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The Impact of co-ownership of Intellectual Property Rights on their Exploitation (Q 194)

REPORT OF SWISS GROUP*

I. Analysis of the Current Substantive Law

The following answers must be read together with the first national report of the Swiss group on Q 194, enclosed hereto

1. Therefore, the groups are invited to indicate if, in their national laws, the rules related to the co-ownership of IP Rights make any distinction in the applicable rules to the co-ownership of an IP Right in case the origin of the co-ownership rights is not voluntary but results from other situations, including the division of a right in case of a heritage.

In this context the Groups may also indicate if there are any legal definitions of co-ownership of the IP Rights adopted in their countries and what their definitions are.

Generally, Swiss law distinguishes two forms of co-ownership: joint ownership (art. 646 Civil Code, CC) and ownership in common (art. 652 CC). In respect of the differences regarding the legal consequences of each form, the following should be pointed out.

A joint owner may sell or pledge his share without the consent of the other joint owners because each joint owner owns a share of the right (art. 464 para. 3 CC). Therefore, the joint owner is considered a normal owner regarding his share. Whereas the owner in common has a right of ownership in the whole property and the whole property may only be disposed of in consent with all the other owners in common (art. 652 CC).

If the co-owners do not constitute voluntarily, that is, contractually, their co-ownership and its extent, Swiss law imposes the legal form of co-ownership according to the situation the right derives from; e.g. if two children inherit their parent's car, they become automatically owners in common regarding the car without being able to influence their form of co-ownership, according to the Swiss rules on heritage.

On the other side, if co-ownership constitutes voluntarily, the co-owners may agree that a share of a co-owner must be sold to the others in case such co-owner becomes subject to a change of ownership (pre-emption right or heritage).

An ownership in common can only be terminated by cancelling the underlying contractual form (i.e. the community of heirs) or by selling the co-owned according to art. 653 CC. A joint owner, on the other hand, can be expelled in case he violates his obligation towards the other joint owner(s) in a fundamental way, that a continuation of the joint ownership with such joint owner cannot be expected from the other joint owners (art. 649b CC).

The specific rules applying to co-ownership of a patent, design, copyright or trademark among the original co-owners do not govern the non-voluntary co-ownership, such as the co-ownership among the successors of an original co-owner.

Division of a right in case of heritage

If a co-owner of such a right dies, his heirs inherit the co-owned right as owner in common according to art. 602 CC (community of heirs). However, the specific rules between them and the other co-owners of the IP Right, which may differ if it is a patent, copyright, trademark or design, remain unaltered and do not apply to the form of co-ownership of the heirs.

The provisions on the ownership in common only apply to the relationship among the heirs. All the heirs together as owners in common succeed into the position of the deceased original co-owner in relation to the other original co-owners of the IP Right and in respect of the co-ownership (art. 33 para. 1 Patent Law, PL).

Only the right of the deceased co-owner of being mentioned as an inventor cannot be inherited as it is a right attached solely to the inventor's personality.

Co-ownership imposed by judgment

If an IP Right is awarded by a court to more than one party, e.g. if an inventor is subsequently recognized as co-owner of a patent, it is again the situation the right derives from that determines the form of the co-ownership and the relationship between the co-owners. As an example, if the claimant is considered by award to be a co-inventor of the patent in question then the legal relationship towards the other co-owners is what the Patent Law defines it to be.

And if the claimant is considered by award to be an heir among other heirs of an inventor's co-owned patent, then the heirs' relationship is what the rules on heritage (art. 602 CC) set forth.

In this context it must be pointed out, that the right to claim ownership in a patent or any other intellectual property rights can forfeit. If the right's owner desists from claiming it for a certain time, but then decides to claim it all the same, his behaviour can be considered an abuse of rights, according the principle *venire contra factum proprium* (cf. art. 2 para. 2 CC). However, because of the fatal consequences of the forfeit, that the right ceases to exist, forfeit should not be presumed easily.

2. The question of outsourcing or subcontracting the exploitation of an IP right, particularly important in case of patents, relates particularly to the problem of subcontracting when a co-owner of the patent who, in principle, and at least according to the position expressed by AIPPI in its 2007 Singapore Resolution, has the personal right to exploit his own part of the patent, specifically by manufacturing and selling the goods or processes covered by the patent, needs to subcontract partially or totally the manufacturing of the product covered by the patent.

No common position could be achieved by the Singapore EXCO in 2007 on the question if the right to exploit the patent should also cover the right to subcontract, specifically the manufacturing of all or part of the invention being the subject matter of the patent.

Therefore, the groups are invited to present the solutions of their national laws on this specific point.

Generally, the rules on the form of the co-ownership define the requirements which must be met that a co-owner may exploit his share and to what extent. However, because the mutual agreement of all co-owners is almost in all situations requested for any kind of exploitation of the IP Right, in particular for the exploitation of a patent, it is not relevant whether the patent is exploited by the patent owner himself or by third party through licensing or subcontracting.

As a matter of fact, in the specific case of patents, the co-owner of a patent has no right to exploit the patent or his share unless all the co-owners have mutually agreed upon according to Swiss law (art. 34 para. 2 PL). The extent of such exploitation if agreed upon mutually is subject to the agreement among the co-owners.

Co-authors on the other hand, may exploit their individual shares if each share can be exploited individually and without threatening the exploitation of the whole copyright (art. 7 para. 4, Copyright Law, CL).

If this separation is not possible all co-authors must agree upon the exploitation of the whole copyright (art. 7 para. 2 CL).

Co-designers may only exploit their IP Right upon mutual agreement of all co-designers (art. 11 Design Law, DL).

There are no specific rules on the co-ownership of trademarks. Therefore, the form of co-ownership is based upon the situation the right derives from. The two possible forms are ownership in common and

joint ownership, and in absence of a clear determination by the parties, the legal structure of the ownership in common applies.

3. Therefore, in order to improve the work of the EXCO, the groups are invited to specify how the differences in the nature of licenses (non-exclusive or exclusive) influence the solution of their national laws in respect of the right to grant the license by a co-owner of an IP Right.

Under Swiss law, and with exception of the co-ownership in respect of copyright that can be exploited separately, all co-owners must agree to any license of the commonly own rights. In that sense, the nature of the license rights, exclusive or non-exclusive, is not relevant for the legal construct of the co-ownership.

However, according to Swiss doctrine, the grant of non-exclusive licenses permitting a multiple use of the co-owned patent may affect and limit the rights of the original owners. The number of parties who co-own the patent together and therefore are allowed to exploit the patent must remain the same, if one co-owner grants a license over his share to a third party. Subsequently, the co-owner who grants the license must be excluded from the exploitation (T. CALAME, SIWR IV, Patentrecht, 187).

In respect of copyright, an exclusive license by one co-owner does most likely not allow a use without disturbance of the other co-owners and is therefore considered not to be permitted.

In this regard, the question arises whether a co-owner may subsequently withdraw his consent to license the patent after the license agreement has already been concluded and which consequences would result from such a withdrawal. This question points at how the co-owners have to exercise their rights towards a third party. According to art. 34 para. 2 PL, a license may only be granted with the consent of all co-owners. On the other hand, one co-owner alone may issue a claim against the infringer(s) of the co-owned patent (art. 33 para. 2 PL). To revoke a license agreement is a question of disposing of the whole patent and not only one part. If the licensee infringes the patent, then one co-owner alone may file a suit against the licensee. As long as the licensee does not infringe the patent, one co-owner may not have the right to revoke the license agreement alone (except as agreed upon otherwise in the license agreement). Such right must be executed upon the consent of all co-owners. One co-owner who wishes to terminate the license agreement may only address the other co-owners who disagree based on the rules that apply to the co-ownership.

4. The Groups are therefore invited to precise their position on the question of the transfer or assignment of a share of the co-owned IP Right, taking into the consideration the different situations which may occur (the transfer of the whole share of a co-owned IP Right or the transfer only of the part of the share of the co-owned IP Right).

General

Only a structure of a joint co-ownership allows an independent assignment or a transfer of the share of the co-owned IP Right to a third party. However, such form of ownership is not presumed to exist, if it is not expressly chosen by the co-owners or created by award. Furthermore, there are cases where law imposes joint ownership.

Further, it must be distinguished between the relationship between the co-owners of an IP Right and the relationship between one co-owner and a third party to which this co-owner transfers or assigns a part of his share of the co-owned IP Right.

Whatever the agreement on or the form of co-ownership of the IP Right between the third party and the transferring or assigning co-owner may be, the relationship towards the other original co-owners of the IP Right will not be affected and remains the same as the one chosen by the initial co-owners or the one imposed by law.

Further, one share of the IP Right whether owned by one or more parties (i.e. heirs) can only be exploited and disposed of in accordance with the rules applying to the co-ownership among the original co-owners of the IP Right.

The relationship between the original co-owners does not affect the relationship between the co-owner and the third party to which this co-owner wishes to transfer its share. This relationship is governed

by the general rules of the assignment and transfer of rights and claims, such as sale, donation, pledge and other rules only.

Exception: Patents

In respect of the co-ownership of patent right, an exception applies. Swiss Patent Law allows the assignment and transfer of the share of one co-owner to a third party as well as its pledge independently and without the prior consent of all other co-owners. However, such transfer does again not affect the relationship between the original co-owners.

5. The exercise of an IP right co-owned by two or more co-owners each of whom has in principle the right to exploit the co-owned right, may also raise difficulties from the point of view of competition rules.

The co-owned IP Rights may give the co-owners the dominant position on the market and their agreement on the co-owned IP Rights (when for example it prohibits the licensing) may also be seen as eliminating the competitors from the market.

The groups are therefore invited to explain if their national laws had to treat such situations and what were the solutions adopted in those cases.

Under Swiss law, effects on competition that result exclusively from laws governing intellectual property are generally permitted and not subject to competition restrictions (art. 3 para. 2 Law on Cartels and other Restraints of Competition, KG). Therefore, the fact that several co-owners have exclusive rights on a patent or copyright and can exploit them to the exclusion of third parties does not per se result in unlawful market restraint.

However, insofar as co-owners agree on other sensitive aspects, e.g. they directly or indirectly fix the prices or allocate the market, such agreements, insofar as no justification exists, are presumed to represent a restraint of competition and are generally considered unlawful (art. 5 para. 3 KG).

6. The groups are invited to investigate once more the question of the applicable law that could be used to govern the co-ownership of various rights coexisting in different countries.

And more specifically the Groups are requested to indicate if their national laws accept that the co-ownership of an IP Right, even if there is no contractual agreement between the co-owners, may be ruled by the national law of the country which presents the closest connections with the IP Right.

If this is the case, what in the opinion of the Groups would then be the elements to take into the consideration to assess this connection?

Swiss conflict of law provides that the extent of intellectual property rights is governed by the law of the country where the protection of the intellectual property rights is requested (art. 110 Act on International Private Law, IPRG). This country is generally the country which has the closest connection with the co-owned IP Right. However, this means that the extent of the exploitation rights of the co-owners may vary depending of the countries in which the co-owners exploit their commonly owned rights. This may represent a disadvantage for the co-owners.

However, Swiss law allows a choice of law for the contracts concluded in respect of intellectual property rights. Accordingly, co-owners, whose co-ownership was determined by contract – which is often the case –, may submit their relationship, and the exploitation of their rights, to the law of a country mutually agreed upon (art. 122 para. 2 IPRG).

As a general rule and in absence of a choice of law, Swiss conflict of laws provides for the application of the law of the country where the contract has the closest connection (art. 117 para. 1 IPRG). The closest connection is supposed to be where the party which provides for the characteristic performance has his residence (art. 117 para. 2 IPRG). In respect of co-owned rights, it is not clear which party provides for the characteristic performance and no precedents exist in this regard.

7. Finally, the groups are also invited to present all other issues which appear to be relevant to the question and which were not discussed neither in these working guidelines, nor in the previous ones for the 2007 EXCO in Singapore.

From the point of view of Swiss law, no other issues are relevant.

For the discussions to take place in Buenos Aires, the Swiss group wishes that the international harmonization of the co-ownership rules and consequences as well as its implementation should be a major target to be addressed to in the resolution.

Summary

Under Swiss law, the rules related to the co-ownership of IP Rights set forth what one co-owner's rights regarding his "share" of the co-owned IP Right and regarding the IP Right as whole are. These legal solutions differ depending on which IP Right is co-owned. The Patent Law provides a different form of co-ownership (as well as a well disputed form) than the Copyright Law, for example. Therefore, if not contractually agreed upon, the co-ownership depends on which IP Right is co-owned. While a co-author has a right to exploit his share (under certain circumstances), the co-owner of a patent or the co-designer has no such right unless all the co-owners agree upon. Eventually, the Trademark Law does not provide any form of co-ownership and the co-owners are referred to the general form of ownership in common or joint ownership, depending on the situation the rights derives from.

However, these different forms of co-ownership remain unaffected if, for example, a co-owner dies. It must be distinguished between the relationship among the co-owners and the relationship among the heirs. The heirs, all together, inherit the share of the deceased co-owner. They succeed, again all together, into to the deceased's position towards the other co-owners according to the rules applicable to the respective form of co-ownership. Meanwhile, the relationship among the heirs is governed by the Swiss inheritance law. As another example, if judgement imposes co-ownership on an inventor, his relationship towards the pre-existing co-owners is as the applicable rules related to the IP Right at hand define it. This is particularly set forth in the Patent Law where a co-owner may even pledge his share without the consent of the others. What is more, if a co-owner assigns or sells his whole share or a part of his share, the successor will be vested in the rights of the assignor or vendor towards the remaining co-owners. Again, the relationship between the vendor of a whole share or a part of his share and the purchaser is what these two parties may choose it to be.

The difficulties a co-owner is faced with regarding the exploitation of his share of the IP Right or the fact that only one co-owner can deny the exploitation of the whole right (id est of a patent) do not automatically rise questions regarding the competition rules. Under Swiss Law, effects on competition that result exclusively from IP laws are generally permitted. In fact, the lack of a contractually defined ownership, wherein the choice of law could be governed, could lead to difficulties when the co-owned IP Right is infringed, for example by a co-owner. In such a case, the law of that jurisdiction applies where the protection against the infringement is requested.

Zusammenfassung

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Sollte ein Erfinder beispielsweise per Gerichtsbeschluss als einer der mehreren Rechteinhaber anerkannt werden, so ist sein Verhältnis zu den bereits bestehenden Rechteinhabern ebenfalls dasjenige, welches durch das entsprechende Gesetz für das entsprechende Immaterialgut vorgesehen ist.

Speziell im Patentgesetz ist eine Regelung vorgesehen, wonach ein Rechteinhaber seinen Anteil sogar ohne Zustimmung der anderen verpfänden kann. Sollte nun ein Rechteinhaber unter mehreren seinen Anteil oder einen Teil davon abtreten oder verkaufen, so erwirbt der Nachfolger die Rechte und die Stellung des Übertragenden beziehungsweise Verkäufers gegenüber den anderen Rechteinhabern. Das Verhältnis zwischen dem Käufer und dem Verkäufer eines Anteils oder eines Teils davon hängt wiederum von der jeweiligen Vereinbarung zwischen den beiden Parteien ab.

Probleme, welche sich einem Rechteinhaber unter mehreren betreffend Ausübung seiner Rechte an seinem Teil des Immaterialgutes stellen, oder die Tatsache, dass ein einzelner Rechteinhaber die Ausübung des Immaterialgüterrechtes als Ganzes (d.h. am Patentrecht) verhindern kann, müssen nicht automatisch wettbewerbs- oder kartellrechtliche Fragen aufwerfen. Gemäss Schweizer Recht sind wettbewerbsrechtliche Implikationen, welche sich ausschliesslich aus einem Gesetz zum Schutz von Immaterialgütern ergeben, generell erlaubt.

Sollte das Immaterialgüterrecht zum Beispiel von einem der mehreren Rechteinhaber verletzt werden, kann das Fehlen einer vertraglichen Regelung des Eigentumsverhältnisses, worin etwa eine Rechtswahl getroffen werden könnte, tatsächlich zu Schwierigkeiten führen. In diesem Fall gelten die Gesetze des Gerichtsstands, wo der Schutz gegen die Verletzung beantragt wird.

Résumé

Pour ce qui est du droit suisse, ce sont les conventions respectives au sujet de la propriété de plusieurs sur une chose qui déterminent les droits de chaque propriétaire sur ses parts de la propriété intellectuelle, ainsi que sur la propriété intellectuelle entière. Ces solutions légales diffèrent en fonction de la propriété intellectuelle concernée. La loi sur les brevets, par exemple, prévoit une autre forme (souvent controversée) de propriété de plusieurs sur une chose que le droit d'auteur. Ainsi, à défaut de convention contractuelle contraire, la forme de la propriété de plusieurs sur une chose dépend de la propriété intellectuelle concernée.

Alors qu'un coauteur a le droit d'exploiter (dans certaines circonstances) sa part du droit de la propriété intellectuelle, un des propriétaires d'un brevet ou un des titulaires d'un droit de design ne l'a pas, sauf si cela a été convenu avec les autres propriétaires ou titulaires. Le droit des marques ne prévoit aucune forme définie de la propriété de plusieurs sur une chose. En conséquence, les caractéristiques des titulaires du droit sont déterminées par les formes générales de la propriété commune ou de la copropriété, en fonction du contexte dans lequel le droit est né.

Cependant, le décès d'un des titulaires du droit, par exemple, n'affecte aucune de ces formes de la propriété de plusieurs sur le bien intellectuel. En revanche, il faut distinguer la relation entre les titulaires du droit et celle entre les héritiers. Les successeurs héritent, tous ensemble, de la part du défunt titulaire du droit. Les héritiers prennent, de nouveau tous ensemble, la place du défunt titulaire du droit dans la propriété de plusieurs sur une chose, ceci étant déterminé par la loi correspondante. La relation entre les héritiers est cependant définie par le droit successoral suisse.

Si un inventeur, par exemple, est désigné comme titulaire d'un droit en commun par une décision du tribunal, sa relation avec les autres titulaires est déterminée par la loi correspondante, relative à la propriété intellectuelle concernée.

De telles conventions sont en particulier prévues par la loi sur les brevets. Selon elle, l'un des titulaires a même le droit de prêter sur gage sa part sans le consentement des autres. Si l'un des titulaires du

droit envisage de céder ou de vendre sa part de la propriété intellectuelle, en totalité ou en partie, l'acquéreur obtient, envers les autres titulaires du droit, les droits et la position de la personne qui les cède ou les vend. La relation entre l'acheteur et le vendeur d'une part, totale ou partielle, dépend cependant de la convention entre les deux parties.

Les problèmes qui peuvent se poser lors de l'exploitation d'une part de la propriété intellectuelle ou le fait qu'un seul titulaire d'un droit puisse empêcher l'exploitation du droit intellectuel comme un tout (soit du droit de brevets) ne soulèvent pas forcément des questions relatives au droit de la concurrence. Selon le droit suisse, les restrictions au sujet du droit de la concurrence sont permises à condition qu'elles résultent exclusivement d'une loi sur la protection de la propriété intellectuelle.

En cas de violation du droit de la propriété intellectuelle par un des titulaires, par exemple, le manque d'une convention contractuelle, dans laquelle le droit applicable serait choisi, peut effectivement entraîner des difficultés. Dans ce cas, les lois du tribunal compétent où la demande de protection contre la violation a été formulée s'appliquent.

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