

**CA/78/20**

Orig.: en

Munich, 27.11.2020

**SUBJECT:** Amendment to the Implementing Regulations to the EPC regarding the designation of the inventor – Rules 19 and 143 EPC

**SUBMITTED BY:** President of the European Patent Office

**ADDRESSEES:** 1. Administrative Council (for decision)  
2. Committee on Patent Law (for information)

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#### SUMMARY

Having regard to the recommendation of a common practice as regards the designation of the inventor (CA/PL 6/20), the EPO proposes to adapt its legal framework accordingly, by amending Rules 19 and 143 EPC.

In its 52nd meeting on 10 and 11 November 2020 the Committee on Patent Law gave a favourable opinion on the proposed Rule changes (CA/PL 8/20).

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## PART I

### I. **STRATEGIC/OPERATIONAL**

1. Operational

### II. **RECOMMENDATION**

2. The Administrative Council is requested to decide on the draft decision in part II of this document.

### III. **MAJORITY NEEDED**

3. Three quarters.

### IV. **CONTEXT**

4. In the framework of the Strategic Plan 2023, as part of the convergence of practice programme, a working group was established to consider options for a common practice concerning the designation of the inventor (CA/PL 14/19). Following a call for interest in December 2019, the working group composed of 17 EPC contracting states and 1 extension state (Bosnia & Herzegovina (BA), Bulgaria (BG), Denmark (DK), Estonia (EE), Finland (FI), France (FR), Germany (DE), Greece (GR), Hungary (HU), Iceland (IS), Italy (IT), Latvia (LV), Monaco (MC), Poland (PL), San Marino (SM), Serbia (RS), Spain (ES) and the United Kingdom (GB)) met four times in 2020 in a virtual setting via Skype (on 18 March 2020, 23 April 2020, 9 June 2020 and 8 October 2020) to discuss options for a common practice.
5. Users were regularly consulted and updated on the progress of the work via the SACEPO and SACEPO Working Party on Rules on 31 March 2020, 18 June 2020, 23 July 2020 and 8 October 2020. On 21 September 2020, the EPO organised a virtual discussion platform, informing users about the results achieved within the working group until then. In the SACEPO Working Party on Rules on 8 October the proposed Rule changes were presented to the user representatives who gave full support to the proposed amendments.

6. In its last meeting of 8 October 2020 the working group agreed to recommend a common practice as regards the designation of the inventor to the Administrative Council for adoption (CA/PL 6/20). This common practice provides that:
  - inventors are not formally notified by patent offices about their designation in a patent application; inventors can instead obtain information about their designation from the applicant, through inspection of the patent register or via file inspection;
  - family name, given name(s), country and place of residence, or, if allowed, of employment of the designated inventors are entered in the patent register. Additional information about the inventors' full addresses is not published in the patent register. This is without prejudice to the right of inventors to waive their right to be mentioned, if available.
7. In its 52nd meeting on 10 and 11 November 2020 the Committee on Patent Law gave a unanimously favourable opinion on the recommended common practice as regards the designation of the inventor (CA/PL 6/20). It is submitted to the Administrative Council for approval as CA/77/20.
8. The EPO's current legal framework differs from the recommended common practice in certain respects. Firstly, Rules 19(3) and (4) EPC provide that if the applicant is not the inventor or the sole inventor, the EPO shall notify the inventor about his designation. Secondly, Rule 143(1)(g) EPC establishes that the European Patent Register shall contain the family name, given names and (full) address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20(1) EPC.
9. In its 52nd meeting on 10 and 11 November 2020 the Committee on Patent Law gave a favourable opinion on the proposed changes to the Implementing Regulations.
10. When considering the expected positive impact of the implementation of the recommended common practice on the EPO's overall strategic objective for a simplification of procedures, the positive effect on the EPO's finances and the clear wish from users for a better alignment with data protection requirements, the EPO has a strong incentive to implement the common practice. From an operational perspective, the EPO is already in a position to do so. It is therefore proposed to adapt the EPO's legal framework by amending Rules 19 and 143 EPC. The considerations of the working group for recommending the common practice apply equally to an adjustment of the EPO's legal framework.

## **V. ARGUMENTS**

### **A. NOTIFICATION OF THE INVENTOR**

11. Under Article 62 EPC (which implements Article 4ter of the Paris Convention), the inventor has a right *vis-à-vis* the applicant or proprietor of a European patent to be mentioned in the application. This is an expression of the inventor's moral right. It is safeguarded by the applicant's obligation under Article 81 EPC to designate the inventor and, if the applicant is not the sole inventor, to indicate the origin of the right to the European patent. If this obligation is not met the application is refused under Article 90(5) EPC.
12. Pursuant to Rule 19(3) and (4) EPC, the EPO shall communicate to the designated inventor the information contained in the inventor designation together with some additional information such as the applicant's name and the designated contracting states. In order to satisfy this requirement, the EPO must be provided with all the relevant data to allow successful notification, including the inventor's full address (Rule 19(1) EPC). Under Rule 20(1) EPC, the inventor may waive the right to be mentioned as inventor, in which case the designation of the inventor is excluded from file inspection. In accordance with Rule 19(2) EPC the EPO does not verify the accuracy of the designation of inventor; this means that the Office does not verify whether it is complete in the sense that all inventors have been named or the correct inventors have been named. Neither applicants nor inventors may invoke the omission of the notification or any errors contained therein (Rule 19(4) EPC).
13. A formal notification to the inventor informing them that they have been designated in a patent application is an exception in the patent grant procedures of the EPC contracting states. In most countries, the obligation to inform the inventor about their designation is with the applicant. Likewise, several national laws offer mechanisms, such as the provisions on employee inventions, to ensure that employed inventors are not only informed about the filing of a patent application by their employer naming them as inventors, but are also given information about the progress of the grant procedure.

14. Furthermore, the EPO has considerably improved the possibilities for inventors to acquire information about patent applications. While in the past information could only be obtained by way of inspection of the public file on the premises of the EPO, the application data available in the European Patent Register and related tools such as Espacenet allow acquiring information about inventor designations. Thus, inventors can extract information about published European patent applications online via the European Patent Register.
15. It is also noted that the notification of inventors imposes a considerable administrative burden on the EPO. Each year the EPO manually sends an increasing amount of letters (530 194 letters in 2019) to inform inventors of their designation. A significant number of these letters is returned as undeliverable due to incorrect address data (36 442 cases in 2019). In these cases, a new notification is issued to the inventor when the applicant submits updated address details, following a request to do so within a set period. Otherwise, no further attempt at notification is made.
16. Based on all of these considerations, a notification is no longer considered indispensable for informing inventors about their designation in a patent application. It is therefore proposed to amend Rule 19 EPC by deleting paragraphs 3 and 4, which contain the obligation to notify inventors about their designation (see point 20).
17. On this occasion, it is also proposed to amend paragraph 1 of Rule 19 EPC by deleting the requirement that the applicant shall provide the inventor's full address. While this amendment would help to curtail the problem that the inventor's full address is visible through file inspection and thus mitigate possible data protection concerns, it would also avoid a collection of data by the EPO which it does not require for its own procedures. Some user groups have in the past years repeatedly expressed their concern about the availability of the inventor addresses in the online file inspection. Disputes arising from inventorship do not fall within the competence of the EPO and, in case where a procedure for rectifying the designation of an inventor under Rule 21 EPC is initiated, there is no need for the EPO to contact the designated inventor directly.
18. It is understood that, as a European patent has the effect of a national patent once it has been granted, national patent authorities may need an inventor's address for national procedures. As this may happen only at a late point in time, there may be no certainty about the correctness of the address collected by the EPO before grant. If national offices decide to implement the common practice as regards the designation of the inventor, they remain free to have processes in place for obtaining the inventor's full address for national procedures.

19. As concerns the above mentioned procedure under Rule 21 EPC, it is noted that a request for rectification of an incorrect designation can only be granted if the requester submits the consent of the wrongly designated person and, if the request is filed by a third party, also the consent of the applicant for or proprietor of the patent. Moreover, the EPO does not verify the accuracy of the designation of the inventor (see point 12). The address of the designated inventor may also change over time, making the data initially obtain upon designation in many cases obsolete. The full address, including the street, would only be required to notify inventors of their designation by post. The need to obtain the inventor's full address no longer exists when no postal notification is performed in the future. Instead, it would suffice if applicants provide the inventor's family name, given name(s), country and place of residence.

20. It is therefore proposed to amend Rule 19 EPC as follows:

<p style="text-align: center;"><b>Present wording</b> <b>Rule 19</b> <b>Designation of the inventor</b></p>	<p style="text-align: center;"><b>Proposed wording</b> <b>Rule 19</b> <b>Designation of the inventor</b></p>
<p>(1) The request for grant of a European patent shall contain the designation of the inventor. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document. The designation shall state the family name, given names and full address of the inventor, contain the statement referred to in Article 81 and bear the signature of the applicant or his representative.</p> <p>(2) The European Patent Office shall not verify the accuracy of the designation of the inventor.</p> <p>(3) If the applicant is not the inventor or is not the sole inventor, the European Patent Office shall communicate to the designated inventor the information in the document designating him and the following data:</p> <p>(a) the number of the European patent application;</p>	<p>(1) The request for grant of a European patent shall contain the designation of the inventor. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document. The designation shall state the family name, given names and <b>country and place of residence</b> of the inventor, contain the statement referred to in Article 81 and bear the signature of the applicant or his representative.</p> <p>(2) unchanged</p> <p>(3) deleted</p>

<p style="text-align: center;"><b>Present wording</b> <b>Rule 19</b> <b>Designation of the inventor</b></p>	<p style="text-align: center;"><b>Proposed wording</b> <b>Rule 19</b> <b>Designation of the inventor</b></p>
<p>(b) the date of filing of the European patent application and, if priority has been claimed, the date, State and file number of the previous application;</p> <p>(c) the name of the applicant;</p> <p>(d) the title of the invention;</p> <p>(e) the Contracting States designated.</p> <p>(4) The applicant and the inventor may invoke neither the omission of the communication under paragraph 3 nor any errors contained therein.</p>	<p>(4) deleted</p>

## **B. PUBLICATION OF INVENTOR DATA**

21. The designated inventor is mentioned in the published European patent application (A publication) and the European patent specification (B publication). However, in the A and B publications, only the inventor's family name, given name(s) and the country and place of residence is indicated. In the European Patent Register the inventor's full address is visible as designated by the applicant in accordance with Rule 143(1)(g) EPC. Address information of the inventor may also be accessed by inspection of the public file (Article 128 EPC).
22. The designation of the inventor may be excluded from file inspection, if the inventor has waived their right to be mentioned. Under Rule 20(1) EPC, the inventors designated by the applicant may inform the EPO in writing that they have waived their right to be mentioned as inventors. As a result, their names are not mentioned in the A and B publications, the European Patent Register (Rule 143(1)(g)) and, consequently, the European Patent Bulletin. The designation of the inventor as well as the waiver is excluded from file inspection pursuant to Article 128(4) and Rule 144(c) EPC. This means that no information concerning the inventor is made public. In these cases, the right of the inventor not to be mentioned outweighs the interests of the public to be fully informed about the origin of the invention.

23. Inventors may however have an interest in their inventorship being recognised in the application without the full set of personal data, especially their private address, being made available to the public – for reasons of data protection. The publication of the complete address is not considered to be necessary to protect the interests of the inventor. On the basis of their designation, it needs to be possible to identify the inventor to a degree that safeguards their moral right under Article 62 EPC. For this purpose, it is considered sufficient to align all sources of information to the model of the A and B publications so that only the inventor's full name and the country and place of residence is published.
24. As was established in the questionnaire of Working Group 2 – Designation of the inventor, many EPC contracting states have already limited the data published about inventors in their official patent register based on the above considerations. Thus, having only the family name, given name(s), country and place of residence of the designated inventor entered in the patent register would correspond with the recommended common practice. The proposed changes do not impact the inventor's right under Rule 20(1) EPC to waive his right to be mentioned as such in the European patent application.
25. On this basis, it is proposed to amend Rule 143 EPC as follows:

<b>Present wording Rule 143 Entries in the European Patent Register</b>	<b>Proposed wording Rule 143 Entries in the European Patent Register</b>
<p>(1) The European Patent Register shall contain the following entries:</p> <p>(a) number of the European patent application;</p> <p>(b) date of filing of the application;</p> <p>(c) title of the invention;</p> <p>(d) classification symbols assigned to the application;</p> <p>(e) the Contracting States designated;</p>	<p>(1)(a) – (f) unchanged</p>

<p style="text-align: center;"><b>Present wording</b> <b>Rule 143</b> <b>Entries in the European Patent Register</b></p>	<p style="text-align: center;"><b>Proposed wording</b> <b>Rule 143</b> <b>Entries in the European Patent Register</b></p>
<p>(f) particulars of the applicant for or proprietor of the patent as provided in Rule 41, paragraph 2(c); (a)</p> <p>(g) family name, given names and address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20, paragraph 1;</p> <p>(h) particulars of the representative of the applicant for or proprietor of the patent as provided in Rule 41, paragraph 2(d); in the case of several representatives only the particulars of the representative first named, followed by the words "and others" and, in the case of an association referred to in Rule 152, paragraph 11, only the name and address of the association;</p> <p>(i) priority data (date, State and file number of the previous application);</p> <p>(j) in the event of a division of the application, the numbers of all the divisional applications;</p> <p>(k) in the case of a divisional application or a new application under Article 61, paragraph 1(b), the information referred to in sub-paragraphs (a), (b) and (i) with regard to the earlier application;</p>	<p>(1)(g) family name, given names and <b>country and place of residence</b> of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20, paragraph 1;</p> <p>(1)(h) – (y) unchanged</p>

<p style="text-align: center;"><b>Present wording</b> <b>Rule 143</b> <b>Entries in the European Patent Register</b></p>	<p style="text-align: center;"><b>Proposed wording</b> <b>Rule 143</b> <b>Entries in the European Patent Register</b></p>
<p>(l) date of publication of the application and, where appropriate, date of the separate publication of the European search report;</p> <p>(m) date of filing of the request for examination;</p> <p>(n) date on which the application is refused, withdrawn or deemed to be withdrawn;</p> <p>(o) date of publication of the mention of the grant of the European patent;</p> <p>(p) date of lapse of the European patent in a Contracting State during the opposition period and, where appropriate, pending a final decision on opposition;</p> <p>(q) date of filing opposition;</p> <p>(r) date and purport of the decision on opposition;</p> <p>(s) dates of stay and resumption of proceedings in the cases referred to in Rules 14 and 78;</p> <p>(t) dates of interruption and resumption of proceedings in the case referred to in Rule 142;</p> <p>(u) date of re-establishment of rights where an entry has been made under subparagraphs (n) or (r);</p>	

<p style="text-align: center;"><b>Present wording</b> <b>Rule 143</b> <b>Entries in the European Patent Register</b></p>	<p style="text-align: center;"><b>Proposed wording</b> <b>Rule 143</b> <b>Entries in the European Patent Register</b></p>
<p>(v) the filing of a request for conversion under Article 135, paragraph 3;</p> <p>(w) rights and transfer of such rights relating to an application or a European patent where these Implementing Regulations provide that they shall be recorded.</p> <p>(x) date and purport of the decision on the request for limitation or revocation of the European patent;</p> <p>(y) date and purport of the decision of the Enlarged Board of Appeal on the petition for review.</p> <p>(2) The President of the European Patent Office may decide that entries other than those referred to in paragraph 1 shall be made in the European Patent Register.</p>	<p>(2) unchanged</p>

## **VI. ENTRY INTO FORCE**

26. It is proposed that the amendments to Rules 19 enters into force on 1 April 2021.
27. The deletion of paragraphs 3 and 4 of Rule 19 EPC has the consequence that as of 1 April 2021 no more communications to designated inventors are issued by the EPO. This applies *inter alia* to all designations made in Euro-direct applications as well as for designations made in PCT applications during the international phase, for which the EPO currently informs inventors of their designation upon entry into the European phase. Similarly, communications to the designated inventors sent prior to 1 April 2021 which are returned to the EPO as undeliverable after that date are not reissued.

28. Amended Rule 19(1) EPC, requiring applicants to furnish the inventors' family names and given names, country and place of residence in the inventor designation, is proposed to apply to any designation of the inventor filed or rectified on or after 1 April 2021. It also applies to any PCT application entering the European phase on or after that date.
29. Considering the more substantial impact on the EPO's IT systems, amended Rule 143 EPC is proposed to enter into force on 1 November 2021 and apply to any patent application published in the European Patent Register as of 1 November 2021. The full addresses of inventors would no longer be visible for any applications published in the European Patent Register as of that date.

**VII. ALTERNATIVES**

30. N/A

**VIII. FINANCIAL IMPLICATIONS**

31. In 2019, the total costs incurred by the EPO for notifying inventors of their designation amounted to ca. EUR 307 000. These costs include the costs for paper, prints, envelopes, postal charges and staff hours of the printshop and the mailroom. When compared with the estimated cost of EUR 50 000 for the IT implementation of the proposed Rule changes, the proposed amendments have a positive impact on the EPO's finances.

**IX. LEGAL BASIS**

32. Article 10(2)(c) EPC; Article 33(1)(c) EPC

**X. DOCUMENTS CITED**

33. CA/PL 14/19; CA/PL 6/20; CA/PL 8/20; CA/77/20

**XI. RECOMMENDATION FOR PUBLICATION**

34. Yes

## PART II

### Draft

DECISION OF THE ADMINISTRATIVE COUNCIL  
of [date of decision]  
amending Rules 19 and 143  
of the Implementing Regulations to the  
European Patent Convention

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention (hereinafter referred to as "EPC") and  
in particular Article 33(1)(c) thereof,

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

#### Article 1

Rule 19 of the Implementing Regulations to the EPC shall be amended as follows:

1. Paragraph 1 shall read as follows:

"The request for grant of a European patent shall contain the designation of the inventor. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document. The designation shall state the family name, given names and country and place of residence of the inventor, contain the statement referred to in Article 81 and bear the signature of the applicant or his representative."

2. Paragraphs 3 and 4 shall be deleted.

## Article 2

Rule 143 of the Implementing Regulations to the EPC shall be amended as follows:

Subparagraph (g) of paragraph 1 shall read as follows:

"family name, given names and country and place of residence of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20, paragraph 1;"

## Article 3

1. Rule 19 EPC as amended under Article 1 of this decision shall enter into force on 1 April 2021. Rule 19(1) EPC as amended shall apply to any designation of the inventor filed or rectified on or after that date. Rule 19(1) EPC as amended shall also apply to any international application entering the European phase on or after that date.
2. Rule 143 EPC as amended under Article 2 of this decision shall enter into force on 1 November 2021. It shall apply to all patent applications published in the European Patent Register on or after that date.

Done at Munich, [date of decision]

For the Administrative Council  
The Chairman