

**Licensing and Transfer of Ownership  
in Different Jurisdictions:  
Commercialisation of IP Generated in FP7 Projects**

**Mark Anderson**  
**Anderson Law LLP, Oxford, UK**  
[www.andlaw.eu](http://www.andlaw.eu)  
[www.ipdraughts.wordpress.com](http://www.ipdraughts.wordpress.com)

## My background

- **IP/commercial lawyer since 1984**
  - Anderson & Company/Anderson Law LLP (since 1994; 6 lawyers)
  - Bristows (major London IP law firm) (7 years)
  - British Maritime Technology Limited (in-house role) (3 years)
- **Technology-based companies and university clients**
  - IP agreements, R&D contracts and commercial contracts
  - Spin-out transactions
  - Commercial disputes, including IP disputes
- **Training courses**
  - Professional courses on contract drafting and IP subjects
  - Visiting lecturer at University College London, Faculty of Laws
    - LLM course in Commercialisation of IP

# Publications and awards



**Chambers Directory UK 2012  
Life Science; Intellectual Property**

**IAM Patent 1000, 2012**



# Joint ownership issues: a UK perspective

# Is letter of intent effective to transfer ownership to MegaCorp and NewCo?

- **Do other consortium members own their IP?**
  - Separate discussion
- **Is LOI governed by English law?**
  - Probably not? Not stated, limited connection with UK
  - If so, unclear if binding – not a good document
  - Has it been signed by authorised signatories?
  - Agreement to assign, not actual assignment
    - Enforceable in equity?
  - What will WIPO arbitrator say?

## What are the rights of co-owners?

- **What are property rights of co-owner**
  - Different from joint owner? National property laws
- **Specific rights under patent laws**
  - Equal undivided share?
  - Require consent of other co-owner to assign, license?
- **Who takes decisions on**
  - Choice (and payment) of patent attorney
  - Prosecution, enforcement of patents
  - Defence of third party claims
  - Licence negotiations, revenue sharing, etc, etc.

## Is co-ownership a bad idea?

- **Yes, but what's the alternative?**
- **Imbalance of co-owners' rights**
  - MegaCorp may not need to license?
- **Solve problems with detailed co-ownership agreement?**
- **Relationship with other consortium members**
  - Should there be warranties of title, etc?

## Implications of 'stalemate' between MegaCorp and NewCo

- **Can other consortium members take IP back?**
  - Implied obligation of commercialisation in LOI?
  - Terms of access rights in consortium agreement?
- **Want to argue that LOI is not binding?**
- **Are College and Institution licences affected?**



## Can NewCo use and license the Foreground IP in the Side Study?

- **Use yes, license no? (if it is a co-owner)**
- **Access to Background IP? (LOI says yes)**
  - What does consortium agreement say?
  - Is the Side Study truly outside the FP7 project?
- **Will such use or commercialisation infringe T-roll's IP?**
  - Will anyone indemnify NewCo?

# Can MegaCorp stop General Ecstatic plc from commercialising non-invasive technology?

- **Not licensed to MegaCorp Background IP**
  - Relevant?
- **MegaCorp not consenting to Foreground IP**
  - Does it cover the non-invasive product?