

# **Study on patent inventorship and ownership in collaborative research and cross-border collaboration (SCP/36/9)**

**Presentation by the Secretariat**

**Standing Committee on the Law of Patents**  
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# Background

- SCP/35 decision for Secretariat to prepare a *study on patent inventorship and ownership issues arising from collaborative research and cross-border collaboration, and their implications on technology transfer*
- SCP/36/9 contains the study, based on information from MS, including national and regional legislation and IPO and court decisions, as well as other sources of information

# Structure

1. Patent inventorship and ownership
2. Approaches to the issues above in collaborative research
3. Contractual management of such issues by parties to joint research projects
4. Impact on technology transfer
5. Appendix: snapshot table of the differences of rules in selected jurisdictions on the exploitation of jointly owned patents

# The mosaic of collaboration

- Research, development and innovation are increasingly collaborative
- The partners may reside in different jurisdictions
- The cross-border element is often present in such cooperations
- The organizations engaging in such projects may have different objectives, funding, obligations and policies
- Some projects involve multiple (i.e. more than 2) partners

# Types of agreements for collaborative research

- Research agreements (between research organizations and third parties)
- Grant agreements (between funding agency and beneficiaries)
- Consortium agreements
- Contract research / commissioned research agreements
- Research collaboration agreements (joint projects, future oriented)
- Material transfer agreements (MTAs)
- Confidential disclosure agreements / NDAs (also as “plug-ins”)

# Intellectual property issues in collaborative research

- **Background IP** and **Foreground IP** (and use rights of such assets)
- **Inventorship**
  - factual matter
  - definition and determination: study provides an overview of jurisdictions
  - moral rights of inventors
  - right to a patent (“original owner”)
- **Ownership** (=entitlement to file for a patent and to be the holder of a granted patent)
  - legal matter
  - distinct concept from inventorship, but linked through succession (“unbroken chain of title” requirement)
    - depends on domestic legislation, organizational IP policies, and contractual arrangements
- **Territoriality** of patent laws and independence of patents
  - rules on matters of ownership show a low degree of convergence internationally

# Legal frameworks of inventorship and ownership in collaborative research

- Collaborative research results in a **large number of actors** involved in research projects, in different roles, with different institutional backgrounds, from different jurisdictions (special emphasis on non-employer contributors)
- **Joint inventorship**: factors to determine who really can be counted as inventor
- **Joint ownership** (against the backdrop of *employee invention rules, institutional policies and contractual arrangements*): **rules governing co-ownership**
  - Mandatory rules v. default rules (susceptible to be overridden by contractual arrangements)
  - Matters of *exploitation, licensing, assignment and enforcement* (question is the need for the consent of co-owners) – see Appendix for an overview
- **Foreign filing license requirements** (triggers, obligations, and possible conflicts)

# Managing joint ownership through contracts

- Where the **statutory rules** leave room for maneuver, parties can customize their relationship (and patent ownership) via their **agreement**
- Good practice to agree on rights and responsibilities **before** the research project starts
- Selection of **governing law** (except for reserved patent law matters) and **dispute settlement** mechanisms
- **Confidentiality** and **publication** arrangements (in view of different interests or parties)
- **Joint ownership** or **transfer of rights** to one party *with license arrangements* for others (and rights for non-inventors, funders, or other financial or managerial contributors)
- Management of the right to use **background IP** by collaborators and third parties
- Governments may issue **guidelines, policies and template agreements** to assist parties



# Implications on technology transfer

- Collaborative research and cross-border cooperation needs to **manage divergences** in national laws and the parties' respective interests and objectives
- **Inventorship**: moral rights are recognized across the board; disputes often involve questions on joint inventorship
- Rules around **employee/service inventions** vary, impacting ownership
- Clear statutory rules, unambiguous contractual terms, agreed confidentiality measures and **unequivocal ownership arrangements** are conducive to a more effective sharing of knowledge and transfer of information for the sake of efficient technology transfer with spillover dissemination and commercialization effects beyond the boundaries of collaboration
- Great degree of **flexibility in customizing research agreements**, but **IP expertise** is required, in alignment with organizational strategies and priorities

Thank you for your attention.

