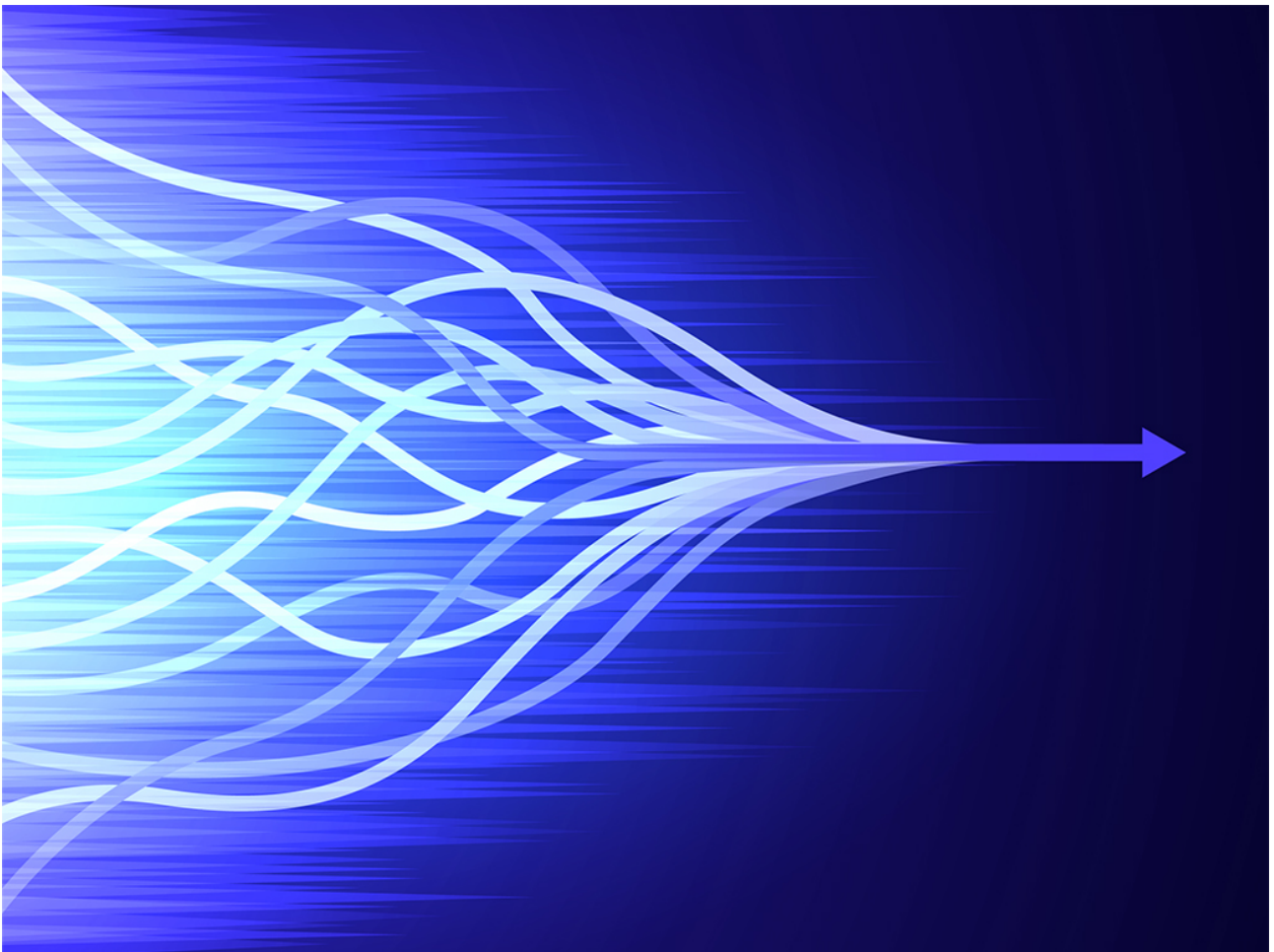


Convergence of practice

Common practice as regards the designation of the inventor

December 2020



Common practice as regards the designation of the inventor

Having due regard to the moral right of inventors under Article 4*ter* of the Paris Convention and Article 62 EPC to be designated as such in patent applications;

Having regard to the existing legal framework of the contracting states regarding the designation of the inventor;

Considering that the majority of the contracting states does not require a notification to the inventor;

Taking into account the existing legislation on employee inventions in some contracting states, requiring the employer as patent applicant to inform salaried inventors about the filing of patent applications and the progress of the patent grant procedure;

Considering the requirement for administrative simplification;

Taking into account the expanding possibilities to search and access patent information online;

Having regard to the interest of some inventors to limit the publication of private address data while remaining mentioned as inventor; and

Noting that any common practice will be implemented on a voluntary basis;

The Administrative Council of the European Patent Organisation at its meeting on 15 and 16 December 2020 approved the following common practice as regards the designation of the inventor:

- inventors are not formally notified by patent offices about their designation in a patent application; inventors can instead obtain information about their designation from the applicant, through inspection of the patent register or via file inspection;
- family name, given name(s), country and place of residence, or, if allowed, of employment of designated inventors are entered in the patent register. Additional information about inventors' full addresses is not published in the patent register. This is without prejudice to the right of inventors to waive their right to be mentioned, if available.

1. Background

With the adoption of the Strategic Plan 2023, discussions were launched on a convergence programme aimed at reducing or overcoming differences in administrative practices by setting common practices in identified areas where it could be expected that a more uniform approach would provide the most beneficial results for users and patent offices. At its 51st meeting, the Committee on Patent Law gave a favourable opinion on this proposal (CA/PL 14/19). Designation of the inventor was identified as an area for a possible convergence of practice. In accordance with the working method established by the Committee on Patent Law, a working group (Working Group 2 – Designation of the inventor) was set up to explore possible common practices in this area. The work of the group was planned to be concluded by the end of 2020.

A call for interest was issued in December 2019, whereupon 17 EPC contracting states and 1 extension state indicated their interest in participating in the discussions of Working Group 2 – Designation of the inventor. As a consequence the composition of the Working Group was as follows:

Bosnia & Herzegovina (BA), Bulgaria (BG), Denmark (DK), Estonia (EE), Finland (FI), France (FR), Germany (DE), Greece (GR), Hungary (HU), Iceland (IS), Italy (IT), Latvia (LV), Monaco (MC), Poland (PL), San Marino (SM), Serbia (RS), Spain (ES), the United Kingdom (GB) and the European Patent Office (EPO).

In February 2020, the chair of the Working Group (a representative of the Office) issued a questionnaire to establish the details of the current practice regarding the designation of the inventor in the participating contracting states and to determine the relevant differences and similarities among the members of the Working Group. The answers from all participants were compiled in a summary document, which was finally adopted by the group to serve as a basis for identifying possible areas of common practice.

The Working Group held four virtual meetings (18 March 2020, 23 April 2020, 9 June 2020 and 8 October 2020). Based on the discussions during these meetings and taking into account the results of the questionnaire, the Working Group identified two primary topics where a convergence of practice was considered to benefit both users and patent offices: the notification of inventors about their designation and the publication of inventor data.

On 23 July 2020, the Committee on Patent Law received a written update on the work of the group performed until that date, as well as a document compiling the results of the questionnaire.

In parallel to the discussions in the Working Group and in accordance with the methodology agreed by the Committee on Patent Law (see CA/PL 14/19 point 21), users were regularly consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 31 March 2020, 18 June 2020, 23 July 2020 and 8 October 2020. In order to further broaden the scope of the consultation process, on 21 September 2020 the EPO organised a virtual discussion platform, informing users and offices about the results achieved within the Working Group until then.

During its last meeting on 8 October 2020, the Working Group unanimously agreed to recommend the enclosed common practice for approval to the Administrative Council and subsequent voluntary implementation. The recommended common practice proposes that:

- inventors are not formally notified by patent offices about their designation in a patent application; inventors can instead obtain information about their designation from the applicant, through inspection of the patent register or via file inspection; and
- family name, given name(s), country and place of residence, or if allowed, of employment of designated inventors are entered in the patent register. Additional information about inventors' full addresses is not published in the patent register. This is without prejudice to the right of inventors to waive their right to be mentioned, if available.

The EPO's practice as regards the designation of the inventor deviates from the recommended common practice. A proposal to align the EPO's legal framework with the recommended common practice by amending Rules 19 and 143 EPC will be presented to the Administrative Council in a separate document (CA/78/20).

At its 52nd meeting on 10 and 11 November 2020, the Committee on Patent Law took note that implementing and applying the common practice may require adjustments to national legal and/or IT systems concerning the designation of inventors. The Committee underlined the voluntary implementation and application of the recommended common practice and gave a unanimous favourable opinion on the recommendation of a common practice as regards the designation of the inventor.

At its 165th meeting on 15 and 16 December 2020, the Administrative Council approved the proposed common practice as regards the designation of the inventor.

2. Explanatory remarks to the common practice

All EPC contracting states require the inventor to be designated as such during the patent grant procedure. This important procedural step, enshrined in Article 4*ter* of the Paris Convention and Article 62 EPC, ensures that the inventor's moral right to be mentioned in a patent application is safeguarded. This fundamental right was duly considered by the Working Group.

Furthermore, the Working Group took note of the fact that a large portion of the elements making up the designation of the inventor are prescribed by the EPC or national law. Therefore, the implementation of any common practice in this area may be subject to a revision of the applicable legal framework. In this regard, it is however reiterated that the implementation of any given agreed common practice takes place on a voluntary basis (CA/PL 14/19, point 16). In order for the benefits of the convergence of practice to fully materialise, implementation of the agreed common practice in as many contracting states as possible should be aimed for.

2.1 Notification of the inventor

The results of the questionnaire have shown that a formal notification to inventors by patent offices informing them of their designation is an exception. Of the participants in the Working Group, only Denmark (DK), Latvia (LV) and the EPO issue such a notification. While in DK and at the EPO the obligation to formally notify inventors is provided by statutory law, in LV such a practice has only recently been introduced provisionally and at an administrative level.

For some countries represented in the Working Group, the obligation to inform inventors about their designation is with the applicant, who provides the inventors' credentials in the first place. In some other countries, inventors acquire information about the patent grant procedure themselves through publication channels, such as the patent register. In addition, many national patent laws provide subsidiary mechanisms, such as the provisions on employee inventions, to ensure that employed inventors are not only informed about the filing of a patent application by their employer naming them as inventor, but are also given information about the progress of the grant procedure.

The majority practice not to formally inform inventors about their designation has the advantage that it avoids the manual processing and posting of inventor notifications and thus considerably alleviates the administrative burden of the patent offices. This is of particular relevance when considering the experience at the EPO, where inventor notifications are frequently returned by the postal services as undeliverable due to incorrect address data, and thus have to be reissued. Therefore, a discontinuation of the practice to formally inform inventors of their designation has considerable potential for administrative simplification.

It must nevertheless be ensured that inventors are duly informed about the filing of patent applications. Based on the results of the questionnaire and the feedback gathered in the Working Group, this requirement can be fulfilled by means other than formal notification. For this purpose, in particular the technical advances in options for accessing patent information online must be taken into account.

Based on the above considerations, the Working Group unanimously agreed to recommend to the Administrative Council the approval of a common practice to provide that inventors are not formally notified by patent offices about their designation in a patent application. Instead, inventors can obtain information about their designation from the applicant, through inspection of the patent register or via file inspection.

2.2 Publication of inventor data

The results of the questionnaire show that all participants in the Working Group publish the inventor's family name and given name(s) in their patent registers. Most countries represented in the Working Group also publish the inventors' country and city of residence as additional information. This is in most cases considered sufficient information to identify the inventor. While in most states the inventor's full address must be provided together with the designation, only some states as well as the EPO subsequently publish the full address data in the patent register.

Many states as well as the EPO offer inventors the possibility to waive their right to be mentioned publicly. With a few exceptions, where inventors can partially waive their right by requesting non-disclosure of their private address only, the filing of a waiver usually has the consequence that the inventor is not mentioned at all in the published patent application or patent. In the majority of cases, inventors are therefore left with having to choose between a full disclosure of their data and not being mentioned at all as the inventor in a specific patent application.

In consideration of the increasing interest of inventors to limit the publication of their personal data, while at the same time remaining mentioned as inventor in a patent application, the Working Group discussed options for a common practice which acknowledges and combines both of these aspects.

On this basis, the Working Group unanimously agreed to recommend a common practice which limits the inventor data entered in the patent register to the family name, given name(s), country and place of residence or, if allowed of employment. Additional information about the inventor's full address including the street is not published in the patent register. It is noted that this recommended common practice is without prejudice to the inventor's right to waive their right to be mentioned, where it is provided for by the applicable national law. It must also be taken into account that irrespective of its non-publication in the patent register, the inventor's full address may remain accessible through file inspection, unless the applicable national law provides for an exclusion of this information from file inspection.