WIPO Circular C.9199

Contribution of Germany to a study on patent inventorship and ownership issues arising from collaborative research

Patent inventorship and ownership issues arising from collaborative research – be it between companies, between universities or between universities *and* companies – are to be assessed on the basis of the **general provisions on inventorship, including joint inventorship and employee inventorship, and ownership** of German Patent Law. In addition, **contracts and contract law** play a pivotal role in this context.

A. Statutory rules on inventorship, co-inventorship and employee inventorship in German patent law

Although the German Patent Act[1] refers to the term "inventor" on numerous occasions (e.g. Sections 6, 7 and 37), it does not provide a definition. Rather, the **definition and principles** of how to determine the inventor have been **developed by courts and jurisprudence**. German case law has in essence conceptualized the inventor as the one who first "recognized" the knowledge of how to resolve a specific technical problem by using certain technical means.[2]

Section 6 sentence 2 German Patent Act refers to the constellation that **two or more persons** have jointly made an invention. It does, however, not give more concrete guidance on under which conditions to assume the status of **joint inventorship**. According to the relevant case law, a joint inventor is generally anyone who has made a **sufficiently significant contribution** to the invention. This has to be assessed with a view to the circumstances of the **concrete case** at hand. The joint inventor's contribution need not itself be inventive in the sense that it does not have to satisfy all the preconditions for a patentable invention out of itself.[3] However, contributions that have not influenced the overall achievement, i.e. are unsubstantial with respect to the solution, and contributions that have been created based on the instructions of the inventor or a third party, do not establish status as a joint inventor.[4]

The law on **employee inventions** is governed by the **German Employee Inventions Act**,[5] which differentiates between **tied inventions (service inventions)** and **free inventions**. According to

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[1] The following explanations are based on the translation available at https://www.gesetze-im-internet.de/englisch_patg/englisch_patg.html#p0092, an online service by the German Federal Ministry of Justice. Please note that the translations of German statutes into languages other than German available on this website are intended solely as a convenience to the non-German-reading public and that any discrepancies or differences that may arise in translations of the official German versions of these materials are not binding and have no legal effect for compliance or enforcement purposes (https://www.gesetze-im-internet.de/Teilliste_translations.html).

[2] Cf. *Bundesgerichtshof* [Federal Court of Justice] BGH, judgement of 18 May 2010, ref: X ZR 79/07, GRUR 2010, 817 – *Steuervorrichtung*; Melullis in: Benkard, Patentgesetz, 11th edition 2015, Section 6 para 30.

[3] BGH, judgement of 16 September 2003, ref: X ZR 142/01, GRUR 2004, 50, 51 – *Verkranzungsverfahren*.

[4] Cf. BGH, judgement of 16 September 2003, ref: X ZR 142/01, GRUR 2004, 50 – *Verkranzungsverfahren*; BGH, judgement of 18 June 2013, ref: X ZR 103/11, BeckRS 2013, 13904.

[5] An **unofficia**l translation of the Employee Inventions Act into English is available at https://www.dpma.de/docs/dpma/schiedsstelle/employee_inventions_act.pdf. Please note that the following

Section 4 para 2, service inventions are inventions made during the term of employment, which either resulted from the employee's task in the enterprise or public authority, or which are essentially based upon the experience or activities of the enterprise or public authority. Other inventions are considered "free inventions" according to Section 4 para 3, which are however also subject to certain legal restraints imposed upon the employee according to Sections 18 and 19. An employee having made a service invention has the **duty to report** this invention to the employer immediately (Section 5 para 1). The **employer may "claim" a service invention** by making a respective statement to the employee (Section 6 para 1). Such claim is deemed declared unless the employer expressly "releases" the service invention by making a statement in text form addressed to the employee, within four months after receipt of the employee's report (Section 6 para 2). Upon claiming the invention, **all property rights in the service invention pass to the employer** (Section 7). The employer is solely entitled and – as a rule – under the duty to apply for a domestic industrial property right for a service invention reported to him (Section 13). The employer is also entitled to apply for industrial property protection abroad (Section 14). The **employee has a right to reasonable compensation** vis-à-vis the employer, which arises as soon as the employer has made the claim to a service invention (Section 9 para 1). In assessing the amount of compensation, due consideration shall in particular be given to the commercial applicability of the service invention, the duties and position of the employee in the enterprise, and the contribution of the enterprise to the invention (Section 9 para 2).

This general legal framework **applies also** with respect to collaborative inventions made in the course of **research and development cooperation** between industry and universities or between companies. In every case, taking into account **the concrete circumstances** at hand, it has to be determined which persons have made a substantial contribution to the solution of the respective technical problem. The rules of the Employee Inventions Acts regarding the „claiming" of service inventions by the employer may thereby lead to cases of co-entitlement to the right to the patent between e.g. employees of a university and employees of a company, or between employees of an industry principal and employees of an industry agent, in constellations where these employees have collaborated in mixed teams.

B. The importance of contracts and contract law

In practice, according to the experience of the Arbitration Board under the Law on Employees' Inventions established at the German Patent and Trademark Office, inventorship issues are widely addressed in advance in the respective **cooperation contracts**. Within the framework of the contractual rights and obligations established there, it is determined **who shall be entitled** to the inventions resulting from the cooperation, **how this shall be compensated** and **who shall have the rights to use** the invention. The formation, validity, termination and

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control of these contracts is – besides binding standards of statutory patent law, and of course any other relevant laws that may apply to a specific case – subject to **the general standards of German contract law**.