

Joint Applicants or Co-owners of Intellectual Property

Sometimes you may wish to apply for (or to own) an intellectual property right (e.g. patent, registered trade mark or registered design) together with one or more people. This is perfectly possible but can cause complications if certain matters are not made clear at the outset. The purpose of this sheet is to outline some of the issues that can arise.

Relationship between co-owners

Firstly, you should be aware that the co-owners of the rights can agree amongst themselves any arrangement of ownership and division of rights and responsibilities that they wish.

However, as with most agreements, it is of course better if these matters are set down in writing at the outset. We can advise on this if you wish.

If the co-owners do not agree any particular arrangement, then the law in the UK provides a "default" position as follows: unless agreed otherwise, where a patent or registered trade mark is granted to more than one applicant, each applicant (co-owner) has an equal undivided share in it. This means that:

- a) Each co-owner is entitled to use the rights without needing the consent of the other co-owners, i.e. if you fall out with your co-owners they will be able to carry on using the rights without needing your agreement. This can be particularly dangerous in the question of a trade mark and may lead to invalidation of the trade mark registration. This provision of course does not necessarily mean that use of the rights does not infringe the rights of third parties.
- b) None of the co-owners may grant a licence, or assign or mortgage their share of the rights without the consent of all the other co-owners. Therefore, if one co-owner wishes to use the rights by licensing a third party, it is important to reach agreement on this.
- c) Upon the death of one of the co-owners, that owner's share devolves to his or her personal representatives and not to the other co-owners.

These comments apply equally to patent applications, patents, trade mark applications and registered trade marks.

The law does not set out any "default" position for registered designs or other rights and it is therefore even more important that written agreement is reached in such cases.

Even if the "default" arrangement set out above is acceptable to all co-owners, there are other matters on which the co-owners should reach written agreement in order to avoid disputes in the future.

For example, an agreement between co-owners should define the responsibility for paying renewal fees, suing infringers and resisting revocation of the rights by others, together with responsibility for the costs involved.

Relationship with Mewburn Ellis LLP

Where an application or right is to be owned by more than one person, we prefer to act for only one of the co-owners involved.

This is to avoid possible conflict of interest problems if the co-owners should fall out in the future. In cases of this kind, we will require all of the co-owners to sign an acknowledgement, agreeing that we are acting for only one party who will be our client.

The acknowledgement also specifies that we need only write to our client and we will only take instructions from our client. This is to enable us to obtain clear instructions on an urgent basis when necessary, and to avoid us getting conflicting instructions from different co-owners.

Of course, the co-owners may include arrangements for taking decisions and sharing costs between themselves in their co-ownership agreement.

TO: Mewburn Ellis LLP, Patent and Trade Mark Attorneys

FROM: [List all parties involved]

RE: Invention/Trade Mark/Design ("the right"):
and/or Patent/Trade Mark/Registered Design Application ("the application"):

and all other applications concerning the above "right".

1. We agree and acknowledge that:

1.1 (If applicable) the inventor(s)/creator(s) of the above Invention/Design is/are:

1.2 By virtue of an assignment or agreement dated:

and/or the employment of:

by:

the current owner(s) of the right is/are:

1.3 the application specified is currently in the name of:

2. We understand that Mewburn Ellis LLP is representing the interests of "the Client":

in connection with the above application, and any or all other applications concerning the above right or any part of it which have or should be filed anywhere in the world, and that Mewburn Ellis LLP will act solely upon the instructions of the Client including (but not limited to) instructions to file applications in any name, to record assignments and changes of name of the proprietor of any patents, registered trade marks, registered designs or applications, to amend any patents, registered trade marks, registered designs or applications, to allow any patents, registered trade marks, registered designs or applications to lapse, to abandon any rights, to maintain and renew any patents, registered trade marks, registered designs or applications, and to incur costs and expenses in connection with such matters, and we do not expect Mewburn Ellis LLP to notify any of us before acting upon any instructions given by the Client in connection with any of their matters.

3. We agree that Mewburn Ellis LLP will not report to any of us other than the Client and will not take instructions in connection with this matter from any of us other than the Client.

4. We acknowledge that Mewburn Ellis LLP will issue its invoices to the Client and the Client will be responsible for payment to Mewburn Ellis LLP.

	<i>Signature</i>	<i>Name/Company</i>	<i>Date</i>
A.	<input type="text"/>	<input type="text"/>	<input type="text"/>
B.	<input type="text"/>	<input type="text"/>	<input type="text"/>
C.	<input type="text"/>	<input type="text"/>	<input type="text"/>
D.	<input type="text"/>	<input type="text"/>	<input type="text"/>

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