

EMPLOYERS, EMPLOYEES,
and
INTELLECTUAL PROPERTY RIGHTS

**Intellectual Property Assignment Agreements:
Are there any limits on these “Brain Trust Mortgages?”**

Prepared by: John P. McNeill
Law Office of John P. McNeill, P.C.
Admitted in North Carolina and Virginia
Cary, North Carolina 27519 USA
john@jpmpe-law.com

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INTRODUCTION

Intellectual property assignment agreements (perhaps more frequently called Invention Assignment Agreements) are critical to many businesses today where a strong intellectual property portfolio may be a company's most important asset. While there are some general principles that address ownership of intellectual property, most companies still prefer that their employees sign an explicit agreement transferring rights and ownership of intellectual property to the company.

There is, however, a tendency to draft extremely broad intellectual property assignment provisions, granting the employer ownership of *all* intellectual property developed by the employee during the term of his or her employment, and in many cases for a period of time even after employment ends, regardless of the applicability of the intellectual property to the employer's business. As an extreme example, we likely all have seen some variant on the following provision: "You agree that XYZ Company owns everything that comes out of or crosses your brain whether before, during, or after the term of your employment with XYZ Company *ad infinitum*." Maybe I'm exaggerating a little about this type of "Brain Trust Mortgage" provision, but you get the point. Actually, (if we are honest with ourselves) many of us that practice in this area have probably drafted provisions with similar language. (Note from author: By the way, that is neither a confession nor an admission; just an observation based on some agreements I have reviewed over the years.) In fact, while slightly off-topic, I have even observed intellectual property ownership provisions trying to sneak their way into non-disclosure agreements between prospective "business partners."

While it is understandable that an employer desires to capitalize and benefit from its investment in its employees, such broad IP ownership provisions may pose legal problems when an employer tries to enforce an overly broad or overreaching agreement. Thus, such broadly worded agreements should be avoided. Unfortunately, careful scrutiny of these intellectual property assignment agreements is frequently overlooked. As you will see in this paper, many times these agreements are subject to both federal (national) and state law resulting in different legal standards and requirements for an employer that has employees across multiple states and for multinational companies that have employees in multiple countries. In addition, these issues are typically governed by a particular jurisdiction's employment law, or its intellectual property law, or both. As a result, the employment lawyers think these agreements come under intellectual property law and the intellectual property lawyers think they are covered under employment law. Consequently, no one gives these agreements the attention they deserve and such agreements certainly should not be drafted as the "one size fits all" variety. The reality is these agreements are covered by principles of intellectual property law, *and* employment law, *and* constitutional law, *and* federal (or national) law, *and* state law, *and* questions of public policy.

This paper looks at how the following issues regarding ownership and assignment of intellectual property are addressed in various jurisdictions:

- a. Who generally owns the IP asset when it is created?
- b. Under what circumstances is the general rule different in the employer-employee context?
- c. What if an independent contractor develops the IP asset? What are the rules between independent contractors and hiring parties?
- d. If applicable, how does the jurisdiction deal with moral rights?
- e. Are there any limitations on what an employee (or independent contractor) can be required to transfer to the employer/hiring party? In other words, are there any limits on overly broad or overreaching intellectual property assignment agreements?

This paper is limited to addressing issues for patent and copyright law. Issues relating to trade secrets are generally covered by confidentiality and non-competition agreements, and raise issues that are significantly different from the issues related to the development, creation, and ownership of patent and copyright rights. Similarly, the issues that might arise with respect to trademarks, service marks, trade dress, domain names, and other types of intellectual property are also quite different. (NOTE: Discussion of trademark ownership and assignment issues added as part of second update.)

Because there are multiple categories of intellectual property it is important to exercise care when drafting intellectual property assignment agreements. As mentioned above, many of these agreements are entitled “Invention Assignment Agreement,” but actually cover more than just inventions/patents or, maybe worse, only cover patents. The first thing you might want to check in the agreement is the definition of “Invention.” Is the agreement intended to cover only patents and patentable subject matter or is it intended to be broader and cover other or all types of intellectual property, including copyright works, trademarks, service marks, industrial designs, trade secrets, and so on? Does the agreement treat all IP equally or does it distinguish among the different types and the differing ownership rights that attach to each type of intellectual property?

Many countries have well-established and uniform national doctrines regarding the division of employer and employee rights in inventions and copyrighted works. With respect to overreaching, a number of countries have national laws that prohibit any changes to an employee’s rights by contract. For example, see the “No Overreaching Provisions” sections of this paper for Brazil, Finland, Germany, and Japan, as well as others. Note, however, that Europe may now be starting to experience some uniformity issues as EU member countries navigate the delicate balance that exists between existing national laws and EU legislation.

On the other hand, the United States is much less uniform. I already mentioned that there are some general principles of U.S. law that apply to ownership of intellectual property, but application of those rules, including any limitations on overreaching, is generally left to the individual states. With respect to the overreaching issue, there are only eight states that have statutes imposing a limit on the reach of employer with respect to ownership of intellectual property developed by an employee. Those states are California, Delaware, Illinois, Kansas, Minnesota, North Carolina, Utah, and Washington. These statutes were passed at various times between 1977 (Minnesota was the first) and 1989, but no other states have followed. But even a close reading of these statutes shows how limited the protection for employees is. First, each statute only applies to a provision contained in an “employment agreement.” Does that mean an employer can avoid the overreaching limitations simply by having an employee sign a *separate* IP assignment agreement (along with adequate consideration and other contract legalities, of course). Second, with the exception of Utah, each statute applies only to inventions/patents. As mentioned above, that leaves many other types of IP assets that are not covered.

Currently this paper covers 60 of the 197 countries, 19 of the 52 jurisdictions in the United States, and the European Union. Additionally, some of the information for a number of jurisdictions is relatively thin, so there is still work to be done. There are still many countries or states that are not covered or where additional information may be needed. I am hoping this becomes a living document that will grow over time and that more people will contribute material to help fill the gaps or correct errors (articles, cases, legislative updates, and the like). Please send any additions or corrections to me at john@jpmc-law.com and I will update this document periodically as the quality or amount of new material warrants a revision.

Finally, an excellent place to check pending information in various jurisdictions can be found on the www.gettingthedealthrough.com website. The last question for each one of the Practice Areas is “Updates and trends.” This typically provides information on anticipated changes, pending legislation, and upcoming court decisions.

I hope you find this document useful. I enjoyed pulling it together and learned a lot in the process. I look forward to hearing from friends, both old and new, as we all work together to make this a more useful tool in our practices.

Thank you,

John McNeill
john@jpmc-law.com

And lastly, the obligatory legal disclaimer: The contents and comments contained in this paper do not constitute a legal opinion or legal advice and should not be regarded as a substitute for seeking legal advice from your own legal advisor.

First Update, August 2011

Second Update, November 2011

This update added some information on 18 countries not previously covered and also added new coverage for trademark ownership and assignment in 51 jurisdictions.

Third Update, February 2015

Made minor corrections and updates.

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A very special thank you to Law Business Research Ltd. (gettingthedealthrough.com), the International Association for the Protection of Intellectual Property (aippa.org), the World Intellectual Property Organization (WIPO) for allowing the use of their excellent and extensive materials, and to each of the individual contributors noted throughout this paper, without any of whom this document would not have been possible.

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SECTION 1

AROUND THE WORLD

ANGOLA

Trademarks

Ownership of marks: Who may apply?

Any person (individual, firm, or body corporate) that has a legitimate interest may apply for the registration of a mark. Foreigners may apply for registration provided that a proof of their activity in their home country is produced upon filing the application in Angola. This proof may consist of a certificate of incorporation of the applicant or extract from the Commercial Register.

Assignment: What can be assigned?

A registered mark may be assigned with or without the goodwill of the business. An assignment is to be registered in order to be effective as against third parties.

Assignment documentation: What documents are required for assignment and what form must they take?

The requirements for registration of an assignment are the following:

- deed of assignment in Portuguese, signed by the assignor and the assignee, and notarised and legalised by the consul of Angola; and
- power of attorney in Portuguese, signed by the assignee, and notarised and legalised by the consul of Angola.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required in order to be valid.

-- from gettingthedealthrough.com (Trademarks 2011, Angola, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=AO> >

ARGENTINA

Labour & Employment

Sections 82 and 83 of the ECA (Employment Contract Act No. 20,744) deal with the employee's inventions and intellectual property rights. It states that the employee owns his or her inventions, even if the employer's instruments were used to create the invention. The employer has a pre-emption right if the employee decides to transfer or sell the invention.

Employee's inventions derived from the employer's industrial procedures, methods or installations, as well as experiments with or improvements of the ones in existence belong to the employer.

Inventions belong to the employer if they are for the purpose or object of the employment contract.

-- from gettingthedealthrough.com (Labour & Employment 2010, Argentina, Ques #28)

Patent

Article 10 of the Patent Law, following local labour law, establishes that employers own the inventions of employees hired for such purposes (or directly related), but that the latter have a right to be additionally compensated if their personal contribution highly exceeds the object of the labour relationship, including the

disposition of the means for achieving the invention. Said article includes other relevant measures, such as a mechanism for the Patent Office to set the due compensation, which has not yet been used. Following local labour law, *some of these regulations would prevail over the private agreement of the parties*.

In cases of multiple-related inventors, the inventors own a patent in equal shares unless otherwise agreed.

Transfer of patent ownership must be recorded with the Patent Office in order to be opposed to third parties and the document must include signatures of the parties, legalisation and a domicile within the City of Buenos Aires.

-- from gettingthedealthrough.com (Patents 2011, Argentina, Ques. #15)

Articles 8 to 10 of the Patent Law of Argentina

< http://www.jpo.go.jp/shiryuu_e/s_sonota_e/fips_e/pdf/argentine_e/e_tokkyo.pdf > address rights to inventions made in the course of employment relations.

Trademarks

Ownership of marks: Who may apply?

Trademarks are specifically governed by Law No. 22,362 on Trademarks and Designations (the TML), which entered into force in 1981, its implementing Decree No. 558/81, and Decree No. 1,141/03. The country is also a party to:

- the Paris Convention on Industrial Property Protection, adopted by Law No. 17,011 (and the Stockholm Act, adopted by Law No. 22,195);
- the General Agreement on Tariffs and Trade (GATT);
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs, adopted by Law No. 24,425); and
- the Ninth Edition of the Nice Classification.

To complete the legal framework, the rules of the Civil, Commercial and Penal Codes apply in particular to situations connected with moral principles and good practice.

Trademarks may be applied by any person, individual or corporation, whether national or foreign, who has a legitimate interest. Legitimate interest must be proven only in the event that someone opposes the registration.

A special address within the city of Buenos Aires has to be stipulated in the application form to establish jurisdiction for legal notices to be served in connection with registration proceedings and any lapse of the trademark.

Trademarks may be registered jointly by two or more persons, who must also act jointly when licensing, transferring and renewing the trademark (article 9 TML).

Trademark ownership and exclusive property rights to the trademark are granted through registration, as the TML sets forth the attributive system. The owner is entitled to license the trademark, sell it totally or partially, and oppose the registration or use of a trademark by third parties.

Assignment: What can be assigned?

Trademarks with or without goodwill may be transferred or assigned. It is not mandatory to refer to goodwill in the deed. All or some of the goods and services protected by a trademark may be assigned.

There is no obligation to register a trademark transfer or change of name, but it must be registered to be effective against any third party. An unrecorded transaction is only enforceable between parties. Applications in course may be assigned.

According to article 7 of the TML, the transfer or assignment of a corporation that owns a trademark includes the mentioned mark unless otherwise agreed. The documents through which parties assign technology transfer may be recorded at the INPI only if they are concluded between a party who has got an address abroad and the other in Argentina. The contract to be registered must have as its principal or accessory object the transfer or the license of technology or a trademark. The monetary benefits of mentioned registration are - for the licensee or local corporation - the entitlement to consider all fees transferred to the company abroad 'cost', while the company abroad is entitled to legally consider them as a reduction of the income tax to be paid in his own country.

Assignment documentation: What documents are required for assignment and what form must they take?
Documents for assignment must be filed together with a sworn translation into Spanish.

No special forms are required for assignment of a trademark, although notarisation is strongly recommended as it gives legal certainty to the date and place of signing mentioned in the document, and also provides legal protection for the signatures contained in it.

Validity of assignment: Must the assignment be recorded for purposes of its validity?
See response to “What can be assigned?”

-- from gettingthedealthrough.com (Trademarks 2011, Argentina, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision: Section 10(f) of the Patent Law states “Any advance renunciation by the worker of the rights conferred by this Article shall be null and void.”

Additional information can be found at:

Ley de Contrato de Trabajo (Employment Contract Act) (Law No. 20744)
< <http://www.infoleg.gov.ar/infolegInternet/anexos/25000-29999/25552/texact.htm> > (in Spanish)

Patent Law of Argentina < http://www.jpo.go.jp/shiryoe/s_sonota_e/fips_e/pdf/argentine_e/tokkyo.pdf >

AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183argentina.pdf> > (Argentina)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=AR> >

Ownership of the Copyright in Works and the Patent Rights in Inventions Created by Employees
< <http://www.juridicum.su.se/user/sawo/Publikationer/Wolk%20nr%20120.pdf> > (in Finland, Sweden, Germany, Austria, the United Kingdom, Estonia, and Argentina).

AUSTRALIA (NOTE: There may be differences among the various Australian states/territories not covered here.)

Labour & Employment

Intellectual property in Australia is governed primarily by federal law, particularly the Patents Act 1990, the Copyright Act 1968, the Designs Act 2003 and the Trademarks Act 1995. As a general rule, any intellectual property created by an employee during the course of employment, including employee inventions, is by force of statute owned by the employer. This can, however, be varied by individual employment arrangements.

An employer will be entitled to an invention where the invention was made by the employee in the course of his or her employment, doing what he or she was engaged and instructed to do, and using the time, opportunity and information or facilities provided by the employer.

There can often be issues concerning whether the work or invention was required to be carried out during the employment. If, therefore, an employer is concerned to protect it, it is best that the employer deals with it in a written contract.

-- from gettingthedealthrough.com (Labour & Employment 2010, Australia, Ques #28)

Copyright

As a general rule under the Copyright Act, the creator of the work, or the person who was responsible for making the published edition, broadcast, film or sound recording, is the first owner of copyright. An agreement may provide for ownership contrary to these rules.

There are a number of important exceptions. These include the following (in the absence of an agreement to the contrary):

- an employer will own copyright in works created by their employees in the course of employment;
- in the case of commissioned portraits, engravings, films, sound recordings and some photographs, the commissioning person and not the artist or maker, will own copyright in the work;
- a producer or person who paid for a film or sound recording will own copyright in the film or sound recording (although a performer in a live performance who is recorded on a sound recording will generally own a share of copyright in the sound recording); or
- a journalist who creates a literary, dramatic or artistic work for inclusion in a newspaper, magazine or similar periodical, under the terms of a contract of service with the proprietor of a newspaper or magazine or similar periodical, may own all or a share of the copyright in the work.

As explained above, the Copyright Act provides that an employer will own copyright in a work that an employee creates in the course of employment unless there is an agreement to the contrary. There is a specific exception for works for inclusion in a newspaper, magazine or similar periodical.

-- from gettingthedealthrough.com (Copyright 2011, Australia, Ques. #22 & 23)

With respect to independent contractors, generally the hiring party will not own a copyrighted work made by an independent contractor unless an assignment of copyright is expressly agreed to. A legal assignment of copyright must be in writing and signed by or on behalf of the assignor.

The exception is that for commissioned portraits, engravings, some photographs, films and sound recordings the commissioning person and not the artist or maker, will own copyright in the work.

If there is no assignment of copyright, the hiring party will generally have received a licence (express or implied) to make certain uses of the copyright work.

-- from gettingthedealthrough.com (Copyright 2011, Australia, Ques. #24)

Authors, film directors, film producers, screenwriters and performers have the following moral rights:

- a right of attribution;
- a right to prevent false attribution; and
- a right to prevent derogatory treatment of their work or performance.

Moral rights are personal rights and are not assignable. [Moral rights ***also cannot be waived.***] There is a specific regime in the Copyright Act relating to consent to acts that would otherwise infringe moral rights. There is a broad defence of reasonableness in relation to the right of attribution and the right against derogatory treatment.

-- from gettingthedealthrough.com (Copyright 2011, Australia, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any person claiming to be the owner of a trademark can apply for its registration. The applicant must have legal personality. It can be an individual, company or incorporated association. If there are two or more persons who own a trademark, they may jointly apply for its registration.

An application for a collective trademark need not be made by a person or persons having legal personality.

An applicant must have an address for service in Australia.

Assignment: What can be assigned?

Registered trademarks can be assigned with or without goodwill.

For unregistered trademarks to be validly assigned, the question of whether they need to be assigned with or without goodwill is not clear-cut. At common law, a trademark is assignable only with the goodwill of the business in which the trademark is used.

Under the Act, an assignment can be partial in that it may apply to only some of the goods and services under the trademark. However, the assignment may not be partial in relation to the use of a trademark in a particular area.

No other assets need to be assigned with a registered trademark or trademark application to make it a valid transaction.

A defensive trademark should be assigned with the registered trademark on which it is based. If the defensive trademark is not assigned with its registered trademark, this could lead to the cancellation of the defensive trademark.

A collective trademark cannot be assigned.

A certification trademark can only be assigned with the consent of the Australian Competition and Consumer Commission.

Assignment documentation: What documents are required for assignment and what form must they take?

A document that establishes the title of the assignee to a trademark must be filed with the TMO. Generally a deed of assignment or confirmatory deed of assignment is filed. The document should be signed by the assignor and assignee. Notarisation is not required. Copies of documents are sufficient for the TMO.

Either the assignor or assignee must apply to the TMO to record the assignment.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Under the Act, either the assignor or assignee must apply to the TMO for a record of the assignment to be entered on the Register. There is no time limit for requesting the recordal of an assignment.

While not recording an assignment does not affect its validity, the registration of the assignee as the owner of the trademark is not taken to have had effect until the application to record the assignment is filed in the TMO. Not recording the assignment of the trademark could lead to the removal of the trademark on the grounds of non-use of the trademark by the registered owner. In addition, the assignee cannot sue for trademark infringement until he is registered as the owner on the Register.

-- from gettingthedealthrough.com (Trademarks 2011, Australia, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183australia.pdf> > (Australia)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=AU> >

The works-made-for-hire rules for employees and independent contractors in Australia, China, France, Germany, Japan, the United Kingdom, and the United States are discussed in the article "Analysis of International Work-for-Hire Law," by Sutherland Asbill & Brennan LLP (2004)

< <http://www.sutherland.com/alertspubs/searchresults.aspx?keyword=international&publicationtype=&practice=&industry=&authors=&year=&fromsearchpage=alertspubs> >

In Australia the Full Federal Court considered the matter of *UWA (University of Western Australia) v Gray* [2009] FCAFC 116 < <http://www.austlii.edu.au/au/cases/cth/FCAFC/2009/116.html> >. This has addressed the issues of how the terms of the contract of employment may be interpreted in the university research context (the inventions related to anticancer drugs) regarding ownership of IP (predominantly patent) rights in the invention. The decision challenged the previously held view that the contract of employment imputed

ownership of IP assets developed or discovered by an employee, to the employer. The court looked at the specific terms of the employment contract (that there should be a duty to invent specified in the contract for ownership of IP assets to pass to the employer) and also looked at the special nature of research in a university context.

-- provided by Jenny Kiss

Another case addressing IP ownership rights in the university context is Victoria University of Technology v Wilson & Ors [2004] VSC 33 < <http://www.austlii.edu.au/au/cases/vic/VICSC/2004/33.html> >. This case was distinguished, but not overruled, in UWA v. Gray.

-- provided by Kerry Hubick

For a recent decision regarding design entitlement, see Courier Pete Pty Ltd v Metroll Queensland Pty Ltd [2010] FCA < <http://www.austlii.edu.au/au/cases/cth/FCA/2010/735.html> >.

-- from a link to a Class 99 blog entry posted by David Musker on May 5, 2011
< <http://class-99.blogspot.com/2010/07/entitlement-to-employee-designs.html> >

The following two cases are also instructive on IP ownership issues under Australian law:

On Call Interpreters and Translators Agency Pty Ltd v. Commissioner of Taxation (No 3) [2011] FCA 366 < http://www.austlii.edu.au/au/cases/cth/federal_ct/2011/366.html > (discusses the principles to apply when determining whether someone providing services for hire is an independent contractor or an employee).

EdSonic Pty Ltd v. Cassidy [2010] FCA 1008
< <http://www.austlii.edu.au/au/cases/cth/FCA/2010/1008.html> > (discusses the allocation of rights between employers and employees under the Australian Copyright Act 1968).

The following page contains a table of some statutory and common law references regarding the treatment of intellectual property created by employees and contractors in Australia. Many thanks to Noric Dilanchian of Dilanchian – Lawyers & Consultants, Sydney, Australia < www.dilanchian.com.au >, for sharing this material.

Links to the sample cases cited in the following table

- Ansell Rubber Co P/L v Allied Rubber Industries P/L [1967] < <http://www.austlii.edu.au/au/cases/vic/VicRp/1967/7.html> >
- Avtex Airservices Oty Ltd & Ors v Bartsch and Ors [1992] < <http://www.austlii.edu.au/au/cases/cth/FCA/1992/187.html> >
- British Syphon Co Ltd v Homewood [1956] – full text can be found at < <http://www.iclr.co.uk> > (requires free subscription)
- Byrne v Statist Company [1914] – brief summary of case found at < <http://slcc.strath.ac.uk/scotslawcourse/ip/ip/copy/byrne.html> >
- Electrolux Ltd v Hudson [1977] – brief summary of case found at < <http://slcc.strath.ac.uk/scotslawcourse/ip/ip/patent/elex.html> >;
full text can be found at < <http://www.iclr.co.uk> > (requires free subscription)
- Faccenda Chicken Ltd v Fowler [1986] – summary of case found at < <http://slcc.strath.ac.uk/scotslawcourse/ip/ip/boc/conflink2.html#case> >;
full text can be found at < <http://www.iclr.co.uk> > (requires free subscription)
- Maggbury P/L v Hafele Aust. Ltd [2001] < <http://www.austlii.edu.au/au/cases/cth/HCA/2001/70.html> >
- Redrock Holdings P/L v Hinkley [2001] < <http://www.austlii.edu.au/au/cases/vic/VSC/2001/91.html> >
- Spencer Industries P/L v Collins [2003] < <http://www.austlii.edu.au/au/cases/cth/FCA/2003/542.html> >
- Sterling Engineering Co Ltd v Patchett [1955] – full text can be found at < <http://www.iclr.co.uk> > (requires free subscription);
discussed in “But it was my Idea!” by Jessica Mark at pages 13 & 14 < <http://www.otago.ac.nz/law/oylr/2007/Mark.pdf> >.
- UWA (University of Western Australia) v Gray [2009] < <http://www.austlii.edu.au/au/cases/cth/FCAFC/2009/116.html> >
- Weldon & Co Services P/L v Harbinson [2000] < <http://www.austlii.edu.au/au/cases/nsw/NSWSC/2000/389.html> >

Intellectual Property – Employees & Contractors

IP CATEGORY	Ownership Considerations	Law	Exceptional Situations	Sample cases
1. COPYRIGHT Copyright Act 1968 (Cth)	An employee or contractor (if a director may be later)? Did the employee create the work pursuant to the terms of his or her employment? Is it part of the job description?	ss 35(6); 196(3) Copyright Act; Restraints of Trade Act 1976 (NSW)	Commissioned photos, commissioner owns; moral rights; s 35(4) work of journalists and media employees	Redrock Holdings P/L v Hinkley [2001] (software case); Avtex Airservices Pty Ltd & Ors v Bartsch and Ors [1992]; Byrne v Statist Company [1914]
2. CONFIDENTIAL INFORMATION	Is it 'Confidential Information', and was it created in the course of employment?	Common Law; s 52 Trade Practices Act; ; Restraints of Trade Act 1976 (NSW)	Ex-employees are free to exercise their "skill and knowledge"; Employee breach of duty of fidelity (eg non-disclosure of IP) or "wilful misconduct"?	Ansell Rubber Co P/L v Allied Rubber Industries P/L [1967], Faccenda Chicken Ltd v Fowler [1986]; Maggbury P/L v Hafele Aust. Ltd [2001]; Weldon & Co Services P/L v Harbinson [2000]
3. REGISTERED TRADE MARK Trade Marks Act 1995 (Cth)	An employee or contractor (if a director may be later)? Did the employee create the mark in the course of his or her employment? Is it part of the job description?	ss 27(1)(a), 58 Trade Marks Act; s 52 Trade Practices Act	Employee breach of duty of fidelity (eg non-disclosure of IP) "wilful misconduct"?	
4. UNREGISTERED TRADE MARK Common law & various federal and state acts	An employee or contractor (if a director may be later)? Did the employee create the mark in the course of his or her employment? Is it part of the job description?	s 52 Trade Practices Act; ; Restraints of Trade Act 1976 (NSW)	Employee breach of duty of fidelity (eg non-disclosure of IP) "wilful misconduct"?	
5. PATENT Patents Act 1990 (Cth)	An employee or contractor (if a director may be later)? Invention part of the employer's field of business? Employee developed it at the direction or in the course of his/her usual employment? Part of the job description? Use of employer's time and resources?	No section but see - ss 14(1); 15(1)(b) & (c); 16; 17 Patents Act; Restraints of Trade Act 1976 (NSW)	S. 16 - each joint owner may exploit but one joint owner cannot alone grant a licence, without consent of the other. Employee breach of duty of fidelity (eg non-disclosure of IP) "wilful misconduct"?	Sterling Engineering Co Ltd v Patchett [1955]; Spencer Industries P/L v Anthony Collins & Anor [2002]; Electrolux Ltd v Hudson [1977]; British Syphon Co Ltd v Homewood [1956]; UWA (University of Western Australia) v Gray
6. REGISTERED DESIGN Designs Act 2003 (Cth)	Is this an employee or contractor (if a director may be later)? Has the design been made by the employee in the course of their employment? Is it part of the job description?	ss 19(2), 19(3) Designs Act	If a contractor has received valuable consideration for providing the design the commissioner will own the design.	Byrne v Statist Company [1914] – course of employment.
7. ELIGIBLE LAYOUTS Circuit Layouts Act 1989 (Cth).	Is this an employee or contractor (if a director may be later)? Layout made by a person under terms of employment or apprenticeship? Is it part of the job description?	s 16(2) Circuit Layouts Act	Commissioned layouts, commissioner owns. Employee breach of duty of fidelity (eg non-disclosure of IP) "wilful misconduct"?	
8. PLANT VARIETIES Plant Breeder's Rights Act 1994 (Cth)	Did the employee create the mark in the course of his or her employment? Is it part of the job description?	s 3(1)(c) Plant Breeder's Rights Act - "breeder"	Employee breach of duty of fidelity (eg non-disclosure of IP) "wilful misconduct"?	

AUSTRIA

Labour & Employment

Generally, the results of an employee's work are due to the employer. However, if the employee makes an invention covered by the provisions of the Patent Act during his or her employment, a patent for the invention may be granted to the employee.

Agreements between the employer and the employee regarding the assignment of the employee's future inventions are valid if the respective invention falls within the line of the employer's business and:

- the invention is a result of the employee's contractual obligations;
- the employee's invention was inspired by his or her work in the company; or
- the invention was facilitated by the use of the company's resources.

In cases of a valid assignment of the employee's invention to the employer, the employee is entitled to reasonable compensation.

-- from gettingthedealthrough.com (Labour & Employment 2011, Austria, Ques #28)

Patents

The inventor or his or her successor in title shall have a right to the grant of a patent. Until the contrary is proved the first applicant shall be regarded as the inventor.

Employees shall also be entitled to the grant of a patent (utility model) for inventions they have made during their employment relationship, unless otherwise provided by contract.

An employee shall be entitled to special and fair remuneration in any case where his or her invention becomes the property of his or her employer or subject to the employer's right to use.

In the case of an invention made by an independent contractor, the right to the grant of a patent depends on the respective contract.

A patent (utility model) applied for by several persons (inventors) as participants in the same invention shall be granted without any determination of each person's share. The legal relationship of the co-patentees shall be governed by civil law.

In any case, the inventors shall be entitled to be named as the inventors. The right may not be transferred or inherited. Renunciation of the right shall have no legal effect.

The right arising from a patent (utility model) application and the granted right is recorded at the Patent Office. It shall be inheritable and not pass to the state. Both rights may be transferred to others, either wholly or in shares, by a legal act, by a court order or by a transfer pro mortis causa. All rights relating to a patent (utility model) shall be acquired by entry in the Patent (Utility Model) Register and shall be binding on third parties. A request for such entry shall be accompanied by the original or a duly certified copy of the document on which the entry is to be based. A document other than a public document shall bear the duly certified signature of the person alienating his or her right.

-- from gettingthedealthrough.com (Patents 2011, Austria, Ques. #15)

Copyright

The owner of a work's copyright is its author or his or her heirs. Other than exploitation rights, the ownership may not be assigned to any third parties (Copyright Act, section 23, paragraph 3).

An employer may not technically own a work made by an employee. However, the employer may be entitled to all of the employees' exploitation rights under specific circumstances. By law, the employer is granted an exclusive right to exploit the program or the design created by an employee in the normal course of his or her work (Copyright

Act, section 40b; Design Protection Act, section 7, paragraph 2). Specific rules also apply in the area of cinematographic works. According to Copyright Act, section 38, the exploitation rights will be exclusively assigned to the producer.

-- from gettingthedealthrough.com (Copyright 2011, Austria, Ques. #22 & 23)

On the basis of the specific regulations referenced above, the Austrian Supreme Court derived a general principle of granting the employer a (limited) right to its employees' work results if the employee has been hired for the specific purpose of creating a copyrightable work. This principle is also applicable when dealing with independent contractors. It is, however, advisable to include a respective clause in the contract, since the Supreme Court decides the applicability and extent of this principle on a case-by-case basis.

-- from gettingthedealthrough.com (Copyright 2011, Austria, Ques. #24)

Moral rights are recognised. The main provisions are Copyright Act, sections 19, 20 and 21, paragraph 3. Section 19 grants the originator the unlimited and mandatory right to defend his or her creatorship against third parties. According to the Copyright Act, section 20 it is within the creator's sole discretion as to whether or not and by which means he or she shall be indicated as originator. Section 21, paragraph 3, preserves the originator the right to object to defacing changes to his or her work even if the right to the adjustment was granted to a third party.

-- from gettingthedealthrough.com (Copyright 2011, Austria, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any physical or legal person - alone or in combination - may apply, irrespective of running a related business. Collective marks may be applied for by associations having legal personality.

Assignment: What can be assigned?

A trademark may be assigned with or without goodwill or the business concerned for all or part of the registered goods and services. Where the assignment would deceive the public, the assignee has to consent to any restrictions to remedy the deception.

Assignment documentation: What documents are required for assignment and what form must they take?

A deed of assignment or a document referring to the assignment is needed. The signature of the assignor has to be notarised whereby the notary public has to state that the person signing the document is entitled to sign on behalf of the assignor on the date of signing in a legally binding manner. Depending on the countries involved, the notarisation needs to be superlegalised diplomatically or by the Hague apostille. The signature of the assignee does not need any legalisation.

Furthermore, an unlegalised power of attorney by the assignee is needed.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Recording an assignment is not mandatory. However, until such time as the transfer of the mark has been recorded, the right to the mark may not be asserted before the Patent Office and all communications concerning the mark served on the registered owner of the mark shall have effect with regard to the acquirer of the mark.

-- from gettingthedealthrough.com (Trademarks 2011, Austria, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

Ownership of the Copyright in Works and the Patent Rights in Inventions Created by Employees < <http://www.juridicum.su.se/user/sawo/Publikationer/Wolk%20nr%20120.pdf> > (in Finland, Sweden, Germany, Austria, the United Kingdom, Estonia, and Argentina).

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=AT> >

BELGIUM

Labour & Employment

IP rights for employees are regulated for inventions, literature or art and computer programs.

For other intellectual creations no specific legislation exists and the matter is disputed.

For employee inventions created within the scope and in the course of the employment contract, a distinction must be made between its moral and patrimonial rights:

- moral rights (e.g., the right to be named as author or the right to claim or refuse the paternity of an invention) always belong to the employee and are not transferable; and
- patrimonial rights (e.g., right of reproduction or use of the invention) belong to the employer.

There is discussion on the ownership of patrimonial rights for employee inventions created in the course of the employment contract, but outside the scope of the employee's contracted duties.

-- from gettingthedealthrough.com (Labour & Employment 2011, Belgium, Ques #28)

Patents

When an employee of a company makes an invention within the performance of an employment contract, the employer is considered the owner of the invention and can therefore file a patent application for said invention. The actual inventor has, however, the right to have his or her name mentioned on the patent. On the other hand, if the invention is made outside the scope of the performance of his or her employment contract, an employee will be considered as the owner of the invention and can therefore file for a patent. A third scenario is the invention made by an employee outside the performance of an employment contract but with company means. These mixed inventions may give rise to legal complications, which is why it is recommended practice to deal with this issue by including language in the employment contract stating that in this case the employer will own the invention and will have the right to file for patent protection. Similar language will be required in contracts with independent contractors such as consultants. Failing that, any inventions made by independent contractors will be owned by them. If there is more than one inventor, a situation of co-ownership arises. Patent ownership is recorded in the patent registry of the Belgian Intellectual Property Office of the Economic Affairs Department. Any transfer or assignment of a patent should be notified to the Office for such transfer to be enforceable against third parties.

-- from gettingthedealthrough.com (Patents 2011, Belgium, Ques. #15)

Copyright

The natural person who has created the work is the original copyright owner. Only natural persons can obtain original copyright. Companies can obtain secondary copyright upon a copyright transfer. After the death of the author, his heirs will become the owner of the copyright. There is a legal presumption of copyright ownership in favour of the author who is designated as such on the work, unless proven otherwise.

An employer (private or public) can only obtain copyright over the work of an employee in secondary order, after the creation of the work and insofar as the work has been created within the scope of the employment activities. Any transfer of patrimonial rights must be expressly agreed in writing. Moral rights cannot be transferred for future works, but can only be waived explicitly for existing works. Specific rules apply to audio-visual works.

-- from gettingthedealthrough.com (Copyright 2010, Belgium, Ques. #22 & 23)

Patrimonial rights of works may be transferred in the framework of a hiring contract. If the hiring party is active in the non-cultural sector or in the publicity sector, copyright can be transferred insofar as the works are created for such activity, and subject to an express transfer of rights in writing. For the remainder, general rules of contract law apply. If the hiring party is active in the cultural sector, specific copyright rules apply to the contract.

-- from gettingthedealthrough.com (Copyright 2010, Belgium, Ques. #24)

Authors have exclusive rights over their work. Two categories of rights can be distinguished:

Patrimonial [economic] rights:

- the reproduction right, including the right to allow the adaptation, the translation, the rental and the distribution of the author's work;
- the right to communicate the work to the public; and
- the resale right, including royalties on resales subsequent to the first transfer of the work.

Moral rights:

- the right to disclose the work;
- the right to respect the work; and
- the right to paternity of the work.

Special rules apply with regard to audio-visual works.

-- from gettingthedealthrough.com (Copyright 2010, Belgium, Ques. #12 & 5)

Trademarks

See Trademarks under the Netherlands for discussion of trademarks under the Benelux Convention on Intellectual Property (BCIP) in Belgium, Luxembourg, and the Netherlands.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183belgium.pdf> > (Belgium)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=BE> >

For a detailed discussion of employee-inventor compensation laws in Belgium, France, Germany, the Netherlands, and the United Kingdom, see "Employee's rights to compensation for inventions - a European perspective" at
< <http://www.cov.com/files/Publication/4ffe8880-deba-493a-8994-2a69f0da78dd/Presentation/PublicationAttachment/3b0e8983-fe2a-41b5-9e96-2fb6c8a3a8c1/Employee%20%80%99s%20Rights%20to%20Compensation%20for%20Inventions%20-%20A%20European%20Perspective.pdf> >

BOLIVIA

Trademarks

Ownership of marks: Who may apply?

A trademark applicant may be any person, whether an individual or legal entity, regardless of its nationality.

Assignment: What can be assigned?

Pursuant to Bolivian law, trademark registrations or trademark applications may be assigned. Similarly, part of the products covered by the mark or the entire list of products may also be assigned. However, when a partial assignment of products is intended the Trademark Office may refuse such an assignment if it decides that the coexistence of an identical trademark for similar products may lead to public confusion. The relation between the groups of products and the degree to which the mark is well known will play an important role in determining coexistence.

In addition, the trademark can be assigned with or without goodwill or with or without the establishment or company to which it belongs. The law, if there is no specification in the assignment deed, will deem that the assignment is with goodwill.

For an assignment to be valid it must be made in writing and registered at the Trademark Office.

Assignment documentation: What documents are required for assignment and what form must they take?

The documents required for the assignment of a trademark are an assignment deed and a valid power of attorney. The assignment deed, which sets forth the assignment conditions, needs to contain the basic elements to be deemed a contract under 'contract theory'.

Both documents need to be notarised and legalised by the Bolivian Consulate.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment needs to be validly recorded by the Trademark Office. Recording the assignment will grant protection against third parties.

If the assignment is not recorded, then the assignor will continue to be the legal owner of the mark and any use made by the assignee will not be construed as use by the owner or a lawful licensee, and thus the mark could be cancelled for this reason.

-- from gettingthedealthrough.com (Trademarks 2011, Bolivia, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=BO> >

BOSNIA AND HERZEGOVINA

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person may apply for the registration of a mark in Bosnia and Herzegovina. Foreign parties in Bosnia and Herzegovina enjoy the same rights regarding trademark protection as domestic parties, should such rights derive from international treaties or the principle of reciprocity. It is considered that the reciprocity exists until proven otherwise. Additionally, foreign parties have to be represented in proceedings before the Intellectual Property Office of Bosnia and Herzegovina by a professional representative having a BA degree in law or technical degree and registered in the Register of Representatives maintained by Intellectual Property Office.

Assignment: What can be assigned?

All trademarks or a right arising from an application may be assigned by a contract for all or part of the goods or services for which it is registered. A trademark may be assigned alone; no other business assets need to be assigned to make it a valid transaction. Even though it is not mandatory to register the assignment, we strongly suggest that it is registered. Once registered the assignment can produce legal effects with regards to third parties, and the assignee is formally conferred all the rights stipulated by the assignment.

A trademark holder or applicant may assign the trademark or the right (or both) in the trademark application on the basis of an assignment in respect of all or some of the goods and services.

The assignment agreement needs to be drawn up in writing and it shall contain: the date of signing the agreement, name and surname or business name, domicile, residence or seat of the contractual parties, the trademark registration number or the number of the trademark application and the amount of the fee, if stipulated.

Registration of the assignment of a trademark or the rights arising from the application (or both) shall not be granted if such assignment is liable to cause confusion in trade in respect of the type, quality or geographical origin of the goods or services for which the trademark has been registered or in respect of which the trademark application has been filed, unless the assignee disclaims protection for the goods or services in respect of which there is a likelihood of confusion.

Registration of the assignment of a trademark or the rights arising from the application (or both) that refers only to certain goods or services shall not be approved where the goods or services being assigned are essentially similar to the goods or services in respect of which the mark remains registered for the benefit of the assignor.

Note that collective trademarks and warranty trademarks may not be the subject of assignment.

Assignment documentation: What documents are required for assignment and what form must they take?

The documents required for the registration of an assignment before the Montenegrin IP Office are the Z-04 assignment form, the evidence of legal grounds for assignment (such as an assignment contract), and the power of attorney should the request be filed through a representative (legalisation and notarisation of the power of attorney are not required).

The registration fee for the trademark assignment is approximately €7.67.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

In order to be effective against third parties, the assignment contract must be in writing and must be entered into the appropriate register at the IP Office at the request of a contracting party.

-- from gettingthedealthrough.com (Trademarks 2011, Bosnia and Herzegovina, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=BA> >

BRAZIL

Labour & Employment

Law No. 9,279/96 provides that the property rights over any invention developed by the employee, as part of an employee's labour activities or using an employer's tools, knowledge and structure, belongs to the employer and may be freely registered and explored by the employer. Law No. 9,609/98 provides that any software developed by the employee, as part of an employee's labour activities or using an employer's tools, structure and knowledge shall be considered as intellectual property of the employer. In both cases, the regular compensation paid to an employee is considered sufficient to compensate the development of the related invention or software, and any additional compensation or participation in the revenue generated by such invention or software may be granted to the employee as an option of the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, Brazil, Ques #28)

Trademarks

Ownership of marks: Who may apply?

The Brazilian Industrial Property Law (IP Law) allows private individuals, private and public companies, and private and public legal entities (including associations and foundations) to apply for registration of trademarks before the Brazilian Trademark Office (BTO). Their activities need to match the corresponding class of product or service applied by BTO. Private individuals must submit the professional documents that evidence the exercise of the professional activity to the BTO for filing purposes.

Assignment: What can be assigned?

Trademark registrations and applications may be assigned to third parties insofar as the assignee meets the legal requirements for requesting such registration.

The assignment must include all applications or registrations in the name of the assignee involving identical or similar marks relating to a product or a service under the penalty of the cancellation of the registrations or the shelving of the unassigned applications.

Brazilian trademark law does not require the assignment of the goodwill with the transfer of rights over a registration or an application.

Assignment documentation: What documents are required for assignment and what form must they take?

In order to proceed with a recordal of an assignment agreement, the BTO requires the filing of the following documents:

- an assignment document signed by the authorised officers of both companies (ie, the assignor and assignee) as well as by at least two witnesses with full identification;
- a document attesting that the signing person is entitled to act on behalf of the assignor;
- an affidavit attesting that the assignee company is engaged in activities related to the products or services claimed by the trademark application or registration sought to be assigned; and
- the power of attorney duly signed by authorised officers on behalf of the assignee.

Neither notarisation nor legalisation is required.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recordation of assignment of a trademark is indispensable for the purpose of producing effects before third parties (including the courts, the administrative authorities, etc), but not for the validity of the assignment, which is duly signed by assignor and assignee. Its effect will be considered from the date recordation is published in the Brazilian Trademark Official Bulletin. Therefore, the IP Law does not provide any penalties for not recording the assignment agreement.

-- from gettingthedealthrough.com (Trademarks 2011, Brazil, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision: Certain provisions of the Brazilian Industrial Property Law (see Sections 88 to 93, and 121), the Software Law (see Article 4), and the Plant Variety Protection Law (see Articles 38 and 39) regulate relations between employers and employees. These provisions cannot be modified by employers or employees in the employment contract. These provisions are reproduced in an attachment that is part of AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property (Group Reports – Brazil) < <https://www.aippi.org/download/commitees/183/GR183brazil.pdf> >.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property < <https://www.aippi.org/download/commitees/183/GR183brazil.pdf> > (Brazil)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=BR> >

BULGARIA

Information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property < <https://www.aippi.org/download/commitees/183/GR183bulgaria.pdf> > (Bulgaria)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=BG> >

CANADA (NOTE: There may be differences among the various Canadian provinces not covered here.)

Labour & Employment

There is a presumption that an employee owns his or her invention, pursuant to the provisions of the federal Patent Act, unless the parties have an express contract to the contrary or the employee is expressly employed for the purpose of inventing or innovating. By contrast, the federal Copyright Act states that the employer is the first owner of copyright for any work created by an employee in the course of his or her employment. This statutory provision may be varied by contract, however. In the case of works protected by copyright, a *written waiver of moral rights* should be secured. The Copyright Act *does not permit moral rights to be assigned*.

-- from gettingthedealthrough.com (Labour & Employment 2011, Canada, Ques #28)

Patents

The issue of patent ownership is determined under the jurisdictions of the inventor and of the inventor's employer. When the invention is made outside Canada by an inventor who is working under an employment contract that is governed by the laws of a jurisdiction outside Canada, then Canadian courts should defer to the laws of the governing jurisdiction to figure out who owns what.

If the invention is made during the performance of conditions of employment in Canada, then the invention is typically owned by the employer. A specific contract helps to further clarify the situation. When an employee is not paid to invent, then his or her inventions remain his or her property. An exception to this is for public servants, who are all governed by specific legislation.

Contractors own inventions that they develop unless an agreement specifies otherwise. It is important when dealing with contractors, especially when they are more like an employee other than being called a contractor for legal reasons, to ensure that contracts indicate patent ownership and ownership of other intellectual property rights. When the contracts are silent on the issue of patents, it is highly beneficial to address the issues of ownership sooner rather than later as it is often easiest to do while the contractor's contract is ongoing.

If multiple inventors are all employees, then the employer owns the invention. If only some inventors are employees, then the employer owns a part of the invention and the other inventors own the remaining part (or parts). This can get quite complicated and should be reviewed by Canadian legal counsel when ownership is in question.

Under the new Patent Rules that became effective on 2 June 2007, it is no longer necessary to register an assignment of rights from the inventors to the applicant. The applicant may simply file an entitlement declaration setting out the mechanisms under which the applicant has acquired the right to file the application. Entitlement declarations often indicate that the applicant has a right to the patent because an employment agreement had been signed, or simply because the inventors are employees of the applicant. Any subsequent transfer of title in the patent requires an assignment.

-- from gettingthedealthrough.com (Patents 2011, Canada, Ques. #15)

Copyright

The author of the work is the first owner of copyright unless the author who created the work did so in the course of their employment, in which case the employer is the first owner of the copyright.

The Act states that 'where the author of a work was in the employment of some other person under a contract of service or apprenticeship and the work was made in the course of his employment by that person, the person by whom the author was employed shall, in the absence of any agreement to the contrary, be the first owner of the copyright.' The determining test, therefore, is whether the author was employed under a contract of service or apprenticeship. This is to be distinguished from a 'contract for services' and various tests developed under employment and tax law can be applied. The work must have been made in the course of employment, and there must be no agreement to the contrary.

-- from gettingthedealthrough.com (Copyright 2011, Canada, Ques. #22 & 23)

A hiring party will not own a copyrighted work made by an independent contractor unless there is an agreement in place specifically stating that the copyright is the property of the hiring party and not the independent contractor. There is no requirement that such a term must be in writing and an implied term of contract may suffice.

-- from gettingthedealthrough.com (Copyright 2011, Canada, Ques. #24)

The author of a work has the right to the integrity of the work and, under reasonable circumstances, to be associated with the work as its author by name or under a pseudonym. **Moral rights may not be assigned but may be waived** in whole or in part. An assignment of copyright does not constitute a waiver of moral rights. Moral rights are infringed by any act or omission that is contrary to any of the moral rights of the author of a work. The author's right to the

integrity of a work is infringed if the work is distorted, mutilated or otherwise modified, or used in association with a product, service cause or institution to the prejudice of the honour or reputation of the author.

Bill C-32 extends moral rights to performers' performances.

-- from gettingthedealthrough.com (Copyright 2011, Canada, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Companies, individuals, partnerships, trade unions and lawful associations can apply to register their marks in Canada.

Specifically, an applicant can be:

- one who proposes to use the mark in Canada by itself or through a licensee;
- one who has used the mark in Canada by itself or through a licensee;
- one whose country of origin is a Paris Convention country or a member of the World Trade Organization (WTO) and who has registered the mark, or applied for registration of the mark, in or for that country, and has used the mark;
- one who has made the mark known in Canada; or
- a successor in title of (i), (ii), (iii), or (iv).

An applicant must be a single legal entity and must state in the application that it is satisfied that it is entitled to use the trademark in association with the wares or services (or both) set out in the application.

Use by a licensee of the applicant is deemed to be use by the applicant as long as the applicant retains control over the character or quality of the applied-for wares or services (or both).

If the applicant has no office or place of business in Canada, it must provide the address of its principal office or place of business abroad and the name and address in Canada of a person or firm to whom any notice in respect of the application may be sent, and on whom service of any proceedings in respect of the application may be given or served with the same effect as if they had been given or served on the applicant.

Assignment: What can be assigned?

The Act provides that a trademark, whether registered or unregistered, is transferable with or without the goodwill of the business and in respect of either all or some of the associated wares or services.

If, as a result of an assignment, the assignor and assignee have rights in confusing trademarks, there is potential that the marks may become non-distinctive and unenforceable.

Assignment documentation: What documents are required for assignment and what form must they take?

There is no specific form of assignment. The registrar will record an assignment if furnished with satisfactory evidence of the assignment along with sufficient particulars of the assignee. A simple document identifying the assignor, the assignee, the trademark and the date of the assignment is regularly accepted by the Trademarks Office.

An assignment need not be executed in writing and in some cases can be inferred from the facts. A written assignment is, however, recommended.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Registration of an assignment is not mandatory but is recommended.

-- from gettingthedealthrough.com (Trademarks 2011, Canada, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/commitees/183/GR183canada.pdf> > (Canada)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CA> >

CAPE VERDE

Trademarks

Ownership of marks: Who may apply?

Any person (individual, firm, or body corporate) with legitimate interest may apply for the registration of a mark.

Assignment: What can be assigned?

A registered mark may be assigned with or without the goodwill of the business. An assignment is to be registered in order to be effective as against third parties.

The requirements for registration of an assignment are as follows:

- deed of assignment in Portuguese, signed by the assignor and the assignee, and notarised and legalised by the consul of Cape Verde; and
- power of attorney in Portuguese, signed by the assignee, and notarised and legalised by the consul of Cape Verde.

Assignment documentation: What documents are required for assignment and what form must they take?

The requirements for registration of an assignment are the following:

- deed of assignment in Portuguese, signed by the assignor and the assignee, and notarised and legalised by the consul of Cape Verde; and
- power of attorney in Portuguese, signed by the assignee, and notarised and legalised by the consul of Cape Verde.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required in order to be valid.

-- from gettingthedealthrough.com (Trademarks 2011, Cape Verde, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CV> >

CHILE

Labour & Employment

Article 68 of Law No. 19,039 on Industrial Property provides:

In the employment and service agreements, whose nature is the fulfillment of an inventive or creative activity, the power to request registration as well as the eventual industrial property rights will exclusively belong to the employer or to whomever the service was assigned, unless there is an express stipulation to the contrary.

The second and third paragraphs of article 8 of Law No. 17,336 on Intellectual Property state that:

- In the case of computer programs, the individual or entities, whose dependents, in the performance of their labour duties, have produced them, will be the title holders of the respective copyright, unless there is a written stipulation to the contrary.
- With respect to computer programs produced by assignment of a third party to be commercialised for its account and risk, the copyright will be understood to have been assigned to it, unless there is a written stipulation to the contrary.

-- from gettingthedealthrough.com (Labour & Employment 2011, Chile, Ques #28)

Copyright

The author of the work is the primary owner of the copyrights and the person acquiring said rights, in any capacity, is the secondary owner. Notwithstanding the aforesaid, the Law has certain special rules about rights' ownership regarding certain works, some of which are:

- Anthologies and compilations: the organiser is the copyright holder but he or she is obligated to obtain authorisation and to pay copyright holders of the works being used.
- Films: the producer is considered the holder of the copyright of the film itself and the authors of the plot, music, lyrics of the songs and dubbing are holders of the rights over the literal elements of said work, which are independently considered for protection purposes, maintaining the right to use, separately, their respective contributions, provided they have not agreed their exclusive use for the film's production, in which case, the rights are considered as assigned to the producer.
- Public entities: works produced by public officials while performing their duties belong, accordingly, to the state, municipalities, official corporations, semi-public or autonomous institutions and other government entities for which they are working.
- Computer programs. There are special regulations concerning their ownership discussed below.

There is no work for hire regulation in Chile. Rights over the works created by employees while performing the duties resulting from a work relationship, belong to the employees.

Only in special circumstances will the employer own a copyright work made by an employee:

- in the case of computer programs, the Law sets an exception, by stating that the holders of the respective copyright are the natural persons or legal entities whose employees, while performing their duties, have produced them, unless it is otherwise stipulated in writing; and
- the works produced by public officials while performing their duties which belong, accordingly, to the state, municipalities, official corporations, semi-public or autonomous institutions and other government entities for which they are working.

-- from gettingthedealthrough.com (Copyright 2011, Chile, Ques. #22 & 23)

With respect to independent contractors, both the Law as general provisions concerning contracts say nothing with respect to works commissioned by a third party and, therefore, following general rules, the respective rights are not considered as assigned to the party commissioning the works.

Notwithstanding the aforesaid, there are some presumptions of transfer of rights established in the Law:

- Films: the contract between the authors of the literal elements of the film and the producer, provided they have agreed on their exclusive use for the film production, entails the assignment to the producer of all the rights over the work, including all of its elements, and authorises him to broadcast it to the public, show it on television, reproduce it in copies, rent and transfer it.
- Computer programs: in the case of software produced by commission of a third party, the rights of the developer to whom the work has been commissioned are considered as assigned.
- Photographs: the photographer has the exclusive right to reproduce, exhibit, publish and sell his photographs, except those done by virtue of a contract, in which case the right belongs to the party commissioning said work.

-- from gettingthedealthrough.com (Copyright 2011, Chile, Ques. #24)

Copyright comprises patrimonial and moral rights, which protect the use, authorship and integrity of the work.

Moral rights: The author, as the exclusive holder of the moral right, has for life the following powers:

- to claim the authorship of the work, associating to it his name or known pen name;
- to oppose to any deformation, mutilation or any other modification performed without his express and previous consent. Works of preservation, reconstitution or restoration of the works that have suffered damages that may alter or reduce their artistic value will not be considered as such;
- to maintain the work unpublished;
- to authorise third parties to finish the unfinished work, with the prior consent of the publisher or cessionaire, should there be one; and
- to demand that his will of maintaining the creator of the work remains anonymous or under a pen name is respected, provided it does not belong to the public domain.

Patrimonial rights: The copyright holder or whoever is expressly authorised by him or her, will be entitled to use the work in any of the following forms:

- to publish it (public offer of a work) by editing, recording or broadcasting it on radio or television, performing, executing, reading, reciting, exhibiting and, generally, through any other public communication means which is currently known or may be known in the future;
- to reproduce it through any means;
- to adapt it to another genre, or to use it in any other way implying a variation, adaptation or transformation of the original work, including its translation;
- to perform it publicly by means of radio or television broadcasting, phonographic records, films, tape recordings or any other material support which may be used on sound and voice reproduction apparatus, with or without images, or through any other means; and
- to distribute it (tangible copies) to the public by means of its sale, or any other property transfer of the original work or the copies that have not been object of a sale or any other property transfer authorised by him or pursuant to this law.

-- from gettingthedealthrough.com (Copyright 2011, Chile, Ques. #12 & 5)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CL> >

CHINA

Labour & Employment

The amended Patent Law (effective 27 December 2008) stipulates that an invention made by an employee in the execution of the tasks of his employer for which he works or made by him by taking advantage of the material and technical means of his employer shall be a service invention. The right to apply for a service invention patent shall remain with the employer. The amended Implementation Regulations of the Patent Law (effective 1 February 2010) further provide detailed provisions on this issue.

The Copyright Law also regulates the ownership of the copyright of works created by an employee. A work created by an employee in the fulfillment of tasks assigned to him by his employer shall be deemed to be a work created in the course of his employment. The copyright in such work shall be enjoyed by the author, subject to the following paragraph, provided that his employer shall have a priority right to exploit the work within the scope of its professional activities. During the two years after the completion of the work, the author shall not, without the consent of his employer, authorise a third party to exploit the work in the same way as his employer does.

The author of a work created in the course of his employment shall enjoy the right of authorship, while his employer shall enjoy the other rights included in the copyright and may reward the author in any of the following cases:

- drawings of engineering designs and product designs and maps, computer software and other works created in the course of his employment, mainly with the material and technical means of his employer and under its responsibility;
- works created in the course of his employment where the copyright is, in accordance with laws, administrative regulations or contracts, enjoyed by his employer.

However, it is also statutorily provided that employees and employers are free to make their own arrangement of the ownership of an employee invention or work.

-- from gettingthedealthrough.com (Labour & Employment 2011, China, Ques #28)

Patent

Under the Chinese patent law, an invention made by a person in execution of the tasks of the entity to which he or she belongs, or made by him or her mainly using the material and technical means of the entity, is a service invention. For a service invention, the right to apply for a patent belongs to the entity. After the application is approved, the entity shall be the patentee. For a non-service invention-creation, the right to apply for a patent belongs to the inventor. After the application is approved, the inventor shall be the patent owner.

For an invention made by a person using the material and technical means of the entity, and where the entity and the inventor have entered into an agreement under which there is provision on who has the right to apply for a patent and to whom the patent right belongs, the provisions of the agreement shall prevail.

For an invention jointly made by two or more entities or individuals, or made by an entity or individual in the execution of a commission for another entity or individual, the right to apply for a patent belongs, unless otherwise agreed upon, to the entity or individual that made the invention, or to the entities or individuals that jointly made the invention. After the application is approved, the entity or individual that applied for it shall be the patent owner.

Patent ownership is officially recorded in the SIPO, and can be assigned to another party and recorded in the SIPO as such.

-- from gettingthedealthrough.com (Patents 2011, China, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

As provided in article 4 of the Trademark Law, any natural person, legal entity or other organisation intending to acquire the exclusive right to use a registered trademark for goods produced, manufactured, processed, selected or marketed by him, or for the service provided by him, shall file an application for the registration of the trademark with the Trademark Office.

As provided in article 17 and 18 of the Trademark Law, any foreign person or foreign enterprise intending to apply for the registration of a trademark in China shall file an application in accordance with any agreement concluded between the People's Republic of China and the country to which the applicant belongs, or according to the international treaty to which both countries are parties, or on the basis of the principles of reciprocity and shall appoint any of such organisations as designated by the state to act as his agent.

Assignment: What can be assigned?

As provided in article 25 of the Regulations for the Implementation of the Trademark Law, when a registered trademark is to be assigned, both the assignor and assignee shall jointly send an application for assignment of the registered trademark to the Trademark Office. The assignee shall go through the formalities for the application for assignment of the registered trademark. The Trademark Office shall, upon approval of the application for assignment of the registered trademark, issue the assignee a corresponding certification and publish the assignment.

Where a registered trademark is to be assigned, the trademark registrant shall assign in a lump all of its trademarks that are identical or similar to each other in respect of the same or similar goods.

As provided in article 26 of the Regulations for the Implementation of the Trademark Law, where the exclusive right to use a registered trademark is transferred due to the reasons other than assignment, the party who accepts the transfer of the exclusive right to use the registered trademark shall, by producing the relevant evidential documents or legal instruments, go through the formalities of the transfer of the exclusive right to use the registered trademark with the Trademark Office.

Assignment documentation: What documents are required for assignment and what form must they take?

The required documents for assignment are:

- application form - this form has to be signed by both parties;
- certificates of business (for corporations) or personal identifications (for individuals) in Chinese from both assignor and assignee - each certificate has to be signed by each party; and
- assignment contract in Chinese - this contract has to be signed by both parties.

No notarisation or legalisation is required.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

As provided in article 25 of the Regulations for the Implementation of the Trademark Law, when a registered trademark is to be assigned, both the assignor and assignee shall jointly send an application for assignment of the registered trademark to the Trademark Office. The Trademark Office shall, upon approval of the application for assignment of the registered trademark, issue the assignee a corresponding certification and publish the assignment.

-- from gettingthedealthrough.com (Trademarks 2011, China, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision: Rights and interests concerning intellectual property are covered by various provisions of (i) Contract Law, (ii) Patent Law and its Implementing Regulation, (iii) Copyright Law and its Implementing Regulation, (iv) Regulations on the Protection of Layout-design of Integrated Circuits and its Implementing Regulation, (v) Regulations on Computer Software Protection, and (vi) Regulations on the Protection of New Varieties of Plants and its Implementing Regulation. Some of these rules are mandatory rules and others may be modified by contract between the employer and employee. See a more detailed discussion on pages 1 through 3 of AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property < <https://www.aippi.org/download/commitees/183/GR183china.pdf> >.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property < <https://www.aippi.org/download/commitees/183/GR183china.pdf> > (China)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CN> >

The works-made-for-hire rules for employees and independent contractors in Australia, China, France, Germany, Japan, the United Kingdom, and the United States are discussed in the article “Analysis of International Work-for-Hire Law,” by Sutherland Asbill & Brennan LLP (2004)

< <http://www.sutherland.com/alertspubs/searchresults.aspx?keyword=international&publicationtype=&practice=&industry=&authors=&year=&fromsearchpage=alertspubs> >

COLUMBIA

Labour & Employment

Colombian labour legislation establishes that the profits from all inventions created by employees while performing their activities belong to the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, Colombia, Ques #28)

Patents

The right to the patent belongs to the inventor or his or her successor. This right may be transferred by an inter vivos act or through succession. Patent owners may be moral or legal persons. In the case of inventions created under an employment relationship, the employer, whatever its form and nature may be, is the owner, but would be able to assign part of the financial advantages of the inventions to the benefit of employee-inventors, in order to encourage research activities.

Patent ownership is officially transferred when a copy of the document, in which the inventor assigns the right of the patent to the applicant, is filed with the patent application.

-- from gettingthedealthrough.com (Patents 2011, Columbia, Ques. #15)

Copyright

The following are the owners of the copyright:

- the author of his or her work;
- the performer of his or her performance;
- the producer of recorded material of his or her recording;
- the broadcasting organisation of its broadcast;
- the successors in title either specific or universal, of the aforementioned owners; and
- the natural person or legal entity who by contract obtains the right, at his or her own account and risk, to produce a scientific, literary or artistic work made by one or more authors under work-for-hire conditions.

There is no automatic transfer of copyright between an employer and an employee in any circumstances. ***Work contracts, for example, generally cannot contain agreements assigning the intellectual creations of the employee to the employer, even if referring to the exercise of his or her functions.***

The employee may transfer his or her rights to the employer, either wholly or in part. ***The transfer of rights cannot include moral rights.*** The assignment of copyright should be signed by the employer and the employee and registered at the Copyright Office.

-- from gettingthedealthrough.com (Copyright 2010, Columbia, Ques. #22 & 23)

In the absence of proof to the contrary, the person whose name, pseudonym or other identifying mark is visibly shown on the work is presumed to be the author of a work. Nonetheless, a person other than the author, whether a natural person or legal entity, may advertise ownership of the patrimonial rights in a work, after an assignment of the patrimonial rights in his or its favour has taken place.

In the absence of proof to the contrary, employers may exercise original or derived ownership of works created by employees by virtue of employment relations. But an assignment of the patrimonial rights over the work must first take place for an employer to actually own a work made by an employee. The assignment must be signed within a public deed or in a private document acknowledged before a notary public, and later recorded before the National Authors' Rights Registry in order for the assignment to be binding against third parties. The National Authors' Rights Directorate currently requires for the assignment to be signed by both the assignor and assignee.

-- from gettingthedealthrough.com (Copyright 2011, Columbia, Ques. #22 & 23)

With respect to independent contractors, the hiring party can own a copyrighted work if the conditions of the work made for hire are complied with. By virtue of the agreement between the hiring party and the authors, the latter automatically transmits his or her economic rights to the former, but retains the moral rights. The assumption is valid if:

- a written service agreement exists between the author and the person ordering the work, indicating the corresponding fees - consequently, the contract cannot have a employment nature;
- the work must be prepared at the account and risk of the person ordering it; the person ordering the work must assume the costs and furnish the elements required to develop the creation; and
- the work must be prepared as per the plan designed by the person ordering it, who previously indicates its conditions, characteristics and attributes and establishes guidelines as to the time, form and place for its development.

-- from gettingthedealthrough.com (Copyright 2010, Columbia, Ques. #24)

A hiring party may own rights to a work made by an independent contractor when the contract relates to the implementation of a photograph, painting, portrait drawing, engraving or other similar work.

In addition, a hiring party may own rights to any other kind of work of an independent contractor if the work is created at the risk and expense of the hiring party and according to plans specified by the hiring party. This last case is similar to the work made for hire concept in copyright law.

-- from gettingthedealthrough.com (Copyright 2011, Columbia, Ques. #24)

Moral rights are recognised in article 30 of Law No. 23 of 1982, which comprises the following rights:

- the right to the authorship of the work. Often called the paternity right, it allows the author to vindicate at all times the paternity of his or her work and to demand that his or her name is indicated if the work is reproduced, translated, adapted, transformed or communicated;
- the right to the integrity of the work allows authors to oppose deformation, mutilation, or any other modification of the work, when such acts can cause prejudice to his or her honour or reputation or demerit the work. This rule has an exception regarding architectural pieces where the author cannot oppose to modifications. As per article 43 of Decision No. 486, the author cannot impede the owner of the building from modifying the work, but may prevent his or her name from being associated with the altered work;
- the right to keep the work unedited or anonymous, until the author's death, or even afterwards if expressed through a testamentary provision;
- the right to modify the work prior to or after its publication; and
- the right of withdrawal. By virtue of this right, the author can withdraw the work from circulation or suspend any use of it even though it had been previously authorised. This right is exercised in a discretionary manner by the author and does not require any formalities. In any case, it is limited to collecting the edition, that is, to withdrawing the copies that are not sold from bookshops. The author cannot exercise this right in regards to the copies that were already purchased.

-- from gettingthedealthrough.com (Copyright 2010, Columbia, Ques. #12)

Moral rights are recognized and also considered fundamental rights as stated by the Constitutional Court in judgement C-155/98.

Authors' rights encompass two types of rights: patrimonial rights and moral rights.

Patrimonial rights comprise the right to carry out, authorise or prohibit, among other things, the following:

- the reproduction of the work by any means or process;
- the communication of the work to the public by any means serving to convey words, signs, sounds or images. Communication to the public is understood to mean any act by which two or more persons, whether or not they are gathered together in the same place, may have access to the work without the prior distribution of copies to each one of them, and especially the following:
 - stage presentations, recitals, dissertations and public performances of dramatic, dramatico-musical, literary and musical works by any means or process;
 - the public projection or showing of cinematographic and other audiovisual works;
 - the transmission of any work by broadcasting or any other means of wireless distribution of signs, sounds or images. The concept of transmission also includes the sending of signals from a ground station to a broadcasting or telecommunication satellite;
 - the transmission of works to the public by wire, cable, optic fibre or other comparable process, whether free or on subscription;
 - the retransmission, by any of the means specified above and by a broadcasting organisation different from the original one, of the work of broadcast by radio or television;
 - the emission or transmission in or to a place accessible to the public and by means of any appropriate apparatus, of a work broadcast by radio or television;
 - the public display of works of art or their reproductions;
 - public access to computer data bases by means of telecommunication, insofar as the data bases incorporate or constitute protected works;
 - in general, dissemination of signs, words, sounds or images by any known or future process.
- the distribution of copies of the work to the public by means of sale, lending or hiring;
- the importation into the territory of any Andean Community member country (Bolivia, Colombia, Ecuador or Peru) of copies made without the authorisation of the rights owner;
- the translation, adaptation, arrangement or other transformation of the work;

and the authors of works of art and their successors in title also have the inalienable right to be granted a share in the successive sales of the work by public auction or through a professional art dealer.

While moral rights comprise the inalienable, unattachable, imprescriptible and unrenounceable right to:

- keep the work unpublished or to disclose it;
- claim authorship of the work at any time; and
- object to any distortion, mutilation or alteration of the work that is prejudicial to the integrity or to the reputation of the author;

and on the author's death, the exercise of moral rights passes to his or her successors in title.

Performance rights are covered by neighbouring rights, which give the right to performers to authorise or prohibit the communication to the public of their live performances in any form and the fixing and reproduction of their performances.

Performers may also demand an equitable remuneration for the communication, rental or making available to the public of the works or audiovisual recordings where their performances are fixed, with the exception of cases where the communication is made for educational and non-profit purposes, or merely to entertain employees at a work place.

Performers also have the moral right to:

- demand that their names be mentioned at or associated with every performance that takes place; and
- object to any distortion or mutilation of their performances or to other acts that might adversely affect their prestige or reputation.

Performers, however, cannot object to the communication of their performances to the public when they have been previously broadcast or made from a previously authorised fixation.

-- from gettingthedealthrough.com (Copyright 2010, Columbia, Ques. #s 5, 10, and 12)

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person, whether public or private and having either Colombian or foreign nationality, may apply for the registration of a trademark. Associations of producers, manufacturers, organisations or groups of individuals legally established, and government, regional or international entities are included among the above.

Assignment: What can be assigned?

The trademark owner or applicant may assign the mark either entirely or partially in connection with the goods or services covered, with or without other assets from the business it belongs to.

Assignment documentation: What documents are required for assignment and what form must they take?

For the assignment to be valid it is necessary that the assignment is stated in writing. The document is signed by the parties and is authenticated before a notary. If the signatory is domiciled abroad, his or her signature should be legalised in accordance with the law of such country and apostilled or authenticated before the Colombian Consulate.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment between the parties will be valid if stated in writing.

In order to be effective and enforceable against third parties, the assignment should be recorded with the Trademark Office. Notwithstanding the above, the Trademark Office is empowered to refuse to record the assignment if it causes a risk of confusion or does not comply with the norms regulating business practices that restrict free competition.

-- from gettingthedealthrough.com (Trademarks 2011, Columbia, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CO> >

COSTA RICA

Labour & Employment

Copyright is regulated by the Copyright Law No. 6683. The law includes literary and artistic productions such as books, brochures, letters, programmes, choreographies, music compositions, architectural plans and drawings. The author of any of these works will be owner of both the moral rights and the patrimony rights.

The moral right is personal, inalienable and gives the titular the facility to maintain the original work or to remove it from circulation, to prevent its public sale to the public and to prevent the titular's name to be mentioned in any reproduction. The patrimony right can be transferred.

On the other hand, the Copyright Law of Inventions, Drawings and Industrial Utility Models establishes that '[...]when an employee, whose contract [...] doesn't have as an object the production of inventions, the ones that he produces will be his own'.

A third of the income he obtains for the invention will be paid by the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, Costa Rica, Ques #28)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CR> >

CYPRUS

Labour & Employment

Under the Patents Law, when an invention has been ordered or is invented in the course of a contract of employment the intellectual property rights to the patent belong to the person who gave the order or the employer as the case may be, subject to any contractual arrangements to the contrary. The inventor employee nevertheless has the right to a fair remuneration, taking into account the value of the invention and the benefit accruing to the employer. In the event of disagreement as to what constitutes fair remuneration, this will be determined by the court.

-- from gettingthedealthrough.com (Labour & Employment 2011, Cyprus, Ques #28)

Patent

The right to a patent belongs to the inventor or its successor in title. Joint inventors - unless otherwise agreed - have equal rights. In cases of employer-employee relationships the ownership of the invention may be regulated by contract, as the law does not interfere with the freedom of contract. Nevertheless, if no such contract exists then the law provides that if the invention took place during the performance of a specific task, the right belongs to the person who ordered such invention. If the invention occurs during employment, the right to the invention belongs to

the employer unless otherwise agreed. Patent ownership is recorded and transferred through the registrar of patents (see sections 10 and 11 of Law 16(1)/1998).

-- from gettingthedealthrough.com (Patents 2011, Cyprus, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person may apply for ownership of a trademark, provided the statutory requirements of an application are met. Applications by co-owners are also possible.

Assignment: What can be assigned?

Following section 24 of the Law, only a registered trademark may be assigned on the transfer of a business, with the entire or the remainder of the goodwill of the business. The vast majority of trademark assignments include the transfer of goodwill. However, assignments are permitted as well without goodwill and no special formalities are required to effect them. The Law does not prohibit assignment for all or some of the goods or services. In order to be effective, the assignment has to be approved by the registrar.

Assignment documentation: What documents are required for assignment and what form must they take?

To register an assignment an applicant must submit the following documents:

- original contract of assignment in Greek, stamped - if the agreement is in English it will have to be translated in Greek and accompanied by an affidavit verifying the authenticity of the translation; and
- form TM16.

If the registrar is satisfied, then the new owner will be given a letter stating that he or she is the new owner of the mark.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The Law does not require recording as part of an assignment procedure. However, if a trademark is not assigned [perhaps should read: "if a trademark assignment is not recorded"], the assignee will not be able to enforce it. Consequently recording is a must.

-- from gettingthedealthrough.com (Trademarks 2011, Cyprus, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CY> >

CZECH REPUBLIC

Labour & Employment

If an inventor-employee has made an invention as part of his work deriving from an employment relationship, the right to the patent passes to the employer. Where the employer does not claim the right to the patent, the right reverts to the inventor. Any inventor who has made an invention under an employment relationship is entitled, where the employer claims the right to the patent, to appropriate remuneration from the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, Czech Republic, Ques #28)

“No Overreaching” Provision: Rights and interests concerning intellectual property are covered by various provisions of (i) Copyright Act (see Section 58(1)), (ii) Patent Act (see Section 9(1)), (iii) Utility Model Act, (iv) Design Act (see Section 13(1)), and (v) Plant Variety Act (see Section 2(c)). These statutory provisions in each of the above Acts are not mandatory and may be modified by contract between the employer and employee. **However, the modifying contract has to be executed before or at the time of the origin of the intellectual property right otherwise the statutory provision applies. Retroactive contracts are not effective.**

Additional information can be found at:

AIPII.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183czech.pdf> > (Czech Republic)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=CZ> >

DENMARK

Labour & Employment

As a general and practical rule, products created by an employee during employment belong to the employer. The products are considered as the quid pro quo for the salary. To avoid conflicts and misunderstanding, the issue is often stated in the contract or a collective agreement.

Inventions that are patentable in Denmark are covered by the Act on Employee Inventions. The general rule of the Act is that the invention belongs to the employee. The employee is, however, obligated to inform the employer of the invention. Then, it is for the employer to decide if he or she wants to use the invention. If he or she decides to do so, the employer must pay compensation to the employee, unless the value of the invention is less than what the employer may reasonably expect the employee to perform.

-- from gettingthedealthrough.com (Labour & Employment 2010, Denmark, Ques #28)

For patentable inventions, the rights of employees are governed by the Danish Employee Inventions Act. Most of its provisions are not mandatory and the employer and employee can thus opt out of them by agreement.

For non-patentable inventions, the general rule is that such inventions belong to the employer because they are seen as a result of the work performed by the employee in the course of his or her employment.

-- from gettingthedealthrough.com (Labour & Employment 2011, Denmark, Ques #28)

Patents

If a company employee makes an invention for the company in accordance with the employee's contract, the general rule is that the employee has to transfer the rights to the invention to his or her employer for a reasonable remuneration.

Inventions made by multiple inventors will be owned jointly by all the inventors. All the inventors will thereby be registered in the patent register as inventors of the invention. The Danish Patent Act has no provision to regulate the co-ownership of joint patent rights and therefore the main rule is that all decisions about the patent require unity. Therefore it is recommended that the inventors make and sign an agreement to settle the details in their co-ownership of the joint patent right.

Patent rights are property rights and can therefore be transferred by an agreement, assignment or other documents proving the transfer of the patent right. The ownership or transfer of ownership will be recorded by the Danish Patent and Trademark Authorities in the patent register.

-- from gettingthedealthrough.com (Patents 2011, Denmark, Ques. #15)

Copyright

Ownership of a copyright at any given time depends on the transactions that have taken place since the initial creation of the work; therefore, the Copyright Act does not in itself decide any current ownership. The Act does, however, define who is the initial owner of the copyright. The initial owner will always be the creator of the work in question.

A work created by an employee in the normal course of employment belongs - if there is no other agreement between the employer and the employee - to the employee. The Copyright Act does not provide any general regulation on this. The act was made under the - perhaps idealistic - assumption that all authors are free and independent artists.

Legal theory and precedent agrees that where there is no legal framework or inter partes agreement, copyright which subsists in a work created during the course of employment may to a certain degree be transferred to the employer to the extent that could be relevant for the usual business of the employer. For example, it is a natural prerequisite condition for a newspaper to pay a salary to a journalist and consequently have the right to print the journalist's article in the paper.

If the work has not been made by the employee in the course of employment, but in the employee's free time, or if the work is, say, a painting or a music score made by a journalist, the employer will not have any right to the work. The time for the creation of the work and the nature of the work and employment will therefore determine which works belong to an employer.

Computer software is an exception: the copyright for computer software written by an employee as part of his normal work will belong to the employer.

-- from gettingthedealthrough.com (Copyright 2010, Denmark, Ques. #22 & 23)

The owner of the copyright is the person who has created the work. Copyright cannot originate in a legal person; however, copyright can be assigned to a legal person. Subject to the limitations following from section 3 on moral rights and section 38 on droit de suite, the copyright owner may assign wholly or partly their rights under the Act (see section 53 of the Act).

Section 7 of the Act contains a legal presumption as to who is the copyright owner of a work: if not otherwise stated, the person whose name or generally known pseudonym or signature is indicated in the usual manner on copies of the work, or where the work is made available to the public, shall be deemed to be the author.

The Act contains no general rule on copyright in employment relationships.

Only regarding computer programs is there a rule in relation to employment in section 59 of the Act: where a computer program is created by an employee in the execution of his duties or following instructions given by his employer, the copyright in such a computer program shall pass to the employer. This means that the employer obtains the copyright to computer programs created in the employment situation, unless otherwise agreed.

Except for computer programs, the starting point is, therefore, that it is the employee (the employed author) who possesses the copyright. But the copyright can be transferred to the employer, including under an explicit agreement. Transfer may also take place via an implicit agreement or common practice.

Thus, without an explicit agreement rights may be assigned due to employment if the employment is permanent and the work is made in the course of the employment. Commissioned works and freelancers are not encompassed (see next section regarding independent contractors).

According to case law, in this situation of employment the employee only assigns to the employer what is necessary for the employer's usual business.

If the work has not been made by the employee in the course of employment, but in the employee's spare time, or if the work is not part of the employee's work duties, the employee will own the copyrighted work, and the employer will not have any rights in it.

-- from gettingthedealthrough.com (Copyright 2011, Denmark, Ques. #22 & 23)

With respect to independent contractors for commissioned or hired works such as photographs, films, portraits or sound recordings, the parties may make an agreement which allows the commissioner to gain certain rights to the use of the work - normally the right to a copy of the work. However, the clear rule in the Copyright Act is that the copyright as such belongs to the creator.

In some cases, this may be implicit. If a reader sends a letter to the editor of a newspaper, the newspaper may assume that the reader has given tacit consent to publication.

The Danish Copyright Act does not prescribe any form of agreement relating to copyright. These agreements are seen as common agreements under Danish law; an agreement does not have to be in writing (though proof of its scope, existence and contents may otherwise be difficult).

-- from gettingthedealthrough.com (Copyright 2010, Denmark, Ques. #24)

With respect to independent contractors, Section 53 of the Act provides that where a right to exploit the work in a specific manner or through specific means has been assigned, the assignment does not give the assignee the right to exploit the work in any other manner or through any other means. According to this principle, assignments of copyright have to be interpreted narrowly.

When a work is commissioned, the commissioner (the hiring party) normally does not get any rights to the commissioned work without an explicit agreement with the author. The transfer of copies will not include an assignment of the copyright, see section 53 (2). However, it may be agreed implicitly in connection with the commission agreement that to a certain extent the hiring party gets rights to exploit the work. Thus the hiring party gets the rights that are necessary to fulfil the purpose of the agreement. Conversely, even without an explicit agreement to this effect certain limitations on the author's use of a commissioned work normally apply. For instance it is often implied between the parties that the author is not entitled to produce more copies of the work than the one acquired by the commissioner.

-- from gettingthedealthrough.com (Copyright 2011, Denmark, Ques. #24)

The Danish Copyright Act protects a number of moral rights, including droit de paternité, droit de respect and droit de suite. These rights are not considered to be related to the owner's monetary interests.

These **moral rights cannot be transferred or relinquished**. In principle, they extend beyond the normal copyright protection in perpetuity.

-- from gettingthedealthrough.com (Copyright 2010, Denmark, Ques. #12)

The Act recognises moral rights in section 3: the right to be named or credited as the author (droit à la paternité) and the author's right of integrity (droit au respect), which implies that the work must not be altered or used in an offending way or in an offensive context. As a main rule, the **moral rights cannot be waived by the author, and consequently they cannot be transferred**. Even when the copyright has expired, a literary or artistic work may not be altered or made available to the public contrary to section 3 if cultural interests are thereby violated (see section 75).

-- from gettingthedealthrough.com (Copyright 2011, Denmark, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

As an introductory remark, it must be noted that all matters relating to Danish trademarks are regulated by the Danish Act on Trademarks (the Trademarks Act). No references are made in this chapter to the European Community Trademark Regulation.

According to the Trademarks Act, private persons and legal entities may apply for a trademark in Denmark. The Trademarks Act contains no requirements regarding the activities of such trademark-holders, hereunder whether the trademark-holder is engaged in commercial activities.

An application form may be downloaded from the Danish Patent and Trademark Office's website (www.dkpto.dk) and may be submitted in the Danish, English, Swedish and Norwegian languages. However the list of goods and services must be submitted or translated into Danish.

A trademark application must contain the following information for recognition at the Danish Patent and Trademark Office:

- the applicant's name and postal address;
- the name and address of any representative (representation is not required);
- representation of the mark; and
- a list of goods and services divided into classes (see question 5).

If these formal requirements are met an application number will be granted.

Note that the Trademarks Act does not apply to collective marks - that is, trademarks that are meant to be used by particulars other than the trademark-holder, for example, members of an organisation. Instead the Danish Act on Collective Marks applies. The Collective Marks Act is not subject to this article. It is worth noting however, that the Act on Collective Marks makes reference to a vast majority of the Trademark Act's provisions, hereunder to the administrative rules regarding applications.

Assignment: What can be assigned?

An assignment of a trademark is considered an agreement between two independent parties, which, due to the Danish legal principles on contractual freedom, gives the parties the right to freely agree on, for example, a partial assignment with regard to specific goods or services, geographical areas, goodwill, other intellectual property assets, etc.

Assignment documentation: What documents are required for assignment and what form must they take?

The assignment is a bilateral agreement and does not need to meet any formal requirements, content, notarisation, etc.

However, due to the burden of proof, it is recommended to draft and sign an agreement containing information regarding the parties, the trademark at hand (including registration number), a representation of the trademark, classification, geographical areas and goods and services, in order to establish the scope of the assignment.

A template regarding assignment is found on the Danish Patent and Trademark Office's website (www.dkpto.dk).

Validity of assignment: Must the assignment be recorded for purposes of its validity?

An assignment becomes valid when agreed by the trademark-holder and the assignee regardless of form. If the trademark right has been registered in the Danish Patent and Trademark Office's database (www.dkpto.dk), the parties need, however, to notify the Danish Patent and Trademark Office of the assignment in order for the Danish Patent and Trademark Office to change the registered information regarding the rightholder.

A template regarding assignment may be found on the Danish Patent and Trademark Office's website (www.dkpto.dk).

-- from gettingthedealthrough.com (Trademarks 2011, Denmark, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/commitees/183/GR183denmark.pdf> > (Denmark)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=DK> >

See [Who Owns IP in Research & Development](http://www.biolegis.com/uploads/tx_articles/Who_owns_IP-Denmark.pdf) < www.biolegis.com/uploads/tx_articles/Who_owns_IP-Denmark.pdf >

DOMINICAN REPUBLIC

Labour & Employment

Articles 8 and 9 of Law No. 20-00 governing industrial property regulate these matters.

Inventions made while under contract

- Under article 8, when an invention is made while under a work or service contract or as part of such a contract, or under an employment contract, the patent rights to the invention belong to either the person who contracted the work or service or the employer, unless a contractual provision to the contrary exists.
- If the invention has an economic value much greater than the parties could have reasonably foreseen when terminating the contract, the inventor is entitled to a special remuneration that is determined by the competent court if the parties fail to come to an agreement.
- Any contractual **provisions less favourable** to the inventor than the provisions of this article are **null and void**.

Inventions made by an employee who is not an inventor

- Under article 9, when an employee who is not contracted to invent invents something using the data or the means (or both) at his or her disposal because of his or her work and communicates the fact immediately in writing to his or her employer, if within two months of the employer receiving said correspondence or finding out about the invention by any other means (whichever occurs first) and the employer notifies the employee of its interest in the invention, the employer will be entitled to patent the invention backdated to its inception and the invention will belong to the employer. If the employer fails to notify within the established time, the employee is entitled to patent the invention.
- If the employer notifies its interest in the invention, the employee is entitled to a fair reward taking into account his or her salary and the estimated economic value of the invention. Failing an agreement between the parties, the reward will be decided by the competent court.
- Any contractual **provision less favourable** to the inventor than the provisions of this article will be **null and void**.

-- from gettingthedealthrough.com (Labour & Employment 2011, Dominican Republic, Ques #28)

Copyright

The owner of the moral rights is always the author and this right is non-transferable. The economic rights belong to the original author, but in this case, if these rights have been transferred, the same correspond to the (new) owner of the work.

An employer can own a copyrighted work made by an employee if expressly agreed by both parties. This agreement must be written in order to have legal effect.

-- from gettingthedealthrough.com (Copyright 2011, Dominican Republic, Ques. #22 & 23)

A fortiori, an independent contractor's work will remain his property too, failing written agreement. A hiring party may own the rights to an independent contractor's work if a very specific and detailed agreement is contracted.

However, economic rights are automatically transferred to the hiring party in special cases: collective works (to the director), civil servants' works (to the state), software and databases (to the producer), etc.

Even then, moral rights will always belong to and remain with the independent contractor.

Besides, it is very important to differentiate between the work support and the work itself: a hiring party ordering a painting will have the canvas, but the painter will keep his IP rights upon the work.

-- from gettingthedealthrough.com (Copyright 2011, Dominican Republic, Ques. #24)

Moral rights are recognised by copyright. According to the Copyright Law, the author of the work will have perpetual moral right over his work, and the same is non-transferable (except, partially, to his or her heirs), imprescriptible and indispensable.

-- from gettingthedealthrough.com (Copyright 2011, Dominican Republic, Ques. #12)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=DO> >

ECUADOR

Labour & Employment

Intellectual property law considers that rights originate from the mere fact of the creation of a work, independent of its merit, destination or method of expression. However, when an invention is created under an employment relationship, economic rights, if expressly agreed upon, will be between the contracting party or employer although the moral rights of the author must be recognised. When applicable, the author will also keep the right to perform an independent edition in the form of a collection.

-- from gettingthedealthrough.com (Labour & Employment 2011, Ecuador, Ques #28)

Patent

Patent holders may be natural or legal persons. The right to the patent belongs to the inventor. In the case of inventions that came about under an employment relationship, ie, by an employing company, the patent holder would be the employing company.

Patent rights are transferred from the inventors to the applicant through an assignment document. For applications via the Patent Cooperation Treaty it is not necessary to submit the assignment; however, for applications submitted in the conventional manner, an assignment document must be filed within a period of two months from the date of notification (renewable only once for the same period). In the case of foreign applications, the document must be duly legalised by the Consulate of Ecuador in the country of origin or apostilled if the country is a member of the Hague Convention.

The employer, whatever its form and nature, may transfer part of the economic benefits of the inventions for the profit of the employee inventors in order to stimulate research activity.

Entities that receive state funding for their research shall reinvest part of the royalties received from the marketing of such inventions in order to generate continued research funding and encourage researchers, giving them a share of the proceeds from innovations, in accordance with the law.

Independent contractors may submit their inventions as natural persons; therefore, the holder in this case would be the contractor as an individual.

If multiple inventors make an invention jointly, the right to the patent belongs in common to them all. That is, in this case there would be a co-ownership of the patent and, unless otherwise agreed, each of the inventors would have equal rights in the protected invention.

This patent right may be transferred by inter vivos or by succession. The transfer of a granted patent shall be recorded in writing before the national competent office - in this case, before the IEPI. The absence of this record will mean that the transfer is not effective against third parties.

-- from gettingthedealthrough.com (Patents 2011, Ecuador, Ques. #15)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=EC> >

EGYPT

Information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183egypt.pdf> > (Egypt)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=EG> >

EL SALVADOR

Labour & Employment

The Intellectual Property Law exists in Salvadorean law, and employees may register their inventions in the registries established for that effect, unless stated otherwise in the proper employment contract.

-- from gettingthedealthrough.com (Labour & Employment 2011, El Salvador, Ques #28)

Trademarks

Ownership of marks: Who may apply?

Any person or entity can apply for a mark in El Salvador, regardless of nationality, domicile or establishment.

Assignment: What can be assigned?

All the rights derived by the ownership of the trademark may be assigned. Trademarks with goodwill and without goodwill may be assigned.

The owner of the mark is allowed to assign some or all the goods or services protected by a mark and reserve the rights over the goods or services (or both) not assigned. Prior to partial assignment, the registrant must follow a trademark division procedure to separate under different registrations the goods or services to be assigned.

Trade names can only be transferred along with the company or the establishment that uses it or with the part of the company or establishment that uses it.

Assignment documentation: What documents are required for assignment and what form must they take?

The required documents are the assignment documents executed by both parties, duly notarised and legalised by the nearest Consulate of El Salvador or alternatively, by apostille.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

According to the Trademark Law all changes of name, assignments, changes of domicile and others must be recorded against each mark.

-- from gettingthedealthrough.com (Trademarks 2011, El Salvador, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=SV> >

ESTONIA

Copyright

A physical person who creates a copyrighted work is being regarded as the 'author'. A person (either physical or legal) who acquires economic right(s) of the author by the law as a legal successor or by the licence as a contracting party is regarded as the 'copyright holder'.

Article 16(1) of CA provides that copyright in a work belongs to the author or his or her successor regardless of who has the right of ownership in the economic object in which the work is expressed.

Article 32(1) of CA stipulates that the author of a work created under an employment contract or in the public service in the execution of his or her direct duties shall enjoy copyright of the work but the economic rights of the author to use the work for the purpose and to the extent prescribed by the duties shall be transferred to the employer unless otherwise prescribed by contract.

According to the Estonian Employment Contracts Act, employment contracts have to be in a written format. Nevertheless, the employment contract does not have to contain a special mention about the transfer of author's economic rights, since the transfer of authors' rights is to be effected under CA.

It is important to take into account that moral rights of the author remain with the employee who has created the work. In order to acquire the corresponding authorisation to use the moral rights of author the employer is obliged to sign a separate contract with the employee or include the issues related to authors' moral rights into the employment contract.

-- from gettingthedealthrough.com (Copyright 2010, Estonia, Ques. #22 & 23)

A hiring party may acquire economic rights of the author only by the contract, whereas the transfer of rights or corresponding licence has to be expressly stated in the contract of services or in any other similar contract.

CA provides for a higher level of protection applicable in cases where the author is a physical person and usually the weaker party in the legal relationship.

Article 49(1) provides that an author's contract has to be entered into in writing. The grant of a non-exclusive licence may also be made in a format that can be reproduced in writing (for example e-mail, fax, etc).

-- from gettingthedealthrough.com (Copyright 2010, Estonia, Ques. #24)

Article 12 of the CA provides for nine separate moral rights (also called personal rights) of the author:

- right of authorship;
- right of author's name;
- right of integrity of the work;
- right of additions to the work;
- right of protection of author's honour and reputation;
- right of disclosure of the work;
- right of supplementation of the work;
- right to withdraw the work; and
- right to request that the author's name be removed from the work which is being used.

All those moral rights listed above are of exclusive nature.

-- from gettingthedealthrough.com (Copyright 2010, Estonia, Ques. #12)

Additional information can be found at:

Ownership of the Copyright in Works and the Patent Rights in Inventions Created by Employees
< <http://www.juridicum.su.se/user/sawo/Publikationer/Wolk%20nr%20120.pdf> > (in Finland, Sweden, Germany, Austria, the United Kingdom, Estonia, and Argentina).

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=EE> >

EUROPEAN UNION

Information can be found at:

Outline of the IP legal system of the European Union < <http://www.wipo.int/wipolex/en/outline/eu.html> >
(from WIPO Lex)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=EU> >

For a recent decision regarding ownership of commissioned designs under Community law, see FEIA v. Cul de Sac, ECJ [2009] < http://www.ippt.eu/files/2009/IPPT20090702_ECJ_FEIA_v_Cul_de_Sac.pdf >.

-- from a link to a Class 99 blog entry posted by David Musker on July 29, 2009

< <http://class-99.blogspot.com/2009/07/ecjs-feia-decision-on-commissioned.html> >

FINLAND

Labour & Employment

The Act on the Right in Employee Inventions (1967) applies to employee inventions patentable in Finland. Accordingly, an employer may obtain the right to a patentable invention created by an employee provided that the IP is created in connection with the employee's employment and it is exploitable within the employer's business. Should the invention be created in connection with a clearly specified work assignment, the employer obtains the right to the created IP even if it would not be directly usable within the employer's current operations.

There are no specific provisions in the general Copyright Act (1961) regarding the transfer of intellectual property rights relating to works created by an employee except for computer software and databases. Therefore, the legal situation is somewhat unclear in this regard but it may be argued that a copyright relating to employee works belongs to an employee unless otherwise agreed or unless regulated by common general practices in the particular area of business.

-- from gettingthedealthrough.com (Labour & Employment 2011, Finland, Ques #28)

Copyright

The physical person who created the work is its original owner. The original ownership of a work protected by copyright always belongs to a physical person and can only be transferred by a contract to a company or another party.

The employee acquires the initial ownership of a work protected by copyright. Ownership is not automatically transferred by virtue of the employment relationship. However, unless otherwise agreed, in practice the general rule is that the employer acquires a right to freely exploit a work within the employer's field of activities.

A special rule in the Copyright Act transfers to the employer the ownership of computer programs and databases protected by copyright which are created in the scope of employment duties.

-- from gettingthedealthrough.com (Copyright 2011, Finland, Ques. #22 & 23)

With respect to independent contractors, ownership is not transferred to a hiring party automatically by virtue of the hiring relationship. The transfer of ownership must be agreed on separately. There are no specific requirements regarding the form of a copyright assignment. All types of agreements (written, oral or implied) are valid, but it is advisable to have an agreement in writing.

-- from gettingthedealthrough.com (Copyright 2011, Finland, Ques. #24)

Moral rights are recognised. An author has the right to be acknowledged as the author of his work. Further, a work may not be altered or made available to the public in a manner which is prejudicial to the author's literary or artistic reputation, or to his individuality. In addition, an author has a right of access allowing him to see a work which he has transferred.

Copyright is divided into two categories: economic rights and moral rights. Economic rights provide the author with the exclusive right to control a work by reproducing it and by making it available to the public. A work is made available to the public when:

- it is communicated to the public by wire or wireless means, including communication in a way which enables members of the public to access the work from a place and at a time individually chosen by them;
- it is publicly performed to an audience;
- a copy is offered for sale, rental or lending or is otherwise distributed to the public; or
- it is publicly displayed without the aid of a technical device.

However, it should be noted that these rights are restricted by various exceptions which may be found in Chapter 2 of the Copyright Act.

Three moral rights are acknowledged for an author. Firstly, the author's name must be stated in a manner required by proper usage when a work or copies of it are made available to the public. Secondly, the author has a right to object to derogatory treatment of his work. Thirdly, the author of fine art has a right of access, allowing him to see the work he has transferred.

-- from gettingthedealthrough.com (Copyright 2011, Finland, Ques. #12 & 5)

“No Overreaching” Provision: Section 2 of the Act on the Right in Employee Inventions provides that contractual terms that are incompatible with certain specified provisions of the Act are void.

Section 2 – The provisions of this Act shall be applied insofar as nothing else has been agreed upon or can be considered to appear from the employment contract or from other circumstances. However, **contractual terms incompatible** with section 3, section 6(2), section 7(1) and (3), section 7a, section 8(2) or section 9 **are void**.

Additional information can be found at:

Act on the Right in Employee Inventions 29.12.1967/656
< http://www.wipo.int/wipolex/en/text.jsp?file_id=127134 > (unofficial English translation)

Act on the Right in Employee Inventions 29.12.1967/656
< http://www.wipo.int/wipolex/en/text.jsp?file_id=127122 > (in French)

Decree on the Right to Employees' Inventions 10.6.1988/527
< http://www.wipo.int/wipolex/en/text.jsp?file_id=127135 > (unofficial English translation)

Ownership of the Copyright in Works and the Patent Rights in Inventions Created by Employees
< <http://www.juridicum.su.se/user/sawo/Publikationer/Wolk%20nr%20120.pdf> > (in Finland, Sweden, Germany, Austria, the United Kingdom, Estonia, and Argentina).

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183finland.pdf> > (Finland)

--thanks to Folke Johansson for the lead to the aippi.org website and Working Committee

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=FI> >

Act on Utility Model Rights (No. 800/1991)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=193998 > (in English)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=193983 > (in Finnish)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=193993 > (in Swedish)

Copyright Act (No. 404/1961)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=208099 > (unofficial English translation)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=194350 > (in Finnish)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=208101 > (in Swedish)

Registered Designs Act (No. 221/1971)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=127056 > (in English)

< http://www.wipo.int/wipolex/en/text.jsp?file_id=127058 > (in French)

Council Regulation on Community Designs (6/2002/EC) (see Article 14)

< http://oami.europa.eu/ows/rw/resource/documents/RCD/regulations/62002_en_cv.pdf >

FRANCE

Labour & Employment

The Intellectual Property Code provides for the rules applicable to any software created by an employee in the performance of his or her duties: the invention created by the employee in the performance of his or her duties shall belong to the company and all rights shall be assigned to the company. The employee will be eligible for additional compensation in consideration for his or her invention.

When the invention is created by the employee outside of normal work duties, the invention belongs to the employee. However, when such an invention has been created by the employee during the performance of normal work duties, in the field of activity of the employer, by knowledge of documents or studies belonging to the employer or with material or installations belonging to the employer, the employer has the option to claim ownership of all or part of the rights deriving from the invention. The employee will be eligible for fair compensation in consideration for his or her invention.

The employer has no rights on inventions created by corporate officers.

-- from gettingthedealthrough.com (Labour & Employment 2011, France, Ques #28)

Patents

In principle, the invention belongs to its inventor or the inventor's successor.

Employee inventions are governed by article L611-7 of the IPC. The IPC defines the categories of employee inventions and the respective rights of the employer and the employee.

According to this article, two categories of inventions have to be distinguished:

- a first category that automatically belongs to the employer concerns 'mission' inventions. Those inventions created by the salaried person in accordance with the terms of mission inventions stipulated in his or her employment contract, or if the employer has explicitly ordered the employee to carry out study and research relating to the invention fall into this category. It would appear from this article that the inventive mission is either permanent, within the framework of work carried out as defined by the employment contract, or casual; and
- a second category that belongs to the employee concerns 'out-of-mission' inventions because they are created without a particular order or mission to do defined research work.

When the invention's subject matter falls within the activity of the employer, the employer may request on a case-by-case basis that the invention and all derivative rights be assigned to it for a payment.

On the other hand, when the invention is outside the scope of activity of the employer, the employee may transfer the rights over the invention to any party.

All legal acts that affect IP rights have to be entered onto the Patent Register maintained by the Patent Office to be opposable against third parties.

-- from gettingthedealthrough.com (Patents 2011, France, Ques. #15)

Copyright

The initial owner is always the author, which may only be a natural person. The author's heirs or assignees may also own the patrimonial rights to a work. Moral rights may not be assigned, only inherited.

An employer may own the rights of his or her employee provided that a written, detailed and legally appropriate assignment of rights has been entered into with the author. The employment contract does not by itself entail assignment of authorial rights to the employer, except when the work created by the employee is software. In the absence of a written assignment of the rights pertaining to a particular work, an employee remains in control of his authorial rights should he or she create a work. If the assignment of rights is valid, the employer becomes the owner, but the employee always remains the author and holds the moral rights. It is recommended that assignment provisions be included in employment contracts.

There is a notable exception concerning state employees, whose rights are automatically assigned to the state for the benefit of 'public service'.

-- from gettingthedealthrough.com (Copyright 2010, France, Ques. #22 & 23)

As a matter of principle, authors as individuals are owners of copyrighted work, which may be assigned once they are created. French law presumes that the person under which the work has been published is deemed to be the author. Also, French law expressly provides the prohibition of a global assignment of future works.

In practice, works may be created by several individuals. In this case, according to French law there may be a collaborative effort (the contribution of each individual is distinguishable) or a collective work (ie, an encyclopedia, where the contribution of each individual is not distinguishable).

Exceptionally, French law provides that authors' rights on collective works may be owned by either natural or legal persons, as rights on collective works are owned by the natural or legal person who initiates it, edits it and publishes it under his direction and name, and in which the personal contributions of the various authors who participated in its production are merged in the overall work for which they were conceived, without it being possible to attribute to each author a separate right in the work as created.

Also, French law presumes that the authors of audiovisual works include the author of a script or scenario, the author of an adaptation, the author of spoken text, the author of musical compositions and the director.

Finally, regarding the advertising industry, French law provides an assignment to the producer as long as the contract between the agency and the producer specifies the separate remuneration payable for each mode of

exploitation of the work, in particular, with reference to the geographical area, the duration of exploitation, the size of the printing and the nature of the medium.

French law expressly provides that an employment or service contract does not limit the rule according to which the author is the owner of authors' rights for a created work. Most assignments of authors' rights need to be in writing. Furthermore, French law provides that, to be valid, an assignment of patrimonial authors' rights must specify separately each right assigned, the field of exploitation of the assigned rights, its scope and purpose, and its location and duration. Also, as a matter of principle, the royalties due to the author must be proportionate to the revenue from the sale or exploitation of the work.

Exceptionally, in cases of works created by civil servants, the State is the owner of the patrimonial rights on such works provided they were created during the exercise of the civil servant's functions (the wording is similar to requirements used in French patent law), or according to received instructions and as long as the use of such work is strictly necessary for a mission of public service. For a commercial use of the work, the State shall only own a preference right.

Also exceptionally, in cases of collective works (that is the case when the contribution of each person is not distinguishable), the employer, may be directly vested of authors' rights.

-- from gettingthedealthrough.com (Copyright 2011, France, Ques. #22 & 23)

A hiring party may own the rights to a work created by an independent contractor provided there is a written agreement complying with certain specific requirements. The independent contractor always remains the author from a legal point of view regardless of the assignment.

Transfer of rights is never automatic. However, the Intellectual Property Code provides that the rights of authors of audio-visual works (namely scriptwriters, authors of adaptation, dialogue writers and directors) are presumed to be assigned to the producer, provided they enter into a written contract.

-- from gettingthedealthrough.com (Copyright 2010, France, Ques. #24)

As mentioned above regarding employees, a hiring party may only own authors' rights once they have been assigned according to the provisions of the IPC, or in case it is a collective work. In particular, the IPC expressly provides that authors' rights are independent of any property right in the physical object.

There specific provisions for audiovisual production contracts regarding the assignment of rights to the producer (articles L132-23 et seq of the IPC).

-- from gettingthedealthrough.com (Copyright 2011, France, Ques. #24)

Moral rights appeared during the 19th Century through case law and were later embodied in the Law by the 1957 Act. Moral rights are non-patrimonial, inalienable, perpetual and imprescriptible. For authors, they include:

- the right to divulge the work to the public;
- the right of paternity (to have one's name associated with the work or to remain anonymous or to prevent one's name from being associated with the work of another person);
- the right of respect against any alteration to the work; and
- the right of withdrawal of the work if the author is no longer satisfied with it.

Performing artists (singers, musicians, actors, dancers, etc.) also have moral rights; they encompass the protection of their name, quality and performance.

An illustration of the perpetuity of moral rights may be found in a case involving the book *Les Misérables* by Victor Hugo. One of the writer's heirs had seized the Court of Paris claiming the publication of a sequel by a contemporary writer infringed Hugo's moral rights, of which he was the guardian. In 2004, the Court of Appeals ruled in favour of the moral rightholder, despite the intentions expressed by the writer during his life to let his 'works live'. The court, by examining Hugo's comments on his work, considered that this 'monument of literature' published in 1862 was finished according to the writer and as such could not be continued. However, in 2007 this decision was reversed by the Supreme Court, which ruled that freedom of creation was due to the author of a sequel since the work had fallen into the public domain and that the lower court should not have taken the intellectual worthiness of the book into

account to examine the moral right violation. In December 2008, the Court of Appeals, to which the case was sent back to be tried again, dismissed the claims of the moral rightholders and ruled in favour of freedom of expression.

-- from gettingthedealthrough.com (Copyright 2010, France, Ques. #12)

Whereas authors moral rights are wider and more protected than those of performers, both enjoy moral rights. Authors have a perpetual, inalienable and imprescriptible right to respect for their name, their authorship and their work. In practice, authors may try to enforce moral rights either when the assignee of authors rights omits to mention the author's name (ie, in cases of industrial designs or photographs), intends to change or destroy the work for practical purposes (ie, the action from Madame Claude Lalanne against the City of Paris regarding the destruction of the garden she created), or in infringement or counterfeiting cases, where both the assignee and the author request the prohibition measures and the indemnification of the damage resulting from the infringement or counterfeiting. Thus, in many cases regarding industrial designs protected by authors' rights both the author and the assignee appear as plaintiffs.

Authors also enjoy a right to reconsider or of withdrawal, even after publication of their work, provided the indemnification of the assignee of authors' rights.

The moral rights of authors, who as civil servants have created works, have restrictions with regards to the right of disclosure and use of the work.

-- from gettingthedealthrough.com (Copyright 2011, France, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any individual or company may apply for a trademark. A trademark can also be applied for in co-ownership. A contract providing for the rules to apply between the co-owners is recommended. It is not necessary to be a French citizen or to have residence in France to apply for a trademark. No declaration of intention of use is requested either.

Assignment: What can be assigned?

A trademark can be assigned without any goodwill, for all or part of the products and services that it designates. The Trademark Office does not control the conditions of the assignment. The trademark can be assigned alone without any other assets. The evaluation of the price of the trademark is made freely between the parties, under the possible control of the price agreed by the fiscal authorities for the payment of the taxes that become due.

Fees are to be paid to the fiscal authorities, depending on whether the trademark is used or not, and the amount of these fees depends on the price of the trademark.

Assignment documentation: What documents are required for assignment and what form must they take?

The assignment is normally concluded in writing. The rights assigned must be clearly identified. No notarisation is required. The assignment document should be translated into French. Confirmative agreements are accepted.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment must be recorded against the trademark with the Office for the assignee to be able to act as the owner of the trademark. Recording can be done by extract.

-- from gettingthedealthrough.com (Trademarks 2011, France, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/commitees/183/GR183france.pdf> > (France) (Summary on pages 14 and 15 in English, pages 16 and 17 in German)

Decree on Employees' Inventions No. 79-797 of September 4, 1979, as amended by Decree No. 84-684 of July 17, 1984 < http://www.wipo.int/wipolex/en/text.jsp?file_id=127169 >

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=FR> >

The works-made-for-hire rules for employees and independent contractors in Australia, China, France, Germany, Japan, the United Kingdom, and the United States are discussed in the article “Analysis of International Work-for-Hire Law,” by Sutherland Asbill & Brennan LLP (2004)

< <http://www.sutherland.com/alertspubs/searchresults.aspx?keyword=international&publicationtype=&practice=&industry=&authors=&year=&fromsearchpage=alertspubs> >

For a detailed discussion of employee-inventor compensation laws in Belgium, France, Germany, the Netherlands, and the United Kingdom, see “Employee’s rights to compensation for inventions - a European perspective” at < <http://www.cov.com/files/Publication/4ffe8880-deba-493a-8994-2a69f0da78dd/Presentation/PublicationAttachment/3b0e8983-fe2a-41b5-9e96-2fb6c8a3a8c1/Employee%e2%80%99s%20Rights%20to%20Compensation%20for%20Inventions%20-%20A%20European%20Perspective.pdf> >

GERMANY

Labour & Employment

The Employee Invention Act governs inventions that are capable of patent or utility patent protection and suggestions for technical improvements, that is, other technical innovations that are not capable of such protection. The Act distinguishes between service inventions, which either result from the employee’s work in the employer’s business or significantly depend on the business’s experience or work, and free inventions, which include all other employee inventions. Employees are obliged to notify the employer in text form without undue delay of any invention they have made during the employment (unless it is obvious that a free invention cannot be used in the employer’s business). Service inventions may be claimed by the employer with the effect that the employer acquires all proprietary rights to the invention. The employer is deemed to have claimed the invention if it does not waive the invention in text form within four months from proper notification. Free inventions must be offered to the employer first, at least on a non-exclusive basis, provided that the invention can be used in the employer’s business. Employees are entitled to compensation for any service or free invention acquired by the employer and for any suggestion for technical improvement granting protection similar to an industrial property right. The compensation shall be agreed between the parties. Failing agreement, employees may apply for determination of the compensation by the court. ***The Employee Invention Act cannot be deviated from to the employees’ detriment by mutual agreement*** (see Sections 22 and 23).

-- from gettingthedealthrough.com (Labour & Employment 2011, Germany, Ques. #28)

Patents

According to section 5 of the German Employee Inventions Act (GEIA), an employee has the duty to report any service invention to his or her employer. The employer then decides whether he or she wants to claim the invention. Upon claiming the service invention (which occurs automatically unless the employer explicitly releases the invention), the right to the invention automatically transfers to the employer (section 7 of the GEIA).

According to section 6 of the GPA, the right to the patent belongs to the inventor. An individual is considered to be an inventor if he or she makes a substantive intellectual contribution to the invention that goes beyond the common general knowledge of a skilled person. Hence, if an independent contractor is an inventor, then the invention belongs to the independent contractor, unless other contractual obligations exist.

Section 6 of the GPA states that ‘if two or more persons have jointly made an invention, the right to a patent shall belong to them jointly’. Thus, in the absence of any contractual agreements regarding ownership of a patent, the joint inventors form a joint ownership, but each of the inventors may in certain circumstances separately dispose of his or her part of this right.

The ownership of a patent is officially registered in the German Patent and Trademark Office (GPTO) patent register (section 30 of the GPA). The register entry is of a declaratory nature only. In the case of a discrepancy between the register and the factual legal situation, only the legal ownership is decisive, not the register entry. If patent

ownership is transferred to a third party by contract (section 15 of the GPA), this transfer should be reported to the GPTO.

-- from gettingthedealthrough.com (Patents 2011, Germany, Ques. #15)

Copyright

The owner is the author or his/her heirs. Ownership may not be assigned to third parties.

An employer may not own a work created by an employee, as ownership cannot be transferred.

However, the employer may be entitled to all of the employee's exploitation rights under specific circumstances. The employee is obliged to assign the rights of exploitation to his employer if this is provided in the employment contract, or if such obligation corresponds to the nature and purpose of the employment.

Specific rules apply for computer programs: where a computer program is created by an employee in the execution of his duties or following the instructions given by his employer, the employer shall be exclusively entitled to exercise all the economic rights in the program unless otherwise agreed (section 69(b))

-- from gettingthedealthrough.com (Copyright 2011, Germany, Ques. #22 & 23)

With respect to independent contractors, the hiring party cannot own a copyrighted work because ownership cannot be transferred. However, comprehensive exploitation rights are often granted to the hiring party on an exclusive basis. The respective agreement does not have to be in writing, but if the hiring party wants to get comprehensive and exclusive exploitation rights, it must prove that this was intended by both parties. Therefore it is advisable for the hiring party to use a written contract with a respective clause.

-- from gettingthedealthrough.com (Copyright 2011, Germany, Ques. #24)

Moral rights protection includes the right of publication, recognition of authorship and the right to prohibit any distortion or any other mutilation of the work which would jeopardise the author's interests. **Moral rights** always rest with the author or the author's heirs. They **cannot be claimed by other persons**.

Performers' moral rights include the right to be mentioned and recognised as the performing artist and the right to prohibit any distortion or any other mutilation of the performance which would jeopardise the performer's interests.

-- from gettingthedealthrough.com (Copyright 2011, Germany, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Natural persons, legal entities or partnerships having the capacity to acquire rights and incur liabilities may apply and thus be owners of registered and trademarks that have been applied for (filed trademarks) (section 7 of the Trademark Act; the Trademark Act).

Assignment: What can be assigned?

The right conferred by the registration as well as by the use or notoriety of a trademark may be transferred or assigned to another person in respect of some or all of the goods or services for which the trademark is protected (section 27 (1)).

Where the trademark relates to a business establishment or to a part of a business establishment, the transfer or assignment of the business establishment or of that part of the business establishment to which the trademark relates shall include, in case of doubts, the right accruing from the registration, use or notoriety of the trademark. However, it is not necessary to assign business assets to make an assignment a valid transaction.

Where the transfer of rights concerns only some of the goods or services for which the trademark is registered, the owner of a registered trademark may divide the registration by declaring that, for the goods or services referred to in the declaration, the trademark registration shall thenceforth be maintained as a divided registration.

There is no possibility of separating the assignment of a trademark from its goodwill.

Assignment documentation: What documents are required for assignment and what form must they take?

No documents are required for an assignment. However, in practice all trademark assignments or transfers are handed down in writing, namely, agreements between the parties. The agreement requires no form, in particular no notarisation.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

It is not necessary to record the assignment for purposes of its validity. Only upon the request of one of the parties will the transfer of the trademark be recorded in the register (section 27, subsection 3).

The recordal of the assignment in the register helps in the assertion of any rights arising out of the trademark registration, but it is not a precondition for it. However, the successor in title shall, in proceedings before the Office or the courts, only be able to assert the claim for protection and invoke the right conferred by the registration from the date of the receipt of the request for registration of the transfer at the Office (section 28, subsection 2).

-- from gettingthedealthrough.com (Trademarks 2011, Germany, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision: Section 22 (Mandatory Applicability) and Section 23 (Inequitable Agreements) of the Law on Employee Inventions deal with attempts to circumvent the law by contract or the imposition of inequitable terms.

Mandatory Applicability (Unabdingbarkeit)

22. – The provisions of this Law *may not be modified by contract to the detriment of the employee*. Agreements shall, however, be permissible concerning service inventions after they have been reported and concerning free inventions and technical improvement proposals (Section 20(1)) after their notification.

Inequitable Agreements

23. – (1) Agreements concerning service inventions, free inventions, or technical improvement proposals (Section 20(1)) permitted by this Law, shall be *null and void to the extent that they are manifestly inequitable*. This provision shall apply also to compensation settlements (Section 12(4)).

(2) The employer and employee may invoke the inequity of an agreement or compensation settlement only if they do so, by written statement addressed to the other party, within six months following termination of the employment contract.

-- thanks to Robert (Bob) Lelkes for the lead to the German Law on Employees' Invention

Additional information can be found at:

Law on Employees' Inventions of July 25, 1957, as last amended by Law of June 24, 1994
< http://www.wipo.int/wipolex/en/text.jsp?file_id=126211 >, and as further amended by Amendment of December 12, 1997, to the Law on Employees' Inventions of July 25, 1957
< http://www.wipo.int/wipolex/en/text.jsp?file_id=126245 > (in English).

Law on Employees' Inventions of July 25, 1957, as last amended by Law of June 24, 1994
< http://www.wipo.int/wipolex/en/text.jsp?file_id=126213 >, (in French) (no French translation of the December 12, 1997 amendment available).

Ownership of the Copyright in Works and the Patent Rights in Inventions Created by Employees
< <http://www.juridicum.su.se/user/sawo/Publikationer/Wolk%20nr%20120.pdf> > (in Finland, Sweden, Germany, Austria, the United Kingdom, Estonia, and Argentina).

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183germany.pdf> > (Germany) (in German and English).

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=DE> >

A paper, "Employees' Inventions in Germany," can be found at <http://www.ipo.org/AM/Template.cfm?Section=Search§ion=Materials5&template=/CM/ContentDisplay.cfm&ContentFileID=58290> >. The slides/transparencies for the presentation can be found at <http://www.ipo.org/AM/Template.cfm?Section=Search§ion=Materials5&template=/CM/ContentDisplay.cfm&ContentFileID=58291> >.

The works-made-for-hire rules for employees and independent contractors in Australia, China, France, Germany, Japan, the United Kingdom, and the United States are discussed in the article "Analysis of International Work-for-Hire Law," by Sutherland Asbill & Brennan LLP (2004) <http://www.sutherland.com/alertspubs/searchresults.aspx?keyword=international&publicationtype=&practice=&industry=&authors=&year=&fromsearchpage=alertspubs> >

For a detailed discussion of employee-inventor compensation laws in Belgium, France, Germany, the Netherlands, and the United Kingdom, see "Employee's rights to compensation for inventions - a European perspective" at <http://www.cov.com/files/Publication/4ffe8880-deba-493a-8994-2a69f0da78dd/Presentation/PublicationAttachment/3b0e8983-fe2a-41b5-9e96-2fb6c8a3a8c1/Employee%e2%80%99s%20Rights%20to%20Compensation%20for%20Inventions%20-%20A%20European%20Perspective.pdf> >

GREECE

Labour & Employment

In accord with article 6 of Law No. 1733/1987, all rights related to an invention of an employee belong to the employee, except where the invention may be classified as:

- an "invention of service," in which case the rights belong to the employer; or
- a "depended invention," in which case the rights are split, with 40 per cent going to the employer and 60 per cent to the employee.

"Invention of service" is the product of the contractual relationship between an employer and an employee that is expressly aimed at the development of inventions. In cases of 'invention of service', an employee may be entitled to additional remuneration if the invention is significantly profitable for the employer.

"Depended invention" is an invention realised by an employee with the use of means, information and materials of the employer. In this situation, the employer has priority over the exploitation of the invention in exchange for compensation given to the employee relative to the economic vale of the invention. After completing his invention, the employee must notify his employer accordingly and the employer has a time limit of four months after the notification to declare his intention to submit a common application together with the employee for the registration of the invention. Failure of the employer to declare his intention within the above-mentioned period gives a right to the employee to submit an application by himself and register and exploit the invention in his own name and account. An **employee may not contractually waive any of his or her rights mentioned above.**

(NOTE: The previous law on this topic, article 668 of the Civil Code, has been abolished)

-- from gettingthedealthrough.com (Labour & Employment 2011, Greece, Ques. #28)

Patents

If according to the employment contract a company employee has as the object of his or her labour the performing of inventive activity, the invention belongs to the employer.

If the employee has no contract on inventive activity but only used the employer's resources to perform the invention, the employee must first communicate to the employer the intention to file a patent application. The employer may then choose to be co-owner of the invention by 40 per cent (which percentage is set by law), the other

60 per cent belonging to the employee. If the employer does not respond within four months, the invention shall belong entirely to the employee.

The ownership of a patent for an invention made by an independent contractor depends on the employment contract.

When there are multiple inventors or patent owners, the patent rights are divided equally between all inventors, unless there is a written agreement between the inventors deciding different percentages.

Patent ownership is officially recorded at the Greek Patent Office. Transfers are recorded at the Patent Office and are valid against third parties from recordal. Documents pertaining to the recognition of inventors (when the patent owner and inventor differ), and also patent ownership transfer documents, should be legalised (apostilled).

-- from gettingthedealthrough.com (Patents 2011, Greece, Ques. #15)

Copyright

Under the basic rule, the owner and initial beneficiary of a copyrighted work is the natural person who is the creator of that work.

As between employers and employees, the basic rule is that the employee is the initial beneficiary of the economic and moral rights of a work created under an employment agreement. If there is no written agreement to the contrary, there is an automatic transfer of only the economic rights that are essential for the achievement of the purpose of the employment agreement. The moral rights stay with the creator.

-- from gettingthedealthrough.com (Copyright 2011, Greece, Ques. #22 & 23)

There is no explicit provision in Greek law in relation to independent contractors. The moral rights remain with the creator; transfer of economic rights is never automatic and depends on the agreement between the parties. Transfer of copyright may be proved against the creator only if such a transfer agreement is made in writing.

-- from gettingthedealthrough.com (Copyright 2011, Greece, Ques. #24)

Moral rights are recognised for authors of works protected by copyright. Moral rights include authors' power to decide on the time, place and manner in which their work is made accessible to the public (publication); to demand acknowledgement of authorship and the right to have their name referred to in every public use of the work, or the right to present the work anonymously or under a pseudonym (attribution/paternity); to prohibit any distortion, mutilation or other modification of their work and any offence due to the conditions of the presentation of the work in public (integrity); to have access to the work, even when the economic right or the physical embodiment of the work belongs to another person; and in the case of literary or scientific works, to rescind any contract transferring the economic right or an exploitation contract or licence agreement, subject to payment of material damage to the other contracting party, because of changes in authors' beliefs or circumstances.

-- from gettingthedealthrough.com (Copyright 2011, Greece, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Under Greek Trademark Law No. 2239/1994, any natural person or legal entity may file a trademark application. The provision includes non-commercial enterprises and enterprises without a direct or specified profitable aim. There is no 'intent to use' requirement. Non-residents may own a trademark registration on the basis of the principle of reciprocity.

Assignment: What can be assigned?

Greek trademark law allows for the assignment of a trademark alone, without assignment of the whole business behind it, which was not the case before 1994.

A trademark may be assigned for part of the products or services distinguished.

No other business assets must be assigned to have a valid transaction. According to the law, the trademark is an asset independent of the business as a whole.

Assignment documentation: What documents are required for assignment and what form must they take?

A copy of the assignment deed or a confirmatory deed thereof must be filed at the Trademarks Office when requesting the recordal of an assignment. The signatures of both parties to the transactions must be included in this deed. The assignment deed needs legalisation with an apostille, or at the local Greek consulate, for countries that have not ratified the Paris Convention.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

By law, the assignment of a trademark is valid against third parties to the assignment only after it is recorded. The trademarks division of the Ministry of Development records the assignment after a formal control.

-- from gettingthedealthrough.com (Trademarks 2011, Greece, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision: An *employee may not contractually waive any of his or her rights* under article 25 of Law No. 1733/1987.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183greece.pdf> > (Greece)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=GR> >

GUATEMALA

Labour & Employment

Copyright is regulated by the Copyright Law No. 33-98. The law includes literary and artistic productions such as books, brochures, letters, programmes, choreographies, music compositions, architectural plans and drawings. The author of any of these works will be owner of both the moral rights and the patrimonial rights.

The moral right is personal, inalienable and gives the titular the facility to maintain the original work or to remove it from circulation, to prevent its public sale to the public and to prevent the titular's name to be mentioned in any reproduction. The patrimonial right can be transferred.

On the other hand, the Copyright Law of Inventions, Drawings and Industrial Utility Models establishes that '[...]' when an employee, whose contract [...] doesn't have as an object the production of inventions, the ones that he produces will be his own'.

However, the employer can negotiate with the employee in order to buy the invention.

-- from gettingthedealthrough.com (Labour & Employment 2011, Guatemala, Ques #28)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=GT> >

HONDURAS

Labour & Employment

The Law of Authors' Rights and Connective [Connected? or Collective?] Rights.

[NOTE: Likely refers to LEY DEL DERECHO DE AUTOR Y DE LOS DERECHOS CONEXOS (also called Law on Copyright and Related Rights) Decree No. 4-99-E of December 13, 1999

< http://www.cerlalc.org/derechoenlinea/dar/leyes_reglamentos/Honduras/Decreto_499E.htm >.]

An English language summary of the law can be found at < www.iht.hn/files/Intellectual.pdf > and an English translation of the entire text of the law can be found at

< http://translate.google.com/translate?hl=en&sl=es&u=http://www.cerlalc.org/derechoenlinea/dar/leyes_reglamentos/Honduras/Decreto_499E.htm&ei=CbtWTquCH4fb0QGd_8WXDA&sa=X&oi=translate&ct=result&resnum=2&sqi=2&ved=0CDIQ7gEwAQ&prev=/search%3Fq%3DLEY%2BDEL%2BDERECHO%2BDE%2BAUTOR%2BY%2BDE%2BLOS%2BDERECHOS%2BCONEXOS%2Bhonduras%26hl%3Den%26client%3Dfirefox-a%26hs%3DZDi%26rls%3Dorg.mozilla:en-US:official%26biw%3D1366%26bih%3D619%26prmd%3Dvns >.

-- from gettingthedealthrough.com (Labour & Employment 2011, Honduras, Ques #28)

Patents

The right to the patent will belong to the inventor without prejudice to what it is established in articles 12 and 13 of the Honduran Industrial Property Law. When several people produce an invention jointly, the right to the patent will belong to them in common. The right to a patent can be transferred by acts between living persons or through hereditary succession. If several people independently effect the same invention from one another, the patent will be granted to the person (or his or her beneficiary) who files the patent application first or who claims the earliest priority date according to article 141 in the Honduran Industrial Property Law.

According to article 12, when an invention had been produced in fulfillment or compliance with a work or service contract or employment contract, the right to the patent for that invention will belong to the person who contracted the work or service, or to the employer, as it shall correspond, except for a contractual provision otherwise. When the invention should have an economic value much higher than the one the parties could have reasonably foreseen at the time of concluding the contract, the inventor will have the right to special compensation, the amount of which will be set by the competent court in the absence of agreement between the parties. ***Any contractual provision less favourable to the inventor than the ones provided in this article will be null.***

According to article 13, if an employee who was not under the obligation in his or her employment contract to perform an inventive activity should fulfill an invention in the area of activities of the employer, or through the use of data or means to which he or she would have access because of his or her employment, he or she will immediately communicate this fact to his or her employer in writing. If, within a term of two months starting from the date on which the employer would have received such communication, or should have knowledge of the invention by any other means, applying the earliest date, the employer notifies in writing the employee his or her interest in the invention, the employee will have a right to the co-ownership of the patent, having an equitable right to the profits that the use of the invention should occasion. If the employer does not carry out the notification within the established term, the right to the patent will belong to the employee.

Any contractual provision less favourable to the inventor employee than the ones provided in this article will be null ipso jure.

-- from gettingthedealthrough.com (Patents 2011, Honduras, Ques. #15)

“No Overreaching” Provision: *Any contractual provision less favourable to the inventor than the ones provided in [Articles 12 and 13] will be null.*

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=HN> >

HONG KONG (SAR)

Labour & Employment

Intellectual property created in the course of an employee's employment generally belongs to his employer unless otherwise stated in the employment contract.

-- from gettingthedealthrough.com (Labour & Employment 2011, Hong Kong, Ques. #28)

Patents

Basically, a patent on an invention belongs to the inventor unless the inventor is an employee.

Where the inventor is an employee, the issue of patent ownership will be determined by the law of the country or territory in which the employee was employed, as stipulated by sections 57 and 100 of the Patents Ordinance.

Where the employment is governed by Hong Kong law, the invention will belong to the employer if:

- the invention was made in the course of the normal duties of the employee or in the course of duties falling outside his or her normal duties, but specifically assigned to him or her, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his or her duties; or
- the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his or her duties and the particular responsibilities arising from the nature of his or her duties, he or she had a special obligation to further the interests of the employer's undertaking.

Where the inventor employee is employed outside Hong Kong, the right to the patent shall be determined in accordance with the law of the country, territory or area in which the employee is wholly or mainly employed or, if the identity of such country, territory or area cannot be determined, in accordance with the law of the country, territory or area in which the employer has his or her place of business to which the employee is attached.

Where there is more than one employee inventor and the employment of the employees is in different countries or territories, the patent will be co-owned and the ownership will depend on the employment of the relevant territories.

The Patents Ordinance does not expressly refer to the ownership of a patent to an invention made by an independent contractor. Therefore, in the absence of an agreement concerning ownership, the above principles also apply.

A patent is a personal property and can be transferred by assignment or mortgage. An assignment or mortgage of a patent or patent application must be in writing.

The patents register, which is maintained by the Intellectual Property Department, is charged with the responsibility of recording a change of ownership in patent.

-- from gettingthedealthrough.com (Patents 2011, Hong Kong, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

Although there is no statutory requirement that the applicant must be using or intending to use the trademark, the applicant has to declare in the application form whether the trademark is 'being used, by the applicant or with his consent, in relation to the goods or services in respect of which it is sought to be registered, and if it is not being so used, whether the applicant honestly intends to use the trademark, or to allow it to be used, in relation to those goods or services' as per section 38 of the Trademarks Ordinance (TMO). A negative answer may amount to a lack of bona fide intention to trade in the goods or services specified in the application, which in turn results in bad faith, which is an absolute ground of refusal of registration.

The applicant may appoint an agent who can act and sign for an applicant in connection with any proceedings. Any natural person, partnership or company who is a resident or has a place of business in Hong Kong can act as an agent (section 88 of TMO).

Assignment: What can be assigned?

Registered trademarks are assignable with or without goodwill for all or some of the goods or services covered or other assets of business (section 27(2) of TMO).

At common law, unregistered trademarks are part of the goodwill of the business and can only be assigned together with the goodwill.

Assignment documentation: What documents are required for assignment and what form must they take?

An assignment of a registered trademark, or of an application for registration of a trademark, must be in writing and signed by the assignor (sections 27(4) and 31(1) of TMO).

Validity of assignment: Must the assignment be recorded for purposes of its validity?

An assignment of a registered trademark is a registrable transaction and will be ineffective against a person acquiring a conflicting interest without knowledge of it until particulars of an assignment are filed for registration (sections 29 and 31 of TMO).

-- from gettingthedealthrough.com (Trademarks 2011, Hong Kong, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=HK> >

HUNGARY

Labour & Employment

The Patent Act regulates inventions resulting from an employment relationship. The Act differentiates between service inventions and employee inventions.

If an employee is required under his or her employment contract to work out inventions, the invention will qualify as a service invention. If the employee is not required to create inventions but actually does create an invention in the course of and in connection with his or her employment, the invention will qualify as an employee invention.

In the case of a service invention, the employer automatically becomes the owner of the patent (as the legal successor of the employee). The employer's right of utilisation is not exclusive; the employee will also be entitled to utilise (licence the use of) the patent.

In both cases, the employee is required to inform the employer without delay after the creation of an invention. Thereafter, the employer has 90 days to inform the employee whether or not it wishes to become the owner of the service invention or intends to utilise the employee invention.

-- from gettingthedealthrough.com (Labour & Employment 2010, Hungary, Ques. #28)

Copyright

According to the Copyright Law, the person who creates a work (the author) is entitled to copyright. As a rule, due to the main characteristics of the authors' rights system, neither copyright in its entirety (ie, moral rights and economic rights together) nor the economic rights separately, can be transferred or assigned during the life of the author. Exceptions where authors' economic rights can be transferred are:

- software;
- works created under employment;
- collectively created works;
- works ordered for advertising purposes; and
- cinematographic works.

After the death of the author, his or her heirs or successors exercise the authors' economic rights, and they can also act in protection of the moral rights of the late author in relation of his or her work. In the case of connected rights, copyrights can be freely transferred. Thus the owners of copyright under the Hungarian copyright regime can be:

- the author;
- his or her employer, or the owner of the economic rights for his or her software, collectively created work or film;
- the author's legal successors; and
- the owners of connected rights.

According to section 30 of the Copyright Act, in the absence of any agreement to the contrary, the employer, as the legal successor to the author, obtains economic rights once a work is handed over if the preparation of the work was within the scope of the author's employment. Except for computer software, authors are entitled to appropriate remuneration if the employer authorises a third party to use the work or assigns the economic rights in connection with the work to a third party. Authors are entitled to receive the remuneration that they are due after the assignment of use rights pursuant to this Act, even in the event of the employer's acquisition of the right.

Although moral rights remain with the author, the applicability of such rights in case of employment is highly restricted; rights against unauthorised modification of the work are limited in practice to the right of the author to refuse to have his or her name indicated on the work.

-- from gettingthedealthrough.com (Copyright 2010, Hungary, Ques. #22 & 23)

With respect to independent contractors the main rule is that the author of the work is the owner of the moral and economic rights. However, the author may enter into a licence agreement with a third party to authorise the use of his or her work. The licence agreement shall be in writing and will generally either concern an existing work, or will be entered into to create a new work. In the case of a hiring relationship, the latter applies and the hiring party may be the sole owner of the economic copyright of the work if the parties expressly agree so and the author (the independent contractor) grants a licence to the hiring party to exercise his or her economic rights. The moral rights remain with the author.

-- from gettingthedealthrough.com (Copyright 2010, Hungary, Ques. #24)

The Copyright Act also protects the moral rights of the authors. The duration of the moral rights under the Copyright Act is the same as that of the economic rights. However, there is protection of moral rights to some extent, even after the expiration of the 70-year term of protection: after this term, the organisation performing the collective administration of rights or the association representing authors' interests may take action with reference to an offence against an author's memory, when such behaviour would be considered, had it occurred within the term of protection, to infringe the author's right to have his or her name indicated on the work or in a communication related to the work.

An individual author of a work is entitled to the following moral rights:

- to first publish the work, including the right to withdraw the authorisation to first publish the work and to prohibit the continued use of a work already published for a well-founded reason, and provided that appropriate compensation of damages is made by the author;
- to be acknowledged as author and to have his or her name indicated on and in connection with the work; and
- to be protected against any distortion, mutilation or any other alteration of the work which prejudices his or her honour or reputation.

Moral rights exist under Hungarian law irrespective of whether the economic rights are exercised by the author, or they have been contractually assigned or otherwise transferred in the case of collective works or employment contracts. In case of employment contracts, however, the ability of the author to exercise moral rights is modified to some extent.

According to the general rules concerning works created by an author as fulfillment of duty under an employment contract, the delivery of the work to the employer shall be considered as an act of consent to make the work available to the public. Where an author withdraws his or her services as an employee, the employer can continue to use the work and is obliged to make no mention of the author's name. The author's name shall likewise be left unmentioned at his or her request if the employer makes alterations to the work without consent.

It must be noted that the transfer of moral rights or the waiver thereof is null and void.

-- from gettingthedealthrough.com (Copyright 2010, Hungary, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person, or unincorporated business association, may apply for trademark protection, regardless of whether it is actively engaged in business operations or not. Foreign applicants have to be represented by representatives residing in Hungary. Domestic applicants do not need to have representatives; however, it is strongly advisable to obtain professional help available from patent agents or attorneys-at-law.

Assignment: What can be assigned?

There are no legal restrictions regarding the assignment of trademarks. They may be assigned with or without goodwill and with or without other business assets to make a transaction valid.

Assignment documentation: What documents are required for assignment and what form must they take?

The written assignment deed shall meet the formal requirements of a private document of full probative value in order to register the assignment. The formal requirements of this document are set forth in section 196 of the Code of Civil Procedure (Act III of 1952), namely that the original document signed by the contracting parties, or a notarised copy, together with the authorisation of the representative are mandatory for the recording. In practice, the Hungarian Patent Office generally also accepts simple copies of original documents.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment is valid subsequent to its signature; consequently, a recording is not necessary. However, the assignment may only become effective towards third parties upon its registration. It is therefore strongly advised to record an assignment.

-- from gettingthedealthrough.com (Trademarks 2011, Hungary, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183hungary.pdf> > (Hungary)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=HU> >

ICELAND

Information can be found at:

Act No 72/2004 respecting Employees' Inventions
< http://www.wipo.int/clea/docs_new/pdf/en/is/is078en.pdf >

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=IS> >

INDIA

Labour & Employment

Whether an invention made by the employee belongs to the employer or not depends on the contractual relations between the employer and employee. If an employee is bound by an agreement to communicate the benefits of his invention to his employer, then the invention shall belong to the employer. In the absence of such an agreement, the employee is free to file a patent application with respect to his invention, even though the same is made during the course of his employment, using the materials and at the expense of the employer.

-- from gettingthedealthrough.com (Labour & Employment 2010, India, Ques. #28)

In the absence of any contract creating assignment or right in favour of the employer, an employee's invention is not automatically the employer's property, even if such invention is made:

- during the course of employment;
- with the employer's material; or
- at the expense of the employer.

Accordingly, an appropriate assignment would be required from the employee to create the interest of the employer in any invention.

-- from gettingthedealthrough.com (Labour & Employment 2011, India, Ques. #28)

Patents

A company employee or an independent contractor's right to apply for and own a patent is governed by the terms of the agreement between employee and employer or contractor and contracting party.

A patent may be owned by an individual, a group of individuals or a legal entity (for example, a company). A firm may also apply for a patent as an assignee. See *Shinning Industries v Shri Krishna Industries*, AIR 1975 ALL 231 < <http://www.indiankanoon.org/doc/1663997/> >.

A patent may be jointly filed and owned by two or more parties. An application may be filed by the inventor or assignee, or a legal representative of deceased persons who were entitled to make such an application, immediately before their death. A patent applicant may be a legal entity and need not necessarily be a natural person.

In the case of jointly owned rights in a patent, unless there is an agreement to the contrary, each of the co-owners shall exercise his or her rights to his or her own benefit without accounting to the other owners. A licence under the patent shall not be granted and a share in the patent shall not be assigned by a co-owner without the consent of the other co-owners (section 50 of the Act).

The rights in the invention can be assigned to any person or legal entity either during the prosecution stage of the application or after the patent is granted. Section 68 of the Act states that assignment, mortgage, licence or a creation of any other interest in the patent shall not be valid unless it is in writing, outlining the terms and conditions governing the rights and obligations of each party.

Where persons become entitled by assignment, transmission or operation of law to a patent or to a share in a patent, they have to apply to the controller for the registration of their title in the register of patents (section 69 of the Act).

The Patent Office maintains a register wherein all information pertaining to a patent, including names and addresses of the grantees, their assignees, notifications of such assignments and of transmissions of patents, licences under patents and amendments, extension and revocation of patents, are recorded (section 67 of the Act).

-- from gettingthedealthrough.com (Patents 2011, India, Ques. #15)

Copyright

The author of the work is the first owner of the copyright therein subject to the following exceptions:

- photograph, painting, portrait, engraving or film for valuable consideration at the instance of a person - such person;
- work created in the course of employment - the employer;
- lectures delivered in public - the speaker;
- government work - the government; and
- work of an international organisation - the international organisation.

If an employee creates the work in the course of employment, the employer is the first owner of the copyright in the absence of an agreement to the contrary. Thus, the employer's ownership is automatic by virtue of the employment relationship.

-- from gettingthedealthrough.com (Copyright 2011, India, Ques. #22 & 23)

In the absence of an assignment in favour of the hiring party, the first owner of the copyright is the independent contractor. The hiring party would have only an equitable right to use the material created for the purpose of hiring or commission, and possibly against any assignment detrimental to such use.

To own the copyright the hiring party would have to obtain an assignment in writing from the independent contractor.

-- from gettingthedealthrough.com (Copyright 2011, India, Ques. #24)

Moral rights are recognised as:

- the right to claim authorship of the work; and
- to restrain or claim damages in respect of any distortion, mutilation, modification or other acts in relation to the work which is done before the expiration of the term of the copyright, if such distortion etc, would be prejudicial to his honour or reputation.

-- from gettingthedealthrough.com (Copyright 2011, India, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

As per section 18 of the Trade Marks Act 1999 (the Act), any person who claims to be the proprietor of a trademark used or proposed to be used by him or her may apply to register the mark. The claim may be based on use of the mark in relation to particular goods by the applicant itself, or its predecessors in title, or it may be based on its intention to use the mark. However, the only exception as per section 46 of the Act is that a person may make an application even if it has no intention of using the mark itself, if it intends to assign the trademark to a company within six months, or by a person who proposes to use the trademark as a registered user as and when the mark is registered. The term 'person' includes any company or association or body of individuals, whether incorporated or not.

Applications can also be made by a minor represented by a guardian. Also, two or more persons may apply to register a mark as joint proprietors provided the conditions laid down in section 24 of the Act are satisfied.

Assignment: What can be assigned?

A registered or unregistered trademark is assignable and transmissible. The proprietor can assign or transmit the trademark with or without the goodwill of the business concerned. Assignment or transmission can be made for all or some of such goods or services. However, no such assignment is possible where exclusive rights subsist in more than one of the persons concerned by the use of trademarks nearly resembling each other or of identical trademarks in relation to the same goods or services or the same description of goods or services that are associated with each other. This would be so because the use of similar trademarks is likely to cause confusion or to deceive. However, such assignment would not be invalid if the goods are sold in different markets, either within India or for export to other countries, keeping in mind the limitations imposed on such exclusive rights.

An assignment, as per provisions of the Act, is valid even without assignment of other business assets.

Assignment documentation: What documents are required for assignment and what form must they take?

To file for recordal of assignment of registered trademarks the prescribed forms are form TM23 and form TM24. An application on form TM23 may be filed, jointly, by the registered proprietor and the transferee to register the transferee as the subsequent proprietor of a trademark. An application on form TM24 may be filed by the transferee alone. In both the cases the assignment deed is to be enclosed.

To file for recordal of assignment of unregistered trademarks, an application on form TM16 along with the assignment deed may be filed by the transferee to carry out amendment to the name and address of the applicant.

The following documents are required for recordal of the assignment:

- duly executed and notarised deed of assignment;
- a power of attorney, from the assignee or transferee, in favour of the representative, duly signed on a stamp paper of 100 rupees. The document needs no notarisation or legalisation but the name and designation of the person signing the power of attorney must be clearly stated; and
- an affidavit endorsing the validity of the subject trademarks and that no dispute is pending with regard to the same.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Yes, where a person becomes entitled to a trademark or service mark by assignment, such person shall apply in the prescribed manner to the registrar for registration of the title and the registrar shall, on proof of title to its satisfaction, register it as the proprietor of the trademark and shall cause the particulars to be entered in the Trademarks Register.

-- from gettingthedealthrough.com (Trademarks 2011, India, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/commitees/183/GR183india.pdf> > (India)

AIPPI.ORG – Aspects of the Relationship Between Employer and Employee in Copyright (India)
< https://www.aippi.org/download/paris10/CV/WSVIII_VLakshmikumaran_Bios_SumPres.pdf >

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=IN> >

IRELAND

Labour & Employment

Section 23(1) of the Copyright and Related Rights Act 2000 provides that the copyright in material made in the course of a person's employment belongs to the employer as first owner of the copyright and not to the author, subject to any agreement between the parties.

The Patents Acts 1964 to 1992 also entitle an employer to protect inventions. However, there is no statutory provision comparable with section 23 of the Copyright and Related Rights Act, although disputes may be decided by the controller of patents designs and trademarks.

-- from gettingthedealthrough.com (Labour & Employment 2011, Ireland, Ques. #28)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=IE> >

ISRAEL

Patents

Under Israeli law, employers own all inventions by their employees produced as a consequence of their employment. This has generally been interpreted to include all inventions in the same or a similar field as that of the employee's work, even if made on the employee's own time. An independent contractor owns his or her invention unless a written agreement specifies otherwise. In the case of multiple inventors, ownership is by each inventor's employer if the above conditions are met or by a party under which each inventor has a contractual obligation to transfer the rights. Otherwise, the inventors are joint owners. Patent ownership is recorded at the Israeli Patent Office. In the case of an initially filed application, ownership is stated on the application papers. If rights are to be transferred, then a written assignment is required and is recorded at the Israeli Patent Office.

-- from gettingthedealthrough.com (Patents 2011, Israel, Ques. #15)

Chapter 8 of the Israeli patent law < http://www.wipo.int/wipolex/en/text.jsp?file_id=202076 > (sections 131-141), deals with the issue of "inventions while in service".

The highlights of the law include:

1. The employee has to inform the employer of any invention invented while in service, as soon as possible after the invention.
2. The employer may waive any rights in the invention within 6 months of the notice; otherwise, the employer becomes the owner of the invention rights.
3. However, the employee may state, in his notice to the employer, that should the employer not respond within 6 months, the invention rights will be the employee's. In such a case, if the employer does not claim ownership within 6 months, the employee remains the owner of the invention rights.
4. A special governmental committee handles employee-employer disputes.

-- provided by Itzik Katz

Trademarks

Ownership of marks: Who may apply?

Any legal entity may apply, that is, physical person or any kind of corporation, such as companies, partnerships, societies, etc. As Israel is now a member of the Madrid Protocol an Applicant from a country which is a member of the Protocol may designate Israel within the frame of an International Application he filed according to the Madrid System.

Assignment: What can be assigned?

A trademark registration can be assigned with or without the goodwill. It is possible to record a partial assignment of some of the goods or services; however, this will result in the division of the trademark registration into separate registrations. There is no need for other business assets to be assigned to make the assignment valid.

Assignment documentation: What documents are required for assignment and what form must they take?

Any document proving to the satisfaction of the registrar the fact of the assignment may be used in order to record the assignment. Usually for this purpose, a simple deed of assignment may be used, signed by the assignor and assignee or any authorised person on behalf of them, for which no authentication or legalisation is required. Other documents, such as agreements, court judgments, etc, may be submissable. An application to record the assignment should be made and the official fee paid. After it is recorded, the assignment is published.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

No, but if the assignment is not recorded in the Trademark Register, the assignment documents would not be admissible as evidence in any court for proving title in the mark, unless the court directs otherwise.

-- from gettingthedealthrough.com (Trademarks 2011, Israel, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

Israeli Patent Law < http://www.wipo.int/wipolex/en/text.jsp?file_id=202076 >

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=IL> >

ITALY

Labour & Employment

Under Italian law the intellectual property rights of employees can be split into three categories:

- Service invention: This is an invention made by employees in the course of their employment, where the activity that led to the invention was part of the scope of the contract and the employees were paid for performing that activity. In this case, the rights arising from the economic exploitation of the invention automatically belong to the employer. Employees are not entitled to specific remuneration for the invention, since their salary already covers this.
- Company invention: This is an invention made by employees in the course of their employment, where the employee was not paid for performing the activity that led to the invention. In this case, the rights arising from the economic exploitation of the invention belong to the employer, but the employee has the right to receive proper remuneration for the invention (called a 'fair reward'). The amount of remuneration is decided according to the importance of the invention.
- Occasional invention: This is an invention made by employees in the course of employment using their own resources, but within the business sector in which the employer operates. In this case, the economic as well as the creative rights belong to the employee. However, the employer may have a right of pre-emption for either the exclusive or non-exclusive use of the invention, or for the acquisition of the patent.

-- from gettingthedealthrough.com (Labour & Employment 2011, Italy, Ques. #28)

Patents

When the invention is made by a company employee executing a contract whose object is the inventive activity and, in this aim, he or she is paid, the employer is the rights owner, but the employee is entitled to be declared author.

If compensation in the form of remuneration for the inventive activity is not provided, and the invention is achieved during the performance or fulfillment of an employment contract or relationship, the rights deriving from the invention belong to the employer. However, according to article 64, as modified in 2010, in addition to the right to be recognised as author, the inventor shall be granted equitable compensation if the employer (or his or her assignee) obtains the patent or uses the invention within an industrial secret regime; the importance of the invention, the tasks

and the retribution of the inventor, and the contribution that the inventor received from the organisation of the employer, will be considered in determining the amount.

In order to ensure the prompt conclusion of the patent acquisition proceeding and the subsequent attribution of equitable compensation to the inventor, the anticipated examination of the application aimed at the granting of the patent can be granted upon the request of the interested organisation of the employer.

Article 64 IPC provides that, should the said conditions not be met and should the industrial invention fall within the field of activity of the employer, the employer shall own an option right for the use, whether exclusive or not, of the invention or for the purchase of the patent, as well as the ability to require or purchase, for such invention, patents abroad, against the payment of the fee or of the price to be determined by deducing a sum corresponding to the assistance that the inventor has received from the employer to achieve the invention. The employer will be entitled to exercise the option right within three months of receipt of the communication regarding the performed filing of the patent application. The relationships established with the exercise of the option shall terminate if due consideration is not fully paid upon the due date.

According to IPC, article 65, when the employment relationship concerns a university or a public administration that has research aims among its institutional purposes, the researcher shall be the exclusive owner of the rights deriving from his or her patentable invention. The inventor files the patent application and communicates it to the administration.

Moreover, the royalties to be given to researchers in the case of licences are at least 50 per cent of those drawn by the patent rightholder.

Five years from the date of the granting of the patent, if the inventor or any successors have not started a relevant industrial exploitation, and unless this is due to causes outside the inventor's control, the public administration that employed the inventor when the invention was completed shall automatically acquire, free of charge, the non-exclusive right to exploit the invention and patrimonial rights thereof or allow its exploitation by third parties, save the right of the inventor to be recognised as the author.

According to IPC, article 65, paragraph 5, the special dispositions of article 65 are not to be applied in the case of research that is wholly or partially financed by private entities, or carried out within specific research projects financed by public entities that are different from the university or public administration that the researcher works for.

Independent contractors are the owners of their inventions; multiple inventors are co-owners and the patent is filed in their joint names.

With the grant of the patent, ownership is officially determined; the transfer of ownership does not have to be recorded to be valid, but registration plays an evidentiary role.

-- from gettingthedealthrough.com (Patents 2011, Italy, Ques. #15)

Copyright

The original owner of the rights is the author; or, in the case of collaboration, the co-authors.

Economic rights can be bought, alienated, or transmitted to others in any way permitted by law.

According to court statements, an employer can gain the usage and exploitation rights of a copyrighted work created by an employee, but the moral rights remain with the author. According to Italian law, when an employee creates a copyrightable software or database (article 12bis LDA) or an industrial design (article 12ter LDA) within the scope of his or her employment activities, the employer automatically owns the patrimonial rights by virtue of the employment relationship.

When the employer is a public administration, the latter is the owner of the copyright on the work done on its behalf, on its appointment and at its own expense.

-- from gettingthedealthrough.com (Copyright 2010, Italy, Ques. #22 & 23)

With respect to independent contractors, patrimonial rights automatically belong to the hiring party by virtue of the hiring relationship, within the specific limits of the contractual relationship. Rights not specifically included in the agreement's operational aspects are not transferred to the hiring party.

Moral rights cannot be transferred.

The agreement must be in writing (article 110 LDA).

-- from gettingthedealthrough.com (Copyright 2010, Italy, Ques. #24)

There are two distinguishable categories of rights:

Moral rights:

- paternity of the work (ie, the right to claim one's own status as author);
- integrity of the work (i.e the option of opposing any change that might damage the author's reputation); and
- publishing rights (the option of deciding whether to publish the work or not).

Patrimonial rights:

- the right of reproduction;
- the right of transcription of an oral work;
- the right of execution, representation, acting or public reading of the work;
- the right of communication;
- the right of distribution; and
- the right of adaptation (to change, modify or adapt the original work, etc).

Each and every right is individually assigned by the author, who remains the owner of every right not specifically transferred.

-- from gettingthedealthrough.com (Copyright 2010, Italy, Ques. #12 & 5)

Trademarks

Ownership of marks: Who may apply?

Any natural and legal entity may file applications for trademarks that are already used or are intended to be used either directly by the applicant or by third parties with the applicant's consent.

Assignment: What can be assigned?

Trademarks can be assigned in Italy with or without goodwill. This, in particular, may be done for all or some of the goods or services for which the trademark is registered. The only requirement is that the assignment does not cause any deceptiveness in those features of the goods or services that are essential for the appreciation of the public. Assigned goods or services should therefore be sufficiently different from those still owned by the assignor.

Assignment documentation: What documents are required for assignment and what form must they take?

Italian law does not request any special documentation for the validity of assignments that, theoretically, would not even need to be in writing. However, the assignee should be able to prove that the transfer of ownership took place. For recordal purposes, a simple declaration, executed by both parties, that the trademark registration has been transferred is required. If instead the deed of transfer is filed, the deed should be legalised.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

As a general rule, assignments do not need to be recorded with the PTO to be valid. However, if a dispute arises among bona fide assignees, the first one to record the assignment will prevail. In addition, the record would identify the new owner in case he or she needs to enforce the mark or to base any administrative proceedings on the mark.

-- from gettingthedealthrough.com (Trademarks 2011, Italy, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183italy.pdf> > (Italy)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=IT> >

JAPAN

Labour & Employment

Patent: As a general rule, where an employee creates an invention in the course of employment, the right to obtain a patent belongs to the employee. If the employee obtains a patent, the employer company simultaneously receives a non-exclusive licence (article 35.1 of the Patent Act). However, where the employer company has stipulated, in any employment contract, work rules or other stipulation (employee invention contract) that the employer has the right to take over any patent application rights or patent rights acquired by the employee, the employee shall have the right to a reasonable remuneration for the invention (articles 35. 2 and 35.3).

The remuneration, as provided for in the employee invention contract, shall not be regarded as unreasonable and the following are the factors to consider under article 35.4 of the Patent Act:

- a negotiation is carried out between employer and employee in the course of establishing the criteria for determining the remuneration;
- the criteria established are disclosed;
- the employee has the opportunity to state his or her opinions for calculating the amount of the remuneration (article 35.4); and
- other factors (interpreted to include price).

If there is no provision regarding the remuneration, or the remuneration provided in the employee invention contract is unreasonable, remuneration shall be determined by considering the amount of profit that the employer will make from the invention, the burden assumed and contribution made by the employer in connection with the invention, the treatment of the employee, and other relevant factors (article 35.5).

Copyright: By comparison, if any work subject to copyright is produced to be published or made public in the name of a company, then the company is the copyright owner unless the relevant employment contract or work rules expressly state otherwise (article 15 of the Copyright Act).

-- from gettingthedealthrough.com (Labour & Employment 2011, Japan, Ques. #28)

Patents

An invention that by its nature falls within the scope of the business of the employer is an employee's invention if the acts that led to the invention are part of the present or past work performed for this employer. If the employee is granted a patent for such an invention, the employer is entitled to a non-exclusive licence to exploit this invention. An employee that, by contract or workplace guidelines, assigns the right to obtain a patent or the patent itself, or grants a non-exclusive licence to the employer, is entitled to a reasonable payment.

When invented by an independent contractor, an invention belongs to such independent contractor. It may also be transferred to the ordering party under the contract. Joint ownership of the patent is available.

The Japan Patent Office (JPO) maintains registration of the patent and an application for the transfer of the patent ownership is filed with the JPO.

-- from gettingthedealthrough.com (Patents 2011, Japan, Ques. #15)

Copyright

The author of a copyrighted work is its owner. Since copyright may be transferred, the assignee may become the owner of the work; this excludes moral rights, which may not be transferred.

Exemptions to this principle are: authorship of a work made by an employee (see question 23); and authorship of a cinematographic work.

Authorship of a cinematographic work shall be attributed to those who, by taking charge of producing, directing, filming, art direction, etc, have creatively contributed to the creation of such cinematographic work as a whole, with the exception of authors of novels, play/film scripts, music or other works adapted or reproduced in such cinematographic work.

With the exception of computer programs, the authorship of a work which, on the initiative of a juridical person (such as a company) or other employers, is made by an employee in the course of the performance of his/her duties in connection with the employer's business and is made public by the employer as a work under its own name, shall be attributed to the employer unless there are contract or work regulations which provide that the work should be attributed to the employee who created the work.

-- from gettingthedealthrough.com (Copyright 2011, Japan, Ques. #22 & 23)

A hiring party can own the copyrighted work of an independent contractor provided that such ownership must be expressly agreed to; although it is not strictly necessary to have a written agreement, it is customary to have one in order to prevent copyright disputes.

-- from gettingthedealthrough.com (Copyright 2011, Japan, Ques. #24)

With respect to moral rights, an author shall have the right (i) to make the work and derivative work thereof public; (ii) to determine how the author's name is shown (whether it is his/her true name or a pseudonym); and (iii) to maintain the integrity of his/her work and its title, without distortion, mutilation or other modification against the author's will.

-- from gettingthedealthrough.com (Copyright 2011, Japan, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any Japanese individual or legal entity that uses or will use a trademark in respect of goods or services in connection with its business may apply, as well as:

- a foreign individual domiciled or resident in Japan;
- a foreign legal entity having a place of business in Japan; or
- an individual or legal entity from a country that allows Japanese nationals to register their trademarks, provided that such foreigners have a representative with respect to the said trademark in Japan.

Assignment: What can be assigned?

In Japan, a trademark can be assigned either with or without goodwill, and either with or without other business assets. When several goods or services are designated for registration, a trademark may be divided into each class and can be assigned separately.

Assignment documentation: What documents are required for assignment and what form must they take?

For the registration of the assignment of a trademark, a deed of assignment is required. Notarisation is not necessary. If the deed includes a provision where an assignor agrees to an assignee's filing application for recordation of the assignment, then the assignee may file an application for recordation of the assignment without cooperation of the assignor.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment of a trademark shall be of no effect unless it is registered with the JPO, except those transferred by inheritance or other general succession.

-- from gettingthedealthrough.com (Trademarks 2011, Japan, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision: The attribution of intellectual property rights over creations made by employees in the course of duty may be changed by contractual provisions, service regulations, etc. *However, any contractual provision or service regulation that stipulates that an intellectual property right for a creation made by an off-duty employee shall belong to the employer shall be null and void.* Under the Patent Law, the Utility Model Law, the Design Law and the Seeds and Seedlings Law, it is *provided that, where the ownership of an intellectual property right for a creation made by an off-duty employee is attributed to the employer, the employee shall have the right to a reasonable remuneration, which is deemed to be a mandatory provision (public policy rule).*

Therefore, it is *unallowable to deprive employees of this right* by contractual provisions, service regulations, etc. See Paragraph 1.1.2 in AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property < <https://www.aippi.org/download/committees/183/GR183japan.pdf> >.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property < <https://www.aippi.org/download/committees/183/GR183japan.pdf> > (Japan)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=JP> >

A paper, “Employee Invention in Japan” (with a listing of major Japanese cases relating to employee inventions), can be found at

< <http://www.ipo.org/AM/Template.cfm?Section=Search§ion=Materials5&template=/CM/ContentDisplay.cfm&ContentFileID=58304> >. The corresponding PowerPoint® presentation can be found at < <http://www.ipo.org/AM/Template.cfm?Section=Search§ion=Materials5&template=/CM/ContentDisplay.cfm&ContentFileID=58305> >.

The works-made-for-hire rules for employees and independent contractors in Australia, China, France, Germany, Japan, the United Kingdom, and the United States are discussed in the article “Analysis of International Work-for-Hire Law,” by Sutherland Asbill & Brennan LLP (2004)

< <http://www.sutherland.com/alertspubs/searchresults.aspx?keyword=international&publicationtype=&practice=&industry=&authors=&year=&fromsearchpage=alertspubs> >

KOSOVO

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person (or an undertaking that is not a legal person if it has the legal capacity to acquire rights and incur liabilities) may apply for the registration of a mark in Kosovo. Foreign parties in Kosovo enjoy the same rights regarding trademark protection as do domestic parties, should such rights derive from international treaties or the principle of reciprocity. However, the party claiming reciprocity has to prove its existence. Additionally, that foreign parties have to be represented in proceedings before the Kosovo Patent Office by a professional representative who has a BA degree in law and is registered in the appropriate register maintained by Patent Office, or by a domestic legal practitioner.

Assignment: What can be assigned?

All trademarks or a right from an application may be assigned by a contract for all or part of the goods or services for which it is registered. A trademark may be assigned alone; no other business assets need to be assigned to make it a valid transaction. Even though it is not mandatory to register the assignment, we strongly suggest that it be registered. Once registered the assignment can produce legal effects with regards to third parties, and the assignee is formally conferred all the rights stipulated by the assignment.

A trademark holder or applicant may assign the trademark or the right (or both) in the trademark application on the basis of an assignment in respect of all or some of the goods and services.

The assignment agreement needs to be drawn up in writing and it shall contain: the date of signing the agreement, name and surname or business name, domicile or residence or seat of the contractual parties, the trademark registration number or the number of the trademark application and the amount of the fee, if stipulated.

Registration of the assignment of a trademark or the rights arising from the application shall not be granted if such assignment is liable to cause confusion in trade in respect of the type, quality or geographical origin of the goods or services for which the trademark has been registered or in respect of which the trademark application has been filed, unless the assignee disclaims protection for the goods or services in respect of which there is a likelihood of confusion.

Registration of the assignment of a trademark or the rights arising from an application that refers only to certain goods or services shall not be approved where the goods or services being assigned are essentially similar to the goods or services in respect of which the mark remains registered for the benefit of the assignor.

Assignment documentation: What documents are required for assignment and what form must they take?

Documents required for the registration of assignment before the Patent Office are the assignment form, the evidence of legal grounds for assignment such as the assignment contract and the power of attorney should the request be filed through a representative (legalisation and notarisation of the power of attorney are not required).

Validity of assignment: Must the assignment be recorded for purposes of its validity?

In order to be effective against third parties, the assignment contract must be in writing and must be entered into the appropriate register at the Patent Office at the request of a contracting party.

-- from gettingthedealthrough.com (Trademarks 2011, Kosovo, Ques #s 1, 12, 13, and 14)

KYRGYZSTAN

Information can be found at:

Law No. 74 of June 15, 1999 on Service Inventions, Utility Models and Industrial Designs
< http://www.wipo.int/wipolex/en/text.jsp?file_id=128434 >

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=KG> >

LATVIA

Information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183latvia.pdf> > (Latvia)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=LV> >

LUXEMBOURG

Labour & Employment

Intellectual property rights in Luxembourg are governed by the Law of 20 July 1992 on patents and the Law of 18 April 2001 on copyright, related rights and databases (both modified by the Law of 18 April 2004).

As regards patents, unless the employment contract states otherwise, the invention will belong to the employer if it is discovered by the employee in the course of an inventive mission corresponding to his actual tasks or in the course of research explicitly delegated to him, or if the invention is devised by an employee in the course of his duties, in the company's particular field of activity, through the knowledge or use of techniques or means specific to the company or data procured by it.

The employee shall inform the employer of his invention and the latter shall confirm receipt. The employee and the employer shall communicate to each other all necessary information concerning the invention.

The employee is entitled to a fair share of the profits earned by the company thanks to his invention, provided the invention entails considerable profits for the company.

It shall be noted that although all other inventions belong to the employee, they may be transmitted.

As regards copyrights, related rights and databases, the authors have financial rights, moral rights, related rights and computer rights. Economic and financial rights arising in connection with computer programs belong, unless stated otherwise, to the employer whereas the moral right stays attached to the employee. Nonetheless, the moral right can be transferred from the employee to the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, Luxembourg, Ques. #28)

Trademarks

See Trademarks under the Netherlands for discussion of trademarks under the Benelux Convention on Intellectual Property (BCIP) in Belgium, Luxembourg, and the Netherlands.

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=LU> >

MACAO

Trademarks

Ownership of marks: Who may apply?

Any person or legal entity having a legitimate interest, in particular, a manufacturer or trader, may apply for trademark registration.

Assignment: What can be assigned?

The rights to an applied-for or to a registered mark may be assigned independently of the goodwill of the business. Although not compulsory, it is advisable to record the assignment with the Intellectual Property Department (IPD) of the Macao Economic Services (MES).

Assignment documentation: What documents are required for assignment and what form must they take?

The requirements for registration of an assignment are as follows:

- deed of assignment in Portuguese, signed by the assignor and the assignee, and certified by a notary public;
- power of attorney in Portuguese, signed by the assignee, certified by a notary public; and
- original certificate of registration of the trademark for endorsement of the recordal therein. If this is not possible, it is necessary to request a duplicate of said document.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required in order to be valid.

-- from gettingthedealthrough.com (Trademarks 2011, Macao, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=MO> >

MACEDONIA (the former Yugoslav Republic of Macedonia)

Labour & Employment

In accordance with the Law on copyright and other related rights, in cases where a copyright work is created by an employee in the execution of his duties or on instructions by the employer, it shall be considered that the economic and other rights of the author of that work have been exclusively assigned to the employer for a period of 10 years from the completion of the work, unless otherwise provided by a collective agreement or employment contract.

Upon the expiry of this term, the economic rights and other rights shall revert to the employee, while the employer may demand their new exclusive assignment, if he pays the employee an equitable remuneration.

As an exception to the above, an employee shall retain the exclusive right to use a copyrighted work in the course of employment as part of his collected work. The economic and other rights of an author of a collective work or database, shall be considered to have been assigned exclusively and without limitation to the employer, unless otherwise determined by contract.

-- from gettingthedealthrough.com (Labour & Employment 2010, Macedonia, Ques. #28)

Patent

There are no special provisions in the Macedonian Law on Industrial Property or the Macedonian Labour Law concerning the issue of patent ownership. When the invention is made by a company employee and, in this aim, he or she is paid, the employer is the rights owner, but the employee is entitled to be declared as inventor.

Independent contractors are the owners of their inventions; multiple inventors are co-owners and the patent is filed in their joint names. The IPPO grants the patent to the applicant and the said person is the owner (the law uses the term 'holder') of the patent. The transfer of the ownership has to be recorded to have effect against third parties.

-- from gettingthedealthrough.com (Patents 2011, Macedonia, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person may apply for the registration of a mark in the Republic of Macedonia. Foreign parties in Macedonia enjoy the same rights regarding trademark protection as do domestic parties, should such rights derive from international treaties or the principle of reciprocity. However, the party claiming reciprocity has to prove its existence. Additionally, please note that foreign parties have to be represented in proceedings before the Macedonian Industrial Property Office by a professional representative having a B.A. degree in law and registered in the Register of Representatives maintained by Industrial Property Office, or by a domestic legal practitioner.

Assignment: What can be assigned?

All trademarks or a right from an application may be assigned by a contract for all or part of the goods or services for which it is registered. A trademark may be assigned alone; no other business assets need to be assigned to make it a valid transaction.

A trademark holder or applicant may assign the trademark or the right in the trademark application on the basis of an assignment in respect of all or some of the goods and services.

The assignment agreement needs to be drawn up in writing and it shall contain: the date of signing the agreement, name and surname or business name, domicile, residence or seat of the contractual parties, the trademark registration number or the number of the trademark application and the amount of the fee, if stipulated.

Registration of the assignment of a trademark or the rights arising from the application (or both) shall not be granted if such assignment is liable to cause confusion in trade in respect of the type, quality or geographical origin of the goods or services for which the trademark has been registered or in respect of which the trademark application has been filed, unless the assignee disclaims protection for the goods or services in respect of which there is a likelihood of confusion.

Registration of the assignment of a trademark or the rights arising from the application (or both) that refers only to certain goods or services shall not be approved where the goods or services being assigned are essentially similar to the goods or services in respect of which the mark remains registered for the benefit of the assignor.

Assignment documentation: What documents are required for assignment and what form must they take?

Documents required for the registration of assignment before the Macedonian Industrial Property Office are the assignment form, the evidence of legal grounds for assignment such as the assignment contract and the power of attorney, should the request be filed through a representative (legalisation and notarisation of the power of attorney are not required).

The administrative fee for the registration of assignment is approximately €10.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

In order to be effective against third parties, the assignment contract must be in writing and must be entered into the appropriate register at the Macedonian Industrial Property Office at the request of a contracting party.

-- from gettingthedealthrough.com (Trademarks 2011, Macedonia, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=MK> >

MALAYSIA

Patents

The rights to a patent on an invention in the case of a company employee belong to the employer, in the absence of any provisions to the contrary in the contract of employment.

In the case of an independent contractor, the rights belong to the person who commissioned the work, in the absence of any provisions to the contrary in the contract for the execution of the work.

However, where the invention acquires an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract, the inventor will be entitled to equitable remuneration, which may be fixed by the court in the absence of agreement between the parties. ***This right of the inventor cannot be restricted by contract.***

Where there are multiple inventors, the rights to a patent belong to them jointly, and the patent may only be applied for jointly by all the joint owners.

Patent ownership can be transferred by voluntary assignment, judicial assignment and transmission. It is officially recorded by filing an application with the registrar to record the change in ownership, and by providing the registrar with a copy of the instrument.

-- from gettingthedealthrough.com (Patents 2011, Malaysia, Ques. #15)

Copyright

Ownership of copyright shall vest initially in the author, except where the work is made by or under the direction or control of the government, government organisations or prescribed international bodies, in which case copyright shall vest in the respective body. Where a work is commissioned by a person who is not the author's employer under a contract of service or apprenticeship, or is made in the course of the author's employment, copyright shall be deemed to be transferred to the person who commissioned the work or the author's employer, subject to any agreement between the parties excluding or limiting such transfer.

Where the work is made in the course of the author's employment, copyright shall be deemed to be transferred to the employer, subject to any agreement between the parties excluding or limiting such transfer.

-- from gettingthedealthrough.com (Copyright 2011, Malaysia, Ques. #22 & 23)

With respect to independent contractors the CA 1987 provides that where a work has been commissioned 'by a person who is not the author's employer under a contract of service or apprenticeship', copyright shall be deemed to be transferred to the person who commissioned the work, subject to any agreement between the parties excluding or limiting such transfer.

-- from gettingthedealthrough.com (Copyright 2011, Malaysia, Ques. #24)

Moral rights are recognised. The CA 1987 provides that where copyright subsists in a work, no person may, without the consent of the author or his or her personal representative (in the event the author is dead), carry out or authorise any of these acts:

- the presentation of the work, by any means whatsoever, without identifying the author or under a name other than that of the author; and
- the distortion, mutilation or other modification of the work if it significantly alters the work and might reasonably be regarded as adversely affecting the author's honour or reputation.

Similar moral rights are also provided to performers.

-- from gettingthedealthrough.com (Copyright 2011, Malaysia, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any individual or corporate entity may apply to register a trademark. The applicant need not be a citizen or have a local presence in Malaysia. The mark must, however, be either in use or intended to be used in the course of trade in Malaysia. Foreign applicants are required to appoint a registered trademark agent who will be their local address for service.

Assignment: What can be assigned?

A registered trademark is assignable with or without the goodwill of the business concerned. It may encompass use of the mark on either all the goods or services or on some of them.

However, an assignment of a registered trademark without goodwill is invalid if the trademark has not been in use in good faith in Malaysia before the assignment by either the assignor, his or her predecessor in title or a registered user.

An unregistered trademark will only enjoy the same rights of assignment as a registered trademark provided it was used in the same business as a registered trademark, and was assigned at the same time and to the same person as the registered trademark.

Assignment documentation: What documents are required for assignment and what form must they take?

To record an assignment, an attested copy of the assignment instrument and form TM15 (simply signed by the assignee, without the need for notarisation) is required. In the case of an assignment without goodwill, the assignment has to first be advertised in the newspapers, and a copy submitted to the registrar.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

A strict reading of the TMA 1976 makes it mandatory for the assignee to apply to be recorded as the subsequent proprietor. Except in limited circumstances, a document or instrument that has not been recorded on the register will not be admissible in court as evidence to prove title, unless the court otherwise directs.

-- from gettingthedealthrough.com (Trademarks 2011, Malaysia, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision: The [IPR] rules may generally be modified by contractual provisions between employees and employers *except for rights conferred on the inventors for equitable remuneration for inventions which acquire an economic value greater than the parties could have foreseen at the time of the conclusion of the employment contract* under the Malaysian Patents Act 1983.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183malaysia.pdf> > (Malaysia)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=MY> >

MEXICO

Labour & Employment

The FLL establishes that the right to profit from all inventions created by employees while performing their activities belongs to the employer. The employee, however, shall receive additional compensation if agreed or if mandated by the labour board due to the importance of the invention and his or her name shall appear as the invention's creator.

-- from gettingthedealthrough.com (Labour & Employment 2011, Mexico, Ques. #28)

Patents

According to article 9 of the IPL, an individual or the assignee of an individual who makes an invention, utility model or industrial design will have the exclusive right of working it for his or her benefit, either by him or herself or by authorised third parties.

Mexican labour law establishes that in cases where an employee is hired to conduct research and development, an invention resulting from such activities belongs to the employer. The employer, however, must compensate the employee when the profits derived from the invention are not commensurate with the salary received by the employee. If the employee is hired for other purposes, the invention belongs to the individual. The employer, however, has the first option to purchase or license the invention.

Patent ownership may be transferred among individuals or corporations through the appropriate assignment of rights. To have full effect against third parties, the assignment must be recorded with the Mexican Patent Office.

-- from gettingthedealthrough.com (Patents 2011, Mexico, Ques. #15)

Copyright

Generally, an author would be the first owner of the copyrighted work. Exceptions include:

- commissioned works - the entity asking for the work becomes the owner *ab initio*; and
- audio-visual works - the law regards the producer as the copyright owner.

Copyright ownership shall vest in the employer when parties have executed a labour agreement in writing and the same has a special work-for-hire clause. If the parties have signed a labour agreement without this special clause, copyright shall be split in equal shares. If parties have not signed a labour agreement, rights shall vest in the employee.

-- from gettingthedealthrough.com (Copyright 2011, Mexico, Ques. #22 & 23)

A hiring party may own the rights on a copyrighted work made by an independent contractor. Requirements are less strict than in the case of an employee's works. It would be sufficient to show that a work has been commissioned and that there has been remuneration. If the two conditions are met, copyright ownership shall revert to the party that hired the work.

-- from gettingthedealthrough.com (Copyright 2011, Mexico, Ques. #24)

The Copyright Act protects moral rights of paternity, integrity, divulgation and withdrawal. Moral rights are personal rights that **cannot be renounced, pledged or transmitted** and that are imprescriptible.

-- from gettingthedealthrough.com (Copyright 2011, Mexico, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Trademarks in Mexico are regulated under Mexico's current Law of Industrial Property (LIP), which was enacted on 27 June 1991 and further amended on 2 August 1994, and also under the Regulations to the LIP.

Article 87 of the LIP establishes who may use and therefore own a trademark registration, stating: 'industrialists, merchants, or service providers may use trademarks in industry, in commerce or in the services they render'. Nevertheless, the right to their exclusive use is obtained through their registration with the Mexican Institute of Industrial Property (IMPI).

In Mexican practice, any kind of person or entity is entitled to apply for a trademark registration before the IMPI.

Assignment: What can be assigned?

The LIP establishes that the rights deriving from an application for trademark registration or from a registered trademark can be transferred in the terms and with the formalities established by civil law. The transfer of rights must be recorded with the IMPI to be effective against third parties.

The civil law establishes no particular provision for the transfer of a trademark, thus the requirements are the same as for the normal purchase of any merchandise. In that sense, trademarks can be transferred without any restriction, that is, with or without goodwill and with or without any part of the business assets.

There is only one special rule in the LIP for cases of transfer and it refers only to mergers. In the case of a merger, the LIP assumes that all the trademarks of the merger company are transferred to the merging company, unless stipulated otherwise. In this case, the merger has also to be recorded before the IMPI to have legal effects against third parties.

Assignment documentation: What documents are required for assignment and what form must they take?

There is no form of assignment prescribed in Mexico, therefore the original assignment document or a signed copy, notarised and legalised by apostille executed by both parties will be accepted by the IMPI.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment is valid and in force between the assignee and assignor regardless of its recordal. However, the assignment must be recorded before the IMPI to have effects against third parties and to be recognised as well as valid and enforceable against subsequent assignees acting in good faith, against other third parties and in courts and administrative agencies, such as with the IMPI. There is no monetary penalty for failure to record an assignment.

-- from gettingthedealthrough.com (Trademarks 2011, Mexico, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=MX> >

MONTENEGRO

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person may apply for the registration of a mark in the Republic of Montenegro. Foreign parties in Montenegro enjoy the same rights regarding trademark protection as domestic parties, should such rights derive from international treaties or the principle of reciprocity. However, the party claiming reciprocity has to prove its existence. Additionally, foreign parties have to be represented in proceedings before the Montenegrin Intellectual Property Office by a professional representative having a BA degree in law and registered in the Register of Representatives maintained by Intellectual Property Office, or by a domestic legal practitioner.

Assignment: What can be assigned?

All trademarks or a right from an application may be assigned by a contract for all or part of the goods or services for which it is registered. A trademark may be assigned alone; no other business assets need to be assigned to make it a valid transaction.

A trademark holder or applicant may assign the trademark or the right (or both) in the trademark application on the basis of an assignment in respect of all or some of the goods and services.

The assignment agreement needs to be drawn up in writing and it shall contain: the date of signing the agreement, name and surname or business name, domicile, residence or seat of the contractual parties, the trademark registration number or the number of the trademark application and the amount of the fee, if stipulated.

Registration of the assignment of a trademark or the rights arising from the application (or both) shall not be granted if such assignment is liable to cause confusion in trade in respect of the type, quality or geographical origin of the goods or services for which the trademark has been registered or in respect of which the trademark application has been filed, unless the assignee disclaims protection for the goods or services in respect of which there is a likelihood of confusion.

Registration of the assignment of a trademark or the rights arising from the application (or both) that refers only to certain goods or services shall not be approved where the goods or services being assigned are essentially similar to the goods or services in respect of which the mark remains registered for the benefit of the assignor.

Please note that collective trademarks and warranty trademarks may not be the subject of assignment.

Assignment documentation: What documents are required for assignment and what form must they take?

Documents required for the registration of assignment before the Montenegrin IP Office are as follows: the assignment form, the evidence of legal grounds for assignment (such as an assignment contract), and the power of attorney should the request be filed through a representative (legalisation and notarisation of the power of attorney are not required).

Registration fees for the trademark assignment amount to approximately €10.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

In order to be effective against third parties, the assignment contract must be in writing and must be entered into the appropriate register at the IP Office at the request of a contracting party.

-- from gettingthedealthrough.com (Trademarks 2011, Montenegro, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=ME> >

MOZAMBIQUE

Trademarks

Ownership of marks: Who may apply?

Any person or legal entity having a legitimate interest, in particular, a manufacturer or trader, may apply for trademark registration.

Assignment: What can be assigned?

The rights to an applied-for or to a registered mark may be assigned independently of the goodwill of the business. Although not compulsory, however an assignment must be registered in order to be effective as against third parties.

Assignment documentation: What documents are required for assignment and what form must they take?

The requirements for registration of an assignment are as follows:

- deed of assignment in Portuguese, signed by the assignor and the assignee, and legalised at the Mozambican Consulate; and
- power of attorney in Portuguese, signed by the assignee, legalised by the Mozambican Consulate.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required in order to be valid.

-- from gettingthedealthrough.com (Trademarks 2011, Mozambique, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=MZ> >

NETHERLANDS

Labour & Employment

According to the Dutch Patent Law an employee is entitled to a patent of his or her invention if the underlying (new) invention is the result of activities that are not related to the working activities for which the employee was employed. Parties can agree differently. A company (as a patent holder) is legally obliged to pay financial compensation to the employee for the invention the employee has made. To avoid actual payment, an employer can stipulate that the salary includes sufficient compensation for the 'loss' of patent earnings.

Concerning other intellectual property rights such as copyrights, trademark rights, model-design rights and trade name rights, the employer is considered to be the owner if these rights are performed during the employment and as a result thereof, with the possibility to agree otherwise. It is possible to stipulate that the employer is the owner of all intellectual property rights and that the employee has (as far as possible) transferred these intellectual property rights to the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, Netherlands, Ques. #28)

Copyright

Generally, the author is the original owner of the copyright. The Copyright Act creates two exceptions to this rule.

In the first exception, where it is the task of an employee to create certain works, the employer will be considered to be the author and original owner of the copyrighted work unless the employer and the employee have agreed otherwise (article 7).

The second exception regards a work that is originally published by a legal entity as its own work, without mentioning a natural person as the author. In that case, the legal entity will be considered to be the creator and owner of the work unless it is proven that the publication by the legal entity was unlawful (article 8).

As described in the first exception above, the employer automatically owns a copyright where it is the employee's task to create works such as the copyrighted work. It can also be agreed in an employment contract that the employer will become the owner of any work created by an employee.

-- from gettingthedealthrough.com (Copyright 2011, Netherlands, Ques. #22 & 23)

For a hiring party to become the owner of a copyrighted work made by an independent contractor, both parties will have to expressly agree that the copyright will be transferred to the hiring party. A transfer must be in writing. Recent jurisprudence has established that this need not necessarily be the case for some designs for industrially designed objects such as packaging.

[A parliamentary working group rendered a report in 2009 (the Gerkens report) about copyright in general. This working group is of the opinion that the various collecting societies should be replaced by one collecting society. The working group also calls on the Dutch government to take steps toward realising European harmonisation with regard to copyright. ***A preliminary bill which includes an important change in copyright contract law was introduced in June 2010. On the basis of this proposed Act, the original author will not be permitted to transfer his or her copyright, although the licensing of copyright will still be possible.*** NOTE: This paragraph removed in 2011 edition of work.]

[Added in "Updates and trends in 2011 edition: The Dutch government has proposed changes in copyright contracting law that aim to strengthen the position of authors in relation to publishers. Initially these plans even included making the complete transfer of copyright impossible; this element, however, has been abandoned. The new proposals include a 'bestseller' provision and a provision that enables an author to require a publisher to commercialise its work, for example digitally (non usus provision). Please note that these examples do not yet have any official status and at the time of writing no texts of the legal provisions were available.]

-- from gettingthedealthrough.com (Copyright 2011, Netherlands, Ques. #24, also Updates and trends)

Article 25 of the Copyright Act sums up the following moral rights:

- to object to publication without mentioning the name of the author (unless this objection is unreasonable) or any publication mentioning the wrong author;
- to object to any modification unless this objection is unreasonable; and
- to object to any distortion, mutilation or other derogatory action in relation to the work which would be prejudicial to the author's honour or reputation.

It follows from Dutch jurisprudence that this list of moral rights is non-exhaustive.

Moral rights cannot be transferred. An author can, however, give a person the possibility of exercising the author's moral rights after his death in (a rider with) his last will. Moral rights can only be partly signed away; according to article 25(3), an author can renounce the moral right to have his or her name mentioned and to object to changes.

-- from gettingthedealthrough.com (Copyright 2011, Netherlands, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

The Netherlands is one of the three countries that are parties to the Benelux Convention on Intellectual Property (BCIP) concerning trademarks and designs. As a consequence, trademarks cannot be registered in one of these countries alone, but only for all of the Benelux countries (Belgium, the Netherlands and Luxembourg). As such, the Benelux is seen as one trademark territory and injunction orders are, in principle, given for the entire Benelux at once. This also applies to international registrations. The following questions have been answered for the Benelux as a whole as regards trademark application and opposition procedures. However it is noted that the procedural law for litigation differs per contracting country. Where it comes to litigation, questions have been answered for the Netherlands alone.

Under the Benelux Convention on Intellectual Property, any individual or legal entity (regardless to its nationality) may apply for a trademark registration. Trademarks can be registered in the name of more than one party.

Assignment: What can be assigned?

A trademark registration can be assigned with or without goodwill, relating to all or just to some goods or services. The assignment must apply to the entire territory of the Benelux.

Assignment documentation: What documents are required for assignment and what form must they take?

The assignment must be executed in a written deed of assignment, signed by both parties.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Even without the recording of the assignment the parties to the assignment are bound to it. Thus, in order to reach effect, the assignment does not have to be recorded. However a copy of the assignment deed (or an extract of it) must be registered with the BOIP in order to be enforceable against third parties.

-- from gettingthedealthrough.com (Trademarks 2011, Netherlands, Ques #s 1, 12, 13, and 14)

“No Overreaching” Provision:

- **Patents:** *Contractual deviation is not possible* with respect to the rules on compensation (article 12.6 Patent Act) and the (moral) right of the employee to be mentioned as the inventor in the patent (article 14 Patent Act). These rules are mandatory pursuant to respectively article 12.7 and article 14.2 Patent Act.
- **Plant Variety Rights:** The right to a reasonable compensation (Article 31.2 of the Plant Variety Act) *cannot be contractually modified*.
- **Semiconductor Rights:** Contractual modification of this provision [Article 3 of the Act on Semiconductor Rights] is possible.
- **Copyright:** This rule [Article 7 of the Copyright Act] is thus not of mandatory nature and may be modified by contractual relations between employees and employers.
- **Neighbouring Rights (performing artists):** Employer and employee are free to contractually modify the various aspects of their relationship.
- **Database Rights:** There is no specific provision in the Database Act, which deals with the relationship between the employer and employee. There may, however, be a distinction to be made between (i) the “producer of a database” which is typically the employer and holder of the rights, and (ii) the “maker/creator” of the database which may be covered under the Copyright Act.
- **Design Rights:** Contractual modification of Article 6.1 of the Benelux Act on Patterns or Models is possible.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183netherlands.pdf> > (The Netherlands)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=NL> >

For a detailed discussion of employee-inventor compensation laws in Belgium, France, Germany, the Netherlands, and the United Kingdom, see “Employee’s rights to compensation for inventions - a European perspective” at < <http://www.cov.com/files/Publication/4ffe8880-deba-493a-8994-2a69f0da78dd/Presentation/PublicationAttachment/3b0e8983-fe2a-41b5-9e96-2fb6c8a3a8c1/Employee%e2%80%99s%20Rights%20to%20Compensation%20for%20Inventions%20-%20A%20European%20Perspective.pdf> >

NICARAGUA

Labour & Employment

There is legislation addressing the parties' rights with respect to employee inventions. Law 354 on Patents, Utility Models and Industrial Designs has provisions for this.

In the case of inventions made under a contract

- If the invention has been made in the discharge or implementation of a contract, the right to the patent shall belong to the person who contracted for the work or service or to the employer, as the case may be, unless otherwise provided in the contract.
- If the invention has an economic value far in excess of what the parties might reasonably have expected on entering into the contract, the inventor shall be entitled to proportional remuneration that shall be determined by the competent judicial authority in the absence of agreement between the parties.

In the case of inventions made by an employee not contracted to make inventions

- If an employee, who is not obliged by his work contract to engage in inventive activity, makes an invention that pertains to his field of work and does so using data or materials to which he has access by reason of his employment, he shall communicate that fact to his employer in writing and shall include such information as may be necessary for the understanding of the invention. The employer shall, within a period of two months from the date on which he received the communication from the employee or became aware of the invention by any other means, inform the employee in writing of his interest in the invention. In that case, the right to the patent shall belong to the employer, otherwise it shall belong to the employee.
- If the employer declares an interest in the invention, the employee shall be entitled to equitable remuneration reflecting the estimated economic value of the invention. In the absence of agreement between the parties, the remuneration shall be set by a competent judicial authority.

Naming of the inventor

- The inventor shall be entitled to be mentioned in the patent that is granted and in the official documents and publications concerning it, except where he opposes such a naming in a written declaration addressed to the Intellectual Property Registry.

Right to protection

- The right to the protection and registration of an industrial design belongs to the designer. If the design has been created under a contract to produce work, a service contract or an employment contract, the right shall belong to the person who contracted for the work or service, or to the employer, as the case may be, unless otherwise provided in the contract. If the industrial design has been created by two or more persons working together, the right to protection shall belong to them jointly. The right to the protection and registration of an industrial design may be transferred by transaction or succession.

Mention of the designer

- The designer shall be mentioned as such in the registration of the corresponding design and in the documents relating to it, except where, in a written statement addressed to the Intellectual Property Registry, the designer states otherwise.

-- from gettingthedealthrough.com (Labour & Employment 2011, Nicaragua, Ques #28)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=NI> >

NIGERIA

Labour & Employment

The Patents and Designs Act provides that where an invention is made in the course of employment or in the execution of a contract for the performance of specified work, the employer owns the patent right.

Where the inventor is an employee whose employment contract does not require him or her to exercise any inventive activity but the employee has in making the invention used data or means that his or her employment has put at his or her disposal or where the invention is of exceptional importance, the employee shall be entitled to fair remuneration.

-- from gettingthedealthrough.com (Labour & Employment 2011, Nigeria, Ques. #28)

Patents

Section 2(4) of the Act provides that the right to patent inventions made by an employee or independent contractor is with the employer or the person who commissioned the work, while in cases of multiple inventors, section 24(1) of the Act provides, by implication, that ownership is joint. Patent ownership is officially recorded by registration under the Act and the consequent issue of document of patent. Transfer is effected by executing an instrument of transfer and registering (this secures interest against third parties) same under the Act, upon the payment of a fee.

-- from gettingthedealthrough.com (Patents 2011, Nigeria, Ques. #15)

Copyright

Ownership of copyright in a work is vested in the author of the work except if otherwise stipulated in writing under a contract. However, ownership may vest in another party in the following circumstances:

- where a literary, artistic or musical work is made by an author in the course of employment by the proprietor of a newspaper, magazines or similar periodical, under a contract of service or apprenticeship; in this case, the said proprietor shall be the owner of copyright in such a work;
- where a work eligible for copyright is made by or under the direction or control of the government, a state authority or international body, copyright in such a work shall vest in the government on behalf of the Federal Republic of Nigeria, in the state authority, or in the international body in question; and
- if a work is made in the course of the author's employment under a contract of service or apprenticeship, ownership shall vest in the employer; the parties may vary the effect of the aforementioned provisions by contract.

-- from gettingthedealthrough.com (Copyright 2011, Nigeria, Ques. #22 & 23)

A hiring party may own a copyright work made by an independent contractor if the terms of the contract vest ownership of the work in the hiring party.

-- from gettingthedealthrough.com (Copyright 2011, Nigeria, Ques. #24)

Moral rights are recognised. The Copyright Act confers on the author of a work the right 'to claim authorship of his work [...] and the right to object and seek relief in connection with any distortion, mutilation or other modification of and any other derogatory [emphasis provided] action in relation to his work' which rights are 'perpetual, inalienable and imprescriptible'. ***Moral rights are not waivable under Nigerian Law.***

-- from gettingthedealthrough.com (Copyright 2011, Nigeria, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

The relevant law (the Trademarks Act (2004) - the Act), does not specifically identify who may apply for a mark. However, the clear implication of its provisions is that a company, individual or firm may apply for registration

under the Act, subject to the requirement that such person is the proprietor of the mark or is authorised by the proprietor. This is the settled position.

It should also be noted that registration under the Act is open to foreign entities directly, and where such entity has previously registered the mark in a country with which Nigeria has a treaty or is a 'convention country', then the priority of such mark may be claimed.

Assignment: What can be assigned?

Both the goodwill and the trademark can be assigned, and assignment may be made of one without the other.

Assignment documentation: What documents are required for assignment and what form must they take?

The Act does not specify the documents needed to assign title, but section 30(1) and regulation 77 of the Trademark Regulations require that such assignee seeking to register an interest must provide proof of title. In practice, this requirement is satisfied upon the production of a deed of assignment and where registration is to be effected by an agent, an authorisation as per trademarks form 1 is also required.

However, regulations 73 and 74 provide for the use of trademark forms 16 and 17, respectively, where subsequent interests are sought to be registered alongside an existing registered interest. Notarisation is not mandatory. All that is required are documents showing assignment of the mark.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

There is no mandatory requirement to register an assignment to make it valid, but for purposes of enforcement proceedings in court, under section 30(1) of the Act, only registered assignments may be so enforced.

-- from gettingthedealthrough.com (Trademarks 2011, Nigeria, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=NG> >

NORWAY

Labour & Employment

The Employee Invention Act regulates on the matter. The employer may introduce rules that, in most cases, give the right to own or use the inventions made by employees. This only applies if the invention is made in relation to the work and the use of the invention is within the business area of the employer. These rules may be deviated from in writing in the employment contract. The employer wishing to use an employee's invention must also inform the employee without delay and no later than four months after learning of the invention. The employee is also entitled by law to compensation for the use of the invention by the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, Norway, Ques #28)

Trademarks

Ownership of marks: Who may apply?

As an introductory remark, the reader must be aware that as a non-member of the European Union, all matters regarding trademarks in Norway are regulated by the Norwegian Trademarks Act, hereafter the Trademarks Act. This shall, however, be harmonised with the EU's Trademarks Directive.

A new act on trademarks entered into force on 1 July 2010. This represents an amplification and modernisation of the prior act, but it also introduces important amendments and new possibilities. An important practical amendment is that the new act regulates, contrary to the prior legislation, registration of collective marks. This chapter will not deal with the rules on collective marks, unless specifically mentioned. An English version of the legal text is available at the NIOP's website, www.patentstyret.no.

Any natural or legal person may apply for a trademark registration (including service marks) in Norway. A registration may be held by several owners, and there are no requirements for actual or intended commercial activities in Norway.

The application must be filed in Norwegian and must contain a specification of products. Other documents may be in Norwegian, Swedish, Danish or English. The application shall include:

- the name and address of the applicant;
- the name and address of any representative;
- a representation of the trademark; and
- a list of the goods or services in respect of which the registration is requested.

An application or registration of a collective mark shall also include the regulations established for the use of the trademark.

Assignment: What can be assigned?

A trademark right may be transferred alone or together with the undertaking to which the trademark is linked. If an undertaking changes ownership, the right to trademarks linked to the establishment transfers with it, unless agreed otherwise. A trademark right may be transferred for some of the products.

Assignment documentation: What documents are required for assignment and what form must they take?

The NIPO does not require an assignment deed or other documents for recording an assignment in the Trademarks Register. However, for the benefit of the parties involved, it is strongly recommended to sign an agreement that establishes the scope of the assignment in all details, such as denomination of the trademark, which products are affected by the assignment, in which countries shall the registration be assigned etc.

Thus, there are no formal requirements for an assignment document.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Recordal of an assignment is not a requirement for validity. It is, however, recommended to proceed with such recordal when the assignment is effective. The NIPO will send renewal notices and other notifications to the registered holder or its representative. Also consent requests and other communications from third parties will be sent to the registered holder or its representative. If there is not a representative in the matter, the communications will be sent to the wrong company or person, who may not know of the new owner etc. In cases of non-recorded assignments, a representative is not informed of the new ownership situation, and will meet problems with tracking the correct addressee. In worst cases, notices on actions for cancellations and the like will not reach the current owner, which may give unfortunate results for the registration owner.

-- from gettingthedealthrough.com (Trademarks 2011, Norway, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=NO> >

PARAGUAY

Information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/comitees/183/GR183paraguay.pdf> > (Paraguay)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=PY> >

PERU

Patent

Pursuant to our law, article 36 of Legislative Decree 1075, there are two instances when the right to the patent belongs to the employer: when during the employment relationship the employee's role is to carry out inventive tasks or actions; or when in the employment relationship something related to its professional activity is invented using media or data provided by the employer.

With the exception of these cases, the right to the patent exclusively belongs to the inventor when he or she carries out inventions during his or her employment relationship or services contract.

Article 22 of Decision 486 outlines the following rules with regards to multiple inventors: 'a) If several persons make an invention jointly, they shall share the right to patent it and b) If several persons make the same invention, each independently of the others, the patent shall be granted to the person or assignee with the first filing date or, where priority is claimed, date of application.'

The ownership of a patent is officially recognised and transferred by a written agreement and recorded in the registry according to article 56 of Decision 486.

-- from gettingthedealthrough.com (Patents 2011, Peru, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

Any individual or legal entity, public or private, Peruvian or foreign, may apply for a trademark with INDECOPI (National Institute for the Defence of Competition and Intellectual Property Protection). An application in the name of more than one person is possible. If the applicant has no domicile in Peru, a Peruvian representative must be appointed.

Assignment: What can be assigned?

It is important to distinguish between a transfer and a licence.

- *Transfer:* A granted or pending registration of a trademark may be transferred, with or without the business (goodwill) attached to it. The burdens and liabilities are totally transferred with it. In fact, if the trademark has an advertising slogan attached to it, it must be transferred. It is important to mention that a transfer of one or some classes should involve all the related goods or services; if this is not the case, the Trademark
- *Licence:* A granted or pending registration of a trademark may be licensed to one or more third parties to use the trademark. The mark may be licensed for all or some of the goods or services for which it has been registered. The licensor is civilly liable to consumers, which does not hinder the responsibility of the licensee in administrative matters with regard to the local business operations.

Assignment documentation: What documents are required for assignment and what form must they take?

For the registration of a licence it is mandatory to submit the contract signed by both parties, notarised (signatures and abilities) and legalised by the Peruvian consulate of the country or countries in question.

In the case of a transference, if it is the result of a contract it can be submitted as:

- a copy of the contract, which the notary must state is in accordance with the original one;
- an extract of the contract that shows the change of ownership;
- an uncertified certificate of transference with the content established in the Regulations of the Trademarks Law Treaty of 1994, which must be signed by holder and purchaser; or
- an uncertified document of transference with the content established in the Regulations of the Trademarks Law Treaty of 1994, which must be signed by holder and purchaser.

When the change of owner is a result of a merger, it is sufficient to supply the copy of the document evidencing the merger issued by the competent authority stating conformity with the original one. When the change of owner is not a result of a contract or merger, but of the implementation of a law or a court decision, it is satisfactory to include the copy of the document that proves that change, notarised and stating conformity with the original one. It is worth

mentioning that if the document is signed abroad, it must be notarised and certified up to the Peruvian consulate, except in cases (iii) and (iv). If it is signed in Peru legalisation by a notary will suffice.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Transfers must be registered with the Trademark Direction to be valid and opposable against third parties. Licence registration is optional. Validity and effects are not subordinated to inscription.

-- from gettingthedealthrough.com (Trademarks 2011, Peru, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=PE> >

PHILIPPINES

Information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/commitees/183/GR183philippines.pdf> > (Philippines)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=PH> >

POLAND

Labour & Employment

In accordance with the Act on Copyright and Associated Rights, if the employer and the employee have not agreed otherwise, and the action that led to the invention is part of the employee's duties performed within his or her employment, the employer acquires the rights to royalties to the employees' innovation. The employee, as author, is solely entitled to the copyright and he or she may not waive or assign this personal right.

-- from gettingthedealthrough.com (Labour & Employment 2011, Poland, Ques. #28)

Patent

Generally, the right to obtain a patent for an invention belongs to the inventor. Where an invention has been made jointly by a number of persons, the right to obtain a patent shall belong to them jointly.

Where an invention has been made by an inventor in the course of employment duties or in the execution of any other contract, the right to obtain a patent for this invention will belong to the employer or the individual who orders it, unless otherwise agreed by the parties concerned.

Furthermore, agreements concluded between entrepreneurs may designate the entity to which the rights to obtain a patent shall belong, if an invention has been made in connection with the execution of such an agreement. Where an invention has been made by an inventor with the assistance of an entrepreneur, the latter may enjoy the right to exploit the invention in its own field of activity. In the agreement on giving assistance, the parties may stipulate that the right to obtain a patent belongs in whole or in part to the entrepreneur.

The ownership of a patent is officially registered in the patent register. The register entry is of a declaratory nature; however, the transfer of a patent becomes effective in relation to third parties upon the date of registration of the said transfer.

-- from gettingthedealthrough.com (Patents 2011, Poland, Ques. #15)

Copyright

Generally, the author is the owner of a copyrighted work. It shall be presumed that the author is the person whose name has been indicated as the author on copies of the work or whose authorship has been announced to the public in any other manner in connection with the dissemination of the work.

If there are co-authors to the work, they shall enjoy copyright jointly.

The producer or publisher shall have the author's economic rights in a collective work and in particular the rights in encyclopaedias or periodical publications, and the authors shall have economic rights in their specific parts which may exist independently. It shall be presumed that the producer or publisher have the right to the title.

If the employee is the author of a work which has been created within the scope of his or her duties resulting from the employment relationship, the employer is the owner of the author's economic rights within the limits resulting from the purpose of the employment contract and the congruent intention of the parties, unless the Copyright Act or a contract of employment states otherwise.

Under Polish law, as a rule and under statutory prerequisites, the employer acquires author's economic rights to the work created by the employee and becomes their owner. The prerequisite for acquiring the author's economic rights by the employer is that the employee creates the work within the scope of his or her duties resulting from the employment relationship, not, for example, while performing his or her employee duties. In this respect, the scope of activities entrusted to the employee is significant. The author's economic rights are acquired by the employer the moment he accepts the work from the employee. The acquisition shall be within the limits resulting from the purpose of the employment contract and the congruent intention of the parties. In order to acquire the copyright in the above-mentioned course, no additional agreement in writing is required.

The provisions of Copyright Act are not mandatory, therefore, if the parties to the contract agreed otherwise, the effect defined by the aforementioned Act may be excluded or amended by the will of the parties. In the employment contract the parties may stipulate that the employer shall acquire author's economic rights in a wider or narrower scope than resulting from the purpose of the employment contract and the congruent intention of the parties. The parties may also exclude the acquisition of author's economic rights to the works created by the employee within the scope of his or her duties resulting from the employment relationship, consequently the author (employee) will be the owner of all the author's economic rights. In such case, a separate agreement in this respect will be required in order to transfer the author's economic rights.

-- from gettingthedealthrough.com (Copyright 2011, Poland, Ques. #22 & 23)

The conclusion and performance of a civil contract whose effect may be the creation of a work, does not result in an automatic transfer of author's economic rights to the work to the orderer. As a rule, the author shall be the owner of copyrights, and their possession by a different entity shall be clearly specified in writing. Therefore, if the author's economic rights to a work are to be owned by an entity different than the author, appropriate provisions in this respect shall be indicated *expressis verbis* in the contract.

-- from gettingthedealthrough.com (Copyright 2011, Poland, Ques. #24)

On the basis of Copyright Act, two types of copyrights are protected: author's moral rights and author's economic rights.

The moral rights protect the link between the author and his or her work which is unlimited in time and independent of any waiver or transfer, and, in particular, the right:

- to be an author of the work;
- to sign the work with the author's name or pseudonym, or to make it available to the public anonymously;
- to have the contents and form of the author's work inviolable and properly used;
- to decide about making the work available to the public for the first time; and
- to control the manner of using the work.

The author or any other entity who purchased the author's economic rights on the basis of a contract for the transfer thereof shall be the owner of the author's economic rights. On the other hand, the disposer of the author's economic rights shall have an exclusive right to:

- use the work;
- dispose of the work; and
- remuneration for the use of the work

-- from gettingthedealthrough.com (Copyright 2011, Poland, Ques. #s 5 & 12)

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person can file an application for registration of a trademark.

Foreign nationals and legal entities will have the same rights as Polish nationals on the basis of international agreements to which Poland is a party, or on the basis of reciprocity. Applicants residing abroad must be represented by an admitted patent attorney permanently residing in Poland.

Assignment: What can be assigned?

Assignment of a trademark (whether registered or applied for registration) is possible with or without transfer of the entire business. Assignment of a mark for part of the goods or services for which it is registered is also possible, provided that the goods or services for which the mark remains registered in the name of the assignor are not of the same kind. After partial assignment (that is, assignment in respect of part of the goods or services only), the right of assignee will be treated as independent of the right of the assignor. Assignment must be in writing to be valid. Any assignment (and change of name or address) must be recorded in the Register of the Patent Office to be effective against third parties.

Assignment documentation: What documents are required for assignment and what form must they take?

The documents required for recording assignment of a trademark registration or pending trademark application are:

- deed of assignment, signed by both parties, or its notarised copy; and
- power of attorney, signed by the assignee.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The trademark assignment agreement must be in writing to be valid. It becomes effective against third parties from the date of being recorded in the Trademark Register. If it is not recorded in the register, it is exclusively binding upon the parties to the agreement.

-- from gettingthedealthrough.com (Trademarks 2011, Poland, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=PL> >

PORTUGAL

Labour & Employment

The general regime applicable to such matters is established by the Intellectual Property Code (Law No. 16/2008 of 1 April 2008), which foresees that intellectual property created within the scope of a company belongs to the company.

Moreover, the employees' rights related to the creation of software are foreseen in the software specific legal regime (Decree-Law No. 252/94 of 20 October of 1994), which establishes that the intellectual property rights of software created by an employee belong either to the company or, if the software was tailor-made, to a specific client.

Both provide rules that are only applicable when the employer and employee do not agree otherwise, notably through specific clauses in the employment agreement.

-- from gettingthedealthrough.com (Labour & Employment 2011, Portugal, Ques. #28)

Patent

The inventor (or his or her successors) holds the right to the patent, unless the inventor is employed for the specific purpose of such inventive activity. In this case, the employer has the right to the patent but the inventor's name must be included in the patent application and the title; the employer may apply for the patent without the consent of the employee.

For applications from persons not resident in Portugal, an officially recognised attorney or agent in Portugal must be appointed.

-- from gettingthedealthrough.com (Patents 2011, Portugal, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

Any individual or legal entity that has a lawful interest, in particular traders or manufacturers.

Assignment: What can be assigned?

The property of a trademark can be totally or partially assigned. The assignment must be recorded in order to have an effect towards third parties. If recordal of the assignment is requested by the assignor, the assignee should also be a signatory of the assignment document, or issue an express statement that he accepts the assignment.

Assignment documentation: What documents are required for assignment and what form must they take?

The requirements for registration of an assignment are a deed of assignment in Portuguese, signed by the assignor and the assignee, and certified by a notary public.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required in order to be valid.

-- from gettingthedealthrough.com (Trademarks 2011, Portugal, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/commitees/183/GR183portugal.pdf> > (Portugal)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=PT> >

REPUBLIC OF KOREA (South Korea)

Labour & Employment

Under the Act on the Promotion for Invention (previously, the Patent Act), employees are eligible to receive reasonable compensation for employee inventions when the patent is transferred to the employer pursuant to an employment contract or any other contract. With respect to reasonable compensation, the courts have held that the employer must provide as compensation a part of the benefits that the employer receives from the employee invention to the employee.

-- from gettingthedealthrough.com (Labour & Employment 2011, Korea, Ques. #28)

Patents

Employee's invention

An employee's invention is governed by the Korean Invention Promotion Act rather than the Korean Patent Law. The employee should notify the employer of the invention in writing. An employer who receives an employee's notice should notify the employee by documents within four months of the receiving date whether the employer will acquire the right to the invention.

Where a company regulation, agreement or contract for labour exists regarding an employee's invention and the employer notifies the employee within the set period (four months) that the employer will acquire the right to the invention, the employer is entitled to the patent application and the employee is entitled to reasonable compensation without regard to the employer's filing of the invention. Where no regulation, agreement or contract exists regarding an employee's invention, and the employer notifies the employee of the intention to acquire the right to the employee's invention, the employer is entitled to the patent application with the employee's consent and the employee is entitled to reasonable compensation.

Multiple inventors' invention

Each inventor is jointly entitled to the patent right to an invention. If only some of the inventors apply for a patent, the application is not eligible for a patent and is subject to invalidation even after it is granted.

Payment of patent fees

When an applicant receives a notice of a decision to grant a patent, the applicant should pay patent (registration) fees within three months of the date of receiving such notice. Where the fees have been paid, the Korean Intellectual Property Office (KIPO) will register the patent to establish a right in the register. A patent right comes into effect upon the establishment of registration.

Transfer of patent ownership

Transfer of patent ownership comes into effect upon registration by submitting evidentiary documents to KIPO. In the case of inheritance or other general succession of the patent ownership, registration is not required and so the successor comes to have ownership immediately upon notifying KIPO. Where a patent right is jointly owned, the owners may not transfer their individual share without the consent of the other owners.

-- from gettingthedealthrough.com (Patents 2011, Korea, Ques. #15)

Copyright

The owner is the individual who creates a copyrighted work or a successor in interest to a copyrighted work. However, the owner can be a corporation if a copyrighted work is created by an employee of the corporation within the scope of his or her employment.

An employer may own a copyrighted work if such work was created under 'work made for hire'. To be qualified as work made for hire, the following conditions should be met:

- the work was made under the planning of an employer;
- the employee created the work within the scope of his or her employment;
- the work was published under the name of employer; and
- no other contractual or company work regulations should specify otherwise.

-- from gettingthedealthrough.com (Copyright 2010, Korea, Ques. #22 & 23)

The creator of the work (in other words, the author) becomes the owner.

According to the [Copyright] Act, if a work-for-hire made by a person engaged in the duty of a juristic person, organisation or other employers (hereinafter referred to as the 'juristic person') is made public in the name of a

juristic person, its author shall be the relevant juristic person unless otherwise stipulated in the contract or work regulation. Therefore, the juristic person employer initially acquires copyright of work-for-hire that is made public in the name of the juristic person unless otherwise stipulated.

-- from gettingthedealthrough.com (Copyright 2011, Korea, Ques. #22 & 23)

Copyright is initially vested into the creator of works. However, a hiring party may own copyrights of the works made by an employee or an independent contractor by assignment if such work was created under work-for-hire circumstances. There is no need for such an assignment to be in writing.

-- from gettingthedealthrough.com (Copyright 2010, Korea, Ques. #24)

For a work to become a work-for-hire, the person engaged in the duty of a juristic person need not have executed a formal employment agreement, but must be under substantial supervision of the juristic person. Thus, work created by a person in an independent relationship through being hired as a contractor or through commissioning of work will not be automatically recognised as work-for-hire, and in order to acquire authors' property rights over such work, it must be assigned through either an oral or written agreement.

-- from gettingthedealthrough.com (Copyright 2011, Korea, Ques. #24)

Authors and performers are granted moral rights. Moral rights granted to authors include the right to disclose, indicate the author's name, and maintain the integrity of the work, etc. Performers are also granted the right to indicate his or her name and maintain the integrity of their work.

-- from gettingthedealthrough.com (Copyright 2010, Korea, Ques. #12)

The Act recognises authors' moral rights. Authors' moral rights include right of disclosure, right of attribution and right of integrity. Further, right of attribution and right of integrity are also recognised for a neighbouring rights holder, namely, the performer.

-- from gettingthedealthrough.com (Copyright 2011, Korea, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any individual, company or legal entity who uses or intends to use a trademark in the Republic of Korea is entitled to file a trademark application.

Assignment: What can be assigned?

A trademark right may be assigned separately for each of the designated goods or services. In such cases, the rights for similar designated goods or services shall be assigned to the same assignee. A trademark may be assigned with or without goodwill and other business assets.

No other business assets must be assigned to have a valid transaction. According to the law, the trademark is an asset independent of the business as a whole.

Assignment documentation: What documents are required for assignment and what form must they take?

The following documents are required:

- a deed of assignment (notarised);
- a letter of consent (where a trademark is jointly owned, one of the joint owners may not assign his or her portion without the consent of all the other joint owners);
- a notarised corporate nationality certificate of assignor; and
- respective power of attorney signed by both the assignor and assignee.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The transfer of a trademark application for trademark registration or a registered trademark, except for inheritance or other general succession, is not effective without recording the transfer of the trademark application or registered trademark.

-- from gettingthedealthrough.com (Trademarks 2011, Korea, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=KR> >

ROMANIA

Labour & Employment

In the absence of any contractual terms agreed by the parties within the employment agreement, there are statutory provisions which will apply to determine the ownership of IP rights. Although not mandatory, provisions on IP rights are commonly included within the individual employment agreements.

-- from gettingthedealthrough.com (Labour & Employment 2011, Romania, Ques. #28)

Copyright

As a rule, the owner of the copyrighted work is the author (or, in case of collaboration - the co-authors). However, in case of collective work, unless otherwise agreed, the patrimonial rights belong to the person that had the initiative and under whose name the work has been created. Also, in case of software created by employees, the patrimonial rights belong to the employer.

An employer may own a copyright in a work made by an employee. While for software, the patrimonial rights belong to the employer by virtue of the employment relationship, for other types of works, the fact that the patrimonial rights belong to the employer must be agreed, in writing, by the parties.

-- from gettingthedealthrough.com (Copyright 2011, Romania, Ques. #22 & 23)

A hiring party may own a copyrighted work made by an independent contractor. However, the fact that the patrimonial rights belong to the hiring party must be agreed by the parties. The legislation provides that the existence and content of such agreement may only be proved by written document (except for contracts having as object works used in the media).

-- from gettingthedealthrough.com (Copyright 2011, Romania, Ques. #24)

Copyright encompasses two categories of rights:

Moral rights, namely:

- the right to decide if, how and when a work is brought to public knowledge;
- the right to claim recognition as author of the work;
- the right to decide the name under which the work is brought to public knowledge;
- the right to claim the observance of the integrity of the work and to oppose any change or other interference with the work that damages the author's honour or reputation; and
- the right to withdraw the work.

These rights cannot be waived or transferred. After the author's death, the rights under the first, second, and fourth bullets above are exercised by the heirs, for an unlimited period of time.

Patrimonial rights, namely:

- the right to reproduce,
- distribute the work,
- import in order to commercialise on the internal market copies of the work made with the author's consent,
- lease or lend, the work,
- communicate it to the public, directly or indirectly, including by making it available for the public to have access to it at any time and in any place,
- broadcast the work, and
- transmit it by cable or create derivative works thereof.

Also, the author of a graphic, plastic art or photographic work has a resale right, which entitles the author to receive a percentage of the price when the work makes the object of a reselling operation to which an art dealer participates as seller, buyer or agent.

Performance rights enjoy protection as neighbouring rights. Performers are granted:

Moral rights, namely:

- the right to the paternity of the performance;
- the right to claim that his name/pseudonym be indicated or communicated in each show and each utilisation of the recording thereof; and
- the right to claim the observance of the quality of the performance and to oppose to any substantial change or any infringement of his rights, that would damage the performer's honour or reputation.

Patrimonial rights, namely:

- the right of fixation of the performance,
- the right to reproduce, distribute, lease or lend the fixed performance,
- the right to import in order to commercialise on the internal market the fixed performance,
- the right of broadcasting and public communication, unless the performance has been already fixed or broadcasted with the performer's permission, in which case the performer is only entitled to a fair remuneration,
- the right to make the fixed performance available for the public to have access to it at any time and in any place, and
- the right to transmit the fixed performance by cable.

-- from gettingthedealthrough.com (Copyright 2011, Romania, Ques. #s 5, 10, & 12)

Trademarks

Ownership of marks: Who may apply?

According to Romanian Law No. 84/1998 (the Law) on trademarks and geographical indications, any natural person or legal entity may own a trademark. Foreign natural persons or legal entities having their residence or place of business outside the territory of Romania shall also enjoy the provisions of this Law, in accordance with the international conventions on trademarks and geographical indications to which Romania is a party.

Assignment: What can be assigned?

Rights in a trademark may be assigned independently of the transfer of the business in which the trademark is incorporated. Assignment of rights in a trademark may be effected for all or part of the goods or services in respect of which the trademark is registered. An assignment, even in part, may not limit the use of the trademark for the goods or services to which it applies to a given territory.

Transfer of the whole of the patrimony of the trademark owner shall include transfer of the rights in the trademark. The transfer of certain elements of the owner's patrimony shall not affect his capacity as owner of the right in the trademark. Identical or similar trademarks belonging to the same owner that are used for identical or similar goods or services may be assigned only as a whole and only to one person, on pain of nullity of the instrument of assignment.

Assignment documentation: What documents are required for assignment and what form must they take?

Assignment shall be effected in writing and signed by the parties to the contract, on pain of nullity. The request for registration of the assignment shall be accompanied by a document attesting to the change of ownership of the trademark.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment is valid between the parties without any formality or registration and may be invoked against third parties as of the date of its publication. Upon request by the person concerned, and on payment of the prescribed fee, OSIM shall enter the assignment in the Trademark Register and publish it in the Official Industrial Property Bulletin.

-- from gettingthedealthrough.com (Trademarks 2011, Romania, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=RO> >

RUSSIAN FEDERATION

Patents

An employer is entitled to file applications and obtain patents for all inventions made by its employees in the course of routine work. An independent contractor - a natural person - is not an employee, so a right to inventions should be declared in the contract. If an invention is created in the performance of a contract of work and labour, or a contract for the performance of scientific or technological research that did not directly envision such creation, the right to obtain a patent and exclusive right for such invention shall belong to the contractor (performer) unless the contract provides otherwise. In the case of multiple inventors, all or any of them may own the patent depending on the agreement between the inventors.

Patent ownership may be transferred at any time in full by an alienation or assignment, or in part by a licence agreement. All such agreements must be recorded in the Register of the Russian Patent and Trademark Office (PTO) and are not valid until recorded.

-- from gettingthedealthrough.com (Patents 2011, Russia, Ques. #15)

Copyright

According to the current Russian legislation the following categories of persons can be copyright owners:

- An author of a literary work, scientific work or a work of art
- The author of a work is the individual who created the work. The person indicated as the author on the original or a copy of the work is considered such unless proven otherwise.
- Generally, a legal entity cannot be regarded as the author of a work. However, the law provides two cases where a person other than the individual who created a work can be considered its author:
 - if the work was created abroad, rather than in Russia. Legislative acts may be in effect in these countries, defining who is considered the author or original copyright owner of the work; or
 - if the legal entity acquired the rights for a work created on the territory of the USSR before 3 August 1993, it can be considered the author of this work. Personal non-proprietary rights for the work can only belong to the person who created it.
- A person who has commissioned the work to be created
- A commission agreement can specify that the customer will be the original owner of exclusive proprietary rights for the work that was created under the agreement.
- An employer, via an employment contract with an employee
- If an employee created the work while performing his or her work-related activities, exclusive copyright belongs to the employer.
- A purchaser, via an agreement
- The owner of the copyright is a person or legal entity who has acquired exclusive copyright for the work via an agreement with the author or any other copyright owner.

It should be noted that personal non-proprietary rights can only belong to the person who created the copyright work, and cannot be transferred to a third party.

An employer is considered to be the owner of the copyright of a work created by an employee if all of the following conditions are met:

- an employment contract does not specify the opposite;
- the work was created while an employee was performing his work-related activities;
- remuneration separate from the salary is quoted in the employment contract or additional agreement to compensate for the creation of the work and alienation of copyright in favour of the employer; and
- within three years of the work's submission, the employer must perform one or several of the following actions:
 - start using the work;
 - transfer the exclusive copyright to another entity; and/or
 - inform the author (employee) that the work must be kept secret.

Otherwise, the exclusive copyright is returned to the employee.

The agreement between the employer and the employee must be in writing.

-- from gettingthedealthrough.com (Copyright 2011, Russia, Ques. #22 & 23)

With respect to independent contractors, the customer will own the author's copyrighted work if the customer and author have a written agreement that specifies alienation of exclusive copyright for the future work in favour of the customer.

-- from gettingthedealthrough.com (Copyright 2011, Russia, Ques. #24)

Personal non-proprietary rights (moral rights) cannot be alienated or transferred in any other way. Such rights include:

- the right of authorship;
- the right to a name;
- the right of integrity; and
- the right to publish the work.

-- from gettingthedealthrough.com (Copyright 2011, Russia, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any legal entity or an individual entrepreneur may apply to register a trademark.

Assignment: What can be assigned?

An exclusive right to a trademark, in respect of all or some of the goods for which it has been registered, may be assigned to a legal entity or to an individual entrepreneur under an assignment deed.

A trademark assignment can refer not only to a trademark, but also to trademarks with goodwill. This is not obligatory; it is a matter of agreement between the parties to a contract.

If a trademark assignment includes a trademark that contains as an unprotected element designation of a place or origin of goods for which legal protection is provided within the Russian Federation, the assignment shall be allowed only if the assignee has the exclusive right to such designation.

A trademark assignment shall not be allowed if it may lead consumers to be confused with regard to goods or their manufacturer.

Assignment documentation: What documents are required for assignment and what form must they take?

To register an assignment with Rospatent, the following documentation must be provided:

- three original assignment deeds (numbered and stapled together, and the copies should be duly notarised);
- power of attorney signed by the assignor or assignee; and
- a payment document amounting to the official fee (about €230 per trademark included in the assignment).

The form of assignment is not strictly regulated; however, one of the assignment articles should be related to monetary compensation, otherwise it might be deemed as the deed of a gift and therefore will be considered invalid in accordance with Russian legislation.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment deed must be registered with Rospatent. Without such registration it shall be deemed invalid.

-- from gettingthedealthrough.com (Trademarks 2011, Russia, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=RU> >

SÃO TOMÉ AND PRÍNCIPE

Trademarks

Ownership of marks: Who may apply?

Any person (individual, firm or corporate body) with a legitimate interest may apply for the registration of a mark.

Assignment: What can be assigned?

The property of a trademark can be totally or partially assigned. The assignment must be recorded in order to have an effect towards third parties. If recordal of the assignment is requested by the assignor, the assignee should also be a signatory of the assignment document, or should issue an express statement that he accepts the assignment.

Assignment documentation: What documents are required for assignment and what form must they take?

The requirement for registration of an assignment is a deed of assignment in Portuguese, signed by the assignor and the assignee and certified by a notary public.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required in order to be valid.

-- from gettingthedealthrough.com (Trademarks 2011, São Tomé and Príncipe, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=ST> >

SERBIA

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person may apply for the registration of a mark in the Republic of Serbia. Foreign parties in Serbia enjoy the same rights regarding trademark protection as domestic parties, should such rights derive from international treaties or the principle of reciprocity. However, the party claiming reciprocity has to prove its existence. Additionally, foreign parties have to be represented in proceedings before the Serbian Intellectual

Property Office by a professional representative having a BA degree in law and registered in the Register of Representatives maintained by Intellectual Property Office, or by a domestic legal practitioner.

Additionally, please note that a representative office of a foreign legal person in Serbia shall not be considered as an applicant, since the Company Law specifies that representative offices do not have the status of a legal person.

Assignment: What can be assigned?

All trademarks or a right from an application may be assigned by a contract for all or part of the goods or services for which it is registered. A trademark may be assigned alone; no other business assets need to be assigned to make it a valid transaction. Even though it is not mandatory to register the assignment, we strongly suggest that it is registered. Once registered the assignment can produce legal effects with regards to third parties, and the assignee is formally conferred all the rights stipulated by the assignment.

A trademark holder or applicant may assign the trademark or the right (or both) in the trademark application on the basis of an assignment in respect of all or some of the goods and services.

The assignment agreement needs to be drawn up in writing and it shall contain: the date of signing the agreement, name and surname or business name, domicile, residence or seat of the contractual parties, the trademark registration number or the number of the trademark application and the amount of the fee, if stipulated.

Registration of the assignment of a trademark or the rights arising from the application (or both) shall not be granted if such assignment is liable to cause confusion in trade in respect of the type, quality or geographical origin of the goods or services for which the trademark has been registered or in respect of which the trademark application has been filed, unless the assignee disclaims protection for the goods or services in respect of which there is a likelihood of confusion.

Registration of the assignment of a trademark or the rights arising from the application (or both) that refers only to certain goods or services shall not be approved where the goods or services being assigned are essentially similar to the goods or services in respect of which the mark remains registered for the benefit of the assignor.

Please note that collective trademarks and warranty trademarks may not be the subject of assignment.

Assignment documentation: What documents are required for assignment and what form must they take?

The request for the registration of an assignment of rights may be filed by either of the contracting parties (ie, the assignor or the assignee) and should comprise the following:

- official Z-4 form in triplicate for the assignment of rights;
- the Z-4 form is to be filed with evidence of the legal grounds for the assignment such as the assignment agreement;
- power of attorney (should the request be filed through a representative); and
- proof of the payment of the administrative fee.

Legalisation and notarisation of the above-mentioned documents is not required.

Additionally, a single request filed on the Z-4 form may specify registration of assignment relating to several trademarks or several applications, provided that the earlier rightholder and the new rightholder are the same in each of the trademarks or applications and that the registration numbers or the Z-numbers are indicated on the request. (The Z number represents an application number assigned by the IP Office to the initial application for trademark registration.) If the applicant of the request submits only one copy of the Z-4 form requesting the registration of several assignments of rights, the Office will use one Z-4 form for each of the trademarks or trademark applications included in the request. The original will be inserted in the file relating to the trademark first listed or to the trademark application first listed, respectively, while the copies will be inserted in the other files. Each copy is to bear an indication of the file where the original is kept.

Administrative fees for the registration of trademark assignment amount to €32.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

In order to be effective against third parties, the assignment contract must be in writing and must be entered into the appropriate register at the IP Office at the request of a contracting party.

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=RS> >

SINGAPORE

Patent

Employee inventions

There are specific provisions in the Patent Act dealing with inventions made by a company employee.

An employee, as defined in the Patents Act, is a person who works or worked (where the employment has ceased) under a contract of employment, or in employment under or for the purposes of a government department. An employer is defined to mean the person by whom the employee is or was employed.

An employee invention belongs to the employer in the following circumstances:

- the invention was made in the course of the employee's normal duties as an employee;
- the invention was made in carrying out the duties specifically assigned to him or her where the circumstances are such that the invention may reasonably be expected to result from carrying out those duties; or
- the employee has a special obligation to further the interests of the employer's undertaking.

For the above provision to take effect, a related provision also stipulates that the employee has to be mainly employed in Singapore or, where the employee is not based in Singapore, the employer has to have a place of business in Singapore to which the employee is attached (whether permanently or not).

Independent contractor

For an independent contractor to have a right to the invention, it must first be determined if there was a contract at all. If a contract exists, the independent contractor would have a right to the invention if that contract is one for services. This question is one of law, and is dependent on the facts of each case in question.

Multiple inventors

It is possible for an invention to be invented by more than one inventor.

The Patents Act defines an inventor as an actual deviser of the invention. A two-step approach is necessary to determine the inventorship: determining the inventive concept and determining who devised the inventive concept.

Therefore, a contribution made by a person has to be in the form of contribution made to the inventive concept of the invention, not merely because he or she had contributed to a claim of the invention.

To be named as an inventor, more than mere advice is necessary. The Patents Act provides that 'merely contributing advice or other assistance to a fellow employee during the conception of an invention does not constitute the making of an invention by an employee'. Although this provision deals with employee inventions, this principle applies generally to all persons involved in the invention.

Ownership of the patent

Any person may make an application for a patent, either alone or jointly with other persons.

-- from gettingthedealthrough.com (Patents 2011, Singapore, Ques. #15)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183singapore.pdf> > (Singapore)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=SG> >

SLOVENIA

Trademarks

Ownership of marks: Who may apply?

An application may be filed by any natural or legal person, either domestic or foreign. Foreign applicants, having no address or seat or real and effective industrial or commercial establishment in the Republic of Slovenia, must have a representative for proceedings before the Slovenian Intellectual Property Office (SIPO). There is a limited number of actions that a foreign applicant may undertake without a representative but also in such cases a foreign applicant must provide an address for correspondence on the Slovenian territory.

Assignment: What can be assigned?

Application or registration may be assigned in part or in whole by means of a contract or a unilateral statement. As the Industrial Property Act does not encompass any conditions with regard to the assignments it must be concluded that an assignment, without any other company assets being transferred, is possible.

Collective marks may not be a subject of assignment.

Assignment documentation: What documents are required for assignment and what form must they take?

If the request for recording of the change (assignment) into the register is filed by the holder of the trademark, no documents whatsoever need to be filed with the said request. However, if the request is filed by the assignee, documents revealing legal grounds for registering the assignment need to be presented. The documents need not be notarised, in fact, even copies of the documents may suffice if the office does not raise a question of their credibility. Original documents together with their translation may be filed subsequently, within three months from the receipt of the SIPO's invitation to do so.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Although the recording of the assignment agreement is not obligatory and the Slovenian Industrial Property Act lacks the provisions related thereto, it may be however very useful for the assignee and any third parties to record it accordingly due to its effects in specific cases.

-- from gettingthedealthrough.com (Trademarks 2011, Slovenia, Ques #s 1, 12, 13, and 14)

Information can be found at:

Employment Related Inventions Act of 25 July 1995 as last amended on 18 December 2006
< http://www.wipo.int/wipolex/en/text.jsp?file_id=180806 >

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=SI> >

SOUTH AFRICA

Labour & Employment

The employer is usually the owner of intellectual property rights created by an employee in the course and scope of his or her employment, even where the employment contract is silent on this point. It is, however, advisable to deal

specifically with ownership of the various forms of intellectual property rights in the employment contract, in order to avoid any debate on this issue.

This general rule does not apply to independent contractors. Where an independent contractor creates intellectual property, the independent contractor will usually be the owner of the intellectual property rights unless the parties have entered into a written agreement in terms of which the intellectual property rights are assigned to the 'employer' [hiring party].

-- from gettingthedealthrough.com (Labour & Employment 2010/2011, South Africa, Ques. #28)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183southafrica.pdf> > (South Africa)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=ZA> >

SPAIN

Labour & Employment

There are three kinds of work-related inventions, as follows:

- Service inventions: These are inventions that are the subject of the employment agreement and belong to the employer. The worker only has a right to supplementary compensation when his personal contribution to the invention and its importance to the company evidently exceed the requirements of the employment agreement.
- Use or mixed inventions: These occur when a worker, not hired to engage in research activities, makes an invention related to his work for the company. The employer has the right to assume ownership or reserve a right of use. The worker is entitled to just economic compensation.
- Other inventions: These are not truly work-related inventions, but are rather free from the terms of employment because the personal participation of the worker predominates. This means that the invention belongs to the worker who may patent and use it.

-- from gettingthedealthrough.com (Labour & Employment 2011, Spain, Ques. #28)

Copyright

Generally, the author (natural person) is the original owner of the copyrighted work. In the case of audio-visual works, article 88.1 TRLPI contains a simple presumption of assignment of rights in favour of the producer.

In the case of software, moral persons may be considered authors.

According to article 51 TRLPI, the transmission to the employer of the exploitation rights of the work created under an employment relationship must be done under a written agreement.

The absence of a written agreement hereby assigns the employer with exclusivity for all exploitation rights

-- from gettingthedealthrough.com (Copyright 2010, Spain, Ques. #22 & 23)

The law does not address this matter in detail, but the case law has different points of view. On the one hand, some courts and judges set forth that in these assumptions it is necessary to express clearly in the contract the assignment of rights. On the other hand, however, some sentences set forth that, in the absence of express assignment, the transmission of rights shall depend on the nature and purpose of the service rendered to the contractor.

Spanish legal doctrine sets forth the interpretation that article 51 TRLPI (related to the assignment of rights of an employee) could also be invoked in the case.

-- from gettingthedealthrough.com (Copyright 2010, Spain, Ques. #24)

Moral rights are recognised in articles 14 to 16 (Chapter 3, section 1, Title II of Book I) of the Copyright Act of 1996, which comprises the following rights:

- the right to decide whether the work should be published and in what form;
- the right to publish the work under his or her real name, pseudo-nymously or anonymously;
- the right to be identified as the author of the work;
- the right to insist on the respect of the integrity of the work and to prevent any distortion, modification, alteration or derogatory action in relation to the work which would be prejudicial to his or her legitimate interests or reputation;
- the right to modify the work in the respect of the rights of third parties and of the protection of ‘Works of Cultural Interest’;
- the right to withdraw the work from commercial exploitation, due to a change of his or her intellectual or moral convictions, with compensation to the holders of the rights of exploitation. If the author later decides to re-undertake the exploitation of his or her work, he or she will have to preferably offer the corresponding rights to the former rights-holder and in conditions reasonably similar to the previous ones; and
- the right to access a single copy or a rare copy of the work in order to exercise the right to publish the work or any other related rights. This right does not include the right to displace the work, and must be exercised without causing any inconvenience to the legal owner of the copy and with compensation for any prejudice or damage incurred.

Duration of moral rights

The rights to be identified as the author of a work and to afford the respect of its integrity are perpetual and, to some extent, may be exercised after the author’s death by his or her executors, heirs or (by default) by the state (articles 15 and 16).

-- from gettingthedealthrough.com (Copyright 2011, Spain, Ques. # 12)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers’ Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183spain.pdf> > (Spain)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=ES> >

SWEDEN

Labour & Employment

The Right to Employee Inventions Act regulates the employee’s and the employer’s right to employee inventions. As a main rule, the employee has the same right to the invention as other inventors, unless otherwise is stated. The employer may obtain the right to employee-created inventions, provided that the invention is created in connection with the employment and the employee’s main work tasks, and that the utilisation of the invention falls within the employer’s area of activity.

-- from gettingthedealthrough.com (Labour & Employment 2011, Sweden, Ques. #28)

Patent

Ownership of employee inventions and patents thereon are subject to regulation by law and collective agreement as well as employment contracts. Provisions in individual employment contracts are applicable, except when they are superseded by a collective agreement. Relevant provisions are included in collective agreements as applicable to

such employment, and are mainly applicable in the industrial and service sectors. The law applies where no collective or individual agreements have been made or where they lack relevant provisions.

The main principle under Swedish law is that an invention belongs to the inventor. Under legal and collective employee ownership provisions, ownership of an invention made by the employee as part of the employment may be transferred to the employer upon the employer's request. Inventions made outside the scope of employment but still in the employer's general line of business may be subject to transfer or licence upon the employer's request. Inventions made outside the employer's line of business belong to the employee. An individual employment agreement may stipulate otherwise.

There is no regulation of ownership of inventions made by independent contractors and patents thereon except for individual agreements. The parties are free to agree on any allocation of ownership. Where no agreement has been made, the main principle is that inventions and patents belong to the contractor.

Ownership of inventions by multiple inventors and patents thereon is not subject to express regulation in law. Ownership is considered to belong to the inventors collectively. The implications of this are widely discussed in doctrine and are considered analogous to implications in connection with collective ownership in other legal fields. Case law on the subject is scarce.

Ownership is officially recorded in the Swedish patent authority's patent registry. Registration is not mandatory and has no legal effect on ownership. It does affect the possibility of pledging the patent. Ownership is transferred under agreement and is not subject to any formal requirements.

-- from gettingthedealthrough.com (Patents 2011, Sweden, Ques. #15)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183sweden.pdf> > (Sweden)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=SE> >

Act on Right to Inventions by Employees < <http://www.notisum.se/rnp/sls/lag/19490345.htm> > (Swedish)

Ownership of the Copyright in Works and the Patent Rights in Inventions Created by Employees
< <http://www.juridicum.su.se/user/sawo/Publikationer/Wolk%20nr%20120.pdf> > (in Finland, Sweden, Germany, Austria, the United Kingdom, Estonia, and Argentina).

Compensation of Employed Inventors in Sweden
< <http://www.juridicum.su.se/user/sawo/Publikationer/WIPRO208%5Bwolk%5D.pdf> >

SWITZERLAND

Labour & Employment

According to the Swiss Code of Obligations, inventions and industrial designs created by the employee, or to which the employee contributed, while performing his employment activity and contractual duties belong to the employer. By written agreement, the employer may reserve the right to acquire any inventions or industrial designs created by the employee while performing the employment activity but not his or her contractual duties. The employer must then exercise this right within six months after notification by the employee and pay appropriate compensation to the employee for the acquired invention or design.

The Swiss Federal Act on Copyright (SR 231.1) confers upon the employer the exclusive right to use any computer programs created by the employee while performing his or her employment activity and contractual duties.

-- from gettingthedealthrough.com (Labour & Employment 2010/2011, Switzerland, Ques. #28)

Patents

An invention belongs to the company if it is made by a company employee who is responsible (meant in a broad sense) for the development or improvement of products or methods of the company. The company owns the invention directly and has the right to apply for a patent. No assignment has to be signed by the employee and no remuneration has to be paid by the company. Inventions made by employees that are not responsible for product or method development will only be assigned by law to the company if a written clause to this end is provided for in the employment contract. In this case, remuneration has to be paid.

Ownership of inventions made by independent contractors depends on the type of contract if no clause is provided for in the contract; it is therefore advisable to cover this issue by an explicit clause in the contract.

Multiple owners of the patent application or patent are collective owners in the absence of other stipulations.

Ownership of a patent application or a patent is recorded in the patent register at the Swiss Federal Institute of Intellectual Property (the Patent Office); recording a change of ownership is not mandatory. The right to an invention and the right to obtain a patent can be freely transferred without formality. A patent application and a patent, on the other hand, must be transferred by a written document.

-- from gettingthedealthrough.com (Patents 2011, Switzerland, Ques. #15)

Copyright

Copyright is initially vested in the author. The author is the physical person who has created the work. Where several authors have contributed to the creation of the work, the copyright belongs to them jointly and, unless agreed otherwise, may only be exercised with the consent of all authors. If, however, the individual contributions can be separated, and the authors have not agreed otherwise, each co-author may make use of his or her contribution independently.

Under Swiss law there is no statutory transfer of copyrights within the framework of an employment relationship; copyrights are transferred from the employee to the employer by contract only. A considerable part of the doctrine and practice advocates that if the creation of copyrighted works is a part of the employee's contractual duties, the exclusive exploitation rights are implicitly transferred to the employer to the extent required by the employment relationship and without specific contractual provisions ('theory of finality'). This doctrine and practice is, however, controversial so it is advisable to include explicit provisions in the employment contract with regard to the extent of the transfer of copyrights.

In relation to computer programs created by employees in the course of their employment and as a part of their contractual duties, the Copyright Act, however, provides that the employer alone shall be entitled to exercise the exclusive exploitation rights.

-- from gettingthedealthrough.com (Copyright 2011, Switzerland, Ques. #22 & 23)

A hiring party may own a copyrighted work made by an independent contractor. Since copyrights are always initially vested in the author, the hiring party does not automatically acquire the ownership by virtue of the hiring relationship and the copyright should be assigned by means of the provisions of the hiring contract. On the other hand, the parties need not expressly agree to the assignment; an implicit agreement is sufficient. Neither the hiring agreement nor the copyright assignment itself is required to be in writing. Within the framework of a publishing contract according to article 380 et seq of the Swiss Code of Obligation, the copyright is assigned by law from the author to the publisher to the extent and for the duration necessary to carry out the contract pursuant to article 381(1) if not otherwise agreed between the parties.

-- from gettingthedealthrough.com (Copyright 2011, Switzerland, Ques. #24)

The rights pertaining to the author's personality (moral rights) form a general restriction on the use of a copyright work by third persons. Even if a person is allowed, contractually or by the law, to modify a work or to use it for the creation of a derived work (translation etc), the author is entitled to object to any distortion, mutilation or other modification of the work which could be prejudicial to his or her reputation or otherwise harm his or her personality.

Besides, the author has the right to be identified as author of a copyright work, as well as the right to decide on the manner and date of first publication of the work.

-- from gettingthedealthrough.com (Copyright 2011, Switzerland, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any individual, company, association, business association, incorporated society or enterprise (including holdings); in brief, any private or public entity may apply for ownership of a trademark. Two or more applicants may seek trademark protection jointly, provided they appoint one single representative for the mark concerned. Further, collective marks and guarantee marks are also available. If the applicant has no domicile or business seat in Switzerland, a Swiss representative must be appointed.

Assignment: What can be assigned?

The assignment of the registration usually includes the goodwill attached to this mark because by way of the assignment, the previous owner or assignor relinquishes all rights to the trademark, including the right to use it, so that the goodwill is automatically transferred to the new owner. However, the business previously attached to the mark does not have to be transferred together with the trademark.

To record the assignment, the parties do not have to include a value or consideration for the goodwill attached to the trademark.

A partial assignment is also possible in such a way that the trademark rights are only assigned for part of the registered goods or services. Partial assignment for only a part of the Swiss territory, however, is not possible. International trademark registrations may be assigned for one country only.

Assignment documentation: What documents are required for assignment and what form must they take?

An assignment declaration, signed by the assignor (previous owner) is required. No notarisation or legalisation is required. The document should state clearly who the parties are (name and full address) and which trademarks (registrations and applications) are to be transferred.

If the procedure is handled by an agent, he or she will need a power of attorney from the new owner (simply signed, no notarisation or legalisation required).

Validity of assignment: Must the assignment be recorded for purposes of its validity?

A contractual obligation to assign a mark may be established in any form, for example, in writing or even by verbal agreement. The assignment itself must be in written form to be valid and effective, but recordal in the Trademark Register is not necessary to establish validity of the assignment. However, the assignment will only take effect in relation to third parties acting in good faith once it has been recorded in the Register, and the actions provided for in the Trademark Act may be brought against the previous owner of the trademark as long as the assignment has not been recorded. Also, the new owner of the mark, in the absence of recordal of the assignment in the Register, will need to prove ownership of the mark in enforcement proceedings (such as oppositions and court actions), whereas once recordal has taken place, an extract from the Trademark Register will usually be sufficient to establish ownership. It is thus highly advisable to record assignments in the Register even though the recordal is not a validity requirement.

-- from gettingthedealthrough.com (Trademarks 2011, Switzerland, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183switzerland.pdf> > (Switzerland) (in Swiss, Summary in English and French)

WIPO Lex -- <<http://www.wipo.int/wipolex/en/profile.jsp?code=CH> >

TAIWAN

Labour & Employment

Under the Copyright Act, unless otherwise agreed, the author of a work generated by an employee within the scope and during the course of his or her employment is the employee. However, the copyrights thereof shall vest in the employer.

Further, under the Patent Act, unless otherwise agreed, where an invention, a utility model or a design is made by an employee within the scopes and during the course of his or her employment, the patent right granted for the invention, the utility model or the design shall vest in the employer. The employer should adequately compensate the employee. On the other hand, if such invention, utility model or design is made outside the scope and the course of his or her employment, the patent right derived therefrom shall vest in the inventor, provided that the employee has not exploited the employer's resource or experience.

Moreover, the employee should notify his or her employer in writing upon completion of the invention, utility model or design made outside the employment scopes and course and allow a six-month period for the employer to assert its claim of patent right. Upon the expiration of the foregoing period, the employer may not assert such patent right to be a patent right derived from the scope and course of employment.

-- from gettingthedealthrough.com (Labour & Employment 2011, Taiwan, Ques. #28)

Patent

Unless the contract provides otherwise, a company owns the patent application right and patent right of its employees' inventions on works for hire, while the employee is entitled to ask for appropriate compensation and his or her name to be indicated as the inventor. The patent application right and patent right of an employee's invention other than that as a work for hire shall be vested in the employee provided that, if the invention is made through utilisation of the employer's resources or experience, the employer may, after having paid the employee a reasonable remuneration, put the same invention or utility model or design into practice in the enterprise concerned.

The patent application right and patent right for an invention made by an independent contractor shall be vested in accordance with the agreement. In the absence of such an agreement, the patent application right and patent right shall be vested in the independent contractor, provided, however, that the fund-provider shall be entitled to put such invention into practice.

Multiple inventors jointly own the patent application rights and must file the patent application jointly.

The ownership and the transfer of patent rights is published by the Patent Official Gazette and recorded in TIPO's database. Unless registered with TIPO, any transfer, trust or licensing or pledge of a patent cannot be asserted against a third party.

-- from gettingthedealthrough.com (Patents 2011, Taiwan, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

Any individual, corporation or legal entity may apply to the Taiwan Intellectual Property Office (TIPO) to register a trademark in Taiwan. Foreign applicants from WTO member countries or countries that protect trademarks on a reciprocal basis with Taiwan may apply, but those not domiciled or established in Taiwan must appoint a trademark agent in Taiwan to register a mark.

Assignment: What can be assigned?

A registered mark is assignable with or without goodwill. All or some of the goods and services may be assigned, and a mark need not be assigned in connection with other business assets to be effective. A trademark may be licensed to multiple licensees. With the permission of the original rights owner, licensees may sub-license an assigned mark to a third party.

A partial assignment is also possible in such a way that the trademark rights are only assigned for part of the registered goods or services. Partial assignment for only a part of the Swiss territory, however, is not possible. International trademark registrations may be assigned for one country only.

Assignment documentation: What documents are required for assignment and what form must they take?

An assignment agreement executed by both parties and power of attorney from the assignee are required to record the assignment with the TIPO. Neither notarisation nor legalisation is required.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment need not be recorded to be valid between the assignor and the assignee. The assignment must be recorded, however, for it to be asserted against any third party.

-- from gettingthedealthrough.com (Trademarks 2011, Taiwan, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=TP> >

THAILAND

Patent

Company employee and independent contractor

The right to apply for a patent for an invention made in the execution of an employment contract or a contract for performing certain work (hire of work) will belong to the employer or the person having commissioned the work, unless otherwise provided in the contract (section 11 of the Patent Act BE 2522 (as amended)).

Multiple inventors

When an invention is made by two or more persons jointly, they will have a right to apply for a patent jointly. If a joint inventor refuses to join in a patent application or cannot be found or reached, or is not entitled to make a patent application, the patent application may be made by the other inventor on behalf of himself or herself.

However, a joint inventor who did not join in a patent application may subsequently make a request to join in the application at any time before a patent is granted.

The assignment of the right to apply for a patent must be in writing and is required to be signed by both the assignor and the assignee. To comply with the filing requirements, the assignment is required to be filed with the Patent Office.

-- from gettingthedealthrough.com (Patents 2011, Thailand, Ques. #15)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=TH> >

TURKEY

Copyright

As clearly defined in article 1/B(b) and article 8(1) of the Copyright Law, the author of a work is the person who has created it.

According to article 18 of the Copyright Law, the authority to exercise the rights on works created by civil servants, employees and workers during the execution of their duty belongs to the persons who employ or appoint them.

The letter of the law leads to an opinion that the authority to exercise any and all rights on the work belongs to the employer with no discrimination between moral and economic rights. However, it is more appropriate to come to the conclusion, considering the strong link between moral rights pertaining to a work and the author who has created it, that only the authority to exercise economic rights shall be deemed to be assigned automatically to the employer within the framework of an employment relationship. The employee who has created the work shall retain the authority to exercise all moral rights over the work (ie the right to disclosure to the public, to designate the name, to prohibit any modification and to request from the actual owner temporary use of the work) unless otherwise stipulated in the employment contract.

This argument is widely accepted in doctrine, with only slight differences. The practice of the Supreme Court of Appeals also reflects a similar approach.

Assignment of economic rights over the work is deemed to be automatically realised, provided that the work has been created by the employee within the scope of the task and job assumed under the contract.

-- from gettingthedealthrough.com (Copyright 2011, Turkey, Ques. #22 & 23)

Any person who has made a contract with an independent contractor for the creation of a work does not automatically acquire the economic rights on the work created within the framework of the said contract. Assignment of economic rights should be realised with a written agreement and the fact that the economic rights are assigned should be explicitly specified in this agreement. In the absence of such an agreement, the economic rights over the work created by the independent contractor within the framework of the contract shall belong to the contractor who has created the work, although they cannot be exercised by him or her.

-- from gettingthedealthrough.com (Copyright 2011, Turkey, Ques. #24)

The Turkish copyright regime recognises an author's perpetual and inalienable rights over his or her work. These rights, defined as moral rights, are limitedly enumerated in the law. They cannot be inherited or transferred by any contractual transactions between living persons and they cannot be the subject of any act of disposal arising from death. Only the authority of exercising moral rights may be the subject of a transfer.

Moral rights enumerated in the Copyright Law are as follows: (i) the right to determine whether or not the author's work shall be disclosed to the public, and the time and manner of its disclosure; (ii) the authority to be identified as the author and to decide whether the work shall be disclosed with or without a name or under a pseudonym; (iii) the authority to prohibit any abbreviation, addition or other modification of the work; and (iv) the authority to request the current owner or possessor of the original work to allow the author to make use of it for a temporary period.

-- from gettingthedealthrough.com (Copyright 2011, Turkey, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

The Trademark Decree Law No. 556 (the Decree Law) and the Regulation on Implementation of the Decree Law (Regulation) regulate trademark protection in Turkey. Further, there are certain provisions of the Turkish Commercial Code that are referred to in terms of unfair competition. The responses below have been provided in light of said legislation.

Real persons and legal entities who are domiciled or perform industrial or commercial activity in Turkey can file trademark applications to the Turkish Patent Institute (the TPE). Real persons and legal entities who are entitled to such right under the Paris Convention or under the World Trade Organization Establishment Agreement can also apply for trademark registration.

Furthermore, as per the rule of reciprocity, real persons and legal entities of a foreign country can make trademark applications in Turkey if Turkish citizens are granted such right in that country by law or in practice.

Assignment: What can be assigned?

A trademark can be assigned for all or only part of the goods or services that it has been registered. There is no legal obstacle to include goodwill in a trademark assignment transaction.

Acquisition of a company with its active and passive assets covers the assignment of the trademarks as well. However, it is possible to agree on exclusion of trademarks in a business transfer.

Trademark assignment agreements must be made in writing. It is possible to register an assignment before the TPE if one of the parties requests this. In the absence of registration, trademark rights arising out of the assignment cannot be claimed against third parties.

If the assignment would cause public confusion in terms of source or quality of the good or service or the trademark itself, the TPE would not accept the assignment unless the scope of the trademark registration is limited by the new trademark owner. Further, if identical or similar trademarks exist for similar goods or services that would cause confusion, those should be assigned as well.

Assignment documentation: What documents are required for assignment and what form must they take?

The TPE requires the following documents to record assignments, including partial ones:

- registration request;
- receipt documenting fee payment;
- notarised assignment agreement between the parties that contains the trademark and its registration number (if partial assignment takes place, the goods or services assigned); and
- if the request is filed by a trademark attorney, reference to his or her power of attorney.

As stated under “What can be assigned?,” unless agreed otherwise, a business transfer includes a trademark transfer. Therefore, submitting a general agreement would be sufficient to request registration of the assignment.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment does not have to be recorded to be considered valid. However, the assignment must be recorded in order for the new trademark owner to be entitled to claim the trademark rights against third parties.

-- from gettingthedealthrough.com (Trademarks 2011, Turkey, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=TR> >

UKRAINE

Labour & Employment

Issues of employee inventions are primarily regulated by the Civil Code of Ukraine < http://www.wipo.int/wipolex/en/text.jsp?file_id=181865 > (in Ukrainian). Personal non-property rights [moral rights] with respect to inventions made by an employee during performance of his or her duties at work are vested in such employee. Property rights with respect to inventions are vested jointly in the employee and its employer unless otherwise stipulated by the employment agreement or contract.

-- from gettingthedealthrough.com (Labour & Employment 2010, Ukraine, Ques. #28)

Trademarks

Ownership of marks: Who may apply?

Any individual or legal entity may apply for registration of a trademark in Ukraine. Foreign individuals and legal entities have the same rights under the laws of Ukraine on trademarks as Ukrainian nationals, as provided under international treaties and the principle of reciprocity. However, if foreign individuals or legal entities are domiciled outside Ukraine, they shall act in Ukraine through their duly authorised patent agents.

Assignment: What can be assigned?

An exclusive right to a trademark may be assigned with regard to all goods and services or a subset of specific goods and services that it was registered for by entering into an assignment agreement. Assignment of right shall be made within the effective term of the registration. The parties are free to assign goodwill with rights to a trademark. No business assets shall be assigned to make it a valid transaction.

A trademark assignment is not allowed if it may lead to deception of the customer in respect of the goods and services or the person who produces goods or provides services.

Assignment documentation: What documents are required for assignment and what form must they take?

The assignment agreement is deemed to be valid if it has been concluded in writing and has been signed by both parties to the agreement. There are, however, certain requirements in respect of the form of the assignment agreement to be filed with the UPTO for the purposes of recordation within the Trademark Register and publication of information on the assignment of the rights. The assignment of rights can be done during and after the completion of the trademark registration process.

In this case, the following documents shall be filed with the UPTO:

- three copies of an assignment agreement (including a minimum of one original and one notarised copy);
- a formal application signed by both parties;
- power of attorney, if appropriate (appointing a patent agent as a representative of assignee or assignor if a non-resident is involved); and
- a payment document amounting to the official fee of €60 (in the case of recording the assignment of a pending trademark application) and a fee of €80 (if the recordation is done after the certificate has been issued).

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Although an assignment concluded in writing and signed by both parties to the agreement is deemed to be valid, the information on the change of an owner should be recorded in the UPTO's State Register of Certificates of Ukraine for Trademarks and Service Marks according to the provisions of the Civil Code. Moreover, the High Commercial Court has recently adjudicated the following: although an assignment agreement may be executed by the parties after it has been signed, the obligations for the third parties arise only after such an agreement is duly registered in the UPTO. It usually takes one to two months, if a trademark application is pending, and two to three months, if a trademark certificate has already been issued, to record the respective trademark assignment.

-- from gettingthedealthrough.com (Trademarks 2011, Ukraine, Ques #s 1, 12, 13, and 14)

By default, IP rights in objects created by employee in course of employment belong jointly to the employee and employer. However, parties in the employment agreement may agree otherwise.

The copyright matter that is developed by employee out of his employment (i. e. out of scope of the job description or specific assignment) belongs to the employee, notwithstanding the fact whether or not such IP was developed with the use of assents or knowledge obtained from the employer.

As regards the patented matter, the situation is somewhat different. Anything patentable belongs to the employer, if it is developed by employee (whether in or out of scope of the job description) with the use of knowledge, know-how or assets of the employer.

-- provided by Anastasija Sinitsa

Additional information can be found at:

[Law on the Protection of Rights to Inventions and Utility Models No. 3687-XII of December 15, 1993](http://www.wipo.int/wipolex/en/text.jsp?file_id=181860)
< http://www.wipo.int/wipolex/en/text.jsp?file_id=181860 > (in Ukrainian)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=UA> >

UNITED KINGDOM

Labour & Employment

Employee ‘inventions’ are addressed by the Patents Act 1977 and the Copyright, Designs and Patents Act 1988. Generally, any intellectual property that is created by an employee in the course of his or her employment in the UK will belong to the employer. However, it is common for there to be an express assignment provision of IP rights in the employment contract.

-- from gettingthedealthrough.com (Labour & Employment 2011, United Kingdom, Ques. #28)

Patents

Generally speaking, patents belong to the inventors of the underlying invention, or to any party who owned all of the rights to the invention at the time it was created. Joint owners will generally be entitled to an equal, undivided share in the patent, and will all be entitled to use the invention. However, the invention can only be licensed or assigned with the consent of all of the owners thereof. In turn, independent contractors or individuals will own any patents granted in respect of their inventions unless they are bound by any contractual provisions to the contrary.

The issue of joint ownership of patents was explored by the House of Lords in the landmark case of Yeda Research and Development Company Limited (Appellants) v Rhone-Poulenc Rorer International Holdings Inc and others (Respondents) [2007] UKHL 43 < <http://www.parliament.the-stationery-office.co.uk/pa/ld200607/ldjudgmt/jd071024/yeda-1.htm> > or < <http://www.bailii.org/uk/cases/UKHL/2007/43.html> >, in accordance with which any individual wishing to be identified as the joint inventor of an invention has to prove that he or she was involved in the creation of the concept underlying the invention. In addition, anyone wishing to be substituted for the individual named as the inventor of an invention has to prove that this individual did not have any input into the inventive concept behind the invention.

If, however, an invention is created during the course of an individual’s employment and it is reasonable to expect that it would result from performance by the employee of his or her duties, then it and any patents subsequently granted in this respect are owned by the inventor’s employer, insofar as the invention was made during the course of the employee’s normal duties or in the course of duties falling outside his or her normal duties but specifically assigned to the employee. In such cases, employees may be granted compensation under section 40 of the Patents Act if the patent or underlying invention is of exceptional benefit [NOTE: Section 40(1) of Patents Act uses the term “*outstanding benefit*”] to the employer. The case of James Duncan Kelly and Kwok Wai Chiu v GE Healthcare Limited [2009] EWHC 181 (Pat) < <http://www.bailii.org/ew/cases/EWHC/Patents/2009/181.html> > was the first compensation award under the provision. Total sales of the drug the claimants had invented had been £1.3 billion: the court awarded them £1 million and £500,000 respectively in compensation.

The issue of employees’ rights to patents was considered in the case of LIFFE Administration and Management v Pavel Pinkava and another [2006] EWHC 595 < <http://www.bailii.org/ew/cases/EWHC/Patents/2006/595.html> >, which related to a situation where an employee had created an invention that had a significantly wider application than the particular problem he had been asked to address during the course of his duties. Nonetheless, because the invention resulted directly from the extra duties given to him, the employee was required to assign the patent to his employer.

Patent ownership is recorded at the UK IPO, and patents may be assigned under a separate contract or by means of contractual provisions in a broader contract. In addition, patents can be licensed to third parties, also by means of a contract to this effect or contractual provisions in an existing contract.

-- from gettingthedealthrough.com (Patents 2011, United Kingdom, Ques. #15)

Copyright

The first owner of copyright in a work is as follows:

- for literary, dramatic, musical or artistic works: the person who creates it;
- for a sound recording: the producer;
- for a film: the producer and the principal director;
- for a broadcast: the person making the broadcast or effecting the retransmission;
- for a typographical arrangement: the publisher; and
- for computer generated works: the person making the arrangements necessary for the creation of the work.

The above is displaced where a literary, dramatic, musical or artistic work or a film is made by an employee in the course of his employment. In those circumstances, the employer is the first owner of any copyright in the work. Furthermore, all of the above arrangements can be altered by a prior agreement. It is also possible for copyright to vest in advance in a particular person where there is an agreement in writing relating to 'future copyright'.

An employer can own copyright in a particular work:

- under an agreement made in advance;
- where a work is made by an employee in the course of his or her employment; or
- where the employer obtains an assignment of copyright.

Where a copyright work is commissioned, in the absence of agreement to the contrary, the creator remains the copyright owner and the commissioner only receives a limited licence to use the work. There are notable exceptions as to first ownership for design right and database right.

-- from gettingthedealthrough.com (Copyright 2010, UK, Ques. #22 & 23)

The general rule is that the first owner of copyright will be the person who creates the work in question. The 'creator' (and hence the copyright owner) will vary depending on the category of work:

- the person who creates the work for literary, dramatic, musical or artistic works;
- the producer for sound recording;
- the producer and the principal director for film;
- the publisher of a published edition;
- the person making the broadcast or effecting the retransmission for a broadcast;
- the publisher for a typographical arrangement; and
- the person making the arrangements necessary for the creation of the work for computer generated works.

The general rules as set out above are altered in an employment relationship and may also be amended by a prior agreement. For example, it is possible to assign the benefit of future copyright to a person other than the first owner.

Where a copyright work is made by an employee in the course of his or her employment, the employer will be the first owner of the copyright unless there is an agreement to the contrary.

-- from gettingthedealthrough.com (Copyright 2011, UK, Ques. #22 & 23)

A hiring party may own the copyrighted work made by an independent contractor, but only pursuant to an agreement (which may be oral or in writing).

-- from gettingthedealthrough.com (Copyright 2010, UK, Ques. #24)

Where a piece of work is commissioned by a hiring party, the general rule is that ownership of a copyright work will remain with the independent contractor (ie, the person who creates the work). The parties may agree by written contract (and often do) that such copyright will be assigned to the hiring party. Even when no formal agreement has been entered into, the courts are sometimes willing, depending on the circumstances, to imply a contractual term that copyright should be assigned, or more frequently licensed, to the hiring party for whatever use was envisaged when the work was commissioned.

-- from gettingthedealthrough.com (Copyright 2011, UK, Ques. #24)

The author or director of a copyright work usually has moral rights in relation to the work. These are the rights to:

- be identified as the work's author or director (the right of attribution or paternity - which must be asserted in writing);
- object to derogatory treatment of a work (right of integrity);
- privacy in respect of certain photographs and films; and
- not have the work's authorship wrongly attributed.

These rights may be waived by the author or director but not assigned. The rights of integrity and paternity and privacy have the same duration as copyright, but the right to object to false attribution lasts for the author or director's lifetime plus 20 years.

-- from gettingthedealthrough.com (Copyright 2011, UK, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any natural or legal person. Joint applicants are also allowed so it is possible to apply in the name of more than one natural or legal person, all of whom have a share in the application and eventual registration.

Assignment: What can be assigned?

A trademark application or registration can be assigned either with or without goodwill. The application or registration can be assigned in relation to all or just some of the goods and services covered by it.

Assignment documentation: What documents are required for assignment and what form must they take?

An assignment must be in writing and must be executed by the assignor. There is no requirement of notarisation and no requirement that the assignee execute the assignment.

However, as assignments generally contain terms other than simply the bare assignment, such as terms covering payment of monies for the assignment, assignment documents are generally executed by both assignor and assignee.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The assignment must be recorded if the assignee is to rely on the trademark registration and enforce the rights given by virtue of registration against a third party.

-- from gettingthedealthrough.com (Trademarks 2011, United Kingdom, Ques #s 1, 12, 13, and 14)

"No Overreaching" Provision:

Where an invention belongs to an employee under section 39 of the Patents Act 1977, then section 39(3) provides a limited "no overreaching" provision with respect to copyright and design rights that may be otherwise vested in the employer:

39(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

(a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or

(b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

-- provided by Francis Davey

Section 42 < <http://www.ipo.gov.uk/practice-sec-042.pdf> > further prohibits contracts that diminish rights in employee-owned inventions.

42 Enforceability of contracts relating to employees' inventions.

(1) This section applies to any contract (whenever made) relating to inventions made by an employee, being a contract entered into by him—

(a) with the employer (alone or with another); or

(b) with some other person at the request of the employer or in pursuance of the employee's contract of employment.

(2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the appointed day and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.

(3) Subsection (2) above shall not be construed as derogating from any duty of confidentiality owed to his employer by an employee by virtue of any rule of law or otherwise.

(4) This section applies to any arrangement made with a Crown employee by or on behalf of the Crown as his employer as it applies to any contract made between an employee and an employer other than the Crown, and for the purposes of this section "Crown employee" means a person employed under or for the purposes of a government department or any officer or body exercising on behalf of the Crown functions conferred by any enactment or a person serving in the naval, military or air forces of the Crown.

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183uk.pdf> > (UK)

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=GB> >

Ownership of the Copyright in Works and the Patent Rights in Inventions Created by Employees
< <http://www.juridicum.su.se/user/sawo/Publikationer/Wolk%20nr%20120.pdf> > (in Finland, Sweden, Germany, Austria, the United Kingdom, Estonia, and Argentina).

For a detailed discussion of employee-inventor compensation laws in Belgium, France, Germany, the Netherlands, and the United Kingdom, see "Employee's rights to compensation for inventions - a European perspective" at < <http://www.cov.com/files/Publication/4ffe8880-deba-493a-8994-2a69f0da78dd/Presentation/PublicationAttachment/3b0e8983-fe2a-41b5-9e96-2fb6c8a3a8c1/Employee%e2%80%99s%20Rights%20to%20Compensation%20for%20Inventions%20-%20A%20European%20Perspective.pdf> >

There are two ways in which an employee's invention will, by section 39 of the Patents Act 1977
< <http://www.legislation.gov.uk/ukpga/1977/37/section/39> >, belong to the employer:

First, if the invention was made in the course of the normal duties of the employee (or in the course of duties falling outside the employee's normal duties, but specifically assigned to them) and such an invention might reasonably be expected to result from carrying out those duties, the invention belongs to the employer. Thus, an invention made by an employee who was employed, say in a research capacity, to do so, would belong to the employer. On the other hand an employee who happens to invent something in the course of their employment which would not reasonably be expected to arise from the carrying out of their duties would normally be the owner of the invention.

For example in Paul Auckland v Enderby Construction (BL O/343/06)
< <http://www.ipo.gov.uk/o34306.pdf> >, the employee was a health and safety officer who devised a temporary cover for partially completed manholes. The invention was clearly made in the course of his employment as a health and safety officer, but his duties were not such that an invention might reasonably be expected from carrying them out. The hearing officer held that the invention belonged to him.

The second way in which an employer may end up owning an employee's invention is where the invention was made in the course of the duties (whether normal or not) of the employee and the nature of those duties and any particular responsibilities arising from them gave rise to a "special obligation to further the interests of the employer's undertaking". For example where an employee is a fiduciary such as a director, their inventions are likely to belong to their employer even if an invention might not reasonably be expected to result from the carrying out of their duties (see for example Harris' Patent [1985] RPC 19) (summary of case found at <http://www.swarb.co.uk/lisc/Emplm19851989.php>).

Where an employee makes an invention which belongs to the employer, the employee may be entitled under section 40 of the Patents Act 1977 <http://www.legislation.gov.uk/ukpga/1977/37/section/40> to compensation if the invention was of outstanding benefit to the employer and, in all the circumstances, it is just that the employee be compensated. The amount of compensation is a "fair share" of the benefit to the employer.

Section 39 (Employees' Inventions) of the UK Manual of Patent Practice can be found at <http://www.ipo.gov.uk/practice-sec-039.pdf>

-- provided by Francis Davey

A good article, "IP ownership in English law," discussing patent ownership in the UK can be found at <http://www.iam-magazine.com/issues/article.ashx?g=af4ff2bc-6232-433f-9b4b-8833e43aa5ae>

A more thorough discussion of ownership of patents under UK law can be found at Chapter 5 – Ownership (pages 42 to 49) in "Intellectual Property Law (5th ed.)" by Tina Hart, Linda Fazzani, and Simon Clark at <http://www.palgrave.com/PDFs/9780230216396.Pdf>.

The works-made-for-hire rules for employees and independent contractors in Australia, China, France, Germany, Japan, the United Kingdom, and the United States are discussed in the article "Analysis of International Work-for-Hire Law," by Sutherland Asbill & Brennan LLP (2004) <http://www.sutherland.com/alertspubs/searchresults.aspx?keyword=international&publicationtype=&practice=&industry=&authors=&year=&fromsearchpage=alertspubs>

UNITED STATES – See Section 2.

URUGUAY

Copyright

The author is the owner of a copyrighted work. After the author's death, his or her heirs inherit the moral and economic rights.

The author can assign economic rights over the work to a third party.

An employer may own a copyrighted work made by an employee; however, moral rights are awarded to the employee.

In the case of works involving software or databases which are created by an employee during a work relationship - public or private - whose purpose has a similar nature to the creation, it is presumed that the author has assigned all moral and economic rights to the employer in an exclusive and unlimited way, unless otherwise stipulated.

-- from gettingthedealthrough.com (Copyright 2010, Uruguay, Ques. #22 & 23)

A hiring party may own a copyrighted work made by an independent contractor; however, the parties must expressly agree so in writing.

-- from gettingthedealthrough.com (Copyright 2010, Uruguay, Ques. #24)

The author has a moral right to:

- request that his name or pseudonym and the title of the work are included in all publications, interpretations, reproductions, and transmissions of the same;
- Control publications, interpretations and translations of the same and oppose any modifications in their title, text or integrity;
- Correct or modify the work, as long as: i) the nature and purpose of the same are not altered and ii) no acquirer of the work is damaged (eg, a novelist who has sold the economic rights over its work to a third party can make corrections to the same, for example in order to correct a spelling mistake or any other aspect, as long as the essence of the novel is not altered and the acquirer of the economic rights is not damaged).

These moral rights provisions are of public order and cannot be suppressed or limited by a contract.

The author has the right to withdraw his or her work if there are grave moral reasons, indemnifying any unfair damage to the acquirers of the economic rights or any other interested party.

-- from gettingthedealthrough.com (Copyright 2010, Uruguay, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

Any individual, corporate person, state entity or semi-public entity may apply for ownership of a trademark.

Assignment: What can be assigned?

Trademarks may be fully or partially assigned. The assignment may be made with or without goodwill. If the assignor maintains ownership of similar or identical trademarks, such ownership must be stated in the assignment contract. Concealment of trademarks entails the cancellation thereof.

Assignment documentation: What documents are required for assignment and what form must they take?

In order to assign a trademark, an assignment document must be executed, wherein both the assignor and assignee appear as parties. The assignment document must include the date and place of execution, name and position of the signatories, name and domicile of the assignor and assignee, the trademark to be assigned, the reference number of the trademark registration, and the class or classes covered by the registration.

In addition, the document must include the express acceptance of the assignment by the assignee, a sum of money paid for the assignment and an express statement by the assignor that the assignor does not own any registrations in Uruguay for trademarks similar or identical to the one being assigned. No certification of signatures or consular legalisation is required for this document.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

In order for it to be considered valid, the assignment must be recorded.

-- from gettingthedealthrough.com (Trademarks 2011, Uruguay, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=UY> >

VENEZUELA

Labour & Employment

The LOT [Ley Orgánica del Trabajo] states that those inventions created with employer's tools or resources are the property of the employer. Inventions made by the employee using his or her own talent without using the employer's tools or resources are the property of the employee.

An employee is entitled to compensation from the employer when the results and profits from the invention are disproportionate to the salary paid to the employees.

-- from gettingthedealthrough.com (Labour & Employment 2011, Venezuela, Ques. #28)

Patents

A patent must always name an individual person as the inventor as only individuals and not companies are capable of producing an invention. However, patents can be and generally are transferred to a company, which is done with a declaration of inventorship with assignment executed by the inventor in favour of the company.

Patents developed within a labour relationship fall under the ownership of the employer. If the inventor is an independent contractor he or she is the owner of the invention, unless the subject matter is related to the activities of the company - if so, the company has a right of priority on the invention (Venezuelan Labour Law).

There can be several inventors and owners on a patent.

Patents, applications or registrations may be assigned and such deeds should be recorded before the PTO in order to have validity against third parties; if not filed, such assignment will only be valid between the parties.

-- from gettingthedealthrough.com (Patents 2011, Venezuela, Ques. #15)

Copyright

Primarily, the author is the owner of the copyrighted work; but any person other than the author, whether a natural person or a legal entity, may own the economic rights to the work in accordance with the provisions of the legislation.

According to the Copyright Law, all economic rights of works made under labour relations are presumed to have been assigned to the employer by the employee, unless otherwise agreed by the parties. This assignment is presumed to be unlimited and for the duration of the right.

In addition, delivery of the work by the employee to the employer is presumed to imply authorisation to the employer to disclose the work made by the employee, to translate it, and to perform any changes to it that the employer considers necessary, as well as to use the title of the work and to defend the moral rights as necessary for the exploitation of the work.

-- from gettingthedealthrough.com (Copyright 2011, Venezuela, Ques. #22 & 23)

With respect to the works of independent contractors, the law establishes a presumption that any work made for hire belongs to the hiring party. In practice, when the registration of a copyright is applied for, the NDC requires a written declaration from the author of the work recognising that the work was made on behalf of the hiring party.

-- from gettingthedealthrough.com (Copyright 2011, Venezuela, Ques. #24)

Pursuant to Decision No. 351, the author shall have the inalienable, unattachable, imprescriptible and unrenounceable moral rights:

- to keep the work unpublished or to disclose it;
- to claim authorship of the work at any time; and

- to object to any distortion, mutilation or alteration of the work that is prejudicial to the integrity thereof or to the reputation of the author.

On an author's death, the exercise of moral rights shall pass to his or her successors in title for a 60-year period. Once the economic rights have lapsed, the state or designated agencies shall assume the defence of the authorship and integrity of the work.

The domestic legislation of the member countries may grant other rights of moral character.

-- from gettingthedealthrough.com (Copyright 2011, Venezuela, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

There are no restrictions as to who may file for a trademark application, including national or foreign individuals, corporations and entities in general. In addition, an application may be filed by co-applicants, including more than one individual or entity. For filing purposes, the following information on each applicant must be included:

- name and address;
- nationality or address and, should the applicant be a legal entity, the place of incorporation; and
- name and address of the applicant's legal representative whenever the applicant has an appointed representative, which is required when the applicant is a foreign individual or corporation.

Assignment: What can be assigned?

The Industrial Property Law establishes that all similar or identical trademarks with respect to that being assigned will also be deemed as included in the assignment unless otherwise established by the parties. Thus, it is recommended that an assignment document is clearly drafted to avoid problems in the future regarding its scope.

Other than the above, there are no major restrictions for the assignment of trademarks. Such assignments will have to be made in writing and submitted before the Trademark Office to have validity against third parties. However, the Trademark Office shall be entitled to deny the recordal of a trademark assignment that it deems will cause confusion, and this may happen in cases where coexistence of similar or identical trademarks in related classes is being sought via an assignment. If such is the case, the Trademark Office might allow for co-ownership of trademark registrations that are similar, but not coexistence in the names of different owners.

Assignment documentation: What documents are required for assignment and what form must they take?

To record an assignment there must be a written document executed by the parties. If any party executed the document abroad (outside Venezuela), such signature must be notarised and either legalised by apostille or by a Venezuelan consulate. If the document is drafted in any language other than Spanish, it will have to be translated by a sworn public translator in Venezuela.

There is no specific assignment form; however, the written document must:

- include the trademark;
- include the application or registration number;
- include a transfer amount;
- indicate the name and address of the parties involved, assignor and assignee; and
- be executed by authorised officers of the assignor and assignee before a notary public and certified by apostille or legalised before the Venezuelan Consulate.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

Assignments must be recorded to have validity against third parties, which is critical in cases where actions such as cancellations and nullities are taken against a given trademark registration. If the assignment is not recorded, it will only be valid inter partes and its effects will not extend to third parties.

-- from gettingthedealthrough.com (Trademarks 2011, Venezuela, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=VE> >

VIETNAM

Patent

Article 86 of the IP Law provides that:

The following organisations and individuals shall have the right to registration of an invention, industrial design and layout-design:

- a) The authors who have created the invention, industrial design or layout design by his or her own efforts and expenses; or
- b) The organisations or individuals who have invested funds and material facilities to the authors in the form of a job assignment or job hiring unless otherwise agreed by the parties and such agreements are not contrary to paragraph 2 of this Article.

If two or more organisations or individuals have jointly created or invested in the creation of an invention, industrial design or layout design, those organisations or individuals shall all have the right to registration and such right shall only be exercised with their consensus.

In line with the above provisions, the ownership of an invention made by a company employee or an independent contractor shall belong to the employer or the person who has invested funds and material facilities in creation of the invention. An invention is recognised as a 'service invention' only when the employee has taken working time or used the material resources of the employer in making such an invention.

If an invention has jointly been created by co-inventors, the ownership of the invention shall belong to all of them.

Patent ownership is recorded by the state by grant of patent. The ownership of a granted patent can be transferred by an assignment agreement in written form (article 138, IP Law).

-- from gettingthedealthrough.com (Patents 2011, Vietnam, Ques. #15)

Trademarks

Ownership of marks: Who may apply?

Any organisation or individual who uses or intends to use a mark in Vietnam for goods produced (trademark) or for services provided (services mark) (collectively referred to as trademarks) shall have the right to file a trademark application.

Any organisation or individual who legally engages in trade of the goods that are produced by a third party shall have the right to file an application for registration of the mark to be used for such goods provided that the producer neither uses such mark nor objects to such registration.

A collective organisation legally established shall have the right to file an application for registration of a collective mark to be used by its members in accordance with the rules on using collective marks.

An organisation with the function of controlling and certifying the quality, characteristics, origin or other relevant criteria of goods or services shall have the right to file an application for registration of a certification mark provided that such organisation is not engaged in the production or trade of such goods or services.

Please note that two or more organisations or individuals shall have the right to jointly file an application for registration of a trademark in order to become the co-owners thereof. Foreign applicants must be represented by a duly qualified and registered trademark agent.

Assignment: What can be assigned?

In Vietnam, a registered trademark can be assigned with or without goodwill as the current law is silent on goodwill regarding trademarks and trademark assignment. All or some of the goods and services for which a trademark is registered can be assigned, provided that such assignment does not cause any confusion as to the origin of goods and services. Other business assets are not required to be assigned to make the trademark assignment transaction valid.

Assignment documentation: What documents are required for assignment and what form must they take?

To assign a registered trademark, the trademark owner (the assignor) must enter an assignment agreement in writing with its assignee. The assignment agreement is only required to be signed by both assignor and assignee in all pages. Notarisation or legalisation is no longer required. There are no specific requirements that an assignment agreement must be in a particular form. However, as stipulated, it should include the following obligatory content:

- full name and address of the assignor and the assignee;
- legal basis for assignment, namely, details of the trademark registration certificates or trademark applications to be assigned;
- assignment fees; and
- rights and obligations of the assignor and the assignee.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

A trademark assignment agreement must be recorded with the Trademark Office for its validity and enforceability otherwise the assignment has no legal effect and thus has no enforceability in Vietnam.

-- from gettingthedealthrough.com (Trademarks 2011, Vietnam, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=VN> >

SECTION 2

UNITED STATES

UNITED STATES – GENERAL

Labour & Employment

Most states have laws or general common law principles allowing employers to require their employees, as a condition of employment, to assign all inventions to the employer except if the invention:

- is not developed by the employee using any of the employee's working time for the employer; and
- is not developed by use of any employer equipment, supplies, facilities or trade-secret information.

However, even if these two requirements are met, an employer can still require the employee to assign an invention to the employer if the invention:

- at the time of conception or reduction to practice by the employee, relates to the employer's business or to the employer's actual anticipated research or development; or
- results from any work performed by the employee for the employer.

-- from gettingthedealthrough.com (Labour & Employment 2011, United States, Ques. #28)

Patent

The presumptive owner of patentable subject matter is the inventor, in the case of sole invention, or the joint inventors (i.e., jointly), in the case of joint invention. With respect to patent rights that arise out of an employment relationship, the general rule is that the sole or joint inventors own the patent rights, in the absence of express contractual arrangements to the contrary. See, for example, Banner Metals, Inc. v. Lockwood, 178 Cal. App. 2d 643 (1960) (and cases cited therein)

< http://scholar.google.com/scholar_case?case=8799123713209636260&hl=en&as_sdt=2&as_vis=1&oi=scholar >.

However, an employer may own the patent rights if the employees were “**hired to invent**.” See, for example, Daniel Orifice Fitting Co. v. Whalen, 198 Cal. App. 2d 791, 797 (1962) (and cases cited therein)

< http://scholar.google.com/scholar_case?case=754692984538689694&q=Daniel+Orifice+Fitting+Co.+v.+Whalen,+198+Cal.+App.+2d+791+%281962%29&hl=en&as_sdt=2,34&as_vis=1 >.

Even if the employer does not own the patent rights, the employer may still have a non-exclusive and non-transferable royalty-free licence (“**shop right**”) to use the invention when the employee uses the time or facilities of his or her employer to conceive an invention or to reduce it to practice. See United States v. Dubilier Condenser Corp., 289 U.S. 178, 188 (1932)

< http://174.123.24.242/leagle/xmlResult.aspx?page=2&xmldoc=1933467289US178_1445.xml&docbase=CSLWA R1-1950-1985&SizeDisp=7 >.

Nevertheless, even with these general rules (also see flowchart on pages 115 and 116), most companies require their employees to sign an explicit agreement transferring patent ownership to the company.

A patent owner may assign or convey his or her patent rights; such an assignment must be in writing. The assignment should be recorded in the US Patent Office. An assignment is void against any subsequent purchaser or mortgagee for a valuable consideration who does not know of the prior transfer, unless the assignment is recorded within three months from its date or prior to the date of such subsequent purchase or mortgage.

In the case of joint owners of a patent, in the absence of any agreement to the contrary, each of the joint owners may make, use, offer to sell or sell the patented invention within the United States, import the patented invention into the United States or transfer his or her rights in or to the patent, without the consent of, and without accounting to, the other joint owner(s). [This is in contrast to the rule under U.S. Copyright law where each co-author can separately make or grant non-exclusive uses of the entire work as he or she pleases without seeking permission from the other author(s) or owners of the copyright, but there is a duty to account to other co-authors or owners of the copyright for any profits.]

-- from gettingthedealthrough.com (Patents 2011, United States, Ques. #15)

Copyright

The general rule is that the author of the work owns the copyright.

An employer can own a copyright when the work is a 'work made for hire'. If a work is made for hire, the employer, and not the employee or actual author, is considered the author and therefore the owner of the copyright. The employer may be a firm, an organisation or an individual. The Copyright Act defines a work made for hire as a work prepared by an employee within the scope of his or her employment.

Whether or not a particular work is 'within the scope of employment' is not always easily determined. In a 1989 US Supreme Court decision, Community for Creative Non-Violence v Reid, < <http://cyber.law.harvard.edu/people/tfisher/IP/1989%20CCNV.pdf> >, the court applied traditional common law employment principles to this question. As an alternative to the 'work made for hire' doctrine, an employer may own a copyrighted work as the result of an assignment from its employee.

-- from gettingthedealthrough.com (Copyright 2011, United States, Ques. #22 & 23)

With respect to independent contractors, Section 101 of the Copyright Act defines a work made for hire as a work specially ordered or commissioned (i.e., on an independent contractor basis) for use as:

- a contribution to a collective work;
- a part of a motion picture;
- a part of another audio-visual work;
- a translation;
- supplementary work;
- a compilation;
- an instructional text;
- a test;
- answer material for a test; or
- an atlas

if the parties expressly agree in a written document signed by them that the work will be considered a work made for hire.

-- from gettingthedealthrough.com (Copyright 2011, United States, Ques. #24)

Rights of integrity and attribution are expressly recognised in Section 106A of the US Copyright Act with respect to original or limited edition works of visual art either created after 1991 or not transferred by the author until after 1991. Beyond such works, existing case law and statutory law outside of the Copyright Act (for example, section 43(a) of the federal Trademark Act); privacy, publicity, and commercial rights laws; and misappropriation and defamation statutes) are recognised as according authors sufficient moral rights protection to satisfy the United States' obligations as a member of the Berne Convention.

-- from gettingthedealthrough.com (Copyright 2011, United States, Ques. #12)

Trademarks

Ownership of marks: Who may apply?

An application may be filed by any person (individual, corporation, partnership, or other legal entity) that believes he, she or it may use a mark in commerce. The owner of a mark is the person who controls the nature and quality of the goods identified or services rendered in connection with the mark. An applicant does not have to be a US citizen or reside in the United States. A trademark owner may request registration on the Principal Register or the Supplemental Register.

Assignment: What can be assigned?

A registered mark is assignable with the goodwill of the business in which the mark is used or with that part of the goodwill of the business connected with the use of, and symbolised by, the mark. No application to register a mark based on an intent to use is assignable prior to the filing of an amendment to allege use or the filing of a statement of

use, except to a successor to the applicant's business or portion of the business to which the mark pertains, if that business is ongoing and existing.

Trademark owners may also assign a separate portion of a business, together with the goodwill and trademarks associated with that portion of the business, but retain rights in the mark for uses pertaining to another part of the business.

Assignment documentation: What documents are required for assignment and what form must they take?

Written assignments and a USPTO recordal cover sheet detailing the relevant information must be filed.

Validity of assignment: Must the assignment be recorded for purposes of its validity?

The recording of an assignment document is not a determination of the validity of the document or the effect the assignment has on the title to an application or registration. However, it is highly recommended, as an assignment will be void against any subsequent purchaser for value, unless the assignment, relevant portions of the assignment, or a statement signed by the parties regarding the interest conveyed is recorded within three months of the date of the assignment or prior to a subsequent purchase.

-- from gettingthedealthrough.com (Trademarks 2011, United States, Ques #s 1, 12, 13, and 14)

Additional information can be found at:

AIPPI.ORG -- Working Committee (Q183) on Employers' Rights to Intellectual Property
< <https://www.aippi.org/download/committees/183/GR183usa.pdf> > (USA)

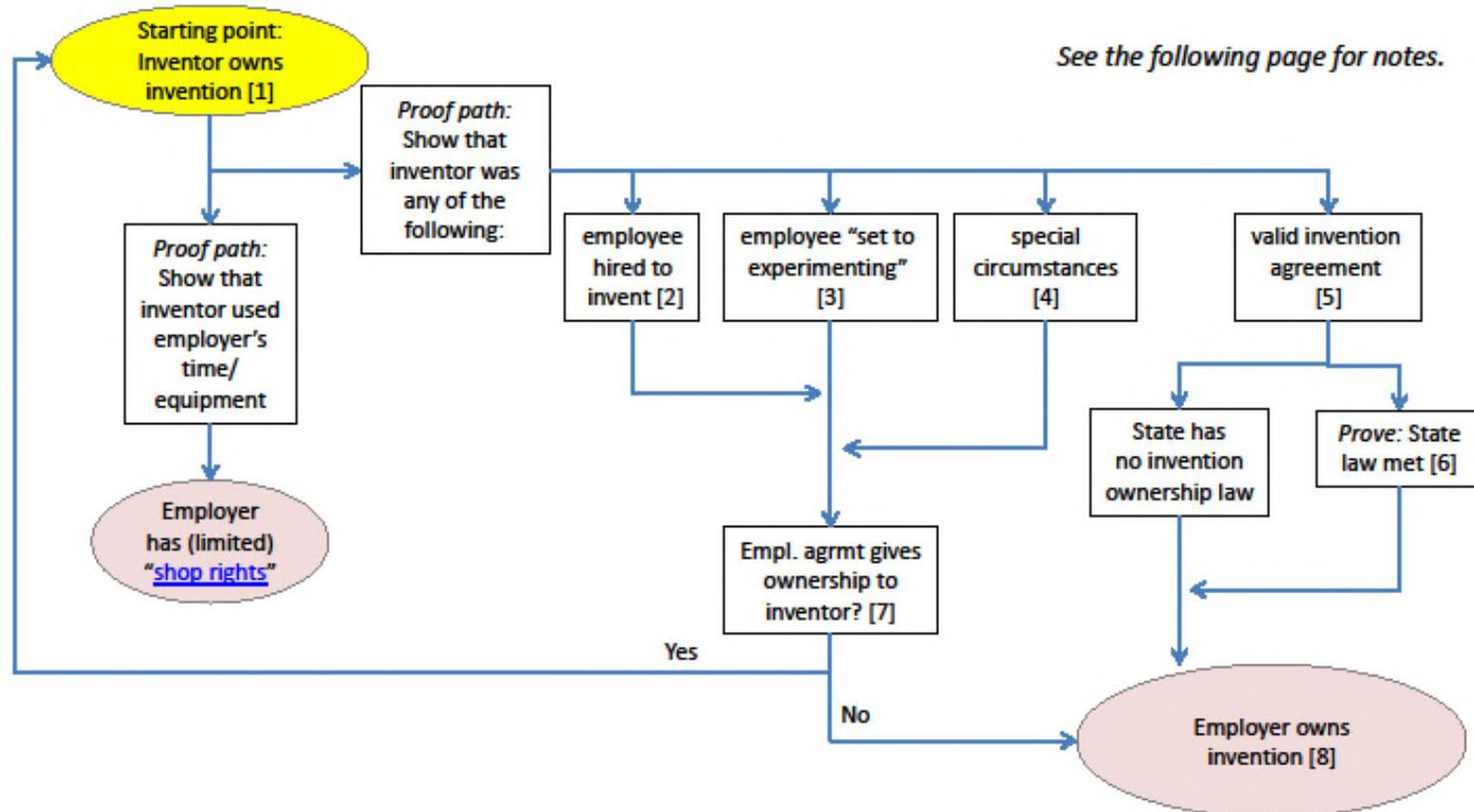
WIPO Lex -- < <http://www.wipo.int/wipolex/en/profile.jsp?code=US> >

The works-made-for-hire rules for employees and independent contractors in Australia, China, France, Germany, Japan, the United Kingdom, and the United States are discussed in the article "Analysis of International Work-for-Hire Law," by Sutherland Asbill & Brennan LLP (2004)

< <http://www.sutherland.com/alertspubs/searchresults.aspx?keyword=international&publicationtype=&practice=&industry=&authors=&year=&fromsearchpage=alertspubs> >

The following flowchart and notes explain the general rules that have developed in the United States regarding ownership of employee inventions. Many thanks to D.C. Toedt III, Attorney at Law, Houston, Texas < www.dctoedt.com >, for sharing this material.

Legal Issues Diagram: Who owns an employee's invention (in the U.S.)?



Legal Issues Diagram: Who owns an employee's invention (in the U.S.)?

NOTES

1. **Inventor owns invention:** This diagram assumes a single inventor; joint inventors are normally joint owners of the invention.
2. **"Hired to invent"** is often proved with a written description of job duties in an offer letter or employment agreement.
3. **"Set to experimenting"** — **example:** An engineer, who had no employment agreement, was assigned to head up a project to address a problem with turbine fan blades in jet engines. During the project, the engineer came up with an idea — at home — to solve the problem. He and other employees refined and tested the idea, and eventually the company filed a patent application. Later, the engineer sued for a declaration that he was the invention's rightful owner. The appeals court rejected his claim, saying that "[h]aving directed [the engineer] to that task, compensated him for his efforts, paid for the refinement of [his idea], and paid for the patent protection, [the company] owns the patent rights" under an implied-in-fact contract. *Teets v. Chromalloy Gas Turbine Corp.*, 83 F.3d 403, Nos. 95-1379, 95-1389 (Fed. Cir. May 7, 1996) (reversing lower-court declaratory judgment that engineer owned the patent rights).
4. **Special circumstances:** An inventor who is associated with a company as an officer, director, or principal shareholder, and whose invention relates to the company's business, might have an equitable duty to assign the patent rights for the invention to the company. See, e.g., *Kennedy v. Wright*, 676 F. Supp. 888, 893 (C.D. Ill. 1988) (collecting cases; patent infringement suit by former president of corporation against successor to corporation dismissed; successor owned equitable title to patents because of plaintiff's fiduciary duty to assign to corporation).
5. **Valid invention-assignment agreement:** Here, the term "valid" refers simply to the usual requirements to have a valid contract, for example, offer, acceptance, and consideration, plus any applicable requirement that the agreement be in writing under the statute of frauds.
6. **State law requirements met:** A number of states limit by statute the types of inventions that an employer can require an employee to assign. In some respects, California's employee invention-ownership statute includes perhaps the most detailed provisions. See: • *Cal. Lab. Code 2870-2871*; • *Del. Code Ann. 805*; • *765 Ill. Code 1060*; • *Minn. Stat. 181.78*; • *N.C. Gen. Stat. 66-57.1*; • *Wash. Rev. Code 49.44.140*.
7. **Employment agreement gives ownership to inventor:** Many companies' employment agreements include "carve-out" provisions by which an employee can retain ownership of his or her inventions not relating to the company's business.
8. **Employer owns the invention:** The employer, of course, may have a separate obligation to assign the invention rights to someone else, for example under a development contract.

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For **Note 6**: Add K.S.A. § 44-130 (Kansas) and Utah Code Ann. § 34-39-3.

UNITED STATES – ALASKA

[Community Property State (optional) – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

In Alaska, a husband and wife can opt-in by agreement to treat property as community property. Generally property is separate property unless both parties agree to make some or all of their property community property through a Community Property Agreement or a Community Property Trust. See Alaska Stat. § 34.77.090 < <http://codes.lp.findlaw.com/akstatutes/34/34.77./34.77.090>. > and Alaska Stat. § 34.77.100 < <http://codes.lp.findlaw.com/akstatutes/34/34.77./34.77.100>. >.

UNITED STATES – ARIZONA

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

UNITED STATES – CALIFORNIA

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

See Enovsys LLC v. Nextel Communications Inc., 614 F.3d 1333 (Fed Cir. 2010) < http://scholar.google.com/scholar_case?case=6021676456437418325&hl=en&as_sdt=2&as_vis=1&oi=scholarr > or < <http://www.cafc.uscourts.gov/images/stories/opinions-orders/09-1167.pdf> >

“No Overreaching” Provision:

Cal. Labor Code §§ 2870-2872
< <http://www.leginfo.ca.gov/cgi-bin/displaycode?section=lab&group=02001-03000&file=2870-2872> >

Note that § 2872 requires that an employment contract contain a written notice provision of the breadth of the employee invention assignment requirements.

Additional information can be found at:

[CAUTIONARY NOTE: COPYRIGHT LAW – WORK MADE FOR HIRE ISSUE] With respect to California, in addition to the protections by Cal. Labor Code §§ 2870-2872 [...], certain statutes provide other types of protections to creators of copyrightable works when they, as “independent contractors,” enter into work-made for hire agreements with those who commission their works. This scenario is quite common in entertainment fields, where business entities often reduce overhead costs by hiring independent contractors rather than employees.

California law provides that one who commissions a “work made for hire,” as defined in Section 101 of the Copyright Act, is *considered the employer* (emphasis added) of the creator of the work for purposes of workers’ compensation and unemployment insurance. See Cal. Labor Code § 3351.5 and Cal. Unemployment Insurance Code § 686 (2009). Whenever a creator works on a “work made for hire” basis, as defined by copyright law, that creator becomes an “employee” for purposes of California workers’ compensation and unemployment requirements.

Unless one obtains workers’ compensation insurance before entering into the “work made for hire” agreement with the creator, before any work is performed, and before any payments were made, there is *potential criminal as well as civil liability* for failure to maintain such insurance. California can issue penalties of up to \$100,000 against illegally uninsured employers. In addition, the creator may be entitled to make unemployment benefit claims despite the fact that both the hiring entity and the creator envisioned that the creator would be an “independent contractor.”

So if California companies (or non-California companies working with a creator in California) want to just hire “independent contractors” because they think it will be easier to draw up a WFH agreement that specifies that the hiring entity is entitled to all proceeds of the creator’s work, such hiring entities need to be aware of the potential consequences of that decision.

[NOTE: There have been no known published court decisions to date applying the above provisions, but they should be noted and taken into consideration when using independent contractors and drafting independent contractor agreements. The potential civil *and* criminal liability is large.]

See also < http://www.gladstonemichel.com/publications_20091203_workmadeforhire.shtml >

-- provided by Rachel Stillwell

Here is a recent case providing guidance on how to draft an enforceable IP ownership and assignment provision that complies with California law:

Applied Materials, Inc. v. Advanced Micro-Fabrication Equipment, Inc., No. 2007-5248 (N.D. Cal. May 20, 2009)
< http://www.ontechnologylaw.com/docs/AppliedMaterialsVsAdvancedMicroFabSJ_Cclms.pdf >

UNITED STATES – DELAWARE

“No Overreaching” Provision:

19 Del. C. § 805
< <http://codes.lp.findlaw.com/decode/19/8/805> >

Additional information can be found at:

For a case decided by the Delaware Court of Chancery discussing 19 Del. C. § 805 see Agilent Technologies v Kirkland (2010) (footnote 154)
< <http://www.delawarebusinesslitigation.com/uploads/file/Agilent%20v%20Kirkland.pdf> >.

UNITED STATES – IDAHO

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

UNITED STATES – ILLINOIS

“No Overreaching” Provision:

765 ILCS § 1060
< <http://www.ilga.gov/legislation/ilcs/ilcs3.asp?ActID=2238&ChapterID=62> >

Note that 765 ILCS § 1060/2(3) requires that an employment contract contain a written notice provision of the breadth of the employee invention assignment requirements.

UNITED STATES – KANSAS

“No Overreaching” Provision:

K.S.A. § 44-130

< [http://kansasstatutes.lesterama.org/Chapter 44/Article 1/44-130.html](http://kansasstatutes.lesterama.org/Chapter_44/Article_1/44-130.html) >

Note that § 44-130(c) requires that an employment contract contain a written notice provision of the breadth of the employee invention assignment requirements.

UNITED STATES – LOUISIANA

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

UNITED STATES – MASSACHUSETTS

Information can be found at:

For a case discussing invention assignment agreements in Massachusetts, see Freedom Wireless v. Boston Communications Group, 220 F. Supp. 2d 16 (D. Mass. 2002) (pre-invention assignment agreements should be construed narrowly, therefore company not entitled to patent for unrelated technology developed by former employee).

< http://scholar.google.com/scholar_case?case=11461496121968100878&q=Freedom+Wireless+v.+Boston+communications&hl=en&as_sdt=2,34&as_vis=1 >

UNITED STATES – MINNESOTA

“No Overreaching” Provision:

Minn. Stat. § 181.78

< <https://www.revisor.mn.gov/statutes/?id=181.78> >

Note that § 181.78(3) requires that an employment contract contain a written notice provision of the breadth of the employee invention assignment requirements.

UNITED STATES – NEVADA

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

UNITED STATES – NEW JERSEY

Information can be found at:

For a detailed discussion of the general approach taken in New Jersey regarding invention assignment agreements, see *Ingersoll Rand Co. v. Ciavatta*, 110 N.J. 609 (1988) (and cases cited therein), < http://scholar.google.com/scholar_case?case=10437095360587338363&q=INGERSOLL+RAND+CO.+v.+CIAVATTA&hl=en&as_sdt=2,34&as_vis=1 >.

UNITED STATES – NEW MEXICO

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

UNITED STATES – PUERTO RICO

[Community Property jurisdiction – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

Puerto Rico is included in this discussion because many U.S. and international pharmaceutical and biotech companies have operations and manufacturing facilities located there.

UNITED STATES – NORTH CAROLINA

“No Overreaching” Provision:

N.C. Gen. Stat. §§ 66-57.1 and 66-57.2

< <http://law.onecle.com/north-carolina/66-commerce-and-business/66-57.1.html> >

< <http://law.onecle.com/north-carolina/66-commerce-and-business/66-57.2.html> >

UNITED STATES – TEXAS

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

See *Alsenz v. Alsenz*, 101 S.W. 3d 648 (Tex. App. Feb. 27, 2003)

< http://scholar.google.com/scholar_case?case=4131978751462124842&q=%22community+property%22+patents&hl=en&as_sdt=2,44 > (the court said in dicta: “It is unquestionable that, had these patents been taken out during the marriage, the patents and the income they generated would be community property. In this, we would join other jurisdictions in which the courts treat the income from intellectual property created during marriage as marital or community property.”)

UNITED STATES – UTAH

“No Overreaching” Provision:

Utah Code Ann. § 34-39-3

< http://le.utah.gov/~code/TITLE34/htm/34_39_000300.htm >

Note that Utah Code Ann. § 34-39-2(2) < http://le.utah.gov/~code/TITLE34/htm/34_39_000200.htm > defines “intellectual property” to mean “any and all patents, trade secrets, know-how, technology, confidential information, ideas, copyrights, trademarks, and service marks and any and all rights, applications, and registrations relating to them.” This statute is much broader than the other U.S. state statutes cited that cover only inventions or patents.

UNITED STATES – WASHINGTON

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

“No Overreaching” Provision:

Wash. Rev. Code Ann. §§ 49.44.140 and 49.44.150

< <http://apps.leg.wa.gov/rcw/default.aspx?cite=49.44.140> >

< <http://apps.leg.wa.gov/rcw/default.aspx?cite=49.44.150> >

Note that § 49.44.140(3) requires that an employment contract contain a written notice provision of the breadth of the employee invention assignment requirements.

Additional information can be found at:

Washington law requires employers to notify employees in writing that they’re not required to assign their rights to inventions not related to/involving the employer (see RCW 49.44.140(1) and (3), and any invention assignment agreement will be void to the extent that it’s inconsistent with RCW 49.44.140(1). However, the required notification can be made via a provision in the employee’s agreement.

Waterjet Technology v. Flow International (Washington Supreme Court, April 6, 2000)

< <http://caselaw.findlaw.com/wa-supreme-court/1026650.html> >

Holding: Notice required by RCW 49.44.140(3) can be provided in the agreement. Even if notice were insufficient, the remedy would be limited to excision of the portions of the agreement inconsistent with RCW 49.44.140(1).

(This case overruled Machen, Inc. v. Aircraft Design, Inc., 65 Wash. App. 319, 828 P.2d 73 (1992).)

-- provided by Ann Parker-Way

UNITED STATES – WISCONSIN

[Community Property State – see SECTION 3, ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS]

SECTION 3

ASSIGNMENTS OF IP RIGHTS IN COMMUNITY PROPERTY JURISDICTIONS

The basic rule under U.S. intellectual property law, as stated elsewhere in this paper, is that, absent an agreement to the contrary, an inventor or an author is the owner of the intellectual property rights in the invention or work. However, in community property states (Arizona, California, Idaho, Louisiana, Nevada, New Mexico, Texas, Washington, and Wisconsin; also Puerto Rico and optionally in Alaska) an inventor's/author's spouse is the co-owner of an equal and undivided interest in any invention or copyright work (or any other property) that is developed or comes into the household during the marriage. This overlap of intellectual property law and state family law now may bring an inventor's/author's spouse into the IP ownership picture. Further, this is an area where the courts have consistently ruled that federal law does not preempt state law (or foreign law) where issues relating to ownership of intellectual property assets are involved. See, for example, Enovsys LLC v. Nextel Communications Inc., 614 F.3d 1333, 1342 (Fed Cir. 2010)

< http://scholar.google.com/scholar_case?case=6021676456437418325&hl=en&as_sdt=2&as_vis=1&oi=scholar > (under California law, all property acquired by a married person during marriage is presumed to be community property); Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572 (Fed. Cir. 1997)

< http://scholar.google.com/scholar_case?case=7128454962784875576&hl=en&as_sdt=2&as_vis=1&oi=scholar > (“the question of who owns the patent rights and on what terms typically is a question exclusively for state courts”); Akazawa v. Link New Tech., 520 F.3d 1354, 1357-58 (Fed. Cir. 2008)

< http://scholar.google.com/scholar_case?case=16498699243052000693&hl=en&as_sdt=2&as_vis=1&oi=scholar > (ownership of the patent to be determined under Japanese intestacy law); Int'l Nutrition Co. v. Horphag Research Ltd., 257 F.3d 1324, 1329-30 (Fed. Cir. 2001)

< http://scholar.google.com/scholar_case?case=13443493019679859510&hl=en&as_sdt=2,34&as_vis=1 > (a contractual agreement to apply French law as to ownership is just as valid as an agreement to apply the law of a particular state); Alsenz v. Alsenz, 101 S.W. 3d 648, 653 (Tex. App. Feb. 27, 2003)

< http://scholar.google.com/scholar_case?case=4131978751462124842&q=%22community+property%22+patents&hl=en&as_sdt=2,44 > (the court said in dicta: “It is unquestionable that, had these patents been taken out during the marriage, the patents and the income they generated would be community property. In this, we would join other jurisdictions in which the courts treat the income from intellectual property created during marriage as marital or community property.”); and Rodrigue v. Rodrigue, 218 F.3d 432 (5th Cir. 2000) (while the five specific rights listed in § 106 [of the Copyright Act] “vest initially” in the author, it does not ineluctably conflict with any provision of Louisiana matrimonial property law that would recognize that the non-author spouse has an economic interest in the spouse-author's copyrights)

< http://scholar.google.com/scholar_case?case=9122319894068371434&q=rodrigue+218+f.3d+432&hl=en&as_sdt=2,34 >.

The application of state or foreign law over patent or copyright laws, arguably, would also apply to the “hired to invent” and “work made for hire” doctrines, both of which are part of the intellectual property law landscape. Note that the “hired to invent” and “set to inventing” doctrines discussed earlier on pages 115 and 116 are more properly categorized as state common law doctrines (not federal law) that give rise to an *implied-in-fact contract* to assign the rights to the IP to the employer. Similarly, the “special circumstances” doctrine arises from a fiduciary duty to act in good faith and in the best interests of the company that obligates an officer or director to assign the IP to the company. Consequently, there may even be competing state public policy questions that come into play in resolving IP ownership questions. That is, which policy has greater importance, protecting marital property rights or promoting certainty in connection with IP ownership rights. Historically, there may have been a presumption that protection of marital property was paramount, but over the past five decades or so intellectual property has become much more important in today's society and world economies. Consequently, how a court might rule on this issue may not be so cut-and-dry.

There is, however, a strong case to be made that ownership of inventions/works covered under the work made for hire or any of the implied-in-fact contract doctrines vest in the employer *upon creation*, so there is no ownership or property interest in the inventor/author that would “come into the marriage” under community property principles. In any event, as previously mentioned, irrespective of the intellectual property rules relating to ownership, many employers still require employees to sign two agreements: the first at the time of employment typically specifying the circumstances under which the employer owns intellectual property developed by the employee and creating the employee's obligations to assign such developments to the employer; and, second, an explicit agreement, typically

an assignment, transferring ownership of the IP asset(s) to the employer. These assignment documents are not only part of a “belt-and-suspenders” approach, but also typically transfer more than just the basic right to ownership of the patent or copyright and transfer additional IP-related rights (e.g., improvements, know-how, commercialization, related confidential information, unpatented or unpatentable ideas, and so forth) to the employer that would not ordinarily be transferred under “hired to invent” or “work made for hire” principles. In that case, absent an express agreement, perhaps those “extras” would be part of the community property estate.

As a result, where an inventor/author is married at the time the invention/work is created, employers might be well-advised to have the inventor’s/author’s spouse also sign as a party to the two documents, or, at a minimum, to the formal license agreement itself (or license or other transferring document). It also may be prudent where an inventor/author is now divorced, but was married at the time the intellectual property asset was created, for the employer to review the final divorce decree or property settlement agreement to ensure the non-employee spouse no longer has an ownership interest in the invention/work. Note that even most common law jurisdictions follow equitable distribution principles for property distribution in divorce and separation proceedings, so it may be prudent, even in common law jurisdictions in post-divorce situations, for an employer to check and confirm ownership of the intellectual property assets being assigned, transferred, or licensed. Think of all those “celebrity” divorce and estate disputes by ex-spouses, ex-children, ex-girlfriends and boyfriends, and ex-dogs over intellectual property rights and residuals.

While much of the above discussion addresses this issue in the employer-employee context, it is equally applicable in merger and acquisition (M&A) or IPO transactions. Now as part of the due diligence investigation, perhaps the acquiring or offering company should consider adding a review of the current and past marital status of inventors/authors and the ownership status of the IP assets being transferred.

Is this important? You betcha!!! Aside from the issue of an employer not having sole or complete ownership of the IP asset which can have a significant effect on valuation or marketability, recall that a co-owner of a patent can sell or transfer or license his or her rights in the patent to anyone, without the consent of, and without accounting to, the other joint owner(s) (35 USC § 262). That sale, transfer, or license could easily be *to one or more of your competitors*. Equally unfortunate would be to have an ex-spouse show up the day before the closing of an acquisition or an IPO and claim ownership of a portion of the IP portfolio. The rules relating to co-authors of a copyright work are similar except that one co-author must account to the other co-author(s) for any profits. See Harrington v. Mure, 186 F.Supp. 655 (S.D.N.Y. 1960)

< http://scholar.google.com/scholar_case?case=14212833224382082905&hl=en&as_sdt=2,34&as_vis=1 > (the duty to account is an equitable doctrine relating to unjust enrichment and general principles of law governing the rights of co-owners).

Transfers of copyright works can be further complicated by exercise of the right termination applicable to copyright transfers under 17 USC § 203 < <http://www.copyright.gov/title17/92chap2.html#203> > (applicable to works created since 1978) or 17 USC § 304(c) and (d) (applicable to works created before 1978)

< <http://www.copyright.gov/title17/92chap3.html#304> >, that allows a copyright owner to terminate a transfer after thirty-five or forty years. An open question arises as to whether a non-author spouse can exercise the termination right. For additional information regarding the termination right see Penguin Group (USA) Inc. v. Steinbeck, 537 F.3d 193 (2d Cir. 2008), cert. denied, 128 S. Ct. 2383 (2009)

< http://scholar.google.com/scholar_case?case=574379354936187072&q=Penguin+Group+%28USA%29+Inc.+v.+Steinbeck,+537+F.3d+193+&hl=en&as_sdt=2,34 >; Classic Media v. Mewborn, 532 F.3d 978 (9th Cir. 2008)

< http://scholar.google.com/scholar_case?case=8354981079663697319&q=Classic+Media+v.+Mewborn,+532+F.3d+978+&hl=en&as_sdt=2,34 >; Siegel v. Warner Bros. Entertainment Inc., 542 F.Supp.2d 1098 (C.D. Cal. 2008)

< http://scholar.google.com/scholar_case?case=536649376071857250&q=Siegel+v.+Warner+Bros.+Entertainment+Inc.,+542+F.Supp.2d+1098+&hl=en&as_sdt=2,34 >; Milne v. Stephen Slesinger, Inc., 430 F.3d 1036 (9th Cir 2005), cert. denied, 548 U.S. 904 (2006)

< http://scholar.google.com/scholar_case?case=6949751764053487398&q=Milne+v.+Stephen+Slesinger,+Inc.,+430+F.3d+1036+&hl=en&as_sdt=2,34 >; and Peter S. Menell & David Nimmer, “Pooh-Poohing Copyright Law’s ‘Inalienable’ Termination Rights,” Journal, Copyright Society of the U.S.A., December 2010, pages 101-160 < <http://abaiplspring.org/coursematerials2011/docs/Pooh-Poohing%20Copyright%20Law.pdf> >.

Let’s add one final complicating factor to this discussion. Employers likely also need to consider the mobility of today’s workforce, both domestically and internationally. Recall that in a community property jurisdiction

ownership vests when the asset is *created* or comes into the marriage. That community property co-ownership attribute generally remains attached to and travels with that property even when the co-owners later move to a common law property jurisdiction, unless the couple affirmatively divest themselves of the community property attribute. In fact, this analysis of the ownership attribute of assets is commonplace in the estate planning and tax planning areas. For example, note that the Akazawa case cited above determined that interpretation of Japanese intestacy law was necessary to resolve the patent ownership issue. For a more detailed discussion regarding U.S. treatment of property acquired in a common law jurisdiction that is later moved to a community property jurisdiction, and vice versa, see “Property Division at Divorce or Death for Married Couples Migrating Between Common Law and Community Property States,” by Kenneth Kingma < http://www.worldservicesgroup.com/pdf/ACTEC_Kingma.pdf >.

Now, in addition to getting to know our employment law colleagues (as mentioned in the Introduction), intellectual property attorneys should get to know our family law, estate planning, or tax planning colleagues too. Ah yes, the world of multi-disciplinary, multi-national law is so much fun.

In conclusion, there are a number of possible outcomes with respect to the ownership of the intellectual property, and these determinations can differ even among the various community property and common law jurisdictions. It is also important to note that there are no two community property states with exactly the same laws on the subject. The statutes or judicial decisions in one state may differ completely from those of another state on any particular legal issue. The possible IP ownership outcomes are:

- The IP is separate property and transferrable by the inventor/author without participation of the spouse.
- The IP is community property that is under or subject to the “management and control” of the inventor/author and, therefore, transferable by the inventor/author without participation of the spouse. See, for example, Texas Family Code § 3.102 and California Family Code §§ 1100-1103.
- The IP is community property and requires the spouse to participate in the transfer.
- The IP vests in the employer upon creation either because (i) the IP has been “pre-assigned” to the employer because a valid “future assignment” is in place, or (ii) the IP is the employer’s property by operation of an implied-in-fact contract or “work made for hire” doctrine. (NOTE: “future assignments” of copyright not effective in Canada. See Century 21 Canada Ltd. Partnership v. Roger Communications Inc., 2011 BCSC 1196)

In any event, this raises important IP ownership issues which employers, buyers, and inventors/authors should review carefully as part of the initial employment process, as part of due diligence process, or anytime intellectual property assets are being sold or transferred.

For a comprehensive collection of cases from the federal courts and from both common law and community property jurisdictions (26 states listed) that have recognized in various contexts, either directly or indirectly, the ownership or economic interests in intellectual property (both patents and copyrights) as part of marital property, see footnote 178 in J. Wesley Cochran, “It Takes Two to Tango!: Problems with Community Property Ownership of Copyrights and Patents in Texas,” 58 Baylor Law Review 407-466 (2006) < <http://www.baylor.edu/content/services/document.php/116861.pdf> >. Footnote 178 is reproduced and reformatted on pages 82 through 88, with a hyperlink to the text of the case where “reasonably and freely” available (defined as found with a two to five minute internet search).

Global Perspective

Presumably, each of these same issues applies in other countries where community property or other marital property principles have been adopted. The common law countries of Australia, Canada, Ireland, New Zealand, and the United Kingdom generally provide for separate property ownership. For the remaining countries (and likely the majority view), including China, South Africa, Taiwan, most of the countries of continental Europe, and virtually all the countries of Latin America, spouses own property “as community property.” Some countries allow couples to expressly adopt another marital property regime by way of a notarial instrument entered into prior to the marriage.

A partial listing of the types of marital property regimes followed in other countries follows.

Marital Property Regimes

Country	Common Law or Community Property¹ Regime
Argentina	Community Property (A)
Australia	Common Law
Belgium	Community Property
Brazil	Community Property (A)
Canada	Common Law
Chile	Community Property
China	Community Property
Columbia	Community Property (A)
Costa Rica	Community Property (B)
Denmark	Community Property
Dominican Republic	Community Property
France	Community Property (A)
Germany	Community Property
Guatemala	Community Property
Ireland	Common Law
Italy	Community Property
Mexico	Community Property
Montenegro	Community Property
Netherlands	Community Property
New Zealand	Common Law
Philippines	Community Property
Portugal	Community Property
Russia	Community Property
South Africa	Community Property
Spain	Community Property
Sweden	Community Property
Switzerland	Community Property
Taiwan	Community Property
Ukraine	Community Property
United Kingdom	Common Law
Venezuela	Community Property (A)

¹ International community property regimes can further fall into three separate classes:

- (A) Community ownership of property acquired after [during] the marriage.
- (B) Community property is determined at the time of death of one spouse or upon dissolution of the marriage.
- (C) Universal community property applies to all assets of the couple, including those brought into the marriage and those acquired after [during] the marriage.

**Cases Listed at Footnote 178 of
“It Takes Two to Tango!: Problems with Community Property Ownership
of Copyrights and Patents in Texas”**

(Used and modified with permission of Baylor Law Review and Professor J. Wesley Cochran, Texas Tech University School of Law.)

Federal

Stein v. Soyer, No. 97 Civ. 1317(MBM), 1997 WL 104967 (S.D.N.Y. Mar. 10, 1997) (remanding to state court for want of federal question involving ownership of patents, trademarks, and copyrights). [Also found at 43 U.S.P.Q. 2d 1479.]

Doty v. Comm’r, 81 T.C. 652 (1983), *action on dec.*, 1985-016 (Sept. 17, 1985) (classifying future royalties for Peanuts cartoon characters as community property).

Dixon v. Comm’r, 44 T.C. 709 (1965) (recognizing future royalties for songs as marital property)

http://scholar.google.com/scholar_case?case=1394878638086938571&q=Dixon+v.+Comm%E2%80%98r,+44+T.C.+709+&hl=en&as_sdt=2,34 >.

Alabama

Rose v. Rose, 395 So. 2d 1038 (Ala. Civ. App. 1981) (awarding a portion of the royalties to the non-creating-spouse)

http://scholar.google.com/scholar_case?case=7097798503201784269&q=Rose+v.+Rose,+395+So.+2d+1038+&hl=en&as_sdt=2,34 >.

California

Roddenberry v. Roddenberry, 51 Cal. Rptr. 2d 907 (Ct. App. 1996) (awarding the former wife profits from copyright-protected works created during marriage)

http://scholar.google.com/scholar_case?case=6500858062962247824&q=Roddenberry+v.+Roddenberry,+51+Cal.+Rptr.+2d+907+&hl=en&as_sdt=2,34 >. [Also found at 44 Cal. App. 4th 634.]

In re Marriage of Worth, 241 Cal. Rptr. 135 (Ct. App. 1987) (holding that copyrights in books written during marriage classified as community property)

http://scholar.google.com/scholar_case?case=14197726827706029480&q=worth+241+cal+rptr+135+%281987%29&hl=en&as_sdt=2,34 >. [Also found at 195 Cal. App. 3d 768.]

Meacham v. Meacham, 68 Cal. Rptr. 746 (Ct. App. 1968) (classifying royalties for inventions as community property)

http://scholar.google.com/scholar_case?case=6705171076626660563&q=Meacham+v.+Meacham,+68+Cal.+Rptr.+746+&hl=en&as_sdt=2,34 >. [Also found at 262 Cal. App. 2d 248.]

Campbell v. Campbell, 321 P.2d 133 (Cal. Dist. Ct. App. 1958) (barring a claim based on res judicata and, therefore, awarding book royalties to the non-creating-spouse)

http://scholar.google.com/scholar_case?case=5533059372102381503&q=Campbell+v.+Campbell,+321+P.2d+133&hl=en&as_sdt=2,34 >. [Also found at 157 Cal. App. 2d 548.]

Fieger v. Fieger, 83 P.2d 526 (Cal. Dist. Ct. App. 1938) (classifying a patent as community property)

http://scholar.google.com/scholar_case?case=9539918236495270480&q=Fieger+v.+Fieger,+83+P.2d+526+&hl=en&as_sdt=2,34 >. [Also found at 28 Cal.App.2d 736.]

Lorraine v. Lorraine, 48 P.2d 48 (Cal. Dist. Ct. App. 1935) (classifying a patent as community property)

http://scholar.google.com/scholar_case?case=8613653654020992267&q=Lorraine+v.+Lorraine,+48+P.2d+48+&hl=en&as_sdt=2,34 >. [Also found at 8 Cal. App. 2d 687.]

In re Marriage of Weres, No. 76505, 2000 WL 34472234 (Cal. App. Dep't Super. Ct. Jan. 18, 2000), *modified by*, 2000 WL 34479333 (dividing patents perfected during marriage and the interest in patent application between the spouses). [Subsequent history upheld result at *Weres v. Weres*, 04-1233 (Fed. Cir. January 11, 2005) < <http://docs.justia.com/cases/federal/appellate-courts/cafc/04-1233/04-1233-2011-03-27.pdf?1301282027> > or < <http://www.ll.georgetown.edu/federal/judicial/fed/opinions/04opinions/04-1233.pdf> >.

Connecticut

Gallo v. Gallo, 440 A.2d 782 (Conn. 1981) (considering future book royalties when dividing assets) < http://scholar.google.com/scholar_case?case=4162835091254218037&q=Gallo+v.+Gallo,+440+A.2d+782+&hl=en&as_sdt=2,34 >. [Also found at 184 Conn. 36.]

Regney v. Regney, No. FA 970326995S, 2000 WL 38738 (Conn. Super. Ct. Jan. 5, 2000) (mem.) (including song royalties as income to set child support).

Zander v. Zander, No. FA 970074587S, 1999 WL 711503 (Conn. Super. Ct. Aug. 30, 1999) (mem.) (denying the husband an interest in wife's musical recordings due to his conduct).

Powers v. Powers, No. CV 9353723S, 1996 WL 88464 (Conn. Super. Ct. Apr. 16, 1996) (mem.) (including book royalties as income to set child support).

Rath v. Rath, No. FA88 0252053S, 1990 WL 274511 (Conn. Super. Ct. Mar. 22, 1990) (mem.), *motion for articulation*, 1990 WL 271125 (May 8, 1990) (mem.), *second motion for articulation*, 1990 WL 264113 (Oct. 22, 1990) (mem.) (including book royalties as income to set child support).

Delaware

E.V.P. v. L.A.P., No. CN98-11448, 2001 WL 1857137 (Del. Fam. Ct. Dec. 4, 2001) (awarding an interest in molds and sculptures as marital property).

Hawaii

Teller v. Teller, 53 P.3d 240 (Haw. 2002) (awarding an interest in patents and trade secrets as marital property) < http://scholar.google.com/scholar_case?case=13733014373225938087&q=Teller+v.+Teller,+53+P.3d+240&hl=en&as_sdt=2,34&as_vis=1 >. [Also found at 99 Haw. 101.]

Idaho

DeMarco v. Stewart, 691 P.2d 801 (Idaho Ct. App. 1984) (allowing royalties from an invention pursuant to the divorce settlement) < http://scholar.google.com/scholar_case?case=8627092914509767500&q=DeMarco+v.+Stewart,+691+P.2d+801+&hl=en&as_sdt=2,34 >. [Also found at 107 Idaho 555.]

Illinois

In re Marriage of Heinze, 631 N.E.2d 728 (Ill. App. Ct. 1994) (holding that future book royalties were marital property) < http://scholar.google.com/scholar_case?case=5740707312622926426&q=In+re+Marriage+of+Heinze,+631+N.E.2d+728+&hl=en&as_sdt=2,34 >. [Also found at 257 Ill. App. 3d 782, 197 Ill. Dec. 506.]

In re Marriage of Aud, 491 N.E.2d 894 (Ill. App. Ct. 1986) (holding that the inventions are not worth more than nill; therefore, there is nothing to divide)
< http://scholar.google.com/scholar_case?case=10124543079800840702&q=In+re+Marriage+of+Aud&hl=en&as_sdt=2,34 >. [Also found at 142 Ill. App. 3d 320.]

Iowa

In re Marriage of White, 537 N.W.2d 744 (Iowa 1995) (awarding an interest in future book royalties to the non-creating-spouse)
< http://scholar.google.com/scholar_case?case=14730433275565242919&q=In+re+Marriage+of+White,+537+N.W.+2d+744+&hl=en&as_sdt=2,34 >.

Kansas

In re Marriage of Monslow, 912 P.2d 735 (Kan. 1996) (awarding future royalties for patents). [Also found at 259 Kan. 412.]

Krueger v. Krueger, 255 P.2d 621 (Kan. 1953) (awarding partnership interest in an invention created during marriage)
< http://scholar.google.com/scholar_case?case=11503836951011520496&q=Krueger+v.+Krueger,+255+P.2d+621+%28&hl=en&as_sdt=2,34 >. [Also found at 174 Kan. 249.]

Louisiana

Smith v. Doody, 721 So. 2d 60 (La. Ct. App. 1998) (affirming summary judgment in an attorney malpractice action concerning a community property interest in song royalties)
< http://scholar.google.com/scholar_case?case=13172877957021828951&q=Smith+v.+Doody,+721+So.+2d+60+&hl=en&as_sdt=2,34 >.

Michel v. Michel, 484 So. 2d 829 (La. Ct. App. 1986)
< http://scholar.google.com/scholar_case?case=8822182136631786551&q=484+So.2d+829+%281986%29&hl=en&as_sdt=2,34 >, *superceded by statute*, LA. REV. STAT. ANN. § 9:374 (2005)
< http://www.legis.state.la.us/lss_doc/lss_house/RS%5C9%5CDoc107793.html >, as recognized in Herrell v. Herrell, 594 So. 2d 943 (La. Ct. App. 1992) (awarding a marital interest in future book royalties for partially complete manuscripts)
< http://scholar.google.com/scholar_case?case=13207311671095541829&q=Herrell+v.+Herrell,+594+So.+2d+943+&hl=en&as_sdt=2,34 >.

Howes v. Howes, 436 So. 2d 689 (La. Ct. App. 1983) (allowing an award to the non-creating spouse of a patent classified as community property because creating-spouse committed fraud on community)
< http://scholar.google.com/scholar_case?case=12661800264059137074&q=Howes+v.+Howes,+436+So.+2d+689+&hl=en&as_sdt=2,34 >, *aff'd*, 518 So. 2d 1147 (1988) (holding that further litigation of the issue of whether the patent was community property was barred by res judicata)
< http://scholar.google.com/scholar_case?case=16235441345134484509&q=518+So.+2d+1147+&hl=en&as_sdt=2,34 >, *appeal denied*, 637 So. 1282 (La. Ct. App. 1994) (requiring the non-creating spouse to pay one-half share of attorneys' to preserve and maintain patent)
< http://scholar.google.com/scholar_case?case=16894488249640414705&q=637+So.+1282+&hl=en&as_sdt=2,34 >.

Massachusetts

Yannas v. Frondistou-Yannas, 481 N.E.2d 1153 (Mass. 1985) (denying an award of an interest in future royalties for artificial skin because it was too speculative)

< http://scholar.google.com/scholar_case?case=10952259659017938858&q=Yannas+v.+Frondistou-Yannas,+481+N.E.2d+1153+&hl=en&as_sdt=2,34 >. [Also found at 395 Mass. 704.]

Michigan

McDougal v. McDougal, 545 N.W.2d 357 (Mich. 1996) (per curium) (finding division of future interest in patents and royalties was inequitable)

< http://scholar.google.com/scholar_case?case=16476697320547878969&q=McDougal+v.+McDougal,+545+N.W.2d+357+&hl=en&as_sdt=2,34 >. [Also found at 451 Mich. 80.]

Wiand v. Wiand, 443 N.W.2d 464 (Mich. Ct. App. 1989) (per curium) (awarding future income from patents and formulas)

< http://scholar.google.com/scholar_case?case=10238163995357203929&q=Wiand+v.+Wiand,+443+N.W.2d+464+&hl=en&as_sdt=2,34 >. [Also found at 178 Mich. App. 137.]

Minnesota

Frey v. Frey, No. C9-99-270, 1999 WL 970328 (Minn. Ct. App. Oct. 26, 1999) (establishing a payment schedule of patent royalties).

Sturm v. Sturm, No. C5--91-1902, 1992 WL 95871 (Minn. Ct. App. May 12, 1992) (remanding to clarify patent interest as the income related to marital property).

Mississippi

Pratt v. Pratt, 623 So. 2d 258 (Miss. 1993) (denying alimony based on potential royalties)

< http://scholar.google.com/scholar_case?case=16902176381810956096&q=Pratt+v.+Pratt,+623+So.+2d+258+&hl=en&as_sdt=2,34 >.

Missouri

In re Marriage of Perkel, 963 S.W.2d 445 (Mo. Ct. App. 1998) (classifying computer software written during marriage as marital property)

< http://scholar.google.com/scholar_case?case=3067039273506743547&q=In-re+Marriage+of+Perkel,+963+S.W.2d+445+&hl=en&as_sdt=2,34 >.

Runyan v. Runyan, 907 S.W.2d 267 (Mo. Ct. App. 1995) (including book royalties in income to set child support but not maintenance)

< http://scholar.google.com/scholar_case?case=11676980693399630760&q=Runyan+v.+Runyan,+907+S.W.2d+&hl=en&as_sdt=2,34 >.

Nevada

Cathcart v. Robison, Lyle, Belaustegui, & Robb, P.C., 795 P.2d 986 (Nev. 1990) (curium) (holding that award of attorneys' fees in divorce where non-creating-spouse was awarded one-share of patent royalties was reasonable)

< http://scholar.google.com/scholar_case?case=8200734005878032394&q=795+P.2d+986+&hl=en&as_sdt=2,34 >.

New Mexico

Mracek v. Dunifon, 233 P.2d 792 (N.M. 1951) (classifying a patent as community property)

http://scholar.google.com/scholar_case?case=18156308669496005445&q=Mracek+v.+Dunifon,+233+P.2d+792+&hl=en&as_sdt=2,34 >. [Also found at 55 N.M. 342.]

Boutz v. Donaldson, 1999-NMCA-131, ¶ 20-3, 128 N.M. 232, 991 P.2d 517 (including book royalties in income to set child support)

http://scholar.google.com/scholar_case?case=13101293011804220986&q=,+991+P.2d+517+&hl=en&as_sdt=2,34 >.

New York

McGovern v. Getz, 598 N.Y.S.2d 9 (App. Div. 1993) (mem.) (distributing equally the royalties for musical works created during marriage)

http://scholar.google.com/scholar_case?case=9755713756447751209&q=McGovern+v.+Getz,+598+N.Y.S.2d+9+&hl=en&as_sdt=2,34 >. [Also found at 193 A.D.2d 655.]

Daye v. Daye, 566 N.Y.S.2d 132 (App. Div. 1991) (mem.) (allowing a maintenance award indefinitely to the wife for the husband's failure to realize profit from his invention)

http://scholar.google.com/scholar_case?case=9551850575328071206&q=Daye+v.+Daye,+566+N.Y.S.2d+132+&hl=en&as_sdt=2,34 >. [Also found at 170 A.D.2d 963.]

Ohio

Lewis v. Lewis, No. CA91-12-218, 1992 WL 193680 (Ohio Ct. App. Aug. 10, 1992) (allowing an equitable division to include royalties from songs).

Summers-Horton v. Horton, No. 88AP-622, 1989 WL 29421 (Ohio Ct. App. Mar. 30, 1989) (denying an award of future book royalties as too speculative).

Phillips v. Phillips, No. 44339, 1982 WL 2543 (Ohio Ct. App. Nov. 18, 1982) (requiring consideration of future book royalties as part of the division of marital property).

Oklahoma

Allen v. Allen, 601 P.2d 760 (Okla. Civ. App. 1979) (awarding an interest in patents to the non-creating-spouse)

http://scholar.google.com/scholar_case?case=1210049752181830338&q=Allen+v.+Allen,+601+P.2d+760+&hl=en&as_sdt=2,34 >.

South Carolina

Woodward v. Woodward, 363 S.E.2d 413 (S.C. Ct. App. 1987) (denying the non-creating-spouse an interest in a worthless patent that might become valuable so as not to contradict the policy of finality)

http://scholar.google.com/scholar_case?case=5664885362725553310&q=Woodward+v.+Woodward,+363+S.E.2d+413+&hl=en&as_sdt=2,34 >. [Also found at 294 S.C. 210.]

Tennessee

Morey v. Morey, No. 01-A-01-9506-CV00243, 1995 WL 739565 (Tenn. Ct. App. Dec. 15, 1995) (transferring a copyright classified as marital property to the non-creating spouse).

Hazard v. Hazard, 833 S.W.2d 911 (Tenn. Ct. App. 1992) (awarding an interest in the sale of a medical invention as part of the division of marital property)

http://scholar.google.com/scholar_case?case=10859585716474210429&q=Hazard+v.+Hazard,+833+S.W.2d+911+&hl=en&as_sdt=2,34 >.

Texas

Sheshtawy v. Sheshtawy, 150 S.W.3d 772 (Tex. App.—San Antonio 2004, pet. denied), *cert. denied*, 126 S. Ct. 359 (2005) (supporting in dicta that a patent is community property, though denying a sixty percent interest in the patent to the non-creating-spouse)

http://scholar.google.com/scholar_case?case=4541732239464486350&q=Sheshtawy+v.+Sheshtawy,+150+S.W.3d+772+&hl=en&as_sdt=2,34 >.

Alsenz v. Alsenz, 101 S.W.3d 648 (Tex. App.—Houston [1st Dist.] 2003, pet. denied) (holding that income from patent royalties is community property and supporting in dicta that a patent is community property)

http://scholar.google.com/scholar_case?case=4131978751462124842&q=%22community+property%22+patents&hl=en&as_sdt=2,44 >.

Miner v. Miner, No. 13-01-659-CV, 2002 Tex. App. LEXIS 5841 (Tex. App.—Corpus Christi, Aug. 8, 2002, no pet.) (not designated for publication) (awarding profits from sales of computer programs and future derivative programs to the non-creating-spouse).

Bell v. Moores, 832 S.W.2d 749 (Tex. App.—Houston [14th Dist.] 1992, writ denied) (dismissing an action brought by former wives for payment of royalties owed former husbands and therefore not deciding the community property question)

http://scholar.google.com/scholar_case?case=3301288803290719839&q=Bell+v.+Moores,+832+S.W.2d+749+&hl=en&as_sdt=2,34 >.

Kennard v. McCray, 648 S.W.2d 743 (Tex. App.— Tyler 1983, writ ref'd n.r.e.) (awarding an interest in royalties for invention)

http://scholar.google.com/scholar_case?case=860071666666470486&q=Kennard+v.+McCray,+648+S.W.2d+743+&hl=en&as_sdt=2,34 >.

Rose v. Hatten, 417 S.W.2d 456 (Tex. Civ. App.—Houston 1967, no writ) (classifying a patent as community property, though the error was not preserved for appeal)

http://scholar.google.com/scholar_case?case=1514571914118725909&q=Rose+v.+Hatten,+417+S.W.2d+456+&hl=en&as_sdt=2,34 >.

Utah

Berger v. Berger, 713 P.2d 695 (Utah 1985) (considering patents as part of the marital estate but found to be worthless)

http://scholar.google.com/scholar_case?case=5157281892475362010&q=Berger+v.+Berger,+713+P.2d+695+&hl=en&as_sdt=2,34 >.

Wilkins v. Stout, 588 P.2d 145 (Utah 1978) (awarding future royalties classified as part of the property settlement but not in the maintenance award)

http://scholar.google.com/scholar_case?case=12183403623434214142&q=Wilkins+v.+Stout,+588+P.2d+145+&hl=en&as_sdt=2,34 >.

Dunn v. Dunn, 802 P.2d 1314 (Utah Ct. App. 1990) (awarding the non-creating-spouse an equitable share of royalty rights at the dissolution of the marriage)

< http://scholar.google.com/scholar_case?case=10083296888992518996&q=Dunn+v.+Dunn,+802+P.2d+1314+&hl=en&as_sdt=2,34 >.

Moon v. Moon, 790 P.2d 52 (Utah Ct. App. 1990) (subjecting the husband's right in his molds for sculptures to division)

< http://scholar.google.com/scholar_case?case=6872514455490437515&q=Moon+v.+Moon,+790+P.2d+52+&hl=en&as_sdt=2,34 >.

Epstein v. Epstein, 741 P.2d 974 (Utah Ct. App. 1987) (disallowing net royalties for the non-creating-spouse for failing to comport with evidence requirements)

< http://scholar.google.com/scholar_case?case=18192042176651480856&q=Epstein+v.+Epstein,+741+P.2d+974+&hl=en&as_sdt=2,34 >.

Virginia

Zalusky v. Zalusky, No. 0199-02-4, 2002 WL 31553133 (Va. Ct. App. Nov. 19, 2002) (classifying a patent as marital property) < <http://www.courts.state.va.us/opinions/opncavwp/0199024.pdf> >.

Jennings v. Jennings, 409 S.E.2d 8 (Va. Ct. App. 1991) (holding that —royalties in property settlement means —net royalties)

< http://scholar.google.com/scholar_case?case=5139151266510202168&q=Jennings+v.+Jennings,+409+S.E.2d+8+&hl=en&as_sdt=2,34 >.

Washington

In re Marriage of Crivello, 103 Wn. App. 1019 (Wash. Ct. App. 2000), *available at* No. 43707-1-I, 2000 WL 1668014 (characterizing the patent as community property).

Schultz v. Schultz, 91 Wn. App. 1072 (Wash. Ct. App. 1998), *available at* No. 40306-1-I, 1998 WL 463480 (holding that patent royalties paid after dissolution of marriage due to an enforcement action were community property).

In re Marriage of Knight, 880 P.2d 71 (Wash. Ct. App. 1994) (allowing the property settlement to award patents and copyrights)

< http://scholar.google.com/scholar_case?case=11923897250725424826&q=In+re+Marriage+of+Knight,+880+P.2d+71+&hl=en&as_sdt=2,34 >. [Also found at 75 Wn. App. 721.]

SECTION 4

WIPO LEX (WIPO, WTO, and UN Members)

From the WIPO Lex website – < <http://www.wipo.int/wipolex/en/> >

WIPO Lex is a one-stop search facility for national laws and treaties on intellectual property (IP) of the 197 WIPO, WTO and UN Members. It also features related information which elaborates, analyzes, and interprets these laws and treaties. It provides streamlined access to reference material of key importance for optimal information on the global IP System.

A

- Afghanistan
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AF> >
- Albania (44 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AL> >
- Algeria (24 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=DZ> >
- Andorra (16 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AD> >
- Angola (11 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AO> >
- Antigua and Barbuda (14 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AG> >
- Argentina (69 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AR> >
- Armenia (12 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AM> >
- Australia (169 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AU> >
- Austria (41 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AT> >

- Azerbaijan (36 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=AZ> >

B

- Bahamas (12 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=BS> >
- Bahrain (18 texts)
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- Bangladesh (6 texts)
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- Barbados (45 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=BB> >
- Belarus (17 texts)
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- Belgium (43 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=BE> >
- Belize (44 texts)
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- Benin (3 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=BJ> >
- Bhutan (9 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=BT> >

- Bolivia (Plurinational State of) (26 texts)
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- Bosnia and Herzegovina (5 texts)
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- Botswana (4 texts)
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- Brazil (81 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=BR> >
- Brunei Darussalam (18 texts)
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- Bulgaria (13 texts)
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- Burkina Faso (14 texts)
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- Burundi (6 texts)
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C

- Cambodia (12 texts)
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- Canada (82 texts)
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- Cape Verde (20 texts)
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- Central African Republic (5 texts)
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- Chad (6 texts)
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- Chile (46 texts)
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- China (154 texts)
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 - Hong Kong (SAR), China (90 texts)
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 - Macao (SAR), China (16 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=MO> >
 - Taiwan, Province of China (44 texts)
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- Colombia (48 texts)
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- Comoros (9 texts)
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- Congo (5 texts)
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- Costa Rica (33 texts)
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- Croatia (18 texts)
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- Cuba (24 texts)
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- Cyprus (8 texts)
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- Czech Republic (40 texts)
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- Côte d'Ivoire (6 texts)
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D

- Democratic People's Republic of Korea (North Korea)
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- Democratic Republic of the Congo (5 texts)
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- Denmark (44 texts)
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- Djibouti (4 texts)
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- Dominica (35 texts)
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- Dominican Republic (4 texts)
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E

- Ecuador (24 texts)
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- Egypt (43 texts)
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- El Salvador (32 texts)
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- Equatorial Guinea (3 texts)
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- Eritrea
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- Estonia (68 texts)
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- Ethiopia (8 texts)
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- [European Union](#) (120 texts)
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F

- Fiji (11 texts)
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- Finland (37 texts)
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- France (99 texts)
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G

- Gabon (14 texts)
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- Guinea-Bissau (2 texts)
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- Guyana (8 texts)
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H

- Haiti (9 texts)
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- Holy See (1 texts)
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- Honduras (1 texts)
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- Hong Kong (SAR), China (90 texts)
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- Hungary (26 texts)
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I

- Iceland (34 texts)
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- India (54 texts)
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- Indonesia (22 texts)
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- Iran (Islamic Republic of) (5 texts)
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- Iraq (3 texts)
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- Israel (30 texts)
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- Italy (31 texts)
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J

- Jamaica (26 texts)
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- Japan (74 texts)
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- Jordan (12 texts)
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K

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- Kuwait (11 texts)
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- Kyrgyzstan (28 texts)
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L

- Lao People's Democratic Republic (20 texts)
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- Latvia (27 texts)
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- Lebanon (5 texts)
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- Lesotho (5 texts)
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- Liberia (5 texts)
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- Liechtenstein (24 texts)
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- Lithuania (34 texts)
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- Luxembourg (18 texts)
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M

- Macao (SAR), China (16 texts)
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- Madagascar (13 texts)
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- Malaysia (43 texts)
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- Malta (27 texts)
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- Marshall Islands (10 texts)
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- Mauritania (4 texts)
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- Mauritius (19 texts)
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- Micronesia (Federated States of) (6 texts)
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- Mongolia (30 texts)
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- Montenegro (17 texts)
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- Morocco (47 texts)
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- Mozambique (18 texts)
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- Myanmar (17 texts)
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N

- Namibia
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- Nauru (13 texts)
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- Nepal (6 texts)
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- Netherlands (16 texts)
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- Nicaragua (27 texts)
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- Niger (3 texts)
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- Nigeria (27 texts)\
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- Norway (34 texts)
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O

- Oman (13 texts)
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P

- Pakistan (18 texts)
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- Palau (10 texts)
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- Panama (21 texts)
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- Papua New Guinea (37 texts)
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- Paraguay (9 texts)
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- Peru (49 texts)
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- Philippines (7 texts)
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- Poland (18 texts)
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- Portugal (133 texts)
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Q

- Qatar (7 texts)
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R

- Republic of Korea (South Korea) (32 texts)
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- Republic of Moldova (39 texts)
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- Romania (52 texts)
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- Russian Federation (54 texts)
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- Rwanda (8 texts)
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S

- Saint Kitts and Nevis
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- Saint Lucia (15 texts)
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- Saint Vincent and the Grenadines (13 texts)
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- Samoa (18 texts)
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- San Marino (8 texts)
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- Sierra Leone
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- Slovenia (53 texts)
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- Solomon Islands (6 texts)
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- Somalia
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- South Africa (46 texts)
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- Spain (71 texts)
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- Sri Lanka (7 texts)
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- Sudan (2 texts)
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- Suriname (9 texts)
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- Swaziland (12 texts)
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- Sweden (36 texts)
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- Switzerland (67 texts)
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- Syrian Arab Republic (2 texts)
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T

- Taiwan, Province of China (44 texts)
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- Tajikistan
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- Thailand (31 texts)
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- The former Yugoslav Republic of Macedonia (11 texts)
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- Timor-Leste (2 texts)
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- Togo (10 texts)
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- Tonga (10 texts)
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- Trinidad and Tobago (26 texts)
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- Tunisia (50 texts)
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- Turkey (26 texts)
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- Turkmenistan
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- Tuvalu (21 texts)
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U

- Uganda (18 texts)
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- United Arab Emirates (5 texts)
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- United Kingdom (147 texts)
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- United Republic of Tanzania (11 texts)
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- United States of America (38 texts)
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- Uruguay (38 texts)
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- Uzbekistan (68 texts)
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V

- Vanuatu (30 texts)
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- Venezuela (Bolivarian Republic of) (16 texts)
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- Viet Nam (37 texts)
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Y

- Yemen
< <http://www.wipo.int/wipolex/en/profile.jsp?code=YE> >

Z

- Zambia (33 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=ZM> >
- Zimbabwe (23 texts)
< <http://www.wipo.int/wipolex/en/profile.jsp?code=ZW> >

A Directory and links to the IP offices for each country and the Regional IP offices can be found at:

< <http://www.wipo.int/directory/en/urls.jsp> >