

CONVERGENCE OF PRACTICE
WORKING GROUP 2 – DESIGNATION OF THE INVENTOR
SUMMARY OF THE REPLIES TO THE QUESTIONNAIRE

I. GENERAL INFORMATION

The EPO has received answers to the questionnaire on the national practice concerning the designation of the inventor from all 18 members of Working Group 2.

The present document gives a summary of the answers received from the members of the working group to provide a basis for further discussions within the working group. It also reflects the practice applicable at the EPO.

For reasons of efficiency, instead of the full country names the two letter country code is used.¹

II. RESULTS OF THE QUESTIONNAIRE

1. General questions

1.1. Does an applicant have to designate the inventor when filing a patent application in your country?

Based on the answers received it is clear that the necessity to designate the inventor at one point during the grant procedure is a generally recognised requirement among all the national offices participating in the working group as well as at the EPO.

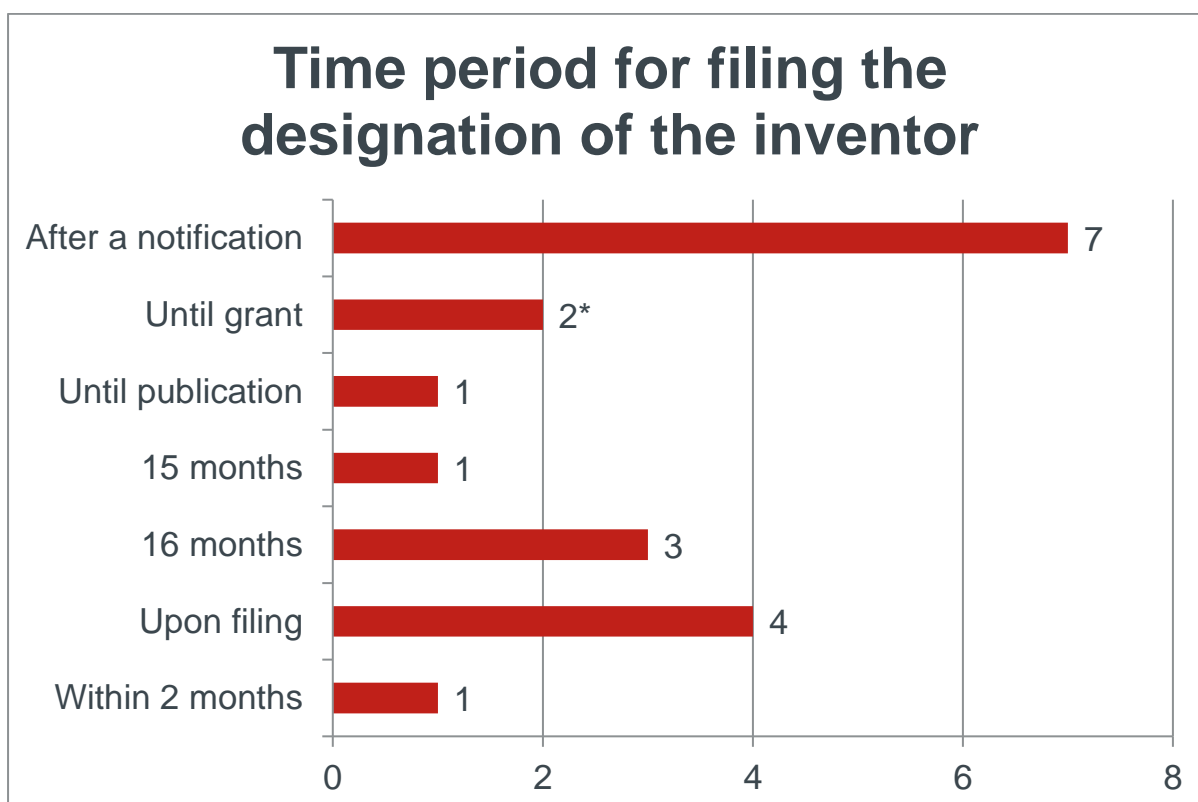
Although the time limit for designating the inventor varies, all respondents have indicated that a designation of the inventor has to be filed to obtain patent protection.

¹ Bosnia and Herzegovina (BA), Bulgaria (BG), Estonia (EE), Denmark (DK), 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), United Kingdom (UK), European Patent Office (EPO).

1.2. How and when does the inventor have to be designated?

The vast majority of national offices as well as the EPO either incorporate the designation of the inventor in the request for grant form, or provide a separate form for designating the inventor, to be used in particular if the applicant is not at the same time the inventor.

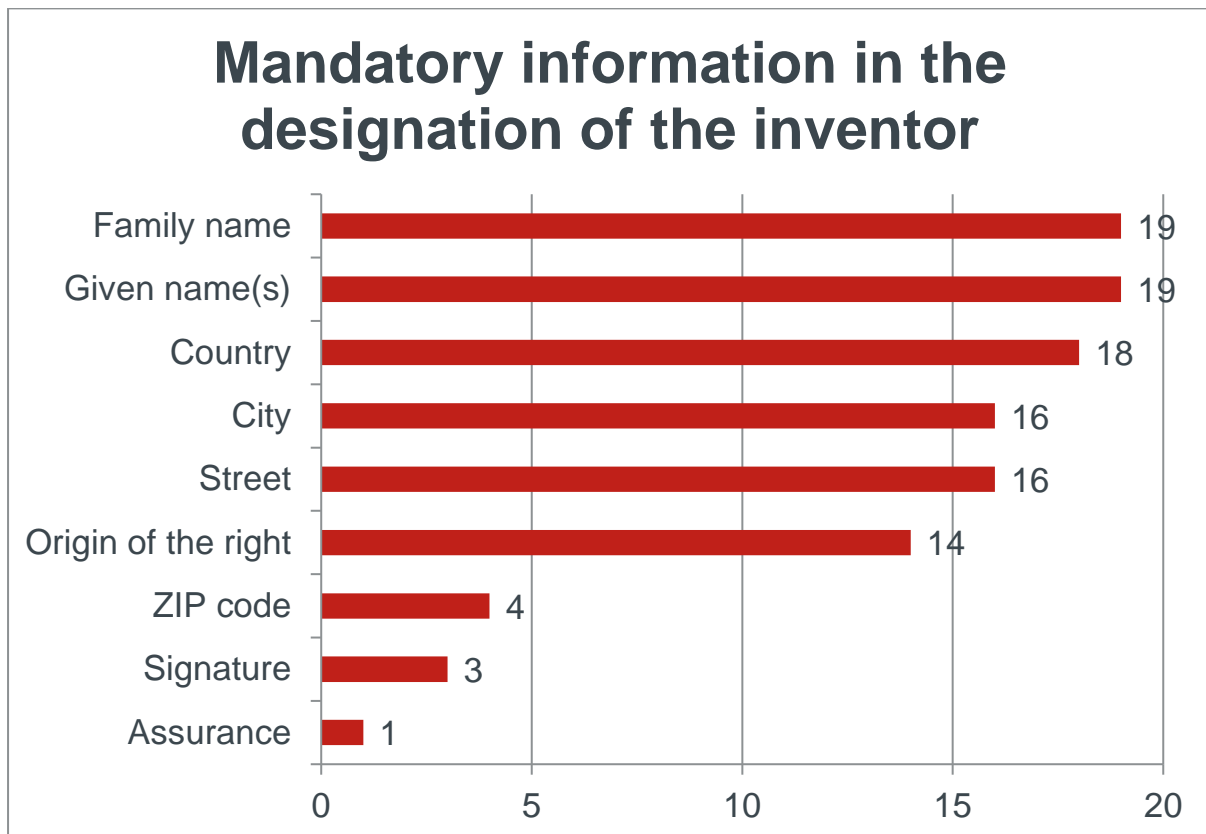
While most offices encourage applicants to designate the inventor already upon filing the request for the grant of a patent – and therefore incorporate the designation in the request for grant form – the mandatory time period for filing the designation varies considerably. In several countries (MC, PL, IS, ES, HU, GR, FI, EPO) applicants are notified of the requirement for designating the inventor in an official communication, if the designation has not been filed together with the patent application. Upon notification, applicants must submit the designation within a specified period (usually 1 to 4 months). Other member states provide a statutory time limit of 15 or 16 months from the date of filing or the earliest priority date (DE, UK, FR, EPO), which may be extended, to submit a designation of the inventor. In some cases, the inventor has to be designated within 2 (SM) months from filing, at the latest before grant of a patent (DK, BG) or before publication of the patent application (BA).



*The fact that the designation can in BG be filed "later" is understood to mean that it has to be filed at the latest before the grant of a patent.

1.3. What information must be contained in the inventor designation?

In the laws of all of the participating offices the inventor's family name and given name(s) must be stated in the designation of the inventor. Except for ES, IT and SM, all other offices require applicants to indicate the inventor's full address information in the designation of the inventor, including country, city and street. In ES the inventor's address details can be provided on a voluntary basis. An indication on how the applicant acquired the right to the invention from the inventor is mandatory at 14 offices and not required only in BA, FR, MC, IT and LV. Other mandatory requirements include the ZIP code of the inventor's place of residence (UK, DE, PL and HU), signatures from the applicant or his representative (DE, RS and EPO) or an assurance of the applicant that to his knowledge no other persons are involved in the invention (DE). It is noted that in some countries the inventor's address does not need to be his private address but could for example be the address of his place of work (DE, FI, UK).

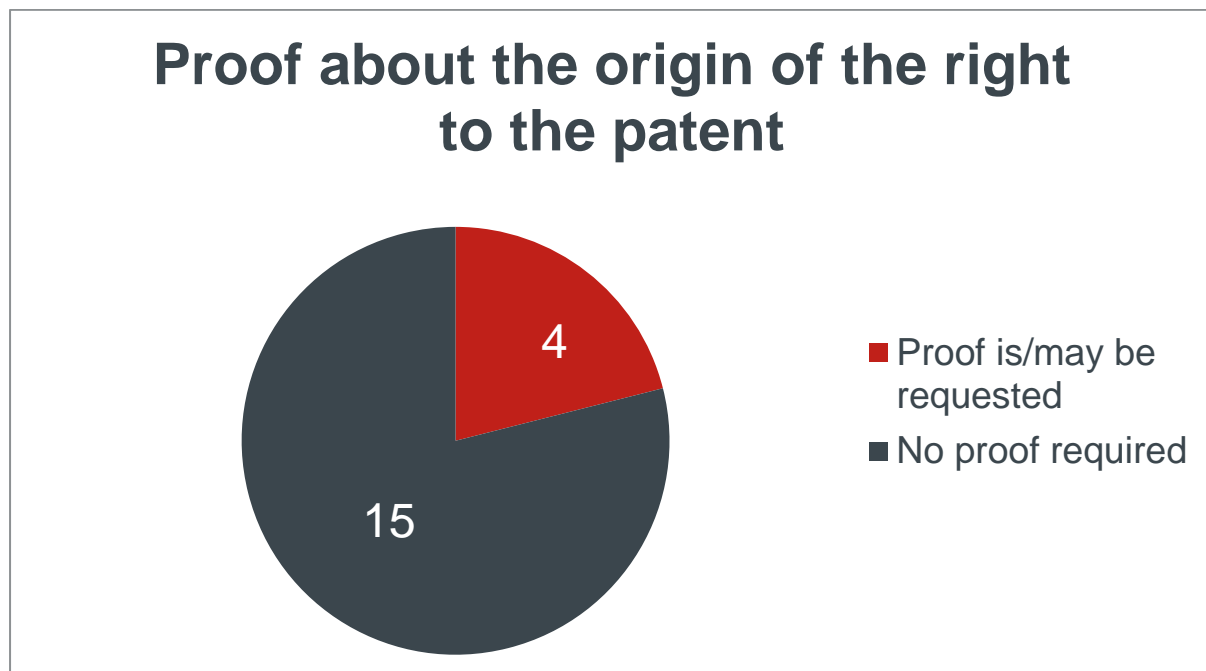


1.4. Do you require proof about the origin of the right to the patent?

It is noted that the requirement to prove the origin of the right to the patent is understood to go beyond the mere indication of how the applicant acquired the right from the inventor, i.e. the checking of a box in the designation form. The requirement to submit transfer agreements or labour contracts would be considered as a requirement for proof.

Although the laws of many countries require applicants to indicate the origin of the right to the patent, it is understood that similar as at EPO, in the vast majority of cases the national patent offices do not verify the accuracy of the information provided by the applicant and thus do not require actual proof about the origin of the right to the patent.

In DK and IS, in addition to the indication given by the applicant, the patent office may ask for further documentation concerning the applicant's right to the invention, although in DK this is an exception. In HU, if the applicant is the inventor's successor in title, the patent application shall contain the document verifying the legal succession. In GR an assignment deed is usually provided as proof of the origin of the right to the patent.

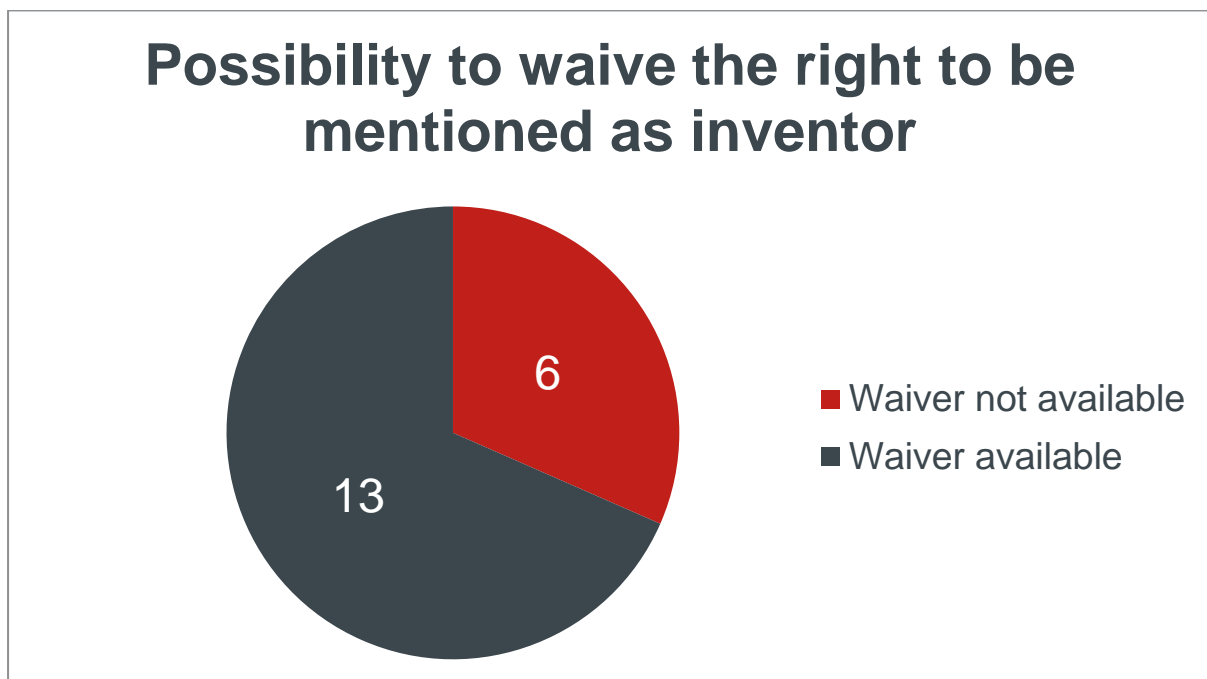


1.5. Does the inventor have a possibility to waive the right to be mentioned? How and when has a waiver declaration to be filed?

About two thirds of all participating offices give inventors a possibility to waive their right to be mentioned in the patent application and the granted patent. No formalised waiver procedures exist in MC, DK, IS, IT, GR and FI although in DK inventors have the possibility to ask to be removed from the application. However, it is understood that the application would have to mention at least one inventor.

Where the inventor has a possibility to waive the right to be mentioned, such a waiver must unanimously be filed before finalisation of the technical preparations for the publication of the application. Although in some member states a waiver can also still be filed at a later stage, such a waiver does not have an effect on prior publications.

In DE and UK the inventor can again retract the waiver of the right to be mentioned at a later stage of the grant procedure. In such a case, the inventor is only mentioned in subsequent publications.



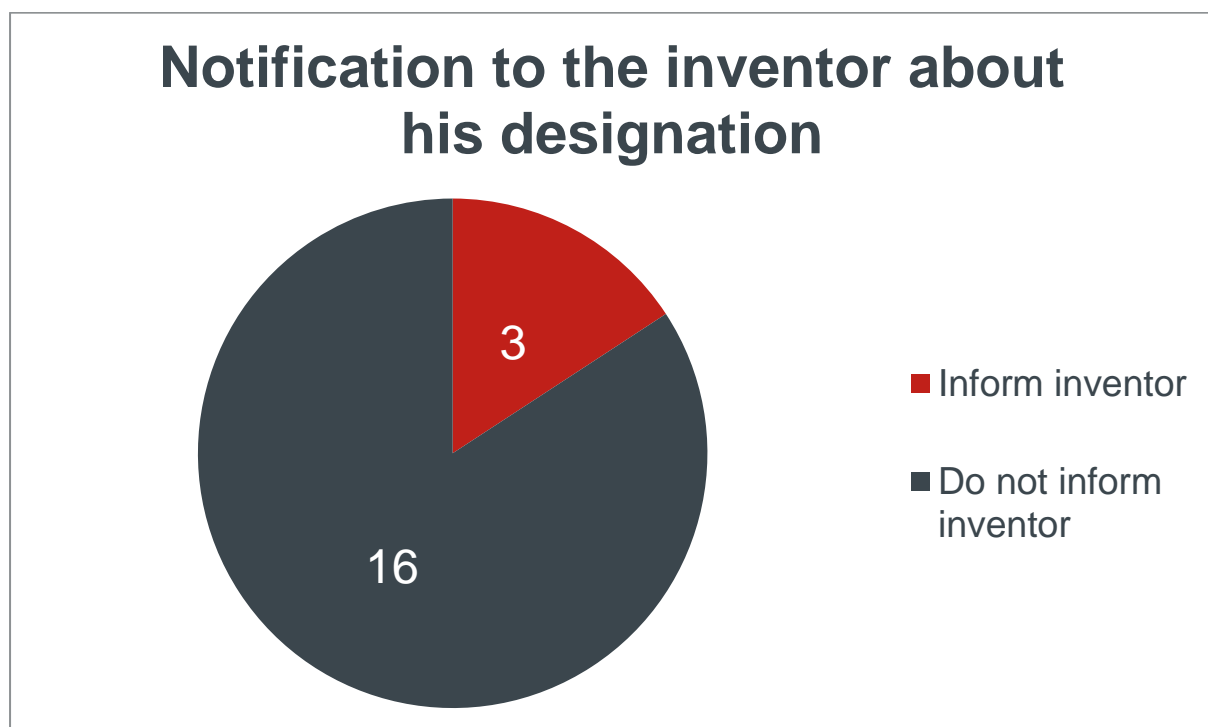
2. Notifying inventors of their designation

- 2.1. Do you inform the inventor that he/she has been designated and if so, how?
- 2.2. If question 2.1 was answered with no, how and by whom is the inventor informed that he has been designated (e.g. employer)?

The vast majority of offices participating in the working group do not inform the inventor personally about his designation (16 out of 19). Rather, it is usually the applicant who is considered to have the obligation to inform the inventor as he provides the inventor's data in the process of the designation. At all offices, the inventor may obtain information about his designation via the official publication channels of the patent offices, including the Official Gazette, the publication of the patent application, the patent register or via file inspection.

Only three offices directly informed the inventor about his designation. These include DK, LV and the EPO. In DK the patent office sends a notification to the inventor, if the patent application is filed by someone other than the inventor. However, no notification is issued, if priority is claimed or if a declaration of transfer of the invention from the inventor to the applicant was filed together with the patent application.

Also in LV, since the entry into force of the EU GDPR, the inventor is directly informed about his designation, although the law does not contain an express obligation to do so.



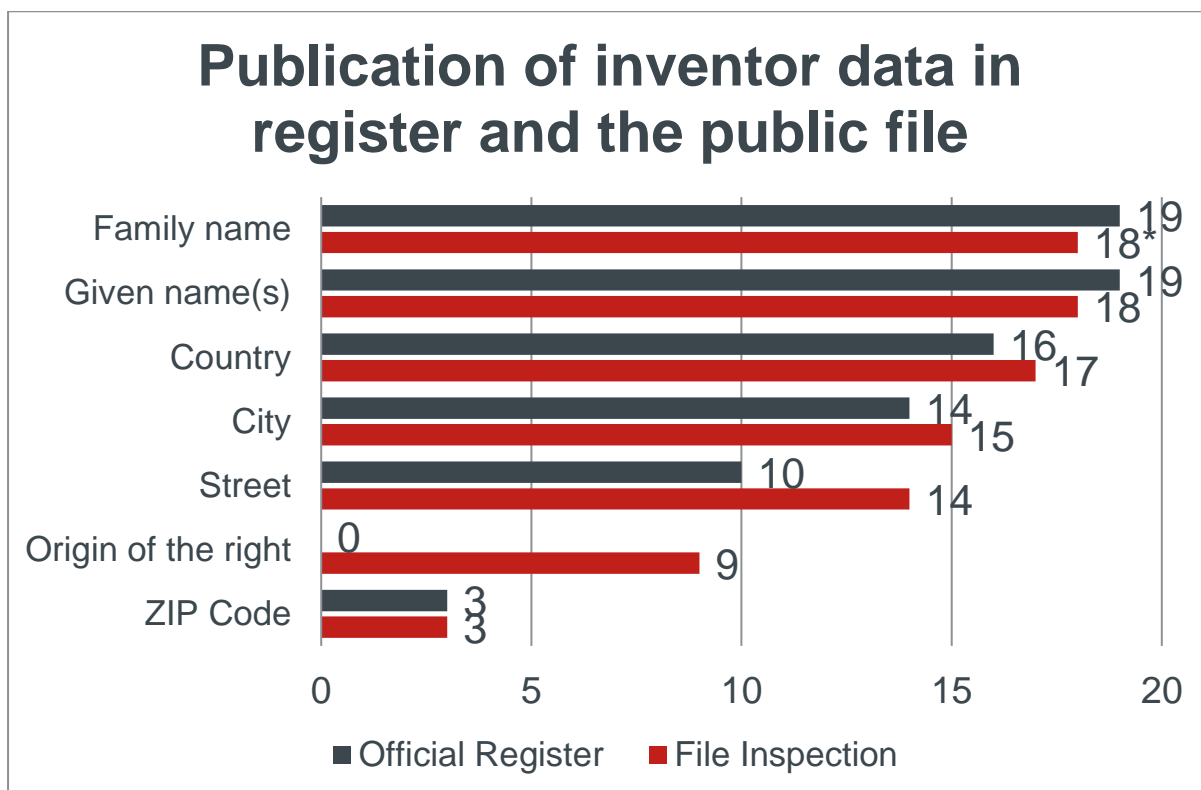
3. Publication of inventor data

3.1. Which parts of the information contained in the designation of the inventor are publicly accessible via file inspection or the official register?

All participating member states publish the inventor's family and given name in the Official Register. While in ES, IT and GR the information published about the inventor is limited to his name, most offices also publish additional data. 16 offices (without ES, IT and GR) also publish information about the country of residence. 14 offices (without ES, GR, IT, LV and SM) also contain information about the city of residence.

Detailed address data of the inventor, including the street is published in the register by 10 out of 19 offices, including the EPO. No information about the street is published in IT, LV, BG, DE, PL, IS, ES, SM and GR.

A similar approach is taken for file inspection. While in PL third parties can only access abstract, description, claims and drawings of an application, most other member states make the entire address information, including names, country, city and street available via file inspection, with exceptions being BG, ES, IT and SM².



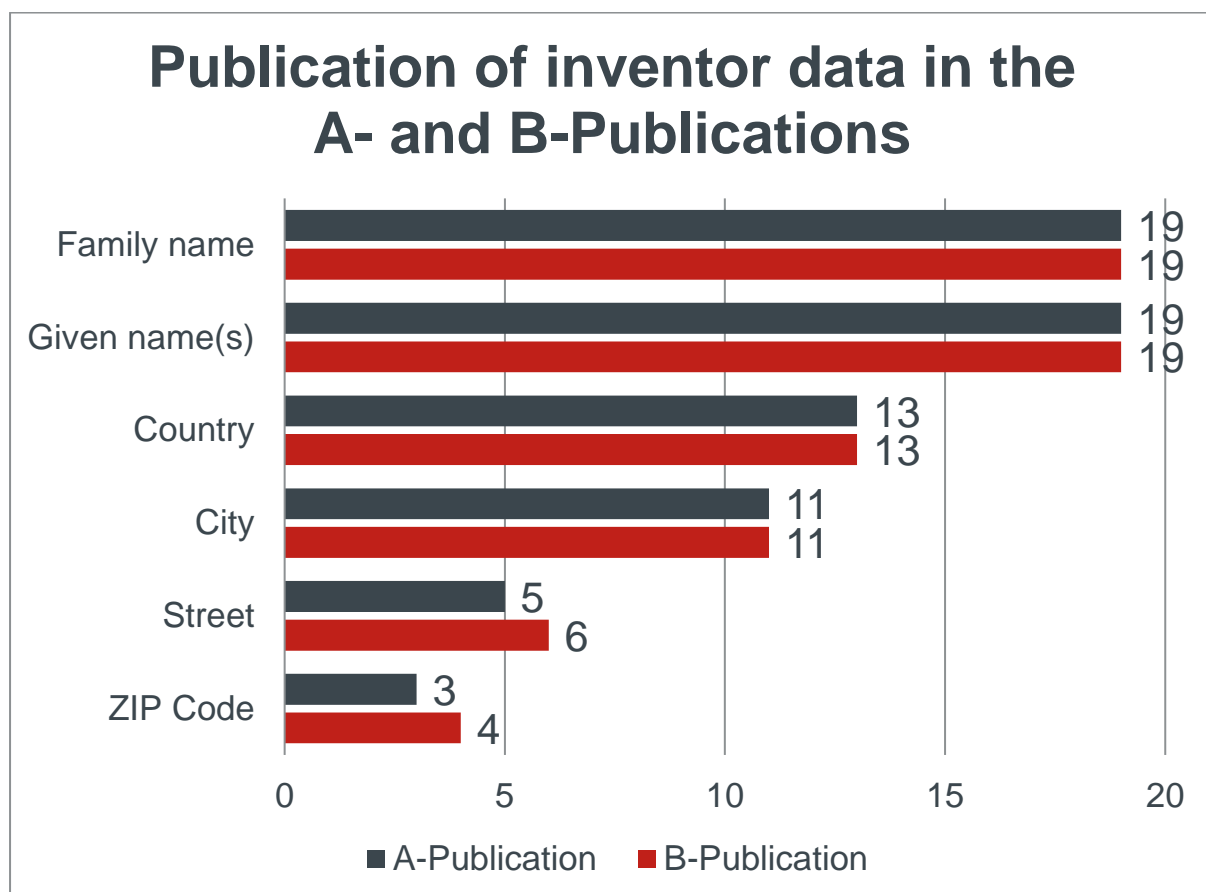
*It is not entirely clear whether in RS and BA, all information can be accessed via file inspection, even if only on paper.

² Since in SM only family name, given name, country of residence and origin of the right to the application is requested no additional address data is expected to be published via file inspection.

3.2. Which information is provided in the published application documents (A-publication) and/or in the published patent specification (B-publication) or any other legal publication (e.g. Bulletin)?

In all of the participating countries the inventor's family name and given name(s) are published in the A- and B-Publication. In case of ES, BG, FR and RS no additional information is published in the A- and B-Publication. In LV and SM also the country is indicated. At the EPO only the names, country and city of residence is published in A- and B-Publication.

The inventor's full address information, also including the street is published in the A-Publication only in 5 member states including DK, UK, BA, EE and HU. In the B-Publication also FI publishes the inventor's full address. The ZIP Code is published in UK, DE, HU and FI (in FI only in the B-publication).

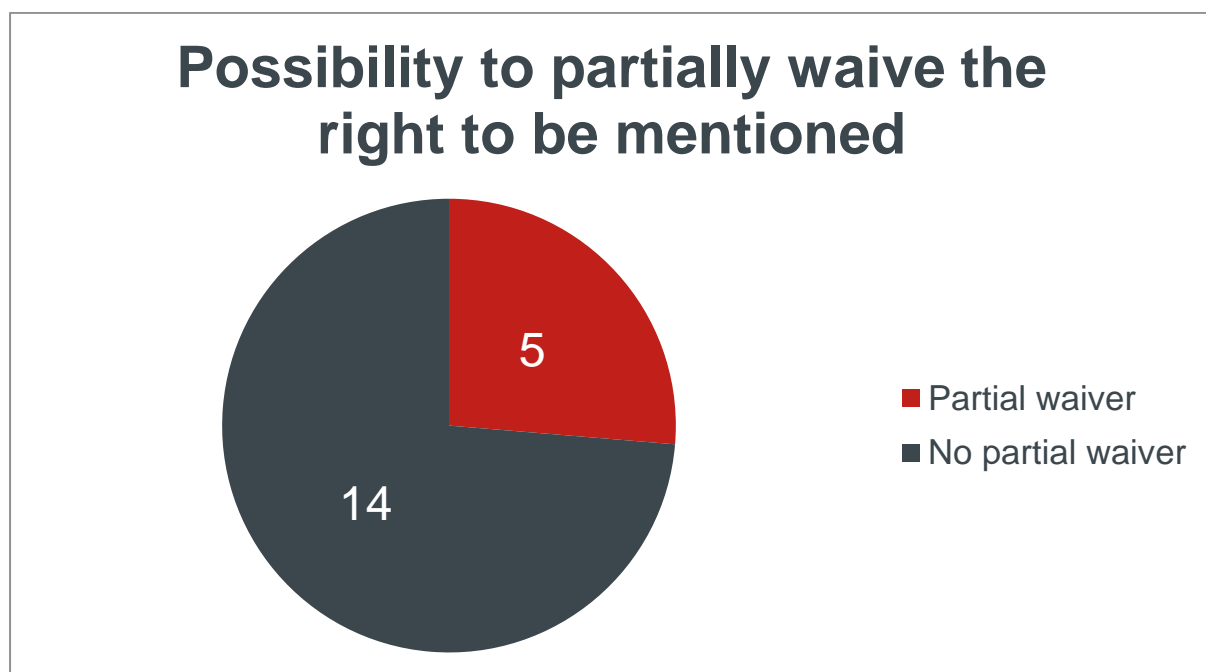


3.3. Does the inventor have a possibility to request non-publication of specific information only, e.g. his address, while remaining mentioned as inventor? If so, please explain the conditions applying to such a request.

5 national offices (UK, DK, BG, FR and IS) allow inventors to partially waive their right to be mentioned by requesting non-publication of specific information such as their address. Also DE is, considering to implement such a possibility in their patent law.

It is noted that when considering only the number of national offices that publish full address data of the inventor (10 in the Official Register, 14 via file inspection and 5 and 6 in the A- and B-Publication), the ratio of offices providing for a limitation of the published data is already high.

In the UK inventors can choose to waive their right to be mentioned in its entirety or with regard to their address only. However, for a full waiver reasons must be provided and it is up to the comptroller to grant the request.



3.4. If question 3.3 is answered with yes, what mechanisms do you have in place to ensure that only the information as requested by the inventor is published?

It appears that in those offices offering a possibility to request non-publication of specific data, such requests are treated manually to avoid dissemination of the data concerned.

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