



Rajeev Kumar



Pankaj Musyuni

Who can be named as inventor – an Indian perspective

Rajeev Kumar & Pankaj Musyuni from LexOrbis give insight into patent law in India, specifically thinking about Inventorship: who can be named as an inventor, what their rights are, and what criteria will be assessed in the process.

The filing of patents to obtain the exclusive rights includes numerous aspects for the validity of the application, apart from the patentability criteria. Among such issues are an indication of correct inventors is an important issue, wherein the identification of contributors to the invention can become a complex issue. The complexity in the determination of inventorship is due to the multiple interactions and contributions among inventor(s) themselves, as well as with their employers. The issues also arise when a paper for research work is published and, invariably, the terms, authorship, and inventorship are used interchangeably in the theoretical context, but each have their own significance either with regard to publication in the renowned journals or for filing a patent application with intention to commercialize and get rewarded for the efforts. Therefore, determination of inventorship essentially requires an accurate analysis.

Conception of idea by Inventor

In fact, a person who has contributed a conception of an idea and made a significant inventive contribution to the identified problem(s) to arrive at an optimum solution

with substantial human intervention is an inventor. Conception includes the idea generation, applied approaches made for definitiveness of invention, and operational part for its practical utility. It is pertinent to note here that an erroneously added or omitted inventor(s) may have serious consequences on the validity of a patent and also on its valuation and, therefore, the issue must be dealt with a vigilant approach to avoid such complexities in future.

Determining factors

While the methodology and approaches for determining the inventorship cannot be generalized and eventually will be based on the facts of a case, it is presumed that a person who perceives and conceptualizes the subject matter of the invention will be considered as an inventor. Such subject matter includes the product, composition, process, and its application along with the matter covered in the independent claims and two or more persons who collaborate with joint efforts to arrive at the solution.

Simultaneously, in any case, it is also worth identifying the persons who cannot be treated as an inventor for a fair approach and analysis. Such criteria includes:

- 1) The factors such as the person whose contribution is limited to suggestions, which can be done by a person skilled in the art;

Résumés

Rajeev Kumar, Partner, Patents Team, LexOrbis

Rajeev has extensive experience in patent law and practice in drafting, prosecution, opposition, litigation and writing legal opinions particularly in field of chemical, pharmaceutical, biotechnological and oil and gas inventions. He can be contacted at: rajeev@lexorbis.com

Pankaj Musyuni, Senior Associate, LexOrbis

Pankaj holds a master's degree in pharmaceutical science and management. He has in-depth knowledge of patent law and regulatory framework and extensive experience in patents filing, drafting, prosecution and opposition and regulatory advises pertaining to the field of chemical and pharmaceuticals. He has authored several articles and also delivered talks in field of pharmaceuticals, agrochemicals, drug regulatory affairs and clinical research. He can be contacted at: pankaj@lexorbis.com

“ The question of determination of inventorship, or the true and first inventors, arises when there are multiple contributors to the invention. ”



- 2) A person who technically performs the experiments on instructions from the inventor(s), supervisor(s)/mentor(s) of the inventor(s);
- 3) A person whose contribution is limited to the consultation about technology know-how, which helps only in performing some experiments;
- 4) A person who has an idea of solution but doesn't know the methodology as to how it can be achieved; and
- 5) A person who provides a mere suggestion for improvement or alternatives of the invention.

For clarity, the benchmark can be based on the facts that an individual cannot be treated as an inventor if they suggest a mere possible idea or obvious solution to the identified problem, performed only on the directions/inputs given by the inventor(s) to perform certain pre-defined tests on pre-specified conditions and has no effective contribution to the invention. Having said that, it is also important to analyze and recognize the proper inventorship, which focuses exclusively from the conception stage and lead to the definite and permanent solution along with working examples to perform.

Indian scenario and judicial interpretation

Section 6 of the Indian Patents Act defines the persons entitled to apply for patents wherein Section 6(1)(a) states that a person must be "true and first inventor" of the invention. Section 2(1)(y) of Indian Patents Act defines the "true and first inventor" as someone that does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India. However, the methodology to determine and identify Inventorship is left for subjective interpretation.

The question of determination of inventorship, or the true and first inventors, arises when there are multiple contributors to the invention and when there is an employer-employee relationship. The position that an employer, who is generally a financial contributor, cannot be an inventor is clear from the *V.B. Mohammed Ibrahim Vs*

Alfred Schafrnek AIR 1960, wherein the Court held that "It is not the plaintiff's case that he contributed any part of his ingenuity or skill or technical knowledge towards the invention in question. All that he says that in that he gave the wherewithal viz., the finances for the running of the concern that with this help experiments were made and ultimately the invention was evolved. It is not disputed that the persons that actually labored and found out the process were defendants 1 and 2. Under these circumstances, it is very difficult to accept that the plaintiff could be treated as an inventor".

However, when there are multiple contributors, say researchers from a single institute or multiple institutions, and there are different types of contributions to a single invention, then the determination of inventorship becomes more critical and poses a challenge. The Controller of Patents in the matter of *National Institute of Virology versus Mrs. Vandana S. Bhide* has discussed such a situation. The Controller addressed the question "who is the inventor", considering various factors and made certain conclusions as to who can be named as an inventor. Some of the factors to be considered while assessing whether a person can be named as an inventor or not, are as follows:

For naming an inventor, he must have made an intellectual contribution in achieving the final results of research work leading to a patent.

- A person who has not contributed intellectually to the development of an invention is not entitled to be included as an inventor.
- A person (read inventor) who provides ideas to produce the 'germ of the invention' need not himself/herself carry out the experiments. The person may take the help of others. Such persons who have helped in conducting experiments, constructing apparatus, etc. without providing any intellectual inputs are not entitled to be named as inventors.

The Controller also provided guidance on the linkage between inventorship and the claims by stating, "The inventor, for the purpose of patent law, is the actual deviser of what is being claimed." Therefore,

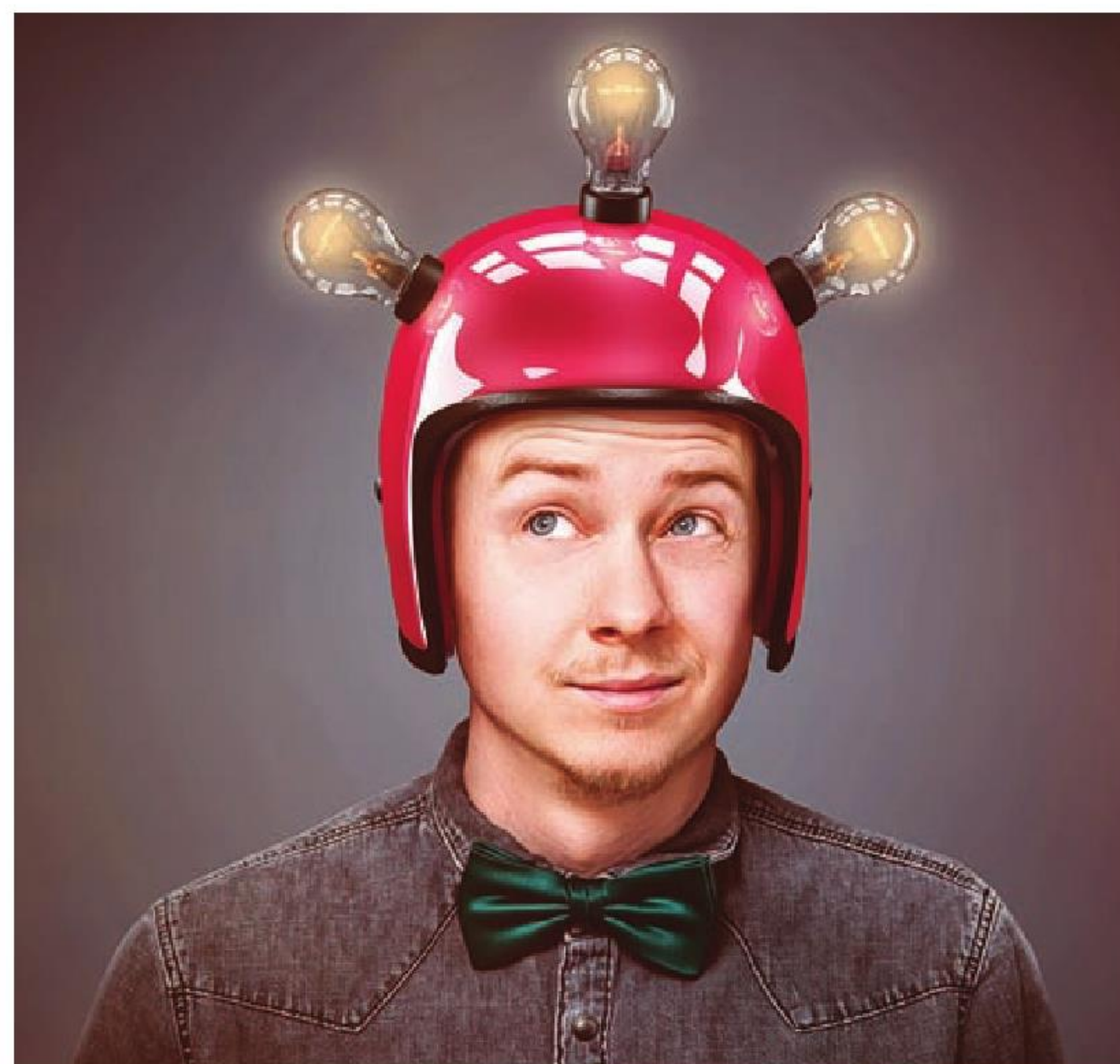
the Controller clarified the distinction between the inventor and a pair of hired hands. In the said decision, guidance can also be deciphered with respect to a difference in authorship and inventorship. In the pieces of evidence submitted by Mrs. Vandana S. Bhide (who alleged that her name was not included as inventor), a paper has been submitted relating to the invention of alleged patent application, wherein Mrs. Vandana S. Bhide was named as one of the co-authors. However, there were two additional co-authors as well, who were not named as an inventor in the application, and there was one inventor in the patent application that was not listed as the co-author in the published paper. Hence, authorship in a paper/article can at best amount to be considered for contribution in writing of the paper/article, but need not be a proof of inventorship in the corresponding patent application.

Based on the above, in general, the following factors can be considered while assessing whether the contribution by a person would merit the person to be named as inventor or not:

- If the person has contributed to the idea that materializes into the invention, then the person will be named as the inventor.
- If the person's contribution is technical in nature and such technical feature is not novel, the person need not be named as the inventor, because such technical contribution can be considered to be known and routine lab work and a person skilled in the art may be aware of that concept.
- If the person's contribution is technical in nature, but such technical feature is novel, the person may be named as inventor, because such technical contribution might be necessary to reduce the idea to actual practice of the invention, in absence of which, the idea could have remained only an idea, and would not have necessarily materialized into an invention.

Conclusion

Though the definition of true and first inventor in the Patents Act does not exactly cover how the Inventorship can be determined, the Indian jurisprudence does provide guidance to determine whether the contribution of a person amounts for a person to be named as an inventor or not. With increase in joint research work, more collaboration in research and development activities among academia and industry and multiple contributors in an invention, such methodology might be of help in determining the true and first inventors while filing patent applications.



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NEW DELHI • MUMBAI • BENGALURU

www.lexorbis.com / mail@lexorbis.com / T: +91 11 2371 6565

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