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The metamorphosis of the trainee into an employee inventor

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This almost unnoticed metamorphosis, which has been hardly or not at all commented on, is nevertheless an important reform of French law.

Order 2021-1658 of 15 December 2021 extends the system of devolution of rights in respect of software (Article L. 113-9-1 of the Intellectual Property Code) and employee inventions (L. 611-7-1 of the Intellectual Property Code) to natural persons who do not have an employment contract or the status of public employee and who carry out missions within and with the resources of a public or private legal person carrying out research. The persons concerned are in particular trainees, foreign doctoral students, professors or directors.

It is, more particulary, a regulatory response to the dispute between the CNRS and one of its trainees. Indeed, the Court of Cassation, in a decision of 25 April 2006, had retained the assignment to the trainee of the patent right on the invention developed during his internship (Cass. com., 25 April 2006, n° 04-19.482). The Court of Appeal had nevertheless held that the CNRS was the successor in title to the trainee because of the stipulations of the internal regulations, which provided for the devolution to the CNRS of the rights to the inventions made within it by the students. It was nevertheless up to the administrative judge to assess the legality of the said regulations (CA Paris, 12 September 2007, RG n° 06/15211). The Paris Administrative Court ("Tribunal administratif" – TA Paris, 11 July 2008, n° 0717692) and then the Council of State ("Conseil d'État" – CE, 22 February 2010, n° 320319) ruled that the regulation was illegal, on the grounds that it was ultra vires, because it meant that the users of this public service were stripped of their industrial property rights.

This reform, which is the result of an economic rationale, aimed at preventing a trainee from holding patent rights (i.e. the right to file a patent application) and copyright (on software), is difficult to justify from a textual point of view. Indeed, there is no salary relationship, so the attribution of the results of the activity carried out in the simple framework of an assignment is not justified. However, from a fundamental point of view, beyond this textual logic, legal certainty must prevail.

There is little doubt that the automatic devolution of patent rights and copyright (on software) strengthens legal certainty. The fact remains, however, that this surgical reform, in that it only targets two rights, will not solve all the problems. In other words, employers will still be obliged to use the contractual route to ensure that other creations can be covered, for example the copyright in a software interface.

Let us therefore hope that in the future the parties concerned will be consulted this time, so as to avoid a piecemeal reform and to prefer a comprehensive harmonisation.

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