

Intellectual Property advocacy in the fields of:

- IP Infrastructure
- IP Valuation
- M & A
- IP Policy
- Technology Transfer
- Innovation Research
- Patent Law
- Licensing
- Data Management
- Copyright
- Collaborations
- Balance for Rights & Obligations



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EDITORIAL

Who is or can be an Inventor

Traditionally, a person or all those who contribute to the conception of the invention, is considered to be the rightful inventor. When the inventor is called “the one who invents”, his contribution in conceptualizing is acknowledged. In addition to conceptualising, if any other person/persons contributes to putting the concept to work in a novel and inventive way, independent of the conceptualiser or jointly with him, such persons can also be entitled to be designated as inventor. However, all those who contributes mechanically without inventive merit, cannot claim “inventorship”. For example, those involved in product, testing, finishing the process routinely or mechanically cannot claim to be inventors.

A recent example will illustrate the concept of inventorship. Bharat Biotech claimed rights over India’s first indigenously developed Corona Vaccine, Covaxin in its patent application, where the scientists of Bharat Biotech were only declared as inventors. After discussions in Parliament and subsequent reports in dailies and SpicyIP, the matter became public, ICMR (Indian Council of Medical Research) whose ICMR-National Institute of Virology (NIV), Pune had actively participated, including their own investments in developing, clinical evaluations and documentations, came forward to register their claim over co-inventorship. Consequently, Bharat Biotech admitted that the “Covaxin” was jointly developed and as such the claim of ICMR for co-inventorship was recognised by Bharat Biotech. Needful amendments have reportedly been made in the patent application declaring “joint inventorship” and “co-inventorship”.

However, the following developments are disclosed by “SpicyIP” in this case, thereafter.

While Bharat Biotech has claimed sole ownership of the Patent application originally filed in February 2020, the inventors were Deepak Kumar and Krishna Murthy Ella only from Bharat Biotech.



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However, later when the matter came up in the Parliament, the S & T Minister stated that the Patent is co-owned by ICMR and Bharat Biotech. Thereafter, Bharat Biotech admitted the lapse and stated that the Patent Application No.202041007559 was filed in a hurry and that they will add the name of scientists of ICMR as co-inventors and the name of ICMR as co-applicant. The original date of provisional patent application was 21/02/2020 which was later post-dated to 21/08/2020. It is interesting to note that no request for examination is filed even as on date, even though the current permitted period of 31 months is over. Even if one considers the earlier 48 months as applicable, it will be worth waiting and watching for if Bharat Biotech applies to the CGPDTM to add co-inventors and co-applicants before requesting for examination or allow the patent application to be abandoned. The latter looks more likely, because in the PCT Application and overseas applications, the examiners have cited prior art invalidating the patentability criteria.

In the latest amendments to Patent Rules, India has introduced provision for granting “Certificate of Inventorship”. By making a request in Form-8A and paying a fee of INR 900, an inventor can obtain a “certificate of inventorship”.

Application Details	
APPLICATION NUMBER	202041007559
APPLICATION TYPE	ORDINARY APPLICATION
DATE OF FILING	21/08/2020
APPLICANT NAME	BHARAT BIOTECH INTERNATIONAL LIMITED
TITLE OF INVENTION	CORONAVIRUS VACCINE AND METHOD FOR PREPARATION THEREOF
FIELD OF INVENTION	BIOTECHNOLOGY
E-MAIL (As Per Record)	afzal@hasanandsingh.com
ADDITIONAL-EMAIL (As Per Record)	hasan@hasanandsingh.com
E-MAIL (UPDATED Online)	
PRIORITY DATE	
REQUEST FOR EXAMINATION DATE	--
PUBLICATION DATE (IJS 11A)	25/02/2022

Application Status	
APPLICATION STATUS	Awaiting Request for Examination

Further, there are inventorship disputes in AI related patent application globally as well as in India. In Thaler vs. Vidal, where USPTO decreed that Patent Application is invalid if AI is listed as inventor.

This decision was upheld by Federal Circuit. The UK Supreme Court's decision on December 20, 2023, denied patent protection for two inventions attributed to DABUS (Device for the Autonomous Bootstrapping of Unified Sentience). Stephen Thaler, a computer scientist from the US, had sought patent protection for these AI-generated inventions in various countries, such as India, back in 2019. There are numerous cases, orders and judgements in various jurisdictions with regard to AI based inventions. In all these cases, it has been decided that AI is not entitled to claim inventorship.



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Application Details	
APPLICATION NUMBER	202017019068
APPLICATION TYPE	PCT NATIONAL PHASE APPLICATION
DATE OF FILING	05/05/2020
APPLICANT NAME	THALER, Stephen L.
TITLE OF INVENTION	FOOD CONTAINER AND DEVICES AND METHODS FOR ATTRACTING ENHANCED ATTENTION
FIELD OF INVENTION	MECHANICAL ENGINEERING
E-MAIL (As Per Record)	filing@prismipr.com
ADDITIONAL-EMAIL (As Per Record)	
E-MAIL (UPDATED Online)	
PCT INTERNATIONAL APPLICATION NUMBER	PCT/IB2019/057809
PCT INTERNATIONAL FILING DATE	17/09/2019
PRIORITY DATE	17/10/2018
REQUEST FOR EXAMINATION DATE	21/07/2021
PUBLICATION DATE (U/S 11A)	19/03/2021
REPLY TO FER DATE	25/07/2022

Application Status	
APPLICATION STATUS	Application in Hearing

A PPT presentation by Dr. Srividya Ravi, Senior Patent Associate and Managing Director, Gnanlex Hermeneutics Pvt Ltd., is reproduced below herein.

Only One Theme **Deciding** Inventorship for Patents

Srividya Ravi
Venture Center
12/03/2024

Meaning of Inventor

- ☑ Someone who has **invented** something
- ☑ To **invent** is the act of bringing ideas and objects together in a new way to **create something that did not exist**
- ☑ **someone who creates** or designs something that did not exist
- ☑ to produce (something, such as a useful device or process) for the first time through the use of the **imagination or of ingenious thinking** and experiment
- ☑ Note: To conceive a problem and a solution (concept of invention)

Laws and Inventor

INDIA

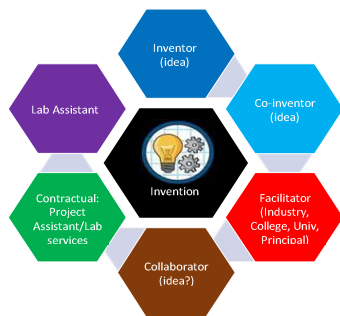
Definition: true and first inventor" does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India

Sec 6: Persons entitled to apply for patents

True or first inventor; Assignee or true or first inventor, by the legal representative of any deceased person who immediately before his death was entitled to make such an application

Each application shall include a declaration of inventorship-Form 1 (and 5)

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Rights of Patentee-India

- (a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;
- (b) where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India

Laws and Inventor

US

- > One who conceived the invention*, not the one who reduced it to practice (*may also have reduced to practice);
- > There is no requirement that the inventor be the one to reduce the invention to practice so long as the reduction to practice was done on his behalf;
- > Inventors need not "personally" construct and test their invention;
- > Non inventor's work was merely that of a skilled mechanic carrying out the details of a plan devised by another



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Joint inventorship-US

- When an invention is made by two or more persons jointly, they shall apply for patent jointly
- Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent
- The inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named joint inventors
- **Inventor and co or joint inventor are natural person**

Laws and Inventor-EPC

- ☑ The inventor is the person who created the invention by their own creative activity
- ☑ The inventor must be a human being, a legal person
- ☑ Inventor has moral right to be mentioned and property rights and rights can be transferred
- ☑ emphasizes the importance of correctly identifying the inventor of an invention.
- ☑ The right to a European patent belongs to the inventor or their successor in title.
- ☑ If multiple inventors contribute to an invention, they are joint inventors, and their rights are shared.
- ☑ Accurate inventorship ensures that the rightful inventors receive credit and benefits from the patent

Test of Inventorship

- India-not defined
- US-Conception of invention (at least one claim)
- EP-National laws and granted claims
- **Co-inventorship-Recognized in most domains**

Rights of co or joint inventors

US

- Equal and undivided rights; - can be assigned;
- No need to obtain each inventor's consent for licensing agreements or practicing the invention (35 U.S.C. 262).

EPC

- Most European countries require permission of other inventors before licensing agreements can be entered into.

India:

- Equal undivided share in the patent.
- No license under the patent can be granted and no share in the patent

Penalty for incorrectly naming inventors

India

- Opposition and/or Revocation Ground: Wrongful obtainment
- patent may stand amended in the name of the opponent alone or added to existing inventors. If some portion of the specification has been contributed by the inventor but not named; the specification may be edited to remove those portions

US and EP: Patent may be declared invalid

OR in US: Court will order a change in inventorship

Determining inventorship

Entity name

PI name and contact details

Title of invention

Ref Number

Claim number	Claim	People involved	Date	
			Role of people involved	Inventor/s
Ind claim 1	A composition comprising	X, Y, Z, A, C, G	X: PI, Y, Z: students, G: Lab assistant, A, C: student) contributed to adesp claim	A, X, C
Ind claim 2	A process of preparing the composition	X, Z, B, E	Z: Lab assistant B: Testing laboratory analyst	X, E
Ind claim 3	A device comprising the composition	J, K, L, X	L, X: Students; J, K: provided inputs to make the device, post-doc scholars	J, K

Certain Considerations

O Anticipation

o Claim amendments/Divisional

o Licensing, Assigning....

O Applicant

o Share in rewards

o Inventorship and loss of rights (Opposition, Revocation)

Inventorship and AI

- Case law: Dr. Thaler and DABUS (Device and Method for the Autonomous Bootstrapping of Unified Sentience) with AI as inventor
- Rejected in most domains though patentable
- Queries raised
 - ❖ Non-person is inventor? IS determination-Who is person skilled in the art?
 - ❖ Can a machine be recognized as the skilled person
 - ❖ If AI is the inventor, then someone owns the inventor here, and the question is who is the creator
 - ❖ Is AI the sole inventor or a co-inventor is involved?
 - ❖ Inventor is deviser of the invention, applicant should recognize them
 - ❖ Who defines the problem, it's not merely about ownership, but about creativity