

The Default Rules Relating To Joint Ownership of Patents – Pitfalls for the Unwary

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ABSTRACT

The issue of joint ownership of patents is vital in relation to university entrepreneurship and startups. Since the invention, which is the subject of commercial exploitation is likely to result from a collaborative effort or joint venture with a third party, there is likelihood that any patents issued from such collaborative efforts will be jointly owned. The parties involved in such ventures may logically believe that joint ownership means that the parties will jointly control the patents and share the profits from the joint venture corresponding to contributions – or at least equally. However, in the absence of any agreement relating to the above matter, the default rules as laid down in statutes and the case law will apply. The default rules relating to the rights of joint owners of patents vary from country to country, but it has long been recognised by the courts that “joint owners are at the mercy of each other”. In an ideal world, co-owners would have arrived at an amicable agreement regarding their respective rights, interests and duties in their joint patent even before the patent is granted or obtained. However, this is not so in the real world; it is not inconceivable that parties involved in applying jointly for patents would initially be more concerned with matters directly related to the grant of the patent. They may not be aware of or appreciate the features and incidents connected with joint ownership under the default rules and, therefore, would initially not realise the importance of the need to make contractual provisions regulating the rights and relationship between themselves. This paper illustrates the default rules relating to the rights of joint owners of patents in Malaysia, the United Kingdom and the United States. Where relevant, the default positions in other countries will also be referred to. This paper aims to show that the default rules may give rise to disastrous consequences,

and concludes by stressing the importance of a carefully thought-out ownership agreement, in order to avoid the various pitfalls arising from the statutory default rules.

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INTRODUCTION

Universities are now encouraged to actively promote and engage in entrepreneurship, and to seek commercialization of the results of any research and development. Research and development projects may be conducted solely by university researchers without outside involvement, but increasingly, universities participate in collaborative research and development projects with outside bodies – be it other universities, research institutions or private enterprises. Universities team up with collaborators in their research and development process for various reasons: to obtain additional finance, expertise, or much-needed entrepreneurial skills. These collaborators include both local and foreign partners.

The output of such collaborative research could be the creation of inventions and ultimately the grant of patents. The issue then arises as to who owns the patents and what are the parties' respective rights in the patent. In a carefully thought-out collaborative research venture, the parties would have addressed all these issues in a written agreement. In such a case, it is a matter of negotiation between the parties as to who should and would own the invention and any resulting patent. The parties might ultimately agree on joint ownership as it seems a fair solution, rather than having to quibble over ownership issues. Joint ownership of a patent may also arise in

other situations, such as when more than one applicant applies for a patent, or when a patent has been jointly assigned to more than one person. It could also occur by operation of law.¹

Like any other property, the owner of a patent has the rights to exploit the patented invention, assign or transmit the patent, and to conclude license contracts.² However, in a case where the patent is jointly owned by more than one owner, the question arises as to what the respective rights of the co-owners are. Does one co-owner have the same rights as the other, and can he exercise all his rights without the concurrence of the other? The intuitive response would be a resounding "Yes". The parties to such ventures may logically believe that joint ownership means that the parties will jointly control the patents and share the profits from the joint venture in proportion to contributions or at least will share equally in such profits. However, the reality is not that simple. If the parties have carefully delineated their rights under a contract, then all is well and good. However, sometimes, through advertence or ignorance, the parties may not have agreed on the rights and obligations each co-owner should have in relation to the patent. In that case, the rights would be governed by operation of the law. This will be referred to as the "default rules" – the rules laid down by statutes and the case law. The patent statutes and case law of many countries

¹In Malaysia, through the combined effect of section 18(3) and section 20, Patents Act 1983.

²See, for example, section 36, Patents Act 1983, Malaysia and section 30, Patents Act 1977, UK.

lay down a series of acts that a co-owner may or may not do without the consent of the other co-owner/s. These default rights and obligations may not be what the parties had in mind when they agreed to joint ownership.

The default rules depend on the applicable national law. This paper illustrates the default rules relating to the rights of joint owners of patents in Malaysia, the United Kingdom and the United States. Where relevant, the default positions in other countries will also be referred to. It aims to show that the default rules may give rise to unwanted and unanticipated disastrous consequences. The paper concludes by stressing the importance of a carefully thought-out ownership agreement, which would help avoid the various pitfalls arising from the statutory default rules. Although it is appreciated that most contracts would have to be negotiated on a case-by-case basis, nevertheless there are certain pointers which must be kept in mind.

THE THEORY UNDERLYING PATENT RIGHTS

The theory underlying patent rights is important, since it gives rise to several common law rules regulating the rights of co-owners inter se in the absence of agreement, which rights have now mainly been codified in patent statutes. Two theories about the nature of patent rights have been enunciated by the courts in the various jurisdictions: the “exclusion” theory, and – for want of a better term – can be referred to as the “whole unit” theory. Under the

“exclusion” theory, a patent is viewed as a right to exclude others from the right to make, use and sell the patented invention. It is only by virtue of a patent grant that the grantee has the right to prevent others from exploiting the invention. The grant does not give a positive right to the use of the invention. Such a right already exists at common law. Because of this right of exclusion, one co-owner cannot exclude other co-owners from the use of the patent. This is because the grant allows the grantee to exclude others, but not another co-owner. Therefore, each co-owner has the right to use the patent for his own benefit.³ Under the “whole unit” theory, however, the grant

³See *Mathers v. Green* LR 1 Ch. App. 29 (1865), per Lord Cranworth L.C., at 33,

"The letters patent grant to the three, their executors, administrators, and assigns, that they and every of them by themselves, their servants and agent, or such others as they may agree with, and on no others, shall, for the term of fourteen years, use, exercise, and vend the said invention. The rights conferred are a right to exclude all the world other than the grantees from using the invention. But there is no exclusion in the letters patent of any one of the patentees. The inability of any one of the patentees to use the invention, if any such inability exists, must be sought elsewhere than in the letters patent. But there is no principle, in the absence of contract, which can prevent any persons not prohibited by statute from using any invention whatever."

In the US, see, for example, *Talbot et al. v. Quaker-State Oil Refining Company* 41 USPQ 1 (CCA 3rd Cir. 1939), per Kirkpatrick, District Judge, at 2-3:

of the patent is regarded as a grant to the patentees jointly and not to each one of them individually. Therefore, the enjoyment of the rights under the patent can only be exercised by all the patentees jointly. This would mean that any exercise of the rights without the full consent of all the owners, for example, by the grant of a license by one owner, would give the other owners a right of action against him.⁴ However, the "whole unit" theory has not found favour with the courts in the United States,⁵ and it does

"In its essence all that the Government confers by the patent is the right to exclude others from making, using or vending the invention (Crown Die and Tool Co. v. Nye Tool and Machine Works 261 US 24, 35 (US Sup. Ct. 1922), and as to this essential attribute of the property each joint owner is in a very real sense at the mercy of the other. Each of them may use or license others to use the invention without the consent of his fellows, and without responsibility to such fellows for the profits arising from such use or licence."

⁴See *Pitts v. Hall* 19 F. Cas. 758 (CC ND N.Y. 1854), *per Hall*, District Judge, at 761.

⁵See, for example, *Lalance & Grosjean Mfg. Co. v. National Enamelling & Stamping Co.* 108 F. 77 (CC S.D.N.Y. 1901), *per Coxe*, District Judge, at 77-78,

"The complainant contends ... [f]irst, that the St. Louis Company could not convey to the defendant the right to make, use and vend without the consent of the complainant; ... The first of these propositions has never been directly passed upon by the Supreme Court, but the overwhelming weight of authority in this country and in England is against the view asserted by the

not seem to have been canvassed before the United Kingdom courts. Therefore,

complainant. Indeed, but one authority is cited in its support, Pitts v. Hall, 3 Blatchf. 201, Fed. Cas. No. 11,193, decided in 1854, which has never, so far as the court has been able to ascertain, been followed in a carefully considered case. It is not thought that the learned judge ... intended to express a definitive opinion upon the question now under discussion. He considered the question an open one, but disposed of the motion upon other reasoning, which, at that stage of the litigation, appears to be unanswerable. The authorities supporting the defendant's contention are too numerous to cite, but the argument in its support will be found sufficiently stated in the following: (citation omitted) ... See, also, the recent and well-considered case of Blackledge v. Manufacturing Co. 108 Fed. 71. It is thought that a rule so generally recognised will not be disturbed, but in any view it is too firmly established and has been enforced for too long a period to be disregarded by this court."

The case of *Herring v. Gas Consumer's Association* 9 F. 556 (CC E.D. Missouri 1878), which purported to distinguish *Pitts v. Hall*, seems to lend support to the "whole unit" theory - see Treat, District Judge, at pages 556-557, where he held that even though the defendant co-owner had, by virtue of the joint ownership, the right to use the patent, but he had no right, more than a stranger, to infringe the same. Therefore, the claim by the plaintiff co-owner for his proportion of the damages for infringement of their common patent was allowed. However, this is a strange decision, containing, as such, a contradiction in terms, and was rightly criticised in *Bell & Howell Co. v. Bliss* 262 F. 131 (CCA 7th Cir. 1919), at 136 as "not at all persuasive" and "difficult to comprehend".

the weight of authority is in favour of the “exclusion” theory, with all its implications as will be discussed below.

THE RIGHTS OF CO-OWNERS UNDER THE DEFAULT RULE

The default rules established by statute or case law relating to the rights of joint owners of patents vary from country to country, but it has long been recognised by the courts that “joint owners are at the mercy of each other”⁶. In the following discussion, reference will be made to the common law position, followed by an examination of the statutory provisions in the relevant statutes. It will be seen that the default rules are substantially statutory enactment of the common law rights.

The default rule relating to the right to assign or transmit rights.

In the United States, although section 262 of US Code, Title 35, Patents, does not

deal with the issue of assignments, the case law allows a co-owner unrestricted rights to assign his full interest, or any portion of it, without the consent of the other co-owner. For example, in *Lalance & Grosjean Mfg. Co. v. National Enamelling & Stamping Co.*,⁷ a patent which was originally granted to one Hubert Claus was assigned to the complainant plaintiff and the St. Louis Stamping Company, each holding a half interest in the patent. The St. Louis Stamping Company later assigned its half interest to some other parties who duly assigned it to the defendant. When sued for infringement, the defendant asserted its right to use the patent by virtue of its half interest in the patent. The plaintiff contended that the assignment to the defendant was invalid since the assignment was made without its consent. This contention was, however, rejected by the court, holding that the overwhelming authority was that such consent was not required.

Similarly, in the Canadian case of *Forget v. Specialty Tools of Canada Inc.*,⁸ the Supreme Court of British Columbia held that the co-owner of a patent may assign his whole interest in the patent without the concurrence of any other co-owner. However, the interest of the co-owner cannot be subdivided into two or

⁶ “In its essence all that the Government confers by the patent is the right to exclude others from making, using or vending the invention [citation omitted], and as to this essential attribute of the property each joint owner is in a very real sense at the mercy of any other... [Each joint owner’s] unlimited right to license others may, for all practical purposes, destroy the monopoly and so amount to an appropriation of the whole value of the patent.”

Talbot v. Quaker-State Oil Refining Co., 104 F.2d 967 (3d Cir. 1939) at 968. See also Phillips, Chief Judge, at 252, in *Willingham, et al. v. Lawton, et al.* 194 USPQ 249 (CA 6th Cir. 1977).

⁷*Lalance & Grosjean Mfg. Co. v. National Enamelling & Stamping Co.* 108 F. 77 (CC S.D. New York, 1901), per Coxe, District Judge, at 77.

⁸*Forget v. Specialty Tools of Canada Inc.* [1993] 48 CPR (3d) 323 (Sup. Ct. of British Columbia), per Rowan J., at 638-642, applying *Mathers v. Green* LR 1 Ch. App. 29 (1865) and *Steers v. Rogers* (1893) 10 RPC 245 (HL).

more parts, nor may it be licensed without the concurrence of all the owners of the patent. This is because the subdivision of an interest in the patent by a co-owner can lead to unfair results and chaotic situations. Furthermore, if one co-owner is entitled to license a patent, the situation would allow numerous licenses to be created, thereby destroying the value of the patent of his co-owners. The court distinguished the case of *Marchand v. Peloquin*,⁹ on the ground that

⁹*Marchand v. Peloquin* [1978] 45 CPR (2d) 48 (Quebec Court of Appeal). The headnote of the case is in English but the report is in French. From the headnote it would appear that the opinion of the court was that a patent conferred a negative right in the sense that it conferred a right to exclude others from the area of the patent. Therefore, co-owners had rights which would normally be exercised together or at least for their joint benefit. The court disapproved of the English cases of *Mathers v. Green* LR 1 Ch. App. 29 (1865) and *Steers v. Rogers* (1893) 10 RPC 245 (HL) to the effect that the practical consideration of these cases was that any other conclusion would permit one patentee to prevent the use of the invention altogether, or in the alternative to risk his skill and capital on terms of being accountable for profits without having to share losses. Such consideration did not apply now because if one patentee refused to permit use of the invention, the other could get a compulsory licence as an interested person. The court further held that the result of the British cases would lead to serious inconvenience because if one patentee could give everybody a right to use the patented invention, he could sabotage the exclusivity of his co-owners. The court then noted that in Britain the case law has been overturned by statute.

With respect, it is submitted that the Court in *Marchand v. Peloquin* seems to have come to an incorrect reading of the British cases. The statutory provisions mentioned by the court above are in fact enactment of the common law

the case could have been decided under the alternative ground of contract law.

The Patents Act 1987, Malaysia, gives the right to assign or transmit the rights in the patent separately. Therefore, no consent of other co-owners is required. This is in contrast to the statutory rights under the 1977 Patents Act of the UK, where consent of all co-owners is required before a share of the patent could be assigned.¹⁰ It is, however, unclear from the Malaysian provision whether a co-owner can assign a portion only of his share in the patent.

The default rule relating to the right to exploit.

Under the common law, each co-owner has the right to exploit the patent for his own use without the consent of the other co-owners. This was so held in *Mathers v. Green*,¹¹

position. Further, there was already a provision for compulsory licences under section 22 of the Patents, Designs, and Trade Marks Act, 1883.

¹⁰See s. 36(3), Patents Act 1977, UK. This a statutory enactment of the common law position - see the case of *Horsley & Knighton's Patent* (1869) 8 L.R. Eq. 475, per Lord Romilly M.R., at 477, where it was held that neither of two joint patentees was entitled to cause to be made in the register of proprietors any entry which purported to affect or prejudice the rights of the other. See also similar provisions in section 16(1)(c), Patents Act 1990, Australia; section 50(3), Patent Act 1970, India and section 46(3), Patents Act, Chapter 221, Singapore.

¹¹*Mathers v. Green* (1865) LR 1 Ch. App. 29. A patent was granted in the joint names of the plaintiff and the two defendants. The defendants used the patent independently of the plaintiff. The plaintiff contended that the intention, at the time of taking out the patent, was that the three grantees should have a joint interest therein. Sir John Romilly M.R., at first instance, held that

where on appeal, the decision by the Master of the Rolls declaring that the plaintiff was entitled to an equal share of the profits derived by the defendant joint owner was overruled. Lord Cranworth L.C. held that in the absence of any contractual provisions to the contrary, the defendant had the right to exploit the patented invention without having to account for the profits to the other co-owner. This was because the right conferred by a patent was a right to exclude the entire world other than the grantees from using the invention. However, there was no exclusion in the letters patent of any one of the patentees.¹² The principle enunciated in *Mathers v. Green* was approved and followed by the House of Lords in *Steers v. Rogers*,¹³ where the court stressed that a

the patent was the joint property of the plaintiff and the defendants and that he was entitled to an equal share of the profits of the manufacture attributable to the invention, as well as to an equal share of the royalties arising from a licence alleged to have been granted. Therefore, the plaintiff was entitled to an account of his share of the profit derived from the defendants' use of the patent.

¹²*Mathers v. Green* LR 1 Ch. App. 29 (1865), per Lord Cranworth L.C., at 33-34.

¹³*Steers v. Rogers* (1893) 10 RPC 245 (HL), per the Lord Chancellor at 251. Lord Halsbury, Lord Macnaghten and Lord Shand concurred. Unlike *Mathers v. Green*, *Steers v. Rogers* involved a situation where the patent was not initially granted in the joint names of the plaintiff and defendant. The defendant became a joint owner by a subsequent assignment. However, the House of Lords held that this made no difference to the duty of the joint owner who worked the patent. He did not have a duty to account to the other joint owner. See also *Wapshare Tube Co., Ltd v. Hyde Imperial Rubber Co. Ltd* (1901) 18 RPC 374 (CA), per

patent, unlike other chattels, was merely a right to exclude others from using it without the consent of the owner. However, even though a co-owner can exploit the patent without consent, he must do it personally or through an agent, and not through an independent contractor. This principle was laid down in the case of *Howard & Bullough v. Tweedales & Smalley*.¹⁴

Collins L.J., at 378, applying the rule that a co-owner could work the patent without the consent of the other co-owners.

¹⁴*Howard & Bullough v. Tweedales & Smalley* (1895) 12 RPC 519. Note that the case was argued essentially on the true construction of the terms of an agreement whereby the assignor of two patents reserved to himself the right to work them personally. However, this case has been used as authority that the right to use is confined to the co-owner or his agent. The reason for this is best given by Chitty J., at 528,

"But I point out that the distinction between the servant and agents and the independent contractor is not one of mere words, or one merely of law, but it is one of very great importance, having regard to the nature of these contracts. A man who only ... employs his own servants and agents, risking his own capital and the like, in the manufacture of the patented articles, stands in a very different position from the man who can, either through himself or his friends, get others to assist him and bring them in as independent contractors. I think, as I have said, the object of the proviso was to confer rights personal to ST, and ST, acting within them, can bring whatever capital he himself has (it may be partially borrowed money) for the purpose of making, but making by himself, or his agents or servants, the articles in question. But if he can go to other persons and get them, however large the firm may be, to manufacture

The law on this aspect of the right of a co-owner is similar in the United States. In *Vose v. Singer*,¹⁵ the court held that since co-owners must be regarded as having interests which are distinct and separate in nature, “they cannot for any legal use of them incur any obligation to each other.” In *Blackledge v. Weir & Craig Mfg. Co.*,¹⁶ the court held that one co-owner has the right to exploit the invention without the consent of the others, stressing the unfairness to the enterprising co-owner if it were to be otherwise. The only case where the court held that one co-owner could be sued for infringement by another co-owner is the case of *Herring v. Gas Consumer’s Association*.¹⁷ However this

for him, that I conceive to be a very different state of things; and, therefore, this distinction, which might at first to some minds seem to be a rather subtle one and rather a refinement of law, is ... one of very great importance to the parties.”

¹⁵*Vose v. Singer* (1862) 4 Allen (Mass.) 226, at 230.

¹⁶Relying on the UK cases of *Mathers v. Green* and *Steers v. Rogers*, and the US case of *Vose v. Singer*, see *Blackledge v. Weir & Craig Mfg. Co.* 108 F. 71 (CCA 7th Cir. 1901), *per* Woods, Circuit Judge, at 73. For similar decisions, see *Clum v. Brewer* 5 F. Cas. 1097 (CC D. Mass. 1855), *per* Curtis, Circuit Justice, at page 1103; *Aspinwall Mfg. Co. v. Gill* 32 F. 697 (CC D. New Jersey, 1887), *per* Bradley J., at 702; *Drake v. Hall* 220 F. 905 (CCA 7th Cir. 1914), *per* Seaman, Circuit Judge, at page 906; *Central Brass & Stamping Co. v. Stuber* 220 F. 909 (CCA 7th Cir. 1915), *per* Kohlsaat, Circuit Judge at 911-912; *Bell & Howell Co. v. Bliss* 262 F. 131 (CCA 7th Cir. 1919), at 136.

¹⁷*Herring v. Gas Consumer’s Association* 9 F. 556 (CC E.D. Missouri, 1878), see Treat, D.J., at 556-558.

case has been criticised and regarded as not persuasive in *Bell & Howell Co. v. Bliss*.¹⁸

Therefore, it is accepted that co-owners are free to use and exploit the patent without the consent of the other co-owners, unless the patent had been vested in a trustee in trust for them. In that case, the beneficiaries cannot freely exploit the patent. To hold otherwise would be to nullify the purpose of the trust, which is to “preserve the joint property and to prevent its practical destruction by co-owners”.¹⁹

In the absence of any agreement to the contrary, section 40 of the Patents Act 1983, Malaysia provides that joint owners of a patent may separately exploit the patented invention. This right is similar to that provided by section 36(2)(a) of the Patents Act 1977, UK, which gives a co-owner the right to exploit the patented invention without the consent of the others. It has to be noted, however, that the rights of free use of the invention provided by the UK Act is exercisable (unless otherwise agreed) by the co-owner and his agent.²⁰ This reflects the common law position discussed above. The term “agent” was held by Jacob J., and not to be used in a strict sense. The patentee was entitled to exploit his invention through others. However, where an independent contractor was used by one of the joint

¹⁸*Bell & Howell Co. v. Bliss* 262 F. 131 (CCA 7th Cir. 1919).

¹⁹See *McDuffee v. Hestonville, M. & F. Pass. Ry. Co.* 162 F. 36 (CCA 3rd Cir. 1908), *per* Buffington, Circuit Judge, at 38-39; cert. denied, 23 U.S. 719; 56 L. Ed. 629 (1911).

²⁰See also similar provisions in section 16(1)(b), Patents Act 1990, Australia; section 50(2), Patent Act 1970, India and section 46(2)(a), Patents Act, Chapter 221, Singapore.

proprietors to perform an act which would be an infringement of a patent if the default rule did not apply, it must be considered whether the act was in substance licensing or use by the joint proprietor for his own benefit.²¹

There is no mention in the Malaysian Patents Act 1983 of the right to exploit the patent through the vehicle of an agency. Nevertheless, it is submitted that by virtue of agency principles, the right to exploit the patent separately can be construed as including the right to exploit through an agent, since the acts of the agent are the act of the principal. However, the right to exploit separately does not extend to having the patent exploited by a sub-contractor, or to a partner of the co-owner, and he cannot form a company to exploit the invention on his behalf. It is specifically provided in section 36(2)(a) of the Patents Act 1977, UK that the statutory right to exploit the patent without the consent of the other co-owners can be overridden by agreement. Therefore, if there is an agreement whereby one co-owner is to be responsible for the commercial exploitation of the patent, with the net profits from sales or licensing to be divided equally, the construction of the agreement may oust the right to exploit it

²¹See *Henry Brothers (Magherafelt) Ltd. v. The Ministry of Defence and the Northern Ireland Office* [1997] RPC 693, upheld by the Court of Appeal [1999] RPC 442. *William Manley Hall Dixon v. The London Small Arms Company, Limited* (1876) 1 App. Cas. 632 is an instructive case to read in relation to the concept of when a contractor to manufacture and supply is to be regarded as an agent or an independent contractor.

personally without having to account for any profits.²²

The position is the same in the United States. Section 262 of Title 35, Patent provides that “In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the US, or import the patented invention into the US, without the consent of and without accounting to the other owners.”

The default rule relating to the duty to account

There is also no duty on the part of one co-owner to account to the other owners for any gains derived from his use of a jointly held patent. This was held to be so in *Mathers v. Green*,²³ where besides declaring that one joint owner could exploit the invention without the permission of the others, the court also rejected the contention that if the joint right of the patentees was conceded, the only mode of making it effectual was to give them a joint interest in the profits. Lord Cranworth held that in the absence of any contractual provisions to the contrary, the defendant had the right to exploit the patented invention without having to account for the profits to the other co-owners. The above principle with regards to the non-obligation to account to the other owners was adopted by the House of Lords in *Steers v. Rogers*.²⁴

²²See, for example, *Young v. Wilson* (1955) 72 RPC 351.

²³*Mathers v. Green* LR 1 Ch. App. 29 (1865).

²⁴*Steers v. Rogers* (1893) 10 RPC 245 (HL), at 251, *per* Lord Herschell L.C.,

In an early case in the United States, it was tentatively stated that one co-owner may have to account to the others for any profit derived from use of the patent. However, the statement was made obiter and the judge was at pains to stress that it was a mere speculation.²⁵ The contrary rule has now been firmly established.²⁶ It is pertinent

to note that the reason given for denying the other co-owner a right to a share of the profits derived by one co-owner was that it would result in one co-owner having to risk his skill and capital and the other co-owner the right to a share of the profits without a corresponding duty to contribute towards any risk.²⁷

"In the case of Mathers v. Green ... it was held that where a patent for an invention is granted to two or more persons, each one of them may use the invention without the consent of the others, and if he so uses it is not bound to account to the others for any share of the profits which he makes by its use. ... Now, ... counsel for the appellant maintained ... that that decision was not good law; but it appears to me to be both good law and good sense when the nature of patent rights is regarded. ... What the letters patent confer is the right to exclude others from manufacturing in a particular way and using a particular invention. When that is borne in mind it appears to me ... very clear that it would be impossible to hold, under these circumstances, that where there are several patentees, either of them, if he uses the patent, can be called upon by the others to pay to them a portion of the profits which he makes by that manufacture, because they are all of them entitled, or perhaps any of them entitled, to prevent the rest of the world from using it."

"The use of an invention by one of co-owners or by his licensees is not the exercise of the entire monopoly conferred by the patent. That can be effected only by the joint or concurrent action of all owners. The separate action of any one owner or of his licensees can be an exercise or use only of his individual right, which, though exclusive of all besides, is not exclusive of the other patentees, their assignees or licensees. On principle, therefore, there can be no accountability on the part of a part owner of an invention to other owners for profits made by the exercise of his individual right, whether it be by engaging in the manufacture and sale, or by granting to others licenses, or by assigning interests in the patent. His use of the invention in any lawful way is not an appropriation of anything which belongs to another. The separate rights of the other owners remain unaffected. They are equally free to use the invention in all legitimate ways for their individual profit. Each is entitled to the fruits of his endeavours, taking no risk and expecting no reward from enterprises in which he does not choose to join."

²⁵*Aspinwall Mfg. Co. v. Gill* 32 F. 697 (CC D. New Jersey, 1887), per Justice Bradley, at 702; appeal dismissed with cost, 40 US 669; 35 L. Ed. 597 (1891).

²⁶See, for example, *Vose v. Singer* (1862) 4 Allen (Mass.) 226, 230, and *Blackledge v. Weir & Craig Mfg. Co.* 108 F. 71 (CCA 7th Cir. 1901), per Woods, Circuit Judge,

²⁷See *Mathers v. Green* (1865) LR 1 Ch. App. 29, per Lord Cranworth, at 34,

"Is there any implied contract where two or more persons jointly obtain letters patent that no one of them shall

use the invention without the consent of the others, or if he does, that he shall use it for their joint benefit? I can discover no principle for such a doctrine. It would enable one of two patentees either to prevent the use of the invention altogether, or else to compel the other patentee to risk his skill and capital in the use of the invention on the terms of being accountable for half the profit, if profit should be made, without being able to call on his co-patentee for contribution if there should be loss."

see also *Vose v. Singer* (1862) 4 Allen (Mass.) 226, at page 230,

"It is difficult to see how an equitable right of contribution can exist among any of them, unless it includes all the parties interested and extends through the whole term of the patent right; and if there be a claim for contribution of profits, there should also be a correlative claim for losses, and an obligation upon each party to use due diligence in making his interest profitable. It is not and cannot be contended that these parties are co-partners; but the idea of mutual contribution for profits and losses would require even more than co-partnership. Nothing short of the relation of stockholders in a joint-stock company would meet the exigencies of parties whose interests may be thus transferred and subdivided. But even as between the original parties, as there was no mutual obligation to contribute for losses, or to use any diligence to make the property profitable, and as each party was at liberty to buy, use, and sell machines at his pleasure, and to sell his moiety of the right, or fractional

It is not clear from the Malaysian Patents Act 1983 whether there is a duty to account to the other co-owners for any profit derived from individual exploitation by a co-owner. The Act is silent on this, unlike the provision of section 36(2)(a) of the Patents Act 1977, UK, where the duty to account is excluded, as the provision specifically states that a co-owner can exploit the patented invention "for his own benefit and without ... the need to account to the other or others".²⁸ Section 262 of the US Patent Act also provides specifically that each co-owner has the right to exploit the patented invention without accounting to the other owners. Again, both these statutory provisions are mere reflections of the common law position. In relation to the duty to account in Malaysia, it would seem that having given the co-owners a right to separate exploitation of the patented invention without any conditions imposed, there may also not be a need to account.

parts of it, we think no obligation arose out of the part ownership, as being legally or equitably incident to it, to make contribution of profits. ... If the defendants have realised any profit in the manner alleged, it has been by investing capital in the purchase of machines, and the use of skill and labour in selling them; and they have taken the risk of losses."

²⁸See also section 16(1)(b), Patents Act 1990 Australia, section 50(2), Patent Act 1970, India and section 46(2)(a), Patents Act, Chapter 221, Singapore, which are in the same vein.

The default rule relating to the right to license.

In *Horsley & Knighton's Patent*,²⁹ one of two co-owners purported to assign by deed his share and interest in a patent, and by the same deed purported to release him from all claims by both the co-owners in respect of the patent. This deed was entered verbatim on the register. The court allowed an application by the other co-owner to have the entry expunged, as one co-owner could not dispose of the right of the other. From the opinion, it would seem that a valid license could only be granted by the acts of both co-owners. However, the Court of Appeal in *Wapshare Tube Co., Ltd v. Hyde Imperial Rubber Co. Ltd*³⁰ seemed to have implied

²⁹*Horsley & Knighton's Patent* (1869) 8 L.R. Eq. 475, 477, per Lord Romilly M.R.,

"Here is a patent granted to two persons, and therefore either of them may use it, but neither can dispose of the right of the other. ... Again, suppose a patent is vested in two persons who are both using it, and a man infringes the patent, upon which they both complain, and a large sum of money is paid to one of them by the infringer to be allowed to make use of the patent, is it meant to be said that he can immediately release all the rights which the other person may have for the injury he has sustained by reason of the user of the patent?"

³⁰*Wapshare Tube Co., Ltd v. Hyde Imperial Rubber Co. Ltd* (1901) 18 RPC 374 (CA). However, it has to be noted that this expression of the law was *obiter*, since the court had come to a conclusion that the defendants could not be sued as their claim to a legal title to a part share of the patent had been made out - see Collins L.J., at 377-378.

that such consent from all co-owners was not necessary.

The common law position in the United Kingdom is thus unclear. However, it is submitted that the reasoning of the court in *Horsley* is more in consonance with the principle of licensing, which is not a transfer of patent rights, but merely an agreement not to sue the licensee in respect of activities which fall within the license. The licensor, by the license, gives up his right to sue for infringement. However, this agreement does not bind the other co-owner, who, therefore, still retains the right to sue the alleged licensee. This is in accord with the accepted rule in personal property whereby, in the basic case of *Wilkinson v. Haygarth*,³¹ the judge held that one of two co-owners of a chattel could sue, giving the reason that "otherwise the license of one would bind both".

It is interesting to note that, although purporting to follow United Kingdom precedents, and hence showing consistency with respect to the other rights of a co-owner, with regards to the right to license, the US courts have shown a significant divergence from the United Kingdom precedents. In *Blackledge v. Weir & Craig Mfg. Co.*,³² the court, although relying on the

³¹*Wilkinson v. Haygarth* (1847) 12 QB 85; 116 ER 1085, 1090, per Lord Denman C.J.

³²*Blackledge v. Weir & Craig Mfg. Co.* 108 F. 71 (CCA 7th Cir. 1901), per Woods, Circuit Judge at 75-77,

"There is ... no ground for the distinction insisted upon between profits derived directly from the manufacture, use, and sale of the patented article by the owner and profits derived by him from

the sale of licenses. It is conceded that the part owner of an invention may sell his title or interest as a whole or in parts without being accountable to another owner for any portion of the consideration received. But it is clear that he might part with his entire title or interest by granting a license or licenses in terms which should forbid further licenses and further use by himself of the invention."

See also the earlier case of *Clum v. Brewer* 5 F. Cas. 1097 (CC D. Mass. 1855), *per* Curtis, Circuit Justice, at 1103,

"One tenant in common has as good right to use, and to license third persons to use the thing patented, as the other tenant in common has. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract modifying the rights which belong to them, as tenants in common."

Similar decisions were reached by the court in *Central Brass & Stamping Co. v. Stuber* 220 F. 909 (CCA 7th Cir. 1915); *Drake v. Hall*, 220 Fed. 905 (CCA 7th Cir. 1914), *per* Kohlsaas, Circuit Judge at 911-912,

"As owner of a one-half interest in the patent, appellant had no standing to restrain appellees from manufacturing under their ownership of the other one-half thereof, or from authorising others to do so."

Aberdeen Hosiery Mills Co. v. Kaufman 96 USPQ 133 (D.N.Y. 1953), following *Talbot v. Quaker State Oil Refinery* 41 USPQ 1 (CCA 3rd Cir. 1939), *per* Leibell, District Judge, at 143,

"Although it is true that Kayser, as an owner of an undivided interest in the patent, had the right to issue licences on its own volition and without the consent of the other defendants ... the

United Kingdom cases of *Mathers v. Green* and *Steers v. Rogers*, and also the US case of *Vose v. Singer*, held that one co-owner has the right to license the invention without the consent of the others. This approach has been consistently applied.³³ However, this right to license does not extend to the granting of an exclusive license by one of the co-owners without the consent of the other owner or owners.³⁴ The case of *Ethicon, Inc. v. United States Surgical Corporation* which involved collaboration on a joint venture research is illustrative.³⁵ One of the collaborators, a Dr. Yoon, filed for a patent and named himself as the sole inventor. Dr. Yoon then granted an exclusive license to Ethicon, who commenced an infringement action against the defendant, US Surgical Corporation. After the infringement action was initiated, the defendant discovered that there was a second unnamed co-inventor, Dr. Choi. United States Surgical then obtained from Dr. Choi a "retroactive license" to

fact remains that there was an explicit authorisation from both Standard and Kaufman to act in their behalf in Kayser's licensing activities."

See also *Bendix Aviation Corp. v. Kury* 84 USPQ 189 (D.N.Y. 1950), *per* Byers, District Judge, at 192-193, where he reviewed the cases.

³³See, for example, *Talbot v. Quaker State Oil Refining Co.* 104 F.2d 967, 968 (3d Cir. 1939), *Schering Corp. v. Roussel-UCLAF SA*, 104 F.3d 341, 345-47 (Fed. Cir. 1997) and *Ethicon, Inc. v. United States Surgical Corp.* 135 F.3d 1456, 1468 (Fed. Cir. 1998).

³⁴See *Moore v. Marsh*, 74 U.S. (7 Wall) 515, 522 (1868).

³⁵*Ethicon, Inc. v. United States Surgical Corp.* 135 F.3d 1456 (Fed. Cir. 1998), *per* Rader, Circuit Judge at 1467-1468

practise the invention. The Court granted United States Surgical's motion to correct inventorship of the patent to include Dr. Choi as a joint inventor. United States Surgical then moved for dismissal of the infringement suit, arguing that Dr. Choi, as a joint owner of the patent, had granted it a valid license under the patent. The Federal Circuit Court of Appeals upheld the district court's ruling in favor of US Surgical and against Ethicon. The Court held that since the defendant had obtained a license from one of the co-owners, the issue of infringement does not arise.

In Malaysia, section 40 of the Patents Act 1983 provides that in the absence of any agreement to the contrary, a co-owner may only jointly conclude a license contract. This means that one co-owner cannot conclude a license contract without the consent of the other co-owner or owners. The position is the same in the United Kingdom, Australia and Canada.³⁶

The default rule relating to the right to commence legal proceedings.

Flowing from the "exclusion" theory and the theory that each co-owner holds his share separate and distinct from the other co-owners, the courts in the UK have held that

³⁶See section 36(3)(b), Patents Act 1977, UK, and section 16(1)(c), Patents Act 1990, Australia. For Canada, see *Forget v. Specialty Tools of Canada Inc.* [1993] 48 CPR (3d) 323 (Sup. Ct. British Columbia). See also similar provisions in section 50(3) Patents Act 1970, India and section 46(3), Patents Act Chapter 221, Singapore and Article 73(3), Patent Law, Japan.

one owner can institute an infringement suit against infringers without the consent of, or the need to join, the other co-owners. In *Sheehan v. Great Eastern Railway Co.*,³⁷ the plaintiff sued the defendants for an account of profit made by them, and for royalties alleged to be due from them for the use of a patent taken out by the plaintiff. The defendants objected that the plaintiff could not sue alone and that he ought to have made his co-owners parties to the action. The court held, however, that a person interested in a patent was entitled to sue, without making his co-owners parties to the action.³⁸ In *Turner v. Bowman*,³⁹ the plaintiff, one of two co-owners of a patent, was able to

³⁷*Sheehan v. Great Eastern Railway Co.* (1880-1881) 16 Ch. D. 59, *per Malin, V.C.*, at 62-63, relying on Mr Justice Lindley's book on Partnership (4th Ed. vol. 1, pp 68,69), *Dent v. Turpin* 2 J. & H. 139 (trade marks case).

³⁸Note that for the defendants, it was argued that it was stated in the claim that the plaintiff had parted with shares in the patent to several persons, and the utmost claim that he had amounted to no more than one-sixth of the patent, the other five-sixth of the patent having been parted with. If the plaintiff now succeeded in obtaining any royalties for the use of his invention, they would not belong to him, but to others as well, who would be obliged to take proceedings to recover the amount of the shares due to them, and if the plaintiff should not succeed in getting a decree, then the owners of the other five-sixth would be able to proceed against the defendants. They were, therefore, liable to be harassed by other persons who were not before the court. Hence, they argued that the action was not properly constituted, and that all the persons interested in the patent ought to be made parties.

³⁹*Turner v. Bowman* (1924) 42 RPC 29, *per Astbury J.*, at 41.

proceed in his infringement suit without any objection, although an inquiry as to damages was ordered to be stood over in order that all the co-owners could be before the court. As to the right to recover damages, it would appear that each co-owner is only entitled to recover damages in proportion to the share of the patent owned by him.⁴⁰

The opposite approach, however, has been adopted in the United States. The rationale for it is explained in *Willingham, et al. v. Lawton, et al.*,⁴¹ where the principal issue was whether the owner of a two-thirds undivided interest in a patent could maintain an action for infringement without the voluntary joinder of the other co-owner. The court gave three reasons for the rule that all co-owners should be joined in a patent infringement suit, i.e., the interest of a co-owner in being able to license third-parties under his or her patent without harassing suits by other co-owners; the interest of a co-owner in avoiding the estoppel effect of a judgment declaring the patent invalid in which he or she did not participate; and the interest of a defendant in avoiding multiple suits concerning infringement of the same patent. The court, however, held

⁴⁰However, in *Smith v. The London & North Western Railway Co.* (1853) Macr 203; 6 HPC 926, the court held that where two persons were tenants in common of a patent assigned to them, and if one of the co-owner died, actions for infringements committed in the deceased's lifetime survived to the surviving co-owner, who was entitled at law to recover the whole damage. See Lord Campbell, Macr 203, at 207 (6 HPC 926, at 930).

⁴¹*Willingham, et al. v. Lawton, et al.* 194 USPQ 249 (CA 6th Cir. 1977), per Phillips, Chief Judge, at 252-253.

that co-owners could, by contract, waive their rights to be joined as co-plaintiffs. In *Ethicon, Inc. v. United States Surgical Corp.*,⁴² the Court of Appeal for the Federal Circuit again confirmed the principle that all patent co-owners must join as plaintiffs in an infringement suit. The effect of this ruling is that one co-owner can stop another co-owner from suing infringers by refusing to join in the legal proceedings. The non-consenting co-owner can take advantage of the situation by the simple device of offering a non-exclusive license to the putative infringer to stymie any attempt by the other co-owner to enforce the jointly held patent, as vividly illustrated in the *Ethicon* case above.

Under the Malaysian Patents Act 1983, one of several co-owners may sue separately. There is nothing in the Act indicating whether, if the other co-owners refuse to join in the action, they should be made nominal co-defendants. This is clearly spelled out in the United Kingdom Act. Under section 66(2) of the 1977 Act of the UK, one of two or more joint proprietors of a patent may bring an action for infringement of the patent without the concurrence of the others. However, the other co-owners must be made parties to the proceedings, either as plaintiffs or nominal defendants.

⁴²*Ethicon, Inc. v. United States Surgical Corp.* 135 F.3d 1456 (Fed. Cir. 1998), per Rader, Circuit Judge at 1468. See also *International Nutrition Co. v. Horphag*, 257 F.3d 1324 (Fed. Cir. 2001) and *Israel Bio-Engineering Project v. Amgen, Inc.*, 475 F.3d 1256, 81 USPQ2d 1558 (Fed. Cir. 2007).

THE PITFALLS

From the discussion above, it can be seen that if the parties are silent regarding their rights and obligations under a jointly held patent, the default rules will apply. This may have consequences which may not be foreseen or desired by the co-owners. Take the case of a joint venture research between University A and Company X. The research agreement provides that any invention and patent resulting from the joint venture will belong to both parties jointly. Nothing else is laid down regarding their specific rights in the patent. Depending on the law of the jurisdiction relied upon, the potential problems associated with the default rules relating to joint ownership of a patent are as described below:

Exploitation of the invention:

In principle, both University A and Company X, if they are unable to come to any agreement, could manufacture and sell competing products. However, the reality of the situation may be that Company X, with its financial and manufacturing capacity, will be in a better position to exploit the patent without the consent of University A. Obviously, University A would also be able to exploit the patent without the consent of Company X. However, from a practical point of view, without any in-house manufacturing capacity of its own, this right is meaningless. This applies whether the governing law relating to the patent is the law of the United Kingdom, United States or Malaysia.

Sharing of profits:

To compound the inequities further, Company X does not have to share the profits obtained from commercializing the patent with University A. The end result is that Company X will be able to generate profits from the jointly owned patented invention, without having to share the profits with University A. University A may end up with nothing but the entitlement to a hollow claim that it is a joint owner of a particular patent. The consequence is the same whether the applicable law is that of Malaysia, the United Kingdom or the United States.

Licensing:

Both in Malaysia and the United Kingdom, University A will not be able to solve the problem above by the device of licensing its rights to another entity to commercialize the patented invention. In both these countries, any grant of a license must be with the consent of all co-owners, in this case, University A and Company X. It is highly unlikely that Company X, having exploited the patented invention itself, will consent to the grant of a license to a potential competitor.⁴³

⁴³Note that under sections 37(1)(c) and 37(2)(c) of the Patents Act 1977, UK, power is given to the Comptroller, upon a reference made to him, to decide on the question of whether a licence should be granted where there is a deadlock between the co-owners. Similar powers are found in section 47, Patents Act Chapter 221, Singapore and section 51, Patents Act 1970, India. However, besides the legal expenses and time involved, there are many other disadvantages when relying on these provisions to resolve deadlocks – see Yang, Joseph (2003)

The situation regarding licensing is different if the applicable law is that of the United States. Here, each co-owner may grant a non-exclusive license without the consent of the other, and without having to pay the other co-owners any of the monies received. Here, again, the lack of experience and industry connections may result in University A being at a disadvantage. Furthermore, the inability to grant an exclusive license may result in potential third parties' hesitance to enter into any licensing contracts when it is a known fact that they would not have exclusive rights to commercialize inventions, and on top of that, could potentially be subject to competition from others.

Assignment of share of patent:

Assuming University A is unhappy with the situation above, can it attempt to sell off its share in the patent to a third party? Based on the default rule in the United Kingdom, University A would be unable to assign its share unless Company X agrees to the transfer. Company X would likely be unwilling to consent, as the result of such a decision would mean that a potential competitor would co-own the patent, possibly to Company X's disadvantage because of the default rule.

University A may now be caught without any recourse except to sell its share in the jointly-owned patent to Company X, if at all Company X is willing to buy from

'Enforcement of jointly owned IP rights: traps for the unwary', available at <http://www.accessmylibrary.com/article-1G1-111694272/enforcement-jointly-owned-ip.html>.

University A. Being in an advantageous position because of the default rules, Company X may not consent to buying out University X's share in the patent – there is no reason to do so.

The situation, however, is different in Malaysia and the United States. In both these countries, University A may be able to assign its share in the patent without the consent of Company X. This may result in a lose-lose situation, where both University A and Company X end up worse off.

Suits against infringers:

If the applicable law of the contract is that of Malaysia or the United Kingdom, University A may institute legal proceedings against any infringer of the jointly held patent without the consent of Company X. However, if the applicable law of the contract is that of the United States, University A can institute a patent infringement action only if Company X agrees to be joined in the action. This could result in infringers being left unpunished, or leads to an unfair situation where one party benefits from the infringement. This scenario would arise, for example, if Company X were to grant a license to the infringer in return for payment of royalties. As mentioned earlier, University A will not be entitled to a percentage of the royalties paid to Company X.

WHAT SHOULD BE DONE TO AVOID THE PITFALLS

Joint ownership of a patent is usually not recommended because of the problems mentioned above. However, if the parties

feel that joint ownership is necessary, or if one party insists on it, several steps can be taken to ensure that pitfalls are avoided. The most important thing to keep in mind is that an agreement to jointly own a patent without more is a recipe for disaster. Hence, the respective rights and obligations of the parties associated with the patent must be clearly and specifically spelled out in the agreement. In other words, there is a need to modify the default rules to reflect the intentions and wishes of the co-owners so that one party is not at a disadvantageous position. More importantly, such a contractual agreement will prevent the application and unwanted consequences of the default rules. The terms that should be considered and agreed upon should relate at least to the following:

- Who should have the right of exploitation
- What are the rules relating to the assignment of one of the co-owner's share in the patent
- Should a partial assignment be allowed?
- Should there be a right of pre-emption, at a fair market value?
- The right to use the patented invention for future Research and Development
- The right to share in the profits
- The basis for sharing of profits – the division and percentage of profits must be spelled out, regardless of which party exploits the patent.
- Who should have the right to license?
- What percentage of the royalties paid under the license should each party have

- Legal proceedings – who has the right to institute legal proceedings, rules as to contribution to expenses, division of damages awarded in any successful actions
- Choice of law clause
- Responsibility for maintenance of the patent

Another viable option is for the parties to agree for any patents resulting from the joint collaboration to be assigned to a company to be set up and owned by the joint collaborators. The rights of members of the company will have to be carefully set out in the articles of association of the company. The company, being the sole owner of the patent will then be in a position to exploit the invention itself, license others or bring infringement proceedings without the need to obtain consent from anybody else. Whatever profits gained by the company will then be divided among the members in accordance with the articles of association.

CONCLUSION

The issue of joint ownership of patents is vitally important in relation to university entrepreneurship and startups. Since the invention, which is the subject of commercial explication, is likely to result from a collaborative effort or joint venture with a third party, there is a high likelihood that any patent issued from such collaborations will be jointly owned. In the absence of agreement to the contrary, the default rules, with all its pitfalls, apply. The consequences of joint ownership need to be carefully

considered; as such ownership arrangements may bring about inequitable and unequal results. The default position becomes even more complicated when patents are obtained in different jurisdictions, each with its own default rules. Thus, the rights of joint owners will need to be specifically spelled out in the agreement to ensure that unintended consequences are avoided. To be forewarned is to be forearmed. Awareness of the default rules relating to joint ownership of patents will enable parties in joint collaborations to insert provisions regulating their rights and obligations to the exclusion of any undesirable default rules, resulting in a win-win situation.

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