



# TRANSFER AND ENTREPRENEUR CENTRE

## Guidelines for Invention Disclosures

The Employee Invention Act (ArbErfG) expressly stipulates that any invention has to be reported to the employer in writing for the purpose of legal certainty. This means that any invention arising during the term of an employment has to be reported in full to OVGU immediately in writing (§ 5 or § 18 ArbErfG). It is strongly recommended that you use the Invention Disclosure Form for this purpose. The receipt of the invention disclosure must be confirmed to the employee immediately (§5 ArbErfG). The purpose of the yellow area in the upper right corner of the first page of the Invention Disclosure Form is to clearly show important dates in relation with the invention disclosure.

In case of inventors who are employees or civil servants of OVGU, the question of who is entitled to the property rights in the invention must first be clarified before any application for an intellectual property right is filed. According to the Employee Invention Act, OVGU, as the employer, has a general claim to inventions which were completed by an employee during the term of the employment. Depending on the individual circumstances, which are requested in the form, these are deemed to be service inventions (§4 ArbErfG) that can be claimed by the employer, OVGU, (§6 ArbErfG).

### Service or free invention?

The Employee Invention Act distinguishes between two types of employee invention, namely service inventions and free inventions (§ 4 ArbErfG).

Service inventions are inventions made by the employee during the term of the employment and which arise out of the employee's work, e.g. through work in the laboratory or during work-related meetings. The definition also includes inventions based on experience gained or work performed at the university. It is irrelevant where or when the invention was made or the inventive solution was conceived of (e.g. at the weekend or "after work"). Even the frequently quoted "but the boss hadn't even tasked with coming up with an invention" does not release employees from the obligation to report the invention.

All inventions by employees which are not classified as service inventions are free inventions. Free inventions cannot be claimed by the employer OVGU. However, free inventions must also be communicated to OVGU (§18 ArbErfG). OVGU must be able to assess whether the invention is actually free on the basis of this report. If OVGU is of the opinion that the invention is not a free invention, the inventor must be notified of the finding within three months. If the free invention overlaps with the institute's existing or prepared field of work, the employee is also obliged to offer the institute a shared use of the invention (§ 19 ArbErfG).

### The invention disclosure

An invention disclosure has to occur, always in writing, to clarify and define the circumstances regarding scope and deadlines (§ 5 ArbErfG). The employee must describe the problem and solution as well as the origin of the service invention in the invention disclosure. It is also important to know whether the invention or parts thereof will soon be published for urgent reasons (e.g. conferences, seminars, publications, reports). Prior to this, special agreements are absolutely necessary to prevent any potential patenting from being made impracticable. In principle, the employee should report a service invention to OVGU at least two months before any planned publication (§ 42 No.1 ArbErfG).

If the disclosure fails to describe and explain the invention or its realization with sufficient precision, the employer has the right to object the disclosure within a period of two months (§5 ArbErfG). In the event of complaints, the deadline for claiming the invention shall be extended accordingly.

## Description of the invention

Your employer (as a so-called non-specialist) must be able to use the information in the invention disclosure to assess whether it is actually a service invention and, if so, whether they wish to claim it. This decision must be taken by OVGU no later than four months following receipt of the valid invention disclosure (§ 6 ArbErfG). In the absence of any express statement by the OVGU, the invention shall automatically be deemed to have been claimed after four months (§ 6(2) ArbErfG).

To assess the patentability of an invention, it is crucial to know whether or not any part of it has already been made available to the public at any time, anywhere, whether in writing, orally or through its use in the public sphere (§ 3 Patent Law). Information deficits often still exist in this context, particularly in the field of science and research. With the invention disclosure, the inventors are bound to secrecy until the invention is released by OVGU or until the patent application is filed. Any pre-publication, even if "only" as a poster at a small conference, is considered detrimental to novelty and will in any case prevent the successful filing of a patent application. Therefore, it is important to ensure that written or other publications detrimental to patent applications are avoided in advance, so please contact Dr. Karen Henning, Head of the Department of Intellectual Property Rights at TUGZ@OVGU, email: [karen.henning@ovgu.de](mailto:karen.henning@ovgu.de); Tel.: +49(0)391 67-52091, in order to avoid actions detrimental to exploitable know-how!

A comprehensive and complete description of the invention has to be appended to the invention disclosure. The contents should be divided into technical task and technical solution, which are also part of every patent application. You are obliged to provide comprehensive information on the state of the art and to append all known references to relevant literature and patents.

You should focus on what is essentially novel about your invention when describing it. Please indicate why your invention solves a specific technical problem and/or what advantages your invention has over previous developments. Lengthy unsuccessful preliminary tests as well as an explanation of the scientific basis may be included as a secondary component of the invention disclosure. Neither will form part of the core of a patent application, but may contribute towards the explanation of the invention.

Please note: As the inventor, you may consider yourself to be "above-average expert" so please describe your invention in terms appropriate for those of "average expertise"! Dispense with page-long theories about the basics of the invention and don't describe why something works; focus instead on "what you have to do to make it work".

## Joint invention / Joint inventor

If several persons are involved in the invention, it is sufficient to submit a joint invention disclosure in one form. The form developed by OVGU explicitly takes this into account. Additional inventors can easily be added using the appropriate buttons. Combining all relevant information in a single form avoids information inconsistencies. The percentage distribution of the contributions of the individual inventors to the invention is also finally recorded at this point, which avoids subsequent discussions or even arguments between the inventors.

The persons recorded in the invention disclosure also confirm that, apart from the named persons, no one else is involved in the invention as inventor. This information is required for the designation of the inventor (§ 37 Patent Law) to be filed no later than fifteen months after filing of the patent application. For a joint patent application or patent exploitation it is also absolutely necessary that all other free participating inventors or participating inventors from other institutions and companies be disclosed and included in the patent application process.

Inventors are those persons who make a substantial, inventive and independent contribution to the invention. Please only admit those persons to the circle of inventors who have made such an independent contribution. There are known cases of successfully granted patents having been subsequently revoked after competitors were able to prove that alleged inventors did not, in fact, contribute towards the invention.

## **Personal details**

The invention disclosure must include both your business and private addresses. The private address must be submitted to the respective patent office along with the inventor's name and is published together with the publication of the patent application. Furthermore, disclosing your private address should enable you to be contacted beyond the period of your employment with OVGU, which will be of benefit to doctoral students, for example. The process of exploitation can be particularly lengthy and you need to provide sufficient information to ensure the compensation to which you are entitled will reach you at a later date.

## **Order (i.e. commissioned) or experience-based invention**

Another point to be clarified is whether the invention is an order invention or an experience-based invention. It is possible that OVGU's obligations towards third-party funding providers arise pursuant through contracts or general terms and conditions, in which case, all subsequent processes of claiming, filing and exploitation would be fundamentally affected, so the current state of affairs must be determined as early as possible.

## **Claim or release of the service invention**

OVGU has a right to claim the invention, which means that all property rights of the invention would be transferred to the employer (§ 7 ArbErfG) and that the employer would be responsible for filing a patent application for the invention or alternatively for filing a utility model application if deemed appropriate on its own costs in Germany (§ 13 ArbErfG). The obligation to file an application is only waived if the employer's clear intention to refrain from filing an application for an intellectual property right is evident. We will often use patent agencies, such as ESA PVA, or external patent law firms, whose quality we are familiar with based on many years of reliable collaboration.

OVGU also has the right to file applications for accepted inventions abroad. This must be communicated to the inventors in good time. If an application for intellectual property rights is filed at any time, the inventors must be given the opportunity in good time to manage the application themselves (§ 16 ArbErfG).

In case OVGU declares that it does not wish to claim an invention, the invention in question becomes a free invention, about which the inventors may freely dispose (§ 8 ArbErfG). Likewise, inventors are expressly permitted to file foreign applications that have not been claimed, at their own expense (§ 14 ArbErfG).

## **Remuneration**

The inventors can and should look for potential users of their invention at any stage of the technical development and of the employee invention and patent law process, provided that the content or nature of the invention is not revealed. Please contact the TUGZ at any time if you become aware of any interest in your invention. If you wish to exploit the property right yourself, for example by founding your own company, you will receive further support from the TUGZ.

## Further regulations and provisions

The Employee Invention Act covers other important issues that require regulation, such as confidentiality obligations (§24 ArbErfG) or regulations that would apply in the event of termination of employment (§26 ArbErfG). It would go too far to explain these rules in detail here. You are welcome to contact us for non-binding discussions relating to specific cases.

There are extensive comments relating to employee inventions in existence. Many special positions, framework conditions and individual points are relevant to the associated legal issues. The TUGZ@OVGU, therefore, accepts no liability for the completeness and correctness of this information or for decisions taken on the basis of this brief summary.

## Further information:

- <http://www.gesetzeiminternet.de/arbnerfg/>
- <http://de.wikipedia.org/wiki/Arbeitnehmererfindung>

Contact

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