

# The possibilities of asserting rights by the co-inventor omitted in the patent application

What are the consequences of filing a patent application in which one of the inventors is omitted? We have already dealt with various aspects of this issue in our previous publications. We presented a case study regarding the invalidation of the CRISPR/Cas9 patent before the EPO due to the omission of one of the inventors (see [here](#)). We also pointed to the matter of criminal sanctions under Polish law applicable in the event of omitting the inventor in the application (see [here](#)). This time we want to tackle this issue **from the perspective of — probably — the person who is the most interested in this problem**. What can the omitted inventor do? What claims is he or she entitled to?

In this article, we demonstrate that the omitted inventor has a certain range of legal means that they can use to assert their rights.

## A co-inventor

The co-inventor is, according to the commentary to the Act of June 30, 2000 - Industrial Property Law (IPL) edited by prof. Sieńczyło-Chlabicz, **"the one whose work of a creative nature became part of the final result, which was the joint invention"**. The commentary indicates that the possibility of recognizing a given person participating in the inventive process as a co-inventor is determined by the assessment of their input in the elaboration of the invention. According to Art. 8(1) in connection with Art. 8(3) of the IPL, the co-inventor has the right to obtain a patent, remuneration, and to be mentioned as the inventor in descriptions, registers, and other documents and publications.

The size of their share in these rights is determined by their contribution to the invention. It may be contractually determined, but the provisions of the Act of 23 April 1964 - Civil Code (KC) regarding joint ownership should be applied accordingly. On the basis of the provisions of the Civil Code, a presumption of equality of shares is established (Art. 197).

## A patent application filed by co-inventors

The IPL contains a provision on the rights of a person who is one of the jointly entitled. Although Art. 72 sec. 1-3 refers directly to the situation of a co-owner of a patent already granted, Art. 72(4) indicates that this regulation shall apply accordingly to the co-ownership of the right to obtain a patent. Importantly, the provision of Art. 72 also contains a reference to the provisions of the Civil Code on co-ownership in fractional parts.

It should be noted that pursuant to Art. 199 of the Civil Code, **the consent of all co-owners is required to dispose of a co-owned object and to perform other activities that exceed the scope of ordinary management**. Alternatively, when there is no consent of the co-owners, the co-inventors whose shares in the right amount to at least half may demand that the case be resolved by the court. In the literature, it is clearly indicated that **an activity exceeding the ordinary management of law is, for instance, the submission of a patent application relating to an invention**. In this regard, the significance of the decision of co-inventors, whether to keep the invention secret or to disclose it, is emphasized.

## The patent invalidation

The patent invalidation is governed by **Art. 89 of the IPL**. Due to revisions made through the amendment act of 16 October 2019, the requirement to demonstrate a legal interest in submitting a motion to invalidate a patent has been removed. Thus, it can be concluded that anyone can submit such a motion to the Polish Patent Office. There are, however, some serious doubt in this respect, which will be discussed below.

The Polish legislator has laid down the following grounds for the patent invalidation:

- 1) The conditions required to obtain a patent have not been met** — this will concern instances where a patent does not fulfill one of the patentability criteria, i.e., it is not a technical solution that can be characterized as new, it does not exhibit the inventive step and is not capable of industrial applicability. At the same time, it does not constitute one of the exceptions to patentability indicated explicitly in the IPL.
- 2) The invention has not been disclosed clearly and sufficiently for a person skilled in the art to be able to recreate the invention;**
- 3) The patent was granted for an invention not covered by the content of the application or the original application;**
- 4) Patent claims do not define the subject of the protection sought in a clear and concise manner or are not fully supported by the description of the invention.**

Will the omission of one of the co-inventors in the application fall within this scope of the grounds for the invalidation? The answer is no: **the grounds listed in Art. 89 of the IPL are objective in nature, while the subjective conditions are regulated in a separate provision, i.e., Art. 74 of the IPL** (see, for instance, the commentary to the IPL edited by Prof. Żelechowski).

As a side note, it is worth noting that in the previous legal regime, when interpreting the requirement of a legal interest (now abolished), the Supreme Court was not willing to recognize that one of jointly entitled persons has a legal interest if he or she acts against the will of the other co-inventors (judgment of the Supreme Court of June 8, 1993, reference number I PRN 59/93).

## The regulation of Art. 74 of the IPL

The provision of art. 74 applies **in the event of filing a patent application or obtaining a patent for an invention by an unauthorized person**. Thus, the defectiveness can be characterized as subjective in nature, in contrast to the grounds for invalidation under Art. 89. It should be emphasized that Art. 74 is a special provision in relation to Art. 89 (such a thesis can also be found

in the commentary edited by Prof. Sieńczyło-Chlabicz). **There are differences in the method of determining the circle of persons entitled to request the invalidation of a patent and the claims that these persons may make** (Art. 74 provides for additional claims in addition to the request for invalidation of the patent).

### **Determining the status of the eligible person**

Unlike in the case of the the motion for the invalidation of a patent pursuant to Art. 89, **only a person entitled to obtain a patent can raise the claims under Art. 74 and not just anyone.**

The PPO cannot issue a decision that will meet the right holder's request unless there is a **prior determination that the relevant person is entitled to the patent.** The determination of the right to a patent is a matter resolved before civil courts in separate proceedings in matters of intellectual property.

Art. 283 and 284 of the IPL are going to apply here. According to Art. 283, cases concerning civil law claims in the field of protection of industrial property shall be settled in proceedings in matters of intellectual property, unless the jurisdiction of another authority or other proceedings is provided for. The provision of Art. 284, on the other hand, contains an open catalogue of cases that are resolved in intellectual property proceedings. These include cases for establishing the authorship of an inventive project (point 1), establishing the right to a patent (point 2), or transferring a patent obtained by an unauthorized person (item 11).

**The general basis for actions for a declaration of a right is Art. 189 of the Act of November 17, 1964 - Code of Civil Procedure (CCP).** This provision provides that **the claimant may demand that the court determine the existence or non-existence of a legal relationship or right if they have a legal interest in it.** Legal interest, as indicated in the commentary to the Code of Civil Procedure edited by prof. Marszałkowska-Krześ occurs "when there is uncertainty of a given right or legal relationship, both for factual and legal reasons." It must exist objectively, and the burden of proof lies with the claimants.

An action to declare the status of a co-inventor will qualify as a form of action indicated in point 1. In the commentary edited by prof. Sieńczyło-Chlabicz, it is noted that "determinations in this regard may be significant in disputes between co-inventors in particular as to the scope and size of their contributions to the project." When filing such an action, the claimant must demonstrate that their claim is based on the subjective right to which he or she is entitled, i.e., right to authorship of an inventive project.

Proceedings for the determination of the right to a patent will differ from the former in that they are used to determine the rights affecting property interests (while the determination of the

right to authorship concerns non-property interests). In this case, the co-inventor must also demonstrate their legal interest within the meaning of Art. 189 of the Code of Civil Procedure, while the substantive legal basis for the request may be, for example, Art. 74 of the IPL.

### The claims available on the grounds of Art. 74 of the IPL

The provision of art. 74 lists a number of claims that the right holder may make, depending on whether an application has been made, but the patent has not yet been granted, or the patent has already been granted.

If an application has been made but **a patent has not yet been granted**:

- A) Discontinuance of proceedings
- B) Granting a patent to the right-holder (while reimbursing the costs of filing the patent application to the applicant).

If a **patent has been granted**:

- A) Patent invalidation;
- B) Transfer of the granted patent to the right-holder (while reimbursing the costs of obtaining the patent to the person who was originally granted the patent)

### The relevant procedure relating to claims under Art. 74

Leaving aside the question whether all claims under Art. 74 are available to the omitted co-inventor, it is worth making some general remarks about the procedure in the first place. In fact, the applicable procedure depends on the exact claim made by the right-holder. **In principle, all claims, with the exception of a claim for the transfer of a granted patent to the holder, are resolved in administrative proceedings.** In the case of claims made before the grant of a patent (i.e., the claim for discontinuation of proceedings or for granting a patent to the right-holder), it may happen that the right-holder does not have a judgment confirming their status, and the applicant challenges this status. In such a case, the PPO should suspend the application procedure until it is decided who has the right to obtain a patent — in civil or contentious proceedings (see the commentary edited by Prof. Sieńczyło-Chlabicz).

In general, if the rights-holder demands that the patent be transferred to him, they should pursue their claim in civil proceedings — the aforementioned Art. 284 point 11 concerning the case relating to the transfer of a patent obtained by a non-eligible person will apply. **In the case that we are interested in, however, we are not dealing with a non-eligible person.** Let us now consider to what extent the options proposed by Art. 74 will be available in a situation where, instead of a clear opposition of eligible/non-eligible persons, we will have rights-holders on both sides.

### **The invocation of Art. 74 by the omitted co-inventor**

In the commentary edited by prof. Sieńczyło-Chlabicz, it is pointed out that **Art. 74 may be applied in a situation where the patent application was filed by one of the co-inventors without mentioning the others.** However, bearing in mind the regulation of Art. 72 and the requirement of appropriate application of the provisions of the Civil Code on co-ownership, it should be remembered that the possibility of taking independent actions by the co-inventor is limited to activities not exceeding the ordinary management of the right to obtain a patent.

Such an omitted co-inventor, as indicated in the literature, **may request to grant a joint patent for them and the filing co-inventor, or to transfer to them a share in a patent already granted.** These two cases will be the only not to constitute activities exceeding ordinary management of the right to obtain a patent. **If the omitted co-inventor would like to seek discontinuation of the application procedure or the invalidation of the patent (activities exceeding the ordinary management of the right to obtain a patent), effective pursuit of such claims would require confirmation by other co-inventors.**

### **The preliminary nature of proceedings before a civil court**

The issue of a legally binding determination of the right to the authorship of an inventive project and/or the right to obtain a patent being resolved in civil proceedings may affect other proceedings pending before the PPO. According to Art. 97 § 1 point 4 of the Act of 14 June 1960 - the Code of Administrative Procedure (which applies to proceedings before the PPO pursuant to Art. 252 of the IPL), **the PPO suspends the proceedings when the consideration of the case and the issuance of a decision depends on the prior resolution of the preliminary issue by another authority or court.**

It is worth noting that the jurisprudence treats the application procedure and invalidation proceedings differently in this case.

In the case no. II GSK 904/15, the Supreme Administrative Court was faced with a situation where the co-inventor asserted his rights to the invention in the course of the application procedure initiated by a certain company. His representative argued that he should be recognized as one of persons entitled to obtain a patent for the invention. The PPO issued a decision to suspend the proceedings due to the emergence of a preliminary issue which, in its opinion, fell within the competence of civil courts (pursuant to Art. 284 point 2 of the IPL). The party complaining in the cassation appeal argued that the PPO, by issuing such a decision, violated the provisions of the procedure, because civil proceedings regarding the right to obtain a patent for an invention do not affect the consideration of the case regarding the granting of a patent and issuing a decision in this respect by the PPO. The Supreme Administrative Court did not take this objection into account in the judgment of 18 May 2016. It stated that **the assertion of rights to the invention at the stage of the examination of the patent application gave rise to a preliminary issue, resulting in the need to suspend the proceedings in order to submit the dispute to a civil court.** The Supreme Administrative Court emphasized that "[the PPO] cannot take over the competence of the common court (...) therefore it could not assess the evidence submitted by the parties to the dispute corroborating the right to obtain a patent".

When assessing the relationship between the civil proceedings regarding the determination of the right to the disputed patent and the patent invalidation proceedings before the PPO, **the Provincial Administrative Court in Warsaw in its judgment of January 13, 2020 (no. VI SA/Wa 1730/19) adopted a completely different position.** The Provincial Administrative Court presented the view that the two proceedings were independent, which led to the repeal of the PPO's decision to suspend the proceedings. The company applying for the invalidation of the patent invoked Art. 74 of the PWP - the court stated that this excluded the application of Art. 284 point 2 of the IPL. It emphasized that the motions for patent invalidation are resolved in contentious proceedings and fall within the exclusive jurisdiction of the PPO pursuant to Art. 255, which it characterized as a special rule in relation to Art. 284 point 2. Referring to the difference between the position taken and the view expressed in administrative jurisprudence (case II GSK 904/15 cited above, which was referred to by the PPO), it pointed out that **the important issue was whether the case pending before the PPO was the application procedure (then court proceedings would constitute a preliminary ruling) or the contentious proceedings (autonomy of proceedings).**

## The protection of personal rights

Another path that a co-inventor might want to consider is the use of the protection under the provisions of the Civil Code on personal rights. **Resorting to it does not affect the status of the patent.** The provision of Art. 23 of the Civil Code contains an exemplary catalog of personal rights, among which it includes, e.g. inventiveness, and indicates that these rights remain under the protection of civil law, regardless of the protection provided for in other provisions. The protec-

tion of inventive activity will cover both the freedom of inventive activity and the relationship between the inventor and their work (see commentary to the CC edited by Prof. Gniewek).

The legislator provides in this respect for **the cumulation of protective measures**. Regardless of the IPL regulations, the inventor (co-inventor) of the invention may therefore invoke Art. 24 of the Civil Code, meaning that they can demand the cessation of unlawful actions infringing their personal interests; in the event of a breach, they may demand that the person who committed it take actions necessary to remove its effects; demand monetary compensation or payment of an appropriate sum of money for the indicated social purpose (paragraph 1). Moreover, if material damage was caused as a result of the violation of personal rights, the aggrieved party may demand that it be remedied on general terms (paragraph 2).

It is worth noting that the commentary edited by Prof. Sięczyło-Chlabicz suggested that the plaintiff may cumulatively seek protection of their personal rights under Art. 23 and 24 of the Civil Code in the case of bringing an action to establish the authorship of an inventive project (Article 284 point 1 of the IPL).

## Summary

In sum, the omitted co-inventor has access to certain tools to protect their rights, **however, the repertoire of those means is quite modest due to the limitations resulting from the appropriate application of the provisions of the Civil Code on co-ownership**. In the event of a dispute as to their status as a co-inventor, there seems to be no escaping an action for declaratory judgment under Art. 189 of the CCP. While Art. 74 of the IPL appears to remain the most reasonable grounds for the claims, **it must be remembered that the co-inventor is limited in undertaking activities exceeding the scope of ordinary management**: they may request that the patent be granted jointly to them and the co-inventor who originally filed the application (in proceedings before the PPO) or that the share in a patent already granted be transferred to them (in proceedings before a court). An additional option, which does not affect their share in the patent, may be to take advantage of the protection of personal rights provided for in the Civil Code.