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Joint Ownership in Consortium Agreements

- Determination of Inventorship
- Ownership
- Prosecution
- Licensing
- Sharing Costs and Revenues
- Enforcement
- What Happens When We Can't Agree



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Inventorship and Ownership

- Not all university faculty have employment contracts; does their university own their rights?
- University inventor(s) may be acting as consultants, in which case ownership is defined by agreement (if there is one)
- Other parties to consortium may own their own rights or their employer may own their rights
- *Challenges to clarify not only inventorship but also ownership*



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Prosecution

- Who controls prosecution?
- What if one party (or more) wish to file first in their own country?
- Approval of law firms; can they represent all parties?
- What language is first patent application filed in?
- What if the parties disagree on prosecution strategy?



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Licensing

- As joint owners, will the parties agree to license together or all individually?
- Will one party control marketing and licensing?
- Will the other parties review and/or sign subsequent license agreements?
- Reserved rights for the parties?
- What if they disagree on the licensing terms?



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Sharing Costs and Revenues

- How are the entities going to share costs for patent prosecution?
- How are revenues from licensing shared among the parties?
 - Numbers of patents licensed
 - Contribution of the inventors to the claims
- What if they disagree?



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Enforcement

- Pre-license, what happens if the party(ies) identify an infringer?
- Who manages/controls/pays for enforcement litigation?
- How are settlements made?
- How are settlements shared?
- What if they disagree?



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Settling Disputes

- Many opportunities for disagreement with joint ownership
- Are same mechanisms for settlement appropriate?