



Intellectual property considerations in collaborative research

Introduction

Collaborative research is often key to accelerating the development of innovation with contributions and expectations from the parties and non-contracting stakeholders, which contributions and expectations affect intellectual property ('IP'). Often, a balance of competing interests is necessary with the primary emphasis upon the collaborative research necessary to achieve deliverables and outcomes[1] and a secondary emphasis upon the parties' activities to exploit and use[2] such deliverables and outcomes for different or similar purposes. These emphases are governed by a single, standard, contractual model ('Model') in which IP is a recurring feature. This paper is a *vade mecum* and considers IP within collaborative research, subject to United Kingdom laws. Many of the considerations within this paper are relevant to the generic contract research programmes of CROs. Bracketed numbers within this paper refer to the notes and references that follow.

IP and information

Modern IP laws are almost entirely creatures of statute with IP comprised of bundles of rights not susceptible of exclusive possession, a general proposition comparable to *Hohfeld's* concept that property exists as much within rights as within physical objects[3]. Statutes establish IP as property and express their nature either as property rights subsisting within some tangible object[4] or as personal property for some tangible object[5]. In each case, they are personal rights enforceable only by legal action and not by physical possession[6]. There is no distinction between property rights and personal property as property *per se*, although personal property within a patent or a registered design is derived through inventorship and authorship respectively with conception leading to entitlement in both application and grant. Personal property within a trade mark is not so derived, and as entitlement is not a relevant consideration an application for a trade mark is not personal property. Being composed of no matter or material existence, IP is commonly referred to as incorporeal or intangible

property.

Laws relating to confidential information, know-how, and trade secrets (together ‘Information’) are not creatures of statute[7]. The jurisprudential basis for the governance of Information is by means control over its disclosure and use through common law principles developed under the law of contract and equity, although historically causes of bailment, fiduciary relationship, trust, and unjust enrichment have been pleaded. The nature and scope of Information is obscure. Information is not property *a fortiori* Information cannot be assigned as property but only as a right of such control. Consequentially, the term proprietary information is a misnomer, and unlawful use of Information gives rise to no proprietary remedy. Information is not defined by registration but by circumstance with no theoretical limit to the duration of its protection nor monopoly conferred upon its controller. Information *per se* can neither be used to prohibit independent thought, development, nor disclosure.

IP and Information are fundamentally separate and yet complimentary regimes. They stand alone, coexist, and overlap with Information preceding IP[8]. In collaborative research, it is best practise that IP and Information are treated separately as expressed within the Model, although such dealing is seldom heeded. Caution in dealings is necessary whenever IP is treated to include Information. An assignment of title to IP that seeks to include Information is void to the extent of its inclusion, as title to Information has no legal basis. Instead, the correct mechanism is by separation of the assignment into IP as property and Information as a right of control. The assignment mechanism is expressed A assigns to B with full title guarantee Z, where Z is the tangible object such as results[9] representing a deliverable or outcome and foreground IP subsisting within or for Z and with exclusive[10] control of all rights of disclosure and use of Information directly regarding Z created or developed in the course and activities of the collaborative research.

Criteria for IP

IP does not exist in a vacuum nor is it magicked from thin air. The belief that soft IP[11] occurs automatically by the making of a work is a common misconception. For soft IP, it is necessary to understand its existence through criteria of subsistence and qualification.

Criteria for soft IP are summarised:

- for copyright, a work falls within one of the categories of protectable work[12], is fixed and expressed in permanent form[13], original[14], and qualifies for copyright protection[15]; and
- for design right, a design matter falls within the shape or configuration of the whole or part of an article, is first recorded in a design document or an article first made to the design[16], original[17], and qualifies for design right protection[18].

For hard IP, applications are subject to criteria necessary for grant and formal, independent examination by the relevant body responsible. Criteria for hard IP are summarised:

- for patent, an invention is novel, involves an inventive step, and is capable of industrial application[19]. A discovery, scientific theory or mathematical method, literary, dramatic, musical or artistic work or any other aesthetic creation, scheme, rule or method for performing a mental act, playing a game or doing business, a program for a computer, or the presentation of information are excluded[20];
- for registered design, a design comprises the appearance of the whole or part of a product resulting from the features of lines or contours, colours, shape, texture or material of the product itself or its ornamentation or both[21], is new in that no identical design or design differing in only immaterial detail has been made available to the public[22], and has individual character, so as to create a different overall impression upon an informed user to known designs[23]. Designs dictated by technical function[24] or the need to interconnect with another product[25] unless part of a modular system are excluded; and
- for trade mark, a sign is capable of being represented in the register in a manner which enables the registrar, other competent authorities, and the public to determine the clear and precise subject matter of the protection afforded the proprietor[26] and distinguishes the goods or services of one undertaking from those of other undertakings[27]. Signs devoid of any distinctive character, consist exclusively of indications which may serve to designate the kind, quality, quantity, intended purpose, value, geographical origin of goods or services are excluded[28].

Background IP and foreground IP

Background IP comprises of IP proprietary to or within the control of a party before the collaborative research and may include IP proprietary to or within the control of a party after but outside the scope of the collaborative research. Control is subject to the terms of a third party in-licence. Within the Model, a generic definition of IP relevant to the nature of the collaborative research is used for the purpose of background IP. To ensure certainty of dealing, the generic definition is separately expressed to subsist within or be for some tangible object. Caution is necessary in dealings with background IP that includes, relies upon, and is subject to third party in-licences as these may impose limitations upon a controlling party's dealing with third party IP affecting the extent or purpose of use, duration, forward use, and even rights to foreground IP. Generally, limitations are tied with price, and the lower the price of a third party in-licence, the greater are its limitations and vice versa. The definition and expression scope the extent of the background IP.

The foremost object of collaborative research is the creation and recording of Information. Foreground IP includes or is directly dependent upon Information created or developed in the course and activities of the collaborative research[29]. Necessarily and by reason of process and timing, Information and subject to criteria soft IP and its subsistence within Results, are the primary consideration. The cost, process, and timing of hard IP are considerations beyond the scope of the collaborative research *per se* and may drain effort and resources. Consequently, hard IP is a secondary consideration that belies the patent first

mantra taken by many parties and non-contracting stakeholders. The generic definition of IP within the single, standard, contractual model is used for the purpose of foreground IP. To ensure certainty of dealing, the generic definition is expressed to subsist within or be for some tangible object, usually Results and any deliverables expressed by the parties. The definition and expression scope the extent of the foreground IP.

Primary and secondary background licences

Typically, collaborative research necessitates the grant of a primary licence to the background IP and Information of a party to the other party. A primary background licence is limited and expressed for the sole purpose of carrying out the activities of the collaborative research and no other purpose is expressed nor implied. A contractual obligation is reasonable and standard, whereas an undertaking in similar terms is unreasonable and not best practise. In the absence of such an expressed primary background licence, the parties act by permission[30] to use the background IP and Information of the other party necessary for the collaborative research. The permission is implied as a matter of law in order to give efficacy. The extent of a permission is limited to that necessary for the sole purpose of carrying out the collaborative research and no other purpose is expressed or implied. The parties may vary the extent of a primary background licence or a permission by agreement in writing. In each case, necessity is determined by the collaborative research, usually in the form of a study plan agreed between the parties. In each case, a primary background licence and a permission is non-exclusive, without payment and royalty free, revocable[31], terminable, and non-transferable with no right to sub-license[32].

Often, following collaborative research the grant of a secondary licence to use the background IP and Information of the other party is necessary and limited to the sole purpose of exploiting and using Results and foreground IP subsisting within Results and no other purpose is expressed or implied. Provision for a secondary background licence is expressed within the Model and a permission is not relevant. Absence the Model or some other agreement, a party may request a secondary background licence through necessity. Necessity is determined in the reasonable opinion of the party whose background IP and Information is sought. The obligation is upon the other party to demonstrate need. Mere desire for a secondary background licence without a reasonable need is refused. In the absence of an expressed secondary background licence, the law implies no permission, even if it is necessary to exploit and use Results and foreground IP subsisting within Results. A secondary background licence is non-exclusive, without payment and royalty free, revocable, terminable[33], and non-transferable with no right to sub-licence[34].

Primary and secondary background licences provide safeguards beyond the standard limitations of exclusivity, field of use, revocability, terminability, and territory. Safeguards are not be implied as a matter of law. Reasonable monitoring of exploitation and use of secondary out-licensed[35] background IP is desirable. Monitoring is straightforward during collaborative research and is by observation and reporting. Following collaborative research,

continued monitoring is problematic, sensitive, and subject to undertakings of confidentiality from a party as licensor to the other party as licensee. Opposition to continued monitoring is deemed a reasonable ground to refuse or terminate a secondary background licence. An improvement by the licensee to secondary out-licensed background IP may undermine or make redundant the original background IP. An improvement is, therefore, defined having regard to the original IP and subject to ownership[36], right of use, payment agreement, evergreening[37], and grant back[38].

Ownership of foreground IP

Ownership of foreground IP is determined as a matter of law preferably according to contract and in default according to statute[39]. By reason of the various rights of exploitation and use, there is no single, standard, contractual model for the ownership of foreground IP[40]. Contractual ownership is agreed prior to the collaborative research either as a sole person owner, being a party or separate entity, or joint or co-ownership[41]. Collaborative research favours joint or co-ownership of foreground IP, either in whole or in part. Ownership in whole provides a party with an equal undivided share of the whole and ownership in part provides a party with absolute ownership of a part of the whole. Subject to an agreement to the contrary, the parties are deemed tenants in common rather than joint tenants, and typically the parties determine ownership of foreground IP and share proportion according to their contributions and expectations. A sole contribution by only one party provides for ownership by that party in whole, although such a scenario is rare. Joint contributions provide for ownership by each party, in whole or in part subject to the contribution's worth.

Contracting for joint or co-ownership of foreground IP or a foreground IP licence post collaborative research gives rise to many considerations not of an IP nature *per se* but of a commercial nature. Although such considerations develop from ownership of foreground IP or a foreground IP licence, in reality they are determined by commercial practicality including, *inter alia*, market need, IP protection, and distribution or the ability of a party to perform some aspect or function. Save for logistics, there is no reason the parties should contract with each other over aspects that govern certain or all of their rights regarding foreground IP, although a failure to do so shows poor judgment or thinking and is not best practise. Alternatively, a pooling of resources leads to more and better party activity.

Many of the contractual considerations regarding joint or co-ownership of foreground IP or a foreground IP licence influence each other and contractual joint or co-ownership of foreground IP is summarised:

- accounting and payment. Such provisions are not standard between academic institutions and commercial entities of equal or similar bargaining power and parties determine not to account to each other. Between commercial entities of unequal bargain power say with dominant territories or fields of use, accounting and payments are commonplace. The justification is a levelling up the shared risk taken by the parties during the collaborative research and its subsequent, direct or indirect, financial benefits;

- field of use. Fields may be all, specified, or related fields of use. It is probable the field is limited by the nature of the foreground IP and the parties' abilities to exploit IP;
- scope of use. Scope involves the physical or practical dealing with products or services and foreground IP subsisting within or registered for them. Commonly, the scope includes advertising and promotion, distribution, manufacturing and production, export and import, selling and offering for sale. The scope can be narrow or broad but caution is needed in dealings by a party with limited experience and infrastructure as well as the consent of a relevant party to sub-license the same;
- licence and sub-licence. The ability to licence and sub-licence is significant having regard to a party's ability to undertake activity for which it may lack certain capacity in terms of infrastructure and outreach. For instance, where two or more persons are proprietors of a patent one of them cannot without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent[42];
- freedom to operate. The ability to carry out commercial plans without infringing third party's IP and IP rights are significant. The term is most commonly used in relation to patents but equally applies to designs and trade marks. Absent freedom to operate, a party may be compelled to cease commercial plans or make third party payments, compounding any pre-existing accounting or payment provision without some reasonable set off known as stacking[43];
- infringement and equivalents. These are subjective and often pre-determined in favour of a party with the responsibility but not the obligation to take control and prosecute or defend legal proceedings. In the event such party declines to do so, the other party or parties may assume control. Whereas there is often an obligation between parties to lend their reasonable cooperation if necessary, the prosecuting or defending party must bear the reasonable legal costs of the cooperating party;
- post grant event. The parties must control post grant events such as prosecutions, management, and actions of regulatory authorities;
- territory. Geographical dealing depends upon market need, followed by a party's ability to distribute products or services within that market, wherein the wealthiest markets often generate the most revenue. IP protection affects geographical dealing but it is not a key influencer and it is rare the parties divide or share territories between themselves, preferring instead a single party or commercial entity, so as to maintain consistency and prevent duplication; and
- publications and options: see below.

The statutory default position is best avoided. Only generic rights of exploitation and use are legislated, the actual contributions of the parties are not identified nor divisible, and there is no guarantee everyone involved in the collaborative research owns a share of foreground IP, such as work and foreground IP created by an employee in the course of employment[44]. Statutory joint or co-ownership of foreground IP is summarised:

- for copyright, a work produced by the collaboration of two or more authors in which the contribution of each author is not distinct from the other author or authors[45] is deemed a work of joint authorship[46];

- for design right, joint ownership arises as with copyright, when two or more designers collaborate to create a design in which the contribution of each is not distinct from the other designer or designers[47]. Where different persons are entitled to different aspects of design right in a work, the design right owner is the person who is entitled to the right in the respect relevant for that purpose[48];
- for patent, any person[49] can apply for a patent but not everyone who applies is entitled to be granted a patent. Entitlement is a matter of law and derives from inventorship. The entitlement or right to be granted a patent belongs to the inventor or inventors, being the actual deviser or devisors of the invention[50], unless another person is entitled to own the invention by any rule of law at the time the invention is made[51]. Co-ownership arises where there are joint applicants for a patent or when a patent or patent application is assigned to two or more persons;
- for registered design, any person can apply for a registered design but not everyone who applies is entitled to be granted a registered design. Entitlement is a matter of law and derives from authorship. The right to be granted a registered design belongs to the author, being the creator of the design in question[52], unless another person or persons are entitled to own the registered design by operation of law[53]. The statute does not establish how joint ownership arises or takes effect but refers to a registered design being jointly owned. It is reasonable joint ownership arises by joint authors creating a design, an agreement or assignment, and the name of each joint owner should be included upon the application or subsequent registered design; and
- for trade mark, any person can apply for a registered trade mark. Entitlement is not derived through authorship or inventorship and is not relevant *per se*[54]. When a registered trade mark is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark[55]. Otherwise, where two or more persons are co-proprietors of a registered trade mark, provisions apply to affect its exploitation and use[56]. The name of each co-proprietor should be included upon the application or subsequent registered trade mark.

Publications and options

Within collaborative research, publication clauses concern the proposed placing of Information, taken from Results and inventions, into the public domain ('Publication') weighed against the potential impact upon and loss and damage to confidentiality and patent rights. As a matter of law, Publication takes effect not merely when Information is placed into the public domain but when it becomes easily ascertainable by members of the public, either through written or oral description or disclosure, demonstration or use, or in any other way. Publication is not territorial and disclosure in one territory constitutes disclosure in all territories. Publication clauses come with varying degrees of reasonableness focussing upon the how and when a Publication may take effect rather than the whether. They are of primary interest to charities, research institutes, universities, and principal investigators with an obligation under certain research governance frameworks, and an absolute ban upon a Publication is not standard practice.

Publication before a patent application is filed may jeopardise patent rights, such that a publication clause seeks to manage the risk and balance the need for transparency with the protection of patents and Information. Publication clauses adopt a standard form of wording to permit disclosure by a sole party but they are rarely mutual so as to allow each of the parties to publish separately or jointly. Further, publication clauses seldom seek to restrict a non-publishing party from Publication and may leave such party with the freedom to publish without notice to the intended publishing party[57]. Typically, written limitations regarding a Publication[58] include the category of persons to whom the Publication is to be made and the purpose for the Publication. Regardless, publication is disclosure and protecting novelty and the confidentiality of Information is inevitably a damage limitation exercise.

It is reasonable a non-publishing party should seek to protect its interests with an option to object and refuse, albeit limitedly, certain aspects of a Publication. Under no circumstances should a party seek to influence, change, or contradict Results, although despite their inclusion a Publication is not a slave to Results and objections are not deemed limitations. Reasonable objections to a Publication include the exclusion of potentially patentable material and Information within the control and without the consent of the non-publishing party. Objection means delay in publication and a non-publishing party must act reasonably and not delay for delay's sake, although there is no obligation upon a non-publishing party to file a patent application but instead merely consider whether to do so. Notice of a Publication must be given within an expressed period of time prior to the submission of a Publication for disclosure, lest the submission itself, the mere sending of the Publication to a publisher, constitutes publication and novelty and confidentiality are lost without some guarantee of confidentiality. A Publication is disclosed in full to the non-publishing party and not as a summary or synopsis[59] since full disclosure enables the non-publishing party to give an informed consideration of the Publication[60].

There is a standard process whereby delivery from a publishing party to a non-publishing party is not less than the standard minimum of 30 business days to not more than the standard maximum of 60 business days prior to submission of the Publication. The non-publishing party may then file a notice of amendment to the publishing party within not more than the maximum of 60 business days with 30 business days being standard. Failure to file such a notice will permit the publishing party to submit the Publication. In the event of a notice of amendment from a non-publishing party, the publishing party redelivers the amended Publication to the non-publishing party for approval by the non-publishing party within not more than the standard maximum of 30 business days or undertakes to the non-publishing party in writing to abandon the Publication altogether. Following a final approval of the amended Publication by the non-publishing party, the publishing party may submit the amended Publication into the public domain.

Foreground IP from collaborative research may be subject to an option. An option is a right but not a requirement that a party, known as the option holder, acquires an exclusive right or

rights over foreground IP for some exclusive purpose or purposes, which may realise different streams of cashflow, opportunity, and value for the option holder, whilst leaving other rights to the other party. Acquisition depends upon the wording of the option and its exercise within a fixed period of time known as the option period. The duration or term of the collaborative research determines the option period. The longer the term the longer the option period, enabling the parties to acquire the maximum amount foreground IP and Information. A straightforward collaboration has the option period run from the commencement of the collaborative research for a period of not more than the term and a complex collaboration has the option period run from the commencement of the collaborative research for a standard period of not more than 180 business days beyond the term. In the case of the latter, a reasonable time limit is necessary, which is usually the shorter of 2 years from the commencement of the collaborative research or the option period stated. Wording the option is considered carefully. Necessarily, exercising of the option is dependent upon monthly disclosures, between the parties, of their respective progress and Results made during the term.

During the option period foreground IP is held between the parties subject to contract or the statutory default position, when neither party may assign or license foreground IP to a third party. An option is exercised by the option holder giving written notice to the other party within the option period. Typically, following receipt of the written notice, the parties give contractual effect to some pre-agreed position or are contractually obliged to negotiate in good faith and seek to agree terms between them. In either case, the option holder acquires certain rights in return for rights acquired or retained by the other party. As with ownership of foreground IP, the rights on either side vary according to the parties pre-agreed expectations and there is no common provision for the option expressed within the Model. Upon exercise of the option or agreement of terms, the parties execute an assignment, exclusive licence, or otherwise in recognition of their respective rights. In the event an option is declined by the option holder or not exercised within the option period, the option lapses. Absent some pre-agreed position, there is incentive for the parties to make *bona fide* efforts and reach an agreement, lest they hinder their dealing with foreground IP.

Notes and references

- [1] Deliverables are specified by the parties to produce or verify something of matter or material existence in a format expressed by them, and outcomes are unknown and unspecified by the parties in their content and detail, usually results. It is best practise to define such terms.
- [2] Exploitation is interpreted as some form of capitalisation or direct financial benefit and otherwise in the case of use. It is not necessary to define such terms.
- [3] *Wesley Newcomb Hohfeld: Fundamental Legal Conceptions* [1913] YLJ 16.
- [4] § 1(1) and 213(1) of the Copyright, Designs and Patents Act 1988 ('CDPA 88').
- [5] § 30(1) of the Patents Act 1977 ('PA 77'), 15A of the Registered Designs Act 1949 ('RDA 49'), and 22 of the Trade Marks Act 1994 ('TMA 94'). As well as an object or product, the tangible includes a process or service.
- [6] § 30(1) PA 77 declares a patent is not a thing in action, an anomaly that seems without purpose or consequence as the provisions for ownership and assignment are contained within the statute itself: *Bainbridge D, Intellectual Property*, (6th Ed., 2007) at 10.
- [7] Cf. The Trade Secrets (Enforcement etc) Regulations 2018 and *Lex Scientia: Trade secrets – no magic formula* at URL: <https://www.scottfarnsworth.biz/wp-content/uploads/2022/05/Trade-secrets-no-magic-formula.pdf>.
- [8] Overlaps occur on account of intangibility and commercial sensitivity, specifically as between laws regarding confidentiality, novelty, and copyright: copyright law does not extend to the contents of a database but the law of confidentiality may do so.
- [9] Results comprise a summary of the results, all information and data required by a study plan, a presentation of the results, including calculations and determinations of statistical significance, an evaluation and discussion of the results and, where appropriate, conclusions (together 'Results').
- [10] Rights assigned under the second part may be exclusive, non-exclusive, or sole, while any reserved rights of the assignor under the latter two assignments must be expressed in writing.
- [11] Soft IP is unregistered IP, which includes copyright and design right cf. hard or registered IP, which includes patents, registered designs, and trade marks.
- [12] § 1 CDPA 88.
- [13] § 3(2) CDPA 88.
- [14] § 1(1)(a) CDPA 88 regarding literary, dramatic, musical or artistic works, known as author's rights.
- [15] § 153(1) CDPA 88; see *Wright v BTC Core* [2023] EWCA Civ. 868.
- [16] § 213(2) and 216 CDPA 88.
- [17] § 213(1) CDPA 88.
- [18] § 217 to 221 CDPA 88.
- [19] § 1(1) PA 77.
- [20] § 1(2) PA 77.
- [21] § 1(2) RDA 49.
- [22] § 1B(1) and (2) RDA 49.
- [23] § 1B(1), (3) RDA 49.
- [24] § 1C(1) RDA 49.
- [25] § 1C(2) RDA 49.
- [26] § 1(1)(a) TMA 94.
- [27] § 1(1)(b) TMA 94.
- [28] § 3(1) TMA 94. Save for a sign not in compliance with § 1(1) TMA 94, all other such exclusions maybe disappplied in the event a sign, before the date of filing, acquires a distinctive character as a result of the use made of it. Further exclusions apply: § 3(2) to 3(6) TMA 94.
- [29] Wording to the effect of foreground IP created 'in consequence' of the collaborative research should be avoided, lest it captures IP too remote from the collaborative research and excluded as independent.
- [30] A permission is a bare consent with little control exercised by the party whose background IP is used.
- [31] Revocation or the cancelling of an act, recalling of a grant or privilege, or making void of some deed previously existing as opposed to termination by right.

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Notes and references continued

- [32] For a primary background licence, Field of use and territory are not relevant when the sole purpose is the collaborative research at hand.
- [33] Revocation and termination of a secondary background licence are subject to reasonableness.
- [34] For a secondary background licence, field of use and territory are relevant and subject to agreement between the parties.
- [35] An out-licence or grant by a person (licensor) to another person (licensee) of a right to use a product, technology, or intellectual property. *Cf* an in-licence or acquisition by a person (licensee) from another person (licensor) of a right to use a product, technology, or intellectual property.
- [36] Ownership considerations include the original technology working better or technology of a different kind, patentability, and patent challenge.
- [37] Evergreening is any of various legal, business, and technological strategies by which a licensor extends the lifetime of a patent that is about to expire in order to retain revenues from it.
- [38] Subject to competition law, a provision that requires a licensee to disclose and transfer or 'grant back' to a licensor all improvements made (including related Information acquired) in the licensed IP during the licensing period.
- [39] Ownership may be academic in the event a party obtains, under licence, the necessary access it requires, although ownership may be paramount, even predetermined, such as investor interest or certain crown procurements.
- [40] There is no common contractual clause or clauses to determine ownership of foreground IP within the Model as there are many variables, although an unsophisticated starting point may be a 50/50 split between two parties.
- [41] Ownership aside, the parties contract for limited concurrent use of foreground IP during the collaborative research, when the limitation is akin to a primary background licence albeit for foreground IP and limited concurrent or consecutive (or both) use of foreground IP following completion of the collaborative research.
- [42] § 36(3)(b) PA 77.
- [43] The principle is commonplace within technology licensing, where stacked royalties allow third party royalties to be shared between parties against royalties payable to a third party licensor.
- [44] By way of example see § 11(2) CDPA 88, § 215(3) CDPA 88, § 39(1) PA 77, § 2(1B) and § 2(2) RDA 49. In the context of TMA 94, the proprietor of a trade mark is the person or entity who owns the registered trade mark.
- [45] § 10(1) CDPA 88.
- [46] In most cases, the authors are first owners and must combine their efforts in such a way their individual contributions are not recognisable as distinct copyright works *cf.* a work comprised of separate copyright works each of which works can be identified are instead owned separately, and the work is deemed one of co-authorship: § 10A(1) CDPA 88.
- [47] § 259(1) CDPA 88.
- [48] § 258(1) CDPA 88.
- [49] § 7(1) to 7(4) PA 77. A person means either an individual or a corporate body but not a firm, partnership or other unincorporated association: <https://www.gov.uk/guidance/formalities-manual-online-version/chapter-2-request-for-grant-of-a-patent-form-1>.
- [50] An inventor must be a natural person and be responsible for the inventive concept or contributed toward it: *Yeda Research and Development Company Ltd v. Rhone-Poulenc Rorer International Holdings* [2007] UKHL 43 and affirmed in *Thaler v. Comptroller General of Patents, Trade Marks and Designs* [2021] EWCA Civ 1374.
- [51] In the absence of any agreement to the contrary, the parties responsible for the formulation of the inventive concept own equal shares in the patent, regardless of the size of their respective contributions. Caution in dealing where resources are shared without discussing any patent applications arising from the collaborative research: *Yeda*.
- [52] § 2(3) RDA 49.
- [53] § 2(1B), 2(2), and 2(4) RDA 49.
- [54] As a matter of law, earlier, registered or unregistered rights held by a third party may affect an application or a granted trade mark.
- [55] § 23(1) TMA 94.
- [56] Act without consent or account: § 23(3) TMA 94; no licence, assignment, or charge: § 23(4) TMA 94; and infringement proceedings with joinder, subject to the leave of the court: § 23(5) TMA 94.

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Notes and references continued

[57] Publication clauses between commercial entities are not commonplace, and absolute restrictions prevent the publication of Results, save in the case of patent applications by a party or the parties.

[58] Those to whom Results are published are not affected by any restrictions placed upon their publication unless they are parties to some contractual embargo regarding their dealing with them.

[59] Lectures, seminars, and tutorials for the purpose of academic research and teaching are subject to limitation and may not permit full disclosure until the approval process has completed.

[60] Failure to give full and frank disclosure may give rise to a cause of action against the disclosing party such as breach of contract, breach of confidentiality, negligence, and/or misrepresentation.

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Contact Scott on +44 (0) 7885 798 853 or at scott@scottfarnsworth.biz