originator of any or all of the patentable invention elements / subject matter.” According to this definition, “a person who simply organizes the process (by providing funds, infrastructure or administrative services) and / or performs auxiliary functions during the invention process should not normally be considered an inventor”.

In addition, the Spanish Group has proposed an international standard for first filing requirements which would take into account multinational inventions.

According to the report produced, “the Spanish Group considers that “first filing requirements” are outdated and that, therefore, it would be desirable for countries to cooperate so that these types of requirements are abandoned.

However, the Spanish Group understands that there may be specific circumstances (for example, when an invention may affect national, regional or international security) where measures aimed at preventing the general disclosure of an invention may be justified. To address these situations, the Spanish Group proposes the following standard:

1. If a country is a party to the NATO Agreement on Safeguarding Defence-Related Inventions of 21 September 1960, or to an international treaty containing similar secrecy obligations for the parties to the treaty, and according to the law of a party to such treaty the patent application should be filed first in that country, the patent applicant should also be allowed to file its patent

application first before any of the countries which are a party to such treaty, provided that the parties to such treaty comprise the country where the invention was made.

2. Subject to paragraph 1, for the purpose of determining whether a country is allowed to require that a patent application for an invention be filed first in that country, the following principles should apply:

a. A country may require that a patent application for an invention be filed first in that country if the invention has been made in that country, regardless of the permanent residence of the inventors.

b. Where the invention has been the result of activities carried out in more than one country:

i. A country may require that a patent application for an invention be filed first in that country, if said country is the country where the most substantial intellectual contribution to the invention has been made.

ii. In the absence of evidence to the contrary, it will be presumed that the country where the most substantial intellectual contribution to the invention has been made is the country where the invention was conceived (i.e. the country where the original idea for the invention was proposed). However, where inventors other than the inventors who conceived the invention carried out activities that solved problems not identified by the former, and/or that they could not solve, and solving such problems was necessary to put the invention into practice, the country where the most substantial intellectual contribution to the invention has been made will be presumed to be the country where the activities that solved such problems were carried out.

3. If a country establishes penalties for applicants who fail to comply with First Filing Requirements, such penalties should only apply if the invention concerned is directly related to national defence, and according to the corresponding national authorities, the patent should have been prosecuted in secrecy. Any penalties should be reasonable and commensurate to penalties established for failing to comply with other similar administrative requirements. In particular, such penalties should not include the loss of the rights deriving from the patent application."

This is just one example of the tricky aspects raised by multinational inventions on which the AIPPI national groups have been asked to make specific proposals for harmonization.

Hopefully, at the forthcoming meeting planned for October, after having digested all the proposals received by all national groups, AIPPI will be able to shed some light in the dark landscape of multinational inventions.

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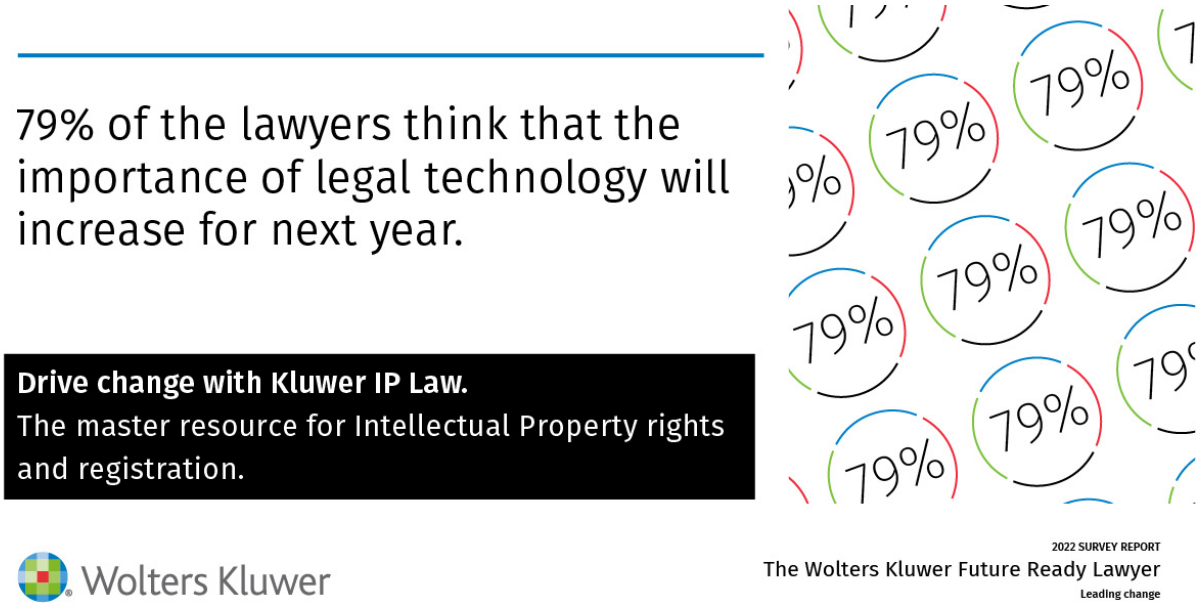

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