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Transforming Ideas into Opportunities

*To whom belong the inventions? Italian perspective*

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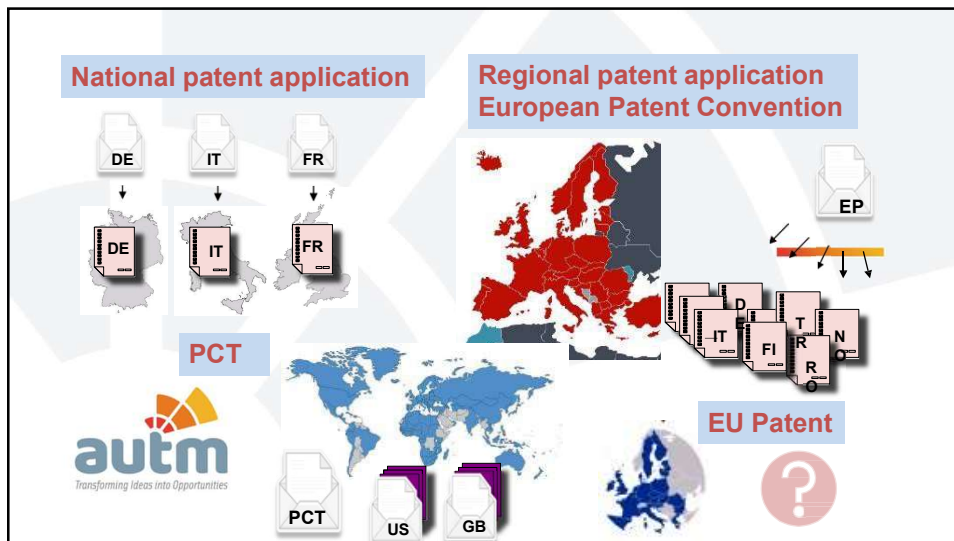
WHY!

HOW?

WHAT?

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### Inventorship vs. Ownership

«The European Patent Application shall designate the inventor»

«The right to a European Patent shall belong to the inventor or his successor in title»

**Yes, BUT...**



The slide features a title 'Inventorship vs. Ownership' in a blue header. Below the title, two quotes are presented: '«The European Patent Application shall designate the inventor»' on the left and '«The right to a European Patent shall belong to the inventor or his successor in title»' on the right. A large white speech bubble with a black border and tail contains the text 'Yes, BUT...' in bold black and red font. Above the speech bubble are a yellow lightbulb icon and a green envelope icon. The autm logo is located in the bottom right corner.

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## Inventorship - Ownership – patent as an object of property

 **The relation between the applicant and the person having the substantive right is governed by *national law***



**The EP application as an *object of property* is subject to the law applicable in each designated Contracting State** 


**SUCH RULES DIFFER ACROSS EU COUNTRIES.**



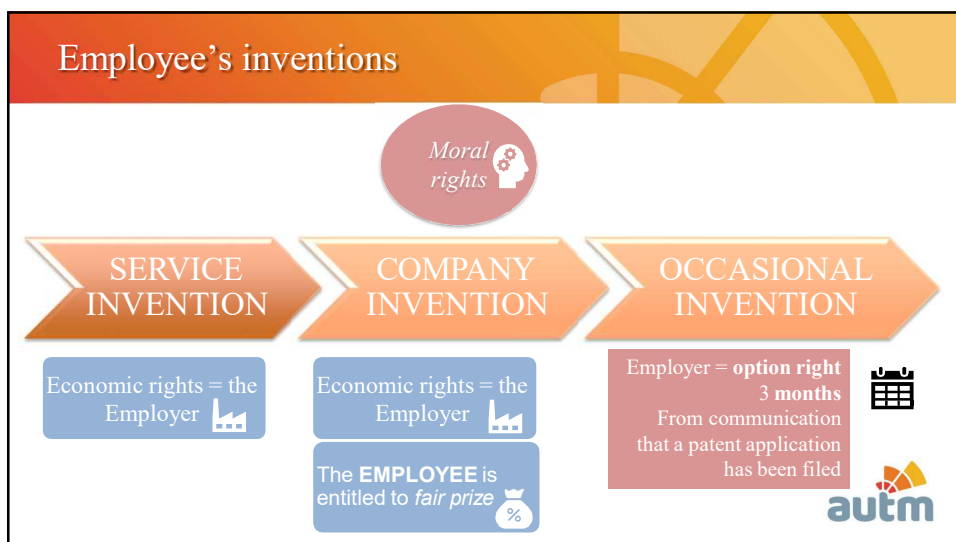
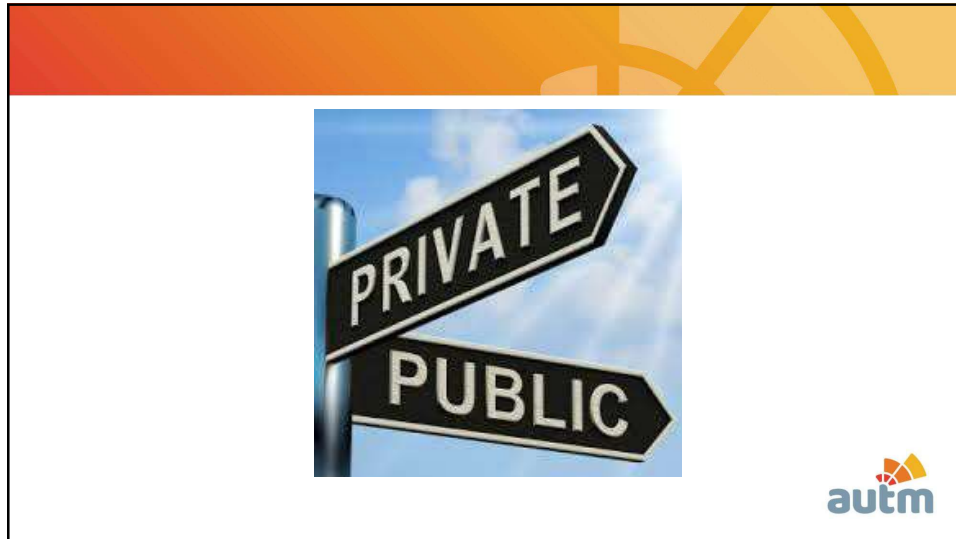
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## Moral vs. economic rights – Italian IP Code





MORAL RIGHTS	ECONOMIC RIGHTS
<p>Right to be mentioned/ recognised as <b>'inventor'</b> = <b>personal right</b> = <b>cannot be assigned</b></p>	<p>Right to economically exploit the invention = <b>right to the patent</b> = <b>can be assigned</b></p>
<p>Inventor (art. 62 IPC)</p>	<p>«owner» (art. 63.2 IPC) Rule = inventor</p>
<p><b>There are no exceptions</b></p>	<p><b>There are exceptions</b></p>




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## Fair prize consideration

- ✓ Extraordinary economic 'one-off' payment
- ✓ Of a *non-salary* nature ("indemnity")
- ✓ Determined on the basis of:
  - the importance of the invention 
  - the tasks performed by the employee 
  - remuneration received by the inventor 
  - contribution received the employer's organisation 

«GERMAN FORMULA»



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## Fair prize: Case law overview

**“** The right to fair prize arises whenever the contract governing the employment relationship does not expressly provide for special remuneration or consideration for the inventive activity.

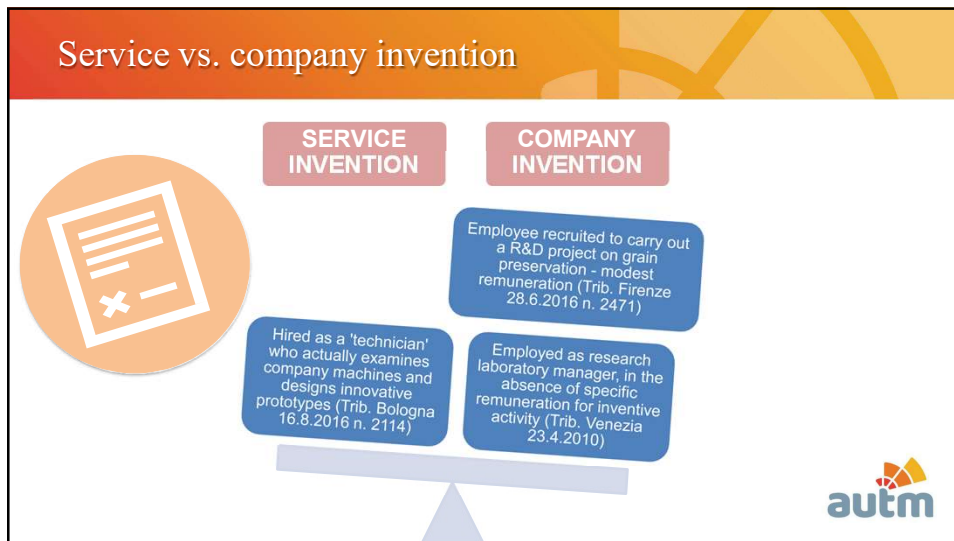
The employer is precluded from challenging, either by way of defence or by way of a claim, the validity of the patent.

In the case of several patents covering the same invention (e.g. patents filed in different countries, claiming the same priority date), it is excluded that each patent should be awarded a prize. The prize rewards the "invention", not each patent.

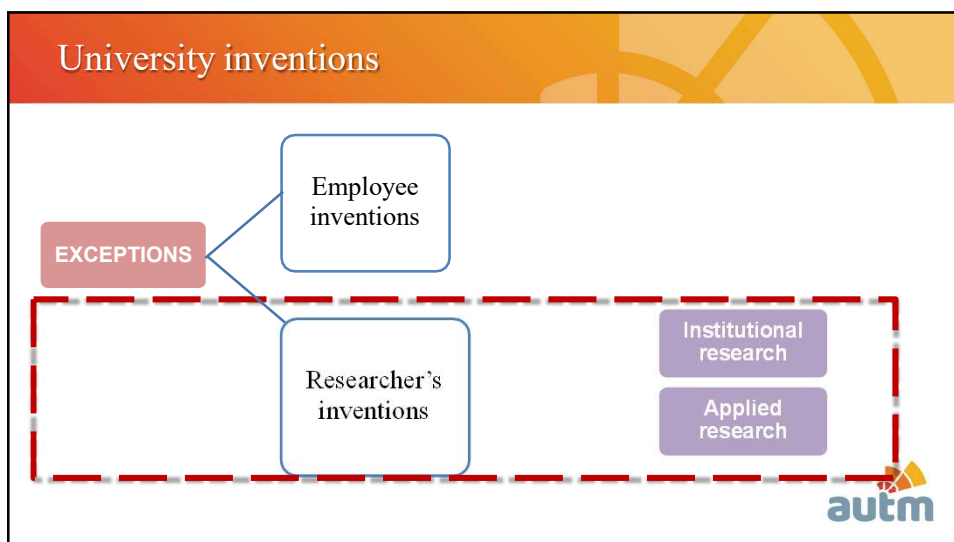
When calculating the fair prize, it must be taken into account the potential for economic exploitation of the invention, not its price.



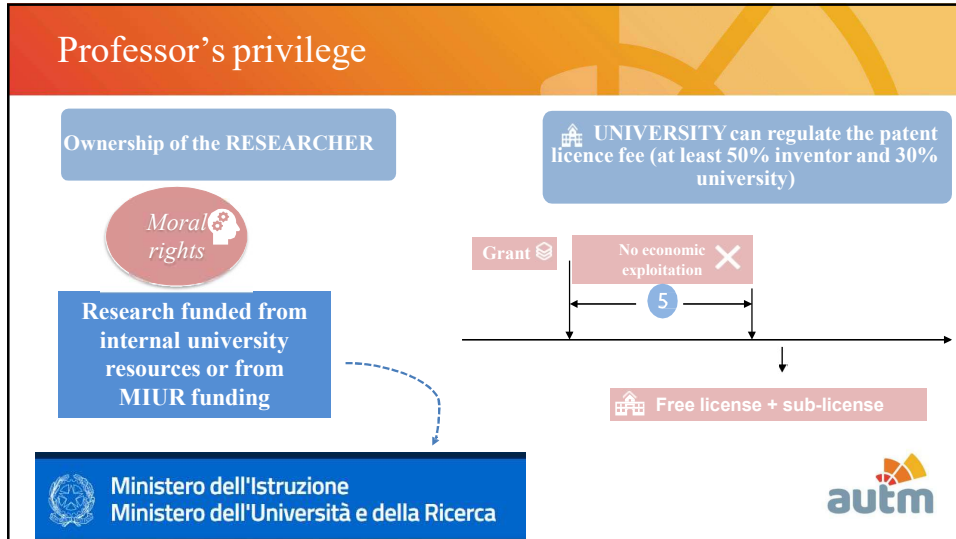
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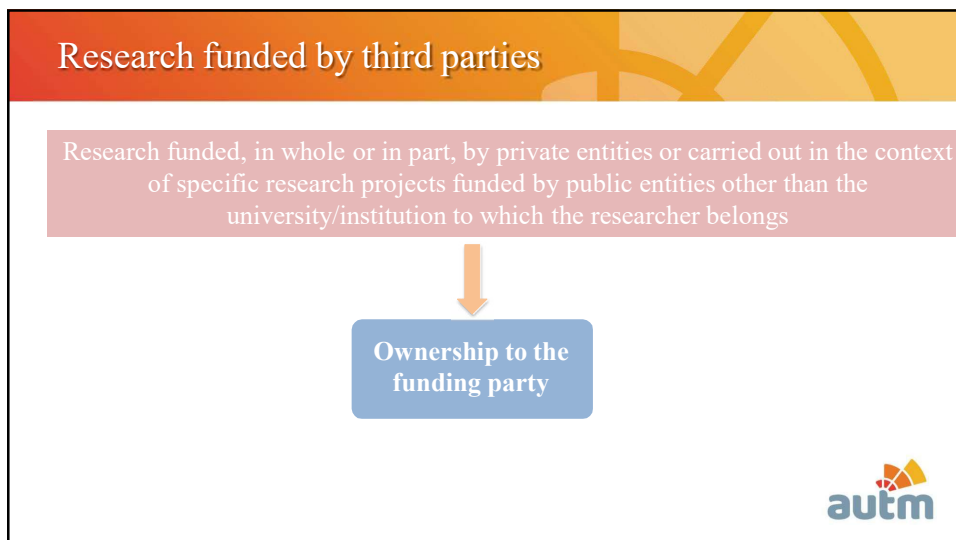
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## IP regimes for university patenting in Europe


Policy and legal changes	Country	Change	Trend
Abolishment of the professor's privilege, to increase scientists' incentives to disclose inventions to university managers	Denmark	2000	Universities assign a share of the patent licensing revenue to the inventor and pay all the costs associated with the patent application
	Germany	2002	
	Austria	2002	
	Norway	2003	
	Finland	2007	
Stronger enforcement of institutional ownership system already in place	United Kingdom	1977	Harmonisation, measures to encourage intellectual property awareness, commercialisation and creation of technology transfer offices
	Spain	1986	
	France	1999	
	Switzerland	1991	
	Belgium	1997	
Mixed changes: Introduction of professor's privilege (from institutional ownership to inventor ownership) + Introduction of managerial and financial autonomy for universities	Italy	2001	Only applies to inventions fully funded by the university employing the inventor since 2005
	Sweden	1949	Recurrent national debate about IP regimes. The conclusion is always that there is no need for legislative change

**Source:** Martinez, Catalina, and Valerio Sterzi. "The impact of the abolishment of the professor's privilege on European university-owned patents." *Industry and Innovation* 28.3 (2021): 247-282.



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## Interpretative issues





Which professional figures are included in the term 'researcher'?

What happens if the researcher decides not to proceed with the patenting of the invention, for example, preferring to publish the scientific results achieved?

To whom belong the results of third parties funded research where the private body in question does not directly fund the research?

Is there any fair prize in case of third parties research?






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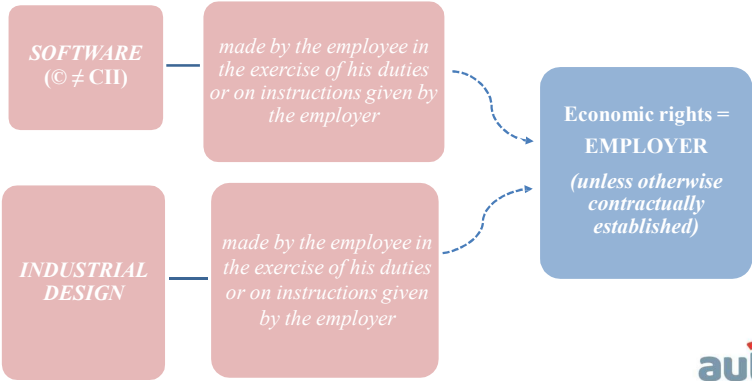
Interpretative issues (con'd): "Pandora" Box

What about other IPR that might emerge?


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Interpretative issues (con'd): "Pandora" Box



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graph LR
    A["SOFTWARE  
(© ≠ CII)"] --- B["made by the employee in  
the exercise of his duties  
or on instructions given by  
the employer"]
    C["INDUSTRIAL  
DESIGN"] --- D["made by the employee in  
the exercise of his duties  
or on instructions given  
by the employer"]
    B -.-> E["Economic rights =  
EMPLOYER  
(unless otherwise  
contractually  
established)"]
    D -.-> E
  
```



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## Commission Recommendation on the Management of Intellectual Property in knowledge transfer activities – Code of Practice

The diagram illustrates the process of intellectual property management. It starts with 'IP Management' in a yellow box. An arrow points from this box to two blue boxes: 'Exploitation' and 'Dissemination'. A second arrow points from 'IP Management' down to a box representing the 'H2020 Programme', which includes the 'Commission Recommendation on the management of intellectual property in knowledge transfer activities and Code of Practice for universities and other public research organisations'. To the left of the diagram is a cover image of the Commission Recommendation document. Below the diagram, the source is cited as 'Source: IPR Helpdesk' and the 'autm' logo is present in the bottom right corner.

COMMISSION RECOMMENDATION, 10 April 2008 on the management of intellectual property in knowledge transfer activities and Code of Practice for universities and other public research organisations

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## Joint ownership

In what measure is ownership divided between the Parties ?	Filing costs – where? How? Filing in single ownership regime is possible? Under which conditions?  Right to use? sub-license? Assignment? =Prior authorisation?
Co-operation obligation	
Defence costs	
Ownership of improvements	
Agreement that regulates the management methods, the use and the economic exploitation of the Invention	

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## Unitary Patent

Article 7

**Treating a European patent with unitary effect as a national patent**

1. A European patent with unitary effect as an object of property shall be treated in its entirety and in all the participating Member States as a national patent of the participating Member State in which that patent has unitary effect and in which, according to the European Patent Register:

- (a) the applicant had his residence or principal place of business on the date of filing of the application for the European patent; or
- (b) where point (a) does not apply, the applicant had a place of business on the date of filing of the application for the European patent.

2. Where two or more persons are entered in the European Patent Register as joint applicants, point (a) of paragraph 1 shall apply to the joint applicant indicated first. Where this is not possible, point (a) of paragraph 1 shall apply to the next joint applicant indicated in the order of entry. Where point (a) of paragraph 1 does not apply to any of the joint applicants, point (b) of paragraph 1 shall apply accordingly.

3. Where no applicant had his residence, principal place of business or place of business in a participating Member State in which that patent has unitary effect for the purposes of paragraphs 1 or 2, the European patent with unitary effect as an object of property shall be treated in its entirety and in all the participating Member States as a national patent of the State where the European Patent Organisation has its headquarters in accordance with Article 6(1) of the EPC.


Will the Unitary Patent solve these issues?

Entitlement


Transfer of rights

Disputes


National law



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*Thank you for your attention*




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