

SPECIAL RIGHTS AND OBLIGATIONS OF THE EMPLOYEE INVENTOR

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Romanian legislation on patents, defines the inventor as the person "who created the invention". If the invention has been created by more than one inventor, each has the status of joint invention and the right belongs to them jointly. In this respect, a legal relationship of employment arises between the employee inventor and the employer, with specific content, special requirements, rights and obligations that makes it different from a general individual employment contract.

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Making an invention implies significant investments and a laborious and time consuming activity, which can be sustained by independent investors only in a small share, these cases being rather the exception¹. This is the reason why, the invention is achieved most of the times in special research institutes or in companies that can sustain the effort. In this respect, a legal relationship of employment arises between the employee inventor and the employer, with specific content, special requirements, rights and obligations that makes it different from a general individual employment contract.

According to Article 10 of the Labor Code, by individual employment contract, we understand an agreement under which an individual, called employee, performs work for and under the authority of an employer, person or entity, in exchange for a remuneration called salary².

The clauses of an individual employment contract cannot contain provisions contrary to or below the minimum rights established by legislation or by collective employment agreements³.

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¹ Gheorghe Gheorghiu, Cosmin Cernat, *Dreptul proprietății intelectuale*, university course, Juridical Universe Publishing House, Bucharest, 2009, p. 147.

² Cosmin Cernat, *Dreptul muncii*, university course, 3rd Edition, Juridical Universe Publishing House, Bucharest, 2011, p. 237

³ Alexandru Țiclea, *Tratat de dreptul muncii*, Juridical Universe Publishing House, Bucharest, 2011, p. 331.

According to the Romanian law, the rule is that an individual employment contract is made for an indefinite period of time⁴.

By exception, the individual employment contract may be terminated and the period determined under the conditions provided by law. In this sense the employee inventor may conclude an individual employment contract with determined period, provided that the contract is concluded for a temporary mission of specific research and its term does not exceed the maximum imposed by the framework law, that is the Labor Law⁵.

Romanian legislation on patents, namely, Law nr.64/1991, republished⁶, defines in Article 2, letter g) that the inventor is the person "who created the invention". If the invention has been created by more than one inventor, each has the status of joint invention and the right belongs to them jointly⁷.

According to article 5 of this law, the inventor employee is entitled to the patent unless otherwise provided, in the following cases:

a) in the employment contract of determined and/or undetermined duration there is a special clause more advantageous in the sense that, for any invention made by him, which comes under Article 5, he is not obliged to inform in writing the employer about the creation and the progress of invention, and the employer has a preference right to make a contract on the invention made by him.

b) in the employment contract for temporary inventive mission, there is a clause providing that if an invention will result from this contract, the person entitled to the patent is the inventor-employee.

c) in the research contract is a clause stating that, if an invention results, the employer declines its right to the patent.

d) in the internal research contract, there is a clause stating that the employee inventor is entitled to the patent.

In these cases it is considered that there is a more advantageous contract provision in the favor of the employee inventor and he is entitled to the patent. The cases in paragraphs c) and d) are very rare because, basically, the person who acquired the research theme that contains the invention cannot, actually, apply it, unless signs a contract with the holder of the patent that is the inventor-employee, which have to be exceptions⁸.

⁴ Ion Traian Ștefănescu, *Tratat de dreptul muncii*, Juridical Universe Publishing House, Bucharest, 2011, p. 223.

⁵ See art. 82 in *Codul muncii*.

⁶ *Law. 64/1991* regarding patent, *Monitorul Oficial al României*, Part I, no. 541, from 08.08.2007.

⁷ Ion Macovei, *Tratat de dreptul proprietății intelectuale*, C.H. Beck Publishing House, Bucharest, 2110 p. 73

⁸ Ligia Dănilă, *Dreptul de autor și dreptul de proprietate industrială*, C.H. Beck Publishing House, Bucharest, 2009, p. 167.

The patent holder is the employer, according to article 5. (1) a) and b), article 5. (2) with an assignment contract or a contract with a contrary provision.

The special rights and obligations of the owner of the patent are:

- the holder has the exclusive right to exploit it during the duration of the patent and to prevent third parties from exploiting the patent without his consent;

- the patent holder may request reinstatement of grounds, in term of 6 months from the date of publication of the forfeiture;

- the patent holder may give up in whole or in part, the right to the patent based on a written declaration filed with OSIM;

- the holder is entitled to be paid damages to compensation under civil law;

- the holder may transmit to a third party rights conferred by the patent based on the license agreement or assignment contract;

- the holder may require, motivated, to the Bucharest Court, to withdraw the compulsory license provided that the legitimate interests of the person who has acquired it are protected in an appropriate manner;

- the applicant / holder may receive credit in foreign currency for certification abroad.

Obligations of the holder of the patent:

- holder shall inform in writing the inventor about the progress of implementation of the invention. Important is that within a research contract information is transmitted by the inventors of the research unit employees through these latter to the beneficiary. It is necessary to conclude a contract of confidence and without collusion between the two parts, same parts that concluded the research contract;

- the holder is obliged to pay annual maintenance fees of patent throughout the duration of the patent in the amounts and terms prescribed by law;

- the holder must respect the rights accruing to the inventor established through negotiation on a contract basis and to specify in the contract of assignment or to settle it by negotiation before the contract of assignment terminates;

- the holder is required to maintain the classification of invention information covered by a patent;

- the holder must request the approval of the institution of classified information for patenting abroad;

- the holder must guarantee, in case of a contract assignment or license with another person. The holder must have a contract with the employee inventor of taking the author the right to claim convention priority, for registration of a patent application in member countries of the Paris Convention or OMC.

If all inventors are employees of the same employer which was signed employment contract with inventive mission, at least up to the entire duration of the employment contract with inventive mission or to the creation of the invention, in accordance with Article 5, paragraph 3, the right to the patent belongs to the employer⁹.

When inventors are employees of other employers, each employee must announce the other co-authors and their employers and comply with the contract which will take account of Article 5 paragraph 6 (Law no. 64/1991). The right to the patent may belong to one or more persons¹⁰.

Virtually all inventors should be employees of the employer unit to comply with Article 5, paragraph 3 and paragraph 6, in the sense that there is at first a single legal entity that has a preference right to a contract related to the invention of his employees.

If, in the team of inventors there is an inventor who is not covered by a contract of employment, or is employed but the invention is not part of the business of the employer, or is a foreign person, and the other inventors are employed in a Romanian legal entity employing invention in art. 5 (a) b) ten, all inventors, persons entitled to the grant of the patent, must obey the provisions of Article 5 para. (3) and paragraph. (6) in relation to the Romanian legal entity¹¹.

According to the provisions of Article 4 and Article 5 para. (2), all inventors must be employees of the employer unit which carried out research under contract with the beneficiary and that actually worked to the contract and / or employees of a third party that has a subcontract research with the employer unit. In this case a sub clause must be inserted in the subcontract related to the person entitled to the patent of the main research contract or failing that a clause on the legal provisions in force.

The preference right of an employer to have the contract for the invention of his employee as required by Article 5 para. (6) and hence of the art. Alin.11 90-14, for an invention created under the provisions of art. 5 paragraph 1 letter. b) for which a patent application has been registered with the applicant the inventor-employee or for which the latter is the holder as a result of granting the patent, the applicant / holder must first offer to license or assignment contract to the employer unit, whose employee he was at the creation date, and the unit will show interest within three months from the offer in a contract between the parties¹².

⁹ Viorel Roș, *Tratat de dreptul proprietății intelectuale*, C.H. Beck Publishing House, p. 97.

¹⁰ Gheorghe Gheorghiu, Cosmin Cernat, *op.cit.*, p. 237.

¹¹ Lîgia Dănilă, *Dreptul proprietății intelectuale*, C.H. Beck Publishing House, Bucharest, 2010, p. 167.

¹² Gheorghe Gheorghiu, Cosmin Cernat, *op.cit.*, p. 239.

Regarding the article. 90 para. (12) it is noted that where it is a non-exclusive agreement, the holder, who is the inventor-employee may enter into non-exclusive agreement with a third party until the final resolution of the dispute on the contract price by the court under provisions of Article 5 para. (6)¹³.

Following the conclusion of individual employment contract, the employee-inventor has the following main rights and obligations.

Employee inventor rights:

1. Employee inventor is entitled to be named, first name and position in the patent issued, employment record and any other documents or publications concerning his invention, according to art. 35 para 1
2. Employee inventor is entitled to a duplicate of patent
3. Employee inventor is entitled to take possession of rights accruing under contract.
4. Employee inventor is entitled to take in whole or in part if the holder surrenders the right to the patent in whole or in part.
5. Employee inventor said the applicant may request in writing to OSIM not be published in the bibliography of published application or patent, this request is subject to payment of legal fees
6. Employee inventor is entitled to additional remuneration after conducting an invention, regardless of wage employment
7. Employee inventor is entitled to reimbursement of costs for all technical and economic documentation, projects, studies, research with prototypes, if they were made by the inventor for the invention
8. Employee inventor is entitled to the right to dignity at work.
9. Employee inventor is entitled to protection in the event of dismissal.
10. Employee inventor is entitled to the right of the employee inventor to the patent

The inventor-employee is entitled to a patent under Art. 3 and hence of the art. 88, para 1 and para. 2, letter. a) for any invention made which comes under Article 5, paragraph 1, letter b).

If the invention was created in accordance with Article 5, paragraph 1, letter a) or Article 5, paragraph 1, letter b), with or without contractual provision contrary to, or Article 5, paragraph 2, and the owner, which is unity, give under Article 37 rights under the patent, the inventor of this situation, if it is - following its announcement by the owner, can take these rights by paying the transfer fee.

When a patent was granted and has not been applied by the employer holder or patent holder has not taken the necessary measures to implement the invention in effect legal right to patent the inventor is under Article 71, paragraph. (4).

¹³ Viorel Roş, *op.cit.*, p. 77.

In both cases it is necessary that the patent is in force, and the charge transfer in the first case will be paid by the inventor-employee, as assignee, or a person established in writing between the parties.

According to the preamble of Article 5 and hence the provisions of Article 88, paragraph 2, letter a) and d), if there is otherwise in the case of inventions created under the provisions of Article 5, paragraph 1 a), and paragraph 2, lit b), unless a contrary clause, right to the patent belongs to the inventor-applicant.

In the situation covered by Article 5, paragraph 5 and Article 88, alin.2.lit.e), inventor employee is entitled to the patent if the employer exceeds the 60 days for the application of the request.

Inventor-employee obligations

1. Obligation to inform of the employee inventor

Employee author of an invention shall inform in writing and "immediately", the leader in working units, of the invention made by him in the operating unit. This obligation refers both to employee engaged with the temporary mission, and to the employee who made an invention, without being assigned to this mission, but within the unit.

If the invention was created by more inventors, information will be made jointly by all the inventors or their attorney. Information must contain sufficient data to allow the unit to assess integration of the invention in the categories of service regulated by law. The notification shall contain information on:

- object of the invention and scope;
- the conditions under which the invention was created;
- integration of the invention in one of the categories of service invention.

Information must be accompanied by a description of the invention on which the unit is entitled to the patent. The information must describe the problems encountered, technical status, the proposed solution and a sample.

Information on invention is personally registered with the employer unit by letter, so that it can be an evidence of the information obligation, but respecting the privacy and confidentiality. The term of 60 days, in which the unit must apply for patent issuance shall begin from the date of registration of information, accompanied by description.

If the employer and employee have not reached agreement on the patent right, the dispute is in the jurisdiction of the courts. In this case, under rule 51 of the Regulations of the Law nr.64/1991, to ensure protection of invention, patent application will be filed with OSIM, by the inventor, before referral to court, with its obligation to inform the employer.

Infringement of the mutual information obligation is punishable and liable for any harm caused.

2. Employee inventor must refrain from any disclosure of the invention. He is bound by loyalty throughout his employment contract. This obligation continues even when the main effects of the job (work performed and salary) are suspended.

3. Employee inventor must provide, at the request of the holder of the patent, technical assistance based on a contract for implementation of the invention.

4. Obligation to comply with health and safety measures at work

5. The obligation to make an offer. If the employee wishes to transfer the rights on his invention, preferably the employer has a right to a contract on free invention that at its conclusion can be exploited in its scope. This right is exercised by the employer within 3 months after the employee's offer. Misunderstandings arising from a contract on free invention are solved in a court.

The analysis of specific provisions reveals a series of conclusions. This general area of labor rights and obligations under the Labor Law are adapted to specific work. The creative activity of the employee must be protected in some way both in employer and employee relationship, and also in the relationship of the employee with third parts.

Also, a number of personal rights of the employee are acknowledged, unprecedented in any other category of employees. These rights are rooted in the specific characteristics of his work. The inventions will always carry the mark of the inventor, and in such a situation the rights of the employee acquire a special connotation. In this category of employees intrinsic motivation plays a crucial role over the extrinsic material one.

It is our duty to highlight also the specificity of obligations, which, must, on one hand integrate in the area of legal work that are dominated by subordinate employee to the employer, and also the increased freedom in performing duties of the employee inventor. This type of employee is an exception from the usual employee prototype. Being a creative and philosophical person, he has special needs and expectations, but his activity is still dominated by a limited obligation of result of the parameters imposed by the employer for each controlled invention.

In this respect, we welcome and appreciate the additional rights recognized for such employee, but also his duties, given the additional expectations of the employer, and also the latter's need of legal protection against both the employee inventor and the beneficiaries of the inventions made by its employees.

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