HOW TO DETERMINE THE TRUE INVENTOR?

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Which employer, licensing, IP or R&D department of a company has never been faced with the difficult task of designating the inventors when filing a patent application?

An invention to be exploited is generally the fruit of a collaboration chain in which each participant has made his/her own contribution to the final work.

Distinguishing between them comes down to separating the different participants in this value chain, and is directly related to human resource management in the corporation.

Basically, according to article L611-6 of the intellectual property code (IPC), “the right to the industrial property title belongs to the inventor or his/her successor in right”.

Determining the true inventor/s is therefore an essential part of ensuring property of the invention. This measure is essential to ensure that the inventor or any successor in right will be properly identified as such in the patent application and, as applicable, can claim his rights within the context of a collaboration contract. Otherwise, article L. 611-8 IPC allows the true inventor or successor in right to claim ownership of the patent.

The designation of the inventor is mandatory, article L611-9 CPI stating in this respect that “the inventor, an employee or otherwise, shall be mentioned as such in the patent”. Such a designation, in the case of employed inventors, gives rise to the obligation to pay an additional remuneration or a fair price (article L611-7 CPI), which is a potential source of dispute between employer and employee.
An invention is above all an intellectual conception which is the fruit of the reflexion of one or several individuals. It is therefore a question of facts in respect of the role of each individual in the conception of the invention, and of his/her intellectual and technical contribution.

This question of facts cannot be pre-defined by law or contract.

Thus, in France, there is no legal definition of an "inventor".

Nevertheless, an inventor designated as such in a patent application is legally presumed to be the true inventor. The burden of the proof to reverse such a presumption is particularly heavy, and will be even more difficult when the presumed inventor has also been designated as such in other patent applications such as, for example, in the United States.

It is therefore essential have a “canvas” available from the start, which will allow decision makers to distinguish inventors from other participants in developing and giving value to an invention and, as applicable, to settle the issue.

Most collective agreements containing provisions relating to the rights of inventors remain silent as to what the paternity of an invention exactly means.

Some of them, including the collective agreement for the chemical industries, provide four indices making it possible to assess the employed inventor’s right to remuneration, i.e.:
- The general framework of the invention;
- The difficulties involved when reducing the invention to practice;
- The personal and original contribution of the employee;
- The commercial interest of the invention

However, the concept of personal contribution is vague. It involves analysing the framework of the research in order to understand the personal role of the employee when making the invention.
Only the case law provides more precise indicators as to the concept of inventor.

Firstly, the inventor is a physical person and not a corporate body as an invention is the fruit of an intellectual activity. It was thus confirmed by the Paris Court of Appeals on 18 June 2004 that an inventor may only be a person who actively participated in making the invention (GRAIRE v/ POL SCARPE SPORTIVE).

Also, the presence of an inventive step is necessary for being qualified as inventor, and any party who claims inventorship must himself provide evidence of his/her inventive step.

However, this concept of inventive step should be distinguished from the corresponding patentability criterion pursuant to article L 611-14 CPI.

Any person may provide this evidence, and his/her position in the company does not presume his/her capacity as inventor. The courts in fact analyze the personal contribution to the conception and, as applicable, to the reduction to practice of the invention, and examine whether this contribution exceeds the framework of mere execution.

One of the evidentiary means most favourably looked on by the courts is the participation of the alleged inventor in the drafting of the patent application, with the help of the patent attorney. The other evidentiary means which can be used are the usual ones such as meeting minutes indicating participants and their position, scientific publications, summary notes or other internal notes concerning the invention, the driving or follow up of industrial tests, testimonies, and of course laboratory notebooks.

Claims of inventive step may nevertheless be disputed, and the courts may assess the technical or professional abilities of alleged inventors to conceive the invention, as well as their position within the company.

Certain categories of employees will generally be considered as mere executors and not inventors. This is the case in general with a technician, foreman, maintenance engineer, lab preparator, manager, company official, secretary, chairman of
the executive board, director, chairman of the board of directors, etc.

Others will be more readily admitted as inventors. These are most commonly researchers having an inventive mission.

In general, any person who participated in making the invention by analyzing the problem to be solved and the technical solution to be provided will be considered as an inventor.

Case law has thus laid down to the indicators which prove or not the contribution of the alleged inventor.

An invention is often the fruit of a team and not a single individual.

In this case, the person from whom the invention and the inventive step originated, on the one hand, and the persons who contributed to its technical and industrial reduction to practice on the other hand, will be deemed inventors. The Paris Court thus ruled that a co-inventor to be designated could be the employee who has provided the technical and marketing ideas of the invention but not its technical feasibility, and that paternity of the invention would then be shared between him and the R&D team to which the feasibility and achievement of the project was entrusted (THIBIERGE v/ ARJO WIGGINS Co., TGI Paris, 16 October 2001).

Further, the lack of a precise description of the contribution of each team member may favour the alleged inventor. Thus the Paris Court has also recognized a person as inventor by acknowledging that the reduction to practice has been carried out by a team to whom he belongs, although it could not affirm that he had a determinant role within the team. (BRINON v/ VYGON, TGI Paris, 14 September 2005).
Persons who have been involved in the reduction to practice and/or industrialization are not automatically considered as co-inventors, and the courts must also consider the nature of the contribution of each of them to distinguish inventors from non-inventors:

- The mere provision of resources or advice within a team is insufficient to become qualified as co-inventor.
- The mere lending of equipment is insufficient to acquire inventorship.
- Self-financing the studies leading to an invention does not provide the quality of inventor to the financer.
- The mere formulation of a problem to be solved or the drafting of technical specifications is generally insufficient to confer the quality of inventor or co-inventor.
- The mere exchange of ideas with regard to the interest of the invention is insufficient to assign any ownership to the patent.
- Participation in an invention which solely pertains to the area of abstract ideas may not in itself provide inventorship.

It is therefore on this basis that public and private bodies must draw up clear internal guidelines to designate inventors. This would undoubtedly make it possible to avoid the majority of disputes in this area.

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