WIPO Circular C.9141

Contribution of Germany to a compilation on how jurisdictions around the world address the issue of AI inventorship through jurisprudence, legislation and practice

A. General Concept of Inventorship

I. Inventor

Although the German Patent Act[1] refers to the term "inventor" on numerous occasions (e.g. Sections 6, 7 and 37), it does not provide a definition. Rather, the definition and principles of how to determine the inventor have been developed by courts and jurisprudence. German case law has in essence conceptualized the inventor as the one who first "recognized" the knowledge of how to resolve a specific technical problem by using certain technical means.[2]

II. Joint Inventors

Section 6 sentence 2 German Patent Act refers to the constellation that two or more persons have jointly made an invention. It does, however, not give more concrete guidance on under which conditions to assume the status of joint inventorship. According to the relevant case law, a joint inventor is generally anyone who has made a sufficiently significant contribution to the invention. This has to be assessed with a view to the circumstances of the concrete case at hand. The joint inventor's contribution need not itself be inventive in the sense that it does not have to satisfy all the preconditions for a patentable invention out of itself.[3] However, contributions that have not influenced the overall achievement, i.e. are unsubstantial with respect to the solution, and contributions that have been created based on the instructions of the inventor or a third party, do not establish status as a joint inventor.[4]

III. Employee Inventors

The law on employee inventions is governed by the **German Employee Inventions Act**,[5] which differentiates between **tied inventions (service inventions)** and **free inventions**. According to

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[1] The following explanations referring to the German Patent Act are based on the translation available at https://www.gesetze-im-internet.de/englisch_patg/englisch_patg.html#p0092, an online service by the German Federal Ministry of Justice. Please note that translations of German statutes into languages other than German available there are intended solely as a convenience to the non-German-reading public and that any discrepancies or differences that may arise in translations of the official German versions of these materials are not binding and have no legal effect for compliance or enforcement purposes (https://www.gesetze-im-internet.de/Teilliste_translations.html).

[2] Cf. *Bundesgerichtshof* [Federal Court of Justice] BGH, judgement of 18 May 2010, ref: X ZR 79/07, GRUR 2010, 817 – *Steuervorrichtung*; Melullis in: Benkard, Patentgesetz, 11th edition 2015, Section 6 para 30.

[3] BGH, judgement of 16 September 2003, ref: X ZR 142/01, GRUR 2004, 50, 51 – *Verkranzungsverfahren*.

[4] Cf. BGH, judgement of 16 September 2003, ref: X ZR 142/01, GRUR 2004, 50 – *Verkranzungsverfahren*; BGH, judgement of 18. June 2013, ref: X ZR 103/11, BeckRS 2013, 13904.

[5] An **unofficia**l translation of the Employee Inventions Act into English is available at https://www.dpma.de/docs/dpma/schiedsstelle/employee_inventions_act.pdf. Please note that the following descriptions are for explanatory purposes only. Any discrepancies or differences that may arise vis-à-vis the official German text are not legally binding and have no legal effect.

Section 4 para 2, service inventions are inventions made during the term of employment, which either resulted from the employee's task in the enterprise or public authority, or which are essentially based upon the experience or activities of the enterprise or public authority. Other inventions are considered "free inventions" according to Section 4 para 3, which are however also subject to certain legal restraints imposed upon the employee according to Sections 18 and 19.

An employee having made a service invention has the **duty to report** this invention to the employer immediately (Section 5 para 1). The **employer may "claim" a service invention** by making a respective statement to the employee (Section 6 para 1). Such claim is deemed declared unless the employer expressly "releases" the service invention by making a statement in text form addressed to the employee, within four months after receipt of the employee's report (Section 6 para 2). Upon claiming the invention, **all property rights in the service invention pass to the employer** (Section 7). The employer is solely entitled and – as a rule – under the duty to apply for a domestic industrial property right for a service invention reported to him (Section 13). The employer is also entitled to apply for industrial property protection abroad (Section 14).

The **employee has a right to reasonable compensation** vis-à-vis the employer, which arises as soon as the employer has made the claim to a service invention (Section 9 para 1). In assessing the amount of compensation, due consideration shall in particular be given to the commercial applicability of the service invention, the duties and position of the employee in the enterprise, and the contribution of the enterprise to the invention (Section 9 para 2).

IV. Rights attributed to the Inventor

The German Patent Act attributes to the inventor various rights, both economic rights and rights of personality. This is generally referred to as the "inventor's principle".[6] The purpose behind the inventor's principle is to pay tribute to the inventive personality and to provide an incentive to inventive activity.[7]

As regards **economic rights**, Section 6 sentence 1 of the German Patent Act attributes the **right to a patent** to the inventor or his successor in title. Sentence 2 establishes that if two or more persons have jointly made an invention (joint inventors), the right to the patent shall belong to them jointly. Sentence 3 governs the case that several inventors have developed the same invention **independently of each other**: In this case, the right to the patent shall belong to the person who is the first to file the application in respect of the invention with the German Patent and Trade Mark Office. The entitled person in respect of whose invention an application has been filed by a non-entitled person or a party aggrieved by usurpation can require the patent applicant to assign to him the right to the grant of the patent (Section 8

[6] Cf. Ann, Patentrecht, 8th edition 2022, § 19. Erfinderprinzip und Erfinderrecht, para 1.
[7] See Explanatory Memorandum to the German Patent Act 1936, BlPMZ 1936, 104.

sentence 1). Where the application has already resulted in a patent, he can require the proprietor of the patent to transfer the patent (Section 8 sentence 2).

As regards **personality rights**, the inventor is in particular granted the **right to be mentioned** in the first publication of the invention, the patent specification and the publication of the grant of the patent, provided that the inventor has already been designated (Section 63 para 1 sentence 1). This mention shall be noted in the Register (Section 63 para 1 sentence 2), unless the inventor requests not to be mentioned (Section 63 para 1 sentence 3). This request may be withdrawn at any time, in which event the inventor shall be subsequently mentioned (Section 63 para 1 sentence 4). An inventor's **waiver of being mentioned shall be without legal effect** (Section 63 para 1 sentence 5). If the inventor has been designated wrongfully or not at all, the patent applicant or patent proprietor as well as the person wrongfully designated are obliged vis-à-vis the inventor to declare to the German Patent and Trade Mark Office that they consent to the mention being corrected or subsequently made (cf. Section 63 para 2 sentence 1). This consent cannot be withdrawn (Section 63 para 2 sentence 2). The proceedings for the grant of a patent shall not be delayed on account of the filing of an action for declaration of consent (Section 63 para 2 sentence 3).

V. The role of the Inventor in Proceedings before the German Patent and Trade Mark Office

In the proceedings before the German Patent and Trade Mark Office, the inventor has to be **designated** by the applicant. According to Section 37 para 1 sentence 1 German Patent Act, the applicant shall designate within fifteen months of the filing or priority date the inventor or inventors and shall affirm that, to his knowledge, no other persons participated in the invention. Where the applicant is not the inventor or not the sole inventor, he shall also indicate how he acquired the right to the patent (Section 37 para 1 sentence 2). Further details of the designation of inventor are governed by **Section 7 of the German Patent Ordinance**.

The **accuracy of these statements shall not be verified** by the German Patent and Trade Mark Office (Section 37 para 1 sentence 3). In order to avoid the substantive examination of the patent application being delayed due to the need to establish the identity of the inventor, the applicant shall be deemed, in the proceedings before the German Patent and Trade Mark Office, to be entitled to request the grant of the patent (Section 7 para 1).

B. Application of the Concept of Inventorship to Inventions generated by or with the help of AI

The application of the concept of inventorship in German patent law to inventions generated by or with the help of AI is currently being assessed in several court cases concerning applications where an AI called "DABUS" has been designated as inventor. At the German Patent and Trade Mark Office, **two applications naming the AI "DABUS"** as inventor have been filed. Both have been rejected in March 2020, as the declarations of inventorship submitted by the applicant were considered not meeting the requirements set out in the German Patent Act and the German Patent Ordinance. The German Patent and Trade Mark Office pointed out in its decisions that according to the relevant provisions, only a natural person, i.e. a human, can be designated as inventor. A **third, international PCT application naming the AI "DABUS" as inventor has entered the national phase** before the German Patent and Trade Mark Office. It has been rejected in January 2023 for the same reasons.

The applicant has appealed the two decisions from March 2020 before the German Federal Patent Court ("Bundespatentgericht"), which is the court of first instance in these cases. One of those appeals is still pending there. The other one has been decided in November 2021.[8] The Court confirmed that designating an AI as inventor does not meet the legal requirements. The Court also rejected an auxiliary request by the applicant to decide that in this particular case an inventor did not have to be designated as no human fulfilled the requirements to be qualified as inventor. According to the Court's reasoning, German law clearly requests a natural person to be designated as inventor. The Court did, however, grant another auxiliary request by the applicant and allowed a declaration of inventorship that designated the applicant, i.e. a human, as inventor but with an additional statement that this person has "caused" the AI "DABUS" to generate the invention.

Both the German Patent and Trade Mark Office and the applicant have appealed this decision to the Federal Court of Justice, which is going to give its final ruling on the matter. Currently, the case is still pending at the Federal Court of Justice.

[8] Federal Patent Court (Bundespatentgericht), decision of 11 November 2021 – 11 W (pat) 5/21. An unofficial translation into English language can be found in GRUR International 2022, 1185.