(viii) study on patent inventorship and ownership issues arising from collaborative research

1. Inventorship on collaborative research

   Inventors may obtain a right to a patent for an invention (Japan Patent Act, Article 29 (1)).

   In case of being invented collaboratively, the right to the granting of a patent is co-owned among all joint inventors. Therefore, a patent may not be obtained for only some of the joint inventors in this case (Japan Patent Act, Article 38, 49 (ii), 123 (1) (ii)).

2. Patent ownership of collaborative research

   When the right to a granted patent is co-owned, no co-owner may transfer their own respective share, establish an exclusive license, or grant a non-exclusive license on the patent right to any third party without the consent of all other co-owners (Japan Patent Act, Article 33 (3), 73 (1), (3)) unless otherwise agreed upon via a contract (Japan Patent Act, Article 73 (2)).

3. Instability of belonging in case the right to obtain a patent for an employee invention is co-owned

   The right to the granting of a patent may be transferred (Japan Patent Act, Article 33 (1)), and in case of an employee invention, any provisions in any agreement, employment regulation, etc. providing the right to the granting of a patent may be acquired by the employer, etc., and the patent rights for any invention made by an employee, etc. are vested in the employer, etc., are prescribed (Japan Patent Act, Article 35 (2)).

   On the other hand, in cases of collaborative research, no co-owner may transfer the co-owner's respective share without the consent of all other co-owners when the right to the granting of a patent is co-owned (Japan Patent Act, Article 33 (3)). However, the procedure related to vesting a right may be complicated if it is not enough to make a contract, etc., established between the employer and employee in advance, leading toward no joint owner being able to vest a right of pledge on the joint owner's own share without the consent of the other company's employee etc., as the other joint owners.

   Therefore, it was established by amending the Japan Patent Act in 2015 that in case it is prescribed in any agreement, employment regulation or any other stipulation in advance that the right to the granting of a patent for any employee invention is vested in the employer, etc., the right to the granting of a patent belongs to the employer, etc. from its occurrence (Japan Patent Act, Article 35 (3)).

4. Relevant Case Law

   The case laws below are those cases disputed with respect to joint inventors.

   (1) Case 1 : Example of a ruling wherein the joint members who came up with an idea for each functional element composing the invention were regarded as joint inventors
   Osaka High Court, 1998 (Wa) 10432, 2001.05.10

   (2) Case 2 : Example of a ruling wherein the joint members who did not come up with an idea about the features of an invention were not regarded as joint inventors

Tokyo District Court, 2001 (Wa) 7196, 2002.08.27

(3) Case 3: Example of a ruling wherein the joint members who realized the ideas were regarded as joint inventors
Tokyo District Court, 1999 (Wa) 20878, 2001.01.31

5. Relevant Provisions

Article 29

(1) A person that invents an invention with industrial applicability may obtain a patent for that invention, unless the invention is as follows:

(omit)

Article 33

(1) The right to the grant of a patent may be transferred.

(omit)

(3) When the right to the grant of a patent is co-owned, no co-owner may transfer the co-owner's respective share without the consent of all the other co-owners.

Article 35

(1) If an employee or officer (hereinafter referred to as an "employee, etc.") of an employer, corporation, or a national or local government (hereinafter referred to as an "employer, etc.") has obtained a patent for an invention which, by its nature, falls within the scope of the business of the employer, etc. and was achieved by an act categorized as a present or past duty of the employee, etc. performed for the employer, etc. (hereinafter referred to as "employee invention"), or if a successor to the right to the grant of a patent for the employee invention has obtained a patent therefor, the employer, etc. has a non-exclusive license on the patent right.

(2) In the case of an invention by an employee, etc. other than an employee invention, any provisions in any agreement, employment regulation or any other stipulation providing in advance that the right to the grant of a patent is acquired by the employer, etc., that the patent rights for any invention made by an employee, etc. are vested in the employer, etc., or that a provisional exclusive license or exclusive license for the invention is established for the employer, etc., is null and void.

(3) In the case of an employee invention by an employee, etc., when it is prescribed in any agreement, employment regulation or any other stipulation providing in advance that the right to the grant of a patent for any employee invention is vested in the employer, etc., the right to the grant of a patent belongs to the employer, etc. from its occurrence.

(omit)

Article 38

If the right to the grant a patent is jointly owned, a patent application may only be filed by all the joint owners.

Article 49

The examiner must reach an examiner's decision to the effect that a patent application is to be rejected if the patent application falls under any of the following:
(omit)
(ii) the invention claimed in the patent application is unpatentable, pursuant to Article 25, 29, 29-2, 32, or 38 or Article 39, paragraphs (1) through (4);

Article 73
(1) If a patent right is jointly owned, no joint owner may transfer or establish a right of pledge on the joint owner's own share without the consent of all the other joint owners.
(2) If a patent right is jointly owned, unless otherwise agreed upon in a contract, each of the joint owners of the patent right may work the patented invention without the consent any other joint owner.
(3) If a patent right is jointly owned, no joint owner may establish an exclusive license or grant a non-exclusive license on the patent right to any third party without the consent of all the other joint owners.

Article 123
(1) If a patent falls under any of the following items, a request for a trial for patent invalidation may be filed. If the request involves two or more claims, it may be filed on a claim-by-claim basis:
(omit)
(ii)the patent has been granted in violation of Article 25, 29, 29-2, 32, or 38, or Article 39, paragraphs (1) through (4) (if the patent has been obtained in violation of Article 38, excluding if the transfer of a patent right under that patent has been registered based on a request under Article 74, paragraph (1));
(omit)