

24 Criteria for the Recognition of Inventors and the Procedure to Settle Disputes about the Recognition of Inventors

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Under the existing Japanese laws, the indication of the inventor or inventors of an invention in the patent application is not subject to substantive examination. Therefore, once a patent is granted, even if the indication turns out to be false, the false indication does not influence the validity of the patent. However, with the increasing awareness of the inventor's right among researchers and technicians, the number of disputes over recognition of inventors has surged in recent years. In order to solve and prevent such disputes, we need to establish clear substantive and procedural rules.

In order to enhance the criteria for recognition of inventors, the author proposes that Japan should further develop the standards of "creation of technological thought" and "present of conception and its materialization", both of which have been adopted by judicial precedents and prevailing theories. In this process, a comparative study with the U.S. case law called "doctrine of simultaneous conception and reduction to practice" should be conducted. The doctrine focuses on the correlation between the technical fields to which the invention in question belongs and the necessity of an experiment.

The author also makes some proposals from the perspective of both construction and legislation in order to improve the procedure for the settlement of disputes over recognition of inventors. Those proposals are mainly about the case of usurped applications where the issue of recognition of inventors is often raised as an underlying problem. More specifically, the author discusses on what conditions the real right holder should be permitted to request the usurping applicant to surrender to him the patent or the right to receive a patent. Furthermore, the author points out the necessity to establish a new procedure that allows the real inventor to amend or correct the false indication of an inventor on the application or the patent.

I Purpose of This Study

The name or names of the inventor or inventors of an invention must be stated in a patent application. These names must also be shown in the patent certificate and patent registration. As the indication of each inventor is not subject to substantive examination, few people have paid much attention to who the real inventor or inventors are. However, with an increase in the number of disputes as described below, it has never been more important to recognize the real inventor or inventors of an invention. This study aims to clarify the substantive criteria for the recognition of the real inventor or inventors of an invention and also to examine arguments from the perspective of interpretation and legislation with regard to the establishment of the procedure for the settlement of disputes about the recognition of the real inventor or inventors of an invention.

II Current Situation in Recognizing the Inventor or Inventors of an Invention

These days, disputes about the recognition

of the real inventor or inventors can be classified into three types: disputes about the ownership of a patent or the right to receive a patent, disputes about the demand for reasonable compensation for employee inventions, and disputes about the confirmation of the status as an inventor. As joint research and development projects have become more common in recent years, the number of disputes about the ownership of a patent or the right to receive a patent has risen. In order to solve a dispute about the demand for compensation for an employee invention, it is sometimes necessary to settle a dispute about the recognition of the real inventor or inventor before discussing about the calculation method for compensation. This type of disputes is expected to surge in number thanks to the recently heightened public awareness of the importance of this issue. In addition to the above-mentioned three types, a new type of disputes has emerged. These disputes are raised not for the purpose of obtaining a patent or financial benefits but of gaining confirmation for the status as an inventor, reflecting the trend toward more emphasis on the value of a patent as a symbol of the achievements of researchers and technicians.

III Criteria for the Recognition of the Inventor or Inventors of an Invention

1 Japanese laws

According to judicial precedents and prevailing theories, since an invention is technological thought regarding specific measures to solve certain problems, a person who has devised such measures should be regarded as an inventor. It is also argued that the reduction to practice of a conception requires the fulfillment of the condition that based on the requirements specified as the constituent features of the invention, a party who has the average level of expertise about the technical field relevant to the invention has such level of technical knowledge that is enough to exploit the invention.

In principle, a person who has offered substantive cooperation for the “technical creation” is considered as a joint inventor. Those who should not be regarded as inventors are managers, assistants, advisors, supporters, and outsourcees. There is another analysis method that has adopted a different viewpoint. The existence of a substantive collaborator is judged for each of the two phases of the invention creation process. The first phase is the provision of a conception (the provision of a subject or advice as to the correct direction to a solution of a problem). The second phase is the reduction to practice of the conception. According to this analysis method, any person who has provided a novel conception should be regarded as the inventor. However, in the case where a person who came up with a conception simply publicizes the conception without materializing the conception, even if another person succeeds in materializing this conception and completes an invention, the person who originally presented the conception cannot become a joint inventor. Furthermore, any person who reduced the conception to practice should be regarded as a joint inventor unless the reduction to practice is a matter of course among parties in the relevant field.

2 Comparative study

(1) Foreign laws

(i) U.S. laws

Under U.S. laws, the formation of conception is traditionally one of the criteria for the recognition of the real inventor of an invention. A

well-known ruling about the meaning of “conception” states “‘Conception’ is the formation in the mind of the inventor of a definite and permanent idea of a complete and operative invention. For a conception to be considered complete, the inventor must have mentally formulated an idea for the invention so clearly that he can make a disclosure that would enable a person of ordinary skill in the art to practice the disclosure without extensive research or experimentation. For an idea to be considered definite and permanent, the inventor needs to have a concrete and complete idea rather than simply having general objectives or plans. A conception can be considered completed even if the inventor does not have a reasonable expectation that an invention will work. It is enough for the inventor to present an idea. Confirmation of the operability of the inventions should be deemed as a part of the reduction to practice.” The criteria for the recognition of the inventors of a joint invention are specified in 35 U.S.C. 116 and 37 C.F.R. 1.45.

For the analysis of the process of the formation of an invention, it is important to take into consideration the concept of “reduction to practice” as well as the concept of “conception”. There are two patterns for an invention to be reduced to practice. The first one is “actual reduction to practice.” This can be carried out by producing products made by reducing the invention to practice or by putting the invented method to practical use in order to prove that the expected results can be obtained. The second one is “constructive reduction to practice.” This can be carried out by submitting a patent application for the invention.

In principle, the concept of reduction to practice becomes an issue in the recognition of the inventor or inventors of an invention only in such case where the priorities of inventions are determined by interference proceedings. As traditionally mentioned in the theories regarding precedents, the core of an invention is the conception. The reduction to practice of an invention basically has nothing to do with the recognition of the inventor or inventors of the invention. The reason for placing more emphasis on the concept of reduction to practice when the priorities of inventions are determined is that proving the time of conception, which is a mental act, is more difficult than proving the time of the reduction to practice of the invention. More emphasis on the concept of reduction to practice is expected to help realize a more appropriate

allocation of burden of proof.

(ii) U.K. laws

The U.K. Patents Act has an explicit provision that defines “inventor” as the actual deviser of an invention. Moreover, the U.K. Patents Act has a provision about employee inventions that specifies that any employee who simply gave advice or assistance to another employee making an invention shall not be recognized as a joint inventor. According to judicial precedents, the recognition of the inventor or inventors of an invention must be carried out by finding the inventive concept in the claims of the patent in question and then by identifying the person who devised this concept. A person who has contributed to a self-evident part of the claims or who has assisted the reduction to practice of the completed conception should not be regarded as an inventor. In principle, an inventive concept must consist of an idea plus a means of realization.

(iii) German laws

Under German laws, a “creative contribution” to an invention is the basic criterion for the recognition of the inventor or inventors of an invention. Any contribution to daily activities cannot be considered as a creative contribution. For a person to be recognized as a joint inventor, he needs to have contributed to the invention through his creative and intellectual dedication. Any person who has not made a substantive contribution to the solution of the problem or who has created something in accordance with the instructions of someone else such as the inventor cannot be recognized as a joint inventor.

(2) Criteria for specific conceptions

The criteria for the recognition of the inventor or inventors in the United States, the United Kingdom, and Germany are different in how it is stated in their respective laws but are the same as the Japanese criteria described below in using the same keywords in the recognition of the inventor: “conception,” “inventive concept,” and “creative contribution.”

For a person to be recognized as an inventor,

- (a) he needs to have not only an idea or a vision but also specific measures to solve a problem;
- (b) he needs to be able to reasonably predict that the measures to solve the problem specified in (a) above will work as expected; and
- (c) he needs to propose the problem-solving measures in detail to such an extent that any

party in the relevant field can implement them without difficulties in reality.

(2) Necessity of experiments

When the above criteria are met, the conception becomes specific enough for the invention to be regarded as complete. In principle, no further action, such as the performance of an experiment to confirm the validity of the conception or the reduction to practice of the conception for actual exploitation, is required for the recognition of the inventor or inventors.

However, U.S. laws allow an exception under the doctrine of simultaneous conception and reduction to practice. Under this doctrine, the actual reduction to practice of an invention is considered as one of the criteria for the recognition of a conception. This is called the doctrine of simultaneous conception and reduction to practice. Today, this doctrine is interpreted as follows. As far as such “unpredictable technical field” as chemistry, biochemistry, or biotechnology is concerned, a conception of an invention, which is only a mental act, is not enough to predict and ensure the effect of the invention. Therefore, in such field, “conception” is nothing more than a mere wish based on prediction. For this reason, a conception should be deemed to take place simultaneously when the invention is actually reduced to practice, i.e., when an experiment on the invention reveals that it functions as expected. Thus, a person who reduces the invention to practice by an actual experiment should be recognized as the inventor. For proper use of this doctrine, the applicability must be carefully examined on a case-by-case basis. This doctrine does not necessarily mean that an experiment is required as one of the criteria for the conception of an invention whenever the invention belongs to any of the unpredictable technical fields. The conception of an invention can be recognized to have taken place before the actual reduction to practice of the invention as long as it can be proven that the effect of the invention is reasonably predictable. This shows the possibility that the person who originally conceived an invention could become a joint inventor as the conceiver, while the person who reduced the conception to practice could also be recognized as a joint inventor.

However, according to the doctrine of simultaneous conception and reduction to practice, if the criterion specified in (b) above is not satisfied, the conception cannot be recognized until the validity of the conception originally

formed is confirmed by an experiment. In Japan, there have been some court rulings that, depending on the technical field and subject of the invention in question, the confirmation of the validity of the conception by an experiment is required for the conception to be recognized as specific enough. These rulings show that Japan is also aware of the necessity of an experiment in some cases.

(4) Proposals

(i) Developed form of the criteria for the recognition of the inventor or inventors

It is possible to create a developed form of the criteria for the recognition of the inventor or inventors as follows if the general criteria that have been adopted by judicial precedents and prevailing theories in Japan are reconstructed from the perspective of the doctrine of simultaneous conception and reduction to practice of the United States.

- (a) In order for a person to be recognized as an inventor, he needs to have formed a conception that consists not of a mere wish but of measures to solve problems. Moreover, measures must be specific enough for a party in the relevant field to implement.
- (b) If those measures are abstract in the case (a) above, the invention is considered incomplete. The invention is regarded complete when those measures are made specific enough.
- (c) It needs to be reasonably predictable that the problem-solving measures specified in (a) will bring about the expected results. If it is not reasonably predictable, the invention is not regarded complete until the conception is considered to be made specific enough after the expected results of those measures are confirmed by an experiment or by any other means.
- (d) Any person who has made a substantive contribution to the above case (a) or (c) can be considered as a joint inventor. However, a person who has merely given advice, supervision, financial support, physical assistance for specific tasks, or engaged in an invention as a subcontractor or an outsourcee cannot be considered as having made a “substantive contribution.”

(ii) Appropriateness of explicit statement of the criteria for the recognition of the inventor or inventors

For the recognition of the inventor or

inventors of an invention, it is extremely important to analyze each fact specifically. Therefore, even if general criteria are established as mentioned above, we could only deduce the solution for a limited number of disputes about the recognition of the inventor or inventors partly because such general criteria cannot catch up with the rapidly changing world where new technical fields are created one after another thanks to recent technical innovation and where researchers and technicians engage in the creation of inventions in increasingly diverse ways. If specific instructions are necessary, they should be given in the form of case reports and guidelines.

(iii) Recommended measures to be taken by companies

In practice, it would be more desirable to prevent any dispute about the recognition of the inventor or inventors from happening to begin with or to establish a system that encourages the parties concerned to voluntarily solve a dispute through discussion. For this purpose, each company or research institution needs to raise awareness of the issues associated with the recognition of the inventor or inventors and to take appropriate measures in daily business activities as follows.

(a) Laboratory notebooks

A laboratory notebook is a notebook to record the process of each research and experiment. This notebook consists of bound sheets of paper with each sheet numbered with the page number. As long as a laboratory notebook contains detailed information about a research or an experiment with the signature of the person who kept the records and also with the date of each record, the notebook can be presented as a convincing evidence when there is a dispute about the chronological order of inventions, the recognition of the inventor or inventors of an invention, or the calculation of the contribution rate of each inventor. Laboratory notebooks are expected to be used in a more sophisticated and advanced manner in the future. For example, the detailed guidelines about the record-keeping by use of a laboratory notebook might be established. People might use notebooks in an advanced way by obtaining fixed dates for records or create further advanced notebooks such as online laboratory notebooks or electric laboratory notebooks.

(b) Training for technicians and researchers

In Japan, not enough discussion has been conducted about the recognition of the inventor or inventors of an invention. Japanese organizations had traditionally adopted excessively lenient criteria for the recognition of the inventor or inventors. It is important to always include the subject of inventor recognition in intellectual property training given to technicians and researchers in order to keep people engaging in research and development activities well aware of the issues related to the recognition of the inventor or inventors of an invention.

IV Procedure for Settlement of Disputes about Recognition of the Inventor or Inventors

1 Japanese laws

(1) Procedural treatment of the inventor or inventors

The right to receive a patent may be assigned before the submission of a patent application. The name and the address or location of the inventor or each of the inventors of an invention must be stated in an application. That information will be disclosed in the patent application publication, the patent gazette, and patent certificate. However, the indication of the inventor or inventors in a patent application is not subject to substantive examination. In the case where a patent applicant is not the inventor, if the applicant has not succeeded to the right to receive a patent, it would constitute a reason for the refusal or invalidation of the application. In any other case, even if the indication of the inventor or inventors in an application is false, it does not affect the effect of the patent.

(2) Procedure for the settlement of disputes about the ownership of the right to receive a patent

The submission of an application by a person who does not have the right to receive a patent or an application by some of the joint owners of the right to receive a patent will constitute a reason for the refusal of the application. However, even if the Patent Office refuses such application submitted by unauthorized people, it does not mean the recovery of the benefits that could have been gained by the real owner of the right through the exclusive exploitation of the patented invention. Although a usurped application is

denied its status as a prior application, subsequent application of the same invention by a true right holder will be rejected because of lack of novelty after publication of the application. Grace period for the true right owner is only within 6 months from losing novelty, therefore it is argued whether the true right holder can demand assignment of patent (or right to receive a patent) to an unauthorized patentee (or an applicant).

According to judicial precedents and prevailing theories and also to the everyday practice at the Patent Office, the following procedure will apply to the case where the real right holder demands a change in the indication of applicant. In the case where an unauthorized person submits a patent application, if there is no dispute among the parties concerned, the real right holder may correct the indication of applicant by submitting a request for the correction of the indication of the name of the applicant or by registering the transfer of the patent in question. On the other hand, if there is a dispute, the real right holder may institute a lawsuit to obtain the final and conclusive judgment that the right to receive a patent belongs to him. Under current practices, such judgment may be sought only during the patent pending period. If he obtains such judgment, he can then have the name of applicant corrected by submitting to the Patent Office this confirmation of the court as a certificate for the succession of the right.

If there is no dispute, this issue can be settled through the assignment of a patent also after the grant of the patent, as is the case before the grant. If there is a dispute, the real right holder can demand a trial for invalidation of the patent granted in response to the usurped application. The real right holder is also said to be allowed to seek the compensation for the damage caused by the illegal act of infringement on the right to receive a patent from the person who submitted a usurped application. Further, it is argued whether the real right holder has the right to request the person who has obtained a patent through usurped application to surrender the patent. The Supreme Court ruling in 2001 allowed such request for the particular case. However, the case had special situations: the true right holder had filed the original application, and she filed the declaratory judgment action for confirming her right to receive a patent before the grant and the case was still pending at the time of the grant, then the complaint was changed

to assignment. Therefore, the scope of the judgment is controversial.

(3) Demand for compensation for an employee invention

The indication of an inventor on the patent does not have any presumptive effect. In the case of a lawsuit over compensation for an employee invention, a court may make a judgment without being bound by the indication of the inventor or inventors in the patent.

(4) Amendment and correction of the indication of the inventor or inventors of an invention

Before the grant of a patent, the inventor or inventors of an invention may file a civil case against an applicant for amendment of the indication of the inventor or inventors in the application. In this case, such civil proceedings will be conducted in accordance with the amendment procedure if there is no dispute among the parties concerned or, if there is a dispute, on the grounds of his right of honor as an inventor. After the grant of patent, however, no procedure is available to correct the indication of the inventor or inventors.

2 Comparative study and proposals

(1) Procedural treatment of the inventor or inventors of an invention

Under U.S. laws, the assignment of the right to receive a patent must not be made before the submission of an application. In principle, the inventor himself is required to sign an application and submit the application together with a written oath that he believes himself to be the original and first inventor. If a person is included as a joint inventor in a patent application by mistake or if a person is not included as such in a patent application by mistake, an amendment of the application is permitted unless the mistake was made with the intention to deceive. If an amendment is not permitted, the patent will be invalidated. In addition, there are precedents pointing out that the false indication of the inventor or inventors made with the intention to deceive could constitute an inequitable conduct and that the patent will be unenforceable in such case.

The United States is unique in requiring the inventor or inventors themselves to submit a patent application. Under European laws, U.K. laws, and German laws, it is sufficient if the

applicant himself proves that the indication of the inventor or inventors is correct and also that the applicant has lawfully succeeded to the right to a patent. Recently, most patent applications are for employee inventions. In most cases, the company and employee have a prior agreement that the company will succeed to the right to receive a patent on any invention made by an employee. Therefore, it is more efficient if the application procedure allows the successor to the right to receive a patent to submit a patent application. The United States has submitted a bill to revise its patent law so that not only the inventor or inventors but also the successor to the right to receive a patent may submit a patent application. The bill is currently under deliberation in Congress. As far as this issue is concerned, the current Japanese legal system needs no alterations.

Under U.S. laws, any false indication of the inventor or inventors of an invention made with the intention to deceive is considered as an adequate reason to make the patent invalid or unenforceable. This U.S. system seems too strict to be adopted in Japan as a means to guarantee the correctness of the recognition of the inventor or inventors of an invention. On the other hand, under the legal systems of the United Kingdom and Germany, the real inventor or inventors are allowed to demand an amendment or a correction to the false indication of the inventor or inventors unless the false indication was made by a usurped application. This level of protection for the real inventor of an invention seems more appropriate for Japan.

(2) Procedure to provide the real right holder with a remedy for the damage caused by a usurped application

U.K. laws and German laws have explicit provisions that allow the real right holder of an invention to demand a surrender of a patent on the invention.

The U.K. Patents Act specifies the right determination procedure available at the Patent Office for settlement of a dispute between an applicant and a third party about the ownership of the right to receive a patent. This is an administrative procedure conducted mostly through examination of the submitted documents in a simple and efficient manner. The comptroller may, at his own discretion, gather evidence by such means as examination of witnesses. Regarding the right determination procedure, the comptroller may, as a remedy for the real right

holder, (1) order that the application shall proceed in the name of the real right holder or in the names of both the original applicant and the real right holder, (2) refuse to grant a patent in pursuance of the application or order the application to be amended, (3) make an order transferring or granting any license or other right in or under the application. If the comptroller has any case still under the right determination procedure that could more properly be carried out by a court, the comptroller may refer the case to a court. The right determination procedure available after the grant of a patent is almost the same while different provisions are relied on. It should be noted that there is a time limit by which the right determination procedure must be commenced after the grant of a patent. No order may be made for a transfer of a patent if a request for the commencement of the right determination procedure was made after the end of the period of two years beginning with the date of the grant of the patent unless it is shown that any person registered as a proprietor of the patent knew that he was not entitled to the patent. If an order is given to surrender the right to the real right holder, adjustments of interests need to be made between the real right holder and any third party having interests in the patent. It is specified that, as a result of such adjustments, any licenses or other rights in or under the patent shall lapse in principle and also that, if the old proprietor or proprietors or a licensee of the patent, acting in good faith, have worked the invention in question or made preparations to do so since before the issuance of the order for a transfer of the right, the old proprietor or proprietors or the licensee shall, on making a request to the new proprietor or proprietors within the prescribed period, be entitled to be granted a non-exclusive license to continue working or, as the case may be, to work the invention for a reasonable period of time under reasonable conditions.

Under the German Patent Law, in the case where there is a dispute among the parties concerned, if a patent has not been granted, the person who is primarily entitled to a patent may request the applicant to surrender to him the right to receive a patent by following the civil procedure at a court. In the case of a usurped application, the real right holder may institute a lawsuit against the patent owner to demand the surrender of the patent. Such a lawsuit must be instituted within two years of the notification of the grant of a patent (this time limit does not apply to the case where the usurped application

was submitted in bad faith). The real right holder may give a notice of opposition only within three months of the publication of the grant of a patent. If the opposition is accepted and results in the revocation of the patent, the real right holder himself may apply for the invention as long as such application is submitted within one month of the notification of the revocation. Even if the opposition is rejected, the real right holder may institute a lawsuit against the patent owner to demand a surrender of the right as long as such lawsuit is instituted within one year of the completion of the opposition procedure (this time limit does not apply to the case where the usurped application was submitted in bad faith).

Next, we will review the Japanese system in consideration of Supreme Court rulings in order to discuss what conditions the real right holder should be allowed to request the usurping patent owner to surrender the right to him.

- (i) The invention of the real right holder and that for which a usurped application has been submitted are regarded to be identical as long as any amendment to the invention is within the scope permitted under law. If a usurping applicant has greatly changed the original invention, it should be handled as an invention jointly made by the real right holder and an unauthorized party. In this case, the real right holder should be allowed to request the party to transfer his share in the patent to him.
- (ii) While many people support the view that the real right holder should not be allowed to request the usurping patent owner to surrender the right to him unless he himself have made a patent application, the Supreme Court ruling in 2001 pointed out the necessity of the balancing of equities between the real right holder and the usurping applicant. According to the ruling, a remedy should be provided to the real right holder even in the case of a usurped application. Furthermore, it is interpreted that the causations between benefit and loss are recognizable in a commonly accepted sense. Such relations provide the grounds for the exercise of the right to request the return of undue profits.
- (iii) There have been discussions about the appropriateness of limiting the period during which such a request for a surrender of the right may be made. As more and more third parties will become interested parties after the registration of a patent, it is necessary to

specify their rights and obligations under law. Such stable legal system is especially important in the case of a usurped application submitted in good faith. On the other hand, it would be reasonable to balance the interests of the real right holder and a usurping applicant by limiting the period only during which the real right holder is allowed to institute a lawsuit because he has opportunities to learn about a usurped application through the publicized application and registered patent. It is however too short to require the commencement of a lawsuit before the grant of a patent. In my opinion, such period should last two years after the grant of a patent as is the case with U.K laws and German laws. No time limit should be set in the case of usurped application submitted in bad faith.

(3) Demand for compensation for an employee invention

German laws are unique in subjecting the recognition of the inventor or inventors of an employee invention as well as the calculation of compensation to arbitration held by the arbitration committee (Compulsory conciliation). The advantage of the arbitration system, which is placed before the judicial system, is that arbitration allows the flexible settlement of disputes by experts. However, Japan decided not to adopt a German-type legal system at the time of the recent revision of the system for employee inventions. This is because a German-type legal system was considered burdensome to both employers and employees because it required them to meticulously follow many procedures. It should be noted, however, that Japan has improved its system in its own way. For example, any court that receives a petition for a civil case may, *ex officio*, place the case in arbitration. Furthermore, arbitration conducted by lawyers and patent attorneys is available especially for intellectual property cases. In this way, with the appropriate handling of individual cases at court, it is possible, even under the existing system, to settle and solve disputes through arbitration in a flexible manner.

(4) Procedure to amend or correct the indication of the inventor or inventors of an invention

U.K. laws and German laws have explicit provisions about the procedures to amend or correct the indication of the inventor or inventors

of an invention.

Under the U.K. Patents Act, an applicant is allowed to amend the indication of the inventor or inventors, without the consent of the initially indicated inventor or inventors, by resubmitting an oath as long as the application has not been publicized yet. After the publication of the application or the grant of a patent, any person who alleges that the indication of the inventor or inventors is false may apply to the comptroller for the commencement of an administrative procedure. This procedure can be carried out through examination of submitted documents in a simple and efficient manner. Moreover, the procedure is applicable regardless of whether or not there is a dispute among the parties concerned about an amendment to the indication of the inventor or inventors. As is the case with the right determination procedure, the comptroller may, at his own discretion, gather evidence or refer a case to a court.

Similarly, under the German Patent Law, an applicant is allowed to amend the indication of the inventor or inventors, without the consent of the initially indicated inventor or inventors, by resubmitting an oath as long as the application has not been publicized yet. After the publication of the application or the grant of a patent, if there is no dispute among the parties concerned, an applicant may make such amendment by filing with the Patent Office for the commencement of the amendment procedure with the consent of the initially indicated inventor or inventors. If there is disagreement among the parties concerned, the real inventor may bring a case against the disagreeing party or parties to court to demand his/her or their agreement.

In Japan, there is a precedent where a court that allowed an amendment to the indication of the inventor or inventors before the grant of a patent cited the right of honor of inventors as the legal grounds for allowing the real inventor or inventors to request the applicant to amend the indication of the inventor or inventors. According to this logic, it can be concluded that more protection after the grant should be provided for the inventor's right to indicate his name on the patent because the need to respect the honor of the inventor or inventors has increased since the grant of a patent. Under Japanese laws, once a patent application is submitted, the indication of the inventor or inventors of an invention cannot be amended without the consent of the initially indicated inventor or inventors regardless of whether such amendment is made before or after

the publication of the application. As is the case with the legal systems of the United Kingdom and Germany, the Japanese system should also allow the submission of an application without filling out the section of the application form for the indication of inventor on the condition that it will be filled out by the time of the publication of the application. In sum, the indication of the inventor or inventors is not required at the time of application as long as the necessary information is provided later. This system seems desirable from the perspective of legislation.

I propose that after the publication of the application or the grant of a patent, if there is no dispute among the parties concerned, an amendment or a correction should be allowed with the submission of a written oath prepared by all the parties concerned. This is the procedure currently adopted in practice. If there is a dispute, an amendment or a correction in the indication of the inventor or inventors of an invention should be carried out according to the court's confirmation of the real inventor or inventors obtained through civil proceedings. These procedures should be expressly specified in the statute.

(5) Necessity to specify the right of honor of inventors

In order to create an explicit provision about the procedure for amendment and correction of the indication of the inventor or inventors as described earlier, further study is necessary as to whether it is appropriate to explicitly specify in a domestic law that each inventor is entitled to the right of honor as an inventor. Prevailing theories and judicial precedents in Japan allow such amendment and correction on the grounds of the right of honor of inventors specified in the Paris Convention, which was ratified by Japan as well. Regarding this issue, the U.K. law has the explicit provision specifying that the indication of the name or names of the inventor or inventors is the inventor's "right." This issue is not clearly addressed in German law. In Germany, however, there is a court ruling that interpreted such right of honor as a personal right.

Japan has not established the procedure for amendment and correction of the indication of the inventor or inventors. Therefore, I personally believe that it will be enough to explicitly specify the establishment of such a procedure as a clear expression of Japan's intention to protect the right of honor of inventors. For this reason, it is unnecessary and even undesirable, at this

moment at least, to create a provision that could imply the grant of a right that is more than the right to indicate the name or names of the inventor or inventors in the patent.