

Question Q244

National Group: Sweden

Title of Question: Inventorship of multinational inventions

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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.*

There is no explicit definition of inventorship in Swedish law. Reference to inventorship restricts itself to what is stated in Chapter 1 Section 1 of the Swedish Patents Act regarding who may be granted patent for an invention. The act states that any person, who has made an invention which is susceptible of industrial application, or his or her successor in title, may upon application obtain a patent for the invention in Sweden.

Some guidance on the application of the law in relation to inventorship can be found in the assessment of co-inventorship, see section (1a) below.

- 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?*

The relevance of the location of the individuals involved is dealt with separately under the answers to questions 2 and 3.

The inventor is the person having intellectually generated the invention, the person having conceived of the innovative step beyond prior art. Should several persons

have independently contributed to the final result which is the invention, they are all co-inventors.

Being regarded as co-inventor requires having independently and intellectually contributed to the finalised invention. In general, such contribution shall express innovative technical problem solving and constitute a part of the inventive step. Mere assistance in the research process which lacks independence, such as the performance of routine tasks or compilation of information pertaining to prior art, shall thus not be regarded as contributing to the invention.

Whether person A and person B are to be considered inventors, separately or jointly, depends on the nature of the directions and instructions given by person A to person B.

The instructions given by person A may, on the one hand, be a mere suggestion to solve a problem; an expressed vision of a desired result without an associated notion regarding how the desired result may be reached. Should person B, relying only on his/her own intellectual capacity, conceive an invention, when working under such directions and instructions from person A, then person B is to be considered the sole inventor of the invention. Person A will not have contributed to the invention as such; the mere desire for a solution to a problem will not in itself contribute to a new invention and will thus not constitute grounds for co-inventorship.

It may on the other hand be the case that already the instructions themselves contain the invention as such. Person A may have identified not only the problem but also a potential solution, which in itself would constitute an invention. Person A may thereafter instruct person B to perform actions aimed at verifying the hypothesis of person A. Given that the hypothesis proves to be true, the invention would already have been finalised when the instructions were given and person A shall be regarded as the sole inventor of such an invention.

It is however not unusual that intellectual contributions from both person A and person B are essential for the invention, in which case both A and B shall be regarded as co-inventors of the invention.

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?

Swedish law, lacking a definition of how to define inventorship, does not relate inventorship to any special part of a patent application. However, as the scope of protection of the patent will comprise only the scope of the claims, to be considered inventor or co-inventor, the independent intellectual contribution to the invention should be found in the patent claims.

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

No. Swedish law applies to the issue of inventorship for all Swedish national patent applications and under its rules the inventorship issue and right to apply for a patent in Sweden is not affected by the inventor's citizenship.

To the extent patents for Sweden are granted by the European Patent Office (the EPO) according to the European Patent Convention (the EPC), Swedish courts have

jurisdiction over disputes concerning patent applications according to the “Act on the jurisdiction of Swedish courts in certain actions in the area of patent law”.

Said act provides that Swedish courts have jurisdiction in disputes concerning entitlement to EPO patent applications (including those based on inventorship) if and to the extent the applicant is domiciled in Sweden or if the plaintiff is domiciled in Sweden and the applicant is domiciled in a non-contracting state. There is no express provision on applicable law in these cases. Swedish courts would generally apply the principle of closest connection to decide on the choice of law issue and one factor would likely be where the invention was made (see below regarding choice of law regarding employee inventions being subject to an EP patent application)

In respect of disputes concerning employee inventions, Swedish courts furthermore have jurisdiction if a) the invention was made by the employee while he/she was working in Sweden or, if its unclear where the employee was working, if he/she was linked to a permanent establishment in Sweden during the relevant point of time, or b) the parties have agreed on Swedish jurisdiction. Swedish law applies in disputes according to a) above. In disputes according to b) above, the law of the country where the employee was working when he/she made the invention shall apply. If it is unclear where the employee was working, the law of the country where the permanent establishment to which the employee was linked during the relevant point of time, shall apply.

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

No, but it can affect the choice of law (see above). See also the specific rules regarding defence inventions (the Swedish Act on Defence Inventions (FUL)) in the answer to question 7 below.

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

Yes.

- a. *If yes, what are the requirements and time limits for such correction?*

After filing the patent application but before grant of the patent, the applicant may file a request of change or correction of inventorship with the Swedish Patent and Registration Office (the PRV) at any time. No formality requirements apply and the applicant does not need to file any documents to support the request.

Historically, the PRV would request that the applicant filed a consent from the other inventors if an inventor were to be added or removed from the application (for removal, the inventor to be removed also needed to give his/her consent). However, case law from the Court of the Patent Appeals suggested that the information provided in a patent application – including the formal requirements – is the property of the applicant alone and that the inventors have no say in any formality relating to the application.

After patent grant, it may still be possible to correct inventorship but special requirements apply.

Historically, the PRV was of the opinion that the information regarding the inventor/-s was information that could not be changed after grant of the patent. A court decision that the information was wrong would of course be binding, and lead to a change in the register. The Court of Patent Appeals changed the practice of the Patent Office with a decision saying that if the patentee claims that the patent register holds wrongful information, the Patent Office must apply Section 27 of the Administrative Procedure Act to the request for change in the register (see below).

The patentee may request recordal of changes to the patent register after grant. When the patentee requests that an inventor is removed from or added to the patent register, the PRV shall try the request with the application of Section 27 of the Administrative Procedure Act.

Hence, if the decision to grant the patent includes incorrect information about the inventor/-s, it may be corrected by the same authority that granted the patent. This means that corrections of inventorship in the patent register for European patents that have been granted by the EPO and validated in Sweden, cannot be done by applying Section 27 of the Administrative Procedure Act.

The Swedish Patents Act has one section concerning proper title to the invention (Section 17) and one section concerning proper title to the patent (Section 53). In practice, these sections have been interpreted as also covering inventor's rights, i.e. that a person may claim to be the proper inventor or co-inventor to an invention/a patent. Inventorship may therefore be corrected by filing a claim of proper title regarding inventorship with the district court.

- 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?*

A patent may be granted to anyone who has made an invention, or to his/her successor in title (Section 1 of the Swedish Patents Act).

As described in the answer to question 4 above, during the patent application proceedings, before grant, claims for proper title of the invention may be brought before the Patent Office or the district (civil) court. If it is proven before the Patent Office that the proper title to the invention belongs to another person than the inventor/-s specified in the patent application, the Patent Office shall transfer the application (or part of the application) to that person, if he/she so demands. If the person awarded inventorship or co-inventorship does not request a transfer of the patent application, the application must be dismissed since a patent may only be granted to the true inventor or his/her successor in title.

A patent may be invalidated if it has been granted despite the fact that the requirements under Section 1 are not fulfilled (Section 25 and 52 of the Swedish Patents Act, i.e. both in opposition proceedings before the Patent Office and as a result of a claim for invalidity in civil court). This includes applicant's lack of proper title to the invention claimed. However, third party's entitlement to a share of the invention is not grounds for invalidation.

In neither of these circumstances/proceedings, does it matter if the error was intentional/unintentional.

- 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.

If the answer is yes, please answer the following:

- a. *Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.*
 - b. *Does your law provide for granting of a foreign filing license or similar mechanism that would allow a patent application for an invention made in your country to be filed first in another country? Please describe any such foreign filing license or similar mechanism as well as the procedure, timing, and cost of obtaining it.*
 - c. *If the answer to b. above is yes, is it possible to obtain a foreign filing license retroactively, for example, if a foreign filing was made without a foreign filing license due to inadvertent error?*
 - d. *How does your law apply to an application for a patent claiming an invention that was made jointly by an inventor in your country and an inventor in another country? Does this apply based on the citizenship of the inventor, the residency of the inventor, or both? Does the nationality of the patent owner affect your answer?*
 - e. *In the case of an invention made jointly by an inventor in your country and an inventor in another country, would it violate your law if a request for a foreign filing license was filed in the other country before being filed in your country?*
 - f. *What are the possible consequences for failing to comply with this law? Does it matter whether the error was intentional or inadvertent?*
- 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?*

Yes, if the invention classifies as a Swedish defence invention.

A Swedish defence invention is an invention concerning military equipment made in Sweden or owned by a physical or legal person domiciled in Sweden. A defence invention can be an invention in any area of technology.

According to Section 79 of the Swedish Patents Act and Section 10 of the Swedish Act on Defence Inventions (FUL), a patent application for a Swedish defence invention, which is to be maintained confidential according to FUL provisions, may only be filed with the consent of the Swedish government.

Consent to filing a patent application outside of Sweden may only be given if confidentiality can be maintained also in the foreign state. Sweden currently has bilateral agreements with the United States, the United Kingdom, France, Germany and Italy, allowing for confidentiality after filing in those states. A framework agreement concerning measures to facilitate the restructuring and operation of the European defence industry has been signed by Sweden and the above mentioned European states with the addition of Spain. Pursuant to this framework agreement, an

implementing arrangement has been agreed upon. A Swedish defence invention cannot be prosecuted as a European patent application, but must be pursued as national patent applications in Sweden and in the above mentioned European states.

Section 5 FUL states that any person wishing to file a patent application for a Swedish defence invention by filing an international patent application or a European patent application with a receiving office other than the PRV, shall first apply for a secrecy review.

Thus, in principle, an applicant is free to file a first patent application for an invention made in Sweden in a different state. However, if the applicant considers that the invention may be classified as a Swedish defence invention, a secrecy review should be carried out before filing abroad.

For an invention which could classify as a defence invention also in a foreign state, the situation is not entirely clear. In the implementing arrangement mentioned above, it is agreed that, for an invention conceived within the context of a transnational defence contract or other transnational defence activities, a first patent application should be filed in the state in which the invention was made "entirely or mainly". For example, if a party based in the UK places a defence related contract in Sweden and an invention is conceived under this contract, a first patent application should be filed in Sweden, even though the invention may classify as a British defence invention.

a. If yes, does this law depend on the area of technology that is disclosed and claimed in the patent application?

No, the relevant provisions apply regardless of area of technology per se but to Swedish defence inventions only.

b. If yes, describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

For national applications filed with the PRV as well as for European patent applications and international patent applications filed with the PRV as a receiving office, the PRV is responsible for assessing whether the invention may be a Swedish defence invention. If so, the application is handed over for a confidentiality assessment to the Swedish Defence Material Administration (the FMV).

Anyone who wants to make public, or otherwise disclose, a Swedish defence invention shall apply for such a confidentiality assessment, as shall anyone who wants to file a European patent application or an international patent application with a receiving office other than the PRV.

If the FMV finds that it is of significant importance for the national defence that the invention is kept confidential, it sends the application and its motivated decision to the Swedish Review Board for Defence Inventions for a final assessment. If the Review Board agrees with the FMV's assessment, it shall issue an order that the invention may not be made public or otherwise be disclosed without authorization.

The confidentiality assessment must be finished within three months from the date of filing with the PRV, or, if priority is claimed, within 13 months from the priority date. If not, the invention cannot be kept confidential under FUL provisions.

If it is ordered that the invention is to be kept confidential, the applicant may request the government to assume ownership of the invention. The government shall pay reasonable compensation for all damages caused by the order.

If the invention is found to be of significant importance for the national defence, the government may order that the invention can be used by or for the government, or that all rights to the invention shall be expropriated and ceded to the government. The government shall in this case pay reasonable compensation for the rights to the invention and for the additional damage caused by the order.

The procedure of secrecy review is free of charge for the applicant.

- c. *If yes, describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?*

The intentional filing in a foreign state of a patent application which should be kept confidential, is a criminal offence punishable by fine or imprisonment for a maximum of one year.

It could further be noted that foreign defence inventions, for which a patent application is filed in Sweden, can only be maintained confidential in Sweden if there is a bilateral agreement between Sweden and the foreign state, and if the invention has been requested to be kept confidential in the foreign state.

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?*

There is no definition of inventorship in Swedish law.

- 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?*

N/A

- 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?*

Yes. The Swedish group believes that it would simplify matters if the decisive criteria for when/where to file a secrecy review would relate only to the applicant instead of also including where the invention was made. As a suggestion, the domicile of the applicant could be made the decisive criteria.

- 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.*

The Swedish group has not identified any specific aspects where precise suggestions can be made. However, an idea for improvement that could be made the subject of further studies and discussions is presented at the end of this report.

III. Proposals for harmonisation

- 12) *Is harmonisation in this area desirable?*

Yes.

If yes, please respond to the following questions without regard to your national or regional laws.

Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

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

The Swedish group realises the challenges of trying to define universal criteria for inventorship without being either too general or too detailed. The suggestion below shall thus be seen as a starting point for further discussions.

“For the purpose of patent law in general and issues of entitlement to inventions and patents in particular, a person shall be considered to be an inventor of an invention if he/she has made a significant intellectual contribution to one or more features of the invention and such feature(s):

- i. are contained in a written disclosure as a whole and, in the case of a granted patent, also defined in at least one of the patent claims, and
- ii. distinguish the invention from the relevant prior art in a manner that makes it novel and non-obvious.

A contribution shall not be considered to be significant to the extent it only involves administrative or financial support, measures normally being taken by the person skilled in the particular art, or routine work carried out on the basis of detailed instructions from others.

If appropriate, in case the assessment of inventive step is made by a problem-solution approach, consideration should be made as to whether the person has contributed significantly to solving the relevant problem or to the identification of the problem if such identification is considered to have contributed to the inventive step.

In case of a granted patent, the assessment should be made on a claim by claim basis. However, only those claims having features that contribute to distinguishing the invention over the prior art, or solving the objective technical problem, should be considered.”

- 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).*

The Swedish group suggests that the information concerning inventors and inventorship provided by the applicant(s) from time to time shall be presumed to be correct until specifically challenged by someone other than the applicant(s). This would mean the applicant could at all times correct/change the information on inventors at will. In case an inventor is said to no longer be an inventor, a notice of this fact should be sent to that inventor by the Patent Office to allow for possible objections.

In case the correctness of the information provided by the applicant(s) is challenged by a third party, the Patent Office should nevertheless be entitled to rely thereon unless such third party submits proof that it has taken legal action to have its claim for inventorship established by a competent court. Once such proof of legal action has been submitted, the Patent Office shall have the possibility to stay the further handling of the patent application in case the applicant's title to the invention is not supported by the documentation before it.

- 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.*

The Swedish group does not consider it appropriate to provide for a first national filing requirement.

- 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.*

The Swedish group realises the need for secrecy reviews.

The Swedish group suggests that the criteria for where a secrecy review shall be made shall be the domicile of the (intended) applicant or applicants. In case of several applicants, the domicile of the majority of them or the first stated applicant can be decisive. Said party or parties are those who have both legal and de facto control over the information intended to be included in the application, and their country of domicile would also have jurisdiction to enforce the requirement for a secrecy review.

In case a country otherwise wishes to prevent its nationals (individuals or legal entities) from communicating sensitive technology to foreign countries, this should be handled by other legislation than patent law.

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

The Swedish group does not consider it appropriate to provide for a first national filing requirement or foreign filing license.

- 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.*

The Swedish group is generally not in favour of a first filing requirement and do not propose any way of curing a possible failure to adhere to such requirement.

In respect of a failure to comply with a secrecy review, it is obviously difficult for the applicant to repair once the information concerning the invention has been disclosed to the patent office(s) in other countries/regions (or even become public as part of the prosecution process).

- 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.*

The Swedish group has discussed a possible abolishment of the requirement of stating the names of the inventors in a patent application in case the stated ground for the applicant's acquisition of the rights to the invention is an employer/employee

relationship with the inventor and the applicant represents that the inventor has waived the right to be named as such.

This would open the possibility to file patent applications on the result of research made in multinational groups of companies, without having to include the names of the inventors and consequently no detailed assessment of inventorship would have to be made for purpose of those patent filings.

To avoid misunderstanding, the intention would not be to abolish any rights of employee inventors as such, but just to remove the absolute requirement for stating the name of the inventor in the prosecution process and thereby facilitating the administrative handling of patent applications. Even so, this proposal raises many issues that would have to be looked into further as a separate working question.

Summary

There is no explicit definition of inventorship in Swedish law but it is clear that something more than routine work and working under instructions from others is required in order to claim inventorship. The inventive contribution shall in principle be directed to what is claimed as the invention in a (patent) application. Erroneous information on inventors in an application can be corrected by the applicant both during the prosecution of the application and after grant. The consequences of an error in respect of inventorship involves the possibility for the proper inventor (or successor in title) to claim a transfer of all or part of (in case of co-inventorship) the application or patent to the entitled person or invalidating the patent (not in case of co-inventorship).

There is no discrimination between national and foreign inventors although there are some choice of law rules implemented for EPC patent applications, which in some cases will involve that foreign law applies to the issue of inventorship.

There is no general requirement for a first filing in Sweden but inventions concerning military equipment made in Sweden or owned by a physical or legal person domiciled in Sweden (defence inventions) are subject to a notification requirement and secrecy review. Such review may then result in a requirement for governmental consent to the filing of patent applications abroad.

The Swedish group suggests a harmonized definition of inventorship, the inventor being a person who has made a significant intellectual contribution to one or more features of the invention, and also discussed some relaxation of the requirement for stating inventorship in respect of inventions which are the result of intragroup research. The latter is however suggested as the topic of a separate Q.