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Inventorship of Multinational Inventions (Q 244)

REPORT OF SWISS GROUP*

Questions

I. Current law and practice

1. Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

In the Swiss law there is no explicit definition of "*inventorship*". In particular, Swiss statutory law does not define the substantive requirements for a person contributing to the making of an invention to be considered an inventor. It is left to the courts to establish and describe such requirements.

With respect to the rights associated with the status of an inventor, Article 3(1) of the Swiss Patent Act sets forth the general principle that the inventor, his/her successor in title, or a third party owning the invention under any other title has the right to the legal position of a patentee, the right to file a patent application, and the right to the grant of the patent. These rights can only be established in a natural person who has fully conceived the inventive idea.

A reduction to practice of the invention is not necessary; the technical details which may be found by routine work do not have to be elaborated, it is sufficient if the conceptual idea has been developed to such a degree that someone of ordinary skill in the relevant field can understand and work the invention.

If several people contribute to the inventive idea, they are to be considered joint inventors.

The creator(s) of the inventive concept are the inventor(s).

This general principle is supplemented by employment law provisions. On the one hand, Article 332 of the Code of Obligations states an exception to the principle that the right to the grant of a patent originally belongs to a natural person. Pursuant to this provision, an invention produced by an employee in the course of his/her work for the employer and in performance of his/her contractual obligations automatically and *ab initio* belongs to the employer by virtue of the employment. Accordingly, the employer has the right to the legal position of an applicant or patentee. On the other hand, if the invention is performed in the course of the employee's work but not in performance of his/her contractual obligations, the employer may reserve the right to acquire such an invention. Any invention produced otherwise belongs, as a free invention, to the inventor.

The inalienable right of the inventor to be mentioned always remains with the inventor. The inventor(s) may, however, waive the right to be mentioned.

The European Patent Convention (EPC) does not explicitly define the term "*inventorship*" either. According to Article 60(1) EPC, "*the right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee, the right to a European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has the place of business to which the employee is attached*."

Basically, the EPC refers to national law when it comes to define the term "*inventorship*".

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The case of several inventors is not explicitly dealt with in the EPC. Rule 19(1) EPC refers to the case that the applicant is *not the sole inventor*.

a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

If, on the one hand, the efforts of person B are directed by person A such that person B is not involved in the creation of the technical solution to the problem addressed by the invention, but merely acts under person A's instructions, or in other words, if person B is not contributing to the inventive idea, person B is not considered an inventor under Swiss law. Only if person B contributes to the inventive idea, person B may be regarded as one of the inventors.

If, on the other hand, person A only hints general directions but is not supporting person B in defining or solving the technical problem addressed by the invention, or if A only supports circumstantially by contributing funds or means without being involved in the creative act, person A is not considered an inventor under Swiss law.

With respect to the question of who is considered an inventor of an invention for which patent protection is sought in Switzerland it does not matter where a person is domiciled or from where a person contributes to the making of the invention. The Swiss Federal Code on Private International Law provides that intellectual property rights shall be governed by the laws of the state in which protection is sought. Accordingly, with respect to an invention that shall be protected in Switzerland, Swiss law determines who shall be considered an inventor regardless of where individual contributions to the invention have been made.

In this matter the EPC refers to national law.

b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

No, Swiss law does not rely on or look to a particular part of the patent application.

According to Article 51 of the Swiss Patent Act the invention must be defined in one or more claims. The inventor's right to be mentioned does, however, not depend on whether his/her contribution is finally covered by the granted claims.

The EPC refers to national law.

2. Does your law of inventorship depend on the citizenship of the inventor(s)?

No, Swiss law does not.

The EPC refers to national law.

3. Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor[s])?

No, Swiss law does not. See above answer to question 1a.

The EPC refers to national law.

4. Can the inventorship of a patent application be corrected after the filing date in your country?

Yes, it can be done under Swiss law.

Also, the EPC offers a mechanism for correcting a wrong designation of inventorship.

a) If yes, what are the requirements and time limits for such correction?

Under Swiss law upon request of the applicant or the proprietor, and only with the consent of the wrongly designated person, an incorrect designation of an inventorship may be corrected. Adding an inventor does not require the consent of the already named inventor(s). There is no time limit involved for altering the statement of inventorship. If it is desired to include the correction in an official patent publication, the correction must be filed before completion of the technical preparations for publication. Any correction will, however, be included in the public patent register.

The same procedure applies under the EPC. There is no time limit involved for altering the statement of inventorship.

5. What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

Under Swiss law and the EPC such a type of error has no *erga omnes* effects. Such errors do not render a patent invalid or unenforceable, and third parties cannot challenge the validity or enforceability of a patent on that ground. Only the rightful inventor (or his/her successor in title, or a third party owning the invention under any other title) has the right to take legal action to enforce his/her right to the position of the applicant or proprietor under Swiss law or the EPC. In this context the rightful owner may also file, under Swiss law, a nullity suit against the patent.

An action for assignment against a defendant acting in good faith must be filed within two years from publication of the patent. There is, however, no filing deadline in case of an action against a defendant acting in bad faith. The fact that the error was intentional may be used to establish bad faith.

6. Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

No, Swiss law does not.

The EPC refers to national law.

If the answer is yes, please answer the following:

7. Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

No, Swiss law does not.

The EPC refers to national law.

II. Policy considerations and proposals for improvements of the current law

8. If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

9. If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

10. If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

11. Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

No, there are not. The Swiss law imposes no specific requirements on applicants of patent applications having multinational inventorship.

III. Proposals for harmonization

12. Is harmonization in this area desirable?

Yes, it is.

13. Please provide a definition of inventorship that you believe would be an appropriate international standard.

A practical definition of inventorship without undue burden to construe its terms seems to be elusive. The following aspects should be considered:

– inventorship shall be attributed only to a natural person who contributes to the creative concept underlying the invention;

– the definition shall be flexible enough to accommodate all present and future fields of technology;

– the definition shall not include a reduction-to-practice requirement.

14. Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

Written request by proprietor or applicant. Consent of the wrongly named. No requirements as to intentional/unintentional. No time limit.

15. If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

Such a requirement is considered not appropriate.

16. If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

Such a requirement is considered not appropriate.

Accordance of a filing date shall not be delayed. If a secrecy review is required, it should be possible to request and obtain a decision thereon retroactively, within the priority year and before any publication.

17. If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

Such a requirement is considered not appropriate.

Accordance of a filing date shall not be delayed. If a filing license is required, it should be possible to request and obtain a decision thereon retroactively, within the priority year and before any publication.

18. Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

A first filing requirement or a security review requirement is considered an undue burden on the applicant; accordingly, such requirements are not supported. The standards proposed above shall apply irrespective of whether the failure to comply is inadvertent or not.

19. Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

If national requirements under items 15 to 17 under current status cannot be abolished, a central deposit for filing application documents should be established in order to secure a filing date without breach of any national law. Said central deposit shall be independent and neither accessible to the public nor to any official body.

Summary

In Swiss law there is no explicit definition of "inventorship"; in particular, Swiss statutory law does not define the substantive requirements for a person to be considered an inventor. The difficult task of establishing such requirements is left to the courts. Also, Swiss law does not lay down any specific provision for patent applications with multinational inventorship. Place of residence and nationality of the inventor are irrelevant to the Swiss law. Furthermore, Swiss law does not stipulate any requirements regarding first filing of patent applications or secrecy review of subject-matters of inventions. In these questions, the European Patent Convention confines itself to referring to national law.

Zusammenfassung

Im Schweizer Recht findet sich keine ausdrückliche Definition der «Erfinderschaft»; insbesondere verzichtet das Schweizer Gesetzesrecht darauf, die materiellen Erfordernisse an eine Person zu definieren, damit diese als Erfinder betrachtet wird. Die anspruchsvolle Aufgabe, solche Erfordernisse festzulegen, ist den Gerichten überlassen. Das Schweizer Recht statuiert auch keine konkrete Vorschrift für Patentanmeldungen mit multinationaler Erfinderschaft. Wohnsitz und Nationalität des Erfinders sind unerheblich im Schweizer Recht. Überdies stipuliert das Schweizer Recht keine Bestimmungen in Bezug auf Ersthinterlegung der Patentanmeldungen oder Sicherheitsüberprüfung der Erfindungsgegenstände. Das Europäische Patentübereinkommen beschränkt sich darauf, in diesen Fragen auf das nationale Recht zu verweisen.

Résumé

En droit suisse, il n'existe pas de définition explicite de la «qualité d'inventeur»; en particulier, la loi statutaire suisse ne définit pas les conditions de fond pour qu'une personne soit considérée comme un inventeur. La tâche difficile d'établir de telles exigences est laissée aux tribunaux. En outre, le droit suisse ne prévoit pas de dispositions spécifiques pour les demandes de brevet d'inventeurs multinationales. Lieu de résidence et la nationalité de l'inventeur ne sont pas pertinents à la loi suisse. En outre, le droit suisse ne prévoit pas d'exigences concernant le premier dépôt de demandes de brevet ou un examen quant aux exigences de secret des objets d'inventions. Dans ces questions, la Convention sur le Brevet Européen se limite à renvoyer à la législation nationale.