

WHAT MAKES A CO-WORKER A CO-INVENTOR?

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Legal Basis

Neither the German patent law (PatG) nor the European Patent Convention (EPC) provides a definition of “invention” or of “inventor” and “co-inventor”, respectively. Thus the legislator has left the definition to the case law.

Inventor

In its judgment rendered on March 27, 1969 (“Rote Taube”), the German Federal Court of Justice (BGH) defines a patentable invention as a “teaching for planned action using controllable natural forces for attaining a causally clear success”.

Under the current case law an “inventor” is a person who has recognized the inventive idea and developed instructions for a technical action in a creative act. Hence, an inventor must have realized for which technical application the invention can be used. The right to the invention starts to exist when the invention is complete and formulated as such that it can be recognized by third parties in an appropriately concrete manner (BGH 10.11.1970 “Wildverbissverhinderung”).

Since the invention is the result of a creative human act, it is only a natural person who can be an inventor.

Co-inventor

The patent law does not specify in detail under which preconditions several persons may have made an invention jointly. The inventor’s personal right continues to be a highly personal matter also in the case of a joint invention. This right is assigned to each individual co-inventor. However, only an acknowledgment as a co-inventor (and

not as a sole inventor) can be derived from such a right.

The employee’s obligation to report to the employer under § 5 II German Employees’ Invention Act (ArbEG) regards not only the report on co-inventors and their contributions to the invention, but also any involvement of further co-workers in the invention and the type and scope of their involvement. § 5 II ArbEG reads:

The employee must describe in the report the technical object, its solution and how the service invention was accomplished. (...) The report shall specify (...) the co-workers involved as well as the type and scope of their contribution, and shall emphasize what the reporting employee regards as his own contribution.

As can be taken from the general term “co-worker”, this term covers both co-inventors within the meaning of § 6 sentence 2 PatG and other persons involved in the creation of the invention (inventors’ assistants). The legislator chose this broad concept to assign the often difficult task of making a distinction between co-inventors and inventors’ assistants not to the reporting employee, but to the employer (BGH 18.03.2003 “Gehäusekonstruktion”).

Only a person who has made his own creative contributions to the inventive idea can be treated as a co-inventor.

“Co-inventor is any person who made a creative contribution to the invention” (BGH 16.09.2003 “Verkranzungsverfahren”).

According to the BGH decision of May 5, 1966 (“Spanplatten”) a “qualified collaboration” is needed that can only be attributed to a person

“who has been involved in the creation of the invention, namely in the statement of the object or in its solution, by ideas that exceed ordinary skill in this field”.

The Upper Regional Court (OLG) of Düsseldorf (30.10.1970 “Einsackwaage”) confirms that a co-inventorship is only justified through a contribution exceeding the ordinary skill of the person skilled in the art (a “creative” contribution) whereas a contribution of the other persons involved that conforms to ordinary skill does not substantiate any share in the invention (see also BGH 20.02.1979 “Biedermeiermanschetten”). In the headnote of its decision the Upper Regional Court of Düsseldorf adds:

“Only if an achievement of an individual person that exceeds the ordinary skill of the person skilled in the art cannot be detected at all, a contribution within the scope of ordinary skill may also substantiate a share in the invention”.

Furthermore, only those contributions that have co-influenced the overall inventive achievement *significantly*, i.e. are significant with respect to the solution, are regarded as being creative (see inter alia BGH 20.06.1978 “Motorkettensäge”, BGH 17.10.2000 “Rollenantriebseinheit”). The BGH also refers to “significant ideas” (BGH 16.09.2003 “Verkranzungsverfahren”). This means that contributions that have not influenced the overall success, i.e. are insignificant with respect to the solution, cannot substantiate any co-inventorship (BGH 20.06.1979 “Motorkettensäge”).

Likewise, contributions that were made upon the inventor’s instructions or those of a third party do not warrant any co-inventorship (BGH 20.06.1978 “Motorkettensäge”). Even contributions that helped in solving the object, but were made upon the instructions of the inventor or a third party, do thus not substantiate any co-inventorship.

This view is shared in a recent decision of the BGH (15.05.2001 “Schleppfahrzeug”), according to which a co-inventor within the meaning of Article 60 EPC can only be a person who has developed a technical teaching by virtue of his own ideas and independently of any directives given to him by third parties and has thus gained knowledge about the invention. The current case law confirms:

“those contributions that have not influenced the overall success, i.e. are insignificant with respect to the solution, and those that have been made upon the instructions of an inventor or a third party, do not [substantiate] any co-inventorship.” (BGH 16.09.2003 “Verkranzungsverfahren”).

To sum up, it should be noted that a co-inventor is normally only a person who was involved in the development of the teaching by contributing an achievement

- which exceeds the ordinary skill of the person skilled in the art and
- which substantially co-influences the overall inventive achievement, and
- which is based on his own initiative and not based on any instructions.

Hence, a co-inventor is distinguishable from the mere inventor’s assistant who carries out or solves constructional or experimental tasks in a manner strictly bound by instructions and without his own initiative (BGH 20.06.1978 “Motorkettensäge”, see also BGH 05.05.1966 “Spanplatten”).

It follows that a mere routine participation or constructive help in a subordinate function, e.g. the sequencing of a gene by a service department within an institute or by another contractor in charge of sequencing, does not substantiate any co-inventorship (e.g. in the sequenced gene).

Contributions that must be regarded as insignificant and do not substantiate an inventorship are for example:

- the contribution of an embodiment to an already completed invention
- (BGH 28.02.1963 Ia ZR 92/63);
- the compilation of the prior art;
- help in drawing up the application (BGH 28.04.1970 X ZR 42/67);
- the execution of work in compliance with instructions given by other persons involved in the invention (BGH 20.06.1979 "Motor-kettensäge", BGH 16.09.2003 "Verkranzungsverfahren").

The last item covers experimental tasks strictly bound by instructions as well as the scrupulous execution of tests exactly described with respect to approach and execution, e.g. the performance of established screening assays or other routine work.

Moreover, the (formal) incorporation of a particular embodiment of the invention in a subclaim alone does not necessarily constitute a creative contribution to the overall invention (BGH 20.02.1979 "Biedermeiermanschetten" and BGH 17.10.2000 "Rollenantriebseinheit"). That is, if a specific embodiment is incorporated into the patent application as a subclaim, this does not per se substantiate that the contributor of this specific embodiment is a co-inventor.

Example

Applied to a method for the development of an active substance in the field of pharmaceuticals, the following can be derived from the case law:

The first step, i.e. provision (synthesis) of specific active substances based on a specific theory, is the invention as such. The testing of these active substances as

to their assumed or expected effect in a further step is not an independent invention under the case law even if difficulties had to be overcome. If the tests are carried out in compliance with predetermined known assays and/or instructions given by the inventor or a third party, no matter how valuable the test results may be, the demands made on co-inventorship are not satisfied.

The step of testing could only qualify for a co-inventorship if existing protocols were changed independently, i.e. on one's own initiative, and properties of an active substance were thus found that had not been expected before and if the finding of such properties as a creative contribution considerably influenced the overall inventive achievement.